

# TRADE MARKS

WORK  
MANUAL

IDEAS TODAY,  
ASSETS TOMORROW.

## About IPOS

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## **WHAT IS A TRADE MARK?**

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## WHAT IS A TRADE MARK?

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## **1 INTRODUCTION**

This chapter is concerned with what constitutes a trade mark as well as issues relating to the graphical representation of trade marks.

## 2 RELEVANT LEGISLATION

### Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

#### Interpretation

2. —(1) In this Act, unless the context otherwise requires —

...

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

"trade mark" means any **sign** capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

#### Application for registration

5. —(2) The application shall —

...

(c) contain a clear representation of the trade mark;

...

#### Withdrawal, restriction or amendment of application

14. —(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If the application has been published, the withdrawal or restriction shall also be published.

(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(4) The Minister may make rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

#### Registration subject to disclaimer or limitation

30. —(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.



- (2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.
- (3) The Minister may make rules as to the publication and entry in the register of a disclaimer or limitation.

### 3 DEFINITIONS – “TRADE MARK” AND “SIGN”

The definition of "trade mark" is a closed and exhaustive definition in that a “sign” must satisfy certain requisite conditions before it will qualify as a trade mark. The requisite conditions are:

- (i) the sign must be capable of being represented graphically; and
- (ii) the sign must be capable of distinguishing the goods or services dealt with or provided in the course of trade by a person from those provided by another person.

The definition of "sign" is an open or inclusive definition, in that the definition merely lists some examples of what may constitute a sign.

Based on the above, no type of sign is automatically excluded from registration unless it is clear that the sign does not constitute a trade mark based on the definition of a trade mark.

## 4 ACCEPTABLE FORMS OF GRAPHICAL REPRESENTATION

Section 2(1) provides that a trade mark is any sign capable of being represented graphically. Graphic representation requires that the sign must be able to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (see *Ralf Sieckmann (Case C-273/00)*). In that case, the ECJ decided that to be represented graphically, the mark must be presented in a way that is "clear, precise, self-contained, easily accessible, intelligible, durable and objective".

The purpose of the graphic representability requirement is:

- To define the mark and the protection on the Register.  
The entry of the mark in a public register is to make it accessible to the competent authorities, the public and particularly to economic operators. Therefore, a trade mark must be **precise and clearly represented** so that the competent authorities know the nature of the signs of which the mark consists in order to be able to fulfill their obligations in relation to the prior examination of the registration application and to the publication and maintenance of an appropriate and precise register of trade marks.
- To enable the public to determine the precise nature of the mark sought for registration and the scope of the registration granted or sought for.  
In order for third parties and users of the Register to know the precise nature of the mark sought for registration and the scope of the registration granted or sought for, the graphic representation in the register must be **self-contained, easily accessible and intelligible**. Applicants inspecting the register must be able to understand what the trade mark is. Applicants must be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.
- To fulfill the significance of a trade mark as a guarantee of origin.  
In order to fulfill its role as a registered trade mark, a sign **must always be perceived unambiguously** and in the same way so that the mark is guaranteed as an indication of origin. It must represent no other sign except the one being applied for.
- To enable future renewals of the trade mark.  
As a trade mark can be renewed every 10 years and maintained without any limit as to the total duration for as long as the proprietor wishes, it is necessary for the representation to be **durable**.
- To enable an objective assessment of the registration application.  
The object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be **unequivocal and objective**. It must be possible to determine precisely what the sign is without the need for any samples or aids.

However, graphic representation does not mean visual representation. It does not matter that the mark cannot be perceived by a mere visual inspection. For example, in the case of sound marks, the relevant sound could be represented by musical notation even though it would not be possible to perceive the sound mark visually.

**(a) Shape marks**

For shape marks, a mere description of the shape would not be sufficiently precise to meet the graphical representation requirement (see *Swizzels Matlow Ltd's Application [1999] R.P.C. 879* below).

A shape mark should be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration as shown in the picture(s).

**(i) Overall shape of goods or container claimed as the trade mark**

Where the subject matter of the proposed registration consists of the overall shape of the goods or their container, it is inadequate to represent the shape by filing a single "front on" view of it because it would be difficult to ascertain from this one view whether the shape has a round profile or is four-sided. Unless the subject matter of the trade mark can be captured from a single perspective view, multiple views of the shape should be filed. The more complex the shape the more likely it is that multiple views will be necessary. Where multiple views are filed each view should be named accordingly, eg. front view, side view, etc.

Pictures should not be put forward as mere **examples** of the shape described in words, the graphical representation requirement would not be met since this way of representation would fall foul of the requirement for "a fixed point of reference".

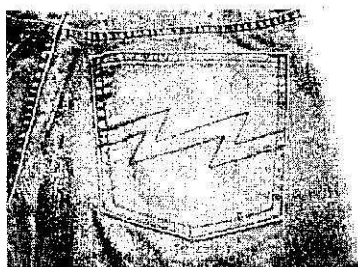
**(ii) Parts of or essential particulars of a shape claimed as the trade mark**

Where the subject matter of the proposed registration consists of only **part of a shape or the essential particulars of a shape** (such as the shape of a lid for a container), or the **position of something** (such as a label) attached to a three-dimensional object, such as a container, it is not necessary for the representation of the mark to show more of the shape of the three-dimensional container etc than is necessary to disclose the subject matter of the proposed registration. For example, it may only be necessary to show the shape of the lid and the position of the label thereon. It would also not be necessary to show all perspectives of the shape that do not disclose the essential particulars of the shape sought for registration.

In such a case, the parts of the configuration claimed to constitute the trade mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines. Alternatively if the unclaimed parts are not in broken lines but the

description of the mark makes it clear that some aspects of the pictorial representation shown are not claimed, it would also be acceptable.

### Example



Description of mark:

“The trade mark consists of a device of zig zag stitches applied to the pockets of the goods, as shown in the representation on the application form.”

**In summary**, the description and the pictorial representation of the shape of the trade mark should together clearly define all the details which constitute the trade mark.

### Examples

- The trade mark consists of the shape of a biscuit, as shown in the representation on the application form.
- The trade mark consists of the 3-dimensional shape of a rooster applied to the roof of a vehicle, as shown in the representation on the application form, where the vehicle itself is represented as dotted lines.
- The trade mark consists of a 3 dimensional shape of a perfume bottle with the words and device appearing thereon, as shown in the representation on the application form.

In the case where the pictorial representation is clear and all features of the mark are obvious, a briefer description of the trade mark will be acceptable.

### Example

The trade mark consists of a 3 dimensional shape of a cookie container as shown in the representation on the application form.

NOTE: A term such as "as exemplified in the representation" is not sufficiently precise, and should not be accepted. This term does not clearly specify what the trade mark is. It merely says that an example of what the trade mark might be is attached to the application form.

### Summary of Swizzels Matlow Ltd’s Application

An application was lodged in the UK on 3 March 1997 for “Non medicated confectionery” in Class 30. In place of the graphic representation was the statement: “The trade mark consists of a circular compressed tablet bearing a raised heart outline

on both flat surfacing and containing with the heart outline on one side any one of several different words or phrases.”

It was indicated that the mark was three dimensional.

Section 3(1)(a) objection was raised on the basis that the mark was not represented graphically since there could be several permutations of marks. Section 3(1)(b) and (c) objections were also raised on the basis that the mark was devoid of distinctive character and was a sign which other traders may wish to use.

During the hearing, evidence was filed in the form of brochures, advertisements and various aids. It was found that the sign was always used with the house mark SWIZZELS and the trade mark LOVE HEARTS.

The Section 3(1)(c) objection was eventually waived.

The Section 3(1)(a) objection was maintained for the following reasons:

- (a) The applicant did not demonstrate that the sign applied for was capable of being graphically represented by reference to the representation of the mark filed.
- (b) It was unclear from the description filed what was the exact meaning of “circular compressed tablet” and the term “raised heart outline” did not define the mark clearly. It was not possible to be certain about the positioning, size of the heart outline or the circumference of the circular compressed tablet.
- (c) A sign would be considered graphically represented only when the graphical representation can stand in place of the sign used and represents only that sign. In this case, it is not possible as the description could represent a significant number of other signs.
- (d) It was impossible for anyone inspecting the register or reading the journal to understand from the description what exactly the trade mark consisted of.

The Section 3(1)(b) objection was also maintained as it was found that the sign was likely to be regarded by the public as mere decoration since the outline of a heart was a commonly used device for the products in question.

At the hearing, the applicants offered to amend the description by adding a limitation via Section 13 of the UK Trade Marks Act 1994. The limitation reads as:  
“The mark is limited to goods which are 19mm in diameter and 4.76mm in length.”

This was rejected as it did not serve to overcome the Section 3 objections and the request did not fall within the provisions of Section 13 nor Section 39(2) of the UK Act. It was decided that Section 13 could be used to limit the representation of the mark in a manner that amounted to an amendment of the representation of the mark itself.

A further appeal was made on 29 January 1999, but the appeal also failed. On appeal, it was affirmed that a mere description of the mark would be inadequate. To satisfy

the requirement of graphical representation, it is essential that the description must stand on its own to identify the trade mark. While it is possible that a mere description of a mark may be enough to meet the requirements of being “graphically represented”, it is unlikely to be good enough unless the description is sufficiently precise.

**(b) Pictorial, figurative or word marks incorporating colour**

Where the trade mark consists of colours in combination with other elements whether they be pictorial, figurative or word elements, a coloured image of the trade mark will be required to be lodged with the application. Colour identification codes will **not** be required for these types of marks.

**(c) Colour(s) as a trade mark**

Where the trade mark consists solely of colour(s), a sample of the colour(s), in the form of a graphical representation, is required to be lodged with the application. In addition, the Registrar recommends that the applicant includes on the application form, a designation from an internationally recognised identification code where the colour or shade exists in the coding system. However, the failure to indicate such a designation on the application form will not result in the application being denied a filing date.

There are a number of colour code identification systems in existence e.g. Pantone®, RAL and Focoltone®. It is not an exhaustive list and it is the choice of the applicant to decide which system to use.

An appropriate description should also be included in the application form to indicate whether the mark consists of the colour(s) applied to the goods or their packaging or to other commercial item. Where colour is applied to the whole (or substantially the whole) surface of the object in question, a statement in words to this effect will suffice. In other cases a picture or diagram may be necessary to identify the area(s) of the item to which the colour(s) is/are applied. Example:

*“The trade mark consists of the colour green (RAL \_\_\_\_), applied to the cap of a container as shown in the representation on the application form.”*

Note: A claim for colour as “an essential element” is unacceptable terminology as it neither restricts the trade mark to colour, nor gives any useful information as to the use of the colour within the trade mark.

In *Heidelberger Bauchemie GmbH (Case C-49/02)* the ECJ held that a graphic representation consisting of 2 or more colours, designated in the abstract and without contours, must be **systematically arranged by associating the colours concerned in a predetermined and uniform way**. The mere juxtaposition of 2 or more colours, without shape or contours, or a reference to 2 or more colours “in every conceivable

form”, as was the case here, lacks precision and uniformity. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

Consequently, it is important for the applicant to be precise about his claims for protection. If the distinctive character of the mark used by the applicant depends in part on other factors, such as a specific arrangement of colours or the manner of application of colour(s) to goods and he did not make that clear in his application form, it will not be possible for him to amend his application later on to include such claims since such an amendment would affect substantially the identity of the mark sought to be registered.

#### **(d) Sound marks**

The ECJ ruled in *Shield Mark BV v Joost Kist h.o.d.n. Memex (Case C-283/01)* that the following would not be sufficient graphical representation of a sound mark:

- (i) a description using written language showing an indication that the sign consists of notes going up to make up a musical work;
- (ii) an indication that the mark consists of the cry of an animal;
- (iii) an indication by means of simple onomatopoeia without more;
- (iv) an indication by means of a sequence of musical notes without more.
- (v) merely stating the name of a specific piece of music is not acceptable as it requires prior knowledge of what the sound is.

A sound mark is considered to be graphically represented when it consists of a representation by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.

If a particular musical instrument is used to produce the sound forms part of the mark, this should be stated.

The description and the representation of the trade mark should together clearly define all the details which constitute the trade mark.

#### **Example**

The trade mark consists of the spoken letters AT&T in the rhythm of an eighth note triplet (AT&T) and one quarter note (for the final T) superimposed over musical sounds in the key of B flat major, namely, the melody notes F, B flat, G and C in the same rhythm as expressed above, along two accompanying chords, one of the four notes F, B flat, C and F and the other of two notes F and F. Both notes are of half note value. In musical notation, the mark is as shown in the representation attached to the application form.



**(e) Scent marks**

Scent is one of the more unusual kinds of signs and is difficult to represent graphically. It is only registrable if it is possible for the public to identify the goods and services of a proprietor through the scent.

In *Ralf Sieckmann* an application was made in classes 35, 41 and 42 with the following description in the application form:

“Trade mark protection is sought for the olfactory mark deposited with the Deutsches Patent- und Markenamt of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula is set out below. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt.



The applicant also lodged an odour sample of the sign in a container and described the scent as “balsamically fruity with a slight hint of cinnamon”.

The ECJ held that the requirements of graphic representability of a “scent mark” are not satisfied by a chemical formula, a description of the scent in words, the deposit of an odour sample or by a combination of these elements. The reasons are as follows:

- a) Few people would recognise a chemical formula as representing the actual odour. In addition, a chemical formula does not represent the odour of a substance, but the substance itself. Therefore the chemical formula cannot be regarded as a graphic representation.
- b) As for a description of an odour in words, although it is graphic, it is not sufficiently clear, precise and objective.
- c) As for the deposit of an odour sample, it does not constitute a graphic representation as an odour sample is not sufficiently stable or durable.

NOTE: It appears that at present stage of technology, there has not been found an acceptable graphical representation for “scent marks”.

**(f) Moving marks**

Moving marks can be represented by a sequence of still pictures in the correct sequence that corresponds to the mark in use and a written description describing the nature of the mark represented by the still pictures. The description should include the following information:

- That the mark is a moving image
- What the images depict i.e. what the change in appearance is

- How many images are involved
- What is the sequential order of the images
- That there is a single sequence of the movement (and not a variable sequence)

**Example**

UK Trade Mark No. 2235348 owned by British Telecom which shows in a combination of pictures and words, the moving image of a revolving globe. The application consists of 286 images representing the globe as it revolves. Their description reads as:

“The trade mark is an animated sequence consisting of a rotating globe device, in which the continents are depicted in the colours red, pink, purple, blue, green, yellow and orange, which is produced by sequentially displaying the attached images in the order given, starting from the top left corner moving across the row to the far right, returning to the second left row and moving across again to the far right, continuing in this order from left to right, ending with the bottom right corner, whereupon the sequence will recommence.”

**(g) Holograms**

Each of the various views of the hologram must be depicted in the representation so that all the material features of the mark are apparent.

For simple holograms where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

NOTE: The Registry has received two applications for hologram marks through the Madrid Protocol. They are:

(i) T01/08194G - T01/08196C in Classes 03, 24 and 25



The description originally reads as “Mark consisting of a hologram.”

This mark has been registered as the applicant confirmed that the hologram consists of a simple image whereby the features do not change according to the angle in which it is viewed. The description of the mark was allowed to be amended to read as:

“The mark consists of a simple hologram as shown in the representation attached to the application form.”

(ii) T03/18748C in Class 10



The description of the mark reads as “The trademark comprises a hologram.”

The applicant has clarified that the mark is a hologram because:

Seen from top to bottom:

Colour changes: the writing of the trade mark logo turns blue except for the dash and the underline (the word “balance” written in green turns blue, the red dash stays red, the yellow line under “Head” stays yellow).

Seen from bottom to top:

Colour changes: the writing of the trade mark logo turns green. “Head” written in blue turns green, red dash stays red, the yellow line under “Head” stays yellow.

However, due to administrative issues, the application has been abandoned.

## **5 FAILURE TO COMPLY WITH THE REQUIREMENTS FOR GRAPHIC REPRESENTATION**

### **Singapore’s current practice**

As long as the application contains a clear (i.e. good quality) representation of the trade mark, a filing date will be granted to the application. No deficiency notice will be sent out even if the representation fails to satisfy the requirements for graphic representation. Such an objection will only be raised during the examination stage. However it will not be possible to amend the mark after filing unless the amendment is justified under Section 14. Where the amendment cannot be justified under Section 14 as an obvious mistake for example, the applicant would have forgone his filing fees.

### **Singapore’s new practice**

If the application does not contain a graphical representation of the mark sought for registration, the Registrar will object to it under Section 5(2)(c) of the Act. No filing date will be granted. The Registrar will then write to the applicant or his representative raising the deficiency and allow two months for things to be put right.

If the deficiency is corrected, the filing date will be the date on which a representation of the mark or marks is presented to the Registrar.

If inadequate representations are deleted from a series of marks, which included marks which were graphically represented, the original filing date will be allocated.

If the deficiency is not corrected/required information is not provided within the two month period, the application will be treated as never having been made. The two month period cannot be extended.

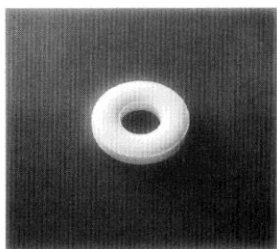
On the question whether the application meets the requirement that the sign is capable of being graphically represented, this assessment will be done at the examination stage. Where the graphical representation does not meet the criteria required for a sign to be deemed as capable of being graphically represented, objections will be raised and applicants will be given a time line to respond to the deficiencies raised.

### **Amendment of graphic representation after filing**

Once a filing date has been given, the mark can only be amended if the applicant can satisfy Section 14 i.e. only if the amendment is to correct an obvious mistake and does not substantially affect the identity or material features of the original mark.

This means that when the mark (which is graphically represented) is not distinctive prima facie, no amendment can be made to the mark to limit the mark for example to colours unless he can satisfy Section 14. One cannot disguise the amendment under Section 30 (via limitation of the goods, size of mark or colour of the mark) or via restriction of the specification when in truth it is an amendment of the mark (see *Société des Produits Nestlé SA v Mars UK Ltd* [2004] EWCA Civ 1008).

In *Société des Produits Nestlé SA v Mars UK Ltd*, it was held that the UK equivalent of Section 30 deals with limitations to “the rights conferred by the registration”. The hearing officer’s requirements of colour and size did not limit “the rights conferred by the registration” of the mark identified in the application. The limitations apply to the description of the mark itself. Limitations applying to the description of the mark should appear as part of the graphic representation. The mark in this case found to be lacking in distinctiveness was:



### **The amendments that were not allowed**

A limitation under UK’s equivalent of Section 30:

“The rights are limited so as to exclude use other than in connection with white sugar confectionery having an external diameter of approximately 2 cm.”

Amendment under UK’s equivalent of Section 14(1) to restrict the specification to:

“White, mint flavoured, compressed confectionery of the shape shown in the form of application and having an external diameter of approximately 0.8 cm and a minimum thickness of approximately 0.4 cm.”

Example of how the mark should be re-filed:

Description of mark: “White, mint flavoured, compressed confectionery of the shape shown in the form of application and having an external diameter of approximately 0.8 cm and a minimum thickness of approximately 0.4 cm.”

## 6 “CAPABLE OF DISTINGUISHING THE GOODS OR SERVICES...”

This requirement in Section 2(1) entails that the trade mark must be capable to the limited extent of being not incapable of distinguishing goods or services (*AD2000 [1997] R.P.C. 168*).

In other words, before a sign can be elevated to the status of “trade mark” and be registered as such, it must possess a distinctive character.

Jacob J in *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, at p. 305 said:

*“Capable of distinguishing means whether the mark can in fact do the job of distinguishing. So the phrase in section 1(1) (Singapore’s Section 2(1)) adds nothing to section 3(1) (SG’s Section 7(1)) at least in relation to any sign within section 3(1)(b)-(d) (SG’s Section 7(1)(b)-(d)). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the Applicants will be unable to prove the mark has become a trade mark in practice - “Soap” for “soap” is an example. The bar (no pun intended) will be factual not legal.”*

In considering whether a sign is “capable of distinguishing”, it is permissible to take into account the use which has been made of the sign in so far as the prior use affects the meaning of the sign, even though it is not permissible to apply the proviso to Section 7(2) to Section 7(1)(a). In other words, use can affect meaning but any distinctive character acquired by use must be ignored.

The test to be applied has a very low threshold. The question could be expressed as - is this a sign which, hypothetically at least, could perform the function of identifying all

goods marked with it as coming from the control of the same undertaking? If the answer to this question is yes, the “sign” is a trade mark.

The ECJ in *Philips v Remington (Case C-299/99)* ruled that there is no special category of marks which, even though distinctive in fact are nonetheless incapable of distinguishing as a matter of law. This decision would mean that if a non-distinctive sign is nevertheless proven to have acquired a distinctive character, then that sign must be capable of distinguishing the goods/services of one person from another.

Accordingly, it is unlikely that the Registrar will raise an objection that the mark is not capable of distinguishing goods/services. If acquired distinctiveness can be established then there must be an underlying capacity to distinguish. If acquired distinctiveness cannot be established, it is immaterial whether the mark is objected to under Section 7(1)(a) or some other limb of Section 7(1).

# **COLOUR MARKS**

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## **1 INTRODUCTION**

This chapter is concerned with the registration of colour and coloured marks and the registrability of such marks.

## **2 RELEVANT LEGISLATION**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Interpretation**

**2.** —(1) In this Act, unless the context otherwise requires —

...

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

#### **Absolute grounds for refusal of registration**

**7.** —(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

### 3 CONCEPTS OF COLOUR AND COLOURED TRADE MARKS

There are various ways in which colour(s) may play a role in trade marks.

#### (a) A colour, by itself or in combination with other colour(s) as a trade mark

This is a case whereby the applicant is claiming rights to the colour(s) per se (that is, colour without limitation as regards shape, extent or presentation) as applied to the goods themselves or as an aspect of packaging which is used as a trade mark, example, a particular coloured wrapper or box used to cover the goods.

(See Chapter on “What is a trade mark?” on how to graphically represent colour(s) as a trade mark.)

#### (b) Colour limitation

This is a limitation of the right in the trade mark to particular colour i.e. the applicant is claiming rights to a word or device or combination of word and device in particular colour(s) only and no rights are conferred to the applicant of the same word or device or combination of word and device in other colour(s).

A precise and unambiguous representation of the trade mark in the colour(s) used is needed. An acceptable description to accompany the application will be “The trade mark is limited to the colour(s) green and blue as shown in the representation of the application form”. As such, the rights of the owner will be limited. Colour limitation is to be done on a voluntary basis by the applicant.

Where the mark is originally filed without colour limitation, it is not possible for the applicant to subsequently volunteer such a limitation (see UK Court of Appeal in *Société Des Produits Nestlé SA v Mars UK Limited [2004] EWCA Civ 1008 (also known as Polo Mint case)*). (Please refer to the Chapter on “What is a trade mark?”).

#### (c) Colour(s) in combination with other features

This is essentially a pictorial, figurative or word mark incorporating colour or colours. A claim that colour is a feature of the mark is not necessary. Once a coloured representation is attached to the application form, the Registrar will treat the colour(s) as a feature of the trade mark. No colour limitation is needed. The mark will be examined in the colour(s) as filed without any clause needed.

Should the applicant insert a description or clause that certain colour(s) are claimed as a feature or component or element of the mark in the application form, the Registrar will clarify with the applicant what the applicant intends and may require the applicant to delete the description if it is not the applicant’s intention to limit the mark to the colour(s) as filed. Colour identification codes will **not** be required for these types of marks, because tonal differences are unlikely to have any material bearing on

the identity of the subject matter of these types of trade mark, but will be recorded if filed.

**(d) Black-and-white representations**

Where the graphical representation of the mark is in black and white, it means that use of the mark in colour(s) is neither claimed nor disclaimed. Therefore, the mark is taken to have been used regardless of whether it appears in colour(s) or it appears in black-and-white as long as the representation conforms to the template or pattern of the mark as registered.

## 4 A COLOUR, BY ITSELF OR IN COMBINATION WITH OTHER COLOUR(S) AS A TRADE MARK

### (a) Graphic representation

(See Chapter on “What is a trade mark?” for how to graphically represent colour(s) per se marks.)

### (b) Difficulties in registering colours per se as a trade mark

A colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of a trade mark. However, in assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought (see *Libertel (C-104/01)*).

This is an important public policy reason for not registering colours as a trade mark. This same public policy ground was applied by The Federal Court of Australia in *Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551* (where the colour Terracotta was the subject of the application). Justice Mansfield was of the view that, if an applicant for a trade mark were to monopolise red in all its shades, the next manufacturer may monopolise orange in all its shades, and the next yellow in the same way, the range of colours left would be very limited for the rest of the traders.

In addition, it may be difficult to satisfy the requirement that the colour in question or the combination of colours in question has the necessary distinctive character without prior use in relation to any goods or services. This is because, the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the relevant consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from those of others.

*“The perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign as a trade mark is sought. Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification. A colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking.” (see *Libertel*, paragraph 65)*

Thus, given that colours are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message as to origin, and given that consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colours or the colours of their packaging, it is at first glance difficult to register colours per se as trade marks. Thus, registering colours per se as a trade mark is more an exception rather than the rule. One category of exception is where the colour/colour combination is exceptionally unique or unusual (eg the colour is not a basic or primary colour) for goods/services which are very restricted and the relevant market is very specific).

*“The fact that registration as a trade mark of a colour per se is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of a particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.” (see **Libertel**, paragraph 71)*

Colour per se marks may also be objectionable for one of the following reasons:

**(i) Colours which serve a function**

Where the colour or colour combination may be seen by the average consumer as serving a function, it will not be capable of serving as an indication of origin. Colours will be functional where:

- **They provide a particular technical result**  
Some colours produce (either physically or chemically) an effect and thereby improve the functionality or durability of the product. For example, the colour black for solar power collectors and associated piping (because of heat absorption) or the colour silver or white in situations where heat or light reflection is required such as building insulation sheeting for roofing tiles.
- **They convey a generally accepted meaning**  
Some colours may convey a recognised meaning. For example, red for heat or danger and green for environmentalism. Another example would be goods such as paints. For such goods, a single colour or even a colour combination is unlikely to be accepted as paints are naturally denoted by their colours.

## (ii) Colours which are common to the trade

Colours which are commonly used in the industry or trade are not distinctive. Colours will be common to the trade where:

- **They are the natural colour of goods**

Some colours are the naturally occurring colour of the product or the result of the manufacturing process. For example, the colour terracotta for roof tiles or pots or the natural colour of hemp rope or seagrass matting. If so, they are not registrable because consumers would not be able to distinguish the goods of the trade mark owner from those of other producers whose goods are of the same colour.

- **Goods in a market in which there is a proven competitive need for the use of colours**

If there is a competitive need for the use of colour in the market concerned, and having regard to the colour chosen and the goods on which it is sought to be registered, other traders may naturally think of the colour and use it in a similar manner in respect of their goods, the colour is also not registrable as a trade mark. For example, registration of two or more colours for goods such as clothing or cars, which normally come in colours, is unlikely to be accepted on a prima facie basis as colours for such goods are not usually regarded as indications of source.

## (c) Acquired distinctiveness

Even if the colours per se is not prima facie distinctive, it may acquire distinctiveness in relation to the goods or services claimed following the use made of it. “That distinctive character may be acquired, inter alia, after the normal process of familiarizing the relevant public has taken place. In such cases, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.” (see *Windsurfing Chiemsee v Boots (Case 108/97)*, paragraph 49). It is to be noted that the evidence must show use of the mark as a trade mark.

In assessing the “use” of a colour or combination of colours as a trade mark, the Registrar will look for evidence whether the applicant has been promoting the colour(s) as something apart from the goods or their packaging. Mere entries in catalogues or brochures showing pictures of the goods in the colour(s) claimed may not be sufficient, even if the applicant is able to show many years of such material.

(See Chapter on “Evidence of distinctiveness acquired through use” for more on acquiring distinctiveness for colour marks.)

Further guidance can be found from UK Opposition Case O-148-03, concerning an application by *Alexander Duckham & Co* to register the mark “*The mark consists of the colour green as added to and integrated with the goods covered by the*

registration, which as a result are wholly and inseparably coloured green as defined by Pantone No 3435.”. The hearing officer in rejecting the case of acquired distinctiveness said as follows:

*“A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so, consumers must rely upon it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative.*

*I am not suggesting that the applicant must necessarily have used the mark as the only means of identifying the trade origin of the product. There is no rule that two or more trade marks cannot operate alongside each other....A trade mark should not therefore be regarded as having acquired a distinctive character in circumstances where (after discounting the distinguishing effect of other marks) it could not be presumed that confusion would occur even if a third party used an identical sign for the same goods. And this cannot be presumed if, in practice, the public place no reliance on the mark.*

*The requirements for securing protection under the proviso to section 3(1) therefore appear to me to be that:*

- a) the mark must have been used by an undertaking as a means of identifying the trade origin of the goods;*
- b) the effect of this use is that the relevant public (or a significant proportion thereof) have come to rely upon the mark, in the course of trade, as a means of identifying the trade origin of the goods*
- c) if the mark is but one of a number used by the undertaking to identify the trade origin of the goods, the competent authority must be satisfied that the mark applied for has, by itself, come to foster a concrete expectation amongst the relevant public that goods bearing that mark originate from, or under the control of, a single undertaking.”*



**Example**

Singapore Registration No. : T99/04253H  
Applicant : BP P.L.C.  
Date of application : 27 April 1999



The mark was applied for in relation to business services relating to aviation and automotive fuel and related services.

The mark was described as consisting of the colour green as applied to the exterior surface of the premises used for the provision of the services.

The mark was found to be acceptable as the Registrar was satisfied that, through substantial use as a trade mark and the effort of the applicant in promoting the colour green as a badge of origin, consumers have come to rely on the colour as a means of identifying the source of the services sought for registration.

**(d) Two or more colours**

A combination of two or more colours may be registrable *prima facie* depending on how unusual the colour combination is in relation to the goods and whether, *prima facie*, the combination is likely to strike the relevant consumer as an indication of trade source. This would also involve a consideration of whether the colours serve a function or is common in the market place or relevant trade.

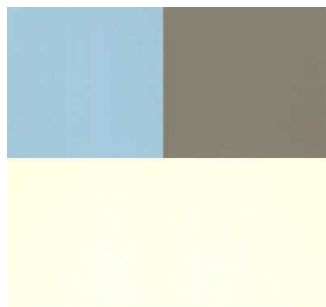
**(i) For goods**

Registration of two or more colours for goods such as clothing or cars, which normally come in colours on a *prima facie* basis, is unlikely as colours for such goods are not regarded as indications of source. Where colour is the nature of the products (such as paints), two colour combinations will also not be registrable on a *prima facie* basis.

As with single colours, additional objections under Section 7(1)(c) and (d) may apply.

**Example**

Singapore Application No. : T00/10524I (abandoned)  
Applicant : Koninklijke Philips Electronics N.V.  
Date of application : 16 June 2000



The mark was applied for in relation to electrical appliances.

The mark was described as: The mark is a colour mark. The rectangular and square shapes of the representation are not part of the distinctive elements of the mark. The mark consists of a combination of the following colours: Ivory:RAL 1015; Pearlblue: Pantone 5435 and Zinc Brown: Pantone 409.

As consumers will not immediately identify the combination of colours as an identifier of source, the mark would not have been acceptable *prima facie*. However, if the applicant can show that through substantial use as a trade mark and the effort of the applicant in promoting the colour combination as a badge of origin, consumers have come to identify the colour combination itself as an identifier of the source of the products, the mark may be accepted on the basis of acquired distinctiveness through use. There would also be the issue of whether the mark has been represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

**(ii) For services**

Colour marks for services are treated in the same way as colour marks for goods.

**Example**

Singapore Registration No. : T99/06795F  
Applicant : 7-Eleven, INC.  
Date of application : 1 July 1999



The mark was applied for in relation to retail services of a convenience store.

The mark was described as: The trade mark consists of three horizontal stripes in the colours orange, green and red on a white or neutral backdrop, as shown in the representation of the trade mark on the form of application.

The Registrar was satisfied, after reviewing the evidence of use, that the said unique colour combination, has acquired distinctiveness of the applicant's convenience store services. That is, through substantial use, consumers have come to identify the said colour combination as identifying that the services originate from the said applicant/proprietor and no other.

## **5 RESEARCHING COLOUR TRADE MARKS**

Research will have to be done by the examiner to determine if the colour is common to the trade or is used in a functional manner within the particular industry.

## **SHAPE MARKS**

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**SHAPE MARKS**

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## **1. INTRODUCTION**

The shape marks covered by this chapter includes two-dimensional and three-dimensional shape marks.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act [Cap. 332, 2005 Ed.]**

#### **Absolute grounds for refusal of registration**

**7.** —(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in Section 2(1);
- (b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of —

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

### **Trade Marks Rules**

#### **Application for registration**

**15.**—(1) An application for the registration of a trade mark must be made in Form TM 4 (called in this Part the application form).

(2) The application must contain a clear indication of the nature of the mark.

#### **Representation of trade marks**

**16.** — (4) Where the Registrar reasonably believes that the representation provided by the applicant does not sufficiently show the particulars of the mark or does not allow all features of the mark to be properly examined, the Registrar may, by notice in writing, require the applicant to provide, within such time as the Registrar may specify in the notice, any or all of the following:

- (a) another representation of the mark consisting of a single view of the mark or of several different views of the mark;
- (b) a description of the mark expressed in words;



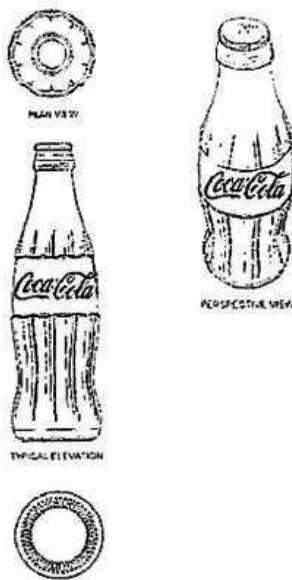
(c) such other information as the Registrar may require.

(6) The Registrar may at any time, if dissatisfied with any representation of a trade mark, require another representation satisfactory to him to be filed before proceeding with the application, and the applicant shall substitute the representation by filing with the Registrar Form TM 27.

### 3. REPRESENTATION AND DESCRIPTION OF SHAPE MARKS

The representation of a shape trade mark (referred herein as “shape mark”) should where practicable, be in the form of a perspective or isometric drawing that shows clearly all the features of the shape mark.

*See example below:*

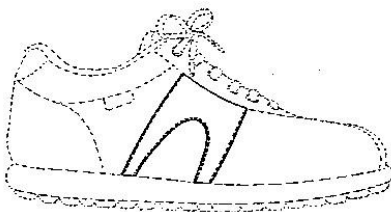


Trade mark number: T0806389H

Description of Particular Feature(s) of the mark: The mark consists of the 3-dimensional shape of a bottle with words "Coca-Cola" appearing thereon as shown in the representation on the form of application.

The parts of the configuration claimed to constitute the shape mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.

*See example below:*



Trade mark number: T0719222H

Description of Particular Feature(s) of the mark: The trade mark consists of a three-dimensional shape of a bridge-shaped arch design applied to the left and right sides of a shoe, as shown in the representation on the notification of international registration. The shape of a shoe, which is represented by a dotted pattern does not form part of the trade mark.

(See Chapter on “What is a trade mark?” for more details on how shape marks should be graphically represented.)

### **3.1 Description of the mark**

An applicant should ensure that there is no discrepancy between the description and the graphical representation of the shape mark. The relationship between the description and graphical representation of the shape mark must be clearly spelled out, for example by including a **cross reference** to the graphical representation in the description. It is important to note that such a description is an integral part of the graphical representation of the shape mark.

If a description is supplied after filing, then care should be taken to ensure that the description is exactly in accordance with the shape mark as filed. Any difference between the graphical representation and description would affect the identity of the shape mark and, therefore, would not be allowable.

The Examiner will usually require that the description includes words such as “... as shown in the representation on the application” to qualify that the description is limited by reference to the drawing or graphical representation.

### **3.2 Indication on the application form**

If the applicant is seeking protection for a shape mark, he should tick the appropriate box on the application form. Rule 15 of the Trade Marks Rules (“**Rules**”) states that an application for the registration of a trade mark must be made in Form TM4 and must contain a clear indication of the nature of the mark.

This indication, together with the graphical representation and description, will indicate clearly that the applicant is applying for a shape mark.

#### **4. SECTION 7(3) OBJECTIONS APPLICABLE TO 2-DIMENSIONAL AND 3-DIMENSIONAL SHAPE MARKS**

Section 7(3) objections can be raised for 2-dimensional and 3-dimensional graphical representations so long as the indication and description on the application form indicate that the applicant is applying for a shape mark. This was the approach taken in *Philips v Remington* [1998] R.P.C. 283. The sign in question was a picture of the head of a three-headed shaver and it was found objectionable under an equivalent of our Section 7(3)(b) – that the sign was of a shape which was necessary to obtain a technical result and shall be refused registration.

## 5. THE TEST FOR REGISTERING SHAPE MARKS

As a general guide, the following should be considered when examining shape marks:

### Step 1

The examiner must consider whether any grounds of refusal under Section 7(3) of the Trade Marks Act (“**Act**”) apply. If so, such grounds of refusal under Section 7(3) of the Act cannot be overcome through evidence of acquired distinctiveness under Section 7(2) of the Act.

### Step 2

The examiner must ensure that the criteria for distinctiveness of the shape itself have been met, otherwise the grounds of refusal under Section 7(1) of the Act will apply.

Under Step 2, the ultimate question is whether the shape is so materially different from basic, common or expected shapes, such that it enables a consumer to identify the goods just by their shape and to buy the same item again if he has had a positive experience with the goods.

Generally, the distinctive character of a trade mark must be judged in light of the goods or services for which the trade mark is registered. This applies not only to word marks, but also to unconventional marks such as shapes, packaging and colours. Whether a trade mark is distinctive depends on how it is perceived by the relevant public. The relevant customers are reasonably well-informed, observant and circumspect of the goods or services in question. In most cases, they will perceive a trade mark as a whole product without paying attention to detail. Therefore, in order to decide whether a sign is distinctive, the overall impression must be studied.

Where protection is sought for a mark which consists of the shape of the goods claimed, the test for distinctiveness of such a mark is no different than that of the test for “ordinary” marks such as word or figurative marks.

However, while the same criteria of distinctiveness apply, it may be more difficult to establish that a shape mark has distinctive character in the eyes of the relevant public, compared to a word or figurative mark. This difference stems from the fact that shape marks usually represent a feature of the appearance of the good itself, and is therefore unable to serve as an identifier of source to the average consumer. This is not the case with word or figurative trade marks, since such marks consist of signs that generally do not represent descriptive features of the claimed goods.

To determine whether a shape (for which registration is sought) is capable of distinguishing one trader’s goods/services from the goods/services of all others, an applicant must consider whether the shape is one which other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use on or in connection with their goods.

(More detailed explanation of what is involved in each of the two steps is set out in the two sections following this.)

## **6. EXAMINATION UNDER SECTION 7(3) OF THE ACT**

In examining the registrability of shape marks, the first hurdle will be whether the shape for which registration is sought falls afoul of Section 7(3) of the Act.

Sections 7(3)(a), (b) and (c) must be assessed independently. They cannot be collapsed into a single hybrid objection.

It must be noted that if the sign falls under any of the categories in Section 7(3), the sign cannot be registered as a trade mark since proof of acquired distinctive character will not overcome the refusal.

### **6.1 Section 7(3)(a) - Shapes resulting from the nature of the goods**

#### **Rationale**

This ground prevents the registration of shapes that result from the nature of the goods claimed. It is not concerned with preventing the registration of marks consisting of the shapes of the goods themselves as shapes of distinctively shaped goods can function as a trade mark.

#### **Application**

The nature of the goods refers to their essential qualities or innate characteristics. For example, a sign consisting of the shape of a banana for bananas would be a shape which results from the nature of the goods themselves. So too, would a shape of a toothbrush for toothbrushes.

The shape of a rabbit, when applied on frozen cabbages, will not fall foul of Section 7(3)(a) of the Act as the shape of the mark cannot be said to result from the nature of the goods themselves.

To assess whether a shape is one which results from the nature of the goods, the Registrar will look at the goods in respect of which the trade mark seeks to be protected for to determine their nature, and consider the following:

- (i) The extent to which the shape is regarded as the “normal” shape of the goods;
- (ii) Where the goods have a “uniform” shape, whether the shape is a variation from the “uniform” shape; if so, the shape may not be objectionable on the ground that it results from the nature of the goods;
- (iii) Where the goods come naturally in a range of shapes, then any one of the usual shapes will be open to objections.

However, it is important to bear in mind that there may be more than one such basic shape, or several usual variations (for e.g., door handles may be round or lever style). To this extent, depending on the shape and claimed goods for which protection is sought, there may be some overlap between Section 7(3)(a) and Section 7(3)(b) of the Act.

With reference to *Societe Des Produits Nestlé SA v Petra Foods Ltd [2014] SGHC 252* (“*Nestlé*”), the following shapes would be excluded from registration under Section 7(3)(a) of the Act:

- (i) “Natural” products which have no substitute;
- (ii) “Regulated” products (the shape of which is prescribed by legal standards);
- (iii) Shapes consisting exclusively of characteristics ordinarily attributed to the goods in question;
- (iv) Shapes with essential characteristics which are inherent to the generic function or functions of the goods.

### Other Examples

- A shape of a lemon as a proposed trade mark for lemons would not be acceptable because the sign would consist exclusively of a shape which results from the nature of the goods themselves – lemons.
- If the goods were lemon juice, then the shape of a lemon should not fall foul of Section 7(3)(a) of the Act. Likewise if the proposed mark was a yellow plastic container in the shape of a lemon, the shape may not be objected to on the ground that it results from the nature of the goods. However, even if a shape mark does not fall foul of Section 7(3)(a) of the Act, it may still attract other absolute grounds of objection under Section 7.

Where the specification is wide, “the goods” refer to any of the goods in respect of which the mark is sought to be registered. Thus, a shape of a banana for “fruit” would be just as objectionable as a shape of a banana for “bananas”.

Although the natural shapes of the goods in question cannot be registered, if the shape has been the subject of substantial design input, then this objection no longer applies.

### Overlap with other grounds of refusal

There is some overlap between an objection under Section 7(3)(a) and the objections on the grounds that the mark is devoid of distinctive character (under Section 7(1)(b) of the Act) or that the mark exclusively designates the intended purpose or a characteristic of the goods (under Section 7(1)(c) of the Act). For example, where the trade mark is a shape of a lemon for “lemons”, obviously, objections can also be taken that the mark is descriptive and thus, not distinctive of the goods in question.

## 6.2 Section 7(3)(b) - Shapes that are necessary to obtain a technical result

### Rationale

The purpose of this provision is to exclude shapes which are merely functional in the sense

that they are motivated by and are the result of technical considerations. In other words, it is to prevent a trade mark monopoly on technical solutions or functional characteristics, which a user is likely to seek in the products of competitors, from being granted to the proprietor. It is in the public interest to allow a shape, whose essential characteristics perform a technical function, to be freely used by all, and to prevent such shapes from being reserved to only one undertaking (see paragraphs 78 and 80 of *Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (“*Philips (ECJ)*”).



## Application

In assessing whether the shape of the goods is necessary to obtain a technical result, one must consider the mark *as a whole* (as held in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2004] EWHC 2327 (Ch) (“*Philips (UKCA)*”). Prior to ascertaining whether the mark consists exclusively of a shape of the goods that is necessary to obtain a technical result, the Registrar will first identify the mark’s essential features. Thereafter, the Registrar will ascertain whether *all* these features perform the technical function of the goods concerned (similar to the steps taken in *Case C-48/09 Lego Juris A/S v OHIM* (“*Lego*”) and *Nestlé* ).

### 1. Determining the essential features of a shape mark

“Essential features” refer to the *most* important elements of a shape mark *to be registered as a trade mark* (see *Nestlé*). The identification of such features is determined on a case-by-case basis (e.g., taking into account the characteristics of the claimed goods and the perception of the average relevant consumer).

The identification is to be determined from the *overall visual impression* produced by the shape mark. The presumed perception or level of scrutiny of the average relevant consumer in relation to the claimed goods is a relevant, although not decisive, consideration in identifying the essential features. In *Nestlé*, the “rectangular slab shape” of the claimed shapes (Nestle’s 2-

Finger  and 4-Finger  marks), in relation to chocolate confectionery, is considered as an essential feature as it is said to be “especially pronounced” when viewed from above by the average relevant consumer. However, the “plinth” of the claimed shape is not considered as an essential feature as the average consumer is unlikely to visually pay attention to or scrutinise this feature.

It is important to note that not every functional element which contributes to the overall impression of the shape will be considered as an essential feature. During the identification process in relation to the essential features, the technical functions resulting from *any* part of the shape mark are irrelevant. It is only after the essential feature(s) of the shape mark has been identified, that the question as to whether the feature as a physical form or shape is necessary to obtain a technical result is to be examined.



## 2. Determining whether the essential features of a shape are functional

A sign consisting exclusively of the shape of the goods is unregistrable under this provision if the essential features of that shape are functional, or attributable only to the technical result (as decided in *Philips (ECJ)*).

The essential feature can be regarded as *functional* if:

- It is essential to the use or purpose of the goods. For example, the feature of a handle and blade assembly for a knife, necessary for the functioning of the knife.
- It is needed to achieve a particular technical result. For example, the vanes featured in a shape mark of a fan which will create a particular air flow pattern.
- It is a feature which has an engineering advantage, resulting in superior performance. For example, a new invented device for slicing bananas that is easier to use than existing devices.
- It is essential to the efficient manufacture of the goods. For example, a spherical shape of a sweet that allows for speedy manufacturing and packaging required for commercial production.

In assessing an application against Section 7(3)(b) of the Act, the Registrar will consider what the nature of a “technical result” is likely to be for the claimed goods. The term should be interpreted broadly and, besides the more obvious types of technical functions, includes shapes which, for example:

- Fit with another article;
- Give the most strength;
- Use the least material; or
- Facilitate convenient storage or transportation.

The fact that there are other shapes which allow the same technical result to be obtained cannot be used to overcome a ground for refusal under Section 7(3)(b) of the Act. In *Nestlé*, the “breaking grooves” appearing in the shape mark resembling a chocolate bar were ruled as functional in nature. Although the presence of a “breaking groove” may not be necessary to break a chocolate bar down for consumption, it is still deemed as a functional feature as it is a more efficient method that allows for a cleaner, easier and more aesthetically pleasing break of a chocolate bar.

Shapes which are the subject of a claim in a patent application are not exempted from an objection under Section 7(3)(b) of the Act. The functional claims made about the shape are *prima facie* evidence that those aspects of the shape are necessary to achieve a technical result. In *Lego*, the European Court of Justice affirmed that the technical functionality of the characteristics of a shape may be assessed by, among other grounds, taking into account the

documents relating to previous patents describing the functional element of the shape concerned, and noted that the Grand Board of Appeal of OHIM and the General Court had indeed taken such documents into consideration with regard to the registrability of the Lego brick.

If the shape of the trade mark is essentially functional with a technical advantage that has yet to become commonplace, its utility should remain open for all to use, and an objection under Section 7(3)(b) should be raised. An example could be a new shape of a can opener which is easier to use than those currently on the market.

### 3. Aesthetic features or non-functional features in the shape

The fact that a shape consists of certain aesthetic or non-functional features does not prevent the operation of Section 7(3)(b) objection if they are not the essential features (i.e. most important elements of the shape) or they are merely part of the essential features, the totality of which is to perform a function attributable to a technical result. In *Philips (UKCA)*, the court agreed with Rimer J's observation that the "clover leaf" feature of the three-headed shaver was not an essential feature of the shape mark.

Trivial embellishments are unlikely to be sufficient to overcome an objection under Section 7(3)(b) of the Act. For example, a knife with a handle engraved with simple stripes is still deemed objectionable as the stripes are minor arbitrary elements in the three-dimensional sign. It does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result.

However, the ground for refusal under Section 7(3)(b) of the Act is not applicable if the shape of the goods at issue incorporates a major non-functional element, such as an imaginative element which plays an important role in the shape.

## Overlap with other grounds of refusal

### Overlap with Section 7(3)(a) of the Act

A shape which is necessary to obtain a technical result may be regarded as resulting from the nature of the goods, or a shape which results from the nature of the goods may be regarded as being necessary to obtain a certain technical result. The partial overlap in the 2 sections is mentioned by the Court of Justice of the European Union (CJEU) in *Hauck GmbH & Co KG v Stokke A/S, Stokke Nederland BV, Peter Opsvik and Peter Opsvik A/S*, where the key difference is said to depend on the perspective one asks the question:

- Determining whether the shape results from the nature of the goods: If the generic function of a good is X, would it be "natural" for the shape of such a good to possess an essential feature Y?
- Determining whether the shape is necessary to obtain a technical result: If a good possesses a natural essential feature Y, would the essential feature enable a *specific* good to perform a technical function X?

The partial overlap is illustrated with an example in *Nestlé*, where an essential feature, which is an *obvious* technical solution for the efficient manufacture of a *specific* good, may be expected to be commonplace among similar types of goods and for the goods to adopt a similar form, and hence suggested to be the “general or inherent nature of the shape” of the goods concerned.

#### Overlap with Section 7(1) of the Act

A shape which is necessary to obtain a technical result may likely indicate the intended purpose of the goods, or it may be customary in the trade and therefore, non-distinctive. Thus, the grounds under Section 7(1)(b) (that the shape is devoid of distinctive character), Section 7(1)(c) (that the shape exclusively designates the intended purpose or a characteristic of the goods) and Section 7(1)(d) (that the shape is a shape that is customary in the bona fide and established practices of the relevant trade) may also apply to refuse a registration of the shape mark, in addition to an objection under Section 7(3)(b) of the Act.

For example, in *Philips (UKCA)*, Remington raised the equivalent of Sections 7(1)(b) or (c) of the Act as grounds of invalidation of the Philips shape mark, in addition to Section 7(3)(b). However, in that case, the UK Court of Appeal, while taking the view that invalidation was made out under the equivalent of Section 7(3)(b), determined that the stylized presentation of the shaving head had distinctive character.

#### 4. Request for additional information where a section 7(3)(b) objection may be contemplated

With reference to the circular “Examination Practice with respect to Shape Marks” ([Circular No. 2/2017, dated 24 Feb 2017](#)), the Registry may request, by way of an Office Action, for additional information for trade mark applications comprising shape marks where a section 7(3)(b) objection may be contemplated. Specifically, the applicant may be requested to:

- (i) State the essential feature(s) of the shape mark; and
- (ii) Provide relevant information on whether the essential feature(s) would be necessary to obtain a technical result.

### 6.3 Section 7(3)(c) - Shapes which give substantial value to the goods

#### **Rationale**

The purpose of this provision is to exclude “aesthetic-type shapes” (i.e., shapes which have eye appeal or are purchased primarily because of the eye appeal) from registration. This prevents conferring on the applicant the exclusive and permanent right (which a trade mark confers) from serving to extend the life of other rights which the legislature has sought to make subject to ‘limited periods’, such as design rights.

#### **Application**

A three-dimensional shape falls afoul of Section 7(3)(c) of the Act, if the shape, as a shape,

adds substantial value to the good and influences the purchase of the good.

In other words, in determining whether Section 7(3)(c) of the Act applies, the value of a good attributable to other factors such as goodwill and reputation, scent, use of quality materials and durability are to be excluded.

As held in *Nestlé*, the following should be taken into consideration when assessing whether the value is substantial:


- The public's perception of the shape of the product;
- The nature of the category of goods concerned;
- The artistic value of the shape in question;
- Its dissimilarity from other shapes in common use on the market concerned;
- A substantial price difference in relation to similar products; and
- The development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.

The decision whether a shape gives substantial value requires a comparison between the shape sought to be registered and shapes of equivalent articles. It is only if the shape has, in relative terms, substantial value that it will be excluded from registration.

Additionally, bearing in mind that something of aesthetic value is a matter of personal taste, whether a shape gives substantial value to the goods is dependent on whether there is a significant section of the public to whom the inherent qualities of the shape appeal strongly to, so as to contribute substantially to the value of the goods in their eyes.

In *Dualit Ltd. v. Rowlett Catering Ltd, UK Trade Marks Opposition Decision (0/186/98)* ("*Dualit*"), the tribunal held that there was survey evidence to show that the aesthetics of the three-dimensional toaster mark appealed to the potential consumers of those products. There was also evidence that the aesthetic appeal of the mark on the goods allowed applicants to charge a premium for the toasters. This therefore resulted in a refusal of registration under Section 3(2)(c) of the UK Trade Marks Act (the equivalent of Section 7(3)(c) of the Act).

In *Bang & Oflusen A/S v OHIM (Case T-508/08)*, the European Court of Justice found that

the shape sought for registration (  ), as a whole, created a striking design which could be remembered easily. The applicant in that case had also admitted that the design was an essential element of its branding and increased the appeal of the product and its value. Further, evidence submitted on the applicant's behalf, namely extracts from distributors' websites and on-line auction or second-hand websites, emphasised the aesthetic characteristics of the shape and that the shape was to be perceived as a kind of pure, slender, timeless sculpture for music

reproduction. The mark was therefore refused for registration under Article 3(1)(e)(iii) of the EU Council Directive (the equivalent of Section 7(3)(c) of the Act).

## **7. EXAMINATION UNDER SECTION 7(1) OF THE ACT**

### **7.1 Whether the shape is devoid of distinctive character**

Even if a shape mark is not objectionable under Section 7(3) of the Act, it is still necessary to ascertain whether the mark is to be refused registration under one or more of the absolute grounds for refusal under Section 7(1).

The European Court of Justice in *Philips (ECJ)* has affirmed that there is no special category of marks which even though distinctive in fact are nonetheless incapable of distinguishing as a matter of law. This means that there is no need to consider whether the shape mark is objectionable under Section 7(1)(a) as a shape mark can, by itself, function as a trade mark. What needs to be considered is whether the shape mark is objectionable under Sections 7(1)(b) to (d).

With respect to the absolute grounds of refusal, there is no distinction between the different categories of trade marks. The criteria for assessing the distinctive character of shape marks are thus no different from those to be applied to other categories of marks. As such, in order to be capable of distinguishing the goods, the shape of an article in respect of which a sign is registered does not require any capricious addition e.g., an embellishment which has no functional purpose.

The test is simply, whether the mark serves to identify the goods in respect of which registration is applied for as originating from a particular source, and thus, is capable of distinguishing the goods and services of one trader from goods and services of other traders. The distinctiveness of a trade mark must be assessed by reference to first, the goods or services in respect of which registration is sought and second, by reference to the perception of the relevant consumers of the goods or services.

It is relevant to look at the presumed expectations of the average consumer of the category of goods or services in question, and assume that such a consumer is reasonably well informed and reasonably observant and circumspect.

Judicial authority has indicated that it may in practice be more difficult to establish distinctiveness in relation to a shape of product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus registered as a trade mark.

As the perception of the average consumer is a relevant question, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three dimensional mark not faithfully representing the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.

It should also be noted that, based on practical experience and established branding practices,

consumers will not rely on the outline or shape of a good or its container in order to determine its origin without having been exposed to that outline or shape for a sufficiently long period to have learned to recognise it ‘at a glance’ without even needing to look for a verbal or graphic sign.

Shape marks that represent the goods themselves and are claiming protection in closely related service classes will be objectionable under Section 7(1)(b) and (c) as they are inseparably linked. For example, the shape of a table for retail services relating to furniture, parts and fittings is, therefore, objectionable.

### **7.1.1 Use of shape by monopoly suppliers**

In cases where the applicant is the only supplier of those goods, the apparent monopoly over the shape of the goods does not automatically render the shape distinctive for trade mark registration.

Nevertheless, use of the shape of the goods before the date of filing of the trade mark application for the shape may be sufficient to establish that the shape mark has acquired distinctive character under Section 7(2) if as a result of such use, a substantial portion of the average consumers associate the goods claimed under the shape mark as originating from the applicant and no other.

Whether there is a monopoly in place over the shape mark is irrelevant to the consideration of distinctiveness.

### **7.1.2 Shapes which are common to the trade**

Any shape which is commonplace for the goods concerned is likely to be legitimately used by other traders.

Therefore, prima facie registration of such shapes is unlikely to be accepted and it may be necessary for the applicant to supply evidence of use demonstrating that the shape, at the date of filing, has acquired distinctive character and is able to distinguish the applicant's goods from those of other traders.

In such situations, it will be the responsibility of the applicant to convincingly show that the shape mark has acquired a secondary meaning and has come to identify the goods of the applicant to the exclusion of other third parties.

The conclusion that something is common to the trade should only be reached after research reveals that the shape, or some minor variation of it, is commonly used within the relevant market. A shape mark hence has to be sufficiently different from a “common shape” so as to permit an average consumer, “without conducting an analytical or comparative examination or paying particular attention, to distinguish the goods concerned from those of other traders”. A common shape is defined as:

- the norm or customary shape in the sector concerned; or

- a shape likely to be taken by the good concerned.

Examples of these types of shapes are standard water bottles for water; a cylindrical mug shape with a standard handle for tea mugs and egg shaped Easter chocolates.

In other words, the shape must not be exclusively descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the good concerned. Comparative evidence should be provided by the applicant to show that the shape applied for is indeed outside the norm and customs of the trade.

A shape that is a 'variant' of a common shape of that type of good, or a simple departure from the norm or customs of the sector is not sufficient - the departure must be significant. Novelty or originality is not relevant in assessing the distinctive character of a mark. For a shape mark to be *prima facie* distinctive, it must differ substantially from the basic shapes commonly used in the trade of the goods in question, and not look like a mere variant of those shapes.

For instance, toys in Class 28 already feature a great variety of commonplace shapes. In this class, it is unlikely that a simple shape such as an animal or toy car will be registrable unless there is considerable additional get up (e.g., clothing) of the sort not normally found in the marketplace. The get up as a whole would need to be most unusual.

#### **Example 7.1.2.1**

*In the matter of Singapore Trade Mark Application No. T0618780H in the name of Societe des Produits Nestle S.A.*



Class 30: Flavours for nutritional purposes

In the above case, the Registrar observed that goods in the nature of the Applicant's goods were typically sold under various container shapes from plain to complex detail. These containers could be designed for functional purposes or made more attractive.

In view of the fact that a consumer was accustomed to being confronted with many shapes of containers, this means that a *prima facie* registrable shape must at least be relatively unusual in order for it to stand out from the crowd and be seen as a badge of origin.



The Registrar considered the mark as not being particularly unusual such that the average consumer would see it as a badge of origin. It has the basic configuration of a bottle with a lid or a cap – this is nothing unusual.

Drawing from the example above, no plain bottle is marketed in its naked form without any additional feature. They can only be found on the market with additional elements such as labels bearing word or figurative marks. The average general consumer **is confronted with an increased sophistication and diversity of packaging in the field of the goods applied for**. The relevant consumer has become accustomed to this amount of variety and familiar with the packaging function of these different bottles. Therefore, the sign applied for will not be perceived by the relevant public as a badge of origin but rather as the packaging of the particular goods.

It is to be noted that even if the shape is not used by other competitors on the market, it may on its own be insufficient to give the shape mark the minimum distinctive character required. This is because the average consumer, who does not make a study of the market, will not know in advance that only one undertaking markets a given good in a certain type of shape or packaging whilst its competitors use other types for that good. Confronted with a multitude of shapes or packaging of various brands, the consumer will refer, rather, to a word mark or logo in order to identify the undertaking of origin of this product.

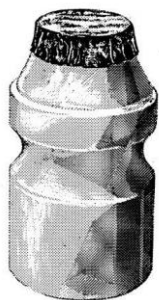
## 7.2 Uniqueness is not the same as distinctiveness

The test for distinctiveness of a mark is whether the average consumer will assume that all goods that come in that shape belong to the same undertaking, and not whether the shape is “unusual”, “memorable”, “recognisable on being seen a second time”, eye catching or highly decorative per se.

To illustrate, the shapes of decorative items such as ornaments or jewellery are unlikely to have inherent distinctive character and be acceptable *prima facie* because it is normal within these trades to provide unusual and imaginative creations for jewellery. Such creations may not automatically perform the function as an identifier of source.

### Example 7.2.1

*Yakult (Bottle Shape) Trade Mark Application, Kabushiki Kaisha Yakult Honsha v Registrar of Trade Marks [2001] R.P.C. 39*



Class 29: Jellies, jams; eggs, milk and other dairy products, including yoghurt and yoghurt preparations; edible oils and fats; preserves, pickles; and meat, fish, poultry and game preparations and extracts.

Class 32: Non alcoholic drinks; syrups and other preparations for making beverages.

The UK High Court held that the fact that a container is unusual or attractive per se does not mean that it will be taken by the public as an indication of origin. Instead, the court had to consider whether the shape of the bottle alone could convey trade mark significance to the average customer. The court ultimately decided that the average consumer of the applicant's goods would likely conclude that the design in the application was nothing more than the shape of a bottle. The mark was therefore refused.

### **7.3 Mere product recognition is not sufficient**

In relation to marks consisting of product shapes, it is not enough to prove that the public recognise them as the product of a particular manufacturer.

It has to be proved that consumers rely upon that shape alone as an indication of trade origin, particularly to buy the goods.

#### **Example 7.3.1**

*Societe de Produits Nestle SA v Unilever plc [2002] EWHC 2709*



Class 29: Ice cream products.

The tribunal held that although the products bearing the above mark had considerable recognition, the evidence did not prove that an average consumer would rely on the appearance alone to identify the goods as originating from a specific trader.

## **8. OVERCOMING ABSOLUTE GROUNDS: ACQUIRED DISTINCTIVENESS**

### **8.1 Whether the shape mark has acquired distinctiveness by virtue of use**

Notwithstanding that the mark may fall afoul of the grounds in Sections 7(1)(b), (c) and (d) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under Section 7(2) of the Act.

### **8.2 Factors for assessment**

In assessing the acquired distinctiveness of a mark, the following may be taken into account:

- (i) The market share held by the mark;
- (ii) How intensive, geographically widespread and long standing use of the mark has been;
- (iii) The amount invested by the undertaking in promoting the mark;
- (iv) The proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;
- (v) Statements from chambers of commerce and industry or other trade and professional associations.

If on the basis of those factors, the Registrar finds that the relevant class of persons, or at least a significant proportion thereof, identify goods originating from a particular undertaking because of the trade mark on the basis of acquired distinctiveness, the requirement for registering the mark is satisfied (see *Windsurfing Chiemsee Productions v Boots (Case C-108/97)*).

### **8.3 Nature of evidence**

To prove that a shape mark has acquired distinctive character as a result of prior use, it will need to be promoted as something apart from the goods.

To lend more weight, the evidence of use should show how the applicant has referred, promoted or demonstrated to potential consumers that the shape as claimed serves as a trade mark.

The evidence showing prior use of the mark should also not deviate from the mark as represented in the application. In other words, if the shape mark is filed without any accompanying material such as word marks and/or figurative signs, whereas the evidence show otherwise, the claim of acquired distinctiveness of the shape itself would not be established.

#### 8.4 **The test: Reliance, not recognition**

Again, the test of acquired distinctiveness has to take into account all the circumstances in which the average consumer may perceive that mark.

The distinctive character of a mark consisting in the shape of a product even that acquired by the use made of it must be assessed in the light of the presumed expectations of an average consumer of the category of goods or services in question who is reasonably well informed and reasonably observant and circumspect.

The essential consideration is that the relevant class of persons of the product identifies the shape mark as originating from a given undertaking as a result of the use of the mark as a trade mark and as a result of the nature and the effect of it - which makes it capable of distinguishing the product concerned from those of other undertakings.

In other words, mere association of a mark with a particular manufacturer or mere use of it is not enough. It must be established that a significant proportion of the relevant class of persons *rely upon the shape mark* (as opposed to any other trade marks which may be present) to get goods from the same trader as before. Registration would then be permissible because the shape would have acquired a distinctive character *in the trade mark sense* (see *Nestlé*).


For more information on the requirements to prove acquired distinctive character, please refer to Chapter 6 of the Work Manual on “Evidence of distinctiveness acquired through use”.

## 9. SHAPE OF PACKAGING OR ASPECT OF PACKAGING

Under Section 2(1) of the Act, the definition of a "sign" that can constitute a trade mark, includes, *“any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof”*.

Where registration of the shape of the packaging is sought, the same absolute grounds considerations under Section 7 of the Act applicable to the shape of goods will equally apply to the shape of the packaging of goods.

*See example below:*

Sign	Decision
 <p><b><u>Singapore application number:</u></b> T1114222A</p> <p><b><u>Description:</u></b> The mark consists of an aspect of packaging of the goods, namely, of a blue can and red cap, depicting the device of a carburetor, as shown in the representation on the form of application.</p> <p><b><u>Class 03</u></b> Cleaning and degreasing preparations for carburetors and chokes.</p>	<p>The representation is that of an aerosol can depicted in a manner that does not depart significantly from the norm or customs of the sector.</p> <p>It has no particular and clearly identifiable element that allows it to be distinguished from the usual ones available on the market and gives it the function of indicating its commercial origin.</p> <p>The device of the carburettor is also descriptive of which the subject goods are intended for.</p>

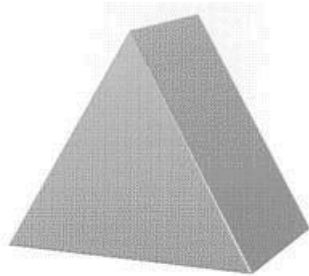
The aspect of packaging may include the container in which the goods are sold or the outer packaging which covers the container. Shape is just one aspect of packaging. There may be other aspects, such as colours, markings, physical indentations or devices on the packaging for which registration is sought.

## 9.1 Where it is not clear whether the trade mark is the shape of packaging or the shape of the goods

Where it is not clear whether the trade mark is the shape of packaging or the shape of the goods, the mark will be assessed on the basis that it is both. For unusual shapes of containers, even if it is accepted that the sign is different to a degree which renders it visually distinguishable from other such signs in use in the relevant market, the question to be determined is whether it is distinctively different so as to be likely to be perceived and remembered by the average consumer as a badge of origin.

### Example 9.1.1

*In the Matter of the request by Kraft Jacobs Suchard SA for protection in the United Kingdom of International Trade Mark No. 711078 (O-106-03)*



Class 30: Chocolates and products containing chocolate.

In order to determine if the mark consisted of the shape of the claimed goods and/or the shape of their packaging, the tribunal felt that it was necessary to treat the request for registration as a two-fold request for the protection in respect of: (i) the shape of the specified goods, and (ii) the shape of their packaging. Ultimately, the tribunal had to decide if the mark was distinctive as both a shape of the claimed goods and the shape of their packaging. The tribunal refused registration on the ground that the mark was devoid of distinctive character, regardless of whether it was viewed either as a representation of the shape of the specified goods or their packaging.

## 9.2 Where the goods possesses no shape on their own


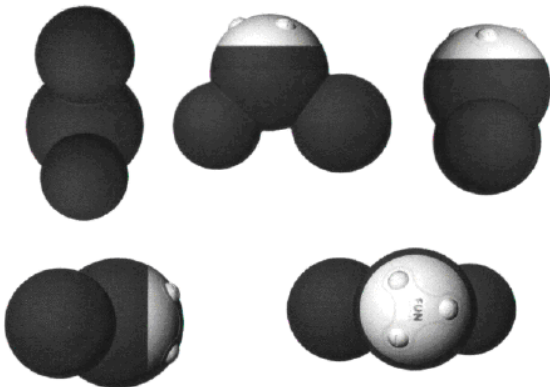
Goods such as granules, powder or liquid lack a shape on their own because of their physical nature. These goods do not possess an intrinsic shape, and must be packaged in order to be marketed. The packaging imposes its shape on the good, and in such circumstances, it is necessary to *assimilate* the packaging to the shape of the goods, so that the packaging constitutes the shape of the goods within the meaning of Section 7(3) of the Act (see *Henkel KGaA v Deutsches Patent- und Markenamt (Case C-218/01)*). Appropriate assessment of the packaging under Section 7(3) and Section 7(1) of the Act will be undertaken accordingly.

## 10. INDISTINCTIVE SHAPE WITH DISTINCTIVE ELEMENTS

A wholly indistinctive or standard shape may be acceptable on the basis that other (non-shape) distinctive elements are used in combination with the shape.

However, it must be immediately apparent in the representation that the distinctive elements make up an essential or prominent part of the mark and not form a *de minimis* portion of the indistinctive shape. If the distinctive elements merely form a *de minimis* portion of the indistinctive shape, then such elements will not endow distinctiveness upon that shape.

The description for the mark must also be tailored accordingly.

Acceptable	Not acceptable
<p data-bbox="188 741 785 813">Distinctive elements forming a prominent part of indistinctive shape</p>  <p data-bbox="188 1597 775 1630">Community Trade Mark number: 001698885</p>	<p data-bbox="809 741 1406 813">Distinctive elements forming a <i>de minimis</i> portion of indistinctive shape</p>  <p data-bbox="809 1597 1406 1675">Judgment of 18/01/2013, T-137/12, ‘Shape of a vibrator’.</p>

## **DESCRIPTIVE TRADE MARKS**

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## DESCRIPTIVE TRADE MARKS

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## **1 INTRODUCTION**

This chapter is concerned with the grounds for refusal of registration of a mark which arise due to the descriptiveness of the mark. The mark will be objected under Section 7(1)(c) if it is descriptive.

## **2 RELEVANT LEGISLATION**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Absolute grounds for refusal of registration**

**7.** —(1) The following shall not be registered:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

...

### 3 PRINCIPLES FOR ASSESSING THE DESCRIPTIVENESS OF THE MARK

Section 7(1)(c) of the Singapore Trade Marks Act provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services shall not be registered. Marks will only come under this objection if the mark consists “exclusively” of descriptive signs. The main aim for not registering descriptive signs or indications is that such signs should be free for use by all and should not be monopolised by any one trader. Further, descriptive marks cannot do the job of distinguishing a trader’s goods or services without the trader investing in advertisements and consumer education to educate the public that it is a trade mark of the trader.

How does one interpret whether a mark is “exclusively descriptive”? In Singapore, we apply the following broad principles in assessing if a mark is to be refused registration on the ground that it is exclusively descriptive.

#### **(a) Mark is to be assessed as a whole**

First, marks are to be assessed as a whole.

#### **(b) Mark is descriptive if, as a whole, one of its possible meanings is capable of designating a characteristic of the goods or services**

Then, we look at whether any one of the possible meanings of the mark as a whole is capable of being descriptive. In *OHIM v Wm. Wrigley Jr. Company (Case C-191/01P)* for DOUBLEMINT, the ECJ confirmed that it is not necessary that the relevant sign is actually being used as a description before an objection based on descriptiveness can be raised. Further, it does not matter if a term has several possible meanings, as long as one of its possible meanings is descriptive (for example, in that case, the combination of “double” and “mint” could mean either that the goods contained twice the amount of mint or it could mean that the goods contain two different kinds of mint). If, at least one of the possible meanings of the relevant trade mark was capable of designating a characteristic of the relevant goods or services, the sign or indication shall not be registered.

The DOUBLEMINT case has now made it clear that, if there was any possibility of a mark being used in a descriptive sense or consisting exclusively of elements that are purely descriptive, registration should be denied. The fact that other competitors could use other terms to describe their goods/services does not make the mark any more registrable.

The European Court of First Instance has found the following marks non-registrable:

- (i) ***Community Concepts AG v OHIM (Case T-360/99)*** for INVESTORWORLD in relation to financial services – “investor” implies that the services designated are aimed at investors and the addition of “world” does not add any further feature such as to render the sign capable of distinguishing the services of the applicant from those of other undertakings because constituted as it is, the sign merely refers to the “world of the investor”, meaning, the services in question relate to anything which might be of interest to an investor;
- (ii) ***Harbinger Corporation v OHIM (Case T-345/99)*** for TRUSTEDLINK, inter alia, communications services – “link” means that which connects. It has a particular meaning in the field of information technology in that it refers in particular, to the links connecting the various data servers on the Internet. The sign “Trustedlink” has therefore, the meaning of a reliable link or a link which can be relied on.
- (iii) ***Mitsubishi HiTec Paper Bielefeld GmbH v OHIM (Case T-331/99)*** for GIROFORM in relation to printed matter – those two words, used together, therefore designate, in financial institution circles, a printed form relating to bank payment transactions for debiting a customer’s account. There is also evidence to show the current usage of the word with that meaning (Electronic giro forms, Bank giro forms, Giro Form, Giro application form, Giro form). The sign tells consumers of the intended purpose of the product. The fact that the product in respect of which registration of the trade mark was applied for can be used to print other sorts of forms does not make the mark any more registrable.
- (iv) ***Taurus-Film GmbH & Co v OHIM (Case T-136/99)*** for CINE COMEDY in relation to films and film production services – it must be acknowledged that the term “Cine Comedy” is such as to enable the public concerned to establish immediately and without further reflection a concrete and direct relationship with the majority of the services in question, particularly those which may concretely and directly concern the product comedy in film form or the production or transmission of the latter.
- (v) ***Deutsche Krankenversicherung AG (DKV) v OHIM (Case T-359/99)*** for EUROHEALTH in relation to insurance services – the word “EuroHealth” allows the relevant section of the public to establish immediately and without further reflection a definite and direct association with the health insurance services which fall within the category of insurance referred to in the application in question. In the present case, the relevant section of the public is deemed to be the average, reasonably well-informed and reasonably observant and circumspect English-speaking consumer of insurance services.

In Singapore, the test of “descriptiveness” was applied in one opposition case, ***Uni-Charm Corporation v The Procter & Gamble Company (TM No. T00/15262Z)***. The case concerned an application for the registration of the word, “breathable” in relation to sanitary napkins. In ruling that the mark is not registrable, the Registrar said,

*“The literal meaning of the word is clear. The word signifies the products’ ability to admit air to the skin and allowing perspiration to evaporate. The word used in relation to products such as the ones in question connotes “airiness” and the “porous” quality. It is a word which would naturally be used by other traders in relation to similar products. In this regard, the Opponents have lodged evidence showing use of the word “breathable” by other proprietors including the Opponents. In particular, the Opponents have satisfied me that the word, “breathable” has been used by them in a descriptive manner in packagings and advertisements in relation to their “Whisper” and “Always” range of related products.”*

The Registrar also drew a direct inference from the evidence that the applicants themselves have used the word, “breathable” in a descriptive manner and not as a trade mark since in actual use, the word is accompanied by the house brand, SOFY within a “wing-like device”.

#### **Example**

Singapore Application No. : T04/14680B  
 Applicant : Kee Wee Hup Kee Food Manufacture Pte Ltd  
 Date of application : 1 September 2004



Class 30: Noodles.

Decision: As the mark means “Korea” in English, and the said Chinese characters are commonly found in Korean-made products, the mark is objectionable under Section 7(1)(c) in that it signifies the geographical origin of the products and also objectionable under Section 7(1)(d) in that it consists of words which have become customary in the bona fide and established practices of the trade. The mark describes a specific and objective characteristic of the goods sought for registration.

The mark is such as to enable the consumer concerned, (in this case, the general public) to establish immediately and without further reflection a concrete and direct relationship with the goods concerned, i.e., the goods are made in Korea.

**(c) Marks which may allude to attributes yet does not speak of a specific and objective characteristic of the goods or services**

On the other hand, if the mark merely consists of laudatory elements or attributes which do not inform consumers of a specific and objective characteristic of the goods or services, the mark may not be refused registration. This principle is illustrated in the following examples:

**Example 1**

Singapore Registration No. : T00/14021D  
Applicant : Prescriptives Inc.  
Date of application : 11 August 2000

**FALSE EYELASHES**

Class 03: Cosmetics, perfumery and toiletries; not including false eyelashes.

Decision: As the mark merely alludes to possible attributes but does not refer to any specific or objective characteristic of the goods (which in this case, includes mascaras), the mark was found to be capable of distinguishing the goods as a whole.

**Example 2**

Singapore Registration No. : T01/04552E  
Applicant : DBS Bank Ltd  
Date of application : 29 March 2001

**CASHLINE**

**CashLine**

Class 36: Financial services; banking services; financing, loan, credit and mortgage services; provision of credit; information and advisory services relating to the aforesaid; including the aforesaid services provided via electronic and communications networks.

Decision: As the words, “cash” and “line” combined is not a recognisable phrase in the English language and the words combined do not refer to any specific characteristic of the services, the mark was found to be acceptable. There is also a perceptible difference between the mark as a whole and the mere sum of its parts.

**(d) Marks which consist of a word or neologism composed of elements, each of which is descriptive of the characteristics of the products or services**

A mark consisting of a word or neologism composed of elements, each of which is descriptive of the characteristics of the products or services in respect of which registration is sought, is itself descriptive and non-registrable, unless there is a perceptible difference between the word or neologism and the mere sum of its parts.

For example, in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Case C-363/99)* for POSTKANTOOR (“POSTKANTOOR” can be translated as “Post Office” and was sought to be registered for goods and services such as postage stamps, paper, telecommunications and insurance), the ECJ ruled that *unless there is a “perceptible difference” between the word and the mere sum of the descriptive parts, the word will not be capable of registration*. In order for a mark to be capable of registration, it must produce an impression that is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed. In that case, the ECJ was guided by public interest grounds that descriptive trade marks should be kept free for all to use. That is the case even when there are more usual signs or indications or synonyms for designating the same characteristics. It is irrelevant whether there are competitors who may or may not have an interest in using the signs or indications of which the mark consists. It does not matter whether or not the characteristics are commercially essential or merely ancillary.

**Example**

Singapore Application No.	: T05/1147IH
Applicant	: PTC-Nakajima Suisan (Asia) Pte Ltd
Date of application	: 6 July 2005

**MR SUSHI**

Class 30: Japanese food, including sushi, sushi condiments, spices and all related sushi ingredients; noodles; rice (cooked); coffee; tea; green tea; rice (cooked); preparations made from rice for human consumption; foodstuffs made from soya; mustard; mustard powder for food; wasabe; ginger; preserved ginger; vinegar; sauces (condiments); salad dressings; spices; pastries and confectionery; ices; ice cream; ice cream confectionery; all included in Class 30.

Decision: Mark is acceptable as the presence of “Mr” in the mark makes the mark as a whole, distinctive and capable of functioning as a badge of origin. There is a perceptible difference between “Sushi”, a descriptive element, and “Mr Sushi” as a whole.



# **GEOGRAPHICAL NAMES**

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## **1 INTRODUCTION**

This chapter deals with the grounds for registration of a mark which contains or consists of geographical name(s).

## 2 RELEVANT LEGISLATION

### Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

#### Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(4) A trade mark shall not be registered if it is —

...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

#### First Schedule

##### Indication of geographical origin

3. —(1) Notwithstanding section 7(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

#### Second Schedule

##### Indication of geographical origin

3. —(1) Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

### 3 TRADE MARKS CONSISTING EXCLUSIVELY OF SIGNS OR INDICATIONS DESIGNATING GEOGRAPHICAL ORIGIN OF THE GOODS OR RENDERING OF SERVICES

A mark consisting exclusively of designations of geographical origin must be refused registration under Section 7(1)(c). The purpose of this objection is so that signs that designate geographical origin remain open to use by all traders to indicate a connection with a particular geographical area. A mark designates a geographical origin if, the relevant class of persons (the persons in the trade and the average consumers), already associates the mark with the goods/services listed in the application, or where there is no current association, but the name is liable to be used in the future by undertakings as an indication of the geographical origin of the goods/services concerned (decision of the ECJ in *Windsurfing Chiemsee v Boots (Case C-108/97)*).

In making an assessment of whether the name is liable to be used as a designation of the geographical origin of the goods/services, the Registrar will consider the following matters:

- (a) Whether the geographical location has a reputation for the goods/services listed in the application;
- (b) If not, what are the characteristics of the geographical origin and whether the characteristics of the geographical location indicate that the place is, or in the future, is liable to become, a geographical source for the goods/services listed in the application; and
- (c) The extent to which the location is known to the relevant class of persons in Singapore – and what it is known for.

The Registrar will determine the above assessment on the balance of probabilities. The mark may be registered if the relevant class of persons (i.e. persons in the trade and potential consumers) will **not** reasonably assume that the goods/services originate from the place concerned. The test is not really whether it is impossible for the goods/services to originate from the place concerned nor whether objection should be raised “*simply because some place upon the earth’s surface had been called it*” (*Magnolia Metal Company [1897] 2 Ch 371*). As long as there is no likely connection (now or future) between a particular geographical name and the goods or services provided, the mark may have sufficient distinctive character and can be accepted *prima facie*.

If consumers may associate the goods/services with the geographical name, the mark will be objectionable under this ground even though the goods are not manufactured in that place.

Association could be to the place of manufacture, production or design of goods, or the place to which, or from which, services are provided or any other association that establishes the geographical location as the commercial origin of the goods/services.

**Examples**

- (a) SENTOSA would be unacceptable for Tee-shirts because the name characterizes the goods as mementoes from Sentosa (whether or not they are made or even designed there).
- (b) It is unlikely a mark is objectionable purely because it is the name of a particular place if that place can hardly be regarded as indicating the geographical origin of the goods. However, where the place concerned has a reputation for the retailing of particular goods, the name of a retail area may become associated with the goods in question, e.g. SIM LIM for computers or KATONG for Laksa.

In determining if a mark comprising exclusively of a sign that serves to designate the geographical origin should be excluded from registration or not, it is irrelevant if a defence under Section 28(1)(b)(i) will be applicable (see the ECJ's judgement in *Libertel Groep BV v Benelux-Merkenbureau (Case C-104/01)*).

#### **4 EXAMINATION PRACTICE IN RELATION TO SECTION 7(1)(c) OBJECTION**

##### **(a) Places with a reputation (or in an area with a reputation)**

Where the geographical location has a reputation (or is in an area with a reputation) for the goods/services listed in the application or closely related goods or services, the application will be refused.

##### **(b) Goods which are natural produce**

The names of places which, because of their characteristics, are likely to be the source of natural produce (such as fresh vegetables, fruits, eggs, milk, cream, water and minerals) are unlikely to be registrable. This is because the public will reasonably assume that the goods are from the geographical origin indicated in the trade mark, unless the place is so small (in terms of area as well as population) or obscure that the place is unlikely to mean anything to the relevant public. This is so even if the place identified by the mark has no specific reputation for the goods.

##### **(c) Local services**

A cautious approach will be taken to the registration of geographical names for neighbourhood services such as hairdressing and retail type services.

##### **(d) Places with no reputation and the application does not include natural produce or local services**

The registrability of the geographical places with no reputation and where the application does not include natural produce or local services will be assessed against the following criteria:

###### **(i) How well known the name is as a geographical location**

Well known geographical locations are less likely to be registrable compared to the names of obscure or remote places. However, names of well known places which are fanciful or exotic in relation to the type of goods or services listed in the application will not be refused simply because it is well known.

For example, MARRAKECH would be a fancy and exotic name in relation to motor cars but may be a plausible indication of the geographical source of other goods, such as carpets, and therefore not registrable for those goods.

###### **(ii) The goods and services with which the place is currently associated (if any)**

The Registrar will take into account the types of goods or services with which the place is already associated. For example, if the mark consists of the name of a town with a significant manufacturing industry, it will be reasonable to assume that the town is, or will become, a source of other manufactured products. Conversely, a rural location is less likely to be the source of a product which requires heavy industry, such as vehicles or their parts and fittings, and may therefore, not be objectionable in relation to such goods.

**(iii) Other characteristics of the place, including its size**

For most goods, the larger the location, the more likely it will appear as a source of goods. Consequently, there are likely to be difficulties in registering the names of well known towns and cities around the world as trade marks for many types of products.

**(e) Names of overseas locations**

The Registrar will apply the same criteria set out above in relation to the names of overseas places as well. However, the names of geographical locations outside Singapore are generally acceptable for services, unless the services are of the sort that are likely to be provided in Singapore from overseas, e.g. financial services, entertainment or travel and accommodation.

**(f) Oceans, seas, lakes, rivers, mountains, deserts**

The names of oceans, seas, lakes, rivers, mountains and deserts will be registrable if the goods or services are not associated with its reputation and the name concerned is not a likely source of origin for the goods or location of the services.

Examples of registrable marks:

**ATLANTIC** for footwear

**MT EVEREST** for paper, stationery

If the geographical name characterizes the location of the goods or services concerned, the mark will face an objection. For example,

**MEDITERRANEAN** for transport services

**ATLANTIC** for prawns

The Registrar will generally object to names of oceans, seas, lakes, rivers for marine produce or for example, boat charters. The same applies to names of mountains for agricultural produce.



**(g) Names of streets, roads, districts and suburbs**

These are treated like any other geographical name. If a street name, road name, or district has a reputation for the designated goods or service, an objection will be raised. Such names would not have the inherent capacity to distinguish.

Many towns have streets or other areas well known for certain goods or services. For example, WALL STREET (New York financial district) will be objectionable in respect of financial services; ORCHARD ROAD will be objectionable in respect of most consumer goods and services.

**(h) Superseded geographical names**

Superseded geographical names that have no connection with the goods such as BYBLOS (class 25) which is the ancient name for the Lebanese town of Jubayl may be *prima facie* acceptable.

Other names which have been officially superseded recently but are still in popular usage may require some evidence or could be accepted if there are any other circumstances which support doing so. These could include names such as PEKING, CEYLON and LENINGRAD where the original geographical meaning is still very much the primary signification of the name and is still being used interchangeably with the new name. The Registrar will also assess if the name of the ancient place would still have tourist significance, albeit the name of the ancient place is no longer a populated centre. If so, the mark may attract a ground for rejection, especially if the services claimed are related to tourism.

**(i) Phonetically similar geographical names**

Generally, a mark will not be objected to merely because of phonetic similarity to existing geographical names. Well known place names have well known spellings and variations on these spellings can often afford a word with sufficient distinctive character for *prima facie* acceptance. However, minor misspellings which are phonetically the same and visually very similar to well known place names may not be objectionable *prima facie*, for example, TOKIO for electrical items.

## **5 HOW TO OVERCOME SECTION 7(1)(c) OBJECTION?**

### **(a) Exclusion in specification**

A Section 7(1)(c) objection cannot be overcome by a limitation to exclude the goods originating from/services provided in the place whose name they carry.

However if the objection is taken in respect of only part of the specification, it may be possible to delete the objectionable item in order to overcome the Section 7(1)(c) objection.

### **(b) Acquired distinctiveness**

A mark consisting exclusively of a sign designating geographical origin can be registered if in fact, it has acquired a distinctive character as a result of use before the date of application for registration (Section 7(2)).

However, it may be near impossible to overcome the objection on the basis of use if the mark comprises exclusively the name of a country or a major city, such as USA, New York, UK, London, France, Paris, China or Beijing.

## 6 EXAMINATION PRACTICE IN RELATION TO SECTION 7(4)(b) OBJECTION

Section 7(4)(b) provides that a trade mark which is of such a nature as to deceive the public as to nature, quality or geographical origin of the goods/services must be refused registration. A trade mark will be deceptive if it misrepresents that the goods or services originate from a geographical area with a given quality, reputation or other characteristic.

### (a) When to raise Section 7(4)(b) objection?

Section 7(4)(b) provides that signs that designate geographical origin should not be misleading. Hence, an objection based on Section 7(4)(b) may arise if a mark contains/consists of a geographical name and the primary significance of the mark is its geographical location.

#### (i) For goods

The use of a geographical name in a trade mark on goods would lead consumers to view the mark as an indication of the source of the goods. This is commonly seen for names of places well-known for certain goods. For example, BRAZIL for coffee or FRANCE for wine.

If, however, the geographical name in the trade mark appears merely to be a fanciful association, for example MISS AMERICA for textiles, the mark would be acceptable (see also *"Roman Holiday" Trade Mark [1964] R.P.C. 129* where the trade mark, ROMAN HOLIDAY, was considered registrable for perfumes and cosmetics).

However, if the words “Made in XYZ” appear on the mark, it would be evident that the geographical name indicates the source of the goods.

#### (ii) For services

The use of a geographical name in a trade mark for services is usually more acceptable as it is less likely to be regarded as an indication of the origin of the services. However, where the geographical name suggests that the services are of a particular nature, objections can be raised. For example: THAI for massage services.

#### (iii) Geographical indications (GI)

The Registrar will raise an objection under Section 7(4)(b) where the mark **consists of or contains** a geographical indication but the goods/services do not

possess the qualities or the reputation that are attributable to that geographical indication.

A geographical indication or GI is a sign used on goods that have a specific geographical origin and possess qualities or a reputation that are due to that place of origin. Most commonly, a geographical indication consists of the name of the place of origin of the goods. Agricultural products typically have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil. Whether a sign functions as a geographical indication is a matter of national law and consumer perception. Geographical indications may be used for a wide variety of agricultural products, such as, for example:

- TUSCANY for olive oil produced in a specific area of Italy; and
- ROQUEFORT for cheese produced in France

The use of geographical indications is, however, not limited to agricultural products. They may also highlight specific qualities of a product which are due to human factors that can be found in the place of origin of the products, such as specific manufacturing skills and traditions. That place of origin may be a village or town, a region or a country. An example is "Switzerland" or "Swiss", which is perceived as a geographical indication in many countries for products that are made in Switzerland and, in particular, for watches.

The concept of geographical indication encompasses appellations of origin. Appellations of origin are used on products that have a specific quality that is exclusively or essentially due to the *geographical environment* in which the products are produced.

A geographical indication tells consumers that a product is produced in a certain place and has certain characteristics that are due to that place of production. It may be used by all producers who make their products in the place designated by a geographical indication and whose products share typical qualities.

Hence GIs are not registrable as a trade mark.

#### **(iv) Geographical names as collective and certification marks**

However, GIs may be registrable as a certification or collective mark. Geographical names may be registrable as certification marks provided that the name is capable of distinguishing goods or services which are certified from those which are not. Similarly, collective marks consisting of geographical names may be accepted for registration provided that they are capable of distinguishing the goods or services of the members of the association from those of other traders.

In assessing such an application, the Registrar will consider if the application is still objectionable under either Section 7(1)(b) and (c), (on the basis that the GI in question has become a generic description of the claimed goods). Geographical indications may become generic if the term is used as the designation of a kind of

product, rather than an indication of the place of origin of that product. If this happens, the term no longer functions as a geographical indication. For example, "Dijon Mustard" now denotes a certain kind of mustard, regardless of its place of production. Alternatively, if the goods do not bear the characteristics that are due to that GI, Section 7(4)(b) may be raised.

### **(b) How to overcome Section 7(4)(b) objection?**

- **Restriction of specification**

In some circumstances, a restriction of the applicant's specification to reflect the composition or geographical origin of the goods will answer an objection that the mark is deceptive.

#### **Example**

SWISS MISS for preparations for making chocolate or cocoa beverages will be deceptive if the goods are not of Swiss origin (*Swiss Miss [1997] R.P.C. 219*). The judge rejected the argument that SWISS used in conjunction with MISS would merely be taken as evoking a particular ambiance or as indicating the style or flavour of the product or its healthy qualities. Although Switzerland has no reputation for cocoa powder, it has a reputation for chocolate and chocolate confectionery. Both chocolate and cocoa powder are produced from cocoa beans and manufacturers of cocoa powder are also manufacturers of chocolate.

SWISS CHALET for chocolate would also be deceptive unless the specification is limited to "chocolate the product of Switzerland" (*Chocosuisse v Cadbury [1998] R.P.C. 117*).

However, the Registrar may not choose to raise an objection where an applicant already has a registration for the same mark or an insignificant variation of the same mark for the same unrestricted goods or services.

#### **Consequences of limiting specification**

Limiting an applicant's specification does not limit a registered owner's rights to sue for infringement. A registered owner can sue for infringement for unauthorised use of his mark on goods or services that are similar to those for which his mark is registered (Section 27(2)).

## **7 EXAMINATION PRACTICE IN RELATION TO SECTION 7(1)(d) OBJECTION**

Section 7(1)(d) of the Act prevents the registration of signs or indications which are customary in the current language or in the trade. The Registrar will take objection where the Registrar has cause to believe that the sign has in fact become customary. When raising such an objection, the Registrar may make reference to extracts from relevant publications or examples of the trade mark in customary use to support the objection.

Examples of such signs or indications would include:

- SWISS ROLL for cakes; and
- PEKING DUCK for food

## **EVIDENCE OF DISTINCTIVENESS ACQUIRED THROUGH USE**

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## EVIDENCE OF DISTINCTIVENESS ACQUIRED THROUGH USE

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## **1 INTRODUCTION**

This chapter deals with the evidence of use submitted by applicants to overcome Section 7(1)(b) and (c) objections to show that the marks in question have acquired distinctiveness through use. The issues that need to be taken into consideration when looking at these evidence are also discussed.

## **2 RELEVANT LEGISLATION**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Absolute grounds for refusal of registration**

**7.** —(1) The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

### 3 ACQUIRED DISTINCTIVENESS

Section 7(2) provides that trade marks which have been refused registration under Sections 7(1)(b), (c) or (d) may still be registered if the applicant proves to the satisfaction of the Registrar that before the date of the application, the mark had in fact acquired a distinctive character because of the use made of it.

Section 7(2) does not specifically mention Section 7(1)(a). This is because, if a sign is shown to be distinctive in fact, the objection under Section 7(1)(a) will not apply to exclude the sign from registration.

The evidence necessary to establish that a trade mark is factually distinctive will vary depending upon the facts of the case. The burden of establishing factual distinctiveness will generally be proportionate to the strength of the prima facie objection raised in the trade mark application.

The purpose of the evidence is to demonstrate that, despite the objectionable nature of the trade mark, it had in fact, prior to the application for registration, become identified, in the minds of the public, with a particular trader's goods or services. The ECJ in *Windsurfing Chiemsee v Boots (Case C-108/97)* said that the test is that the mark must be used in such a way that a sufficiently large part of the relevant class of persons recognize the sign as a distinctive trade mark at the time when the application is filed.

The evidence submitted should answer the following questions in the affirmative:

- (i) Has the trade mark been used as a trade mark i.e. as a means of identifying trade origin of the goods?
- (ii) Has the applicant promoted the trade mark as a trade mark?
- (iii) Does the evidence show, as a matter of fact, that the trade mark is operating in the market place as an indicator of origin?
- (iv) Has the relevant public (or a significant proportion thereof) come to rely upon the mark, in the course of trade, as a means of identifying the trade origin of the goods?
- (v) (Although the applicant need not necessarily have used the mark as the **only** means of identifying the trade origin of the product as there is no rule that two or more trade marks cannot operate alongside each other), the trade mark applied for must, by itself, come to foster a concrete expectation amongst the relevant public that the goods bearing that mark originate from, or are under the control of, a single undertaking.

## 4 EVALUATING EVIDENCE OF USE FILED BY THE APPLICANT

In examining the evidence of use filed by the applicant, the Registrar will check that the details of the declarant are acceptable and that the declaration is sworn correctly. The declaration is usually made by a principal officer of the applicant company, but the Registry will accept a declaration from anyone who declares himself authorised to make it on behalf of the applicant.

The Statutory Declaration must incorporate the exhibits or appendices as stated in the Sample Statutory Declaration. If these were not incorporated, they would not form part of the declaration.

See the following for guidance:

**Appendix 1** - Notes on how to file evidence of use to support Trade Mark applications

**Appendix 2** - A sample statutory declaration

The Registrar will consider the following factors when examining any evidence of use filed by an applicant:

### (a) Period of Use

- (i) The longer the period of use, the more likely the mark is to have acquired a distinctive character. Five years of prior use of the trade mark with strong sales is generally required. Extensive use over a shorter period may well be sufficient, although use that is less than two years prior to the date of application would very unlikely be regarded as sufficient.
- (ii) Evidence should include the date the trade mark was first used in Singapore on the particular goods/services.
- (iii) Evidence must relate to use before the date of filing of the application. This requirement is indicated in Section 7(2) of the Act which states:

*“A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, **before the date of application for registration**, it has in fact acquired a distinctive character as a result of the use made of it.”*

- (iv) The use of the mark should be continuous. If the use has not been continuous, the reputation of the trade mark may have been diminished. Therefore, the Registrar will consider how the break in use may have affected the reputation of the mark applied for. For example, if the sales were very good before and after the break, it might suggest to the Registrar that the distinctiveness acquired before the break had not been lost.
- (v) If the trade mark has been transferred between owners, details such as the name of the former owner and date of acquisition of the mark should be indicated.
- (vi) The period of use will be considered in conjunction with turnover figures.

**(b) Extent of use (Turnover)**

- (i) Turnover figures should be given for the sales of the goods/services under the mark. The greater the turnover, the more likely it is for the mark to be accepted.
- (ii) The turnover figures should be broken down to show the turnover relating to each class of goods/services, where practicable. It is recognized that the industry does not group its products according to the WIPO system of classification. However, there should be a sufficiently clear breakdown of the goods/services to support a decision to allow the mark to proceed for the specification applied for. Where a wide range of goods/services within a class is claimed, a breakdown of figures will be helpful to allow an adequate assessment in relation to particular goods/services to be made.
- (iii) In the context of turnover figures, account will be taken of the cost of the goods/services and whether the goods/services are specialized in nature or are common everyday items. It would thus be useful if the turnover figures are broken down to show the number of items sold or service transactions undertaken in respect of the trade mark.
- (iv) It is usually useful to explain the nature and size of the market and the size of market share of the applicant so that an assessment can be made as to whether the turnover under the mark comprises a sizeable part of the total market.
- (v) Turnover figures may not always be the appropriate means to gauge the extent of use of the trade mark. For example in the case of financial services, the extent of use may be demonstrated by showing the number of account holders/investors, the number of branches etc.

**(c) Advertising expenditure**

- (i) Advertising figures provided should be for a period of 5 or more years prior to the date of filing.
  - (ii) The type of advertising should be listed e.g. TV, magazines, posters, newspapers, radio, billboards, trade publication, trade fair, sponsorships etc.
  - (iii) The breakdown of advertising figures in relation to each class of goods and services should be provided, where feasible. All amounts given must be in Singapore dollars.
  - (iv) Details of titles of publications and names of TV channels and radio stations used should be given. Samples of advertisements should be included in the exhibits.
  - (v) The importance to be attached to advertising figures depends on the goods/services in issue.
- In some cases, high advertising figures without any sales may be sufficient.

**Illustration**

An aircraft manufacturer may spend vast amounts of money assessing the market for a new aircraft, developing the product and extensively advertising it to potential buyers. Such costs may run to hundreds of thousands of dollars,

or even millions, and may indicate that the company has established the reputation of the mark even before any aircraft has been sold.

- For other cases, little or no advertising expenditure may also be acceptable, for example, in cases involving highly specialized goods with a small market.

### **Illustration**

A company producing technical valves may inform existing clients of their updated product through a periodic catalogue sent to their clients. It would be impossible for that company to attribute specific marketing costs of the catalogue to any particular product among hundreds in their catalogue.

### **(d) Nature of exhibits**

- (i) The exhibits should reflect how the mark has been used in relation to identified goods/services. All exhibits should be listed in the declaration and clearly cross-referenced.
- (ii) All exhibits should be dated, or where this is not possible, an estimate of its date of use should be given. The materials relied upon must precede the filing date.
- (iii) The exhibits must show use of the mark applied for as a trade mark. If the mark is commonly used with a house mark or in a substantially stylized form, an assessment will be made to determine whether this constitutes use of the mark applied for. For example, in the UK case of *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, TREAT was always accompanied by the established mark SILVER SPOON. Hence, the court was of the view that it was doubtful if the mark TREAT had acquired distinctiveness on its own.
  - However, if the additional matter in the mark is subsidiary, i.e., a background or a decorative device, the mark may still be distinctive on its own.
  - If the application is for a different typeface to that actually used, the Registrar may consider if the variant could qualify as a series. If not, the use would not be sufficient to establish factual distinctiveness.
  - If the evidence shows that the mark applied for is used only as a subsidiary part of a composite device mark or is used as part of a longer mark which naturally “hangs together”, such as a known phrase or a full name, the Registrar may not consider that the evidence is sufficient to establish that the mark applied for has become factually distinctive.
- (iv) The Registrar will give little weight to evidence which shows use of the sign not for trade mark purposes. For example, use of words as descriptions, shape of goods in a brochure alongside many other similar goods of various shapes with no indication that the shape is functioning as an indication of origin will not be accepted as evidence of distinctiveness of the shape as a trade mark.
  - The addition of the letters “TM” to a word or other sign may assist but will not turn any obvious descriptive use into trade mark use.

- Advertising statements drawing attention to the sign as indicating the applicant's goods e.g. "look for the one with ..." may assist in showing that the mark has acquired a distinctive character.
- If the evidence shows that the mark is used as part of the overall get-up of T-shirts, the public may not interpret the use of the mark as an indication of trade origin.

In ***WILD CHILD Trade Mark [1998] R.P.C. 455***, Mr Geoffrey Hobbs Q.C. stated *"My difficulty with regard to the use of the words WILD CHILD as part of the overall get-up of sweatshirts is that I would not expect people to interpret the use of those words in that manner as an indication of trade origin. I therefore cannot see any basis for the suggestion that people in the world at large will have been educated by means of such use to infer that "complete articles of outer clothing; footwear and headgear" supplied under or by reference to the trade mark WILD CHILD are connected with the course of trade or business with the undertaking responsible for supplying sweatshirts embellished in the way I have described"*.

In ***CORGI Trade Mark [1999] R.P.C. 549***, Geoffrey Hobbs Q.C. stated *"The word CORGI was plainly being used on the clothing with reference to CORGI model vehicles. There is a question as to whether it was also being used with reference to the clothing upon which it appeared...I do not regard it as self-evident that use of the word CORGI in the context and manner identified in the applicant's evidence provided people with information as to the origin or status of the clothing as such."*

- (v) If the evidence shows use of a substantially different mark, the evidence would be given little or no weight. In such a case, the Registrar may suggest that the applicant re-file their application, and the evidence be re-considered in connection with the re-filed application.
  - (vi) The exhibits must show use of the trade mark on the goods/services sought to be protected. If it only supports some categories, the Registrar may request the applicant to delete those goods or services where the mark has not been shown to be factually distinctive.
- Price tickets or carrier bags displaying the mark may not be accepted as evidence of use of the mark on the goods per se but rather, the services relating thereto such as retail services for example. This was highlighted in ***Euromarket Designs Incorporated v Peters and another 2000 All ER (D) 1050 (also known as the Crate & Barrel case)*** where the judge essentially said,

*“Only a trade mark obsessed lawyer would argue that putting a Kodak film in a Boots carrier bag is use of the trade mark Boots on film”.*

- (vii) Possible exhibits showing use of the trade marks in relation to the goods/services include:

Articles  
Brochures  
Catalogues  
Balance sheets  
Statements of accounts  
Annual reports  
Newsletters  
Magazines  
Headed stationery  
Invoices  
Receipts  
Sales advices  
Samples  
Staff business cards  
Delivery vans  
Entrance signs  
Advertising  
Posters  
Menus, bar lists, wine lists (for restaurants)  
Room folders, guest information cards (for hotels)  
Timetables (for travel services)

\*This list is not exhaustive

**(e) Goods/services claimed**

- (i) The evidence of use shown must relate to the goods and services sought to be protected. If the evidence shown only pertains to certain items, the Registrar may request that the applicant delete those goods or services where there is no use of the trade mark.
- (ii) The goods/services shown in the exhibits must also correspond with the goods/services claimed in the specification. E.g. where the use is shown on a specific item like “magazines” the specification should reflect that item rather than a general description like “printed matter” which may include magazines.
- (iii) The evidence shows use for a range of goods e.g. pencils, pen, rulers within a general term e.g. “stationery”. However, the Registrar will generally require greater specificity if the general term is very wide (e.g. electrical apparatus).



#### **Evidence of distinctiveness acquired through use**

- (iv) If the mark is very descriptive or non-distinctive, the Registrar will examine the evidence thoroughly and pay particular attention to the specification.

## **5 ACQUIRED DISTINCTIVENESS FOR NON-CONVENTIONAL MARKS**

### **(a) Colour marks**

For a colour or combination of colours to be recognised as a trade mark, the applicant usually needs to be promoting the colour(s) as something apart from the goods or their packaging. Entries in catalogues or brochures showing pictures of the goods in the colour(s) claimed will usually not be sufficient by themselves, even if the applicant is able to show many years of such use. However, if research or information from the applicant demonstrates that the usual colour(s) for the goods in question is something quite different, these examples will be more persuasive.

Examples of advertising text referring specifically to the colour(s) in respect of the goods will be most useful. Statements such as "look for the orange coloured box" or "unusual colours; exceptional goods" are the type of promotional terms that will assist an applicant in demonstrating that the colour(s) has the capacity to distinguish. Consumer surveys based on recognition of the colour(s) and declarations from the trade and from consumers attesting to the recognition of the colour(s) as an indicator of trade source may also be valuable.

However, if the distinctive character of the mark used by the applicant depends in part on other factors, such as a specific arrangement of colour(s) or the manner of application of colour(s) to goods, it will not be possible to amend the subject matter of the proposed registration at a later date.

### **(b) Shape marks**

A trade mark consisting exclusively of a shape may not possess the capacity to distinguish. All goods have shapes, and containers for goods come in various shapes. Hence, customers have come to expect a variety of shapes for goods within many trades, and it may not be as easy for the applicant to show the capability of a shape trade mark to distinguish their goods as it would be if the trade mark consisted of mere words, figurative devices or phrases or of a combination of these three.

For a shape to have acquired recognition as a trade mark, it will need to have been promoted as something apart from the goods. Entries in catalogues or brochures showing pictures of the goods in the shape claimed are not definitive, even if the applicant is able to show many years of such material. What may be more useful are examples of advertising text referring specifically to the shape in respect of the goods. Statements such as "look for the star shaped box" or "attractive colours; unusual shape" are the type of promotional terms that may assist an applicant in demonstrating that the shape has a capacity to distinguish. Consumer surveys based on recognition of the shape, declarations from the trade and declarations from consumers relating to recognition of the shape as an indicator of trade source may also be valuable.

However, if the distinctive character of the mark used by the applicant depends in part on other factors, such as the application of a specific colour to the mark or of the mark being in a particular size, it will not be possible to amend the subject matter of the proposed registration at a later date (*Société Des Produits Nestlé SA v Mars UK Limited* [2004] EWCA Civ 1008).

## 6 OTHER CONSIDERATIONS

### Monopoly

In *Philips v Remington (Case C-299/99)*, the ECJ found that the fact that an undertaking is the only known supplier of a kind of product/services does not preclude a finding that a mark has acquired a distinctive character of the goods/services. However, a monopoly may make it difficult to gauge whether the public have come to recognise the sign as a trade mark or whether they merely recognise the sign as a characteristic of a particular kind of goods or services, and associate that kind of product/services with the applicant because it is the only known (or the best known) supplier of products/services of that kind.

## 7 EVALUATION OF SURVEY EVIDENCE

Survey evidence, in addition to other evidence of use, may be useful, especially when the mark is highly descriptive or very non-distinctive, or when the mark is consistently used with other matter.

Evidence of use in the form of professionally conducted customer surveys or opinion polls may be presented to the Registrar for consideration. In assessing survey evidence, the Registrar will consider the following.

Factors to consider when examining survey evidence:

### (a) How interviewees are chosen

The survey should reveal the criteria for selecting the interviewees. For example, if they are selected to represent a cross section of the relevant industry or consumers, such evidence would definitely be more persuasive in value.

The Registrar will consider if the survey is done with actual and/or potential customers. This is because a lack of recognition as a trade mark by members of the public who are not actual or potential customers for the goods or services may not be detrimental against an applicant.

***Dualit Ltd's Trade Marks Application [1999] R.P.C. 890***

*"...in terms of recognition required for the acquisition of distinctive character, it ought to be tested by reference to the market for domestic toasters generally, not just the market for extremely expensive toasters."*

### (b) Number of interviewees surveyed

The evidence should reveal the number of persons issued with questionnaires or otherwise invited to take part in the survey should be disclosed.

***Imperial Group Plc v Philip Morris Ltd [1984] R.P.C. 293***

*"The number of participants invited to take part in the survey should be mentioned [S]urvey evidence ... can only be of weight if ... the fullest possible disclosure of ... how many surveys [were] carried out, ... how those surveys were conducted and the ... number of persons involved, because otherwise it is impossible to draw any reliable inference that answers given ... in one survey might ... indicate that similar answers would be given [in] a survey covering the entire ... population"*

**(c) Total number of respondents**

The survey should confirm that the number of responses submitted to the Registrar correspond with the total number of those who had indeed responded to the survey.

**(d) Questions in the survey**

The questions found in the survey should be phrased in an open-ended manner. Well-conducted surveys where the questions are relevant and not leading and where the sample interviewed is properly chosen will be more persuasive.

Open-ended questions like “What does this sign mean to you?” or “Are you able to identify this sign?” are preferable to leading questions like, “Do you regard this sign as a badge of origin for the applicant’s goods?”

***Dualit Ltd’s Trade Marks Application [1999] R.P.C. 890***

*“As Jacob. J noted in the **Philips** case, the word associates can have a number of meanings. The word could be used by those that mean “first come to mind”, “best known one”, “only one I can think of-but there may be others”. None of those meanings amount to recognition of the sign as a trade mark. On the other hand, the witness may mean “that shape tells me it’s a **Dualit**- I’d definitely expect it to be a **Dualit** and be confused if it wasn’t. That sort of recognition is more likely to support the claim that the sign(s) is regarded as a trade mark. - These are subtle but important distinctions”*

Thus, it should be clear from the survey whether respondents show recognition of the product or recognition of the sign as a trade mark as a result of use.

**(e) Representation of mark used in survey**

The survey should include a copy of the mark used in the survey and this should correspond to the mark as filed.

**(f) Exact answers from the interviewees**

The survey should disclose the exact answers from the respondents in order to get the full picture and not a rephrasing or interpretation of the answers solicited. Complete disclosure of all results, including any that are not favorable, should be presented in the evidence.

**(g) Location and instructions of survey**

The place where the survey was conducted, and the exact instructions given to interviewers should be presented.

**(h) Balance between strength of evidence and strength of objection**

The amount of evidence sufficient to prove factual distinctiveness will be proportionate to the strength of the objections raised by the Registrar. Hence, the Registrar will not specify any benchmark that must be attained for any survey result. Evidence of a 70% recognition as a trade mark by consumers in respect of a descriptive mark, e.g. FRESH SCENT for air fresheners, may not suffice while a less than 50% positive results for a less objectionable mark may suffice. Much would depend on the facts of each case. It is instructive to have cognizance of the guidance laid out in the following case:

***British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281***

*“Take a very descriptive or laudatory word. Suppose the proprietor can educate 10% of the public to recognise the word as his trade mark. Can that really be enough to say it has acquired a distinctive character and so enough to let the proprietor lay claim to the word as a trade mark altogether? The character at this stage is part distinctive but mainly not. I do not think that it would be fair to regard the character of the word as distinctive in that state of affairs. But if the matter were the other way around, so that to 90% of people it was taken as a trade mark, then I think it would be right to so regard it. This all suggests that the question of factual distinctive character is one of degree. This proviso really means “has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark.”*

**(i) Other traders using the same sign**

Where the survey evidence shows that a fair percentage of people associate the applicant’s mark with another trader, it may reveal that other traders are also using the same sign as the applicant. If such a conclusion is drawn, even 90% recognition in a survey may not be enough. In ***Imperial Group Plc v Philip Morris Ltd [1984] R.P.C. 293 (also known as the RAFFLES case)***, Whitford J. opined that being the best known of a number of traders who use the same sign does not amount to factual distinctiveness. Hence, if the survey evidence shows significant recognition of the applicant’s sign as the trade mark of another trader, the Registrar will ask the applicant to establish the factual position with regard to that party’s use of the sign.

Nevertheless, in ***Philips v Remington (Case C-299/99)***, the ECJ held:

*"Where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character for the purposes of Art 3(3) of Directive 89/104 in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking or believes that goods of that shape come from that trader. However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark."*

#### **(j) Date of survey**

In the majority of cases, surveys carried out to assist a trade mark application are likely to have taken place after the date of application. While this time lapse is unlikely to make any significant difference in most cases, care should be exercised where the applicant's evidence reveals a substantial increase in use only after the date of application. The Registrar will also give little weight if the period of use before the date of application is relatively short and a long period has elapsed between the date of application and the date of survey.

#### **(k) Participants should be the relevant public**

A sufficiently large part of the relevant class of persons should recognise the sign as a distinctive trade mark at the time when the application was filed. This is the second *Windsurfing Chiemsee* test. This raises questions as to who the relevant public is, what constitutes a sufficiently large part of this public, and to what time period should the evidence relate?

Who is the relevant public? - The relevant public is deemed to be average consumers of the particular category of products concerned and the average consumer is deemed to be *"reasonably well informed and reasonably observant and circumspect"*. It is usually relatively straightforward to assess who the public is. If the mark covers mass consumer goods such as foodstuffs, clothing, etc, the applicant will have to prove that the general public as a whole, or at least a substantial part of it, recognise the sign applied for as a mark. If the goods/services are addressed to a specialist public, say, surgeons active in a specific medical area or a specific sector of a trade such as wholesalers, evidence need generally only relate to the limited public.



## 8 EVALUATION OF TRADE EVIDENCE

Evidence from the trade may be filed to overcome a valid Section 7(1) objection, in addition to evidence of use from the applicant, or to show that a Section 7(1) objection is unfounded.

Details that should be given in trade evidence:

- (i) how the declarants were selected;
- (ii) status of declarant within the trade;
- (iii) relationship of declarant with the applicant, if any;
- (iv) length of time that declarant has known the mark; and
- (v) that the declarant regards the sign as being indicative of a **single** source.

Factors to consider when examining trade evidence:

### (a) Weight given to the statements

Unsworn declarations will not be given much weight. The more apparently objectionable the application is, the more important it will be for at least some of the survey or trade statements to be sworn. Statements setting out how a survey was conducted should always be sworn.

### (b) Trade view vs. relevant public

Trade experts are only capable of stating their opinion on whether a particular trade mark is distinctive in their view. They are, in the absence of contrary evidence, not authorized to represent the views of a particular industry.

When dealing with specialized goods and services, the Registrar will examine the weight of the evidence from the trade. The Registrar will consider the trade evidence to be representative of the trade where many or most respondents share the same view.

When dealing with goods and services which are not specialized, even overwhelming evidence of trade experts regarding the sign as a badge of origin may not lead to the conclusion that the public at large regards it as such. Such evidence, to a lesser extent, may merely establish that the applicant's mark is unique among that industry. Hence, the Registrar will always exercise care in deciding the weight to be given to the evidence from the trade and whether it relates to the "public" relevant to the goods and services in question.

**(c) How independent the applicant is**

Evidence from any party under the control of the applicant, or in respect of whom the applicant is likely to be able to apply commercial pressure for supporting statements, such as those who manufacture, distribute or provide the goods or services on the applicant's behalf (other than independent retailers), or those with a vested interest in securing registration (such as licensees), may not be given much weight.

**APPENDIX 1****FILING EVIDENCE OF USE OF A TRADE MARK****Introduction**

These notes are intended to assist you in your preparation and presentation of evidence of use of your trade mark. The Trade Marks Act (Cap. 332, 2005 Rev. Ed.) allows you to file such evidence as a means of overcoming certain objections raised in our examination letter to you. References to “Section” in these notes refer to that section of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.).

**What evidence should be provided**

You will need to provide:

- the date on which your mark was first used on your goods/services in Singapore;
- annual sales/turnover figures of your goods/services;
- annual advertising or promotional expenses in respect of your goods/services;
- evidence showing how the mark has been used, for example, copies of your sales brochures, copies of advertisements for your goods/services, samples of packaging of your goods – these are referred to as “exhibits”; and
- any other relevant information.

**Overcoming Section 7(1)(b), (c) and (d) objections**

The Registrar may have objected to the registration of your mark on the ground that your mark is not distinctive because, for example, it is a common surname, a term commonly used in the trade or business you are in, or the name of a geographical place. You may provide evidence to satisfy the Registrar that your mark has “acquired a distinctive character as a result of the use made of it”.

It is not possible to specify how much evidence you will need to provide to overcome such objections. As a guide, the more common a surname is, or the more descriptive a mark is, the more evidence (in terms of length of use or amount of sales/turnover) that will be required to show that it is in fact distinctive of the goods/services in question. Turnover figures should be given for any sales of goods or services in relation to the mark, over a period of about five years before the date of application. Evidence should include the date in which use of the mark first commenced and must relate to continuous use before the date of filing. If use of the mark is not continuous, the mark may not be considered sufficiently distinctive, as reputation in the mark may not have been built up.

Sometimes, such evidence is of no assistance at all or is not adequate to overcome the objections. For example, the mark you wish to register may be a word or term peculiar to a trade or business, or one which other traders commonly use to describe their goods or services. In these circumstances, you may be asked to provide further evidence from

trade associations or similar independent organisations if there is any doubt about the descriptive nature of the mark.

### **How evidence should be presented**

Evidence must be presented in the form of a Statutory Declaration. The declaration should, preferably, be typed. Further, the declaration and any exhibits must be sworn before a person authorised to administer oaths, such as a commissioner for oaths or notary public.

Please note that the evidence you provide must relate to use of the mark before the date of application.

Sometimes, the Registrar may ask you to provide additional evidence to clarify a particular point. For instance, we may require confirmation that other people in the same business would not use the mark in a descriptive sense.

APPENDIX 2

Sample Statutory Declaration

TRADE MARKS ACT (Cap. 332, 2005 Rev. Ed.)

In the matter of  
Trade Mark Application No. \_\_\_\_\_  
in the name of \_\_\_\_\_  
to register the mark \_\_\_\_\_  
in Class \_\_\_\_\_

STATUTORY DECLARATION

I, \_\_\_\_\_ *[name of declarant]* of \_\_\_\_\_ *[address]*  
hold the position of \_\_\_\_\_ *[designation within the applicant company]* in  
\_\_\_\_\_ *[applicant company name]* (hereinafter referred to as “the applicant company”)  
and I do hereby solemnly and sincerely declare as follows:

2 I have held the aforesaid position in the applicant company since \_\_\_\_\_ *[date]*  
and the evidence given in this declaration are within my personal knowledge or derived from the  
records of the applicant company to which I have access.

3 I am duly authorised to make this declaration on behalf of the applicant company in the  
prosecution of this application.

4 The trade mark \_\_\_\_\_ *[insert the mark if it is a word mark or a  
representation of the mark in the exact manner you use it if it is a device mark or a composite  
mark]* was first used in Singapore on \_\_\_\_\_ *[date]* by \_\_\_\_\_  
*[“the applicant company”, or if the mark was previously owned by someone else, who the  
previous owner was, and when and how you acquired ownership of the mark].*

5 The goods/services on which the mark has been used, and the date of first use, are as  
follows: *[List within each class of application, all the goods and/or services on which the mark  
has been used, together with the year in which the mark was so used. If you cannot give an exact  
date, you can use the phrase “not later than”.]*

Class \_\_\_\_ : \_\_\_\_\_ *[goods/services]* first used in the year \_\_\_\_\_

Class \_\_\_\_ : \_\_\_\_\_ *[goods/services]* first used in the year \_\_\_\_\_

Class \_\_\_\_ : \_\_\_\_\_ *[goods/services]* first used in the year \_\_\_\_\_

## Evidence of distinctiveness acquired through use

6 There is now produced and shown to me Exhibit 'A' which is showing use of the mark **exactly, or substantially, as applied for**. *[The exhibits must have been in use **before** the date of your application]*

Exhibit A1 which is \_\_\_\_\_ *[Describe the nature of the exhibit e.g. labels attached to the goods, packages in which the goods are wrapped, brochures, leaflets, etc]* shows use of the mark on the goods/services in Class \_\_\_\_\_.

Exhibit A2 which is \_\_\_\_\_ *[Describe the nature of the exhibit e.g. labels attached to the goods, packages in which the goods are wrapped, brochures, leaflets, etc]* shows use of the mark on the goods/services in Class \_\_\_\_\_.

Exhibit A3 which is \_\_\_\_\_ *[Describe the nature of the exhibit e.g. labels attached to the goods, packages in which the goods are wrapped, brochures, leaflets, etc]* shows use of the mark on the goods/services in Class \_\_\_\_\_.

7 Sales of the goods/Turnover for the services for the five years immediately preceding the date of application were as follows: *[If you are applying for goods/services in more than one class, you should provide separate figures for each class, as far as possible]*

Year	Amount (S\$)
20..	
20..	
20..	
20..	
20..	

8 There is now produced and shown to me Exhibit 'B' which is showing sales invoices of the goods/services on which the mark is used. *[The sales invoices must be dated **before** the date of your application. A selection of sales invoices from each year the mark is used shall suffice.]*

Exhibit B1 are sales invoices of the goods/services in Class \_\_\_\_\_ on which the mark is used.

Exhibit B2 are sales invoices of the goods/services in Class \_\_\_\_\_ on which the mark is used.

Exhibit B3 are sales invoices of the goods/services in Class \_\_\_\_\_ on which the mark is used.

9 The amounts spent on promoting the goods/services in the five years preceding the date of application were as follows:

**Evidence of distinctiveness acquired through use**

<b>Year</b>	<b>Amount (S\$)</b>
20..	
20..	
20..	
20..	
20..	

by means of \_\_\_\_\_. *[State the sort of advertising that has been used e.g. TV, radio, titles of newspapers or magazines, etc.]*

10 There is now produced and shown to me Exhibit 'C' which consists of samples of promotional material showing use of the mark on the goods/services. *[The samples must be of those used **before** the date of your application]*

Exhibit C1 are samples of promotional material showing use of the mark on the goods/services in Class \_\_\_\_\_.

Exhibit C2 are samples of promotional material showing use of the mark on the goods/services in Class \_\_\_\_\_.

Exhibit C3 are samples of promotional material showing use of the mark on the goods/services in Class \_\_\_\_\_.

11 Other information *[Please provide any other additional information about the use of the mark which you think can help your application].*

12 And I make this solemn declaration by virtue of the provisions of the Oaths and Declarations Act (Cap. 211), and subject to the penalties provided by that Act for the making of false statements in statutory declarations, conscientiously believing the statements contained in this declaration to be true in every particular.

Declared at \_\_\_\_\_ )  
this \_\_\_\_ day of \_\_\_\_\_ )

*[Signature of person making the declaration]*

Before me

*[Signature of person before whom the declaration is made]*

*[Title of person before whom the declaration is made]*

## **RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION**

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**RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION**

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## **1 INTRODUCTION**

“Relative grounds for refusal of registration” refers to the grounds for refusing the registration of a trade mark due to conflict with another party’s earlier trade marks or other earlier rights.

This chapter deals with the relative grounds for refusal that may apply during the course of examining a trade mark application.

## 2 RELEVANT LEGISLATION

### Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

#### Interpretation

2. —(1) In this Act, unless the context otherwise requires —

"Convention country" means a country or territory, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organisation;

"dilution", in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is —

- (a) any competition between the proprietor of the trade mark and any other party; or
- (b) any likelihood of confusion on the part of the public;

"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;

"international trade mark (Singapore)" has the meaning given to it under section 54;

"Paris Convention" means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883, as revised or amended from time to time;

"proprietor" means —

- (a) in relation to a registered trade mark, the person in whose name the trade mark is registered; or
- (b) in relation to an unregistered trade mark that is a well known trade mark, the person to whom the trade mark belongs;

"register" means the register of trade marks maintained by the Registrar under section 66;

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

"well known trade mark" means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
  - (i) is a national of a Convention country; or
  - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,whether or not that person carries on business, or has any goodwill, in Singapore;

...

**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.

(3) Where an application for registration of a trade mark is made before 1st July 2004, if the trade mark —

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

the later trade mark shall not be registered if —

- (i) the earlier trade mark is well known in Singapore;
- (ii) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
- (iii) there exists a likelihood of confusion on the part of the public because of such use; and
- (iv) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
  - (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
    - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
    - (ii) if the earlier trade mark is well known to the public at large in Singapore —
      - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
      - (B) would take unfair advantage of the distinctive character of the earlier trade mark.
- (5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith.
- ...
- (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
  - (b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.
- ...
- (9) The Registrar may, in his discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.
- (10) The Registrar may, in his discretion, register any trade mark referred to in subsection (3), (4) or (7) where the proprietor of the earlier trade mark or other earlier right fails to give notice to the Registrar of opposition to the registration in accordance with section 13.
- (11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no bona fide use of the mark during the 2 years immediately preceding the expiry.

### **Raising of relative grounds in case of honest concurrent use**

**9.—**(1) Where, on an application for the registration of a trade mark, it appears to the Registrar —

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 8(1), (2) or (3) apply; or

- (b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use in the course of trade in Singapore of the trade mark for which registration is sought, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect —

- (a) the refusal of registration on the grounds mentioned in section 7; or
- (b) the making of an application for a declaration of invalidity under section 23(3).

### **Claim to priority of Convention application**

**10.**—(1) Subject to subsection (6), where —

- (a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;
- (b) that application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (referred to in this section as the first Convention application); and
- (c) within 6 months after the date on which the first Convention application is filed, that person or his successor in title applies under this Act for the registration of the trade mark in respect of all or any of those goods or services,

that person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from (and including) the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark shall not be affected by any use of the trade mark in Singapore in the period between —

- (a) the date the first Convention application was filed; and
- (b) the date the application under this Act was filed.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.



(5) For the purposes of subsection (4), “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the subsequent fate of the application.

(6) Where a subsequent application concerning the same subject as an earlier application is filed, whether in the same or a different Convention country, and these are the first 2 applications concerning that subject to be filed in any Convention country, the subsequent application shall be considered the first Convention application if, at the date the subsequent application is filed —

- (a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) the earlier application has not yet served as a basis for claiming a right of priority.

(7) For the avoidance of doubt, where subsection (6) applies —

- (a) the date on which the subsequent application was filed, rather than that of the earlier application, shall be considered the starting date of the period of priority under subsection (2); and
- (b) the earlier application may not thereafter serve as a basis for claiming a right of priority.

(8) The Minister may make rules as to the manner of claiming priority under this section.

(9) A right of priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the applicant’s “successor in title” shall be construed accordingly.

### **Claim to priority from other relevant overseas application**

**11.**—(1) The Minister may, by order, confer on a person who has filed an application for the registration of a trade mark in a country or territory to which the Government has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(2) An order under this section may make provision corresponding to that set out in section 10 or such other provision as appears to the Minister to be appropriate.

...

### **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.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition and such other matter as may be prescribed.

(4) The Minister may make rules to provide for opposition proceedings and for matters relating thereto.

...

#### **Withdrawal, restriction or amendment of application**

**14.**—(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

#### **Registration**

**15.**—(1) Where an application has been accepted and —

- (a) no notice of opposition is given within the period referred to in section 13(2); or
- (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the Registrar shall register the trade mark.

(2) A trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

...

#### **Revocation of acceptance**

**16.**—(1) Notwithstanding section 15(1), if, before a trade mark is registered, the Registrar is satisfied —

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered,

the Registrar may revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance —

- (a) the application is taken to have never been accepted; and
- (b) section 12 again applies in relation to the application.

...

#### **Cancellation of registered trade mark**

**21.**—(1) A registered trade mark may be cancelled by the proprietor in respect of some or all of the goods or services for which it is registered.

...

**Revocation of registration**

**22.**—(1) The registration of a trade mark may be revoked on any of the following grounds:

- (a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered;
- (d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the 5 year period and before the application for revocation is made.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 5 year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

- (a) the date of the application for revocation; or
- (b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

...

## Grounds for invalidity of registration

### 23.—

(3) The registration of a trade mark may be declared invalid on the ground —

- (a) that there is an earlier trade mark in relation to which —
  - (i) the conditions set out in section 8(1) or (2) apply;
  - (ii) where the trade mark has been registered pursuant to an application for registration of the trade mark made before 1st July 2004, the conditions set out in section 8(3) apply; or
  - (iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply; or
- (b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(4) The registration of a trade mark may be declared invalid on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

...

(7) An application for a declaration of invalidity of the registration of a trade mark on the ground that there is an earlier trade mark in relation to which the conditions set out in section 8(3) or (4) apply —

- (a) shall not be made after the expiry of 5 years from 1st July 2004 or the date of completion of the registration procedure, whichever is the later, unless the applicant for the declaration shows that —
  - (i) the registration of the later trade mark was applied for in bad faith; or
  - (ii) the later trade mark was never used; and
- (b) shall not be granted if the registration of the later trade mark was applied for before the earlier trade mark became well known in Singapore, unless the applicant for the declaration shows that the registration of the later trade mark was applied for in bad faith.

(8) In deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark.

(9) Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(10) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, but this shall not affect transactions past and closed.

### **Effect of acquiescence**

**24.**—(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of 5 years in the use in the course of trade of a registered trade mark in Singapore, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right —

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

(3) For the purposes of subsection (1), in deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark or other right.

...

### **Rights conferred by registered trade mark**

**26.** —(1) The proprietor of a registered trade mark has the exclusive rights —

- (a) to use the trade mark; and
- (b) to authorise other persons to use the trade mark,

in relation to the goods or services for which the trade mark is registered.

(2) The proprietor has the right to obtain relief under this Act for infringement of his trade mark.

...

(5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.

...

### **Registration subject to disclaimer or limitation**

**30.**—(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or

- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.

...

**Power to make provision giving effect to Madrid Protocol, etc.**

**54.—**

(4) For the purposes of this section —

“international trade mark (Singapore)” means a trade mark which is entitled to protection in Singapore under the Madrid Protocol or a trade mark prescribed by the Minister as an international trade mark (Singapore);

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989, as revised or amended from time to time.

**Trade Marks Rules**

**Amendment of application**

**22.—**(1) An application to amend an application for registration shall be made in —

- (a) Form CM1, if it is made to appoint, change or remove an agent;
- (b) Form CM2, if it is made to change or correct the name or other particulars of the applicant, and the change or correction does not affect the representation of the trade mark; and
- (c) Form TM 27, if sub-paragraphs (a) and (b) do not apply.

...

(5) Before acting on an application to amend an application for registration, the Registrar may require the applicant to furnish such proof as the Registrar thinks fit.

...

**Publication of application**

**26.—**(1) An application which has been accepted for registration shall be published in the Trade Marks Journal during such times and in such manner as the Registrar may direct.

(2) In the case of an application with which the Registrar proceeds only after the applicant has lodged the written consent to the proposed registration of the proprietor of, or the applicant for the registration of, another trade mark, the words “By Consent” and the number of that other mark shall appear in the publication.

...

**Notice of opposition**

**29.**—(1) A person (referred to in this Division as the opponent) may, within 2 months after the date of publication of the application for registration, file with the Registrar a notice opposing the registration in Form TM 11 (referred to in this Division as a notice of opposition).

...

(3) A request for an extension of time to file the notice of opposition —

- (a) must be made by filing with the Registrar Form TM 48 within 2 months after the date of the publication of the application for registration; and
- (b) must state —
  - (i) the reason for the extension; and
  - (ii) the name and address of every person likely to be affected by the extension.

...

(4) The total extension of time for which the Registrar may allow to file the notice of opposition shall not exceed 4 months after the date of the publication of the application for registration.

...

**Registration subject to disclaimer or limitation**

**43.** Where the applicant for registration of a trade mark by notice in writing sent to the Registrar, or the proprietor of a registered trade mark by Form TM 27 filed with the Registrar —

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the Registrar shall make the appropriate entry in the register.

...

**Request for extension of time**

**77.**—(1) Subject to paragraph (6), any period of time —

- (a) prescribed by these Rules; or
- (b) specified by the Registrar for doing any act or taking any proceedings,

may, at the request of the person or party concerned, be extended by the Registrar by such period and upon such terms as the Registrar considers fit.

...

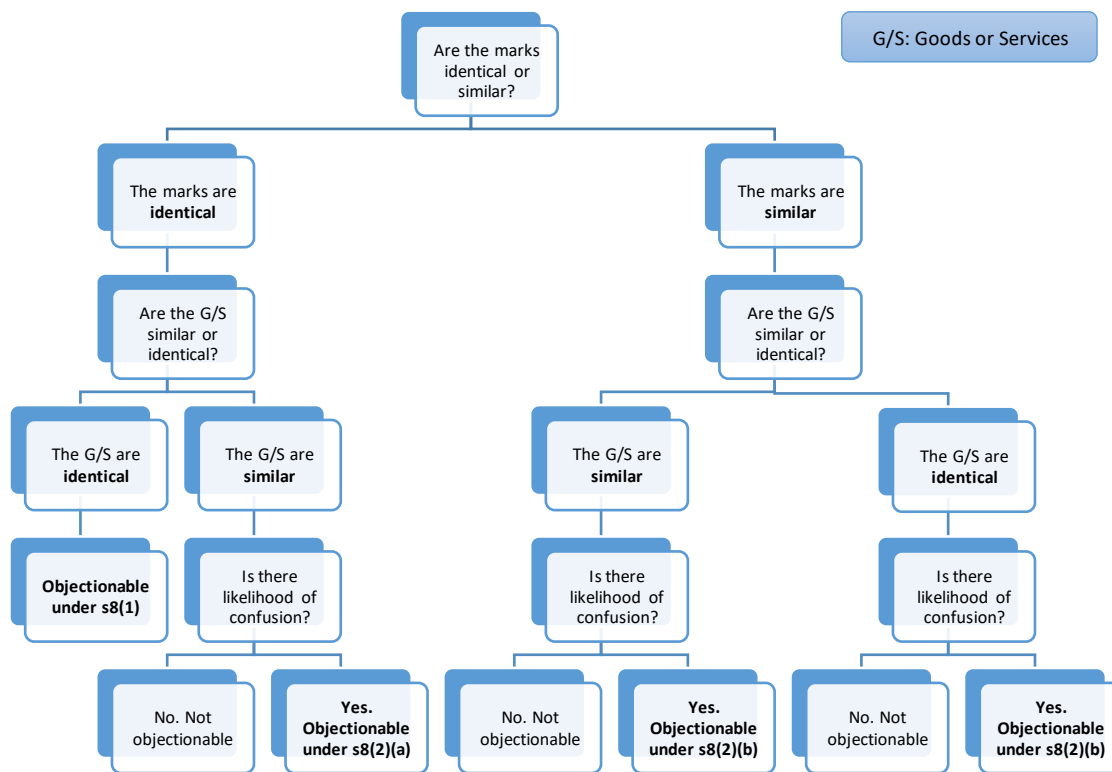
(2) The Registrar may refuse to grant an extension of time if the person requesting the extension —

- (a) fails to show a good and sufficient reason for the extension;

### 3 OVERVIEW

The Trade Marks Act provides that a trade mark shall not be registered if it conflicts with an earlier trade mark in scenarios such as the following:

- (a) The marks and the goods and/or services are identical (section 8(1)); or
- (b) The marks are identical or similar and the goods and/or services are identical or similar, and there exists a likelihood of confusion on the part of the public (section 8(2)(a) or section 8(2)(b)).





#### 4 MEANING OF AN “EARLIER TRADE MARK”

Objection to the registration of a trade mark under section 8 can only be taken if the conflicting mark is an “earlier trade mark” defined under section 2(1).

For the purpose of examining a trade mark application under section 8, an earlier trade mark is a trade mark with an earlier date of filing or priority date than the trade mark under examination (the subject mark). For more information on “priority”, please refer to the Trade Marks Work Manual’s section on “Priority Claims”.

The examiner will conduct a search of the register for potential conflicting marks with an earlier date of filing or priority.

The examiner will consider marks with the following statuses as potential citations under section 8 of the Trade Marks Act:

- Marks that are registered
- Marks that are under examination
- Marks that are published but not yet registered
- Marks whose registration expired for one year or less
- Marks that are treated as withdrawn and pending reinstatement to the register

The Registry’s citation practices will be further elaborated in Part 6 “Citing Practices”.

## 5 CONFLICT WITH EARLIER TRADE MARKS

### 5.1 Step-by-step approach

The approach adopted in Singapore in relation to an objection under sections 8(1) and 8(2) of the Trade Marks Act is known as the step-by-step approach. This approach has been endorsed by the courts including the Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 (“*Polo (CA)*”) and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”).

There are three elements under the step-by-step approach:

1. Similarity of marks

The first step is to assess whether the marks, when observed in their totality, are identical or similar.

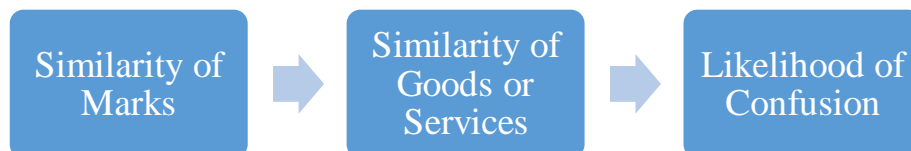
2. Similarity of goods or services

The second step is to assess whether the goods or services in relation to which the marks are applied on are identical or similar.

3. Likelihood of confusion

The third step is to consider whether there exists a likelihood of confusion on the part of the public due to these similarities.

The three elements are assessed sequentially. Each element has to be satisfied before moving on to the next step. This means that the second step of assessing the similarity of the goods or services will proceed only if there is identity or similarity between the marks. In the same vein, if either of the first two conditions is not satisfied, there is no need to go into the third step of determining whether there exists a likelihood of confusion.



## 5.2 Comparing the marks

In the first step of the step-by-step approach, the marks are assessed to determine if they are identical or similar.

### 5.2.1 Mark-for-mark

The assessment of marks similarity is “mark-for-mark”, without consideration of any external matter. This means that the marks are to be compared as they are applied for or registered, and not how they are actually being used in the marketplace.

When there are multiple earlier marks to be compared against the subject mark under examination, each of the earlier marks must be compared separately and independently of the subject mark. The multiple earlier marks cannot be combined to form a single composite mark which is then used to be compared with the subject mark (see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 (“*Rovio Entertainment (HC)*”) at [70]). This is consistent with the principle that one should not consider extraneous matter at the marks-similarity stage.

### 5.2.2 The average consumer

In the comparison of marks, the viewpoint should be that of the average consumer of the relevant goods and/or services. The average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry (see *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40]).

The average consumer may vary depending on the nature of the goods and/or services in question. It is also possible to have more than one group of average consumers. The degree to which persons are involved in selecting a product for the end-use will determine whether these persons are considered as part of the “average consumers”, for example, people who deals with the distribution of the goods (see *Allergan, Inc. v Ferlandz Nutra Pte Ltd* [2016] SGHC 131 at [79].)

It is to be borne in mind that the average consumer has imperfect recollection. That is, the consumer often makes a comparison from memory removed in time and space from the marks. Hence, the earlier mark and the subject mark should not be compared side by side and examined in detail for the sake of isolating particular points of difference (see *Hai Tong* at [40(d)] and [62(a)]).

### 5.2.3 Identical marks

The test of whether a mark is “identical” with another mark under section 8(1) entails a strict interpretation, where minor differences would take the case outside of the definition of “identical” (see *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) at [39]).

Such a strict approach is taken because once the marks are found to be identical and the goods and/or services are also determined to be identical, there is no need to establish a likelihood of confusion on the part of the public which is the case under section 8(2) and will be elaborated upon later.

The following cases illustrate the approach that will be taken:

Subject mark	Earlier mark	Elaboration
“intuition”	“INTUITION”	The same words in plain font are considered identical despite the difference in letter case.  <i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [24], citing the decision of <i>Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd</i> [2011] SGHC 176 (“ <i>Sarika (HC)</i> ”) at [58].
“INTUITION CONSULTING”	“INTUITION”	Not identical.  The subject mark has the additional word “CONSULTING”.  <i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [25].
“Origin”	“Origins”	Not identical.  The subject mark “Origin” is not identical to the earlier mark “Origins” because of the omission of the letter “s”.  <i>Origins Natural Resources Inc v Origin Clothing Ltd</i> [1995] FSR 280; cited as an example in <i>Polo (CA)</i> at [21].

#### 5.2.4 Distinctiveness

Distinctiveness is a factor integrated into the visual, aural and conceptual analysis of the competing marks in order to determine whether they are similar.

“Distinctiveness” in this regard has two different shades of meaning and they are elaborated below:

- Distinctiveness in the ordinary (non-technical) sense:

This refers to what is outstanding and memorable about the mark. Components of a mark which are distinctive in the ordinary and non-technical sense are those which tend to draw the consumers' attention, bearing in mind the imperfect recollection of the average consumer. These distinctive (in the ordinary sense) and memorable components of the mark stand out in the consumer's imperfect recollection. Hence, special regard may be placed on the distinctive or dominant components of a mark, even while the examiner assesses the similarity of the two marks as composite wholes (see *Staywell* at [23]).

- Distinctiveness in the technical sense:

This refers to the capacity of a mark to serve as a badge of origin. Distinctiveness can be inherent, usually where the words comprising the mark are meaningless and can say nothing about the goods or services; or acquired, where the words that do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use (see *Staywell* at [24]).

A mark which has greater technical distinctiveness enjoys a high threshold before a conflicting mark will be considered dissimilar to it (see *Staywell* at [25]). In other words, the more distinctive the earlier trade mark, the more it is necessary to show sufficient alterations to, or difference in the later mark in order that it may not be held to be similar to the earlier mark (see *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika (CA)*”) at [20]).

One should bear in mind that while the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness (see *Staywell* at [25]).

When assessing the similarity of marks, the degree of distinctiveness of the various components of the earlier mark and of the later mark must be considered. The purpose of analysing the components is to determine whether the marks coincide in a component that is distinctive, non-distinctive or weak and in order to assess the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. This recognises that the consumer is more likely to consider that a non-distinctive or weak element of a mark is not being used to identify a particular trader, and thus not being used to distinguish goods or services of one trader from those of another.

In *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10 (“*Xiaomi*”), the competing marks, “IPAD” and “MI PAD”, shared the same component “pad”, which the relevant public understands is a synonym for “tablet computers” and has a descriptive meaning in relation to goods and services which are linked to tablet computers. Accordingly, the Hearing Officer found that “Pad” was less likely to be regarded as the dominant or distinctive element of the “IPAD” and “MI PAD” marks.

Instead, the Hearing Officer was of the view that the distinctiveness of the “IPAD” mark resided in the I-prefix and that the elements “I” and “PAD” are conjoined to form a single invented word. On the other hand, the dominant and distinctive component of the “MI PAD” mark was “MI”. Hence, notwithstanding that “MI PAD” contained all the letters of the “IPAD” mark in the same sequence, “MI PAD” does not capture the distinctiveness of the “IPAD” mark.

### **5.2.5 Similar marks**

#### **5.2.5.1 Visual, aural and conceptual similarities**

The earlier mark and the subject mark are to be compared for any visual, aural and conceptual similarities, by reference to the overall impressions of the marks, bearing in mind their distinctive and dominant components.

However, these three aspects of similarities are merely signposts to guide the marks similarity inquiry. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar, and trade-offs can occur between the three aspects (see *Staywell* at [18]).

At the marks-similarity stage, the relative weight and importance of each aspect of similarity (that is, visual, aural and conceptual similarities) having regard to the goods or services, is not considered. Rather, this would be a matter reserved for the confusion stage of the step-by-step approach (see *Staywell* at [20]).

As stated earlier, one should bear in mind that ultimately the conclusion to be reached is whether the marks, when observed in their totality, are similar rather than dissimilar (see *Staywell* at [17] and *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone (CA)*”) at [27]).

Further elaboration of how visual, aural and conceptual similarities are assessed can be found in the later parts of this chapter.

#### **5.2.5.2 Visual Similarity**

Visual similarity deals with the appearance of the marks. It is to be assessed by examining each of the marks in question as a whole, bearing in mind their dominant and distinctive components and by reference to the overall impressions created by the marks.

The following are some considerations to note in assessing visual similarity.

##### **5.2.5.2.1 Substantial reproduction does not equate to visual similarity**

The High Court in the case of *The Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 (“*USPA*”) (at [17]) has stated that the test for visual similarity is not that of substantial reproduction.

To illustrate, in the case of *Xiaomi* (“IPAD” versus “MI PAD”), the Hearing Officer took the view that the fact the mark “MI PAD” contains all the letters in the “IPAD” mark in the same sequence did not result in an automatic conclusion that “IPAD” was visually similar to “MI PAD”.

#### 5.2.5.2.2 Common denominator in the marks

The Court of Appeal, in the decision of *Caesarstone (CA)* (at [32]) has affirmed the principle that where there is a common denominator, it is important to look at the differences between the competing marks in order to decide whether the challenged mark (the Caesarstone Mark as indicated in the below table) has been able to distinguish itself sufficiently and substantially.

The marks in question in the aforementioned case are:

Caesarstone Mark	
Caesar Mark	

In this case, the common denominator between the two marks was the word “Caesar”. The Court of Appeal considered that the word “Caesar” was the distinctive and dominant component of the “CAESARSTONE” mark, while the device was a somewhat insignificant component, and the word “stone” was descriptive of the goods claimed. For the “CAESAR” mark, the word “Caesar” was the distinctive and dominant component. The differences between the two marks do not serve to distinguish the “CAESARSTONE” mark sufficiently and substantially. The overall impression conveyed by both marks is dominated by the word “Caesar”.

#### 5.2.5.2.3 Colour

Colour is a relevant consideration to be taken into account in assessing visual similarity. The extent to which colours play a role would vary from case to case and the impact of the use of colours in the marks on the perception of the average consumer.

In the case of *Apptitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15, the marks were:



Both marks were in colour. The Hearing Officer was of the view that based on visual impression alone, the colours were very different. Taking into account the imperfect recollection of the average consumer, the difference in colours pointed towards the conclusion that the marks were dissimilar.

- Comparing a black-and-white mark with a coloured mark

In the marks-similarity step, the marks are compared as they are represented on the register, that is, “mark-for-mark” and extraneous matter should not be considered. Where one mark is depicted in black-and-white and the other is in colour, colour is *not* a factor which influences the mark-similarity assessment either way; it neither adds to, nor detracts from, the similarity between the marks (see *Starbucks Corporation d/b/a Starbucks Coffee Company v Morianaga Nyugyo Kabushiki Kaisha (Morinaga Milk Industry Co. Ltd.)* [2017] SGIPOS 18 at [37] and *Fox Head, Inc. v Fox Street Wear Pte Ltd* [2018] SGIPOS 8 at [56]).

#### 5.2.5.2.4 Where the earlier mark and the subject mark are word marks

Marks consisting of text only are known as word marks. When comparing two word marks, the High Court, in the case of *Sarika (HC)*, set out the following guidelines for consideration (at [51]):

- length of the marks;
- structure of the marks (i.e. whether there are the same number of words); and
- whether the same letters are used in the marks.

Applying the above guidelines, the High Court noted that the “Nutella” mark and the “Nutello” mark comprised 7 letters each, with the first 6 letters being identical and only the last being different. Taking into account the possibility of imperfect recollection and that the difference lies only in the single ending letter, the Court of Appeal, in *Sarika (CA)*, affirmed the High Court’s decision that the marks would appear visually similar to an average consumer.

#### 5.2.5.2.5 Where the earlier mark and/or the subject mark are composite marks

Marks consisting of both textual and figurative elements are known as composite marks.



In assessing the visual similarity of marks where one or more of the marks is a composite mark, the correct approach is to consider the marks in totality without placing undue emphasis on any particular component of such marks unless such emphasis is warranted on the facts (see *Hai Tong* at [41]).

The following non-exhaustive list of principles have been laid out by the courts in various cases (see *Hai Tong* at [62] and *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 (“*Caesarstone (HC)*”) at [30]):

- The visual similarity of two marks is assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.
- The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.
  - When the other components of a complex composite mark are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).
  - However, it cannot be assumed that there will always be a feature of the mark which dominates the mark’s landscape. In some cases, no particular feature will stand out. Micro-analysing a mark for particular features in such cases is unhelpful.
- Words do not necessarily ‘talk’ in composite marks
  - Words in composite marks do not dominate or constitute the whole of such marks simply because they are words.
  - The textual component of a composite mark could (but will not necessarily or always) be the dominant component of the mark. The textual component is a dominant component of the mark if:
    - the textual component is in itself highly distinctive;
    - the textual component is large, and is in a prominent location in relation to the other components, or stands out from the background of the mark.
  - If the competing marks contain a similar device, the overall resemblance between them may be diminished if they each bear words which are entirely different from each other.
- Significance of the device component

- The device component is an equally significant, if not the dominant, component of a composite mark where:
  - the device is prominent and large;
  - the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component; or
  - the device component is of a complicated nature.
- But usually not where:
  - the device is simple and does not evoke any particular concept for the average consumer;
  - the device component does not attract the attention of the average consumer of the goods or service in question because such a consumer is regularly confronted with similar images in relation to those goods or services; or
  - the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.

Below are some illustrations to show how composite marks would be assessed for visually similarity:

1) *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941



The textual element “Lady Rose” was determined to be the dominant component of the mark, as it was distinctive and had no allusive quality in relation to the goods claimed which were perfume products. On the other hand, the device component, which was a simple stylised rose, was found to be relatively insignificant<sup>1</sup>. The rose device emphasised the “Rose” portion of “Lady Rose” and hence, was not a feature which drew any attention away from the words. Furthermore, a customer trying to recollect the mark would be far more likely to recall the textual component rather than the device component.

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<sup>1</sup> At paragraph 65 of the judgement, the device component consisting of a simple stylised rose, was found to be relatively insignificant for several reasons:

- (a) The device component emphasised the “Rose” portion of “Lady Rose”;
- (b) The simple stylised rose was not a feature that drew any significant attention away from the words;
- (c) A customer trying to recollect the mark would be far more likely to recall the textual component rather than the device component
- (d) It was unlikely that the simple stylised rose would serve as a point of distinction if the textual component of the conflicting marks were found to be substantially similar.

- 2) *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 (“*Audience Motivation (HC)*”)



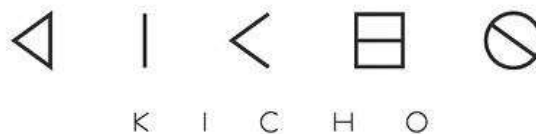
The words “to create, entertain and inspire” were presented in the mark in very small font and were not prominent. Consequently, they had limited visual impact on the consumers.

- 3) *The Polo/Lauren Company L.P. v Royal County of Berkshire Polo Club Ltd* [2017] SGIPOS 19



The Hearing Officer found that none of the elements in the mark, namely the polo player device, the words “Royal County of Berkshire”, or the words “POLO CLUB” were more outstanding or memorable than the others. There was no dominant component in the mark and the mark should be assessed as a whole.

- 4) *Kiko S.p.A. v Dooyeon Corp* [2016] SGIPOS 4



The Hearing Officer was of the view that both the device element and the word element were equally dominant. The word element is distinctive while the device element was significant, large and not simple. The device was also not a decoration but constituted part of the trade mark message of the sign to indicate origin. Both the word and the device elements were distinctive and significant when considering the mark as a whole.

### 5.2.5.3 Aural Similarity

Aural similarity deals with the pronunciation of the competing marks. It is important to bear in mind that the aural analysis involves the utterance of the syllables without exploring the composite meaning embodied by the words (see *Staywell* at [35]).

### 5.2.5.3.1 Dominant Component Approach and Quantitative Assessment Approach

There are two possible approaches in the assessment of aural similarity (see *Staywell* at [31]–[32]), known as the “dominant component approach” and the “quantitative assessment approach”:

#### 1) Dominant component approach

This approach gives special regard to the distinctive or dominant components of the conflicting marks. Where a word in the mark is descriptive (that is, non-distinctive) of the goods or services claimed, that element has less significance in the assessment of aural similarity. An example can be found in the case of *Caesarstone (CA)* (the mark images can be found in the earlier section 5.2.5.2.2 “Common denominator in the marks”). The dominant component of the “CAESARSTONE” mark is the word “Caesar”, as the device is irrelevant (elaborated in the later section “Aural comparison of device mark(s)”) and the word “stone” of the mark is descriptive of the goods claimed. As a result, the competing marks were found to have a high level of aural similarity.

In the case of *Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825, the competing marks are:

The Han’s trade marks



The Han’s sign



The Judge stated (at [137]) the following with regard to the application of the above principle in relation to composite marks:

In my view, there is phonetic similarity between the HAN sign and the Han’s trade marks. The main phonetic component of the HAN sign is “HAN”. “Cuisine of Naniwa” is subsidiary. It is doubtful that the average consumer would make constant reference to the seven-syllable “HAN Cuisine of Naniwa” phrase every time he refers to it. “HAN” and “Han’s” are both single-syllable words which share similar pronunciations. Adequate allowance must be made for imperfect recollection and careless pronunciation and speech: *Future Enterprises Pte Ltd v McDonald’s Corp* [2006] 4 SLR(R) 629 at [12].

The slightest mispronunciation would result in complete identity. There is, therefore, phonetic similarity between the HAN sign and the Han's trade marks.

## 2) Quantitative assessment approach

This approach involves determining “*whether the competing marks have more syllables in common than not.*” (see *Staywell* at [32]).

In *Sarika (CA)*, there were three syllables in both the marks, “Nutello” and “Nutella”. The first two out of three syllables in both marks are the same. Hence, the marks had more syllables in common than not.

However, one should also be mindful that realism should be incorporated into the assessment of how the average consumer would aurally perceive the marks and avoid simplistic or formulaic application of the two approaches (see *Apple Inc. v Swatch AG (Swatch SA)(Swatch Ltd.)* [2018] SGIPOS 15 at [43]). For example, it is necessary to take into account the rhythm (and stress) of the marks and their influence on how the marks will eventually sound, before comparing how aurally similar the competing marks are.

### 5.2.5.3.2 Factors to consider in assessing aural similarity

In assessing aural similarity, some non-exhaustive factors to consider are:

- Pronunciation of the marks
- The possibility of slurred pronunciation
- Slurring of the termination of words
- Whether there is a pause in reading the marks
- How different the prefixes and suffixes are
- Quantitative assessment as to whether the marks have more syllables in common than not
- Syntax of the words (marks with inverted word order may still be considered similar)

### 5.2.5.3.3 Pronunciation of Marks

The pronunciation of a mark is based on “how an average Singaporean consumer would pronounce the respective words”, taking into consideration the possibility of “imperfect recollection and careless pronunciation and speech” (see *Sarika (CA)* at [30]-[31]).

It was observed in *London Lubricants (1920) Limited's Application to Register a Trade Mark* [1925] 42 RPC 264 at [279]:

[That] the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and... the first syllable of a word is, as a rule, far [sic] the most important for the purpose of distinction.

However, this observation should not be taken as a hard and fast rule of pronunciation in the English language. The Court of Appeal in *Polo (CA)* held (at [23]) that there was no rigid principle that the first syllable of a word mark is more important than other syllables.

Further, it was also observed that there is a tendency of persons using the English language to slur subsequent syllables or the termination of words (see *Hyundai Mobis v Mobil Petroleum Company, Inc* [2007] SGIPOS 12 and *Sarika (CA)* at [30]).

The following marks were found to be aurally similar:

- “NUTELLA” and “NUTELLO” (*Sarika (CA)*)
  - The first syllable would likely be emphasized in pronouncing the words “Nutella” (pronounced as Nut-ella) and “Nutello” (pronounced as Nut-ello). Taking into consideration imperfect recollection, the average consumer is likely to regard both marks as aurally similar.
- “CAREFREE” and “CAREREE” (*Johnson & Johnson v Uni-Charm* [2007] 1 SLR (R) 1082)
  - A person with an imperfect recollection of the “CAREFREE” mark (pronounced as two words “care” and “free”) may find that the “CAREREE” mark (pronounced as the two words “care” and “ree”) to be rather aurally similar.

Ultimately, it is the pronunciation of the words as a whole that is critical in ascertaining aural similarity. In the case of *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552, “FESTINA” and “J.ESTINA” were found to share aural similarities. The average consumer is likely to stress the “-estina” portion when pronouncing the words “FESTINA” and “J.ESTINA”, while the beginning letters of the words “F” and “J” would be given less emphasis.

#### 5.2.5.3.4 Pronouncing invented words

In the pronunciation of an invented word, a person would have the tendency to reach for a familiar word in his own vocabulary that is closest to the invented word.

Guidance may be taken from the approach taken in *Appitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15 at [41]-[46], citing *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8 (“*Seiko*”). In the *Seiko* case, the Hearing Officer commented on how “ROOX” should be pronounced at [30]:

When a person is faced with an unfamiliar word, there is a tendency for that person to reach within his own vocabulary of words and mentally look for words that have the same structure in the sense that the chronology of the alphabets [*sic*] is the same as the unfamiliar word. Having identified the similar word or words; he would apply the way in which those words are pronounced to the unfamiliar word. In this case,

that person would apply the pronunciation of very normal English words like “roof”, “room” and “root” which look the most identical to the word “ROOX”. The mark “ROOX” would be pronounced phonetically as “rooks”, the letter “X” at the end of a word as most of us have been taught, being enunciated with a “-ks” or “-cs” sound. It would be quite a stretch to consider the word “ROOX” as a dual-syllable word; it is clearly a single-syllable word.

#### 5.2.5.3.5 Syntax of words (inverted word order)

A mark which consists of the same words as another mark, albeit in reverse or inverted order, may still be considered aurally similar. In *Hai Tong*, the words “Rose Lady” was found to be aurally similar to the words “Lady Rose”.

“Composite Mark”



“Sign”

Rose Lady



The Court of Appeal elaborated at [69]:

In the present case, there is no doubt that both the Composite Mark and the Sign consist of exactly the same syllables. The only difference is in their syntax in that they are read in inverted order. However, we think that the fact that the syllables are articulated in an inverted order does not prevent the Composite Mark and the Sign from being aurally similar.

#### 5.2.5.3.6 Aural comparison of device mark(s)

In general, when one or both marks under comparison is a device mark, no aural comparison may be undertaken, as a device mark has no verbal element to speak of. An aural comparison would result in a neutral conclusion rather than the marks are aurally dissimilar. Finding aural similarity where no aural component exists in a mark may be akin to allowing for visual or conceptual similarity to be taken into consideration within the assessment of aural similarity, which is an incorrect approach.

In the case of *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10, the competing marks were:

Application Mark	Opponent's Earlier Mark T1111886Z
	

The Hearing Officer stated the following (at [60]):

It is clear that there can be no comparison between the Application Mark and the Opponents' Earlier Mark T1111886Z as the Opponents' Earlier Mark T1111886Z, being a device mark, has no aural component to speak of.

This finding of the Hearing Officer was not disturbed on appeal (see *Rovio Entertainment (HC)* at [85])

#### 5.2.5.4 Conceptual Similarity

Conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (see *Staywell* at [35]).




The idea must arise from the mark itself, and not something that is known only to its creator (see *Audience Motivation (HC)* at [43]). It is what the consumer would perceive at surface value—not the actual intention of the creator—that is relevant in the conceptual analysis of a mark.

In considering whether there is conceptual similarity between marks, it is necessary to consider the overall impression created by the marks from the perspective of the average consumer in Singapore, bearing in mind their distinctive and dominant components.



#### 5.2.5.4.1 Conceptual meaning in devices

Aside from words (which may contain semantic meaning contributing to the concept of a mark), conceptual meaning may also be found in devices, if the device is capable of evoking an idea. For example:

Device	Conceptual meaning (underlying idea conveyed by the mark) from the perspective of the average consumer in Singapore	Case
	Moose  (Silhouette of a moose)	<i>Abercrombie &amp; Fitch Europe SAGL v MMC International Services Pte Ltd</i> [2016] SGIPOS 6
	Fox  (Stylised depiction of a fox head)	<i>Fox Racing, Inc. v Fox Street Wear Pte Ltd</i> [2014] SGIPOS 13
	Game of polo  (Image of a person engaging in the game of polo)	<i>Polo/Lauren Co LP v United States Polo Association</i> [2016] 2 SLR 667

#### 5.2.5.4.2 Where marks under comparison are meaningless or invented words

In cases where a word is invented and meaningless, it does not possess what can be said to be a concept. Hence, in the comparison of two marks in which one of the marks has no concept, there is no basis for a conceptual comparison of the marks. Therefore, no conceptual similarity can be found (see *Sarika (CA)* at [34]).

In the case of *Sarika (CA)*, no conceptual similarity was found between the marks “NUTELLO” and “NUTELLA”, because the marks were invented and meaningless terms with no particular idea underlying each of them.

### 5.2.5.4.3 No conceptual similarity is not the same as conceptually dissimilar



Marks found to have *no conceptual similarity* is not equivalent to marks that are *conceptually dissimilar*:

- No conceptual similarity: There is no basis for conceptual comparison of the marks.
- Conceptually dissimilar: The marks evoke different ideas/concepts.

### 5.2.6 Earlier trade mark registered subject to a disclaimer

Where the *only* component of an *earlier* trade mark which could be regarded as creating a similarity with a later trade mark is the subject of a disclaimer to any exclusive right, the examiner will not consider the marks to be similar enough to create a likelihood of confusion. In other words, a citation would not be raised in a case where the resemblance between the marks in issue is attributable to nothing more than the presence in the earlier mark of an element for which protection has been disclaimed.

This principle is illustrated in the opposition case *Christie Manson & Woods Limited v Chritrs Auction Pte. Limited* [2016] SGIPOS 1. In this case, the Hearing Officer found that “since the only possible point of similarity between the Application Mark and the Opponents’ mark in Class 35 rests solely on the word “Christie’s”, which has been disclaimed, the opposition under section 8(2)(b) relating to the Opponents’ mark in Class 35 must fail” (at [62]). The Application Mark and Opponents’ mark referred to are reproduced below for ease of reference:

Application Mark	Opponents’ mark in Class 35
	 <p><b><u>Disclaimer clause:</u></b></p> <p>Registration of this Trade Mark shall give no right to the exclusive use of the word “Christie’s”.</p>

### 5.2.7 Conclusion on similar marks

After considering the three aspects of similarity (visual, aural and conceptual) and bearing in mind that trade-offs can occur between the three aspects of similarity, an assessment will be made on whether the competing marks, when observed in their totality, are similar rather than dissimilar. Similarities in all three aspects need not be present to warrant a finding of similarity, neither is there a strict requirement that all similarities be of equal weightage.

If the competing marks are found to be similar rather than dissimilar, the examiner will move on to the second step of the step-by-step approach to assess whether the goods and/or services of the competing marks are identical or similar. This will be elaborated in the next section.

If the competing marks are found to be dissimilar rather than similar, there is no need to move on to the second step of the step-by-step approach.

## 5.3 Comparing the goods or services

The second step in the step-by-step approach seeks to answer the question whether the goods and/or services of the competing marks are identical or similar.

### 5.3.1 Reading the specification of goods and services

The specification in a trade mark application is a list of goods or services that is classified in various classes according to the Nice Classification (also known as the International Classification of Goods and Services (ICGS)). For more information regarding the Registry's classification practices, please refer to our Trade Marks Work Manual chapter on "Classification of goods and services".

In interpreting the scope of a specification, the words or phrases used are considered in their *ordinary and natural meaning*, without straining the language unnaturally so as to produce a narrow meaning which does not cover the goods or services in question (see *Staywell* at [41]). For example, the item "jam" does not fall within the ambit of "dessert sauce". The ordinary and natural meaning of "dessert sauce" does not include jam and vice versa.

When determining whether the goods or services are identical or similar, the examiner will compare the full spectrum of goods and/or services which the earlier mark is registered (or applied for) against that of the later mark.

### 5.3.2 Identity of the goods or services

The goods or services of two competing marks are *prima facie* identical if the later mark's goods or services fall within the ambit of the specification of the earlier mark (see *Staywell*

at [41]). For example, “lipsticks” will fall within the ambit of “cosmetics”, hence “lipsticks” and “cosmetics” would be considered as identical goods.

Where the goods or services are regarded as identical, “there is no further need to consider whether they are similar or the extent of their similarity” (see *Staywell* at [42]).

### 5.3.3 Similarity of the goods or services

In the assessment of whether or not there is similarity in the goods or services of conflicting marks, numerous Singapore cases have relied on the following factors set out in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) (at [296]):

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

The factors above merely serve as guidelines and they may not all be relevant to every case. The Court of Appeal stated in *Sarika (CA)* (at [51]) that “the weight which ought to be accorded to each factor is for the trial judge to ascribe after assessing all pertinent factors”.

If the goods or services are found to be similar, they may vary in the degree or extent to which they are similar (see *Hai Tong* at [85(c)]). The extent of similarity between the goods or services has an impact on the confusion-inquiry (i.e. the final step of the step-by-step approach), which is elaborated in the later parts of this chapter.

#### 5.3.3.1 Does the class of the goods or services matter?

The class under which the goods or services are classified does not determine their similarity. The fact that the goods or services of two conflicting marks are in the same class does not automatically mean that the goods or services must be similar. For example, Class 9 covers a broad range of goods. “Fire-extinguishing apparatus” would not be considered as being similar to “Computers”, even though both descriptions are classified in Class 9. Further, goods or services of two conflicting marks in different classes may be found to be similar and the difference in class number does not automatically lead to the conclusion that the goods or services are dissimilar. The assessment for similarity of the

goods or services involves the comparison of the specific goods or services in the specification, rather than just their class number.

#### **5.3.4 Conclusion on similarity of the goods or services**

Once similarity between the competing marks and the goods or services has been established, the impact of these similarities on the relevant consumers' ability to understand where those goods and services originate from will be considered in the final step of the step-by-step approach (see *Staywell* at [64]).

However, if it is established that there is no similarity in the goods or services, there is no need to proceed to the next step of the approach to determine whether there is any likelihood of confusion.

### **5.4 Likelihood of confusion**

The final step of the step-by-step approach considers the likelihood of confusion. This step is also known as the confusion inquiry.

Any likelihood of confusion must arise from the similarity of the marks and the goods or services (see *Staywell* at [64]). However, it does not mean that a finding of similarity between the marks and the goods or services will automatically translate to an establishment of confusion.

At this stage, the effect of objective similarities between the conflicting marks and the goods or services in question on the consumer perception is assessed (see *Staywell* at [20]). This entails looking at (i) how similar the marks are; (ii) how similar the goods or services are; and (iii) given this, how likely it is that the relevant segment of the public will be confused (see *Staywell* at [55]).

Before going further into how such similarities affect the likelihood of confusion, some key principles to note are as follows:

#### **5.4.1 Two types of confusion**

In general, there are two possible types of confusion. As elaborated by the Court of Appeal in *Caesarstone (CA)* at [57] (citing *Hai Tong* at [74]), the first type of confusion involves mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the competing marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks come from the same source or from sources that are economically linked or associated. For example, the relevant segment of the public may perceive that the goods bearing the competing marks come from the same provider who has chosen to diversify its range of marks for marketing or promotional reasons or the goods come from sources that are economically linked.

### 5.4.2 Mere association does not equate to confusion

The Court of Appeal has clarified (in *Hai Tong* at [75] and *City Chain* at [58]) that “mere association” is not *in itself* sufficient to prove that confusion has occurred. This means that it is insufficient that the relevant segment of the public would recognise or recollect similarities between the conflicting marks if there is no likelihood of confusion as to the trade origin.

### 5.4.3 Substantial portion of the consumers must be confused

To establish that there is a likelihood of confusion, the test to adopt is whether a substantial portion of the relevant public will be confused. Although it is not necessary to show that a majority of the public is confused, it is insufficient if only a “single member” of the relevant public is confused or if only a “very small and unobservant section” is confused. (see *Sarika (CA)* at [57] and *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [79]).

It should be noted that the relevant segment of the public may comprise various groups of consumers. For instance, in *Caesarstone (CA)*, the relevant public is a composite comprising both specialists and lay end-consumers (at [85]). To establish that there is a likelihood of confusion, it has to be shown that a substantial portion of the relevant public composing of the respective groups of consumers will be confused.

### 5.4.4 Permissible extraneous factors to consider

There is a limit to the range of external factors that may be taken into account to determine whether a likelihood of confusion exists. The permissible factors are those which (i) are intrinsic to the very nature of the goods or services and/or (ii) affect the impact that the similarity of marks and goods/services has on the consumer (see *Staywell* at [95]).

In contrast, superficial differentiating steps which are not inherent in the goods or services themselves but are dependent on traders’ business strategies are not permissible. These may include pricing differentials, packaging and other superficial marketing choices (see *Staywell* at [95]).

Based on the considerations above, the Court of Appeal in *Staywell* set out a non-exhaustive list of extraneous factors that are admissible in the confusion inquiry (see *Staywell* at [96]). These factors are elaborated below.

#### 5.4.4.1 Factors relating to the impact of marks-similarity on consumer perception

At this stage, the effect of the similarity between the marks, on the perception of consumers is examined. For example, the significance of aural similarity in relation to beverages normally sold by mail order, and visual similarity in relation to clothing normally sold based on the consumer’s direct perception, would be determined (see *Staywell* at [20]).

Factors relating to the impact of marks-similarity on consumer perception include:

**(i) the degree of similarity of the marks themselves;**

In general, if there is a greater degree of similarity between the marks, it follows that the likelihood of confusion would be greater (see *Hai Tong* at [85(c)(iii)]).

In the case of *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10, it was found that there was identity in the goods, which are mainly eyewear and related goods. Eyewear “are usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer. In this case, there is only a very low degree of visual similarity between the marks. This, coupled with the fairly high degree of care and attention that the average consumer will pay when purchasing eyewear, are factors which point away from a likelihood of confusion.” (at [112]).

**(ii) the reputation of the marks;**

The reputation of the marks is one of the factors which should be taken into account but it should be noted that the reputation of a well-known mark does not necessarily equate to a higher likelihood of confusion (see *Mobil* at [74]). On the contrary, a strong reputation may have the reverse effect as the average consumer is unlikely to be confused (see *McDonald’s Corp v Future Enterprises Pte Ltd* [2004] SGCA 50 at [64]).

**(ii) the impression given by the marks; and**

**(iv) the possibility of imperfect recollection.**

**5.4.4.2 Factors relating to the impact of goods-similarity on consumer perception**

Factors relating to the impact of the similarity of goods or services on consumer perception include (i) the normal way in or the circumstances under which consumers would purchase goods or services of that type; (ii) whether the products or services are expensive or inexpensive; (iii) the nature of the goods or services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase (see *Staywell* at [96(b)]).

**(i) The normal way in or the circumstances under which consumers would purchase goods or services of that type**

The normal way in which the product is sold or the service is procured varies, and can include purchases made entirely via websites, mobile applications, brick-and-

mortar stores or via specialists or professionals as in the case of prescription drugs or renovation fixtures.

The mode of purchase affects how much weightage should be given to the visual, aural or conceptual aspect of the assessment of similarity of marks. For goods/services that are mainly procured via vocal means such as phone ordering, aural similarity would play a greater role in assessing the likelihood of confusion, as compared to visual or conceptual similarity. On the other hand, for purchases made after physical inspection of the conflicting marks, such as via a website or from a physical store, the visual aspect would play a more important role in assessing the likelihood of confusion as compared to aural or conceptual similarity.

**(ii) Whether the products or services are expensive or inexpensive**

At the onset, it should be clear that the price of the type of goods or services is distinct from the issue of price parity between the parties' goods or services (see *Staywell* at [96(b)] and *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 at [108]). It is not the price that different traders set for the same category of goods or services due to the different marketing strategies adopted by the traders, but rather, the average price of a typical item or service from that category which is considered.

To illustrate, a car would generally be considered an expensive item while a piece of clothing would be relatively inexpensive, despite the fact that there can be luxury cars or high-end clothing as well as relatively cheaper ones. The superficial price disparity between the conflicting goods in the same category, which speaks more about the trader's marketing choices rather than differences in the nature of the goods themselves, is not a permissible factor in this inquiry (see *Reed Executive plc v Reed Business Information Ltd* [2003] RPC 12 at [103]).

In general, the purchase of an expensive item or service would point away from a likelihood of confusion due to the greater care that the average consumer would exercise in making such a purchase, provided the attention is directed towards the marks themselves (see *Caesarstone (CA)* at [81]). This means that consumers looking to procure expensive items or services are likely to accord more attention to ensure that they are indeed paying for what they get, which is by making sure that they are purchasing from the correct trade source. This is also based on the consideration that the average consumer is someone who would exercise some care and a measure of good sense in making his or her purchases, and not an unthinking person in a hurry (see *Hai Tong* at [40(c)]).

However, the above is premised on the assumption that the greater care exercised relates to the differences between the two competing marks. In the case of *Caesarstone (CA)* at [81], it was found that the consumers of tiles are likely to be indifferent towards the mark used in relation to the goods. Their focus tends to be on the price and attributes of the goods and the greater care exercised by the consumers



would relate to these attributes and not to the differences between the competing marks. Hence, in this case, while the purchase is considered to be expensive, it was at best a neutral factor in the assessment of likelihood of confusion.

**(iii) The nature of the goods or services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers**

The nature of the goods or services will also affect the degree of attention consumers pay when making purchasing decisions. For example, purchasers of pharmaceutical goods would generally pay greater care and attention to make sure they are buying from the correct trader, as compared to purchasers of household goods such as cloth wipes. Where the importance of purchasing from the intended trade source is highly desirable or critical, it can be reasonably inferred that the consumer will pay a greater degree of attention in the purchasing process, thereby reducing the likelihood of confusion.

**(iv) The likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase**

Generally, professionals in a particular field of trade would possess specialist knowledge of the goods or services in that industry. They would most likely come into contact with the goods or services provided under the conflicting marks on a frequent basis and would have developed a discerning eye for the various marks.

Their expertise in the trade origin of the goods or services in their fields may point away from a likelihood of confusion.

Once the examiner has, using the step-by-step approach, established similarities in the marks, similarities in the goods and/services and assessed that as a result there is a likelihood of confusion, a section 8(2)(b) objection will be raised.

## **5.5 Family of marks**

Where a number of similar marks in the same ownership incorporate an identical element as a family of marks and another party also applies for registration of a mark incorporating that element, the public may assume that the new mark originates from the same undertaking as an addition to the family of marks and be confused or deceived if that is not the case.

However, for the purposes of examination, the examiner will not assume that the mere fact that a search reveals a number of marks in the same ownership with common identical elements, means all the marks must be cited. To do so would be to assume in the prima facie that each and all of the marks are in use at the date of application and is known to the public hence resulting in confusion.

In other words, the registration of a number of marks sharing a common element by a single trader is not sufficient to establish that the average consumer would perceive this group of marks as being a family of marks. The proprietor has to provide evidence to prove that the average consumer readily associates marks sharing the common element as originating from the proprietor in order to establish that the marks are indeed perceived as a family of marks (see *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 (“*Deestone*”) at [39]).

In the case of *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10, the “IPAD” mark was found to be a member within Apple Inc.’s well known I-prefix family of marks (for example, IMAC and ITUNES), based on the evidence submitted.

## 6 CITING PRACTICES

As mentioned in Part 4 “Meaning of an earlier trade mark”, the examiner will conduct a search of the register for potential conflicting earlier trade mark(s).

The Registry’s citation practices in three particular situations are elaborated below:

### 6.1 Where the conflicting marks have the same filing date or priority date

If two or more applications for identical or similar marks and for the same or similar goods or services, have the same filing date or priority date, the Registrar will notify the owners of the marks of the potential conflict. This notification serves to inform the owners of the presence of the other mark(s) and the Registrar will not cite either mark against the other. If the either owner of these marks wishes to oppose the registration of the other mark, he may do so by filing a notice of opposition when the other mark is published in the Trade Marks Journal.

### 6.2 Where there is a conflicting mark but the applicant has an identical “earlier trade mark”

Where an applicant applying to register a trade mark has an earlier identical trade mark that is registered, the Registrar will not cite any conflicting mark filed during the period between these two applications’ filing/priority dates, provided that the following conditions are met:

- (i) The applicant’s earlier trade mark registration has an earlier filing/priority date than that of the conflicting mark(s);
- (ii) The applicant’s later trade mark application is filed in respect of goods and/or services that are protected by the applicant’s earlier trade mark registration; and
- (iii) The applicant’s earlier trade mark registration is not subject to any pending proceeding that may affect its validity.

In the following example, Trade Mark No. 2 will face a citation of Trade Mark No. 1, whereas Trade Mark No. 3 will not face a citation of Trade Mark No. 2 as the same applicant (ABC Company) has an earlier identical trade mark registration covering the goods applied for in Trade Mark No. 3.

	<b>Trade Mark No. 1</b>	<b>Trade Mark No. 2</b>	<b>Trade Mark No. 3</b>
<b>Applicant</b>	ABC Company	XYZ Company	ABC Company
<b>Filing date</b>	1 June 2017	1 August 2017	1 December 2017
<b>Mark</b>	MEZZEN	MEZZEN	MEZZEN
<b>Mark Status</b>	Registered	Pending (Under Examination)	Pending (Under Examination)
<b>Goods (Class 25)</b>	Clothing.	Shirts; trousers.	T-shirts; shirts; trousers; jeans.

However, if the goods and/or services applied for in a later trade mark application are broader than the scope of the goods and/or services covered by the applicant's earlier trade mark registration, the later application will face a citation for those goods and/or services that are not covered in the earlier registration.

	<b>Trade Mark No. 1</b>	<b>Trade Mark No. 2</b>	<b>Trade Mark No. 3</b>
<b>Applicant</b>	ABC Company	XYZ Company	ABC Company
<b>Filing date</b>	1 June 2017	1 August 2017	1 December 2017
<b>Mark</b>	MEZZEN	MEZZEN	MEZZEN
<b>Mark Status</b>	Registered	Pending (Under Examination)	Pending (Under Examination)
<b>Goods (Class 3)</b>	Hair care products.	<b>Fragrances.</b>	Hair care products; <b>Cologne; Perfumes.</b>

In the example above, Trade Mark No. 3 will face a citation of Trade Mark No. 2 in respect of "Cologne; Perfumes".

To overcome the objection, the applicant of Trade Mark No. 3 may choose to remove "Cologne; Perfumes" from the list of goods or obtain a letter of consent from XYZ Company. Please refer to Part 7 "Overcoming grounds of refusal under sections 8(1) and 8(2)" for more information.

### **6.3 Late recording of applications with earlier rights**

It is possible that an “earlier trade mark” may not have yet been recorded on the register when the Registrar conducts similar marks searches when examining a later application. This is likely to arise as a result of a priority claim on the later filed application, or due to the time lag in receiving and recording of an earlier trade mark that is filed via the Madrid Protocol at IPOS.

If the existence of another conflicting application with an earlier filing date or priority date is drawn to the attention of the Registrar, the Registrar may:

- (i) raise a late citation for the later application (if the later application is pending examination); or
- (ii) revoke the acceptance of the later application under section 16 of the Trade Marks Act (if the later application has been published but is pending registration).

## 7 OVERCOMING GROUNDS FOR REFUSAL UNDER SECTIONS 8(1) AND 8(2)

### 7.1 Methods that may overcome objections under section 8

The objection under section 8 may be overcome by the following methods:

#### 7.1.1 Removing the conflicting goods or services

Applications are often filed with wide specifications, over a number of classes and may include general terms which cover a wide range of goods and services. The applicant may not actually intend to trade in, or offer all the goods or services which might be covered by such wide terms and therefore may be able to limit the list of goods or services to cover only the intended activities.

##### 7.1.1.1 Positively limiting the goods or services of the application

The applicant may request an amendment under rule 22(1) of the Trade Marks Rules to limit the goods or services covered by the application so that it no longer covers goods or services which are similar to those of the cited application(s).

This may be done by deleting goods or services from the specification, or substituting a more specific list of the goods or services for which protection is required, or defining more specifically the purpose or nature of the goods or services.

Positively limiting the specification	Cited mark	Application mark	Proposed amendment
By deleting	Class 7: “agricultural elevators; crushing machines; cultivators; <del>spraying machines</del> ”	Class 7: “milling machines; mills; millstone; <del>spraying machines</del> ”	Class 7: “milling machines; mills; millstone; <del>spraying machines</del> ”
By substituting	Class 42: “computer system design; graphic arts design”	Class 42: “scientific and technological services and research and design relating thereto”	Class 42: “scientific research”
By defining specific purpose	Class 9: “computer software for use in financial transactions”	Class 9: “computer software”	Class 9: “computer software <u>for use in medical diagnosis</u> ”

### 7.1.1.2 Excluding the goods or services which are in conflict

The applicant may overcome a citation by amending the specification to exclude goods or services which are similar to the goods or services covered by the cited application or registration. Such exclusions or restrictions will usually be phrased as “excluding...”, “not including...” or “none being...” followed by the goods or services which would otherwise fall within the scope of the specification.

Exclusion should not be done in very general terms and the onus is on the applicant to clearly specify goods or services in the application which are not the same or similar to those of a cited trade mark. For example:

- Class 16: Articles of stationery, printed matter; all not including adhesives.
- Class 7: Washing machines and spin driers; none being for domestic use.

Further, a proposed amendment which seeks to exclude goods which are obviously not included in the specification will not be allowed. For example, “Eggs and cheese, but not including butter” is not allowed as butter is not included in the statement “eggs and cheese” and the exclusion is redundant.

An example where exclusions may assist in overcoming grounds for objection under sections 8(1) and 8(2):

Application in Class 12	Citation in Class 12	Proposed exclusion
Trishaws	Motor land vehicles	Trishaws <u>but not including</u> motorised trishaws vehicles

The proposed exclusions should distinguish the goods and/or services of the application from the cited mark. For example, the following exclusion is **not** allowed, since a transistor remains the same whether or not it is used in electronics or for other purposes. For example:

Application in Class 9	Citation in Class 9	Unsuitable exclusion
Electric transistors	Sound recordings and reproducing apparatus and parts and fittings therefor	Electric transistors <u>but not including</u> those for recording and reproducing apparatus

It should also be noted that it may not be possible to use an exclusion to overcome the citation if the cited mark covers a very wide scope of goods and services, for example:

<b>Application in Class 10</b>	<b>Citation in Class 10</b>
X-ray imaging apparatus.	Surgical, medical, dental and veterinary apparatus and instruments.

It is the applicant's responsibility to propose amendments which result in limiting the specification as only the applicant will know the exact area of business interest within which the trade mark is or will be used.

### **7.1.1.3 Withdrawing of class(es)**

In a multi-class application, a citation may be overcome by withdrawing the class(es) of the conflicting goods and/or services. If the application has no other outstanding objection, the remaining class(es) of the application will proceed to be accepted for publication.

<b>Application</b>	<b>Citation</b>	<b>To overcome the citation</b>
Class 16 Pen.  Class 25 Clothing.	Class 16 Stationery.	Withdraw Class 16 from the application such that only Class 25 remains in the application.

## **7.1.2 Obtaining consent from the proprietor of the cited mark**

### **7.1.2.1 Letter of consent**

Under section 8(9) of the Trade Marks Act, the Registrar may, in his discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

An applicant may overcome a citation by obtaining consent in the form of a consent letter from the cited mark proprietor consenting to the registration (and not just use) of the mark.

Letters of consent should not contain any conditions, since the Registrar is not in a position to ensure that any condition about the use of the trade mark is met.



The letter of consent must include the following details:

- (a) Details of the subject application:
  - 1. Application number
  - 2. Representation of the trade mark
  - 3. The specification of goods and/or services to which the cited mark proprietor is consenting for registration.
    - If the consented specification of goods and/or services is narrower than that required to withdraw the citation, the specification of the subject application should be amended to reflect only those goods or services to which the consent applies.
- (b) Details of the cited trade mark:
  - 1. Application number
  - 2. Representation of the trade mark
- (c) Other content:
  - 1. A statement unequivocally indicating that consent to the registration of the mark is given.
  - 2. The name, designation and signature of the signatory must be indicated.
  - 3. The signatory must be the proprietor of the cited mark or a person authorised to sign on behalf of the cited mark proprietor.
  - 4. The letter of consent must be dated.

A sample letter of consent can be found on IPOS website.

Upon the Registrar's acceptance of the letter of consent, a clause will be endorsed in the subject application using the following formats:

- *"By consent of the registered proprietor of TM No. T1498765A."*  
(where the cited mark is a registered trade mark)
- *"By consent of the applicant of TM No. T1398765A."*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the letter of consent furnished, the objection will be maintained.

#### **7.1.2.2 Consent between companies in the same parent ownership**

A general letter of consent may be provided between two companies in the same parent ownership setting out the relationship between the two companies and confirming that they are prepared to consent to any trade mark applications made by the other party.

On each occasion that a copy of the general letter of consent is filed, the applicant must supply a cover letter stating that the general consent is still valid and in force at the relevant time.

Upon the Registrar's acceptance of the general letter of consent, a clause will be endorsed in the subject application using the following formats:

- *"By consent of the registered proprietor of TM No. T1498765A."*  
(where the cited mark is a registered trade mark)
- *"By consent of the applicant of TM No. T1398765A."*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the general letter of consent or consent agreement, the objection will be maintained.

#### **7.1.2.3 Agreement between two companies to consent to the registration of each other's marks**

A general agreement to consent to the registration of each other's trade mark applications may exist between companies which may not be in the same ownership.

The agreement should include the following:

- the agreement relates to the registration of the mark and not just its use;
- the consent covers registration in Singapore;
- the agreement relates to the mark applied for (the application number or the representation of the trade mark is sufficient);
- the consent covers the goods and/or services applied for; and
- the consent is not conditional, or if conditional, that any such conditions for giving consent are satisfied.

Any general agreement to consent must be valid and in force at the relevant time.

Upon the Registrar's acceptance of the agreement, a clause will be endorsed in the subject application using the following formats:

- *"By consent of the registered proprietor of TM No. T1498765A."*  
(where the cited mark is a registered trade mark)
- *"By consent of the applicant of TM No. T1398765A."*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the general consent agreement furnished, the objection will be maintained.

### **7.1.3 Where the earlier mark belongs to the applicant but IPOS' records do not indicate as such**

The cited earlier mark may belong to the same applicant in the following scenarios but IPOS records do not indicate as such:

**(i) The applicant has changed its name**

The applicant has changed its legal name but IPOS' records of the applicant's earlier mark still indicate the mark under the applicant's former name. As the legal entity remains the same, the applicant should update IPOS' records by filing Form CM2 to update the applicant's name for the earlier mark.

**(ii) The earlier mark has been assigned to the applicant**

Where the earlier mark has been assigned to the applicant but the assignment was not recorded at IPOS, the applicant should update IPOS' records by filing Form CM8 to record the transfer of ownership. Please refer to the Trade Marks Work Manual's chapter on "Assignment" for more information.

### **7.1.4 Division of the application**

Where the section 8 objection does not apply to all the goods and/or services in the application, the applicant may choose to divide the application into two applications, one containing all of the conflicting goods and/or services and another containing only the non-conflicting goods and/or services.

This places the conflicting goods and/or services in a separate application in which the applicant is required to respond to the section 8 objection. The benefit of division would be that the divided application in respect of the non-conflicting goods and/or services will proceed to be accepted for publication if there are no other outstanding objections.

The request for the division of the application may be done by filing Form TM8 for national applications, or Form MM22 for international registrations.

### **7.1.5 Awaiting the expiry of the cited mark**

A trade mark is registered for a period of ten years from the date of registration. Registration may be renewed at the request of the proprietor for further periods of ten years. If a registered trade mark is not renewed within the prescribed period, it will be removed from the Trade Mark Register and will no longer be a valid citation against marks with later filing date.

For more information on citation of expired and removed marks, please refer to our Trade Marks Work Manual chapter on "Renewal".

### 7.1.6 File evidence to indicate honest concurrent use

In certain circumstances, to overcome a citation, an applicant can file evidence to show to the satisfaction of the Registrar that there has been “honest concurrent use” in the course of trade in Singapore of the subject application with the cited mark.

#### 7.1.6.1 Assessing whether honest concurrent use is made out

##### Was the use “honest”?

It is essential that the concurrent use be honest. The applicant bears the responsibility of establishing that he has been honest in his use of the trade mark.

Depending on the facts of the case, concurrent registration may not be granted to an applicant who wholly reproduced the cited mark as his own trade mark, or adopted the mark knowing that it is very similar to the cited mark and persisted in doing so.

It is to be borne in mind that knowledge of the cited mark does not automatically mean that the applicant was dishonest in use of his trade mark. As long as there is no reason to doubt the honesty of the applicant, a statement within the statutory declaration giving a satisfactory account of the adoption of the trade mark is sufficient proof of honesty.

##### How long must the honest concurrent use be for?

The length of time of honest concurrent use indicates how long the consumers have been exposed to both the applicant’s trade mark and the cited mark in the marketplace. Therefore, the longer the use and exposure, the stronger the applicant’s case will be.

While there is no specific law setting a minimum time frame, in practice, the applicant should show honest concurrent use of at least 5 years before the date of application of his trade mark.

Use after the date of application will not assist in overcoming the objection.

Honest concurrent use over a shorter period of time may still be persuasive if there is extensive use of the applicant’s trade mark.

##### What is the scope of the use?

The exhibits must show use of the applicant’s trade mark in respect of the goods or services (whichever applicable) which are in conflict with the goods or services of the cited proprietor.

Exhibits showing use of the applicant’s trade mark on goods or services which are not in conflict will not assist in overcoming the objection.

*Is it necessary to show that there are no instances of actual confusion?*

It is not necessary to show that there are no instances of actual confusion in the marketplace as to the origin of the applicant's goods or services as a result of the overlap of the applicant's trade mark with the cited mark.

In any case, whether there were instances of actual confusion would be alleged by an opponent in opposition or infringement proceedings, and not in the examination of the application.

**7.1.6.2 Establishing honest concurrent use**

To establish "honest concurrent use", the applicant should file evidence showing that his use of the trade mark is in accordance with honest practices in industrial or commercial matters.

The evidence should as far as possible include the following:

- The date of first use of the trade mark (prior to date of application) in Singapore;
- Evidence showing the extent of use of the trade mark on the goods and/or services applied for, i.e. the length of use of the trade mark in Singapore, the volume of goods sold or services offered etc.;
- The period of concurrent use of the trade mark with the cited mark;
- Evidence of use of the trade mark overlapping with the use of the cited mark;
- Sales turnover pertaining to the goods and/or services claimed for;
- Advertising and promotional expenses pertaining to the goods and/or services claimed for;
- Opinion polls, statements from industry players, surveys (e.g. market surveys on end-consumers, or trade surveys on industry players);
- An explanation of how the applicant came to adopt the trade mark;
- Whether the applicant was aware of the existence of the cited mark;
- Whether the applicant genuinely believed that the use of his trade mark would not cause confusion in the public;
- Information about any actual instances of confusion that the applicant is aware of having occurred between its mark and the cited mark.

**7.1.6.3 Form of evidence of honest concurrent use**

Evidence must be presented in the form of a Statutory Declaration.

The declaration should, preferably, be typed. Further, the declaration and any exhibits must be sworn before a person authorised to administer oaths, such as a commissioner for oaths or notary public.

Please refer to Appendix 2 of our Trade Marks Work Manual chapter on “Evidence of distinctiveness acquired through use” for more information about preparing a Statutory Declaration.

#### **7.1.6.4 Evidence of honest concurrent use is satisfactory**

If the Registrar is satisfied that the evidence has established honest concurrent use, the Registrar will accept the trade mark for publication.

An endorsement in the following terms will be entered at acceptance:

- *“Proceeding under honest concurrent use with trade mark registration number T1498765A.”*
- *“Proceeding under honest concurrent use with trade mark application number T1398765A.”*

However, even though the trade mark is accepted for publication in the Trade Marks Journal, the proprietor of any earlier mark (including the proprietor of the cited mark) still has the right to oppose the registration of the trade mark. Acceptance by the Registrar of the trade mark on the basis of honest concurrent use therefore does not guarantee registration.

#### **7.1.7 Other methods which may overcome the citation(s)**

An applicant whose trade mark application faces a citation under section 8 may negotiate with the cited mark proprietor. Since the potential for negotiation can only be assessed by the applicant, the Registrar will not propose this course of action. The outcome of such negotiation may be one of the following:

##### **(i) Amendment of the specification of the cited mark**

The applicant may seek to negotiate with the owner of the cited trade mark to amend the specification of the cited mark to remove any conflicting goods and/or services. The cited mark’s owner is required to effect the amendment of the specification via:

- Form TM27 if the cited mark is pending; or
- Form CM3 if the cited mark is registered.

Any amendment to the specification of the cited mark must be clear and unambiguous.

##### **(ii) Cancellation of the cited mark’s registration**

The cited mark's proprietor may voluntarily cancel the registration of his trade mark under section 21 by filing Form CM3.

**(iii) Assignment of the application or the cited mark to the same entity**

The section 8 objection may be waived if the owners of the application and the cited trade mark come to an agreement where the trade marks are assigned to a single entity. The transfer of ownership shall be recorded by filing Form CM8.

**7.1.8 Initiating proceedings against the cited mark**

In certain circumstances, the applicant may consider exploring the option of initiating proceedings against the cited mark in order to overcome the citation. Legal advice should be sought in this regard.

**7.2 Methods that cannot overcome objections under section 8**

The following methods will not overcome the objection under section 8:

**7.2.1 Amending the representation of the subject mark**

The mark representation cannot be amended to remove or change the element(s) that is similar to the cited mark in order to overcome the section 8 objection.

As a matter of general practice, the examiner takes a very strict approach to amendments of mark representation given that section 14 of the Trade Marks Act does not permit amendments to a trade mark application except under very limited circumstances.

**7.2.2 Where the cited mark's proprietor is a corporate entity, evidence of its dissolution or non-existence**

Evidence of the dissolution of a cited mark proprietor, or that it no longer exists, assuming it is a corporate entity is not sufficient to overcome a citation.

This is because it is not clear how the assets of the cited mark's proprietor (including the cited mark) has been disposed of. Until there are any changes made by the cited mark proprietor to the registration of the cited mark, the cited mark remains a valid registration and continues to enjoy the rights conferred upon it.

**7.2.3 Written submissions**

The applicant may present written submissions for the Registrar to reconsider the section 8 objection.

Given that each trade mark application is considered on its own merits based on the facts of each case, the following arguments have limited persuasive value:

### **7.2.3.1 Co-existence of other marks on the trade marks register**

Simply because there are other similar marks which co-exist with the cited mark on the trade marks register does not automatically mean that subject application should therefore also be allowed to co-exist.

This is especially so if these other marks are not analogous to the subject application.

In any case, there could be specific reasons why those other marks co-exist and these reasons may not apply to the subject application.

Decisions made by the Registrar in previous cases can do no more than give an indication of what has or has not been thought acceptable at that time, and are not binding on the present case (see *Marvelous AQL Inc.* [2017] SGIPOS 3 at [45]).

### **7.2.3.2 Co-existence of the subject mark and the cited mark in overseas trade mark registers**

Given that the protection of trade marks is territorial, the co-existence of the subject mark and the cited mark(s) in trade mark registers of other countries is of limited persuasive value as the circumstances of the co-existence of the marks in overseas markets are not known and may not apply to the Singapore market.

### **7.2.3.3 Global appreciation approach**

The argument that the marks should be compared using the global appreciation approach, instead of the step-by-step approach, has been rejected by the Court of Appeal in *Staywell*.

As stated in Part 5.1 above, the approach adopted in Singapore is the step-by-step approach. The Court of Appeal stated in *Staywell* (at [15]):

Since this court’s decision in *Polo (CA)*, our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (“*Sabel v Puma*”). Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round. Under the global appreciation approach the elements of similarity between marks and goods or services, whilst still necessary ingredients in the confusion inquiry, are elided with other factors going towards the ultimate question of whether there is a likelihood of confusion (see *Sabel v Puma* at 223–224, and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC



117 at 132). Whilst there have been suggestions that the two approaches might be distinct without being different, *we maintain this dichotomy and endorse the step-by-step approach as being conceptually neater and more systematic and, importantly, as being more aligned with the requirements imposed under our statute* (see *Polo (CA)*) at [8]).

[emphasis added]

#### **7.2.3.4 Alleging that the cited proprietor uses (or intends to use) the mark only in respect of some goods/services, industries, or groups of consumers etc.**

Registration confers on the proprietor the exclusive right to use the mark in respect of all the goods and services registered. In the course of examination, the Registrar will consider the full range of goods and services of the earlier mark against the full range of goods and services in the subject application. Therefore, the argument that the cited mark's proprietor uses the mark in respect of only some, and not all, of the goods and services registered is irrelevant.

It should be noted that the full range of notional and fair use of both the subject mark and the cited mark is considered in examination and opposition proceedings.

Notional and fair use refers to use of the trade mark across the range of goods and services claimed *in any way* that would be considered to be normal use in relation to the goods and services, without having regard to its actual use and market circumstances such as how the proprietor markets the goods and services. This means that conflict may be found even though the proprietor markets his goods and services only for a certain industry or a particular group of consumers.

#### **7.2.3.5 Opportunity for the cited mark's proprietor to oppose the subject mark during publication**

The mere fact that the cited mark's proprietor has the opportunity to oppose to the registration of the subject mark during publication is not a valid reason to request for an objection under section 8 to be waived. There is no legislative provision that allows for a citation to be overcome based on such argument.

#### **7.2.3.6 Prior use**

Submissions from the applicant claiming that he has used his mark prior to the filing date or priority date of a cited mark do not serve as a valid reason to overcome the citation. The applicant will need to establish that he has an earlier right by bringing proceedings against the cited mark. The applicant may seek legal advice on the filing of such proceedings.

## **SERIES OF MARKS**

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**SERIES OF MARKS**

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## **1. Introduction**

This chapter deals with the grounds for registration of marks which constitute a series.

## **2. Relevant legislation**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Registration of series of trade marks**

**17.**—(1) A person may make a single application under section 5 for the registration of a series of trade marks.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act and the Registrar is required under section 15 to register the trade marks, he shall register them as a series in one registration.

### **Trade Marks Rules**

#### **Irregularities**

**83.** Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct.

### 3. **General requirements of a series**

To qualify as a series of trade marks, the following requirements must be satisfied:

- (a) **Each mark in the series must resemble each of the others in the series in their material particulars, that is, the main features in each of the trade mark must be essentially the same.**
- (b) **The differences between the marks must comprise only matters which, when considered as a separate element of the mark, be non-distinctive in nature.**
- (c) **The differences between the trade marks must not comprise matters which, in the context of the trade mark as a whole, substantially affect the identity of the trade marks.**
  - (i) This is the over-riding requirement – the differences between the marks must not substantially affect their identity. The test is **not** merely whether the marks in the series would be regarded as **confusingly similar** to each other if used by unrelated undertakings. Even if the marks are confusingly similar, the marks may still not qualify as a series.
  - (ii) Any variation in the non-distinctive features in the marks must leave the **visual, phonetic and conceptual identity** of each of the trade marks substantially the same. Even if the marks are conceptually similar, they will not constitute a series if there are substantial differences in the visual or aural identities of the marks.
  - (iii) The assessment of whether the identity of the marks is substantially affected is based on the likely reaction to the marks of an average consumer of the goods/services in question.

(See [Logica Plc's Application \(UK Decision of Appointed Person in Case O-068-03\)](#)).

#### **4. Application of principles to different types of marks**

##### **4.1. Upper and lower case presentation**

In order to be acceptable as a series, the differences in upper and lower case of the words must not result in the marks being perceived or pronounced differently.

**CHERRY**  
**Cherry**

##### *Example 4.1.1*

In Example 4.1.1 above, the series of two marks are acceptable as the difference in the letter case does not alter the pronunciation and meaning of the marks. The identity of the marks remains the same word “Cherry”.

**MYSTORE**  
**MyStore**  
**Mystore**  
**MystOre**

##### *Example 4.1.2*

In Example 4.1.2 above, the series of four marks are not acceptable as a series. The first three marks are clearly interpreted as combinations of two common English words “My” and “Store”. As the average consumer will read these three marks as “My” and “Store” regardless of the difference in letter case, the visual, aural and conceptual identities of the three marks are substantially the same. However, for the fourth mark, it is not immediately apparent that this mark would be interpreted as a combination of “My” and “Store” without a side-by-side comparison with the first three marks. Due to the upper case in the letter “O” in the fourth mark, this mark may instead be interpreted as a coined term made up of “Myst” and “Ore”. Hence, the identity of the fourth mark is substantially different from that of the first three marks. The fourth mark would therefore not form a series with the first three marks. However, if the first three marks are filed as a series of three marks, they would be acceptable as a series.

**SWEETORANGE**  
**SweetoRange**

##### *Example 4.1.3*

In Example 4.1.3 above, the two marks do not qualify as a series. The first mark may logically be interpreted as a combination of the English words “SWEET” and “ORANGE”, but the second mark could appear to be an invented term comprising “Sweeto” and “Range”. As the difference in letter case in the second mark is likely to render a different pronunciation and conceptual interpretation from the first mark, the two marks are not acceptable as a series.

**ImGold**  
**IMGOLD**

*Example 4.1.4*

In Example 4.1.4 above, the two marks do not qualify as a series. Due to the upper case in the letter “G” in the first mark, this mark is clearly dissected into an invented term “Im” and the dictionary word “Gold”. However, as all the letters in the second mark are in upper case, it is not immediately apparent that this mark is made up of “Im” and “Gold”. Instead, the second mark appears to comprise a single invented word “IMGOLD”. Given that there are differences in the visual, aural and conceptual identities of the marks, the two marks are not acceptable as a series.

#### **4.2. Conjoining words**

Mark(s) consisting of two or more words separated by spacing, and another mark consisting of the same words conjoined into a single term may form a series if:

- (a) the marks are composed of two or more common English words, **and**
- (b) in the separated and conjoined versions, the pronunciation and meaning of the marks remain the same regardless of the placement of the spacing.

**CHERRYTREE**  
**CHERRY TREE**

*Example 4.2.1*

In Example 4.2.1 above, the two marks are acceptable as a series. The marks are composed of two common English words “CHERRY” and “TREE”, and the pronunciation and meaning of the marks remain the same regardless of the presence of the spacing in the second mark in the series. There is also no substantial difference in the visual identity of the marks. Hence, the two marks would qualify as a series.

**GOODSIT**  
**GOODS IT**

*Example 4.2.2*

In Example 4.2.2 above, the two marks are not acceptable as a series. The first mark may be interpreted as “GOODSIT”, “GOODS IT” or “GOOD SIT”, depending on how the average consumer perceives the conjoined term. The second mark would only be interpreted as “GOODS IT” due to the placement of the spacing. Given that there are multiple ways to interpret the first mark whereas there is only one way to interpret the second mark, the pronunciation and conceptual idea of the first mark may differ from the second mark. Hence, the two marks do not qualify as a series.



**Q WIN**  
**QWIN**

*Example 4.2.3*

In Example 4.2.3 above, the two marks are not acceptable as a series. The first mark would be seen as comprising the letter “Q” and the word “WIN”, whereas the second mark may be interpreted in multiple ways, i.e. as a single coined term “QWIN” (similar pronunciation as “queen”) or as a combination of the letter “Q” and the word “WIN”. Without the benefit of a side-by-side comparison with the first mark, the second mark is open to different interpretations. Therefore, the two marks do not qualify as a series.

**NARA**  
**BOKU**

**NARA BOKU**

**NARABOKU**

*Example 4.2.4*

In Example 4.2.4 above, the three marks are not acceptable as a series. The textual element in the first and second marks is dissected into two separate words, “NARA” and “BOKU”, whereas the textual element in the third mark is a single coined word “NARABOKU”. As the terms “NARA” and “BOKU” are not common English words, without a side-by-side comparison with the first and second marks, it is not clear that the third mark is intended to be broken into two terms “NARA” and “BOKU”. Consequently, the difference in the positioning of the textual element in the marks may cause the marks to be interpreted differently. The three marks therefore do not qualify as a series. However, if the first two marks are filed as a series of two marks, they would be acceptable as a series.

### **4.3. Spelling**

#### **4.3.1. American and British spelling**

Differences in the same word(s) due to the American or British spelling of the word(s) are generally acceptable, provided that there is no substantial difference in the visual, aural and conceptual identities of the marks in the series, as shown in the following examples:

**PAUL’S CENTER**  
**PAUL’S CENTRE**

*Example 4.3.1.1*

**ABC JEWELRY**  
**ABC JEWELLERY**

*Example 4.3.1.2*

4.3.2. **Misspelling**

If the differences in spelling change the visual, aural or conceptual identities of the marks in the series, the marks may not constitute a series.

**EXOTEK**  
**EXOTEC**

*Example 4.3.2.1*

In Example 4.3.2.1 above, the two marks are not acceptable as a series. The marks “EXOTEK” and “EXOTEC” are coined or invented words with separate identities, even though they may be pronounced in the same way. The use of the letters “K” and “C” in the first and second marks respectively also results in a substantial visual difference between the two marks. Hence, the two marks do not qualify as a series.

**ALL 4 YOU**  
**ALL FOR YOU**

*Example 4.3.2.2*

The two marks in Example 4.3.2.2 above are not acceptable as a series. The numeral “4” is not a conventional and grammatically-correct replacement for the English word “for”, and therefore the misspelling results in substantial visual and conceptual differences between the first and second marks.

**4.4. Punctuation**

Punctuation is used to create sense, clarity and stress in sentences. Punctuation marks are used to structure and organise a phrase or sentence. Where the marks in a series differ as to their punctuation, the series is acceptable provided that the punctuation does not substantially alter the visual, aural and conceptual identities of the marks. Otherwise, the marks would not qualify as a series.

The following examples are acceptable series of marks despite the inclusion or alteration of the punctuation marks:

**TRICK N TREAT**  
**TRICK 'N' TREAT**  
**TRICK-N-TREAT**

*Example 4.4.1*

In Example 4.4.1 above, the three marks are acceptable as a series, as the marks would be interpreted as a phrase made up of the terms “TRICK”, “N” and “TREAT”. The addition of the apostrophes and hyphens in the second and third marks in the series does not substantially affect how the three marks would be interpreted. The three marks in the series would be pronounced in the same way, and there is no substantial difference in the visual identity of the marks. Therefore, the three marks qualify as a series.

**UKNY**  
**U.K.N.Y**

*Example 4.4.2*

In Example 4.4.2 above, the two marks are acceptable as a series. Regardless of the presence of the full stops in the second mark in the series, the two marks would both be interpreted as the same abbreviation comprising the letters “U”, “K”, “N” and “Y”. Hence, the two marks qualify as a series.

On the other hand, if the addition or removal of punctuation marks causes the marks to differ visually, phonetically or conceptually, the marks will not be acceptable as a series. The following marks are not acceptable as a series.

**ESCAPE**  
**E’SCAPE**

*Example 4.4.3*

In Example 4.4.3 above, the first mark will be seen and pronounced as the English word “ESCAPE”. However, the introduction of an apostrophe to the second mark serves to ‘divide’ the mark and changes the identity of the mark to “E” and “SCAPE”. The two marks will therefore not qualify as a series.

**RHop**  
**RHop!**

*Example 4.4.4*

In Example 4.4.4 above, the two marks are visually and conceptually different due to the addition of the exclamation mark to the second mark. The exclamation mark contributes an expression of surprise or excitement, which is not present in the first mark. Therefore, the marks do not qualify as a series.

**Create. Innovate. Design.  
Create Innovate Design**

*Example 4.4.5*

In Example 4.4.5 above, the punctuation affects the interpretation of the phrases. The addition of the full stops in the first mark breaks it up into three separate sentences. The second mark, without any punctuation, will be interpreted as an ungrammatical phrase. Consequently, the two marks have different conceptual identities and do not qualify as a series.

#### **4.5. Symbols and special characters**

Where the marks in a series contain symbol(s) or special character(s), the series of marks are acceptable provided that the symbol or special character does not substantially alter the visual, aural and conceptual identities of the marks. Otherwise, the marks would not qualify as a series.

**Williams and Smith  
Williams & Smith**

*Example 4.5.1*

In Example 4.5.1 above, the two marks are acceptable as a series. The ampersand is a conventional symbol that is commonly used in place of the word “and”. The substitution of the word “and” with an ampersand symbol in the second mark thus does not substantially alter the meaning of the two marks. Hence, the two marks qualify as a series.

The substitution of letters with special characters in a series of marks is generally not acceptable, unless the special characters do not substantially alter the visual, aural and conceptual identities of the marks.

**IPOS Café  
IPOS Cafe**

*Example 4.5.2*

In Example 4.5.2 above, the two marks are acceptable as a series. The difference in the two marks lies in the words “Café” and “Cafe”. English dictionaries show that the two words are used interchangeably. Hence, the special character “é” in the first mark does not render the visual, aural and conceptual identities of the first mark different from that of the second mark. The marks therefore qualify as a series of two marks.

**ADIDE  
ADIDÉ**

*Example 4.5.3*

In Example 4.5.3 above, the two marks are not acceptable as a series. The words “ADIDE” and “ADIDÉ” are coined terms with no meaning. Unlike in the previous Example 4.5.2, the

substitution of the letter “E” with the accented letter “É” in this case is not acceptable. As the average consumer in Singapore generally understands that certain foreign languages (such as French) contain words with accented letters, he/she may infer that the second mark is a foreign word due to the accented letter “É” in the second mark. Given that the presence of the accented letter “É” in the second mark may result in different interpretations of the two marks, the two marks have different identities and do not qualify as a series.

**IPOS CAFE**  
**IPOS C@FE**

*Example 4.5.4*

The two marks in Example 4.5.4 above are not acceptable as a series. The substitution of the letter “A” with the symbol “@” in the second mark is not acceptable, as the symbol “@” is normally pronounced as “at” and is not a conventional symbol for the letter “A”, in the manner that the ampersand is a conventional symbol for “and”. Hence, the two marks have different visual, aural and conceptual identities. The marks therefore do not qualify as a series of two marks.

**RHop**  
**#RHop**

*Example 4.5.5*

In Example 4.5.5 above, the two marks are not acceptable as a series. The first mark is a word whereas the second mark, with the addition of a hash sign “#”, will be interpreted as a hashtag. A hashtag is used to classify or categorise the word or phrase following the hash sign, or identify a keyword or topic of interest and facilitate a search for it. The hash sign “#”, although lacking in distinctive character, changes the identity of the second mark from a word to that of a hashtag. Hence, the second mark is conceptually different from the first mark, and the two marks do not qualify as a series.

## **4.6. Stylisation**

Variations in stylisation should be minimal and of a non-distinctive nature such that the differences do not substantially affect the identities of the marks in the series.

### **4.6.1. Conventional fonts**

For marks containing textual elements, the same word(s) in different scripts or fonts are acceptable as a series if the scripts or fonts are conventional and not fancifully stylised.

**BLACK KNIGHT BAR**  
***BLACK KNIGHT BAR***  
**BLACK KNIGHT BAR**  
**BLACK KNIGHT BAR**

*Example 4.6.1.1*

In Example 4.6.1.1 above, the four marks are acceptable as a series. The different fonts depicted above are conventional scripts that are not stylised in a fanciful manner. The difference in the fonts is considered non-distinctive as it does not substantially affect the identity of the marks. Therefore, the marks qualify as a series of four marks.

#### 4.6.2. **Fanciful stylisation**

A word mark which contains stylised letter(s) may be acceptable in a series, provided that the stylisation of the letters is not overly fanciful and does not render the mark(s) to be substantially different in identity from the other mark(s) in the series.

SEESAW  
SEESAW

##### *Example 4.6.2.1*

In Example 4.6.2.1 above, the two marks are acceptable as a series. The stylisation of the letter “S” in the second mark in the series is simple and does not substantially affect the identity of the mark. The marks therefore qualify as a series of two marks.

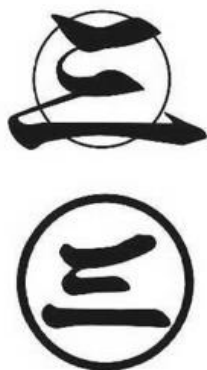
Where the stylisation is fanciful and results in a substantial visual, aural, or conceptual change in any of the marks, the marks will not be acceptable as a series.

I P O S  
I ? O S

##### *Example 4.6.2.2*

In Example 4.6.2.2 above, the first mark has all the letters “IPOS” in the same conventional font, whereas the second mark contains a stylised “P” in the shape of a light bulb with the other letters “I”, “O” and “S” depicted in plain font. The stylised “P” in the second mark renders it visually and conceptually different from the first mark. As such, the marks are not acceptable as a series.

For device marks, slight differences in the stylisation would generally render them unacceptable as a series.

*Example 4.6.2.3*

In Example 4.6.2.3 above, the difference in the stylisation of the two marks creates a very different visual impact. Hence, the two marks do not qualify as a series.

#### 4.6.3. Addition of device element

The addition of a device element to a word mark almost always substantially affects the identity of the mark and would therefore render the marks unacceptable as a series. However, a plain conventional embellishment, such as the addition of a line or a simple border, contributes nothing of a distinctive nature to the trade mark as a whole. Such embellishments are generally acceptable since they contribute no significant difference to a mark. This principle is demonstrated in the examples below.

**Bellson**

**Bellson**

*Example 4.6.3.1*

***Trafwicbook***

**Trafwicbook**

*Example 4.6.3.2*

#### 4.7. Positioning of elements

In order to qualify as a series, differences in the positioning of the elements in the marks must not substantially affect the overall identity of the series of marks.



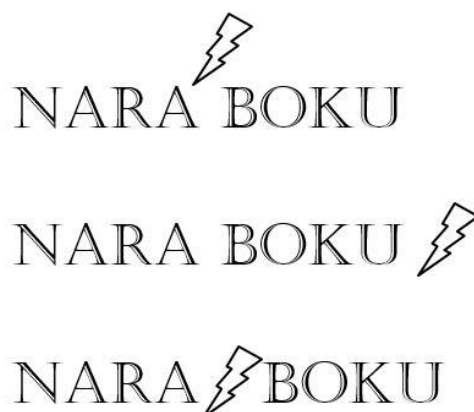
***Live for Real!***

*Example 4.7.1*

In Example 4.7.1 above, the two marks are acceptable as a series. Despite the differences in their respective layouts, the marks share the same visual, aural and conceptual identities. As such, the marks qualify as a series of two marks.

If the difference in the positioning of the elements results in visual, aural or conceptual dissimilarities which substantially affect the identities of the marks, the marks will not be acceptable as a series.

#### 4.7.1. **Positioning of elements in marks containing meaningless terms**



##### ***Example 4.7.1.1***

In Example 4.7.1.1 above, the three marks are acceptable as a series. The first and second marks in the series will be read as individual words “NARA” and “BOKU” due to the spacing in between the words. Similarly, the device element in the third mark in the series separates the textual elements such that the mark is also pronounced as “NARA” and “BOKU”. The positioning of the device element in the third mark does not substantially alter the visual, aural and conceptual identities of the three marks. Hence, the three marks qualify as a series.

#### 4.7.2. **Positioning of elements in marks with meaning**



##### ***Example 4.7.2.1***

In Example 4.7.2.1 above, the three marks do not qualify as a series. The first and second marks will be interpreted as “WE FOOD” with a heart device. However, due to the positioning of the heart device between the two words “WE” and “FOOD” in the third mark, the average consumer may also interpret this mark as “WE LOVE FOOD”, as the heart device may connote the meaning “love”. Therefore, there is an additional way to interpret the third mark as



compared to the first and second marks. Hence, the identity of the third mark is substantially different from the first and second marks, and it does not qualify as a series with the first two marks. Only the first and second marks are acceptable as a series of two marks.

#### 4.8. Prominence of elements

Increasing the prominence of one or more elements in the mark over others, where it does not significantly affect the visual, aural and conceptual identities of the marks, is acceptable in a series.



*Example 4.8.1*

In Example 4.8.1 above, the three marks are acceptable as a series. As the word and device elements are equally distinctive in the three marks, the difference in the size of the word and device elements does not significantly affect the visual, aural and conceptual identities of the marks. Hence, the three marks qualify as a series.

**ZAAR'S CAKES**  
**ZAAR'S** CAKES

*Example 4.8.2*

In Example 4.8.2 above, the two marks are acceptable as a series. The distinctive element in the two marks is the word "ZAAR'S". Hence, the difference in the size of the word "CAKES" in the second mark in the series does not contribute to a conceptual difference in the marks. Both marks would be interpreted as "cakes from the brand or person named Zaar". Given that there is no substantial difference in the visual, aural and conceptual identities of the marks, the two marks qualify as a series.

If the difference in the prominence of the elements results in visual, aural or conceptual dissimilarities which substantially affect the identities of the marks, the marks will not be acceptable as a series.

**THE COOK HOUSE**  
 THE **COOK** HOUSE  
**THE** COOK **HOUSE**

*Example 4.8.3*

In Example 4.8.3 above, the three marks are not acceptable as a series. The three words “THE COOK HOUSE” in the first mark are of equal size and the mark would only be read as the phrase “THE COOK HOUSE”. However, the relatively larger size of the word “COOK” in the second mark and the words “THE HOUSE” in the third mark gives visual emphasis to these words. Generally, the average consumer has a natural tendency to first focus on the most prominent element(s) in a mark. Therefore, he/she will be drawn to look at “COOK” first followed by “THE HOUSE” in the second mark, and “THE HOUSE” first followed by “COOK” in the third mark. Hence, in addition to interpreting the second and third marks as a single phrase “THE COOK HOUSE”, they may also be interpreted as “COOK” and “THE HOUSE” separately. There are additional ways to interpret the second and third marks as compared to the first mark. As a result, the three marks do not qualify as a series due to the significant differences in the visual and conceptual identities of all three marks.

#### **4.9. Colour**

Differences in colour in the elements of the marks are acceptable in a series only if the colours do not substantially affect the identities of the marks.

The criterion for marks to be acceptable as a series is not about the size of the element in which the colour difference lies, or whether the marks would be seen as pointing to the same trade source. Even if the colour difference lies within a minor portion of the marks or if it is clear that the marks belong to the same trade source, the marks may still be found to be unacceptable as a series if there are substantial differences in the identities of the marks. This is explained further in the following sections.

##### **4.9.1. Colour difference in word marks**

Generally, for word marks in a series, the distinctive feature lies mainly within the meaning of the word(s). The aural and conceptual identities of the word marks play a more important role than their visual identity. If the colour difference does not change the way the word(s) in the marks in a series are read or interpreted, the marks would be acceptable as a series.

***HIP ALLIANCE***  
***HIP ALLIANCE***

*Example 4.9.1.1*

In Example 4.9.1.1 above, the two marks are acceptable as a series. Although the second mark in the series is in orange, the difference in the colour of the textual element does not substantially affect the visual impact of the marks as both marks are presented in a single colour. Moreover, in this case, colour is a subordinate and non-distinctive feature of the marks. The difference in the colour of the textual element therefore does not substantially affect the identities of the marks. Consequently, the two marks qualify as a series.

IPPZ  
 IPPZ  
 IPPZ  
 IPPZ  
 IPPZ

*Example 4.9.1.2*

In Example 4.9.1.2 above, the five marks are also acceptable as a series. The difference in the colour of the letters does not change the way the marks are interpreted. The five marks are all pronounced as “I-P-P-Z”, and the textual element “IPPZ” is meaningless. The five marks therefore qualify as a series.



*Example 4.9.1.3*

In Example 4.9.1.3 above, the three marks are not acceptable as a series even though the marks appear to point to the same trade source, “The Goodsit Company”. The dominant textual element “GOODSIT” in the first mark may be interpreted as “GOODSIT”, “GOODS IT” or “GOOD SIT”, depending on how the average consumer perceives the conjoined term. However, the colour contrast in the second and third marks dissects the textual element such that it could only be interpreted as “GOOD SIT” and “GOODS IT” respectively. Given that all three marks may be interpreted differently due to the colour differences, the three marks do not qualify as a series.

#### 4.9.2. **Colour difference in marks consisting of device(s)**

Generally, for device marks in a series, colours may play an important role in the distinctiveness of the marks, such that any variation in the colours may substantially alter the visual and/or conceptual identities of the marks.

Where colour is the primary or only distinctive element of a mark consisting of device(s), the absence or variation of colour(s) in the other mark(s) will disqualify them as a series.

The addition of colours to simple shapes will occasionally add distinctiveness to an otherwise non-distinctive mark. In such cases, the marks will not qualify as a series given that a distinctive element of the mark, that is, the colour, is not the same in all of the marks. This principle is illustrated in the following examples:



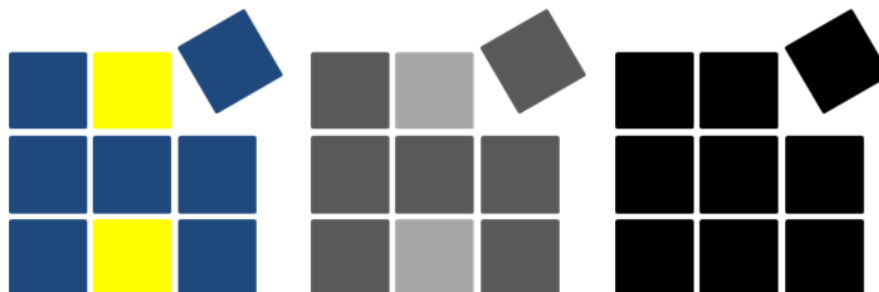
*Example 4.9.2.1*



*Example 4.9.2.2*

Where colour is not the primary or only distinctive element of the marks, the difference in colour(s) should not bring substantial difference to the identities of the marks in order for them to be acceptable as a series.

Generally, applicants lodging coloured mark(s) in a series together with a non-coloured version of the same mark should furnish the non-coloured mark in greyscale tones rather than in pure black-and-white tones. This is because certain features present in the coloured version(s) may not be clearly perceivable in the pure black-and-white version of the mark, thereby resulting in differences in the visual identity of the marks.



*Example 4.9.2.3*

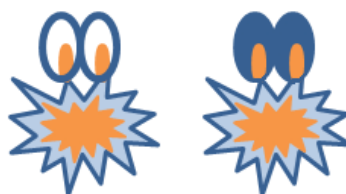
In Example 4.9.2.3 above, the three marks are not acceptable as a series. The contrasting colours in the first mark are discernible in the monochrome shades of the greyscale mark (second mark) but not in the black-and-white colours of the third mark. As there are substantial differences in the visual identity of the third mark as compared to the first and second marks, the third mark does not form a series with the first and second marks. Only the first and second marks would qualify as a series.



*Example 4.9.2.4*

In Example 4.9.2.4 above, the three marks are acceptable as a series. The distinctive features of the characters in the marks are essentially the same and colour is not the primary distinctive element in the marks. As the difference in the colours of the characters does not substantially alter the identity of the marks in the series, the three marks would qualify as a series.

However, if the difference in colours brings substantial differences to the identities of the marks, the marks will not be acceptable as a series.



*Example 4.9.2.5*

In Example 4.9.2.5 above, the two marks are not acceptable as a series. The difference in the colours of the ‘eyes’ renders the characters to appear noticeably different, such that they are not recognised as being the same character. As the difference in the colours of the characters in this case has substantially altered the identities of the marks, the two marks do not qualify as a series.

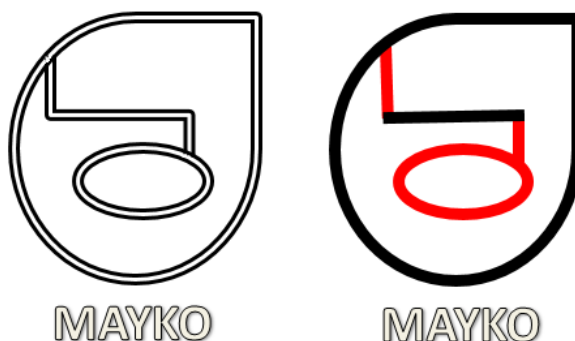
#### 4.9.3. Colour difference in composite marks

Composite marks are marks that contain both word and device elements. Generally, for composite marks in a series, the marks are assessed in their entirety with consideration to the dominant and distinctive features of the marks. The criterion for examining whether composite marks constitute a series is the same as for word marks and for device marks. If the colour difference does not substantially affect the visual, aural and conceptual identities of the marks as a whole, the marks would be acceptable as a series.



*Example 4.9.3.1*

In Example 4.9.3.1 above, the two marks are acceptable as a series. The differences in the colours in the marks do not substantially change the visual, aural and conceptual identities of the marks. The distinctive feature of the device lies in the overall representation of the device, and the difference in the colours does not significantly alter the visual identity of the device. Likewise, the colour difference in the word element does not change the way the word is read or interpreted, as it still reads “MAY-KO” in both marks. Hence, the two composite marks share the same visual, aural and conceptual identities when assessed in their entirety, and the two marks qualify as a series.



*Example 4.9.3.2*

However, in Example 4.9.3.2 above, the two marks are not acceptable as a series. The differences in the colours of the device element in the marks in this case have significantly altered the visual identity of the marks. The colour red in particular parts of the device element in the second mark results in this device appearing significantly different from the device in the first mark. With reference to section “4.9.2. Colour difference in marks consisting of device(s)” (which states that colour variations that substantially alter the visual and/or conceptual identities of the marks would disqualify the marks as a series), the colour difference in this example results in a significant change in the visual identity of the two marks. When compared in their entireties, the two composite marks do not share the same identities. Hence, the two marks do not qualify as a series.

#### **4.10. Chinese characters**

In order for marks comprising Chinese characters to qualify as a series, any variations between the Chinese characters must leave the visual, aural and conceptual identities of the marks essentially the same.

##### **4.10.1. Traditional and simplified Chinese characters**

The same Chinese characters presented in both traditional and simplified forms are acceptable as a series if the characters are in the same conventional scripts. The following example illustrates an acceptable series of marks:

知識產權局  
知識產權局

*Example 4.10.1.1*

##### **4.10.2. Stylisation of Chinese characters**

Differences in the stylisation of the Chinese characters would generally render the marks unacceptable as a series, given that the visual identities of the marks would be substantially different. The following example illustrates an unacceptable series of marks due to differences in the stylisation:

知識產權  
知識產權

*Example 4.10.2.1*

#### 4.10.3. Positioning of Chinese characters

Chinese characters are usually read from left to right or from top to bottom. This principle is applicable for assessing Chinese characters as a series of marks.



##### *Example 4.10.3.1*

The two marks in Example 4.10.3.1 above are not acceptable as a series, because the difference in the positioning of the Chinese characters alters the identity of the marks. As Chinese characters would generally be read from left to right, the first mark would be read as “草莓 微笑” and the second mark would be read as “微笑 草莓”. This results in the two marks being substantially different in their visual, aural and conceptual identities. Hence, the two marks do not qualify as a series.

#### 4.10.4. Chinese characters in other languages

Some Chinese characters have been borrowed by and incorporated into other languages, such as Japanese (*kanji*) and Korean (*hanja*). These Japanese *kanji* or Korean *hanja* characters are written in the same way as the Chinese characters but are pronounced differently and may have different meanings.

For a series of two marks consisting of one mark with Chinese characters in simplified form and another mark with the same characters in traditional form which could also be read in Japanese and/or in Korean, the two marks would be acceptable as a series. This principle is illustrated in the following example:

马车  
馬車

Translation clauses:

- 1) The transliteration of the Chinese characters in the mark is “Ma Che” meaning “Horse-drawn carriage”.
- 2) The transliteration of the Japanese characters in the mark is “Basha” meaning “Horse-drawn carriage”.
- 3) The transliteration of the Korean characters in the mark is “Macha” meaning “Horse-drawn carriage”.

##### *Example 4.10.4.1*



In Example 4.10.4.1 above, the two marks are acceptable as a series. The characters “马车” in the first mark in the series can only be read in Chinese, whereas the characters “馬車” in the second mark in the series can be read in Chinese, Japanese and/or Korean. The pronunciation of the characters “馬車” in Chinese is different from the way the same characters are pronounced in Japanese or in Korean. However, the two marks would still qualify as a series since both marks can be interpreted in the same language (Chinese) with the same pronunciation and meaning.

In addition, it would be acceptable if the applicant requests to include the Japanese and/or Korean translation clause(s) for the characters “馬車” in the application. The endorsement of translation clauses in multiple languages—in this case, Chinese, Japanese and Korean—for the same characters does not affect the assessment of whether the marks in the application qualify as a series.

#### **4.11. Foreign words**

##### **4.11.1. Foreign words containing special characters**

For applications in which one of the marks in the series contains special characters such as diacritics or accents, the identities of the marks have to remain the same in order for the marks to be acceptable as a series.

mere  
mère

##### ***Example 4.11.1.1***

In Example 4.11.1.1 above, the two marks are not acceptable as series. The first mark “mere” is an English word. On the other hand, the second mark “mère” is a French word with the meaning “mother” and is pronounced as “mair”. The average consumer in Singapore generally does not understand French and may not recognise the second mark as a French word or know how the word “mère” is really pronounced. However, the existence of the accent symbol on the letter “e” in the word “mère” would inform the average consumer that the second mark is not the English word “mere”, and he/she would hesitate to interpret the mark as an English term and pronounce it as “mere”. He/She may pronounce the word “mère” in different ways, such as “meh” or “meh-reh”. As there are substantial differences in the aural and conceptual identities of the two marks, they do not qualify as a series.

#### **4.12. Cartoon characters**

When assessing whether marks comprising cartoon characters are acceptable as a series, the following factors are considered:

- Overall appearance of the characters
- Clothing worn by the characters
- Props used/held by the characters
- Names ascribed to the characters
- Positions assumed by the characters
- Activities undertaken by the characters
- Extent to which the props, clothing, name and/or activities undertaken by the character dominate the mark

Generally, marks comprising cartoon characters may qualify as a series if the characters are wearing the same clothing, holding/using the same props, and/or are ascribed with the same name (if applicable). Even if the marks appear to be portraying the same character, the marks may not be acceptable as a series if the differences between the characters substantially affect the identities of the marks. This is explained in greater detail in the sections below.

#### 4.12.1. **Facial expression of cartoon characters**

Differences in the facial expression of a series of marks comprising cartoon characters are acceptable as long as the facial expression is not the primary distinctive feature of the characters.



***Example 4.12.1.1***

In Example 4.12.1.1 above, the three marks are not acceptable as a series. The facial expression of the cartoon characters plays an important role in the distinctiveness of the marks, as there is little other distinctive element(s) in the marks. Hence, the difference in the facial expression substantially changes the identities of the marks, and the three marks do not qualify as a series.



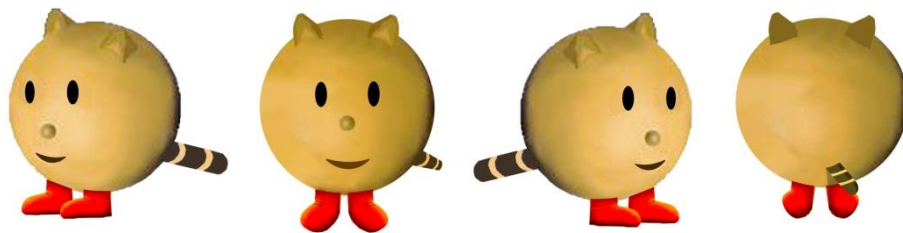
***Example 4.12.1.2***

In Example 4.12.1.2 above, the two marks are acceptable as a series. Facial expression is not the primary distinctive feature of the character in the two marks in the series, as the character comprises other distinctive features such as the overall appearance and the clothing worn by

the character. Hence, the difference in the facial expressions of the character does not substantially affect the identity of the marks in the series. The marks therefore qualify as a series of two marks.

#### 4.12.2. Different positions of cartoon characters

For cartoon characters that assume different positions to be acceptable as a series, the extent to which the differences affect the identities of the marks should be considered. Differences which substantially affect the identities of the marks would disqualify the marks from being accepted as a series.



*Example 4.12.2.1*

In Example 4.12.2.1 above, the four marks are not acceptable as a series. The distinctive elements making up the character (i.e. the round face/body with pointed ears, facial features, protruding tail, and red shoes) are all clearly visible in the first, second and third marks. On the other hand, the facial features of the character are not visible in the fourth mark. The absence of facial features in the fourth mark renders the identity of that mark substantially different from the first, second and third marks. Hence, only the first, second and third marks would qualify as a series of three marks.

#### 4.13. Background

Variations to backgrounds in a series of marks may be permissible if the backgrounds are merely a subordinate and non-distinctive feature of the marks and the difference in backgrounds does not substantially affect the identity of the marks.



*Example 4.13.1*

In Example 4.13.1 above, the two marks are acceptable as a series. The difference between the two marks in the series lies in the backgrounds. In this case, the backgrounds are merely decorative embellishments that are non-distinctive features of the marks. As the visual, aural

and conceptual identities of the two marks are not substantially affected by the difference in backgrounds, the two marks qualify as a series.

However, an addition or a change in a simple background may, in some instances, substantially affect the identities of marks, as illustrated in the following example.



*Example 4.13.2*

In Example 4.13.2 above, the two marks are not acceptable as a series. The elements within the first mark are encompassed within a circular background whereas the second mark appears to not have any background element. The absence of a circular background in the second mark renders the visual identity of the second mark significantly different from that of the first mark. The two marks therefore do not qualify as series.

#### **4.14. House mark in combination with indication of goods/services**

A house mark is a trade mark that appears on and identifies all of a company's goods and services. When a house mark is used in combination with descriptor(s) of goods and services, the assessment of whether the marks are acceptable as a series is based on two criteria, namely, the distinctiveness of the house mark and the descriptor(s) of goods and services.

The presence of a highly distinctive house mark in combination with clear or obvious descriptions of the goods/services claimed in the application is acceptable in a series of marks. This principle is illustrated in the following examples.

**decoim paper**  
**decoim pencil**  
**decoim eraser**

Application filed in Class 16 for "Paper, pencils, erasers".

*Example 4.14.1*

In Example 4.14.1 above, the three marks are acceptable as a series. The word “decoim” is a distinctive house mark and the words “paper”, “pencil” and “eraser” in the series of marks refer to the goods claimed in the application. Hence, the three marks qualify as a series.

**IANNA YELLOW**  
**IANNA RED**  
**IANNA GREEN**  
**IANNA BLUE**  
**IANNA PURPLE**  
**IANNA BLACK**

Application filed in Class 2 for “Paints”.

*Example 4.14.2*

In Example 4.14.2 above, the six marks are acceptable as a series. The marks comprise the house mark “IANNA” and conventional descriptors of the colours of the paints claimed in the application. Hence, the six marks qualify as a series.

However, if the house mark is of low distinctiveness because it is a common or descriptive dictionary word(s), the marks are unlikely to qualify as a series.

**POWER MACHINES**  
**POWER TOOLS**  
**POWER MACHINE TOOLS**

Application filed in Class 7 for “Machines and machine tools”.

*Example 4.14.3*

In Example 4.14.3 above, the three marks are not acceptable as a series. The common element “POWER” in the marks may be intended as a house mark. However, when used in combination with the descriptors “MACHINES”, “TOOLS” and “MACHINE TOOLS”, the combinations of the words (i.e. “POWER MACHINES”, “POWER TOOLS” and “POWER MACHINE TOOLS”) are descriptive of the purpose and/or characteristics of the goods claimed. Hence, the word “POWER” is unlikely to be perceived as a house mark in these three marks. The three marks therefore do not qualify as a series.

If the descriptors of goods and/or services appearing in the marks are not clear or obvious indications of the goods and/or services claimed in the application, the presence of a distinctive house mark will not assist in rendering the marks acceptable as a series.

**NEWEN SKIN**

Beauty jelly

**NEWEN SKIN**

Eye serum

**NEWEN SKIN**

Gel cleanser

**NEWEN SKIN**

Purifying toner

Application filed in Class 3 for “Cosmetic moisturisers; serum for cosmetic use; skin cleansers (cosmetic); skin care products including facial toners (cosmetic)”.

***Example 4.14.4***

In Example 4.14.4 above, the four marks are not acceptable as a series. Despite the presence of the distinctive house mark “NEWEN SKIN” in the four marks, the first mark does not constitute a series with the remaining three marks. This is because the descriptor “Beauty jelly” in the first mark is not a clear and obvious description of the goods claimed in the application. On the other hand, the descriptors “Eye serum”, “Gel cleanser” and “Purifying toner” in the second, third and fourth marks respectively are obvious descriptions of the goods claimed. As such, only the second, third and fourth marks would qualify as a series of three marks.

Further, if the application contains a trade mark which is a house mark on its own, and other marks which are combinations of the same house mark with indications of the goods/services, the application would not be acceptable as a series of marks.

**decoim**

**decoim paper**

**decoim pencil**

**decoim eraser**

Application filed in Class 16 for “Paper, pencils, erasers”.

***Example 4.14.5***

In Example 4.14.5 above, the four marks are not acceptable as a series. The first mark consists of the house mark “decoim” on its own and does not include an additional descriptor element that is present in the second, third and fourth marks. On the other hand, the second, third and fourth marks are signs which describe the goods (i.e. papers, pencils and erasers by “decoim”). Hence, the additional descriptor elements in the second, third and fourth marks result in conceptual differences between these marks and the first mark. The four marks therefore do not qualify as a series. Only the second, third and fourth marks would qualify as a series of three marks.

#### **4.15. House mark in combination with numbers**

House marks in combination with different numbers may constitute a series if the numbers can clearly be interpreted as being merely model numbers following the house mark, and it is common for the claimed goods to be described in terms of model numbers.

**ESTON 1**  
**ESTON 2**  
**ESTON 3**

Application filed in Class 9 for “Colour printers; computer printers; photo printers”.

##### ***Example 4.15.1***

In Example 4.15.1 above, the three marks are acceptable as a series. The word “ESTON” is distinctive and can clearly be interpreted as being the house mark in all three marks. The addition of the numbers behind “ESTON” does not substantially alter the identities of the marks given that the numbers merely indicate the models or serial numbers of the claimed goods. The marks therefore qualify as a series of three marks.

However, there are marks wherein the house mark is not distinguishable from the numbers and is considered an integral rather than a separate element from the numerals. In such cases, the identity of each mark will reside in the specific combination of letters and numbers in the marks. Each mark may be perceived as a whole to be a product model or serial number, which typically consists of a string of letters and numbers. We will be cautious in allowing the registration of a series of serial and model numbers if we assess that the application may be an attempt to protect a wide array of product model or serial numbers. The following example illustrates an unacceptable series of marks based on this principle:

**IN01**  
**IN02**  
**IN03**

##### ***Example 4.15.2***

#### **4.16. Indication of business entity**

A series mark cannot consist of a trade mark on the one part and the same trade mark with an indication of its business entity on the other part.

**Carolina**  
**Carolina Private Limited**

##### ***Example 4.16.1***

In Example 4.16.1 above, the two marks are not acceptable as a series. The first mark would be regarded as an individual's name whereas the second mark refers to a business entity (i.e. a Private Limited company). Hence, the two marks are conceptually different and do not qualify as a series.

Where the marks in an application differ as to indications or types of business entities, the marks would not be acceptable as a series. The marks do not qualify as a series as they possess different conceptual identities.

**Carolina Private Limited**  
**Carolina Pte. Ltd.**  
**Carolina LLP**

*Example 4.16.2*

In Example 4.16.2 above, the three marks are not acceptable as a series. The first and second marks are seen as reference to the same business entity (i.e. a Private Limited company), whereas the third mark refers to a different business entity (i.e. a Limited Liability Partnership). Consequently, the third mark is conceptually different from the first and second marks. Only the first and second marks are acceptable as a series of two marks.

#### **4.17. Domain names**

A series mark cannot consist of a trade mark on one part and a domain name or an Internet address on the other part.

Although a domain extension (e.g. “.com”, “.com.sg”, “.gov.sg”, or “.org.sg”) lacks distinctive character, the addition of a domain extension at the end of a trade mark changes the identity of that mark from a word(s) to an Internet address. The primary function of an Internet address is to locate a website and this is how most people would regard an Internet address when they see one. Hence, the addition of a domain extension may substantially affect the identity of the mark.

**ipos**  
**ipos.gov.sg**

*Example 4.17.1*

In Example 4.17.1 above, the two marks are not acceptable as a series. The identity of the first mark is “ipos”, whereas the second mark indicates an Internet address due to the presence of the domain extension “.gov.sg”. Hence, the two marks are conceptually different and do not qualify as a series.

##### **4.17.1. Well-known/common domain extensions**

Marks consisting of Internet domain names with different domain extensions may form a series of marks if the domain extensions are well-known and easily recognisable and the marks as



wholes point to the same entity (e.g. the same commercial organisation or government organisation). The following examples are acceptable series marks:

**WEBSITE.COM**  
**WEBSITE.CO.UK**

*Example 4.17.1.1*

**ipos.com**  
**ipos.com.sg**

*Example 4.17.1.2*

#### 4.17.2. Uncommon domain extensions

The average consumers generally do not recognise an Internet domain name with uncommon domain extension as an Internet address. Hence, a mark which contains an uncommon domain extension may be regarded to have a different conceptual identity from mark(s) with well-known/common domain extensions. Such marks would not qualify as a series of marks.

**CHARNIL.TM.ZA**  
**CHARNIL.COM**  
**CHARNIL.COM.SG**

*Example 4.17.2.1*

In Example 4.17.2.1 above, the three marks are not acceptable as a series. The identity of the first mark is ambiguous as “.TM.ZA” is not a well-known domain extension and the average consumer would be uncertain as to the conceptual identity of the mark. The first mark could also be regarded as three terms separated by full stops. On the other hand, the second and third marks contain the well-known domain extensions “.COM” and “.COM.SG” that point to the same entity and the marks would be easily recognised as domain names. The conceptual identity of the first mark is thus different from that of the second and third marks. Only the second and third marks would qualify as a series of two marks.

#### 4.17.3. Trade marks and domain names

There may be instances where trade marks that would normally constitute a valid series of marks do not form an acceptable series when they are represented as domain names. Generally, Internet addresses are character and case-sensitive, and a specific character string points to a particular source. Variations of the domain names, no matter how minor, would bring about differences to the source of the domain names. Therefore, different domain names do not possess the same identity and would not form a series. This principle is illustrated in the example below:

Acceptable series:

**IPOS1**  
**IPOS2**  
**IPOS3**

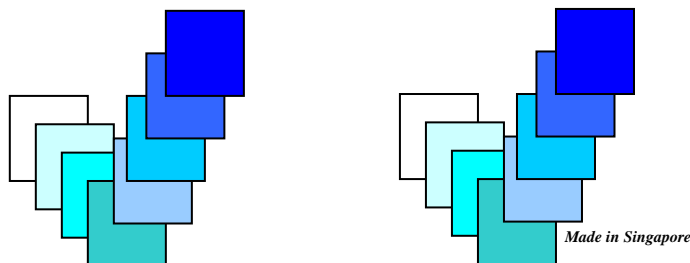
Unacceptable series:

**IPOS1.COM**  
**IPOS2.COM**  
**IPOS3.COM**

*Example 4.17.3.1*

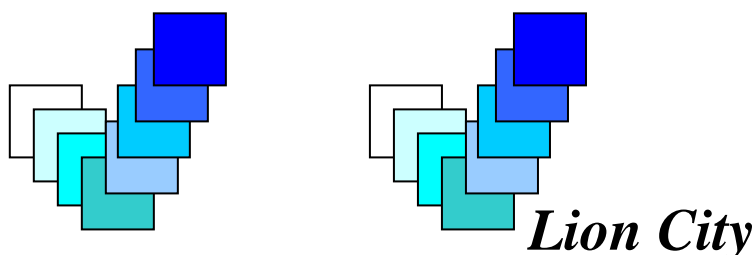
#### 4.18. Geographical components

The addition of a statement containing geographical component(s) to a mark to indicate the geographical origin may not substantially affect the identity of the marks in a series if the statement is non-distinctive and does not add material particulars to the mark.



*Example 4.18.1*

In Example 4.18.1 above, the two marks are acceptable as a series. The statement “Made in Singapore” in the second mark in the series would be taken as non-trademark matter that merely indicates the geographical origin of the goods. The textual element is not distinctive and its addition does not change the identity of the marks in the series. Therefore, the two marks qualify as a series.



*Example 4.18.2*

In Example 4.18.2 above, the two marks are not acceptable as a series. Unlike the mark in the Example 4.18.1 with the statement “Made in Singapore”, it is not obvious that the words “Lion City” in the second mark in the example above indicate the geographical origin of the goods or services. The words “Lion City” is a distinctive feature in the second mark. Thus, this introduces material particulars to the second mark which renders it substantially different from the first mark. Therefore, the two marks do not qualify as a series.

##### 4.18.1. Geographical names

Geographical names added to distinctive words may be regarded as making no substantial difference to the identities of the marks, if the geographical names are clearly descriptive of the goods or services claimed in the application.

**PLOED’S NEW YORK**  
**PLOED’S PARIS**  
**PLOED’S LONDON**

Application filed in Class 16 for “Travel guides”.

***Example 4.18.1.1***

In Example 4.18.1.1 above, the three marks are acceptable as a series. The common element in the three marks “PLOED’S” is a coined term of high distinctiveness. When the marks are applied onto the claimed goods “travel guides”, the geographical names “NEW YORK”, “PARIS” and “LONDON” merely denote the subject matter of the goods (i.e. the travel guides are for the locations New York, Paris and London respectively). Given that the geographical names do not contribute any substantial difference to the identities of the marks, the three marks qualify as a series.

Where it is not obvious that the geographical names in the marks are descriptive of the goods or services claimed in the application, the identities of the marks would be assessed as a whole, i.e. the geographical names would not be regarded as being purely informative matter. Hence, if the inclusion of the geographical names substantially affects the identities of the marks, the marks would not qualify as a series.

**NORTH POLE BANANAS**  
**ANTARCTIC BANANAS**

Application filed in Class 31 for “Fresh bananas”.

***Example 4.18.1.2***

In Example 4.18.1.2 above, the two marks are not acceptable as a series. The common element in the two marks is the word “BANANAS”, which is descriptive of the goods claimed in the application. It is not obvious that the geographical names “NORTH POLE” and “ANTARCTIC” in the marks denote the geographical locations from which the goods originate, given that bananas are not known to be produced in the North Pole and the Antarctic. The geographical name in each mark therefore contributes distinctiveness to the mark as a whole. Consequently, the two marks “NORTH POLE BANANAS” and “ANTARCTIC BANANAS” are distinctive marks with separate identities, and would not qualify as a series.

## **5. Examination of applications which face series mark objections**

Where an application does not comprise marks in a series, the trade mark examiner would raise a series mark objection against the application. The examiner may, where practical, indicate in the examination report whether any of the marks in the series applied for could be accepted as a series, and if so, which of the marks would form a series.

To overcome the series mark objection, the applicant may choose to:

- (a) Retain only the marks that constitute a series in the mark representation and remove the other marks. The series mark claim should also be amended accordingly; or
- (b) Retain only a single mark in the mark representation and remove the other marks. The series mark claim should also be deleted.

The applicant should effect the above amendments via Form TM27 with the requisite fee. A representation of the mark(s) intended to be retained in the application should also be submitted in the Form TM27 for the Registry to replace the existing representation.

Once a mark has been removed from a series in the application, the removed mark cannot be reinstated unless there are circumstances which allow the Registrar to treat the matter as a correction of irregularity in procedure under Rule 83 of the Trade Marks Rules.

**6. Where absolute grounds objections for refusal of registration have been raised**

In examining the trade mark application for absolute grounds for refusal of registration (i.e. under Section 7 of the Trade Marks Act), the examiner may raise an objection in respect of one or more marks in the series.

In such cases, the applicant must overcome the absolute grounds objection before the series of marks may be accepted for publication. The applicant may also consider deleting the objectionable mark(s) from the series to overcome the series mark objection.

## **7. Series of marks with priority claims**

An application may be filed in Singapore for a series of marks with priority claim(s) for only one mark or for multiple marks in the series, based on one priority application in a Convention country or more than one priority applications in multiple Convention countries.

For more information on priority claims, please refer to the chapter on “Priority Claims” in our Trade Marks Work Manual.

## **MARKS CONTRARY TO PUBLIC POLICY OR TO MORALITY**

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## MARKS CONTRARY TO PUBLIC POLICY OR TO MORALITY

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## **1 INTRODUCTION**

This chapter is concerned with marks which are contrary to public policy or morality.

## **2 RELEVANT LEGISLATION**

### **The Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Absolute grounds for refusal of registration**

**7.** —(4) A trade mark shall not be registered if it is —

(a) contrary to public policy or to morality;

...

### **3 CONTRARY TO PUBLIC POLICY**

#### **(a) Not concerned with economic grounds of objection**

The public policy ground is not concerned with economic grounds of objection. In *Philips Electronics NV v Remington Consumer Products Ltd [1998] RPC 283*, it was argued at first instance that it would be contrary to public policy for the plaintiffs to gain ‘an automatic and indefinite extension to the monopoly conferred by a patent, design or copyright if their three-headed rotary shaver were to be registered as a three-dimensional trade mark. Jacob J disagreed, stating that this ground “...is not concerned with this sort of matter – it is ...confined to matters ...involving some sort of question of morality. It is not concerned with economic grounds of objection.”

#### **(b) Concerned with matters involving morality**

Jacob J stated that the public policy ground “...is ...confined to matters ...involving some sort of question of morality.” Examples of marks that would be objected to under this ground would be, those which have criminal connotations, those which exhibit racial, religious or discriminatory characteristics.

## 4 MARKS CONTRARY TO MORALITY

On a morality spectrum which classifies marks in order of their increasing offensiveness, marks contrary to morality would exceed those that are considered distasteful or unpleasant. They would be akin to marks that would cause scandal in that they offend a portion of the public, although they fall short of obscenity.

Below are some categories of marks which would be contrary to morality. These categories are however not exhaustive.

### (a) Marks with religious connotations

#### (i) Names of Supreme Being

The Registrar will exercise care when examining marks which are likely to be perceived by the average member of a particular religious group (as opposed to the views of a single religious fanatic) as designating their Supreme Being. If the use of the trade mark will provoke greater offence than mere distaste, or even outrage, the mark will be denied registration **without regard to the goods or services claimed** for registration. It is not material that the average consumer does not recognize the mark as designating a Supreme Being. This is because a higher degree of outrage or censure amongst a small section of the community will suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.

#### (ii) Words or symbols of religious significance

Whether marks consisting of or comprising words or symbols of great religious significance will face an objection **depend on the goods or services claimed** for registration. The Registrar will look at the context of the use of the mark and the identified goods or services from the perspective of the specific group that considers the word or symbol to be sacred. If the identified religious group is not offended by the trade mark usage, the mark is acceptable.

#### (iii) Names of religious groups or terms and symbols that identify their followers

Adopting and using a religious group's name to identify goods or services is **not per se offensive**. The context of the usage of the mark and the identified goods or services will be important in determining whether the commercial impression of the mark is one that raises offence.

Names of religious groups, sects or orders and terms or symbols that identify their followers will be refused registration if the use of the goods claimed in the application for registration are forbidden to the followers or adherents of such sect or order, as it is an affront to such persons and tend to disparage their beliefs.

**(b) Marks involving racial, ethnic, religious or gender disparagement**

Marks which disparage any race, ethnic, religious or gender group will be refused registration **without regard to the goods or services claimed** for registration, even if the identified racial, ethnic, religious or gender group does not represent a majority of the general public. The use of such matter perpetuates negative stereotypes and serves to arrest the promotion of a progressive multicultural society.

**(c) Profane content**

Marks containing or comprising profane matter are likely to be refused **without regard to the goods or services claimed**.

“Profane” means to violate or treat with abuse or contempt something which is sacred. “Sacred” means something which is entitled to reverence and respect. Words that defile sexual and excretory functions are regarded as profane.

**(d) Vulgar content**

Whether or not a vulgar word or symbol is found to be offensive **depends upon the context of the use of the mark and the goods or services claimed** for registration. Vulgarity exceeds what might be considered unpleasant but falls short of obscenity. It may be defined as matter that is lacking in taste, indelicate and morally crude.

**(e) Sexual content**

Marks imparting a sexual connotation may be regarded as offensive and refused registration, depending on whether or not the connotation is shocking. The more sexually explicit the message, the more likely the mark will be refused registration.

It is to be noted that the test here is not whether the sexual connotation is obscene but whether the connotation would cause offence. It is likely that a device mark depicting a nude man and a nude woman kissing and embracing is sufficient to render the mark offensive.

**(f) Marks involving innuendo**

Innuendo marks will be denied registration if their insinuated messages are offensive.

**(g) Marks suggesting or promoting illegal activity**

Marks advocating illegal activity are considered offensive and will be refused registration. For example, "FAMILY HEAT" for "adult entertainment magazines" will be refused as it is suggestive of family sex which is incest.

## 5 THE TEST TO BE APPLIED

### (a) Look at the social, linguistic and cultural conditions in Singapore

A mark that is not likely to be seen as offensive in another country does not mean that it will not be seen as offensive in Singapore. This is because the social, linguistic and cultural conditions may differ.

### (b) Is the mark likely to be perceived as containing offensive matter?

The Registrar will look at the primary meaning of the mark in the minds of the relevant public and the applicant's intended meaning for the mark in deciding whether the trade mark is likely to be perceived as containing matter which might be offensive to some.

For example, "JESUS" may be a popular forename in a number of countries, but it is not a common forename in Singapore and few would see JESUS as a forename. The majority would attribute only one meaning to JESUS and that would be JESUS CHRIST. Hence, JESUS has been refused registration for "clothing".

It is possible that with calculated concealment of the words through idiosyncratic spelling or clever disguising within a device element, potentially offensive matter may be registrable.

### (c) The nature of the goods or services may be relevant

The Registrar will sometimes look at the nature of the goods or services to decide if the mark is likely to be perceived as containing offensive matter. For example, "HOOKER" in connection with "boat anchors" may be acceptable while the same mark may be refused in relation to "adult magazines".

### (d) The Registrar may draw upon his own knowledge of words and his own perception of how they may be used

In deciding if the mark is likely to be perceived as containing offensive matter, the Registrar is entitled to draw upon his own knowledge of words and their own perception of how they may be used. The mere fact that Examiner is offended or not offended is irrelevant. The Examiner must have regard to the likelihood of an identifiable section of the public being offended.

In *Ghazilian's Trade Mark Application [2001] RPC 654*, the Hearing Officer said:

*"... the ordinary dictionary words **TINY PENIS**, when used in a proper context, are not words that would, or should cause offence to*

*the vast majority of persons in the UK. But the applicant seeks to use these words not in an ordinary descriptive context, but as a means of differentiating products in the course of trade. Consequently, these words could appear on signs in shop windows, on advertisement boards in public places and on labels on clothing and accessories. ... bearing in mind that the goods applied for are items which could be on display in public places for all members of the general public to view, I consider that the trade mark will cause offence to a substantial proportion of the purchasing public who will, without any choice, be exposed to the words **TINY PENIS** out of context.”*

In *Ghazilian’s Trade Mark Application [2001] RPC 654*, the Appointed Person said:

*Section 3(3) is not concerned with political correctness; it is concerned with principles or morality, a different and less readily involved standard. The Registrar’s Hearing Officers cannot be expected in all cases to form a view without the assistance of evidence. They are entitled to draw upon their own knowledge of words and upon their own perception of the way in which those words can be used without offending against public morality. They must however be careful not to allow their personal views to deflect them from approaching the matter on the basis of the “right-thinking” person.*

**(e) Would the mark cause outrage or censure?**

If the mark is likely to be perceived as being offensive, the Registrar will look at whether offence amounts only to distaste or will the offence justifiably cause outrage and censure. If the normal and fair use of the mark would justifiably cause outrage or censure, the mark is objectionable.

***Ghazilian’s Trade Mark Application [2001] RPC 654.** In upholding the Registrar’s decision to refuse registration of the mark “**TINY PENIS**”, in respect of clothing in class 25, Simon Thorley QC, acting as the Appointed Person said:*

*“Each case must be decided with on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.”*

**(f) The Registrar should not be out of date nor be a trend setter of moral standard**

The Registrar has to decide on the acceptable standards as of the date of application. This means being neither out of date nor a trend setter of moral standard.

***Hallelujah Trade Mark [1976] RPC 605.*** *In refusing registration of the mark “HALLELUJAH” in respect of “articles of clothing for women”, the Hearing Officer said:*

*“...it is well established that the registrability of a trade mark must be judged as at the date of its application.... When religious and moral standards are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where others have given a clear lead. While he must not remain isolated from the day-to-day world, frozen in outmoded moral principles, he must equally not presume to set the standard. He must certainly not act as a censor or arbiter of morals, nor yet as a trendsetter. He must not lag so far behind the climate of the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive.”*



**NAMES AND/OR REPRESENTATIONS OF FAMOUS PEOPLE, FICTIONAL  
CHARACTERS, STORIES AND BUILDINGS**

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**NAMES AND/OR REPRESENTATIONS OF FAMOUS PEOPLE, FICTIONAL  
CHARACTERS, STORIES AND BUILDINGS**

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## **1. INTRODUCTION**

This chapter is concerned with marks which contain or consist of the name or representation of a famous person, fictional character, story or building.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act [Cap. 332, 2005 Rev. Ed.]**

#### **Absolute grounds for refusal of registration**

**7.** — (1) The following shall not be registered:

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

### **Trade Marks Rules**

#### **Persons living or recently dead**

**14.** — (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

### **3. NAMES AND/OR REPRESENTATIONS OF FAMOUS PEOPLE**

A mark may contain or consist of the name and/or representation of a famous personality, which can be an individual or a group. The name need not be the famous personality's full name, it may be the surname, given name or even the nickname, so long as the name has become interchangeable with the famous personality's full name such that the average consumer would understand the name as referring back to the famous personality. The representation may be a photograph, a picture, a drawing or other forms of image portraying the famous personality, such that the average consumer would be able to identify the famous personality from the representation.

Two issues will have to be looked at when determining the registrability of a trade mark that contains or consists of the name and/or representation of a famous personality. Firstly, whether the name or representation is capable of functioning as a badge of origin and secondly, whether authorisation, if required, has been obtained for the use of that name or representation of the famous person.

#### **3.1 Inherent distinctiveness of the mark**

The question is whether the name or representation is likely to be taken as an indication that the goods and/or services originate from a single trade source or whether it will be seen as denoting some characteristics of the goods and/or services, for example, a description of the subject matter of the goods and/or services.

This is assessed by looking at the goods and/or services applied for under the mark and the perception of the average consumers of such goods and/or services in Singapore (who are assumed to be reasonably well informed, observant and circumspect). If the average consumer would not expect all the goods and/or services claimed in the application bearing the famous name or representation to originate from a single undertaking, an objection under section 7(1)(b) will arise. In addition, in cases where the mark is descriptive of the goods and/or services claimed in the application, it will be objectionable under section 7(1)(c).

The issue here is whether the name or image is likely to be taken as an indication that the goods or services have come from a particular source, or if the use of the name/image in relation to the goods or services will merely be seen as a commemoration of that famous person or an indication that they are about that person. In this regard, if a famous personality's name or representation is likely to result in a demand for memorabilia or commercial consumer items, then the general public is unlikely to see that name or representation as anything other than an indication of the content or characteristic(s) of the goods.

The following is a non-exhaustive list of goods and services in which a famous name or representation is, more often than not, the subject matter, and thus descriptive of the goods and services:

- Recording discs; electronic publications; computer game software etc. (Class 09)
- Printed matter; printed publications; photographs; stickers etc. (Class 16)
- Toys; playthings etc. (Class 28)
- Broadcasting services; transmission of audio and video content etc. (Class 38)
- Production of music and film; presentation of live performances etc. (Class 41)

In assessing whether to raise an objection, the examiner would have regard to how the famous person's name or image is perceived and whether it is required for descriptive purposes. This in turn requires the examiner to consider, among other things:

- (i) the nature and extent of the reputation of the famous person;
- (ii) the nature of the goods in respect of which registration is sought;
- (iii) how other traders would use the name or image of the famous person;
- (iv) whether any existing trade in souvenirs, memorabilia, etc. exists or can be expected to arise;
- (v) (in the case of literary or artistic figures) the extent to which the life and works of the famous person are kept alive either by general public interest or media coverage, etc. in such a way as to generate demand for commercial consumer items;
- (vi) how the public would view the use of the name or image of the famous person.

### **3.1.1 Mark contains or consists of personal name and/or representation**

It should be noted that an individual does not have an exclusive and unqualified right to the use of his/her name and/or representation for commercial purposes. This was affirmed in ***ELVIS PRESLEY Trade Marks [1997] RPC 543 ("ELVIS 1997")***, where Elvis Presley is the name of an internationally famous rock and roll singer in the early 1950's, where the judge said, *"Just as Elvis Presley did not own his name so as to be able to prevent all and any uses of it by third parties, so Enterprises can have no greater rights. Similarly, Elvis Presley did not own his appearance. For example, during his life he could not prevent a fan from having a tattoo put on his chest or a drawing on his car which looked like the musician simply on the basis that it was his appearance which was depicted. For the same reason under our law, Enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any of the myriad of photographs, including press photographs, and drawings in which it does not own the copyright simply by reason of the fact that they contain or depict a likeness of Elvis Presley. Nor could it complain if a fan commissioned a sculptor to create a life-size statue of the musician in a characteristic pose and then erected it in his garden. It can only complain if the reproduction or use of the likeness results in the infringement of some recognised legal right which it does own."*

In addition, a name which is unique to a particular person does not mean that it possesses distinctive character as a trade mark. In ***DIANA, PRINCESS OF WALES Trade Mark [2001] ETMR 254*** (“***DIANA, PRINCESS OF WALES***”), where Diana was a member of the British royal family with the title of Princess of Wales, the Hearing Officer refuted the claim that a name which is unique to a particular person must by definition have distinctive character as a trade mark in the following extract, “*Personal names do not usually allude to non-origin attributes of the goods and services. Indeed, most personal names are readily taken as denoting the trade source of the goods, e.g. ‘Laura Ashley’, ‘Harry Ramsden’ and ‘Dorothy Perkins’. However, where a famous name is concerned (other than names which are famous as indicators of trade source, as in these examples) there is the possibility that the name will serve to signify not the trade source of the goods/services but merely the subject matter. The Elvis case is an example of this.*”

It was held in ***DIANA, PRINCESS OF WALES***, that the essential function of a trade mark is to guarantee that the items bearing it had originated under the control of a single undertaking responsible for their quality. Thus, the use of a famous name to endorse a product does not constitute trade mark use unless the proprietor takes responsibility for the quality of the goods and/or services to which it is applied. In this case, the average consumer would not have expected all commemorative items bearing Diana's name to be marketed under the control of a single undertaking. In addition, Diana's name was not used for commercial purposes by her during her life. Although her name was often used, none of this use of her name indicated any trade connection between the source of any goods and services and the Princess. The reasonably well informed and observant average consumer would be aware that there was a long history of use on mementoes featuring the royal family, which had no significance as to the trade source of the goods. Hence, it is unlikely that they would attach any trade mark significance to the name as at the date of the application when they had not done so when she was alive.

Similarly, in ***ELVIS PRESLEY Trade Marks [1999] RPC 567*** (“***ELVIS 1999***”), the marks “Elvis” and “Elvis Presley”, were refused as members of the public purchased Elvis Presley merchandise not because it came from a particular source but because it carried the name or image of Elvis Presley.

The distinctiveness of a name or representation is assessed at the date of application of the mark (see ***TARZAN Trade Mark [1970] RPC 450*** (“***TARZAN***”). If at that date the personality was so famous that its name or representation possessed very little inherent distinctiveness, the name or representation is not registrable. Hence, the greater the fame of a personality, the lesser the inherent distinctiveness that its name or representation will have. This was affirmed in ***ELVIS 1997***, where the judge citing ***TARZAN*** said, “*These passages emphasise that the more a mark has come to describe the goods to which it is to be applied or to indicate some quality of those goods, the less it is inherently adapted to carry out the trade mark function of distinguishing the trade origin of the proprietor's goods from the origin of similar goods from other sources. This is consistent with Mr. Meade's argument that the more famous Elvis Presley*

*is, the less inherently distinctive are the words “Elvis” and “Presley”. They are peculiarly suitable for use on the wide range of products sold as Elvis Presley memorabilia. He therefore does not contest but adopts Enterprises’ assertion that “Elvis is about as famous a name as could be, made famous by the efforts of Elvis Presley. ... Why else do members of the public wish to [purchase] Elvis merchandise?” Just as members of the public will go to see a Tarzan film because it is about Tarzan, so they will purchase Elvis merchandise because it carries the name or likeness of Elvis and not because it comes from a particular source.”*

### **3.1.2 Mark contains or consists of invented name**

Although invented word(s) are generally distinctive as they are meaningless, it is possible for them to lose their distinctiveness if they have acquired a meaning as a result of the use made of it over time. The relevant date for assessing the meaning of the mark is as at the date of application and not the date when the mark was coined. The fact that the mark was already widely known to be the name of the music group by the application date meant that the mark was no longer meaningless. The term need not become a dictionary term in order for it to attract an objection under sections 7(1)(b) and 7(1)(c) (see ***LINKIN PARK [2006] ETMR 74***, where “LINKIN PARK” is the name of an American rock band that rose to international fame with their debut album in 2000).

The name or image of an artist or group of artists affixed to compact discs and displayed on packaging merely indicates the name of the performer whose performance is recorded on the compact disc. If the use of the name is not likely to be understood as indicating the trade source of the good, then such use would be descriptive only. Similarly, such a name or image appearing on goods such as posters, calendars, photographs, transfers and figurines is likely to be seen as the subject matter of such goods and the mark would be precluded from registration under sections 7(1)(b) and 7(1)(c). Having said that, whether or not an objection is appropriate will depend on the fame of the person or group. The more famous the person or group, the more likely it is that there will be a market for goods bearing the name or image of the person or group and the less likely it will be regarded as acceptable for registration.

### **3.1.3 Signatures**

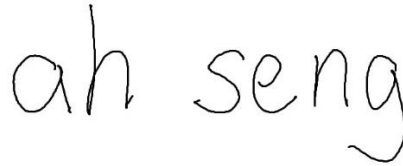
Signatures are generally considered more distinctive than the name in ordinary typeface as it is presented in a form which visually distinguishes it from the name, thereby conferring the mark with a higher degree of distinctiveness. Therefore, it should be noted that a name in perfect script or nearly resembling such that it is no different from an ordinary typeface will not be regarded as a signature.

In the example below, “Ah Seng” is the name of a famous personality. Signature A would be considered more distinctive as it differs from the ordinary typeface of the name. On the other hand, Signature B would be less distinctive as it resembles the ordinary typeface and can be easily discerned as “Ah Seng”.





Signature A



Signature B

### **3.2 Authorisation for the registration and use of the mark**

An application to register the name/representation/signature of a famous personality or a recently deceased famous personality may face an objection under section 7(6) which provides that, a trade mark shall not be registered if or to the extent that the application is made in bad faith. The application could attract a bad faith objection when it covers goods and/or services with which the famous personality is associated. For example, an application to register the name of a famous footballer for “footballs” would be objectionable because it is likely to indicate either the patronage of the footballer, or that he/she is involved in the production of the goods and thereby take unfair advantage of the footballer’s reputation.

Bad faith objections can be overcome if the applicant obtains the written consent of the famous personality or his/her legal representative to the registration and use of the mark.

Under rule 14 of the Trade Marks Rules, the Registrar may, before proceeding to register a mark in which the name or representation of any person appears, require the applicant to furnish the Registrar with the consent of the person. Where consent is required by the Registrar, the applicant must furnish the person's consent to the registration and use of the mark for the specified goods and/or services.

#### **4. NAMES AND/OR REPRESENTATIONS FAMOUS FICTIONAL CHARACTERS AND STORIES**

##### **4.1 Names of famous fictional characters and stories**

The names of fictional characters/stories will be accepted on a prima facie basis as long as it is perceived as a sign indicating the origin of the goods and/or services. Similar considerations as discussed in section 3.1 above regarding the inherent distinctiveness of the mark apply.

If the name in question is widely known, it is possible that it will only be viewed as the name of the character in the story concerned and not as an indication of trade source (as held in *TARZAN*). In such cases, the mark may be seen as serving some other function, for example, designating that the goods feature the story/character concerned and will thus face section 7(1)(b) and (c) objections. For example, "CINDERELLA", which is the name of a famous fairy tale character who is exploited by her family as a servant but eventually meets and marries Prince Charming with the help of a fairy godmother, on goods such as dolls may be seen to serve the sole purpose of designating a characteristic of the goods and not as a badge of origin. Thus, it will be open to section 7(1)(b) and (c) objections.

In order to decide whether the name has become "famous", the critical date to look at is the date of the application (as held in *TARZAN*). If at the date of application, the name is not widely known, the applicants' own success at promoting the name after the date of application should not jeopardise the application. Conversely, if the name is already widely known as at the date of the application, promotional activities after the date of application by the applicant will not benefit the applicant even if it has brought about a certain level of association with the applicant.

It is to be noted that assessment of distinctiveness is based on whether the name is capable of functioning as a badge of trade origin in respect of the goods and/or services claimed. The fact that the applicant created the fictional character, owns the copyright or some other exclusive right to produce or reproduce materials associated with the fictional characters/stories is irrelevant to the issue.

##### **4.2 Representations of famous fictional characters**

Similar considerations apply when assessing the distinctiveness of the representations of famous fictional characters. However, as there are many ways to depict the same character, a representation of a famous fictional character may be acceptable if certain element(s) such as stylisation in the representation is able to confer the mark with sufficient degree of distinctiveness.

## **5. NAMES AND/OR REPRESENTATIONS OF FAMOUS BUILDINGS**

Some factors to consider when determining the registrability of a mark bearing the name and representation of a famous building under section 7(1)(b) and (c) of the Trade Marks Act are:

- (i) whether the name or representation of the famous building is likely to generate demand for memorabilia as in the case for tourist attractions. For example, the representation of the Esplanade on memorabilia such as magnets, key chains etc. is likely to be seen by consumers as an indication of souvenirs from visiting Esplanade rather than signifying trade origin of the magnets.
- (ii) whether the building concerned has an association with the goods and/or services applied for, either because it is famous for the goods and/or services or it is a likely source of location of the goods and/or services.

Objections under section 7(6) may also arise if the applicant is not the owner or developer of the building. This objection will be waived if consent from the owner or developer of the building is obtained.

## **6. ACQUIRED DISTINCTIVENESS**

Notwithstanding that a mark may fall afoul of the grounds in section 7(1)(b) and/or (c) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under Section 7(2) of the Act.

The Registrar will consider whether there has been use of a mark as a trade mark, and whether as a result of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking.

(Reference should be made to the Trade Marks Work Manual's section on Evidence of Distinctiveness Acquired Through Use for more information.)

## **OTHER GROUNDS FOR REFUSAL OF REGISTRATION**

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## OTHER GROUNDS FOR REFUSAL OF REGISTRATION

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## **1 INTRODUCTION**

This chapter is concerned with some other grounds for refusal of registration of a mark which are not covered in other chapters of this manual.

## 2 RELEVANT LEGISLATION

### **The Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Interpretation**

2. — (1) In this Act, unless the context otherwise requires —

"Convention country" means —

- (a) in section 10 and paragraph 13 of the Third Schedule, a country or territory, other than Singapore, which is —
  - (i) a party to the Paris Convention; or
  - (ii) a member of the World Trade Organisation; and
- (b) in any other provision of this Act, a country or territory which is —
  - (i) a party to the Paris Convention; or
  - (ii) a member of the World Trade Organisation;

"Paris Convention" means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883, as revised or amended from time to time;

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

"TRIPS Agreement" means the Agreement on Trade-Related Aspects of Intellectual Property Rights, set out in Annex 1C to the WTO Agreement, as revised or amended from time to time;

"WTO Agreement" means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

#### **Absolute grounds for refusal of registration**

7. — (1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in Section 2(1)
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade mark which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(4) A trade mark shall not be registered if it is —

- (a) contrary to public policy or to morality; or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services).



## Other grounds for refusal of registration

(5) A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

(11) A trade mark shall not be registered in the cases specified in sections 56 and 57.

(12) The Minister may make rules to provide that a sign specified in the rules shall not be registered as a trade mark, or shall not be registered unless such conditions as may be prescribed are met.

(13) A trade mark shall not be registered if or to the extent that the registration contravenes any rule made under subsection (12).

### **National emblems, etc., of Convention countries: Article 6ter of Paris Convention, etc.**

**56.**—(1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris convention or the TRIPS Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without their authorisation.

**Emblems, etc., of certain international organisations: Article 6<sup>ter</sup> of Paris Convention, etc.**

**57.** —(1) This section shall apply to —

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

- (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without its authorisation.

(5) Nothing in this section shall affect the rights of a person whose bona fide use of the trade mark in question began before 23<sup>rd</sup> February 1995 (where the relevant provisions of the Paris Convention entered into force in relation to Singapore).

**Notification under Article 6<sup>ter</sup> of Paris Convention, etc.**

**58.** —(1) For the purposes of Section 56, state emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

- (a) the country in question has notified Singapore in accordance with Article 6<sup>ter</sup> (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) Singapore has not objected to it in accordance with Article 6<sup>ter</sup> (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of Section 57, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

## Other grounds for refusal of registration

- (a) the organisation in question has notified Singapore in accordance with Article 6*ter* (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) Singapore has not objected to it in accordance with Article 6*ter* (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6*ter* (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of —

- (a) the state emblems and official signs or hallmarks; and
- (b) the emblems, abbreviations and names of international organisations, which are for the time being protected under Paris Convention or the TRIPS Agreement by virtue of a notification under Article 6*ter* (3) of that Convention or under that Article as applied by the TRIPS Agreement.

### **Acts of agent or representative: Article 6septies of Paris Convention, etc.**

**59.** —(1) Subsections (2) to (6) shall apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the trade mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may —

- (a) apply for a declaration of the invalidity of the registration; or
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use in the course of trade of the trade mark in Singapore which is not authorised by him.

(5) Subsections (2), (3) and (4) shall not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) must be made within 3 years of the proprietor becoming aware of the registration.

(7) No injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of 3 years or more.

## **The Trade Marks Rules**

### **Representation of President**

**11.** The Registrar shall refuse to register a trade mark which consists of or contains any representation of the President or any colourable imitation thereof.

### **Singapore Crest, Presidential Coat of Arms, Royal Arms, etc.**

**12.** The Registrar shall refuse to register a trade mark which consists of or contains –

- (a) any representation of the Crest of the Republic of Singapore, the Presidential Coat of Arms, the Royal or Imperial Arms, or of any crest, armorial bearing, insignia, or device so nearly resembling and of the foregoing as to be likely to be mistaken for them;
- (b) any representation of the Royal or Imperial crown, or of the Singapore flag, or of the Royal or Imperial flag;
- (c) the word “Royal”, “Imperial”, “Presidential”, or “Singapore Government”, or any word, letter or device if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal, Imperial, Presidential or the Singapore Government’s patronage or authorisation, whether or not such be the case;
- (d) the words “Red Cross” or “Geneva Cross”, any representation of the Geneva Cross or the Red Cross, any representation of the Swiss Federal cross in white on a red background or silver on a red background, or any representation similar to any of the foregoing; or
- (e) the word “ANZAC”,

unless it appears to the Registrar that consent to its registration and use of the person or authority entitled to give consent has been obtained.

### **Registration of mark consisting of arms, etc.**

**13.** —(1) Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate, government body, statutory board, institution or person appear on a trade mark which is the subject of an application for registration, the Registrar, before proceeding to register the mark, may require the applicant to furnish the Registrar with the consent to the registration and use of the matter in question of such official or other person as appears to the Registrar to be entitled to give consent.

(2) The Registrar shall refuse to register the mark if no such consent is furnished within the time specified by the Registrar.

### **Persons living or recently dead**

**14.** —(1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

### **Other grounds for refusal of registration**

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

### **3 SECTION 7(11) – MARKS PROTECTED UNDER ARTICLE 6<sup>TER</sup> OF THE PARIS CONVENTION**

Section 7(11) of the Trade Marks Act prohibits the registration of a trade mark which falls within the cases specified in sections 56 and 57. Sections 56 and 57 give effect to the obligation under Article 6<sup>ter</sup> of the Paris Convention, which is concerned with protection for emblems of Convention countries and emblems of certain international organisations. “Convention country” is defined in section 2(1) as “a country or territory, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organisation”.

Flags of Convention countries receive automatic protection. All other emblems only receive protection if they have been notified in accordance with the procedure set out in section 58. Briefly, the country concerned notifies Singapore that it desires to protect the emblem in question. In the absence of an objection from Singapore, the notification affects applications for registration made more than 2 months after the receipt of the notification. A list of the protected emblems may be viewed at [IP<sup>2</sup>SG](#) > Search for IP > Trade Marks (under “Search Category”) > Article 6<sup>ter</sup> (under “Application Type”).

#### **(a) Section 56 – Emblems of Convention Countries**

Section 56 of the Trade Marks Act provides that a trade mark which consists of or contains:

- (i) the flag of a Convention country;
- (ii) the armorial bearings or any other state emblem of a Convention country
- (iii) an official sign or hallmark adopted by a Convention country; or
- (iv) anything which from a heraldic point of view imitates any such flag, emblem, sign or hallmark,

shall not be registered without the authorisation of the competent authorities.

The items in (i), (ii) and (iv) above are protected irrespective of the goods or services sought to be registered. As for item (iii), the objection may be waived if the applicant shows that the goods or services for which the official sign or hallmark is used as an indication of control and warranty are dissimilar to those for which trade mark protection is sought.

#### **(b) Section 57 – Emblems of International Organisations**

Section 57 of the Trade Marks Act provides that a trade mark which consists of or contains:

- (i) armorial bearings, flags or other emblems;
  - (ii) abbreviations and names; or
  - (iii) anything which from a heraldic point of view imitates any such emblem;
- of international organisations of which one or more Convention countries are members, shall not be registered without the authorisation of the international organisation concerned, unless the Registrar is satisfied that the use of the emblem in question does

not indicate a connection with the organisation and is not likely to mislead the public as to the existence of a connection.

### (c) Registrar's Practice

When Singapore is notified of the emblems, they are indexed and put onto the Trade Marks database so that an appropriate search during the normal examination process will reveal these emblems. These emblems are allocated with an "A" prefix in the Trade Marks database.

Although many national flags are notified, Article 6<sup>ter</sup> of the Paris Convention indicates that formal notification is not necessary for protection to be accorded to the flags of countries of the Union. Therefore the identity of any flag which is included within a trade mark should be researched even if it does not appear on the Trade Marks database.

If a notified emblem is found which closely resembles the trade mark being searched, further research should be carried out to determine if the sign has only been notified for specific goods and/or services or whether the notification of that sign is a general prohibition on the use of the mark. Flags, coats of arms and country emblems, for example, apply to all goods and services in all classes. However, intergovernmental and warranty signs have limited goods and/or services. For example, a hallmark which is limited to metal goods is unlikely to cause confusion if applied to textile goods. Basic information on the emblem such as the date of the notification and a description of the emblem is available on the trade marks database. More information in determining the extent of the prohibition may be obtained from World Intellectual Property Organization's (WIPO) 6<sup>ter</sup> database search interface at <http://www.wipo.int/reference/en/>. The onus is on the applicant to show that the goods or services for which the official sign or hallmark is used as an indication of control and warranty are dissimilar to those for which trade mark protection is sought.

### (d) Wording of Registrar's Objection

The Registrar will raise the following objection:

"The mark is objectionable under section 7(11) of the Trade Marks Act as the mark consists of/contains:

- a flag of a Convention country (see attached printout)
  - the state emblem of a Convention country (see attached printout)
  - an official sign or hallmark adopted by a Convention country (see attached printout)
  - the armorial bearing/flag/emblem of an international intergovernmental organisation (see attached printout)
  - the abbreviation/the name of an international intergovernmental organisation (see attached printout)
- (choose only one of the above)*

## **Other grounds for refusal of registration**

The objection may be overcome by obtaining the written consent of the competent authority of the country/countries/organisation concerned, to the proposed registration of the trade mark.”



#### **4 SECTION 7(5) – SIGNS PROTECTED UNDER OTHER NATIONAL LEGISLATION**

Under section 7(5), a trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law. In other words, if the trade mark applied for contains or consists of a sign the use of which is precluded under some other piece of national legislation, an objection under this subsection will apply.

Examples of legislation which prohibits the use of words and signs as trade marks are the Singapore Arms and Flag and National Anthem Rules, Singapore Tourism Board Act and the Geneva Conventions Act.

##### **(a) Singapore Arms and Flags and National Anthem Rules**

The Singapore Arms and Flags and National Anthem Rules restrict the use of Singapore's national symbols in trade marks.

##### **Singapore's Crest/Coat of Arms**

An application to register a trade mark which consists of or contains a representation of the Coat of Arms of the Republic of Singapore or anything so nearly resembling the Arms as to be likely to be mistaken for them breaches rule 3, which provides as follows:

##### **Singapore Arms and Flags and National Anthem Rules**

**3.** —(1) Subject to paragraph (3), no person shall, without the prior written permission of the Minister or any authorised officer —

- (a) print, publish, manufacture, sell, offer for sale or exhibit for sale;
- (b) cause to be printed, published, manufactured, sold, offered for sale or exhibited for sale;
- (c) send, distribute or deliver to, or serve on, any other person; or
- (d) cause to be sent, distributed or delivered to, or served on, any other person,

any writing, material or object in or on which appears the Arms or any token, insignia, emblem or other thing that so nearly resembles the Arms as to be capable of being mistaken for the Arms.

(3) This rule shall not prohibit —

- (a) the display of the Arms by any Government department on or within the premises of any building owned by the Government or occupied by one or more Government departments; or
- (b) the use or application of the Arms on any writing, material or object produced or commissioned by any Government department, or any public officer, for the purposes of the Government.

Consent to use the Coat of Arms of Singapore may be obtained from the Ministry of Information, Communications and the Arts.

### **Flag of Singapore**

Under rule 9, the flag of Singapore shall not be used in any trademark, nor for any commercial or advertising purposes.

#### **Singapore Arms and Flags and National Anthem Rules**

- 9.** —(1) No person shall use or apply the Flag or any image thereof —
- (a) for any commercial purpose;
  - (b) as a means, or for the purposes, of any advertisement;
  - (c) as or as part of any furnishing, decoration, covering or receptacle,
- except in such circumstances as may approved by the Minister, being circumstances wherein there is no disrespect for the Flag.
- (2) No person shall use or apply the Flag or any image thereof as or as part of any trademark.

### **(b) Singapore Tourism Board Act**

Sections 24 and 25 of The Singapore Tourism Board Act restrict the use of the Merlion symbol and the Singapore Tourism Board's symbol.

#### **Use of Merlion symbol**

**24.** Any person who, without the permission of the Board, uses the Merlion symbol, a representation of which is set out in Part I of the First Schedule, or a symbol or representation so nearly resembling the Merlion symbol as to cause confusion in relation to it, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding 6 months or to both.

#### **Board's symbol**

- 25.** —(1) The Board shall have the exclusive right to the use of the Board's symbol a representation of which is set out in Part II of the First Schedule.
- (2) Any person who, without the permission of the Board, uses the Board's symbol, or a symbol or representation so nearly resembling the Board's symbol as to cause confusion in relation to it, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$2,000 or to imprisonment for a term not exceeding 6 months or to both.

**FIRST SCHEDULE**

**PART I  
MERLION SYMBOL**



**PART II  
BOARD'S SYMBOL**



Consent to use the symbols above in a trade mark may be obtained from the Singapore Tourism Board.

**(c) Geneva Conventions Act – Red Cross and Other Emblems**



**Red Cross  
emblem**



**Red Crescent  
emblem**



**Red Lion and Sun  
emblem**



**Red Crystal  
emblem**

Sections 8 and 9 of the Geneva Conventions Act provide as follows:

**Prohibition of use of emblem without authority**

**8.** No person shall, without the authority of the Minister, use for any purpose in Singapore —

- (a) the red crescent emblem;
- (b) the red cross emblem;
- (c) the red crystal emblem;
- (d) the red lion and sun emblem; or
- (e) the words “Red Cross” or “Geneva Cross”.

**Prohibition of use of certain words and designs**

**9.** No person shall without the authority of the Minister use for any purpose whatsoever —

- (a) any design consisting of a white or silver cross on a red ground, none of the limbs of which extends to the margin of the ground, being the cross comprised in the Arms of the Swiss Confederation;
- (b) any design being a colourable imitation of the design mentioned in paragraph (a);
- (c) any design being a colourable imitation of the red crescent emblem, the red cross emblem, the red crystal emblem or the red lion and sun emblem; or
- (d) any words so nearly resembling the words “Red Cross” or “Geneva Cross” as to be capable of being understood as referring to the red cross emblem.

Applications with trade marks containing or consisting of the following are objectionable under section 7(5):

- (i) a red cross on a white ground (where the cross is made up of 5 red squares)
- (ii) a white or silver cross on a red ground;
- (iii) a cross which is in black and white and the application does not contain a voluntary limitation that the cross will be used in colours other than red on a white background or vice versa (where the cross is made up of 5 squares);
- (iv) the words “Red Cross” or “Geneva Cross”;
- (v) phonetic equivalents of the words “Red Cross” or “Geneva Cross”;
- (vi) any design so nearly resembling the above emblems as to be capable of being understood as referring to them.

The above practice applies regardless whether the objectionable emblem or words are not prominent in the mark, and regardless of the goods or services claimed.

Applications containing or consisting of a red cross on a white ground (where the cross does not have the proportion of 5 red squares) will still be objected to under section 7(5) if the cross closely resembles the red cross emblem and the goods or services are medical related (for example, Class 3, 5, 10, or 44). It is irrelevant whether the cross is a significant or prominent part of the mark.

Depending on the scenario, the applicant may overcome the objection by inserting a colour limitation to the application or obtaining consent to use the above prohibited emblems or words from the relevant authorities.

## **5 SECTIONS 7(1)(b), (c) AND (d) - INTERNATIONAL NON-PROPRIETARY NAMES**

An International Non-proprietary Name (INN) identifies a pharmaceutical substance or active pharmaceutical ingredient by a unique name that is globally recognised and is public property. World Health Organization (WHO) advises member states of names which are proposed as and later, of names recommended as, INN. Notification to member states is accompanied by a request that the name should be recognised as the non-proprietary name for the particular substance and that member states should take all steps necessary to prevent acquisition of proprietary rights in the name, including prohibiting registration of the name as a trade mark.

The on-line database of INNs is available at <https://extranet.who.int/soinn/>.

### **(a) Registrar's Practice**

All applications in class 5 are searched against the INN list. The Registrar would raise an objection under sections 7(1)(b), (c) and (d) in the event that:

- (i) the trade mark contains or consists of the INN without being accompanied by any other distinctive matter; and
- (ii) the specification contains “pharmaceutical substances”, “veterinary substances”, “pesticides” or analogous descriptions.

### **(b) Wording of Registrar's Objection**

The Registrar will raise the following objection:

“The mark is objectionable under sections 7(1)(b), (c) and (d) of the Trade Marks Act as the mark consists exclusively of the word [state the INN] which is a generic term for [state the product].”

## **6 SECTION 7(13) – SIGNS PROTECTED UNDER TRADE MARKS RULES**

Under section 7(13), a trade mark shall not be registered if or to the extent that the registration contravenes any rule made under subsection 12. Subsection 12 states that the Minister may make rules to provide that a sign specified in the rules shall not be registered as a trade mark, or shall not be registered unless such conditions as may prescribed are met. The following rules have been made under subsection 12.

### **(a) Rule 11 – Representation of President**

Under rule 11, a mark which consists of or contains any representation of the President or any colourable imitation thereof shall not be registered as a trade mark.

### **(b) Rule 12 – Singapore Crest, Presidential Coat of Arms, Royal Arms, etc.**

Under rule 12, a mark which consists of or contains any representation of the Crest of the Republic of Singapore, the Presidential Coat of Arms, the Royal or Imperial Arms, crown or flag or any word, letter or device that is likely to lead persons to think that the applicant has Royal, Imperial, Presidential or the Singapore Government's patronage or authorisation shall not be registered as a trade mark. Words such as "Red Cross", "Geneva Cross" or "ANZAC" as well as any representation of the Red Cross, the Geneva Cross or the Swiss Federal cross in white on a red background or silver on a red background shall not be registered as a trade mark.

A mark may proceed to registration if the Registrar is satisfied that consent to its registration and use has been obtained from the authorised person or organisation.

### **(c) Rule 13 – Registration of mark consisting of arms, etc.**

Under rule 13, a mark which consists of or contains name, initials or devices of any government body, statutory board, institution or person shall not be registered as a trade mark, unless consent is furnished within the time specified by the Registrar. The signs restricted from registration under rule 13 can be found at [IP<sup>2</sup>SG](#) > Search for IP > Trade Marks (under "Search Category") > Logogram (under "Application Type").

### **(d) Wording of Registrar's Objection**

Where a trade mark applied for contains or consists of any of the above prohibited symbols or any symbol so nearly resembling the above prohibited symbols as to cause confusion, the Registrar will raise the following objection(s):

### Other grounds for refusal of registration

The mark is objectionable under section 7(5) of the Trade Marks Act and/or rule 11/12/13 of the Trade Marks Rules as the mark consists of or contains:

- the word \_\_\_\_\_
- a representation of the \_\_\_\_\_ of Singapore
- a design of \_\_\_\_\_
- the \_\_\_\_\_ symbol
- a [word/symbol/design] so nearly resembling the [word\_\_\_\_\_/representation of \_\_\_\_\_ design of \_\_\_\_\_/ the \_\_\_\_\_ symbol] as to be capable of being understood as referring to it  
(choose only one of the above)

which is a sign whose use is prohibited under the [state the name of the Act and the relevant provision].

The objection may be overcome by obtaining the written consent of the competent authority concerned, to the proposed registration of the trade mark.

## **DECEPTIVE MARKS**

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## **1 INTRODUCTION**

An objection under Section 7(4)(b) will be raised if because of some connotation or sign contained in the mark, the use of the trade mark in relation to the goods or services claimed in the application would be likely to deceive the public.

Considerations under this subsection relate to the matter within the trade mark that could deceive the relevant buying public. The deception could arise in regard to:

- a characteristic of the goods or services such as their composition, nature or other properties;
- the quality or quantity of the goods or services;
- the geographical origin of the goods or services;
- the intended use or purpose of the goods or services; or
- the endorsement or licence of the goods or services by a person or organization.

An objection may be raised under this subsection even if the mark does not consist exclusively of the deceptive element.

## **2 RELEVANT LEGISLATION**

### **The Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Absolute grounds for refusal of registration**

**7** —(4) A trade mark shall not be registered if it is —

...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

### 3 THE TEST FOR DECEPTIVENESS

In deciding whether an objection under Section 7(4)(b) should be raised, the Registrar will look at the following factors:

**(a) Is there a false implication?**

A trade mark may be deceptive if it includes a word or sign which is descriptive of any of the characteristics of the goods or services but the characteristic is not in fact present. The following are some scenarios in which a characteristic of the goods or services may be implied.

- (i) Descriptive words or devices conjoined with another word or device. For example, STEELSCREWS for metal hardware will suggest that the screws are made of steel.
- (ii) A word which is phonetically similar to a descriptive word may also suggest a property of the goods or services. For example, ORLWOOLA for suits would suggest that the suits are made of all wool.
- (iii) Marks which consist of a geographical name may cause consumers to associate the mark with the geographical origin of goods. This is especially so if the place concerned has a reputation for the particular goods, for example FRANCE or PARIS for perfumery or SRI LANKA for tea.

However, where the geographical name in a trade mark only has a fanciful association, (for example MISS AMERICA for textiles), the mark will be registrable.

Where the words "Made in XYZ" or "Product of XYZ" appear in the trade mark, it is a clear indication that the geographical origin of the goods is XYZ. However, there are trading standards governing the use of this kind of indication in the marketplace, and therefore, the Registrar will not question the veracity of that indication unless it appears from the specification or the evidence of use lodged that the goods are made elsewhere.

- (iv) The presence of a geographical name in a trade mark to be used in respect of services is much less likely to be taken as an indication of the origin of the services. But there may be occasions when the appearance of a geographical name in a trade mark to be used in respect of services suggests that the services are of a particular nature, for example, SWEDISH for massage services.

**(b) Are prospective purchasers likely to believe in the false statement?**

There must be a real tangible danger of the buying public being deceived by the misrepresentation. However, if there is no realistic possibility of deception, the objection need not be raised.

In *Imperial Tobacco Co. (of Great Britain & Ireland) (1915) 32 RPC 361*, Warrington L.J. said:

*“I ask myself first of all without knowing anything more about the case, but treating myself as I think that I am entitled to do, as a man who knows something about the ways of the world and the ways of trades people, and the ways of people who buy goods, whether if I saw the Prince of Wales Feathers used as a trade mark on a packet of goods, it would suggest to me that that meant to represent, or was calculated to lead to the belief that the person who has put that trade mark on the goods held some special warrant of authority from the Prince of Wales? I do not think that it would be for a moment. What it would suggest to me would be, that the man thought that it was an attractive trade mark which would make his goods not only attractive, but more than that, would distinguish his goods from those of other people in the same trade, being used as a trade mark.”*

There are a number of factors to take into consideration when assessing whether the use of a trade mark is likely to be deceptive when used in respect of goods. These include:

**(i) The nature of the goods.**

Are they:

- readily inspectable? If they are then this lessens the likelihood of deception occurring.
- of an immediately apparent composition? If they are, then this also lessens the likelihood of deception.
- very cheap and therefore likely to be casually inspected prior to purchase?
- expensive and hence carefully inspected prior to purchase?

**(ii) The nature of the ordinary persons purchasing the goods.**

Are they:

- persons with some special training, such as doctors, engineers or scientists?
- likely to be some social group? For example, children will have limited consumer education in respect of some goods and/or services (e.g. financial services) but in others, such as electronic games and other playthings, they may

have very specific knowledge of products constituting the market and may constitute the majority of actual purchasers, or at least will have a large input into such purchases.

**(iii) The likely nature of the transaction. For example, some transactions may offer less opportunity to inspect goods.**

These include:

- mail-order
- television vending
- goods ordered by telephone
- over-the-counter, as opposed to supermarket, sales

## 4 REGISTRAR'S PRACTICE

### (a) Descriptions of goods/services

If a trade mark as a whole is distinctive, the mere fact that the trade mark contains a sign describing a particular type of goods in the specification, does not mean that the trade mark will encounter an objection under Section 7(4)(b) or a bad faith objection for a broad specification. For example, GRAHAMS OLIVE OIL for “cooking oil” is acceptable. The Registrar will not request that the specification be restricted. This is because there is no apparent contradiction in the mark and the specification and the Registrar will assume that the applicant will either use the mark on olive oils or he will vary the mark in use.

However, if there is an apparent contradiction between the mark and the goods claimed in the specification, for example, GRAHAMS OLIVE OIL for “vinegar”, a Section 7(4)(b) objection may be raised.

### (b) Packaging sizes

The Registrar will not question the veracity of references to packaging sizes in a trade mark, if the mark as a whole is distinctive. Such references are dealt with by other commercial practices in the marketplace.

### (c) Other desirable quality of the goods

The Registrar will raise an objection in the following cases as the marks indicate a particular desirable quality of the goods:

CUDDLY LAMB deceptive for “bags” if the bags were not made of lambskin

SILK JOY deceptive for “clothing” if the clothing is not made of silk

## 5 OVERCOMING SECTION 7(4)(b) OBJECTIONS

Section 7(4)(b) objections may be overcome by:

- **Limiting the specification of goods or services**

The applicant may amend the application to limit the goods or services covered by the application so that the goods or services for which the mark would be deceptive are no longer claimed. For example, the limitation may be to include the words "...; all made of lambskin." or "...all manufactured in ...".



## **LICENCES**

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## LICENCES

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## **1 INTRODUCTION**

The proprietor of a trade mark can give permission to someone else to use his trade mark. This is done by granting that person a licence over the trade mark.

Although the grant of a licence is not invalidated due to failure to record the licence with the Registrar, it is advisable for licensees to record their interest to ensure that third parties are aware of the existence of the licence. Once the licence is entered in the register, every person is deemed to have notice of it (section 42(6)). It is also advantageous to record the licence as it serves as prima facie evidence of the transaction (section 101(b)).

## 2 RELEVANT LEGISLATION

### Trade Marks Act (Cap. 322, 2005 Rev. Ed.)

#### Co-ownership of registered trade mark

37.

...

- (4) One co-proprietor may not, without the consent of the other or others —
- (a) grant a licence to use the registered trade mark; or
  - (b) assign or charge his share in the registered trade mark.

...

#### Registration of transactions affecting registered trade mark

39. —(1) On application being made to the Registrar by —

- (a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or
  - (b) any other person claiming to be affected by such a transaction,
- the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions under subsection (1):

...

- (b) the grant of a licence under a registered trade mark;

...

(5) For the avoidance of doubt, subsections (3) and (4) shall not apply to any registrable transaction relating to —

- (a) a licence under a registered trade mark; or
- (b) any right in or under the licence.

...

#### Licensing of registered trade mark

42. —(1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

(4) Subsection (3) may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

(5) Subject to subsection (7), a licence to use a registered trade mark is binding on every successor in title to the grantor's interest —

- (a) except any person who, in good faith and without any notice (actual or constructive) of the licence, has given valuable consideration for the interest in the registered trade mark; or
- (b) unless the licence provides otherwise,

and any reference in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(6) Every person shall be deemed to have notice of a licence if the prescribed particulars of the grant of the licence are entered in the register under section 39(1).

...

(8) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include references to a sub-licence or sub-licensee.

### **General provisions as to rights of licensees in case of infringement**

#### **44.**

...

(3) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(4) If the proprietor —

(a) refuses to do so; or

(b) fails to do so within 2 months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

...

### **Exclusive licensee having rights and remedies of assignee**

**45.** —(1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) Where or to the extent that the provision referred to in subsection (1) is made, the licensee is entitled, subject to the provisions of the licence and to the provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

...

### **Registration to be prima facie evidence**

**101.** In all legal proceedings relating to a registered trade mark or any right thereunder (including proceedings for rectification of the register) —

(a) the register shall be prima facie evidence of anything contained therein;

(b) the registration of the prescribed particulars of any registrable transaction under section 39 shall be prima facie evidence of the transaction; and

(c) the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of —

- (i) the validity of the original registration; and
- (ii) any subsequent assignment or other transmission of the registration.

## **Trade Marks Rules**

### **Application to change name or address in register**

**44.** —(1) An application by —

- (a) the proprietor of a registered trade mark;
- (b) a licensee of a registered trade mark; or
- (c) any person having an interest in or charge on a registered trade mark registered under rule 55,

to change his name or address appearing in the register shall be filed with the Registrar in Form CM2.

...

(4) The Registrar may at any time, on a request filed in Form CM2 by any person who has filed an address for service under rule 9 or 10, change that address in the register.

### **Entry in register of particulars of registrable transactions**

**54.** —(1) The prescribed particulars of a transaction to which section 39 of the Act applies to be entered in the register are —

...

- (b) in the case of the grant of a licence under a registered trade mark —
  - (i) the name and address of the licensee;
  - (ii) where the licence is an exclusive licence, that fact;
  - (iii) where the licence is limited, a description of the limitation; and
  - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;

...

(2) In each of the cases mentioned in paragraph (1), there shall be entered in the register the date on which the entry is made.

### **Application to register or give notice of transaction**

**55.** —(1) An application to register particulars of a transaction to which section 39 of the Act applies shall be made, and a notice to be given to the Registrar of particulars of a transaction to which section 41 of the Act applies shall be —

...

- (b) in the case of the grant, amendment or termination of a licence, in Form CM6;

...

(2) Where an application under paragraph (1) is filed other than by means of the electronic online system, the application shall be —

...

- (d) signed by or on behalf of the grantor of the licence or security interest, in any other case.

...

(3) Where an application under paragraph (1) is filed by means of the electronic online system, the application shall be authorised by all relevant parties and be validated by such means as the Registrar considers fit.

(3A) Where an application under paragraph (1) is not signed in accordance with paragraph (2)(a), (b) or (d) or authorised and validated in accordance with paragraph (3), the application shall be accompanied by —

...

- (b) in the case of a grant of a licence (under a registered trade mark or an application for registration of a trade mark) referred to in paragraph (1)(b), at the option of the applicant, by —
  - (i) an extract of the licence contract, being an extract which shows the parties to the contract and the rights which are licensed under the contract;
  - (ii) a statement of the licence containing such information as the Registrar may require, being a statement signed by both the person granting the licence and the licensee; or
  - (iii) a certified copy of any documentary evidence which in the Registrar's view is sufficient to establish the grant of the licence;
- (c) in the case of an amendment to, or a termination of, a licence (under a registered trade mark or an application for registration of a trade mark) referred to in paragraph (1)(b), at the option of the applicant, by —
  - (i) a statement of the amendment or termination of the licence, as the case may be, containing such information as the Registrar may require, being a statement signed by both the person granting the licence and the licensee; or
  - (ii) a certified copy of any documentary evidence which in the Registrar's view is sufficient to establish the amendment or termination of the licence, as the case may be; or
- (d) in any other case, by a certified copy of any documentary evidence which in the Registrar's view is sufficient to establish the transaction.

...

(3C) The Registrar shall refuse to accept an application under paragraph (1) if paragraph (2), (3), (3A) or (3B) is not complied with and in such event, the Registrar may require a fresh application to be made.

## Trade Marks (International Registration) Rules

### Notification of transactions

**8.** —(1) The following are notifiable transactions for the purpose of this rule:

- (a) the grant of a licence under a protected international trade mark (Singapore) or an international registration designating Singapore;

...

- (c) the making by personal representatives of an assent to a license in relation to —

- (i) a protected international trade mark (Singapore);
  - (ii) an international registration designating Singapore; or
  - (iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore.

(2) On application being made to the Registrar by —

- (a) a person claiming to be entitled to an interest in or under a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction; or

(b) any other person claiming to be affected by such a transaction,  
the relevant particulars of the transaction shall be entered in the register.

...

(6) In this rule, “relevant particulars” means —

- (a) in relation to a notifiable transaction mentioned in paragraph 1(a) or (c) -
  - (i) the name and address of the licensee;
  - (ii) where the licence is an exclusive licence, that fact;
  - (iii) where the licence is limited, a description of the limitation; and
  - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;

...

### Licensing

**9.** —(1) The provisions of sections 42 to 45 of the Act shall, with the necessary modifications, apply in relation to licences to use a protected international trade mark (Singapore) as they apply in relation to licences to use a registered trade mark.

(2) The reference in section 42(2) of the Act to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which a trade mark is protected in Singapore.



### 3 TYPES OF LICENCES

A licence to use a registered trade mark may be exclusive or non-exclusive. It may also be general or limited.

#### (a) Exclusive or non-exclusive

An exclusive licence authorises the licensee to use the mark in the manner authorised by the licence, to the exclusion of all other persons, including the licensor himself (section 43(1)). Hence, the grantor of an exclusive licence cannot grant a licence to any other person, except in respect of goods and services not covered by that exclusive licence.

In granting a non-exclusive licence to one party, the grantor is still permitted to grant other non-exclusive licenses to others to use the same mark.

#### (b) General or limited

A general licence means a licence to use the mark in relation to all the goods or services for which the mark is registered.

A limited licence means the rights of the licensee are limited, for example, to some but not all of the goods or services for which the mark is registered.

#### (c) Sub-licence

A licensee may grant a sub-licence, if the licence so provides (section 42(8)). A sub-licensee may further grant a licence, if the licence or sub-licence so provides. Further hierarchies can be envisaged. References in the Trade Marks Act to a licence or a licensee include a sub-licence or a sub-licensee.

When lodging a sub-licence application, please ensure that there is also a licence application lodged or licence recorded. When filling up Form CM6 for a sub-licence application, please note that box 2 being “Particulars of registered proprietor/licensee” should contain the “Particulars of licensee” and not the “Particulars of registered proprietor”.

#### (d) Limited period licence

A licence can be for an unlimited period or it can be for a limited period and end on a specified date.

There is no need to terminate a licence if it is valid for a fixed period. It automatically expires. The licence system will automatically update the licence to an “Expired” status on the day after the licence expiry date.

## **4 APPLICATION TO RECORD A LICENCE**

### **(a) Form of application**

An application to register a license is to be made by filing Form CM6 (Application to Register, Amend or Terminate License) online at <https://ip2sg.ipos.gov.sg>. The following information is required:

#### **(i) Particulars of the grantor**

The grantor could be the registered proprietor or, in the case of a sub-licence, the licensee.

#### **(ii) Particulars of the licensee**

In the case of a sub-licence, the licensee is the sub-licensee.

#### **(iii) The duration of the licence (where applicable)**

If the licence is a limited period licence, the commencement and ending dates have to be indicated.

The licence commencement date (i.e. the date entered in Part 10 of Form CM6) should not predate the date from which the proprietor's rights in the mark accrue. For a trade mark application filed before 1/7/2004, the earliest licence commencement date is the trade mark application date or the priority date, if any. For a trade mark application filed on or after 1/7/2004, the earliest licence commencement date is the trade mark application date.

Where there are 2 or more exclusive licences, the licence periods involving the same goods or services must not overlap.

#### **(iv) Indication whether the licence is limited to certain goods/services**

If the licence does not apply to all the goods or services for which the mark is registered, a statement of the goods or services which the licence is to be recorded against has to be provided. It is to be noted that the list of licensed goods or services should not be wider than those under the trade mark registration.

#### **(v) Address for service of the grantor**

The address for service entered in Form CM6 is for the purpose of corresponding on the application to record, amend or remove the licence only. This address for service stands alone and does not update the address for service for other processes of the mark. There is no need to additionally lodge Form CM2 together with Form CM6.

Form CM2 is required only if there is a change of agent or address for service whilst Form CM6 is being processed.

**(vi) Address for service of the licensee**

**(vii) Signature by or on behalf of the grantor**

If the application filed other than by mean of electronic online system, is signed by or on behalf of the grantor, it need not be accompanied by documentary evidence establishing the transaction. This is not to say that there is no need for a licence agreement between the parties. A licence has to be in writing signed by or on behalf of the proprietor to be effective. Form CM6 is not a substitute for a licence agreement.

In the event that Form CM6 is not signed by or on behalf of the grantor of the licence, the applicant shall lodge one of the following, in addition to Form CM6:

- a certified extract of the licence contract, being an extract which shows the parties to the contract and the rights which are licensed by the contract;
- a statement of the licence containing such information as the Registrar may require, being a statement signed by both the person granting the licence and the licensee; or
- a certified copy of the documentary evidence which in the Registrar's view is sufficient to establish the grant of the licence (Rule 55(3A)(b)).

**(b) Co-Owners**

One co-owner cannot grant a licence to use the mark without the consent of the other co-owner or co-owners (section 37(4)).

However, an agent or a co-owner authorised to act for all co-owners can validate Form CM6 on their behalf.

**(c) Licence of trade mark applications for registration**

Where an application to register a licence was filed before 2/7/2007, it will be processed only after the mark has been registered. However, an application to register a licence filed on or after 2/7/2007 will be processed by the Registry even though the status of the mark is still pending registration. The relevant form to use for the application to register a license is Form CM6.

**(d) Particulars of the licence entered in the Register**

When the licence is recorded, the following details are entered in the Register:

- (i) the name and address of the licensee;

- (ii) the fact that the licence is an exclusive licence, if it is;
- (iii) where the licence is limited, a description of the limitation;
- (iv) the duration of the licence if it is for a definite period; and
- (v) the date on which the entry in the register is made.

A notification with these details is sent to the licensor, with copy to the licensee.

**(e) Assignment of licence**

If there is an assignment of a licence, the original licence should be first terminated by lodging Form CM6. Only then can the new licence be recorded by lodging a separate Form CM6.

**(f) Withdrawal of licence application**

The application to record a licence may be withdrawn before the recordal has been processed by writing in to the Registrar. The fee accompanying Form CM6, once paid, is generally not refundable. If the licence application has been processed and licence duly recorded, it cannot be withdrawn. The licence must be terminated by lodging Form CM6.

**(g) Trade mark subject of application for revocation, invalidation or rectification**

The Registrar may proceed to process a licence application even if there has been an application filed on Form TM28 for the revocation, declaration of invalidity, or rectification of the same registered trade mark.

## **5 INTERNATIONAL REGISTRATIONS**

Licences recorded in the international register in respect of International Registrations designating Singapore have no effect.

Pursuant to Rule 20*bis*(6)(b) of the Regulations under the Madrid Protocol, Singapore has notified the World Intellectual Property Organisation that it would not give effect to the recording of trade mark licences in the International Register. Accordingly, any recording of a licence made under Rule 20*bis*(3) of the Regulations will have no effect on any International Registration designating Singapore. The holder of such an International Registration may record the relevant licence with the Registry by lodging Form CM6, if he so wishes.

## **6 AMENDMENT OR REMOVAL OF REGISTERED PARTICULARS OF LICENCE**

To **remove** a licence, Form CM6, validated by the grantor of the licence or his representative, has to be lodged.

Upon recordal of the removal of the licence, a notification will be sent to the licensor informing him of the removal, with copy of this notification to the licensee.

To **amend** the terms of a licence, Form CM6, validated by the grantor of the licence or his representative, has to be lodged.

Upon recordal of the amendment, a notification with the details of the licence, including what has been amended, will be sent to the licensor, with copy to the licensee.

It is to be noted that applications to change a licensee's name or address due to errors or changes in such particulars, is to be done via Form CM2.

## **7 EXTENSION OF TIME**

In the course of processing any application relating to a licence, the Registrar may require additional information or evidence or raise any objection pertaining to the request. If so, the Registry will inform the applicant in writing, giving him a time frame of 2 months to respond. If he is unable to reply within this time, the applicant may apply for an extension of time by filing Form CM5 before the expiry of the deadline. Three or more extensions may be requested for, each with a duration of 3 months at a time. However, cogent reasons need to be given for the request if applying for the 3<sup>rd</sup> or subsequent extension before the extension is granted.

## **SLOGANS**

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## SLOGANS

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## **1. INTRODUCTION**

This chapter is concerned with the registrability of slogan marks.

## **2. RELEVANT LEGISLATION**

### **The Trade Marks Act [Cap. 332, 2005 Ed.]**

#### **Absolute grounds for refusal of registration**

**7. – (1)** The following shall not be registered:

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, and other characteristics of goods or services;

(2) A trade mark shall not be refused registration by virtue of subsection (1) (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

### 3. **THE TEST FOR ASSESSING THE REGISTRABILITY OF SLOGANS**

The fact that slogans may be used for advertising and promotional purposes does not exclude the registration of slogans as trade marks.

The test for assessing the distinctive character of slogans under the Trade Marks Act (the “**Act**”) is no different than that for traditional signs such as words, logos and figurative marks. It would not be appropriate to apply criteria which are stricter than those applicable to these traditional signs to slogans.

However, slogans may not be so readily accepted by the relevant public as an indication of trade source because of their inherent promotional and advertising quality, unlike traditional signs such as words, logos and figurative marks.

In other words, the perception of the relevant public is not necessarily the same in relation to each of those categories of marks, and it may therefore prove more difficult to establish the distinctiveness of marks comprising slogans than traditional signs. In assessing whether a slogan qualifies as a badge of origin, the Registry may take account of the fact that average consumers are not in the habit of making assumptions about the origin of goods or services on the basis of slogans (see *Case C-64/02 P, OHIM v Erpo Möbelwerk*).

As a general guide, as with any sign for which registration is sought, the following should be considered when assessing whether a mark comprising a slogan qualifies for registration under the Act:

1. The distinctiveness of a mark must be assessed, firstly, by reference to the goods and services in respect of which protection is sought and, secondly, by reference to the way in which the mark is perceived by the relevant public, constituted by average consumers of those goods or services.
2. A mark shall not be registered if at least one of the possible meanings of the mark is capable of designating a characteristic of the relevant goods or services.
3. The fact that no one else uses the mark does not make the mark automatically distinctive.
4. The obviousness of the description need not be fatal to the application if the mark is an unusual way of conveying a descriptive message.
5. It is not necessary for the mark to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness.

#### **4. SLOGANS OBJECTIONABLE UNDER SECTION 7 OF THE ACT**

Marks comprising slogans may be objectionable under Section 7(1)(b) and/or (c) of the Act.

##### **4.1 Objection under Section 7(1)(c) of the Act**

A slogan which consists exclusively of terms which may serve, in trade, to designate the characteristics of the goods and services is not registrable. Such characteristics would include the “quality” as well as “intended purpose” of the goods or services.

**Not acceptable**

**PROPER SIZE. PERFECT FIT.**

in respect of clothing and shoes

**Not acceptable**

**EDUCATION IS OUR BUSINESS**

in respect of education services

##### **4.2 Objection under Section 7(1)(b) of the Act**

The fact that a slogan does not convey any information with regard to the nature of the goods or services concerned does not mean that it possesses an inherent capacity to distinguish.

In other words, a slogan that is not exclusively descriptive of the relevant goods and services may nevertheless be devoid of any distinctive character, that is, it is incapable of denoting the trade origin of the goods and services.

It should be noted that the grounds of distinctiveness and descriptiveness, although overlapping to some extent, are independent grounds for refusing registration and should be separately examined and considered.

**Not acceptable**

**WHERE BRANDS MEET PEOPLE**

in respect of advertising, publicity and brand  
management services

**Not acceptable**

**THE DOCUMENT COMPANY**

in respect of paper products and paper  
manufacturing services

## 5. **FACTORS TO BE CONSIDERED IN ASSESSING THE REGISTRABILITY OF SLOGANS**

### **5.1 Normal or common way of referring to the goods and/or services or of their characteristics**

Slogans are deemed descriptive if they consist of a word combination that an average consumer would regard as a normal or common way of referring to the goods and services or of representing their essential features.

#### **Not acceptable**

#### **MAKES LIFE BETTER**

- Class 7: Machines and machine tools, among others
- Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media, among others
- Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, among others

*(Re an Application for a mark “MAKES LIFE BETTER” by Aki Habara Electric Corporation Pte Ltd in Classes 7, 9 and 11,[2004] SGIPOS 13)*

The mark was objected to under Sections 7(1)(b) and 7(1)(c) of the Act.

The mark was found to be non-distinctive on the basis that it was unable to distinguish the goods claimed from goods of other traders in the absence of any prior use. The relevant consumer would have to be educated by the salesman that the slogan was the brand name of the claimed goods. It was held that while the words “Makes Life Better” did not describe what the products are, they described “what can be attained by using these electronic products – a better life”, thus designating the kind of goods and quality of the goods or intended purpose of the goods under Section 7(1)(c) of the Act.

#### **Not acceptable**

#### **HOME CALLS FOR COMPUTERS**

- Class 37: Repair, maintenance and installation services
- Class 42: Design and development of computer hardware and software services

*(Decision of the Intellectual Property Office of New Zealand, Trade Mark Application No. 802604)*

The mark was objected to under, among others, Section 18(1)(c) of the New Zealand Trade Marks Act 2002 (which is equivalent to Section 7(1)(c) of the Act).

The mark was found to “simply describe the nature of the services for which the Applicant sought registration”, and was also “apt for [the] normal description of the Applicant’s services” for which registration was sought. It was further decided that the average consumers would

“immediately understand” that the Applicant provided home call services for computers, and hence objectionable.

**Not acceptable**

**GUARANTEED TO KEEP YOU DRY**

- Class 24: Textiles and textile goods, not included in other classes; bed covers; table covers  
Class 25: Clothing, footwear, headgear

*(Decision of the Intellectual Property Office of Hong Kong, Trade Mark Application No. 300709984)*

The mark was objected to under, among others, Section 11(1)(c) of the Trade Marks Ordinance (Cap.559) of Hong Kong (which is equivalent to Section 7(1)(c) of the Act).

The mark was found to be descriptive of the goods claimed, because the combination of the words was a mere assurance to the relevant consumer that the goods would prevent them from getting wet. The message conveyed by the mark was therefore “loud and clear”.

In light of the clear message being conveyed by the mark, it will be perceived as a designation of a characteristic of the goods in question and not as an identifier of trade source. The mark was on this basis also found to be non-distinctive.

**Acceptable**

**DAZ PRINZIP DER BEQUEMLICHKEIT  
 (“THE PRINCIPLE OF COMFORT”)**

- Class 8: Tools (hand-operated); cutlery  
Class 12: Land vehicles and parts therefor  
Class 20: Household furniture, in particular upholstered furniture, seating, chairs, tables, unit furniture, as well as office furniture

*(Case C-64/02 P, OHIM v Erpo Möbelwerk)*

In the case above, although the message conveyed is clear, it is not usual or common for the word “comfort” to be prefaced with “The principle of”. The slogan, as a whole, is an unusual way of conveying a descriptive message.

## **5.2 Pure promotional statements**

Slogans which the relevant public perceive as mere promotional statements and not indicative of the commercial origin of the goods and services in question cannot be registered.

This however does not mean that all promotional statements are devoid of distinctive character and not registrable.

An advertising slogan is likely to be distinctive if, apart from its promotional function, the public perceives it as an indication of the commercial origin of the goods or services in question.

### **Not acceptable**

#### **A UNIQUE EXPERIENCE...MINT**

Class 30: Confectionery, chewing gum, bubble gum, candy, mints, drops and lozenges

*(Case R 1733/2011-2, WM Wrigley JR Company v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) and (c) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) and (c) of the Act).

The mark was found to be non-distinctive on the basis that it was a plain and banal incitement to consumers to purchase the goods claimed based on a straightforward promise of their unique taste. On a holistic assessment, it was observed that the mark was self-explanatory that conveyed a laudatory message immediately discernible by the relevant consumer, that is, that the consumer would experience an extraordinary, unique and remarkable mint-flavoured taste sensation upon consuming the claimed goods. Accordingly, the mark could not be said to designate a specific commercial origin since it referred to a desirable feature of the goods claimed.

### **Not acceptable**

#### **Building Tomorrow's Enterprise**

Class 35: Advertising, business management, business administration and office functions, among others  
 Class 36: Insurance, financial affairs, monetary affairs and real estate affairs  
 Class 38: Telecommunications, among others  
 Class 42: Design and development of computer hardware and software services, among others

*(Case R 374/2014-2, Infosys Limited v OHIM)*



The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act).

The mark was found to be non-distinctive on the basis that apart from its promotional meaning, the slogan “Building Tomorrow’s Enterprise” did not contain any element that enables the relevant public to immediately perceive it as an indication of the commercial origin of the services sought to be registered.

Even though the mark possessed some graphical elements (that is, the positioning of the words and differences in colour), it was held that it was common for promotional purpose to use common graphical methods to mix the size and colours of the letters and words in a mark and to place the words one below the other, and that the public was used to seeing such banal features and would therefore not give these features any significance beyond a pure promotional function. Hence, the effect of the graphical elements was limited and was unable to divert the attention of the relevant public from the clear and unambiguous laudatory meaning resulting from the expression “Building Tomorrow’s Enterprise”.

**Not acceptable**

### **FEEL THE DIFFERENCE**

Class 5: Infant foods; milk and milk powder for infants  
 Class 29: Milk and milk products in this Class; other goods which include milk or milk products and ingredients

*(Case R 2276/2011-2, A2 Corporation Limited v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act).

The mark was found to be non-distinctive as the meaning of the mark in connection with the claimed goods did not amount to anything more than a plain laudatory message that the claimed goods are different from a competitor’s goods. It was observed that the mark did not constitute a play on words, nor did it possess any element of originality or resonance to make it easy to remember. Accordingly, it was decided that there was nothing in the expression beyond its obvious and promotional meaning to enable the relevant public to memorise it instantly as a distinctive mark for the goods concerned. The mark was therefore rejected because it was banal, with a clear and unambiguous meaning.

**Not acceptable**

### **BETTER MARKETS MAKE A BETTER WORLD**

Class 36: Financial services, namely institutional sales and trading, execution services, principle trading, liquidity providing, market making, and operating a market for matching buy and sell orders

*(Case R 826/2013-1, KCG IP Holdings LLC v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act).

The mark was found to be non-distinctive. It was observed that the mark merely promoted the claimed services as providing “better (financial) markets, which in consequence, make a better world”. In other words, the mark would directly lead the average consumer to understand that “secure and reliable markets lead to empowered investors and efficient deployment of capital”.

In respect of the structure and wording of the mark, although there was a repetition of the word “BETTER” and alliteration of the letter “M” in the words “MARKETS” and “MAKE”, it was held that these characteristics were simple and popular in advertising language in respect of enhancing the overall promotional character of the expression, but did not assist the average consumer in regarding the mark as an identifier of trade source.

### Acceptable

#### **WE RESTORE, YOU RECOVER**

- Class 37: Carpet upholstery and drapery cleaning, and spot and stain removal services; air-dust cleaning services; disaster restoration services, namely, restoring building interiors, carpet and furnishings damages by fire, water, smoke and other disasters; carpet repair services; commercial and residential building cleaning services;
- Class 40: Carpet, upholstery and drapery odour removal services; providing carpet and upholstery dyeing, tinting and colourising services; mould inhibition services of buildings and their contents.

*(Case R 2197/2011-2, Rainbow International Carpet Dyeing and Cleaning Company v OHIM)*

The mark was found to be registrable on the basis that the word combination did not consist conclusively of a sign which designated the services in question directly. Instead, it was observed that as a whole, the mark conveyed an “intention or promise on the part of the proprietors, and the effect of the promised restoration”, and did not imply a “sufficiently direct and specific relationship between the mark and services (for which registration [was] sought)”.

Additionally, it was determined that the mark “openly embodied a play on words” – while the primary clause “WE RESTORE” merely informed the average consumer that the applicant is involved in restoration services, the secondary clause “YOU RECOVER” had an “unexpected meaning”, because it could be interpreted as the average consumer “recovering” a lost item or one’s health, stability or peace of mind after a shock, illness, disappointment or trauma. Accordingly, it was found that the mark had a double meaning, and this linguistic trick was “surprising and unexpected”, therefore imparting distinctive quality to the mark as a whole.

### **5.2.1 Abbreviated/ Ungrammatical slogans**

It is to be borne in mind that in advertising, it is customary to use shorthand when promoting goods and services to capture the attention of potential customers. Phrases used in advertising may not always be confined to strict grammatical usage.

Therefore, the fact that a slogan is abbreviated or not strictly grammatical does not mean that the mark possesses the sufficient distinctive character for registration.

**Not acceptable**

**ONLY JEANS WEAR**

Class 25: Clothing, footwear and headgear

*(Case R 153/2000-1, Holdingselskabet af 25/3-1983 A/S v OHIM)*

The slogan consists of three ordinary English words which immediately inform consumers that the goods in question are made from jeans material. Although the expression is ungrammatical, this does not outweigh the descriptive nature of the mark so as to impart distinctive character for the purposes of registration.

**Not acceptable**

**AMAZING STARTS NOW**

Application filed in respect of goods in Classes 7, 9 and 11

*(Case R 1124/2013-1, Samsung Electronics Co. Ltd v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act). The slogan conveys a promise that the claimed goods will immediately provide an amazing experience to the consumer. The relevant consumer would generally not expect advertising slogans to be precise or to fully describe the characteristics of the goods and services. Rather, it is a common characteristic of advertising slogans to merely convey abstract information of the claimed goods and services. In other words, it is customary in trade to use short and succinct phrases when promoting the goods or services so as to capture the attention of potential customers. They are not intended to provide a full picture about the goods or services being advertised.

In this case however, the fact that “amazing starts now” contains a grammatical flaw does not alter the perception of the relevant public to view the expression as laudatory. The flaw does not stop the consumer from understanding the expression nor does it add any element which would open the expression to any additional interpretation.

**5.2.2 Exaggeration**

An average consumer is reasonably well-informed, observant and circumspect.

Such a consumer would be exposed to a wide range of techniques used by traders in advertising their goods and services. The consumer will be aware that exaggerated expressions are

commonly employed by traders for advertising purposes. Such expressions would not, however, be perceived by consumers as an indicator of trade origin.

### Not acceptable

#### ENDLESS POSSIBILITIES

Class 18: Handbags; covers for interchangeable handbags; purses, general tote bags, luggage, waist packs, and duffle bags

*(Case R 122/2013-1, Miche Bag, LLC v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act).

The mark was found to be non-distinctive as the relevant consumer would understand the expression “**ENDLESS POSSIBILITIES**” immediately as a laudatory indication that the claimed goods provided the consumer with manifold appearances, functions and/or facilities. Additionally, it was observed that in relation to handbags with multiple functions and facilities, the mark clearly and directly indicated, with some promotional exaggeration, that the average consumer had endless possibilities to change their appearance and/or functions. It was also determined that the mark “delivered a laudatory message, which, albeit abstract, can be related to the goods, and the relevant public [had] no reason to enter into any further analysis of interpretation which would endow the expression with a certain originality and resonance which [made] it easy to remember”.

### **5.3 Value statements**

Value statements which are straightforward and could apply to any undertaking are devoid of any distinctive character.

For example, “**CARING FOR THE ENVIRONMENT**” for recycling services, “**LOVE PEOPLE, RESPECT PEOPLE**” for consultancy services, “**CHERISH THE OLD**” for nursing home services, and “**FIGHT FOR JUSTICE**” for legal services would be examples of value statements which are objectionable as trade marks.

### **5.4 Inspirational or motivational statements**

Inspirational or motivational types of slogans are considered to be non-distinctive particularly for services.

For example, “**GIVE YOUR BEST**” for sports coaching services, “**GO FOR IT**” for training services, “**UNLOCK YOUR POTENTIAL**” for education services and “**BELIEVE IN YOURSELF**” for counselling services would be examples of inspirational or motivational statements which are objectionable as trade marks.

### **5.5 Customer service statements**

Simple and straightforward statements about customer service that could apply to any undertaking have no distinctive character, and thus objectionable as trade marks.

**Not acceptable**

**SMARTER. BOLDER. FASTER.**

Class 36: Real estate brokerage services

*(Re Trade mark application number 1502579(36) “SMARTER. BOLDER.FASTER.” in the name of Century 21 Real Estate LLC, [2014] ATMO 15)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act). The mark was objected to on the ground that it lacked inherent distinctiveness. It was found that any real estate brokerage, without improper motive, would wish to claim that their sales staff were “smarter, bolder, and faster”, and was therefore not distinctive of the Applicant.

**Not acceptable**

**WITH YOU AT EVERY STEP**

Class 41: Educational and training services relating to diseases and disorders in the field of neuroscience; arranging and conducting classes, seminars and workshops relating to diseases and disorders in the field of neuroscience;  
Class 44: Medical services in the field of neuroscience; medical information in the field of neuroscience.

*(Case R 1572/2013-2, Novartis AG v OHIM)*

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to Section 7(1)(b) of the Act). There is nothing in the slogan that might, beyond its obvious promotional meaning, enable the relevant consumer to memorise it easily and instantly as a distinctive mark for the services concerned. Educational and medical services are typically the kind of services where the client needs to be accompanied, and needs support at every step. The sign applied for is not being rejected merely because it is a promotional slogan, but rather because it is a banal informative slogan, with a clear and unambiguous laudatory meaning.

### **5.6 Commonplace salutations**

Salutations such as “**HAPPY BIRTHDAY TO YOU**”, “**THANK YOU SO MUCH**”, “**SO LONG FAREWELL**” and “**MERRY CHRISTMAS**” are prefatory greetings or well-wishing statements which are often used on many goods and services.

Consumers are more likely to perceive such slogans as a common salutation rather than a trade mark denoting trade origin of the goods and services claimed. Therefore, these salutations would be objectionable as trade marks.

### **5.7 Personal statements**

Personal statements in the form of slogans such as “**I ♥ SINGAPORE**”, “**HERE COMES TROUBLE**”, “**DO YOU LIKE ME**” are often used on goods such as T-shirts, bandanas or badges.

Consumers are more likely to perceive such slogans as a personal statement about the wearer/user or a personal statement by the wearer/user of the goods claimed rather than a trade mark denoting the trade origin of the goods. Therefore, these personal statements would be objectionable as trade marks.

### **5.8 Use of slogans by other traders**

The assessment of the registrability of an expression is to be based on the nature of the trade mark itself – not by reference to whether traders other than the applicant are using the expression in relation to similar goods and services.

However, if other traders are using the expression, that fact may confirm a finding that the mark is an expression of everyday speech, used in common parlance, or uses no element of fancifulness, sense of humour or surprise. Therefore, such an expression lacks the inherent capacity to distinguish the applicant’s goods and services from those of others.

Even if the applied-for expression has not been used by other traders, the applicant’s pioneer use of it does not attribute to the overall distinctiveness of the mark. Assessment of distinctiveness of a mark is based on whether it is perceived as a badge of trade origin.

## **6. ENHANCING REGISTRABILITY OF SLOGANS**

The fact that slogans may be used for advertising and promotional purposes does not exclude the registration of slogans as trade marks.

To enhance the prospects of registrability of a slogan mark, it is essential that there must be elements in the slogan which assist the relevant consumer to regard the slogan as an indicator of source of the goods and services claimed, beyond the inherent promotional nature of the slogan.

### **6.1 Ambiguity**

Ambiguity may enhance the prospects of acceptance of a slogan mark.

However, the mere fact that the meaning of a mark is ambiguous or is not strictly grammatically accurate does not necessarily mean that the mark is registrable.

A slogan with two meanings will be objectionable if one of them describes a characteristic of the goods or services.

**Not acceptable**

### **GIVING YOU YOUR PERSONAL SPACE**

Class 39: Provision of storage facilities for use by others

#### ***Example 6.1.1***

In the example above, there could be more than one interpretation of the mark. It can yield the meaning of “giving a person space to breathe or to think through things”, or the literal meaning of “providing personal storage space”. Considering that one of the meanings is descriptive of the intended services (“provision of storage facilities for use by others”), the mark will be objected to under Section 7(1)(c) of the Act.

**Acceptable**

### **OWN THE TREE**

Class 8: Hand tools and implements (hand-operated); axes.

#### ***Example 6.1.2***

The expression applied for constitutes a play on words and is imaginative. The linguistic trick is surprising and unexpected, and the mark requires a degree of interpretation of the relevant public that is being exposed to it. The play on words can therefore be expected to set off a cognitive process in the minds of the relevant public.

**Acceptable****SITEINSIGHTS**

Application filed in respect of goods and services in Classes 9, 35 and 42

(Case R 879/2011-2, *IgnitionOne N.V. v OHIM*)

**Example 6.1.3**

The mark is found to possess some degree of originality and expressiveness that makes it easy to remember. It should be observed that ‘SITEINSIGHTS’ contains a play on words as the words ‘SITE’ and the part ‘SIGHT’ in ‘INSIGHTS’ are homonyms.

**6.2 Inclusion of “house” mark**

Generally, the addition of a house mark to a slogan may enhance the overall distinctive character of a slogan, and therefore enhance the prospect of registrability of a slogan, particularly where the house mark is itself, a distinctive trade mark.

For example, while “**HAVE A BREAK**” for chocolate confectionery may not be registrable, “**HAVE A BREAK, HAVE A KIT-KAT**” would be registrable on the basis that “KIT-KAT” as the house mark has distinctive character, and can impart a unique quality to the mark such as to enhance the overall registrability of the mark.

**6.3 Overcoming absolute grounds: acquired distinctiveness**

Notwithstanding that a mark may fall afoul of the grounds in Sections 7(1) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under Section 7(2) of the Act.

In assessing the acquired distinctiveness of a mark, the following may be taken into account:

- (i) the market share held by the mark;
- (ii) how intensive, geographically widespread and long standing use of the mark has been;
- (iii) the amount invested by the undertaking in promoting the mark;
- (iv) the proportion of the relevant class of persons who, because of the mark, identify goods or services as originating from a particular undertaking;
- (v) statements from chambers of commerce and industry or other trade and professional associations.



The Registrar will consider whether there has been use of a mark as a trade mark, and whether as a result of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (see *Windsurfing Chiemsee Productions v Boots (Case C-108/97)*). It is not sufficient that consumers may be caused to wonder whether or not this might be the case or simply be ‘reminded’ of the undertaking concerned. The best evidence will be of the mark being used on its own, without any other trade mark, so that the slogan may be taken as an indication of origin and not merely as informational or otherwise non-trade mark matter.

### **Acceptable**

#### **NO MORE TEARS**

Application filed in respect of goods in Classes 03 and 05

*(Community Trade Mark application number 003429883; United Kingdom registration number 1500571)*

#### ***Example 6.3.1***

In the case above, the mark was refused on the basis that it would merely be perceived as a laudatory slogan informing that the goods are “gentle and will not sting or produce tears”. It was noted that the mark proceeded to registration in the UK and OHIM on the basis of distinctiveness acquired through use.

(Reference should be made to the Trade Marks Work Manual’s section on Evidence of Distinctiveness Acquired Through Use for more information.)

## **COLLECTIVE MARKS**

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**COLLECTIVE MARKS**

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## **1. INTRODUCTION**

This chapter deals with collective marks – what they are, how they differ from “ordinary” trade marks and how they would be examined and processed at the Registry.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Collective marks**

**60.** (1) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

(2) The provisions of this Act shall apply to collective marks subject to the provisions of the First Schedule.

*[UK Trade Marks Act 1994, s. 49; Aust. Trade Marks Act 1995, s. 162]*

#### **First Schedule**

##### **General**

1.—(1) The provisions of this Act shall apply to collective marks subject to the following provisions.

(2) For the purposes of this Schedule, “published” means made available to the public (whether in Singapore or elsewhere), and a document shall be taken to be published if it can be inspected as of right at any place in Singapore by members of the public, whether on payment of a fee or not.

##### **Signs of which a collective mark may consist**

2. In relation to a collective mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association.

##### **Indication of geographical origin**

3.—(1) Notwithstanding section 7(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

### **Mark not to be misleading as to character or significance**

4.—(1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

### **Regulations governing use of collective mark**

5.—(1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

(3) Further requirements with which the regulations have to comply may be imposed by rules made under this Act.

### **Approval of regulations by Registrar**

6.—(1) A collective mark shall not be registered unless the regulations governing the use of the mark —

- (a) comply with paragraph 5(2) and any further requirements imposed by rules; and
- (b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the Registrar and pay the prescribed fee.

(3) If the applicant does not comply with sub-paragraph (2), the application shall be treated as withdrawn.

7.—(1) The Registrar shall consider whether the requirements mentioned in paragraph 6(1) are met.

(2) If it appears to the Registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(3) If the applicant responds within the specified period but fails to satisfy the Registrar that those requirements are met, or to file regulations that have been amended so as to meet those requirements, the Registrar may refuse the application.

(3A) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 13.

8. The regulations shall be published and notice of opposition may be given relating to the matters mentioned in paragraph 6(1), in addition to any other grounds on which the application may be opposed.

### **Regulations to be open to inspection**

9. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

### **Amendment of regulations**

10.—(1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations the Registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given relating to the matters mentioned in paragraph 6(1).

### **Infringement: rights of authorised users**

11. The following provisions shall apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark:

- (a) section 27(5);
- (b) section 82.

12.—(1) The following provisions (which correspond to the provisions of section 44) have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

(2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor —

- (a) refuses to do so; or
  - (b) fails to do so within 2 months after being called upon,
- the authorised user may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by virtue of this paragraph, the authorised user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(5) Sub-paragraph (4) does not affect the granting of interlocutory relief on an application by an authorised user alone.

(6) A proprietor who is added as a defendant as mentioned in sub-paragraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised users shall be taken into account; and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

### **Grounds for revocation of registration**

13. Apart from the grounds of revocation provided for in section 22, the registration of a collective mark may be revoked on the ground —

- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1); or
- (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
- (c) that an amendment of the regulations has been made so that the regulations —
  - (i) no longer comply with paragraph 5(2) and any further conditions imposed by rules; or
  - (ii) are contrary to public policy or morality.

### **Grounds for invalidity of registration**

14. Apart from the grounds of invalidity provided for in section 23, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1).

## **Trade Marks Rules**

### **Application of Rules to collective marks and certification marks**

62.—(1) Except as provided in this Part, the provisions of these Rules shall apply in relation to collective marks and certification marks as they apply in relation to ordinary trade marks.

(2) In case of doubt in applying the provisions of these Rules, any party may apply to the Registrar for directions.

(3) The address of the applicant for the registration of a collective mark or certification mark shall be deemed to be the trade or business address of the applicant for the purposes of rule 9(4)(o).



## **Filing of regulations**

63. Within 9 months after the date of the application for the registration of a collective mark or certification mark, the applicant must file with the Registrar —

- (a) Form TM 10; and
- (b) a copy of the regulations governing the use of the mark.

## **Filing of amended regulations**

64.—(1) The filing of amended regulations pursuant to paragraph 7(2) of the First Schedule to the Act in relation to a collective mark or paragraph 8(2) of the Second Schedule to the Act in relation to a certification mark shall be made in Form TM 10.

(2) Form TM 10 shall be accompanied by a copy of the amended regulations with the amendments shown in red.

## **Opposition to registration**

65.—(1) Any person may, within 2 months after the date of the publication of an application for registration of a collective mark or certification mark, give written notice to the Registrar in Form TM 11 opposing the registration; and rules 29 to 40 shall apply, with the necessary modifications, to the proceedings thereon.

(2) [Deleted by S 852/2005]

(3) In case of doubt, any party may apply to the Registrar for directions.

## **Amendment of regulations**

66.—(1) An application for the amendment of the regulations governing the use of a registered collective mark or certification mark shall be filed with the Registrar in Form TM 10.

(2) The application shall be accompanied by a copy of the amended regulations with the amendments shown in red.

(3) Where it appears expedient to the Registrar that the amended regulations should be made available to the public, the Registrar may publish a notice indicating where copies of the amended regulations may be inspected.

## **Opposition to amendment of regulations**

66A.—(1) Any person may, within 2 months after the date of the publication of the notice referred to in rule 66(3), file with the Registrar —

- (a) a notice of opposition to the amendment to the regulations in Form TM 11; and
- (b) a statement indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of the First Schedule to the Act, or paragraph 7(1) of the Second Schedule to the Act, as the case may be.

(2) The person filing the notice and statement under paragraph (1) shall, at the same time, serve copies of the notice and statement on the proprietor.

(3) Rules 29(3) to (7) and 31 to 40 shall, with the necessary modifications, apply to the proceedings thereon as they apply to an opposition to an application for registration of a trade mark.

(4) For the purposes of the application of the rules referred to in paragraph (3) —

- (a) references in those rules to the applicant shall be treated as references to the applicant for the amendment of the regulations;
- (b) references in those rules to the application shall be treated as references to the application for the amendment of the regulations;
- (c) references in those rules to the date of the publication of the application for registration shall be treated as references to the date of the publication of the notice referred to in rule 66(3);
- (d) references in those rules to the notice of opposition shall be treated as references to the notice and statement referred to in paragraph (1); and
- (e) references in those rules to the opponent shall be treated as references to the person who filed the notice and statement referred to in paragraph (1).

### 3. **DISTINCTION BETWEEN COLLECTIVE MARKS AND "ORDINARY" TRADE MARKS**

Section 60 of the Act defines a collective mark as "a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association".

The main feature of a collective mark is that it serves as a badge of origin, to indicate that the goods or services originate from members of a particular association. In this way, it is similar to an "ordinary" trade mark as they both function as badges of origin.

A collective mark is typically used by companies alongside their own trade marks to indicate their membership in a certain association.

Collective marks do not necessarily certify the quality of the goods/services, although this is sometimes the case.

Sometimes, the same sign could be applied for either as a collective mark or an "ordinary" trade mark. Differences between them do not depend on the signs per se, but rather on other factors such as ownership and use of the mark.

<i>Comparison Table</i>	
Collective Mark	"Ordinary" Trade Mark
<ul style="list-style-type: none"> <li>Serves as a badge of origin to distinguish goods or services of members of a particular association from those who are not members of the association</li> </ul>	<ul style="list-style-type: none"> <li>Serves as a badge of origin to distinguish goods or services of one trader (i.e., a single trade source or entity) from those of other traders</li> </ul>

## 4. EXAMINATION OF COLLECTIVE MARKS

### 4.1 Distinctiveness

Collective marks must be examined for distinctiveness just like in the case of “ordinary” trade marks. When considering the distinctiveness of a collective mark it is important to appreciate that the distinguishing function of collective marks differs from that of “ordinary” trade marks.

Paragraph 2 of Schedule 1 of the Act provides:

*"In relation to a collective mark, the reference in the definition of "trade mark" in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association."*

Unlike an “ordinary” trade mark, which, distinguishes the origin of goods or services of one trader from those originating from another trader, collective marks serve to distinguish the origin of goods or services of members of a particular association from the goods or services of non-members.

A mark which is purely descriptive of a characteristic of the goods or services or which is already in common usage by more than one organisation would not be able to distinguish goods or services provided by suppliers of the goods/services belonging to a particular association from those of other suppliers of the goods/services not belonging to the association. As such, they would be objected to under section 7(1)(b), (c) and/or (d) of the Act.

#### **Not Acceptable**

#### **“Professional Photographers”**

##### ***Example 4.1.1***

For example, a collective mark which merely reads “Professional Photographers”, would be objected to under section 7(1)(b) and section 7(1)(c) of the Act. First, the mark is purely descriptive of the quality of photographers generally, and secondly, the mark does not distinguish the services of photographers who are members of an association from those rendered by other photographers who are not members of the association. Thus, such marks are generally not acceptable, even if the name has not been used by one or more other associations.

### 4.2 Geographical names

Geographical names (and other such signs or indications) are usually not registrable as “ordinary” trade marks and would be objected to under section 7(1)(c) of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration.

(Reference should be made to the Trade Marks Work Manual’s section on Geographical Names for general guidelines on when a geographical name is registrable as a trade mark.)

However, paragraph 3(1) of Schedule 1 of the Act provides:

*"Notwithstanding section 7(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services."*

This means that the Registrar has a discretion (note that this is not an automatic right of acceptance) to accept geographical names as collective marks. In general, the Registrar will accept geographical name only if it is capable of distinguishing goods or services of members of an association from those of non-members. In exercising this discretion, the Registrar will look at existing practices in the market and consider whether due to custom and practice, the geographical name is capable of performing this distinguishing function.

It should be noted that paragraph 3(2) of the First Schedule provides that if a geographical name is accepted for registration, the proprietor of such a mark is not entitled to prohibit the use of the name in accordance with honest practices, in particular, by a person who is entitled to use the geographical name.

### **4.3 Geographical indications (GIs)**

An application to register an "ordinary" trade mark which consists solely of a GI would face insurmountable objections as GIs should not be monopolised by any single trader. Furthermore, the function of a GI is to guarantee geographical origin and not trade origin. However, GIs are registrable as collective marks where for example, the applicant association is the association of producers of the goods protected by the GI.

### **4.4 Evidence of acquired distinctiveness**

Section 7(2) of the Act provides that a trade mark shall not be refused registration by virtue of section 7(1)(b), (c) or (d) of the Act, if, before the application date for registration, it has in fact acquired a distinctive character as a result of the use made of it.

This provision applies to applications for collective marks as well.

In proving acquired distinctiveness, the applicant needs to show that the mark has become capable of distinguishing goods or services of members of an association from those of non-members, by the date of application. It is not essential that the mark should have been used that way prior to the relevant date.

In other words, the test is whether consumers have been educated as to the distinguishing function of the mark and not whether consumers have been educated who is providing the goods or services in the course of trade.

(Reference should be made to the Trade Marks Work Manual's section on Evidence of Distinctiveness Acquired Through Use for general guidelines on the determination of acquired distinctive character through prior use made of the mark.)

### **4.5 Other absolute grounds of refusal**

The other absolute grounds of refusal applicable to collective marks include the following:

- That the collective mark consists exclusively of certain shapes (thus objectionable under section 7(3) of the Act);
- That the collective mark is contrary to public policy or morality (thus objectionable under section 7(4)(a) of the Act);
- That the collective mark which is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service) (thus objectionable under section 7(4)(b) of the Act);
- That the use of the collective mark is prohibited in Singapore (thus objectionable under section 7(5) of the Act);
- That the collective mark was applied for in bad faith (thus objectionable under section 7(6) of the Act); and
- That the collective mark in question is the subject of a national emblem protected under section 56 and section 57 of the Act (thus objectionable under section 7(11) of the Act).

#### **4.6 Existence of prior conflicting mark(s)**

The process of examination of collective marks also involves a search of the register to ascertain if there are any earlier marks (certification, collective or "ordinary" trade marks) which conflict with the subject application.

##### **4.6.1 Where there is an earlier identical certification or "ordinary" trade mark for the same goods or services**

In the event that the search reveals the existence of an earlier identical certification or "ordinary" trade mark for the same goods or services, this would be taken as prima facie evidence that the mark cannot serve the function of distinguishing goods / services of members of an association from those of non-members (thus objectionable under section 7(1)(b) of the Act) and is liable to mislead the public as regards the character or significance of the mark (thus objectionable under paragraph 4 of the First Schedule of the Act).

These objections cannot be overcome with consent from the proprietor of the earlier conflicting mark. The fact that the proprietor of the earlier conflicting mark is the owner of the subject collective mark is also irrelevant.

If the prior conflicting mark and the subject collective mark belong to the same proprietor, it is possible to convert the mark type of the subject mark or to voluntarily cancel the prior conflicting mark in order to overcome the objection.

Further, the existence of the prior conflicting mark may also give rise to an objection under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual's section on Relative Grounds for Refusal of Registration for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

4.6.2 Where there is an earlier identical or similar collective mark for identical or similar goods or services in the name of a different owner

In the event that the search reveals the existence of an earlier identical or similar collective mark for the identical or similar goods or services, the subject collective mark may be objectionable under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual's section on Relative Grounds for Refusal of Registration for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.).

4.6.3 Where there is an earlier similar certification or "ordinary" trade mark and the goods or services are only similar in the name of a different owner

Where there is an earlier similar certification or "ordinary" trade mark and the goods / services are only similar, acceptance of the mark for registration may be possible.

The key factors for consideration by the Examiner are the degree of similarity between the respective marks and the goods or services covered by the respective marks.

The Examiner must be satisfied that there is no real likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual's section on Relative Grounds for Refusal of Registration for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

**4.7 Correcting the nature of the mark**

Applicants may change the nature of the trade mark application, for example from an "ordinary" trade mark to a collective mark or vice versa. This is not considered a correction that materially alters the meaning or scope of the application and will therefore be allowed.

## **5. MARK NOT TO BE MISLEADING AS TO CHARACTER OR SIGNIFICANCE**

A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if the mark applied for is likely to be taken as something other than a collective mark (see paragraph 4 of the First Schedule to the Act).

This means that an objection will be raised if the mark is likely to be taken as something other than the true designation of the mark, i.e. that it is more likely to be taken as an "ordinary" trade mark as opposed to a collective mark.

To overcome this objection the Registrar may require that the mark include some indication that it is a collective mark (paragraph 4(2) of First Schedule of the Act). This may be made in one of the following ways:

- Include the following statement in the regulations:  
*"It is a condition that the mark shall not be used in Singapore in any manner including use in advertisement or any form of publicity in Singapore without indicating that it is a collective mark."*
- Amend the representation of the mark to include the words "collective mark" within the representation of the mark. This form of amendment is permissible notwithstanding section 14(3) of the Act.



## **6. SPECIFICATION OF GOODS AND/OR SERVICES FOR COLLECTIVE MARKS**

As with "ordinary" trade marks, collective marks must be filed in respect of specific goods and/or services in the appropriate classes under the International Classification of Goods and Services (ICGS).

The specification for collective marks should denote the goods and services being provided by members of the applicant association users (as opposed to the goods and services of the applicant). This is because when in use, the collective mark would appear on the goods and services of members of the association.

All applicants are reminded that failure to use a collective mark in the appropriate manner may render it vulnerable to revocation for non-use.

## **7. STATUS OF THE APPLICANT**

The applicant/proprietor of a collective mark must be an association (paragraph 2 of the First Schedule of the Act). This could be an association of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have legal capacity to hold property in their own name.

If it is apparent from the applicant's name or from the content of the regulations that the applicant is not an association or has no legal personality, then the Examiner may raise an objection on this ground.

## **8. EXAMINATION OF THE REGULATIONS**

### **8.1 Requirement of regulations**

An applicant seeking registration of a collective mark must file a copy of the regulations governing the use of the collective mark with the Registry within 9 months after the date of the application (see rule 63 of the Trade Marks Rules), failing which, the application shall be treated as withdrawn (paragraph 7(3A) of the First Schedule of the Act).

The applicant may apply for an extension of time if more time beyond 9 months from the date of application is required to compile the regulations. As with any extension of time applied for under the Act, the application for extension of time is made by way of filing Form CM5 together with the requisite fee (if any), and the request should be accompanied by adequate reasons explaining why the extension of time is required (if applicable).

For ease of reference and clarity, the regulations should be incorporated in a single document providing the required information (see below). An applicant may attach supplementary documents by way of annexure to the regulations and cross reference to them in the regulations but such documents cannot themselves constitute the regulations.

### **8.2 Content of regulations**

Paragraph 5(2) of the First Schedule to the Act prescribes the content required in the regulations, namely:

- Who is authorised to use the mark;
- The conditions of membership of the association and, where they exist;
- The conditions of use of the mark; and
- Any sanctions against misuse
- The fees (if any) to be paid in connection with the operation of the mark

Annex A contains more details on what the regulations must minimally contain.

It is to be noted here that in examining the regulations, the Registrar has a role in ensuring that the regulations are not contrary to public policy or morality (paragraph 6(1)(b) of the First Schedule to the Act).

### **8.3 Amendment of regulations**

If the regulations filed by the applicant do not meet the statutory requirements, the Examiner will inform the applicant and give the applicant an opportunity to make representations or file amended regulations, within a specified period.

If the applicant responds within the specified period but fails to satisfy the Examiner that those requirements are met, or file the regulations that have been amended so as to meet those requirements, the application will be refused (see paragraphs 7(2) and 7(3) of the First Schedule to the Act).

If the applicant fails to respond within the specified period, the application shall be treated as withdrawn (see paragraph 7(3A) of the First Schedule to the Act).

The filing of the amended regulations shall be made on Form TM10 with the requisite fee.

## **9. PUBLICATION OF COLLECTIVE MARKS**

Once the examination process is complete, and the Examiner is satisfied that the application of the collective mark and the regulations meet the relevant criteria for registration, the Examiner will accept the mark and the regulations for publication.

Before accepting the mark, the Examiner should also ensure that the approved regulations (without unnecessary documents such as covering letters) are correctly attached, so that the regulations are correspondingly uploaded to the register when the mark is published.

Once published, the regulations governing the use of the collective mark can be viewed online and are open to public inspection in the same way that "ordinary" trade marks are open to public inspection. The regulations are open to opposition on the matters listed in paragraph 6(1) of the First Schedule to the Act.

After this point, any amendment of the regulations governing the use of the collective mark is not effective until and unless the amended regulations are filed with the Registrar and approved by the Registrar.

## **10. AMENDMENT OF REGULATIONS**

Once a collective mark has been accepted and published for opposition purposes, any amendment of the regulations governing the use of a registered collective mark (including any schedules attached to it) is not effective unless and until the amended regulations are filed with the Registrar and accepted by him. This means that the Registrar has to examine the amended regulations in the same way as newly filed regulations.

Where the Registrar considers it appropriate, the amended regulations will be published for opposition purposes. In fact, this will be the case in most if not all cases, save where the amendment is insignificant or minor.

If no oppositions are received, the regulations will become effective.

## **11. ASSIGNMENT OF COLLECTIVE MARKS**

Collective marks may be assigned to a new owner in the same way as "ordinary" trade marks. Unlike certification marks, the Registrar's prior consent to the assignment is not necessary. Usually, a change in ownership of a collective mark would necessitate the amendment of the regulations to reflect the new name of the owner. If so, the request should be made in the manner detailed in paragraph 10 and should be filed at the same time as the request to record the assignment.

## **ANNEX A - GUIDELINES FOR STRUCTURE & CONTENT OF REGULATIONS GOVERNING COLLECTIVE MARKS**

**Note: This guide is intended to assist applicants in preparing regulations to accompany applications for registration of collective marks.**

### **General guidelines**

1. The regulations may be titled "Regulations Governing the Use of Collective Mark [Trade Mark No.]"
2. Regulations should be incorporated in a standalone document so that it can be easily read and understood.
3. Annexures, if any, should be properly labelled and cross-referenced.
4. The Licensing Agreement is not the regulations governing the use of the collective mark.

The regulations should minimally deal with the following, and may be structured in the following manner:

#### **(1) The conditions of membership of the association**

Associations will normally have pre-qualifying conditions that must be met before one may be admitted as a member. For example, it may be a condition that a person must have certain academic qualifications or practical experience in a particular field for a period of time before being permitted to join.

Accordingly, the regulations should set out the conditions under which the applicant of the collective mark would accept any individual or entity to be its member.

These conditions should be set out clearly and objectively so that would-be users of the collective mark can clearly and objectively anticipate the conditions they will need to fulfil before being allowed to join the association, with the view to subsequently using the collective mark.

#### **Example:**

Membership of the [Applicant] is open to those persons meeting the requirements for membership as set out in paragraph 5 of the Charter of the [Applicant] annexed to these regulations.

#### **(2) Persons authorised to use the mark**

The regulations must indicate the persons who are authorised to use the mark. This does not mean to say that the applicant needs to identify the exact persons who at any given time are authorised users. It is sufficient for the applicant to state whether it is simply every member of the association or only a specified category of members. If there are any other requirements (apart from being a member of the association) that a would-be user must possess (e.g. certain qualification or a particular class of membership in the association) then these should also be detailed.



**Example:**

The use of the mark is strictly limited to insurance and financial services practitioners who have been granted Full or Candidate membership of [Applicant].

**(3) Conditions of use of the mark (if any)**

The regulations should indicate the conditions of use of the collective mark, if there are such restrictions. Such conditions usually relate to the manner in which the mark may be used, such as in a certain size. This is to ensure that the collective mark is used by authorised users in a consistent and uniform fashion.

**Example:**

The Member agrees that:

- (a) it will use the Mark only in the manner prescribed herein;
- (b) it will use the Mark only in relation to its membership in [Applicant];
- (c) it will use the Mark on its communication media in such a way as to create no confusion between matters of external quality assurance activities and other matters;
- (d) when posted on the Member's website, the Mark shall be used as a hypertext link from its website to the URL of [Applicant's] website <http://www.abc.com>
- (e) it will not, during the period of membership, register or attempt to register the Mark or any imitation thereof; make or assert any claim of ownership to the Mark; or dispute the right of [Applicant], or its successors, to authorise the use of the Mark as provided herein;
- (f) it will, upon withdrawal or termination of membership of [Applicant], discontinue the use of the Mark or any reference thereto, and will not thereafter use any copy or imitation thereof; and
- (g) In case of takeover of the Member, the new agency shall submit a membership application in accordance with the application procedure that will be provided by [Applicant] upon request.

**(4) Sanctions against misuse of the mark (if any exist)**

If the applicant association intends to impose any sanctions (such as expulsion from the association) against a member who misuses the mark, such sanctions must be provided for in the regulations.

Misuse of the mark would include using the mark in a manner that does not meet or violates the conditions of use or unauthorised usage of the mark.

**Example:**

In the event where the Member does not comply with the Conditions of Use, which represents a violation of the collective mark, [Applicant] may prosecute the Member on the basis of the present regulations and of trademark laws.

[Applicant] may forthwith suspend or withdraw the Member's right to use the Mark.

The Member may appeal this decision in accordance with the appeal procedure that will be provided by [Applicant] upon request. The Appeals and Complaints Committee will deal with all appeals.

If any person uses the Mark without authorisation, a sanction of up to S\$500 may be levied. If such person continues to use the Mark despite the initial sanction, [Applicant] reserves the right to take further legal action as is deemed necessary.

#### **5) Optional: Fees to be paid for the use of the collective mark (if any)**

If there are fees to be paid for the use of the collective mark, these fees may be included in the Regulations. Note however that the Regulations do not make it mandatory that these fees need to be indicated in the Regulations, even if they exist.

The structure and frequency of any fees stipulated should then be fully described in the regulations.

The Registrar would not require the actual amount of fees to be laid down in the regulations if the regulations state that the fees can be found on the applicant's website and the fees are so indicated at the point of examination.

If fees are not applicable, this may also be stated in the regulations.

#### **Example:**

Annual fees have to be paid by a member of the applicant association user to the [Applicant] of the mark in connection with the operation of the mark. The total amount of annual fees payable by each authorised user (an individual and/or an organisation) is [-----] per year.

## **CERTIFICATION MARKS**

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**CERTIFICATION MARKS**

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## **1. INTRODUCTION**

This chapter deals with certification marks – what they are, how they differ from “ordinary” trade marks and how they would be examined and processed at the Registry.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Certification marks**

**61.**—(1) A certification mark is a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified.

(2) The provision of this Act shall apply to certification marks subject to the provisions of the Second Schedule.

### **Second Schedule**

#### **General**

1.—(1) The provisions of this Act shall apply to certification marks subject to the provisions of this Schedule.

(2) For the purposes of this Schedule, “published” means made available to the public (whether in Singapore or elsewhere), and a document shall be taken to be published if it can be inspected as of right at any place in Singapore by members of the public, whether on payment of a fee or not.

#### **Signs of which a certification mark may consist**

2. In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1) (b) from those which are not so certified.

#### **Indication of geographical origin**

3.—(1) Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

### **Nature of proprietor's business**

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

### **Mark not to be misleading as to character or significance**

5.—(1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

### **Regulations governing use of certification mark**

6.—(1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

(3) Further requirements with which the regulations have to comply may be imposed by rules made under this Act.

### **Approval of regulations, etc.**

7.—(1) A certification mark shall not be registered unless —

- (a) the regulations governing the use of the mark —
  - (i) comply with paragraph 6(2) and any further requirements imposed by rules; and
  - (ii) are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the Registrar and pay the prescribed fee.

(3) If the applicant does not comply with sub-paragraph (2), the application shall be treated as withdrawn.

8.—(1) The Registrar shall consider whether the requirements mentioned in paragraph 7(1) are met.

(2) If it appears to the Registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(3) If the applicant responds within the specified period but fails to satisfy the Registrar that those requirements are met, or to file regulations that have been amended so as to meet those requirements, the Registrar may refuse the application.

(3A) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 13.

9. The regulations shall be published and notice of opposition may be given relating to the matters mentioned in paragraph 7(1), in addition to any other grounds on which the application may be opposed.

### **Regulations to be open to inspection**

10. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

### **Amendment of regulations**

11.—(1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may, in any case where it appears to him expedient to do so, cause them to be published.

(3) If the Registrar causes the regulations to be published, notice of opposition may be given relating to the matters mentioned in paragraph 7(1).

### **Consent to assignment of registered certification mark**

12. The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

### **Infringement: rights of authorised users**

13. The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark —

- (a) section 27(5);
- (b) section 82.

14. In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account; and



the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

### **Grounds for revocation of registration**

15. Apart from the grounds of revocation provided for in section 22, the registration of a certification mark may be revoked on the ground —

- (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4;
- (b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1);
- (c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark;
- (d) that an amendment of the regulations has been made so that the regulations —
  - (i) no longer comply with paragraph 6(2) and any further conditions imposed by rules; or
  - (ii) are contrary to public policy or morality; or
- (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

### **Grounds for invalidity of registration**

16. Apart from the grounds of invalidity provided for in section 23, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1).

## **Trade Marks Rules**

### **Application of Rules to collective marks and certification marks**

**62.**—(1) Except as provided in this Part, the provisions of these Rules shall apply in relation to collective marks and certification marks as they apply in relation to ordinary trade marks.

(2) In case of doubt in applying the provisions of these Rules, any party may apply to the Registrar for directions.

(3) The address of the applicant for the registration of a collective mark or certification mark shall be deemed to be the trade or business address of the applicant for the purposes of rule 9(4)(o).

### **Filing of regulations**

**63.** Within 9 months after the date of the application for the registration of a collective mark or certification mark, the applicant must file with the Registrar —

- (a) Form TM 10; and
- (b) a copy of the regulations governing the use of the mark.

### **Filing of amended regulations**

**64.**—(1) The filing of amended regulations pursuant to paragraph 7(2) of the First Schedule to the Act in relation to a collective mark or paragraph 8(2) of the Second Schedule to the Act in relation to a certification mark shall be made in Form TM 10.

(2) Form TM 10 shall be accompanied by a copy of the amended regulations with the amendments shown in red.

### **Opposition to registration**

**65.**—(1) Any person may, within 2 months after the date of the publication of an application for registration of a collective mark or certification mark, give written notice to the Registrar in Form TM 11 opposing the registration; and rules 29 to 40 shall apply, with the necessary modifications, to the proceedings thereon.

...

(3) In case of doubt, any party may apply to the Registrar for directions.

### **Amendment of regulations**

**66.**—(1) An application for the amendment of the regulations governing the use of a registered collective mark or certification mark shall be filed with the Registrar in Form TM 10.

(2) The application shall be accompanied by a copy of the amended regulations with the amendments shown in red.

(3) Where it appears expedient to the Registrar that the amended regulations should be made available to the public, the Registrar may publish a notice indicating where copies of the amended regulations may be inspected.

### **Opposition to amendment of regulations**

**66A.**—(1) Any person may, within 2 months after the date of the publication of the notice referred to in rule 66(3), file with the Registrar —

- (a) a notice of opposition to the amendment to the regulations in Form TM 11; and
- (b) a statement indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of the First Schedule to the Act, or paragraph 7(1) of the Second Schedule to the Act, as the case may be.

(2) The person filing the notice and statement under paragraph (1) shall, at the same time, serve copies of the notice and statement on the proprietor.

(3) Rules 29(3) to (7) and 31 to 40 shall, with the necessary modifications, apply to the proceedings thereon as they apply to an opposition to an application for registration of a trade mark.

(4) For the purposes of the application of the rules referred to in paragraph (3) —

- (a) references in those rules to the applicant shall be treated as references to the applicant for the amendment of the regulations;
- (b) references in those rules to the application shall be treated as references to the application for the amendment of the regulations;
- (c) references in those rules to the date of the publication of the application for registration shall be treated as references to the date of the publication of the notice referred to in rule 66(3);
- (d) references in those rules to the notice of opposition shall be treated as references to the notice and statement referred to in paragraph (1); and
- (e) references in those rules to the opponent shall be treated as references to the person who filed the notice and statement referred to in paragraph (1).

### 3. **DISTINCTION BETWEEN CERTIFICATION MARKS AND “ORDINARY” TRADE MARKS**

Section 61 of the Act defines a certification mark as “a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to the origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified”.

The main feature of a certification mark is that it serves as a badge of quality used not by the proprietor of the mark, but by his authorised users as a guarantee to the relevant public that goods or services possess a particular characteristic. Usually, the proprietor of the mark will authorise the use of the mark to anyone who can demonstrate that the goods or services possess that characteristic.

Certification marks distinguish the goods or services of a class of traders who are certified from those who are not certified. In contrast, “ordinary” trade marks function as a badge of origin which distinguishes the goods or services of one trader from those of other traders.

<i>Comparison Table</i>	
Certification Mark	"Ordinary" Trade Mark
<ul style="list-style-type: none"> <li>Serves as a badge of quality used not by the proprietor of the mark, but by his authorised users, as a guarantee to the relevant public that the goods or services possess a particular characteristic</li> </ul>	<ul style="list-style-type: none"> <li>Serves as a badge of origin which distinguishes the goods or services of one trader (i.e. a single trade source or entity) from those of other traders</li> </ul>

## 4. EXAMINATION OF CERTIFICATION MARKS

### 4.1 Distinctiveness

Certification marks must be examined for distinctiveness just like in the case of “ordinary” trade marks. When considering the distinctiveness of a certification mark it is important to appreciate that the distinguishing function of certification marks differs from that of “ordinary” trade marks.

Paragraph 2 of the Second Schedule of the Act provides:

*In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1)(b) from those which are not so certified.*

Due to the differences in the distinguishing function, marks which may not be acceptable as “ordinary” trade marks (as it cannot point towards a single trade source), may sometimes be acceptable as certification marks if it is able to distinguish goods which are certified from those which are not so certified.

For example, a composite mark consisting of the words “100% Organic” combined with designs would not be acceptable as an “ordinary” trade mark as it is unlikely that the average consumer would regard it as identifying a single trader but may be acceptable as a certification mark if it is capable of identifying goods which are certified from those which are not.

**Not acceptable:**

**100% ORGANIC**

*Example 4.1.1*

The above mark will face an objection under the following sections:

- Section 7(1)(b) - as it is incapable of distinguishing, in the eyes of the average relevant consumer, the goods certified by the applicant organisation from the goods not so certified.
- Section 7(1)(c) – as descriptive indications should be kept free for all traders to use.
- Section 7(1)(d) – as monopolies over signs that are already customary in the trade should not be given.

### 4.2 Geographical names

Geographical names (and other such signs or indications) are usually not registrable as “ordinary” trade marks and would be objected to under section 7(1)(c) of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration.

(Reference should be made to the Trade Marks Work Manual's section on "Geographical Names" for general guidelines on when a geographical name is registrable as a trade mark.)

However, paragraph 3(1) of the Second Schedule of the Act provides:

*Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.*

This means that the Registrar has a discretion (note that this is not an automatic right of acceptance) to accept geographical names as certification marks. In general, the Registrar will accept geographical names only if they are capable of distinguishing goods and services which are certified from those which are not. In exercising this discretion, the Registrar will look at existing practices in the market and consider whether due to custom and practice, the geographical name is capable of distinguishing the goods or services certified from those which are not.

It should be noted that paragraph 3(2) of the Second Schedule provides that if a geographical name is accepted for registration, the proprietor of such a mark is not entitled to prohibit the use of the name in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use the geographical name.

#### **4.3 Geographical indications (GIs)**

An application to register an "ordinary" trade mark which consists solely of a GI would face insurmountable objections as GIs should not be monopolised by any single trader. Furthermore, the function of a GI is to guarantee geographical origin and not trade origin. However, GIs are registrable as certification marks since it sends the message to the consumer that the goods are certified as being the produce of the particular location.

#### **4.4 Evidence of acquired distinctiveness**

Section 7(2) of the Act provides that a trade mark shall not be refused registration by virtue of section 7(1)(b), (c) or (d) of the Act, if, before the application date for registration, it has in fact acquired a distinctive character as a result of the use made of it.

This provision applies to applications for certification marks as well.

In proving acquired distinctiveness, the applicant needs to show that the mark has become capable of certifying a characteristic of goods or services, by the date of application. It is not essential that the mark should have been used that way prior to the relevant date.

In other words, the test is whether consumers have been educated as to the distinguishing function of the mark and not whether consumers have been educated who is certifying the goods/services or that goods/services have in fact been certified.

(Reference should be made to the Trade Marks Work Manual's section on "Evidence of Distinctiveness Acquired Through Use" for general guidelines on the determination of acquired distinctive character through prior use made of the mark.)

#### **4.5 Other absolute grounds of refusal**

The other absolute grounds of refusal applicable to certification marks, include the following:

- That the certification mark consists exclusively of certain shapes (thus objectionable under section 7(3) of the Act);
- That the certification mark is contrary to public policy or morality (thus objectionable under section 7(4)(a) of the Act);
- That the certification mark which is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service) (thus objectionable under section 7(4)(b) of the Act);
- That the use of the certification mark is prohibited in Singapore (thus objectionable under section 7(5) of the Act);
- That the certification mark was applied for in bad faith (thus objectionable under section 7(6) of the Act); and
- That the certification mark in question consists of or contains an emblem protected under section 56 and section 57 of the Act (thus objectionable under section 7(11) of the Act).

#### **4.6 Existence of prior conflicting mark(s)**

The process of examination of certification marks also involves a search of the register to ascertain if there are any earlier marks (certification, collective or “ordinary” trade marks) which conflict with the subject application.

##### **4.6.1 Where there is an earlier identical collective or “ordinary” trade mark for same goods or services**

In the event that the search reveals the existence of an earlier identical collective or “ordinary” trade mark for the same goods or services, this would be taken as prima facie evidence that the subject certification mark cannot serve the function of distinguishing goods/services which are certified from those which are not (thus objectionable under section 7(1)(b) of the Act), and is liable to mislead the public as regards the character or significance of the mark (thus objectionable under paragraph 5 of the Second Schedule of the Act).

These objections cannot be overcome with consent from the proprietor of the earlier conflicting mark. The fact that the proprietor of the earlier conflicting mark is the owner of the subject certification mark is also irrelevant.

If the prior conflicting mark and the subject certification mark belong to the same proprietor, it is possible to convert the mark type of the subject mark or to voluntarily cancel the prior conflicting mark in order to overcome the objection.

Further, the existence of the prior conflicting mark may also give rise to an objection under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual’s section on “Relative Grounds for Refusal of Registration” for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

**4.6.2 Where there is an earlier identical or similar certification mark for identical or similar goods or services in the name of a different owner**

In the event that the search reveals the existence of an earlier identical or similar certification mark for the identical or similar goods or services, the subject certification mark may be objectionable under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

**4.6.3 Where there is an earlier identical “ordinary” trade mark for the same goods or services in the name of the same owner**

The registration of a certification mark is prohibited if the owner trades in the goods or services to be certified. The owner of a certification mark is responsible for setting and regulating the standards which the goods or services bear the mark must meet. Therefore the applicant must be independent of the supply of those goods and services to do this effectively and consistently.

Where this occurs, the objection is taken under paragraph 4 of the Second Schedule of the Act. A detailed explanation of this ground of objection is set out at paragraph 6 below.

**4.6.4 Where there is an earlier similar collective or “ordinary” trade mark and the goods or services are only similar in the name of a different owner**

Where there is an earlier similar collective or “ordinary” trade mark and the goods/services are only similar, acceptance of the mark for registration may be possible.

The key factors for consideration by the examiner are the degree of similarity between the respective marks and the goods or services covered by the respective marks.

The Examiner must be satisfied that there is no real likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual’s section on “Relative Grounds for Refusal of Registration” for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

**4.7 Correcting the nature of the mark**

Applicants may change the nature of the trade mark application, for example from an “ordinary” trade mark to a certification mark or vice versa. This is not considered a correction that materially alters the meaning or scope of the application and will therefore be allowed.

## **5. MARK NOT TO BE MISLEADING AS TO CHARACTER OR SIGNIFICANCE**

A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if the mark applied for is likely to be taken as something other than a certification mark (paragraph 5(1) of the Second Schedule of the Act).

This means that an objection will be raised if the mark is likely to be taken as something other than the true designation of the mark, i.e. that it is more likely to be taken as an “ordinary” trade mark as opposed to a certification mark. For example, there is little in the mark “Global Training Consultancy” to indicate to the general public that it is a certification mark.

To overcome this objection the Registrar may require that the mark include some indication that it is a certification mark (paragraph 5(2) of the Second Schedule of the Act). This may be made in one of the following ways:

- Include the following statement in the regulations:  
*“It is a condition that the mark shall not be used in Singapore in any manner including use in advertisement or any form of publicity in Singapore without indicating that it is a certification mark.”*
- Amend the representation of the mark to include the words "certification mark" within the representation of the mark. This form of amendment is permissible notwithstanding section 14(3) of the Act.



**6. APPLICANT NOT TO BE INVOLVED IN THE SUPPLY OF GOODS OR SERVICES OF THE KIND CERTIFIED**

A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified (paragraph 4 of the Second Schedule of the Act). In other words, the applicant must not be supplying goods or services identical to those for which he is certifying.

The owner of a certification mark is responsible for setting and regulating the standards which the goods or services bear the mark must meet. Therefore the applicant must be independent of the supply of those goods and services to do this effectively and consistently.

The Examiner must therefore run a proprietor search and if it reveals that the applicant has “ordinary” trade marks for identical goods or services (regardless whether the marks are the same, similar or different), raise an objection under paragraph 4 of the Second Schedule of the Act. The fact that the applicant owns “ordinary” trade marks is *prima facie* evidence that the applicant is trading in those goods and services.

This objection can be overcome if the applicant withdraws or surrenders the “ordinary” trade mark, produces evidence to show that he does not trade in the goods or services (such as company incorporation documents, or company profile brochures), or confirms in writing that he does not carry on a business in the goods or services certified.

It should be noted however that grounds for revocation and invalidation exist (upon application from a third party) should this prove to be false or to become false by the applicant beginning to trade in the goods or services.

## **7. SPECIFICATION OF GOODS AND/OR SERVICES FOR CERTIFICATION MARKS**

As with “ordinary” trade marks, certification marks must be filed in respect of specific goods and/or services in the appropriate classes under the International Classification of Goods and Services (ICGS).

The specification for certification marks should denote the goods and services being certified i.e. the goods and services of the authorised users (as opposed to the goods and services of the applicant). This is because when in use, the certification mark would appear on the goods and services of persons who have been certified by the proprietor.

Applicants are reminded that failure to use a certification mark in the appropriate manner may render it vulnerable to revocation for non-use.

## **8. COMPETENCE OF THE APPLICANT**

The applicant of a certification mark must show that it has the competency to certify and operate the certification scheme (paragraph 7(1)(b) of the Second Schedule of the Act). This requirement is usually satisfied if the applicant is an established trade body or a government department.

Otherwise, the applicant will be asked to provide information to clarify why they are competent to certify. There is no set manner of providing this information and an explanation of the applicant's history in the particular field will often suffice.

Unlike collective marks, there is no restriction on who can be a proprietor of a certification mark. In practice, certification marks are normally applied for by trade associations or other similar bodies who have an interest in monitoring and maintaining standards in their particular field.

The applicant of a certification mark must have legal capacity to hold property in its own name. If it is apparent from the applicant's name or from the content of the regulations that the applicant has no legal personality, then the examiner may raise an objection on this ground.

## **9. EXAMINATION OF THE REGULATIONS**

### **9.1. Requirement of regulations**

An applicant seeking registration of a certification mark must file a copy of the regulations governing the use of the certification mark with the Registry within 9 months after the date of the application (rule 63 of the Trade Marks Rules), failing which, the application shall be treated as withdrawn (paragraph 7(3) of the Second Schedule of the Act).

The applicant may apply for an extension of time if more time beyond 9 months after the date of application is required to compile the regulations. As with any extension of time applied for under the Act, the application for extension of time is made by way of filing Form CM5 together with the requisite fee (if any), and the request should be accompanied by adequate reasons explaining why the extension of time is required (if applicable).

For ease of reference and clarity, the regulations should be incorporated in a single document providing the required information (see below). An applicant may attach supplementary documents by way of annexure to the regulations and cross reference to them in the regulations but such documents cannot themselves constitute the regulations.

### **9.2. Content of regulations**

Paragraph 6(2) of the Second Schedule to the Act prescribes the content required in the regulations, namely:

- Who is authorised to use the mark;
- The characteristics to be certified by the mark;
- How the certifying body is to test those characteristics and to supervise the use of the mark;
- The fees (if any) to be paid in connection with the operation of the mark; and
- The procedures for resolving disputes.

Annex A contains more details on what the regulations must minimally contain.

It is to be noted here that in examining the regulations, the Registrar has a role in ensuring that the regulations are not contrary to public policy or morality (paragraph 7(1)(a)(ii) of the Second Schedule to the Act).

### **9.3. Amendment of regulations**

If the regulations filed by the applicant do not meet the statutory requirements, the Examiner will inform the applicant and give the applicant an opportunity to make representations or file amended regulations, within a specified period.

If the applicant responds within the specified period but fails to satisfy the Examiner that those requirements are met, or file the regulations that have been amended so as to meet those requirements, the Examiner may refuse the application (paragraphs 8(2) and 8(3) of the Second Schedule to the Act).

If the applicant fails to respond within the specified period, the application shall be treated as withdrawn (paragraph 8(3A) of the Second Schedule to the Act).

The filing of the amended regulations shall be made on Form TM10 with the requisite fee.

## **10. PUBLICATION OF CERTIFICATION MARKS**

Once the examination process is complete, and the Examiner is satisfied that the application of the certification mark and the regulations meet the relevant criteria for registration, the Examiner will accept the mark and the regulations for publication.

Before accepting the mark, the Examiner should also ensure that the approved regulations (without unnecessary documents such as covering letters) are correctly attached, so that the regulations are correspondingly uploaded to the register when the mark is published.

Once published, the regulations governing the use of the certification mark can be viewed online and are open to public inspection in the same way that "ordinary" trade marks are open to public inspection. The regulations are open to opposition on the matters listed in paragraph 7(1) of the Second Schedule to the Act.

After this point, any amendment of the regulations governing the use of the certification mark is not effective until and unless the amended regulations are filed with the Registrar and approved by the Registrar.

## **11. AMENDMENT OF REGULATIONS**

Once a certification mark has been accepted and published for opposition purposes, any amendment of the regulations governing the use of a registered certification mark (including any schedules attached to it) is not effective unless and until the amended regulations are filed with the Registrar and accepted by him. This means that the Registrar has to examine the amended regulations in the same way as newly filed regulations.

Where the Registrar considers it appropriate, the amended regulations will be published for opposition purposes. In fact, this will be the case in most if not all cases, save where the amendment is insignificant or minor.

If no oppositions are received, the regulations will become effective.

## **12. ASSIGNMENT OF CERTIFICATION MARKS**

The assignment of a certification mark is not effective without the consent of the Registrar (paragraph 12 of the Second Schedule of the Act). This is to ensure that the new proprietor has the necessary competence to certify and administer the certification scheme (as outlined in paragraph 8 above) and is not involved in the supply of the goods and services certified (as outlined in paragraph 6 above).

Usually, the change in ownership of the certification mark would necessitate the amendment of the regulations to reflect the new name of the owner. If so, the request should be made in the manner as detailed in paragraph 11 and should be filed at the same time as the request for consent to the assignment.



## **ANNEX A - GUIDELINES FOR STRUCTURE & CONTENT OF REGULATIONS GOVERNING CERTIFICATION MARKS**

**Note: This guide is intended to assist applicants in preparing regulations to accompany applications for registration of certification marks.**

### **General guidelines**

1. The regulations may be titled “Regulations Governing the Use of Certification Mark [Trade Mark No.]”.
2. Regulations should be incorporated in a standalone document so that it can be easily read and understood.
3. Annexures, if any, should be properly labelled and cross-referenced.
4. The Licensing Agreement is not the regulations governing the use of the certification mark.

The regulations should minimally deal with the following, and may be structured in the following manner:

#### **(1) Persons authorised to use the mark**

The regulations must indicate the persons who are authorised to use the mark. This does not mean to say that the applicant needs to identify the exact persons who at any given time are authorised users. It is sufficient for the applicant to state objectively the category of persons who would be eligible if they demonstrate the characteristics being certified.

The regulations should state clearly whether:

- The certification mark is available to use by any person whose goods or services demonstrate the relevant characteristics being certified; or
- The certification mark is only available to certain categories of persons, for example, only persons possessing particular qualifications, due to the nature of goods/service being certified, may be authorised to use the mark.

This is to ensure that there is no discrimination in authorising the use of the mark and provide absolute certainty for potential users to assess whether they qualify to apply to be certified.

#### **Example:**

The certification mark is available for use by any individual and/or any organization who complies with the regulations and who provide the goods having the certified quality or characteristics as specified in the regulations herein.

#### **(2) Characteristics to be certified by the mark**

The regulations must indicate the characteristics to be certified by the mark.

The regulations should not simply list the goods and services being certified, they should explain the specific characteristic present in the goods and services being certified. These characteristics of the underlying goods and/or services must be set out in a clear, objective and detailed fashion.

This is for transparency to allow anyone reading the regulations to know precisely what characteristic is being certified.

**Example:**

A certification mark is used to distinguish foods, in particular confectionary (candies), and over-the counter pharmaceuticals (throat and cough lozenges, syrups) which—by virtue of the absence of fermentable sugars and excessive amounts of acids—are "tooth-friendly", i.e. do not harm the teeth.

**(3) Test and supervision of the certification mark**

The regulations must indicate how the applicant intends to test the presence of the characteristics to be certified by the mark and to supervise use of the mark.

The regulations must state the methodology and/or process for testing. In the event that the testing is not done by the applicant of the mark, the details of the entity responsible for testing must be stated.

In addition, the regulations must explain how the certifying body will subsequently supervise the use of the mark by authorised users.

Examples of methods of supervision include, but are not limited to:

- Periodic site visits to premises of users of the certification marks by certifying body
- Provision of periodic reports and samples to the certifying body by users of the certification marks
- Issuance of compliance certificates to evince compliance with the certification regime by certifying body

The regulations should include the checks that are in place and specify any timeframes at which inspections will occur.

The Registrar needs to be satisfied that there is adequate control over the use of the mark.

**Example:**

The [Applicant/any authorised certification authority] will conduct routine site visits to the area in which the tea are produced.

Samples of the tea produced in that area will be subject to the following tests:

T1 Quality tests:

To be observed by eyes, by touching, by tasting; to determine the categories by its shape; to determine the colour, aroma and using new tea of the year as a standard.

T2 Sampling tests:

To be tested in accordance with XYZ01

T3 Water content test:

To be tested in accordance with XYZ02

T4 Residue test:

To be tested in accordance with XYZ03

The rules of the testing are as follows:

1. The products should be tested by batches. Quality of products in the same batch and the same category should be the same.
2. The products should be tested in accordance with the regulations and can only be sold after the requirements are met.
3. The tests are divided into "transfer tests" and "routine tests".

Routine tests should be carried out in any one of the following situations:

- (a) when the standard packaging is changed;
- (b) where there is significant change in the production method or origin of fresh tea leaves;
- (c) once every year under normal production circumstance;

In transfer tests, if the tea does not meet the requirements of the regulations, an additional sample may be taken from the same batch of product and put for tests again.

**(4) Fees to be paid for the use of the certification mark (if any)**

The regulations must indicate the fees (if any) to be paid in connection with the operation of the mark.

The structure and frequency of any fees stipulated must be fully described in the regulations.

The Registrar would not require the actual amount of fees to be laid down in the regulations if the regulations state that the fees can be found on the applicant's website.

If fees are not applicable, this should be stated in the regulations.

This is to ensure that the fees are transparent and not excessively high so as to prevent would be users from accessing the scheme.

**Example:**

Annual fees have to be paid by an authorised user to the [Applicant] of the mark in connection with the operation of the mark. The total amount of annual fees payable by each authorised user (an individual and/or an organization) is [-----] per year.

**(5) Dispute resolution procedures**

The regulations must indicate the procedure for resolving any disputes between the certifying body and an authorised user (or would be authorised user) of the mark.

Essentially under this item the Registrar is looking for the right of appeal to an independent person or body such as a specialist arbitrator or tribunal or the courts, for example, where the proprietor has refused to authorise use of the mark to a particular user.

The purpose of requiring the right to appeal to an independent tribunal is to ensure that decisions would be fair and impartial.

**Example:**

Where a dispute between the [Applicant] and an authorised user (or would be authorised user) regarding the [Applicant's] decision not to allow use of the mark arises, the dispute should be resolved via international arbitration centres, including but not limited to the Singapore International Arbitration Centre.

Any appeals from the decision of the arbitration authority will be subject to the jurisdiction of the courts in which the arbitration authority is located.

## **RENEWAL**

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**RENEWAL**

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## **1. INTRODUCTION**

---

This chapter is concerned with the renewal of a registered trade mark application.

## 2. RELEVANT LEGISLATION

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### Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

#### Relative grounds for refusal of registration

8.

...

(11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no bona fide use of the mark during the 2 years immediately preceding the expiry.

#### Registration

15.

...

(2) A trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

#### Duration of registration

18.—(1) A trade mark shall be registered for a period of 10 years from the date of registration.

(2) Registration may be renewed in accordance with section 19 for further periods of 10 years.

#### Renewal of registration

19.—(1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the fee referred to in subsection (4) or the fees referred to in subsection (5), as the case may be.

(2) The Minister may make rules for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal shall be made not later than 6 months after the date of expiry of the registration.

(4) Where the request for renewal is made on or before the date of expiry of the registration, the fee payable shall be the prescribed renewal fee.

(5) Where the request for renewal is made within the period of 6 months after the date of expiry of the registration, the fees payable shall be the prescribed renewal fee and the prescribed late renewal fee.

(6) Renewal shall take effect from the expiry of the previous registration.

(7) If the registration is not renewed in accordance with this section and the rules referred to in subsection (2), the Registrar shall remove the trade mark from the register.



(8) The Minister may make rules to provide for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions, if any, as may be prescribed.

## Trade Marks Rules

### Address for service

**9.**—(1) For the purposes of any proceedings before the Registrar, an address for service in Singapore shall be filed in accordance with paragraph (2) or (5) by or on behalf of —

...

(f) every applicant for the renewal of the registration of a trade mark or for the restoration of a trade mark to the register;

...

(2) Where the application for a matter requires an address for service in Singapore to be furnished, the address for service in Singapore shall be furnished on the form filed for the matter.

(3) The filing of an address for service in accordance with paragraph (2) shall be effective only for the matter for which the form is filed.

(4) Notwithstanding paragraph (3) —

...

(b) subject to sub-paragraph (f), the address for service of a proprietor of a registered trade mark shall be effective for the purposes of all proceedings in respect of the registered trade mark, except for any application for the second or any subsequent renewal of the registered trade mark;

...

(g) where an applicant for the renewal of the registration of a trade mark, or the restoration of a trade mark to the register, furnishes an address for service in Form TM 19, the address for service shall be effective for the purposes of all renewal applications or proceedings, and all restoration applications or proceedings, in respect of the trade mark in relation to which that form is filed;

...

(5) In a case where paragraphs (2) and (4) do not apply, the address for service shall be furnished in writing.

### Renewal of registration

**49.**—(1) Subject to paragraph (2), an application for the renewal of registration of a trade mark shall be made not earlier than 6 months before, and not later than 6 months after the date of expiry of the registration.

(2) Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of the application for its registration, an application for the renewal of its registration shall be made not later than 6 months after the actual date of its registration.

(3) An application for the renewal of registration of a trade mark shall —

(a) be in Form TM 19, if made on or before the date of expiry of the registration; or

- (b) be in Form TM 19 and be accompanied by the additional late payment fee, if made within 6 months after the date of expiry of the registration.

(4) Notwithstanding paragraph (3) (b), where —

- (a) a trade mark is registered —

- (i) within 6 months before; or
- (ii) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration; and

- (b) an application for the renewal of its registration is made not later than 6 months after the actual date of its registration,

the application for the renewal of its registration shall be in Form TM 19.

(5) To avoid doubt, the application for the renewal of the registration of the trade mark under paragraph (4) need not be accompanied by any additional late payment fee.

#### **Notice of renewal**

**50.** —(1) Subject to paragraphs (2) and (3), the Registrar shall, not less than one month nor more than 6 months before the date of expiry of the registration of a trade mark, send a notice in writing to the proprietor, at the proprietor's address for service, notifying him of the date of expiry of the registration.

(2) Subject to paragraph (3), where a trade mark is registered —

- (a) within 6 months before; or
- (b) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration, the Registrar shall, within one month after the actual date of its registration, send a notice in writing to the proprietor —

- (i) where an application for the renewal of registration of the trade mark has previously been made in accordance with rule 49, at the address for service as indicated in the application; or
- (ii) in any other case, at the proprietor's address for service,

notifying him of the date of expiry of its registration.

(3) The Registrar need not send any notice referred to in paragraph (1) or (2) if an application for the renewal of registration of the trade mark has been made in accordance with rule 49.

#### **Notice of non-compliance**

**50A.**—(1) If, in the course of an examination of an application for renewal of registration, it appears to the Registrar that the application is not in order, the Registrar shall give written notice of this to the applicant.

(2) If the applicant fails to —

- (a) respond in writing to the Registrar on the notice; or
- (b) comply with any requisition of the Registrar set out in the notice,

within the time specified in the notice, the Registrar may treat the application as having been withdrawn.

### **Removal of trade mark from register**

**51.** The Registrar may remove a trade mark from the register if —

- (a) no application for the renewal of registration of the trade mark is filed in accordance with rule 49; or
- (b) where an application for the renewal of registration of the trade mark is filed in accordance with rule 49, the applicant for the renewal of registration —
  - (i) fails to comply with any direction of the Registrar relating to the renewal; or
  - (ii) notifies the Registrar that he wishes to withdraw or abandon the application.

### **Restoration of registration**

**53.—**(1) An application for restoration of a trade mark which has been removed from the register under rule 51 shall be filed with the Registrar on Form TM 19 within 6 months from the date of the removal of the trade mark from the register.

...

(3) The Registrar may, in any case, require the applicant for restoration to furnish such additional evidence or information, by statutory declaration or otherwise, as he thinks fit, within such time as the Registrar may specify.

...

(4) The Registrar may restore the trade mark to the register and renew its registration if he is satisfied that it is just to do so, and upon such conditions as he may think fit to impose.

### **Reinstatement of application, right or thing**

**77B**

...

(5) Paragraphs (1) to (4) do not allow the reinstatement of —

...

- (b) any application which is treated as withdrawn, any right which has been abrogated or any thing which has ceased to be in force or to exist by reason of —

...

- (iii) a failure to pay the fee for the renewal or restoration of the registration of a trade mark under rule 49(3) or (4) or 53, as the case may be.

**Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007)**

**Article 6**  
**Period of Validity of International Registration; Dependence and Independence of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

- (i) an appeal against a decision refusing the effects of the basic application,
- (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- (iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

## **Article 7**

### **Renewal of International Registration**

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

## **Article 8**

### **Fees for International Application and Registration**

(7) (a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3*ter*, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as “the individual fee”) whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

- (i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3*ter*, and
- (ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

**Regulations under the Protocol relating to the Madrid Agreement concerning the International Registration of Marks (as in force on February 1, 2020)**

**Rule 29**  
**Unofficial Notice of Expiry**

The fact that the unofficial notice referred to in Article 7(3) of the Protocol is not received shall not constitute an excuse for failure to comply with any time limit under Rule 30.

**Rule 30**  
**Details Concerning Renewal**

(1) [*Fees*]

(a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

- (i) the basic fee,
- (ii) where applicable, the supplementary fee, and,
- (iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no statement of refusal under Rule 18<sup>ter</sup> or invalidation, in respect of all the goods and services concerned, is recorded in the International Register, as specified or referred to in item 6 of the Schedule of Fees.

However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it shall be considered as having been received three months before the date on which renewal is due.

(c) Without prejudice to paragraph (2), where a statement under Rule 18<sup>ter</sup>(2) or (4) has been recorded in the International Register for a Contracting Party in respect of which payment of individual fee is due under subparagraph a(iii), the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

(2) [*Further Details*] (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18<sup>ter</sup>, in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18<sup>ter</sup> is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a

statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.

(c) The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) [Deleted]

(e) The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.

(3) *[Insufficient Fees]*

(a) If the amount of the fees received is less than the amount of the fees required for renewal, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly. The notification shall specify the missing amount.

(b) If the amount of the fees received is, on the expiry of the period of six months referred to in paragraph (1)(a), less than the amount required under paragraph (1), the International Bureau shall not, subject to subparagraph (c), record the renewal, and shall reimburse the amount received to the party having paid it and notify accordingly the holder and the representative, if any.

(c) If the notification referred to in subparagraph (a) was sent during the three months preceding the expiry of the period of six months referred to in paragraph (1)(a) and if the amount of the fees received is, on the expiry of that period, less than the amount required under paragraph (1) but is at least 70% of that amount, the International Bureau shall proceed as provided in Rule 31(1) and (3). If the amount required is not fully paid within three months from the said notification, the International Bureau shall cancel the renewal, notify accordingly the holder, the representative, if any, and the Offices which had been notified of the renewal, and reimburse the amount received to the party having paid it.

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years.

### **Rule 31**

#### **Recording of the Renewal; Notification and Certificate**

(1) *[Recording and Effective Date of the Renewal]* Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for renewal are paid within the period of grace referred to in Article 7(4) of the Protocol.

(2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

(3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

### **Rule 34**

#### **Amounts and Payment of Fees**

(1) *[Amounts of Fees]* The amounts of fees due under the Protocol or these Regulations, other than individual fees, are specified in the Schedule of Fees that is annexed to these Regulations and forms an integral part thereof.

#### *(2) [Payments]*

(a) The fees indicated in the Schedule of Fees may be paid to the International Bureau by the applicant or the holder, or, where the Office of the Contracting Party of the holder accepts to collect and forward such fees, and the applicant or the holder so wishes, by that Office.

(b) Any Contracting Party whose Office accepts to collect and forward fees shall notify that fact to the Director General.

(3) *[Individual Fee Payable in Two Parts]* (a) A Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol may notify the Director General that the individual fee to be paid in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or the subsequent designation of that Contracting Party and the second part to be paid at a later date which is determined in accordance with the law of that Contracting Party.

(b) Where subparagraph (a) applies, the references in items 2 and 5 of the Schedule of Fees to an individual fee shall be construed as references to the first part of the individual fee.

(c) Where subparagraph (a) applies, the Office of the designated Contracting Party concerned shall notify the International Bureau when the payment of the second part of the individual fee becomes due. The notification shall indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the date by which the second part of the individual fee must be paid,
- (iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.



(d) The International Bureau shall transmit the notification to the holder. Where the second part of the individual fee is paid within the applicable period, the International Bureau shall record the payment in the International Register and notify the Office of the Contracting Party concerned accordingly. Where the second part of the individual fee is not paid within the applicable period, the International Bureau shall notify the Office of the Contracting Party concerned, cancel the international registration in the International Register with respect to the Contracting Party concerned and notify the holder accordingly.

(4) [*Modes of Payment of Fees to the International Bureau*] Fees shall be paid to the International Bureau as specified in the Administrative Instructions.

(5) [*Indications Accompanying the Payment*] At the time of the payment of any fee to the International Bureau, an indication must be given,

- (i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;
- (ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

(6) [*Date of Payment*]

(a) Subject to Rule 30(1)(b) and to subparagraph (b), any fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives the required amount.

(b) Where the required amount is available in an account opened with the International Bureau and that Bureau has received instructions from the holder of the account to debit it, the fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives an international application, a subsequent designation, an instruction to debit the second part of an individual fee, a request for the recording of a change or an instruction to renew an international registration.

(7) [*Change in the Amount of the Fees*]

(a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

(b) Where a designation under Rule 24 is presented by the Office of the Contracting Party of the holder and the amount of the fees payable in respect of that designation is changed between, on the one hand, the date of receipt, by the Office, of the request by the holder to present the said designation and, on the other hand, the date on which the designation is received by the International Bureau, the fee that was valid on the first date shall be applicable.

(c) Where paragraph (3)(a) applies, the amount of the second part of the individual fee which is valid on the later date referred to in that paragraph shall be applicable.

(d) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid on the date of payment, or on the date considered to be the date of payment under

Rule 30(1)(b), shall be applicable. Where the payment is made after the due date, the fee that was valid on the due date shall be applicable.

(e) Where the amount of any fee other than the fees referred to in subparagraphs (a), (b), (c) and (d) is changed, the amount valid on the date on which the fee was received by the International Bureau shall be applicable.

### **Rule 38**

#### **Crediting of Individual Fees to the Accounts of the Contracting Parties Concerned**

Any individual fee paid to the International Bureau in respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol shall be credited to the account of that Contracting Party with the International Bureau within the month following the month in the course of which the recording of the international registration, subsequent designation or renewal for which that fee has been paid was effected or the payment of the second part of the individual fee was recorded.

### 3. BACKGROUND

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#### 2.1. Duration of Registration

Under the Trade Marks Act, the duration of validity of a registered mark is for an initial period of 10 years from the date of registration (*see Section 18(1) of the Act*).

The date of registration of the registered mark is deemed to be the **date of application** (*see Section 15(2) of the Act*).

Accordingly, the registered mark becomes due for renewal by reference to the date of application for registration (*see Rule 50(2) of the Trade Marks Rules*).

#### 2.2. Renewal Term

A registered mark may be renewed in accordance with Section 19 of the Act for further periods of 10 years (*see also Section 18(2) of the Act*).

Renewal takes effect from the expiry of the previous registration (*see Section 19(6) of the Act*).

Under the statutory provisions for renewal, the validity of a registered mark may therefore last indefinitely, subject to (a) the request for renewal having been filed under the prescribed form within the prescribed time frame, and (b) the payment of the relevant renewal fees.

## 4. APPLICATION TO RENEW A TRADE MARK

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### 4.1. Renewal Notice

Prior to the expiry of a registered mark, the Registry will issue to the registered proprietor a letter to notify the proprietor of the date of expiry of the registration. This letter, termed as the “First and Only Notice” (FON), will be sent 1 to 6 months before the date of expiry of the registered mark (*see Rule 50(1) of the Rules*).

The FON will be sent to the registered proprietor at his address for service (*see Rule 50(2) of the Rules*). Registrations may be renewed by lodging Form TM 19 with the prescribed renewal fees on or before the date of expiry of the registration (i.e. the deadline for renewal).

If there has been a change in the details of the registered proprietor or his address for service, the appropriate forms as shown in Section 4.12: *Effect of Change of Registered Proprietor's Details on Renewal Application* shall be filed with the Registrar to update the address for service appearing in the Register.

The Registry need not send the FON if a renewal application has already been made (*see Rule 50(3) of the Rules*).

### 4.2. Renewal Application

Prior to the expiration of a registered mark, or on its expiry date, the registered proprietor may request for the mark to be renewed by lodging Form TM 19 with the prescribed renewal fees. (*see Section 19(1) and (4) of the Act*).

This application is to be filed online at <https://ip2sg.ipos.gov.sg>.

#### **Electronic filing of Form TM 19**

Form TM 19 can be used for the following types of renewal:

- **Request for renewal made on or within 6 months before date of expiry of registration (subject to payment of prescribed renewal fee).**
- Where a mark is registered within 6 months before the expiry of the mark provided that the request for renewal is made within 6 months from the date of the actual registration of the mark (subject to payment of prescribed renewal fee)
- Where a mark is registered after its expiry date provided that the request for renewal is made within 6 months from the date of the actual registration of the mark (subject to payment of prescribed renewal fee)

- **Request for renewals made within 6 months from the date of expiry of registration (subject to payment of additional late payment fee)**
- **Request for renewal made between 6 to 12 months from the date of expiry of registration (subject to payment of restoration and renewal fees)**

Please take note of the following when filing a request for renewal electronically. Upon entering the trade mark number, you will be able to view the details of the proprietor on record for the mark and the details of the mark. The details of the mark include:

- The class number in which the renewal pertains to
- Due date of renewal
- Type of renewal applicable

Please ascertain that these details are correct. If they are not, please check that you have entered the correct trade mark number.

After the renewal request has been made, you may like to print a copy of the payment receipt for your own record.

The request for renewal will be automatically processed and the registered mark will be renewed for a further period of 10 years upon the completion of the renewal request. No confirmation letter will be sent out by the Registry but the *Expiry Date* of the registered mark will be updated in the Register.

To ensure that the renewal notices are sent to the correct address, or that the registered mark is renewed with the correct registered proprietor's details, please take note of the following:

If you wish to merely update the registered proprietor's details such as the name, address and/or Singapore address for service of the proprietor, you will have to file Form CM2 online to effect such change.

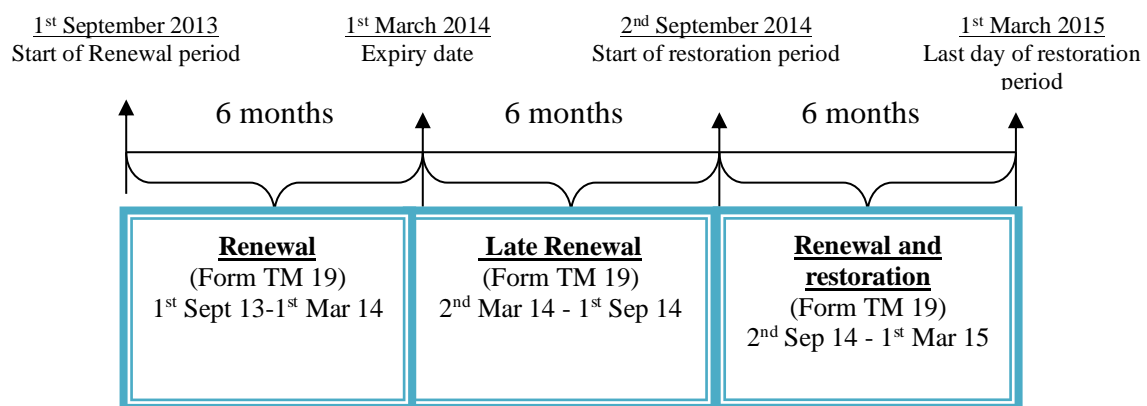
If there is a change of ownership of the registered trade mark, you will have to file Form CM8 online to update the details in the Register as appropriate.

### 4.3. Renewal Timeline

In this example, an application for registration of a mark has an expiry date of 1 March 2014. From the period between 1 September 2013 till 1 March 2014 (being 6 months before expiry date), the renewal can be made via Form TM 19 with the prescribed renewal fee.

If the proprietor fails to renew the mark by 1 March 2014, he may still file for a late renewal of the mark by 1 September 2014 (being 6 months from 1 March 2014), by lodging Form TM 19 with the additional late payment fee.

If the proprietor fails to renew the mark by 1 September 2014, the mark will be removed from the Register. Accordingly, to restore the mark, the proprietor may lodge Form TM 19 with prescribed renewal and restoration fees by 1 March 2015.



### 4.4. Late Renewal Application

Once the mark has expired, the Act provides that a request for renewal may still be filed **within 6 months from the date of expiry of the registration** (see Section 19(3) of the Act, Rule 49(1) of the Rules).

The 6-month time frame to file a request for late renewal is **non-extendible**.

A request for renewal filed up to 6 months after the date of expiry of a registration is known as a “late renewal”.

The registered proprietor may request for the late renewal of a registered mark by lodging Form TM 19 with additional late payment fee (see Rule 49(3) of the Rules).

### 4.5. Examination of Application for Renewal of Registration

The Registrar will examine the application for renewal.

If in the course of such an examination, if it appears to the Registrar that the application is not in order, the Registrar shall notify the registered proprietor of any non-compliance (see Rule 50A(1) of the Rules).

Failure by the registered proprietor to respond to the notification shall result in the Registrar treating the application as having been withdrawn (*see Rule 50A(2) of the Rules*).

#### **4.6. Removal of the Mark from the Register**

The status of the registered mark on the Register will be updated to “Removed” in the event where:

- No application for renewal and restoration has been filed under Section 19 of the Act;
- The registered proprietor fails to comply with any direction of the Registrar relating to renewal under Rule 49 of the Rules; or
- The registered proprietor notifies the Registrar that he wishes to withdraw or abandon the application under Rule 49 of the Rules.

(*see Rule 51 of the Rules*)

#### **4.7. Restoration Application**

Where a registered mark has been removed from the Register pursuant to Rule 51 of the Rules, the mark will be reflected as "Removed (Restoration Possible)" on the Register.

The registered proprietor may apply for such a mark to be restored to the Register by lodging Form TM 19 within 6 months after the date of the removal of the trade mark from the Register (*see Rule 53(1) of the Rules*).

The 6-month time frame to file a request for restoration is **non-extendible**.

It is not possible to file for restoration of the removed mark after 6 months from the date of which the trade mark status is updated to "Removed (Restoration Possible)".

Where an application for restoration is filed, the Registrar may request for additional evidence or information to be furnished by the applicant for restoration, by way of a statutory declaration (*see Rule 53(3) of the Rules*).

#### **4.8. Expired and Removed Marks**

Marks that are not renewed in accordance with the Act would be reflected on the Register as “Expired”.

If no request for late renewal is made within 6 months after the date of expiry of the registration (*see Rule 49(3) of the Rules*), the mark will be reflected as “Removed (Restoration Possible)” on the Register.

If no request for restoration and renewal is made within 6 months after the date of the removal of trade mark from the register (*see Rule 53(1) of the Rules*), the mark will be reflected as “Removed”.

Once a mark is expired or removed, it is impossible to process any other action on the expired or removed mark, for example, transactions such as assignment, licence, grant of security interest, amendment of registered mark or removal for non-use applications etc.

#### **4.9. Effect of Late Registration**

Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of application for its registration i.e. a late registration, an application for the renewal of the mark shall be made within 6 months after the actual date of its registration (*see Rule 49(2) of the Rules*).

Such an application to renew shall be made by way of payment of prescribed renewal fee with Form TM 19 (*see Rule 49(4) of the Rules*).

In the case of a late registration, the Registry will send the FON letter to notify the proprietor of the date of expiry of the registration within 1 month after the actual date of its registration (*see Rule 50(2) of the Rules*).

##### **Example of restoring a late registration**

An application for registration of a mark was filed in on 1 January 2000. The application was registered, and certificate of registration was only dispatched to the proprietor on 1 January 2011 due to protracted opposition proceedings.

As it is more than 10 years since 1 January 2000, the registered mark is treated as a "late registration". In such case, for the purposes of renewal of the mark, the proprietor should lodge Form TM 19, and pay the prescribed renewal fees by 1 July 2011 (being 6 months from the actual date of registration).

If the proprietor fails to renew the mark by 1 July 2011, he may still file for a late renewal of the mark by 1 January 2012 (being 6 months from 1 July 2011), by lodging Form TM 19 with additional late payment fee.

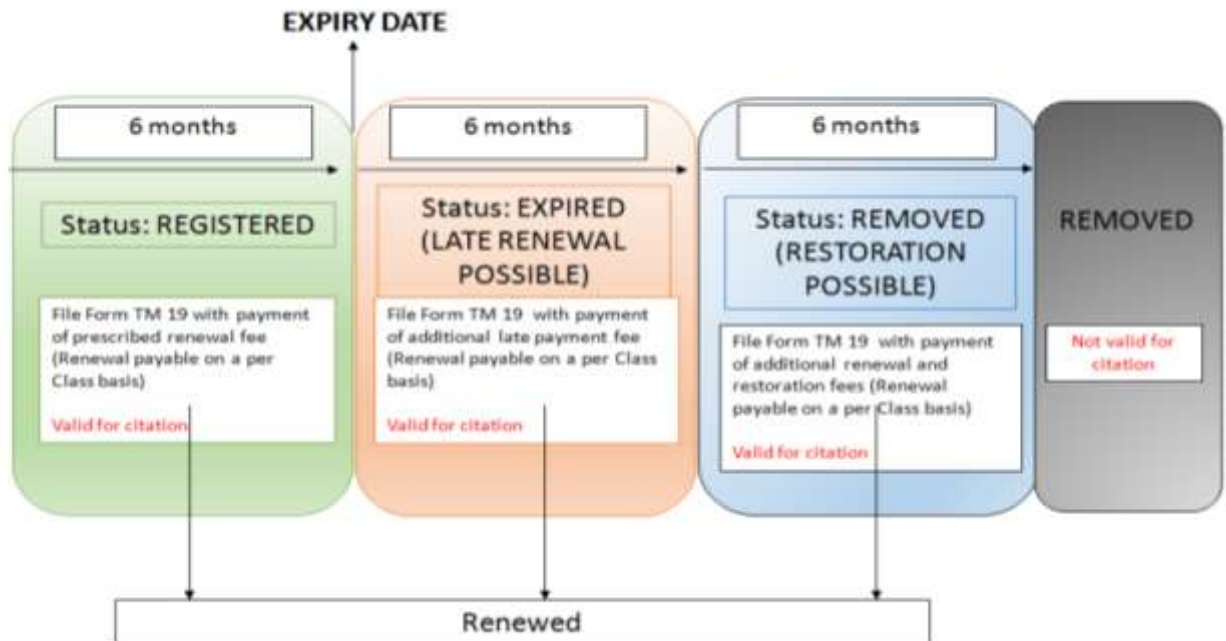
If the proprietor fails to renew the mark by 1 January 2012, the mark will be removed from the Register. Accordingly, to restore the mark, the proprietor may lodge Form TM 19 and the prescribed renewal and restoration fees by 1 July 2012.

#### **4.10. Citation of Expired and Removed Marks**

For the purpose of relative grounds of refusal of registration, marks with "Registered", "Expired (Late Renewal Possible)" and "Removed (Restoration Possible)" status will be valid for citation. However, marks with "Removed" status will not be cited against other marks with later filing date (*see Section 8(11) of the Act*).



## **Renewal & Citation of Expired/Removed Marks**



### **4.11. Fee Structure for Form TM 19**

#### For renewal

*[To be made on or 6 months before the date of expiry of the registered mark]*

You may renew the registration of your trade mark by completing and submitting Form TM 19 online at a prescribed fee of S\$380.00 per class before the expiry of the mark.

#### For late renewal

*[To be made within 6 months from the date of expiry of the registered mark]*

You may apply for late renewal by submitting Form TM 19 online at a prescribed fee of S\$560.00 per class.

#### For restoration and renewal

*[To be made between 6 to 12 months from the date of expiry of the registered mark]*

You may apply for renewal and restoration by submitting Form TM 19 online at a prescribed fee of S\$610.00 per class.

### **4.12. Effect of Change of Registered Proprietor's Details on Renewal Application**

If there has been a change in the details of the registered proprietor, whether by way of:

- (a) A mere change in the name and address of the proprietor, or

(b) A change of ownership of the registered mark by way of transfer or assignment

the proprietor shall effect such changes using the prescribed forms before the application to renew.

The appropriate forms to file online at <https://ip2sg.ipos.gov.sg> are as follows:

Form CM1	For request to appoint, change or remove an agent
Form CM2	For request to change name, address or Singapore address for service
Form CM8	For change of ownership

## **5. ADDRESS FOR SERVICE**

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For renewal applications lodged on or after 1 January 2006, the address for service entered on the renewal request form (including late renewal and restoration of registration) is effective for all renewal matters in respect of the registered mark in relation to which the form is filed (*see Rule 9 of the Rules*).

This means that FONs issued subsequent to that renewal request would be sent to this address.

## 6. INTERNATIONAL REGISTRATION

---

Renewals of International Registrations ("IR") must be done with the World Intellectual Property Office (WIPO).

### 6.1. Duration of Registration

An IR is valid for an initial period of 10 years with the possibility of renewal under Article 7 of the Madrid Protocol (*see also Article 6(1) of the Madrid Protocol ("MP")*).

### 6.2. Renewal Application

Any IR may be renewed for a period of 10 years from the expiry of the preceding period subject to the payment of the prescribed fees and lodgment of the prescribed form (*See Article 7(1) of the MP*) before the date of expiry of the IR.

WIPO will send an unofficial reminder to the holder of the IR stating the exact date of expiry of the IR 6 months before the expiry of the IR (*see Article 7(3) of the MP*).

If the holder does not receive such a notice, this will not constitute an excuse for failure to comply with the any time limit for payment due for renewal (*see Rule 29 of the Regulations*). This reminder will also be copied to the holder's representative (if any) in the country of origin of the mark.

The renewal may be effected electronically via the WIPO Website under *Forms Required for the International Registration of a Mark* and also under *Online Services*.

No official form is prescribed for the renewal of an IR, as electronic renewal may effected by giving the necessary information numbers of the IR concerned and the purpose of payment.

A request to renew an international registration may be sent to WIPO earliest 3 months before the renewal date.

Holders should be aware that if they file a request for renewal more than 3 months in advance of the renewal date, it shall be considered as having been received by the International Bureau 3 months before the date on which renewal is due (*see Rule 30(1)(b) of the Regulations*) and the prescribed fees for renewal will be based on that date considered as received by the IB, even if the prescribed fees are changed after the date of payment and before the renewal date (*See Rule 34(7) of the Regulations*).

An international registration is dependent on the national basic mark for a period of five years following the recordal date of the IR (*see Article 6 of the MP*).

After the 5 year duration, the IR becomes independent of the basic mark (*see Article 6(2) of the MP*). In order to extend the validity of the IR, it is not necessary for the basic mark to be renewed and the IR will not extend its protection to country upon which it is originally based.

**Renewal of Subsequent Designations**

The period of protection under the subsequent designation expires on the same date as the international registration.

The effective date of the renewal is the same for all designations contained in the IR, irrespective of the date on which such designations were recorded in the IR (*see Rule 31(2) of the Regulations*).

For example, if a holder has an IR dated 31 December 2005 designating Australia and Japan and he makes a subsequent designation in the USA and Vietnam on 31 December 2008. In order to maintain the validity of the IR beyond the expiry date of 31 December 2015 in **all** the individual designated countries, the holder must:

- Renew the IR with WIPO by 31 December 2015; and
- Select all the individual designations in Australia, Japan, the USA and Vietnam for renewal.

**6.3. Late Renewal Application**

It is possible to renew international trade marks within a grace period of 6 months after the date of expiry of the IR, subject to the payment of a surcharge (*see Article 7(4) of the MP*).

**6.4. Non-Renewal**

Where an international registration is not renewed, the International Bureau shall notify the Offices of all of the Contracting Parties designated in that international registration. Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the Office of that Contracting Party (*see Rule 31(4) of the Regulations*).

For more details on the Madrid Protocol regime, please refer to the IPOS Website or to the WIPO Website.

## **CLASSIFICATION OF GOODS AND SERVICES**

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**CLASSIFICATION OF GOODS AND SERVICES**

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## **1. OVERVIEW**

In Singapore, a trade mark application for registration has to be accompanied by a list of the goods and/or services on which the mark is intended to be used. The list of goods and services is an important aspect of a trade mark application as the scope of the applicant's rights in the mark is defined and limited by the scope of the list also known as the specification.

The goods and services must be classified in accordance with an internationally agreed classification system used by more than 150 countries, known as the International Classification of Goods and Services (ICGS) or the Nice Classification. The international classification system enables efficient searches for conflicting trade marks to be done worldwide, benefitting not just the Registry staff, but also users who wish to check whether there are marks which have been already applied for or registered that conflict with marks they are using or propose to use. If the classification of the goods or services of an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the Register.

It is therefore important that the list of goods and services in an application for registration be worded in such a way as to (a) indicate clearly the nature of the goods and services, and (b) allow each item to be classified in the correct class of the edition and version of the Nice Classification prevailing at the point of filing of the application for registration of the trade mark.

The purpose of this manual is to describe the Registry's practice concerning classification of goods and services.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act [Cap. 332, 2005 Ed.]**

#### **Application for registration**

**5.**—(1) An application for registration of a trade mark shall be made in the prescribed manner to the Registrar.

(2) The application shall —

- (a) contain a request for the registration of a trade mark;
- (b) state the name and address of the applicant;
- (c) contain a clear representation of the trade mark;
- (d) list the goods or services in relation to which the applicant seeks to register the trade mark; and
- (e) state —
  - (i) that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services; or
  - (ii) that the applicant has a bona fide intention that the trade mark should be so used.

(3) The application shall be subject to the payment of the application fee and such other fees as may be appropriate.

(4) The date of the application for registration of the trade mark shall be the earliest date on which —

- (a) all the requirements under subsection (2) have been satisfied; and
- (b) all the fees payable under subsection (3) —
  - (i) have been paid; or
  - (ii) are treated by the Registrar as paid.

#### **Classification of goods and services**

**6.**—(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final.

#### **Withdrawal, restriction or amendment of application**

**14.**—(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If the application has been published, the withdrawal or restriction shall also be published.

(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

## **Trade Marks Rules**

“specification” means the specification of goods or services in respect of which —

- (a) a trade mark; or
  - (b) a transaction in relation to a registered trade mark or an application for the registration of a trade mark,
- is registered or proposed to be registered;

## **Specification**

**19.**—(1) For the purposes of the registration of a trade mark, goods and services are classified according to the Nice Classification as in force on the date of the application for registration of the trade mark.

(2) Every application shall contain, for each class of goods or services to which the application relates —

- (a) the class number as set out in the Nice Classification as in force on the date of that application; and
- (b) a specification of those goods or services which —
  - (i) is appropriate to that class;
  - (ii) is described in such a manner as to —
    - (A) indicate clearly the nature of those goods or services; and
    - (B) allow those goods or services to be classified in accordance with the Nice Classification as in force on the date of that application; and
  - (iii) complies with any other requirement of the Registrar.

(2A) For the purpose of paragraph (2)(b), the applicant may adopt a specification set out in an approved list of goods or services contained in a practice direction issued by the Registrar.

(3) An application may be made in respect of more than one class of goods or services in the Nice Classification as in force on the date of that application, and in such a case, the specification shall set out the classes and list under each class the goods or services to which the application relates.

(4) In the case of an application for registration in respect of all the goods or services included in a particular class in the Nice Classification as in force on the date of that application, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make if and when it is registered.

## **Amendment of application**

**22.**—(1) An application to amend an application for registration shall be made in —

- (a) Form CM1, if it is made to appoint, change or remove an agent;

- (b) Form CM2, if it is made to change or correct the name or other particulars of the applicant, and the change or correction does not affect the representation of the trade mark; and
- (c) Form TM 27, if sub-paragraphs (a) and (b) do not apply.

(5) Before acting on an application to amend an application for registration, the Registrar may require the applicant to furnish such proof as the Registrar thinks fit.

## **Trade Marks (International Registration) Rules**

### **Entitlement to protection**

**5.** —(1) Subject to the provisions of rules 11 to 17, an international registration designating Singapore shall be entitled to become protected where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration of a trade mark under the Act, including any imposed by the Trade Marks Rules.

(2) For the purpose of paragraph (1), sections 5 and 6 of the Act and rules 9, 15, 16, 18, 19(1), (2)(a) and (b)(i), (ii)(B) and (iii) and (3), 20 and 21 of the Trade Marks Rules shall be disregarded.

### 3. THE NICE CLASSIFICATION

Goods and services are divided into 45 classes, each class covering a different category of goods or services. Classes 1 to 34 relate to goods, and Classes 35 to 45 relate to services.

In total, the Nice Classification contains around 10,000 indications of goods and 1,000 indications of services.

#### 3.1 Structure of the Nice Classification

Each class of the Nice Classification contains:

- a) **Class Heading:** The class headings describe in very broad terms the nature of the goods or services contained in each class.
- b) **Explanatory Note:** The explanatory note of a given class describes in greater detail the types of goods or services included in that class.
- c) **Alphabetical List:** The most detailed level of the Classification is the alphabetical list which shows the individual goods or services appropriate to a class.

The Nice Classification further contain General Remarks which prescribe that the indications of goods and services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to ascertain the exact classification of each individual good or service.

The General Remarks prescribe that if a term cannot be classified with the aid of the list of classes, the Explanatory Notes and the Alphabetical List, the following criteria shall be applied:

#### Goods

- a. A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.
- b. A finished product which is a multipurpose composite object (e.g., clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria, indicated under (a), above, are to be applied.
- c. Raw materials, unworked or semi-worked, are in principle classified according to the material of which they consist.
- d. Goods intended to form part of another product are in principle classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.
- e. When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is in principle classified according to the material which predominates.
- f. Cases adapted to the product they are intended to contain are in principle classified in the same class as the product.

### Services

- a. Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List.
- b. Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Class 38). Leasing services are analogous to rental services and therefore should be classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.
- c. Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.
- d. Services rendered in the framework of franchising are in principle classified in the same class as the particular services provided by the franchisor (e.g., business advice relating to franchising (Class 35), financing services relating to franchising (Class 36), legal services relating to franchising (Class 45)).

## 3.2 Changes to the Nice Classification

The Nice Classification is continuously revised to keep it up to date, to remove anomalies and inconsistencies that have been found and to make improvements with new entries.

A new edition is published every five years and, a new version of each edition is published annually. The revision is carried out by the Committee of Experts set up under the Nice Agreement, to which all States party to the Agreement are members of.

As mentioned above, goods and services are classified according to the current edition and version of the Nice Classification in force at the time of application. Consequently, changes are not made retrospectively to existing registrations on the Register to accord them with the new classification.

Users doing a search for conflicting trade marks should bear in mind the possibility of classification changes to the specific items in that class. For example, “temporary accommodation” which used to be classified in Class 42 under the seventh edition of the Nice Classification is now classified in Class 43. (Prior to the implementation of the eighth edition of the Nice Classification, there were only 42 classes of goods and services.) To cater to this change, the Registry’s search system performs an automatic search of conflicting trade mark(s) in Class 42 for applications which are made in Classes 43, 44 and 45.

#### **4. CLASSIFICATION TOOLS**

The Registry maintains an online Classification Search Tool comprising some 100,000 terms (including those in the Alphabetical List) which the Registry has pre-approved for classification purposes. The Classification Search Tool is updated regularly to reflect the Registry's current practices as well as the latest version and edition of Nice Classification.

If you do not know which class(es) your goods or services are in, please use the Classification Search Tool accessible at:

<http://goo.gl/k5ZmLi>

This tool will help you to search for and classify goods and services (terms) needed to apply for trade mark protection.

The Registry's database of the pre-approved list of goods and services has also been incorporated into the electronic form for applying to register a trade mark, Form TM4, in the form of "Keyword search" function.

"Keyword Search" function assist applicants in:

- a. searching the most appropriate descriptions of a certain good or service;
- b. ensuring that the application is filed in the correct class; and
- c. ensuring that the description is one that would not face objection from the Registrar.

Applicants can be assured that every term found in the pre-approved list of goods and services at the point of filing will be accepted by the Registrar for classification purposes. This will shorten the examination time as there is no need to verify whether the goods or services can be accepted in the class proposed by the applicant and ultimately the application would be accepted for publication earlier if no other objections are encountered. Applicants can also enjoy a 30% fee discount for each class that fully conforms to the pre-approved list.



## 5. GENERAL CLASSIFICATION PRINCIPLES

The following are some of the general classification principles which every specification of goods and services will need to comply with. In accordance with Section 6(2) of the Act, any question that may arise regarding the proper class in which the goods or services should be classified shall be determined by the Registrar; and any such decision shall be final.

### 5.1 Need for clarity in specifications

Rule 19(2) of the Trade Marks Rules (the “**Rules**”) provides that the specification of goods and services must be clear as to the nature of the goods and services and described in a manner to allow them to be classified in the classes in the Nice Classification. The terms used should therefore be found in mainstream dictionaries, specialist dictionaries or prevalent on the internet.

Where the term is not clear to the Registrar, the Registrar may ask for an explanation of the term or an amendment of the term.

#### 5.1.1 Use of acronyms and abbreviations in specifications

In view of the need for clarity in the specification, only acronyms and abbreviations which are commonly known in the particular industry of the goods and/or services claimed, such as “CD-ROM”, “MP3”, “VCD”, “AM”, “FM”, “TV”, “UV”, are acceptable.

If the acronym or abbreviation is not commonly known in the industry or is vague as to its nature, the Registrar will require the acronym or abbreviation to be amended to its full form.

#### 5.1.2 Interpretation of specifications

In construing how an item in the specification should be interpreted, the Registrar will look at how the goods or services are regarded for the purposes of trade. They would usually be given a narrow interpretation confined to the substance or the core of the possible meanings attributable to the phrase.

For example, in a case concerning printed matter, *MINERVA Trade Mark* [2000] FSR 734, Jacob J. made the following comments:

*“The specification of goods poses difficulties. “Printed matter” as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads “printed matter” perfectly literally. Every packet has printed matter on it. “Printed Matter” cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for “printed matter” but the only use is on labels for, say, soap or bananas, there has not been use for printed matter. On the other hand, the kind of printed forms and other things produced by these proprietors seem to be perfectly well described as “printed matter”. People buy them for what is printed on them. However, there is a very big difference between that sort of printed matter and printed matter of a literary character.”*

## **5.2 Need to be correctly classified**

Rule 19(2) of the Rules provides that the specification of goods and services must be appropriate to the class claimed.

In considering the classification of a particular good/service, the first point of reference shall be the Alphabetical List. If a good/service is not listed in the Alphabetical List, reference will be made to the Explanatory Notes, followed by the General Remarks.

Applicants may also use the Registry's pre-approved list of goods and services by doing a search of the goods or services of interest to determine the correct class for the term.

### **5.2.1 Class to be taken into account when interpreting specifications**

In the context of the Nice Classification, there are general terms which are sometimes marked with an asterisk to indicate that a more specific item of those goods or services is also classified in other classes.

Therefore, applicants are cautioned to bear in mind the scope of what a particular item covers in the context of the class in which it is applied or registered.

For example, a registration in respect of "clothing" in Class 25 does not include "clothing for protection against accidents" in Class 9. Similarly, a registration in respect of "building materials" in Class 6 does not include "building materials, not of metal" in Class 19.

### **5.2.2 The use of square brackets [ ] and round brackets ( ) in specifications**

Square brackets [ ] and round brackets ( ) are used in the Alphabetical List and are also used by the Registrar.

#### **Square brackets**

Square brackets [ ] are used to define more precisely the text or item preceding the brackets, in situations where the text is ambiguous or too vague for classification purposes.

For example, "jackets" can fall in several classes depending on the nature of the jackets. Hence, to define the item more precisely in Class 25, the item should be described as "jackets [clothing]".

The Registrar adopts this practice and would sometimes require an otherwise vague item to be qualified using square brackets. For example, the description "desserts" per se would be objected to on the ground that it is vague but would be acceptable in Class 30 if amended to "desserts [ice cream]".

#### **Round brackets**

Round brackets ( ) are used to qualify the text or item preceding the brackets to ensure correct classification.

Round brackets are used when it is possible that the item can be classified in various classes depending on the intended goods or services sought to be covered. For example, “clips” can fall in several classes depending on the nature of the clips. Hence, to define the item more precisely in Class 14, the item may be described as “clips (tie -)” or alternatively “tie clips”.

### **5.3 Class headings of the Nice Classification**

Class headings of the Nice Classification are general indications of the goods and services that are included in a particular class.

A specification consisting of a class heading does not equate to a claim for all the goods or services that may be in that class. To illustrate, the class heading of Class 15 is “musical instruments”. An application stating “musical instruments” in the specification of goods does not include “music stands” and “piano strings”, although they are listed in Class 15 of the Nice Classification.

Claims for class headings or parts of class headings are acceptable, save for “personal and social services rendered by others to meet the needs of individuals”, which appears in the heading of Class 45. The item “personal and social services rendered by others to meet the needs of individuals”, is deemed to be insufficiently clear and precise as it does not provide a clear indication of what services are covered. It simply states that it is a form of personal and social services and such services cover a wide range of activities performed by different service providers in different market sectors, and require varying levels of knowledge and skill sets. An objection under Rule 19(2)(b)(ii) of the Rules will be raised against such an item.

### **5.4 The use of punctuation in specifications**

The use of correct punctuation is very important in a list of goods and services. Applicants are advised to take note of the following guidelines when using punctuation within a specification:

- a. Use semicolons (;) to separate the different categories of goods or services as segments within a class. For example, “Clothing; footwear; headgear” in Class 25 are separated by semi-colons as they are three different categories of goods.
- b. Use commas (,) to separate different items within the same category of goods or services where they are related to each other. For example, “Retail services in relation to clothing, footwear, headgear” in Class 35, “clothing, footwear, headgear” are separated by commas as they form part of the item “retail services in relation to...”;
- c. Avoid the use of colons (:).

The separation of terms by incorrect punctuation can lead to changes in meaning and possible incorrect classification.

Example 1: “Computer programs for use with filling machines; packaging machines” in Class 9. Due to the use of the semi-colon, “packaging machines” would be regarded as an independent category of goods and not regarded as “computer programs for use with packaging machines”. In this case, an objection will be raised against “packaging machines” as it is proper to Class 7.

Example 2: “Meat; fruits; vegetables, all being frozen” in Class 29 means that the qualifier “all being frozen” only applies to “vegetables” as the use of semi-colons before “vegetables” had separated each item as an independent category of goods. If the intention was to protect “frozen meat, frozen fruits and frozen vegetables”, the specification should read as “Meat; fruits; vegetables; all being frozen”.

## 5.5 Use of transitional expressions in specifications

The use of transitional expressions in specifications could determine if a description is limited to the goods or services specified after an expression. Such use could also result in specifications encompassing additional, unnamed goods or services. The following sets out how the Registrar interprets the use of transitional expressions in specifications.

### Restrictive transitional expressions

Restrictive expressions such as “namely”, “exclusively”, “being”, “in the nature of”, “consisting of” and “comprising” effectively restricts a specification of goods or services. This means that what would otherwise be considered a vague description may be made acceptable through the use of such expressions and the listing of acceptable goods or services after them.

For example:

<b>Specification</b>	<b>Effects of use of restrictive expression</b>
Class 5: “Pharmaceutical products <b>exclusively</b> for dermatological use”	The use of “exclusively” would limit the goods to only pharmaceutical products for dermatological use, and exclude pharmaceutical products for all other uses.
Class 21: “Oral care kits <b>comprising</b> toothbrushes and dental floss”	The use of “comprising” renders the specification of goods acceptable as the vague description “oral care kits” has been restricted to encompass only toothbrushes and dental floss.
Class 30: “Desserts, <b>namely</b> ice cream”	The use of “namely” renders the specification of goods acceptable as the vague term “desserts” has been limited to only ice cream.

### Elaborative transitional expressions

On the other hand, the use of expressions like “such as”, “in particular”, “particularly”, “including”, “especially”, “specifically” and “containing” merely serves to elaborate the preceding description and does not effectively restrict a specification of goods or services. This means that the specification is not limited to specific goods or services, and may also include unnamed goods or services that falls within the scope of the preceding description.

For example:

<b>Specification</b>	<b>Effects of use of elaborative expression</b>
Class 15: “Musical instruments, <b>including</b> piano”	The use of “including” does not restrict the scope of the specification. Essentially, the applicant is claiming all types of musical instruments, with piano as an example.
Class 25: “Clothing, <b>in particular</b> T-shirts”	The use of “in particular” does not restrict the scope of the specification. The applicant is claiming all types of clothing, with T-shirts as an example.

Consequently, the use of such elaborative transitional expressions after a vague description will not help to clarify the ambiguity of the preceding description or render the description acceptable as a whole.

For example:

<b>Specification</b>	<b>Effects of use of elaborative expression</b>
Class 3: “Gift sets <b>containing</b> skin and hair care preparations”	As the preceding description “gift sets” is vague, the use of “containing” merely informs that skin and hair care preparations are included in the gift sets, among other products. Such an expression does not help to clarify the vagueness of the preceding description.
Class 30: “Foodstuff <b>especially</b> biscuits”	As the preceding description “foodstuff” is vague, the use of “especially” merely informs that the applicant is claiming other types of foodstuffs apart from “biscuits”. Such an expression does not help to render the whole specification acceptable.
Class 45: “Personal services, <b>such as</b> babysitting”	As the preceding description “personal services” is vague, the use of “such as” merely informs that “babysitting” is one of the personal services provided by the applicant, and does not help to clarify the ambiguity of the preceding description.

## 5.6 Referencing to other classes in specifications

As a general rule, references to other classes within a specification are not permitted. For example, “machines, not included in Class 7” in Class 9. This is because it is vague and it lacks

legal certainty as to what goods and services are included. In the example above, the respective goods in Class 9 would need to be specified.

However, where the trade mark application is a multi-class application, cross referencing to the goods and services in the other classes of the same application, is acceptable, where the language is clear and there is no doubt on the face of the application what the specific goods and services being referred to are.

In the example below where a multi-class application is filed in respect of Classes 7 and 37, the description of services claimed in Class 37 is acceptable:

Class 7: “Blowing engines; packaging machines”.

Class 37: “Repair services; all relating to goods in Class 7 of this application”.

Even where the reference is clear, cross-referencing to other classes, whether of a multi-class application or otherwise, may not always be meaningful. For example, “transport services of textiles and textile goods, not included in other classes” in Class 39.

## **5.7 Use of Geographical Indications in specifications**

Geographical Indications (GIs) are signs that identify specific products which comply with certain characteristics and come from a particular area. Therefore, they are not a generic category of goods.

For this purpose, GIs should not be used in the specification unless it is clear that the reference is indeed to the GI and not the generic category of goods.

Where the Registrar is of the view that the nature of the goods being claimed are not clear (i.e. whether the goods are GI goods or generic goods), the Registrar may raise an objection under Rule 19(2)(b)(ii)(A) of the Rules, suggesting that the item be amended to either of the following:

- a. The generic description of the product;

*For example:*

*“sparkling white wine” for “Champagne”; or  
“brandy” for “Cognac”.*

- b. Clarify that it is indeed the GI that is being referred to:

*For example:*

*Wines with the geographical indication “Champagne”; or  
Spirits with the geographical indication “Cognac”.*

## **5.8 Use of registered trade marks in specifications**

Registered trade marks, whether belonging to the applicant or otherwise, are not acceptable in specifications of goods and services. Instead, applicants should use generic descriptions for their goods and services.

For example, as “Bluetooth” is a registered trade mark, a specification of goods which reads “bluetooth-enabled devices for communications” should be amended to read as, for example, “devices for communications which are enabled by short range radio technology”.

The non-exhaustive list below provides suggested alternative description(s) to words which are registered trade marks:

TRADE MARKS	CLASS	ALTERNATIVE DESCRIPTION(S)
BAND-AID	05	Adhesive dressings; Adhesive materials
ELASTOPLAST	05	Elasticised dressing
IPOD	09	Portable audio and data storage equipment
KLEENEX	16	Facial tissues
LYCRA	22	Synthetic fibres and filaments
POLAROID	09	Photographic equipment
ROLLERBLADE	28	In-line skates
STYROFOAM	17	Multicellular expanded synthetic resinous material
THERMOS	21	Insulated flask
VASELINE	05	Lubricating jelly
WALKMAN	09	Portable audio equipment
XEROX	09	Photocopier

## **5.9 All goods/services or a large variety of goods/services claimed in application**

### **5.9.1 “All goods or services” and “all other goods or services”**

Descriptions such as “all goods in this class”, “all services included in this class”, “all other goods in this class”, “all other services included in this class”, “all goods in Class XX”, “all services in Class XX” and their equivalent are objectionable under Rule 19(4) of the Trade Marks Rules. If a description of such a nature is used in a specification of goods or services, the Registrar will ask that the applicant delete it and to specify clearly the goods or services to which the trade mark relates.

### **5.9.2 Multi-class application consisting of unrealistically broad range of goods/services**

The Registrar may also raise an objection under Rule 19(4) of the Rules for multi-class application consisting of unrealistically broad range of goods/services when viewed in a commercial context such that it is unlikely that the applicant would trade in that entire range of goods/services.

## **6. EXAMINATION PROCEDURES**

### **6.1 Checklist for examination of specifications**

The Registrar will apply the following checklist when a specification is being examined:

- a. Whether the goods or services are grouped according to class numbers in accordance with Rule 19 of the Rules?
- b. Whether the specification is filed in the correct class such that it is in accordance with Section 6 of the Trade Marks Act (“Act”)?
- c. Whether the description of the goods or services is clear? If it is not, the applicant will be asked to provide further information.
- d. Whether the specification contains goods or services that do not fall in the class applied for?
- e. If an amendment is necessary, whether the proposed amendment will result in the widening of the scope of the specification? If so, the amendment will not be allowed.

### **6.2. Goods and services to be grouped according to class number**

According to Rule 19 of the Rules, a specification should be set out in the following manner:

- a. The goods or services should be grouped together according to their relevant class(es); and
- b. The class number for each group must be indicated.

### **6.3. Goods or services that could fall in more than one class**

Where there is a possibility that a good or service could fall into classes not included in an application, a qualifier is **generally not required** as it will be assumed that the item is correctly classified and no objections should be raised.

For example, “vanity cases, not fitted” falls in Class 18 while “fitted vanity cases” falls in Class 21.

If an application is filed for “vanity cases” in Class 18, then it should be assumed that the applicant is claiming for “vanity cases, not fitted”. It will not be necessary to request for more information. This approach should generally be taken regardless whether the applicant is represented by an agent or acting on his own, though in the latter case, the Registrar may exercise more customer care if it appears that the applicant could be mistaken.

However, the Registrar requires a qualifier to be added if:

- a. The items have been highlighted in our practice circulars, available on IPOS’s [website](#), as being too broad or vague for the purpose of classification without the addition of a proper qualifier. For example, “prepared meals” - The item should specify the content of the prepared meals, for example, “prepared meals consisting of meat” in Class 29 or “prepared meals containing principally of rice” in Class 30.



- b. The goods or services claimed are of a specialised nature or specialised market and falls in a different class from the non-specialised goods or services. For example, “clothing” which is applied for in Class 9 would need to be qualified to “clothing for protection against accidents” as the proper class for generic types of clothing falls in Class 25. Similarly, “furniture” which is applied for in Class 10 would need to be qualified to “furniture for medical purposes” as the proper class for generic types of furniture falls in Class 20.
- c. They are vague or broad descriptions. For example, “franchising services” - The description may be amended to, for example, “business advice relating to franchising” in Class 35, “franchising services [financing services]” in Class 36 or “legal services relating to franchising” in Class 45.

#### **6.4 Precedents in support of a specification of goods/services**

When examining a specification of goods or services for compliance with the ICGS, the Registrar is prepared to rely on precedents relating to Singapore, United Kingdom, Australia, Hong Kong, New Zealand and the United States of America.

However, the Registrar will not consider precedents which are:

- Clearly accepted in the wrong class;
- No longer accurate in light of the relevant edition/version of the International Classification of Goods and Services; or
- Inconsistent with our current practice or that of the relevant foreign IP office.

#### **6.5 Correction of errors in specifications / classification before registration**

An application for registration may be amended at any time before registration to correct errors in the specification or the classification of items in the specification.

However, amendments will not be allowed if:

- (a) The proposed amendment does not fall within the scope of the original specification (that is, it is not a subset of the original specification);
- (b) The amendment would widen the original specification; or
- (c) The amendment would prejudice the rights of a mark which has been filed, accepted or registered before the date of application of the amendment.

The following sections deal in more detail with what is permitted and what is not.

##### **6.5.1 Deletion of classes from an application**

Deletion of a class from an application means that every single item spelled out in the specification within that class would be deleted as well. This may be done at any time during the prosecution of an application by writing in to the Registrar. The filing fee is however not refunded when a class is deleted.

### **6.5.2 Deletion of items within a class**

When the goods or services included in a specification fall in a class that is different from the one applied for, the incorrectly classified item(s) should be deleted. For example, if a specification in Class 39 reads “Rental of cars; booking agency services for hotel accommodation”, the applicant will have to delete “booking agency services for hotel accommodation” as the item is proper to Class 43 instead.

Amendments to a specification of goods/services must be effected on Form TM27 which is chargeable on a per class basis.

It is to be noted that once a deletion has been effected, the deleted item cannot be re-introduced or the remaining list of goods or services extended.

### **6.5.3 Amendment of class number not involving splitting of goods or services**

If the goods or services have been correctly stated on the application form and the goods or services clearly do not fall in the class as filed but in another class, the amendment of the class number can be allowed.

The amendment of the class number not involving any split of the goods or services may be effected by the applicant on Form TM27 which is chargeable on a per class basis.

#### **Circumstances when it is allowed**

It will be allowed only when all the items listed under that class obviously belong to one other class of the Nice Classification.

Example 1:

Original filing: “Computer programming” in Class 9

Decision: Substitution of Class 42 for Class 9 would be allowed as the specification obviously indicates a service that does not belong to Class 9 but Class 42.

Example 2:

Original filing: “Services for providing food and drink; restaurant services; cafe services; catering services” in Class 42

Decision: Substitution of Class 43 for Class 42 would be allowed as the specification obviously indicates services that do not belong to Class 42 but Class 43.

#### **Circumstances when it is not allowed**

Amendment of the class number would not be allowed if the mistake is not obvious on the face of the application.

Example 1:

Original filing: “Hats” in Class 25

Amendment to: “Protective hats” in Class 9

Decision: Substitution of Class 9 for Class 25 would not be allowed as it is not obvious that there is a mistake on the face of the application as hats do fall in Class 25 and it will be assumed that protection is only required for the hats that fall in Class 25.

Example 2:

Original filing: “All goods in Class 31” in Class 31

Amendment to: “Processed fruits” in Class 29

Decision: Substitution of Class 29 for Class 31 would not be allowed as it is not obvious that “all goods in Class 31” was intended to cover “processed fruits” in Class 29.

When the amendment of the class number may be allowed, the application is subjected to a search for similar marks in the corrected class to see whether there are any prior similar or identical marks on record. It is recommended that the applicant conducts a similar mark search before proceeding with the amendment. If the search reveals:

- a. A conflicting mark filed or claiming priority before the filing date or priority date of the subject application:

The amendment may be allowed (so that the change in class would be reflected publicly) but an examination report will be issued, refusing the subject mark on relative grounds.

- b. A conflicting mark filed after the subject application and not having priority before the subject application:

The amendment is not allowable. The applicant may wish to consider amending the specification so that the application in that class may be salvaged within accepted principles, such as, not altering or broadening the scope of the application.

#### **6.5.4 Transfers (splitting) of goods or services where an application covers more than one class**

If on a multi-class application there are goods or services incorrectly classified it is allowable to transfer those goods or services between the classes shown on the application.

The amendment may be effected by the applicant on Form TM27 which is chargeable on a per class basis, on the basis that this is a correction of obvious mistakes under section 14(3)(c) of the Act.

#### **Circumstances when it is allowed**

It will be allowed only when items which obviously belong to another class of the Nice Classification are found to be in the specification and that other class is claimed in the application.

Example 1:

Original filing:           Class 3: Deodorants for personal use; room deodorants; perfumes  
                                  Class 5: Air freshening preparations

Class 11: Air deodorising apparatus

Proposed transfer: “Room deodorants” from Class 3 to Class 5

Decision: The item “room deodorants” is clear and not vague. It is obvious that “room deodorants” have been wrongly classified and the proper class is obviously Class 5 and Class 5 has been claimed in the same application. Therefore, the transfer is allowed.

**Circumstances when it is not allowed**

The transfer of the item would not be allowed if the mistake is not obvious on the face of the application, in the sense that an alteration in the item previously claimed is required or would widen the scope of the specification originally sought.

Example 1:

Original filing: Class 1: Developing materials

Class 3: Detergents for household purposes

Proposed transfer: “Detergents for household purposes” from Class 3 to “detergents for use in manufacturing processes” in Class 1

Decision: Not allowed as the transfer would widen the scope of the specification originally sought.

Example 2:

Original filing: Class 30: Non-alcoholic beverages

Class 32: Beer

Proposed transfer: “Orange juice” from Class 30 to Class 32

Decision: Not allowed as it is not obvious that “orange juice” was intended to be claimed as it would be assumed that the “non-alcoholic beverages” claimed in Class 30 are only those which fall in Class 30.

When the transfer of item may be allowed, the application is subjected to a search for similar marks in the corrected class to see whether there are any prior similar or identical marks on record. It is recommended that the applicant conducts a similar mark search before proceeding with the amendment. If the search reveals:

- a. A conflicting mark filed or claiming priority before the filing date or priority date of the subject application

The transfer of item may be allowed (so that the item is reflected in the correct class publicly) but an examination report will be issued, refusing the subject mark on relative grounds.

- b. A conflicting mark filed after the subject application and not having priority before the subject application

The transfer of item is not allowable. The applicant may wish to consider amending the specification so that the application in that class may be salvaged within accepted principles, such as, not altering or broadening the scope of the application.

### **6.5.5 Adding a new class to the application**

Addition of new classes to an application would not be allowed as the amendment will widen the scope of protection of the trade mark.

### **6.5.6 Exclusions and restrictions of the list of goods and services**

Exclusions or restrictions in a specification are intended to exclude items which would otherwise fall within the specification claimed. Such exclusions or restrictions would usually be phrased as “excluding .....” or “but not including .....”. This is usually done to overcome an objection made under Section 8 of the Act. In such a scenario, an applicant may seek to exclude goods or services that are similar to that of the earlier application or registration in order to overcome the Section 8 objection.

An applicant may also restrict his specification in order to overcome an objection made under Section 7(1)(c) of the Act where the trade mark is found to be descriptive of the goods or services claimed.

Restrictions can be in positive or negative terms, such as:

Original filing: Alcoholic beverages

Acceptable restriction: “Alcoholic beverages all being whisky and gin” or “Alcoholic beverages none being whisky and gin”

Restriction of the specification may be effected by the applicant on Form TM27 which is chargeable on a per class basis.

### **6.5.7 Classification of goods or services for international registrations designating Singapore**

Where it concerns an international registration (“**IR**”) designating Singapore, the transfer of an item from one class to another existing class within that IR is not allowed.

This is because the International Bureau (“**IB**”) of the World Intellectual Property Organisation (“**WIPO**”) has already made the classification of the goods and services in respect of that IR and the IB's determination on the classification shall prevail even in the event of a disagreement with the office of origin (Article 3 of the Madrid Protocol).

Hence, a contracting country under the Madrid Protocol should not be re-determining the classification. A transfer in class may only be effected by the Registrar when the relevant correction notice is issued by the IB.

However, Article 4(b) of the Madrid Protocol still allows a contracting country to determine the scope of protection of the mark. In cases where items in a specification are vague, the office of a designated contracting country of an IR may object to those items and request that the holder of the IR amends them for the purpose of clarity.

### **6.5.8 Amendment or restriction of goods and services for international registrations designating Singapore**

Following an objection from the Registrar, the holder of an IR designating Singapore may request in writing for the item to be amended or restricted. No form or fees are required for this amendment or restriction. However, to make the request, an address for service in Singapore must be lodged on Form CM 1.

Alternatively, and in addition, the holder of an IR may record a limitation of the list of goods and services in some or all of the designated contracting countries for that IR by lodging with the IB Form MM6. Such a request may be made whether or not the item has been objected to by the Registrar but where it stems from such an objection, the holder has to ensure that the limitation is received by the Registrar before the deadline given for responding or to seek extension of time for responding.

The recording of a limitation does not entail the removal of the goods and services concerned from the IR as recorded in the International Register. The sole effect is that the IR is no longer protected for the goods and services concerned in the contracting countries covered by the limitation. Even if a limitation of the goods and services has been recorded with effect for all designated contracting countries, the goods and services which have been the subject of a limitation may be made the subject of a subsequent designation.

### **6.6 Correction of errors in specifications / classification after registration**

Under limited circumstances, errors in specifications may also be amended after the mark is registered. This should usually only be allowed where the Registrar has made a mistake in classifying the item.

Rule 83 of the Rules states, “Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interest of any person or party may be corrected on such terms as the Registrar may direct.”

However, it would not be possible to correct an error that results in broadening of the scope of a registration.

## **7 PRACTICE ON SPECIFIC ITEMS**

### **7.1 Rental or hire services**

The General Remarks of Nice Classification state “rental services are in principle classified in the same classes as the services provided by means of the rented objects”.

For example, “rental of telephones” would therefore fall in Class 38 as the services offered by telephones, telecommunication services, fall in Class 38.

### **7.2 Consultancy services**

Consultancy services are classified according to their subject matter. For example, “consultancy services relating to telecommunications” will be classified in Class 38, “transportation consultancy services” in Class 39 and “intellectual property consultancy services” in Class 45.

### **7.3 Technical consultancy services / Technical support services**

The Registry classifies “technical consultancy services”, “technical support services” and other similar technical advisory and technical information services according to their subject matter. This is in accordance with the General Remarks of the Nice Classification that state that services which provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation. For such descriptions, their subject matter has to be specified for the purposes of classification.

Having said that, as “technological services” is classified in Class 42, the Registry may, on a case by case basis, accepts “technical consultancy services” and “technical support services”, without further qualification, in Class 42 by interpreting the term “technical” as referring to “technological”.

### **7.4 Goods made of more than one material or ingredient**

When goods which are usually classified by their material or ingredient are made of more than one material or contain more than one ingredient, the applicant is required to specify the principal material or ingredient thereof. Such descriptions may be accompanied by phrases like “all made wholly or principally of”, “made predominantly of”, “primarily of”, “mainly of” or “based on”.

For example, the description “statues made of a mixture of plastic, metal and precious metal” is not acceptable as the principal material of which it is made, is not indicated. An acceptable description in Class 20 would be “statues made predominantly of plastic, with added metal and precious metal”.

Similarly, the description “snack food” is not acceptable, and should be reworded to, for example, “snack food made wholly or principally of rice” or “snack food based on rice” for an application filed in Class 30.

## **7.5 Computerised communication network security and other security services**

“Computerised communication network security” and like services are proper to Class 42 and not Class 45, as such items are forms of computer services classified in Class 42.

Class 45 covers services for the protection and security of individuals and property in general, eg. “security services for buildings”, “personal body guarding” and “night guards”. If such services and information relating to such services are offered online or via a computer network, they will be classified under Class 45 as well.

However, Class 42 will cover security services if they pertain to security of computer networks or the internet, eg. “computerised communication network security”, or if such services are offered as a form of computer service, eg “data security services [firewalls]” or “professional consultancy relating to computer security”. It would not be correct to classify such computer security services in Class 45.

It is also useful to note that some security services are classified in Class 39. Security services relating to transport, eg. “guarded transport of valuables” and “escorting of travellers” are classified under Class 39 and not Class 45.

## **7.6 Electronic data storage; storage of data, information or documents**

“Electronic data storage” is classified in Class 42 instead of 35 by analogy to “duplication of computer programs” and “data conversion of computer programs and data [not physical conversion]” which are classified under Class 42. This is consistent with the Explanatory Note which states that “Class 42 includes mainly services provided by ... computer programmers, etc.”.

On the other hand, if the data, information or documents are being stored physically, for example, in a warehouse, then it is proper to Class 39. The determining factor is where the data, information, or documents are being stored.

The following are examples of acceptable descriptions in the designated classes:

- “Physical storage of electronically-stored data or documents” (Class 39)
- “Physical storage of electronically-stored information” (Class 39)
- “Computerised business information storage” (Class 42)

In practice, the Registry will accept the descriptions “data storage” and “information storage”, without further qualification, in both Classes 39 and 42, by assuming that the services relate to the physical storage of data/information when filed in Class 39, and that the services relate to the electronic storage of data/information when filed in Class 42.



### **7.7 Providing on-line forums; operating chat rooms; providing chat rooms; providing discussion services on-line**

“Providing on-line forums”, “operating chat rooms”, “providing chat rooms”, and “providing discussion services on-line” are acceptable in Class 38, regardless of the topic of the discussion. These items are analogous to the items “electronic bulletin board services [telecommunication services]” and “providing internet chatrooms” listed in Class 38 of the Nice Classification.

### **7.8 Arranging and conducting of colloquiums; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of symposiums; arranging and conducting of conventions; arranging and conducting of exhibitions**

The following services are classified in Class 41, regardless of the content covered by these services:

- “arranging and conducting of colloquiums”;
- “arranging and conducting of conferences”;
- “arranging and conducting of congresses”;
- “arranging and conducting of seminars”;
- “arranging and conducting of symposiums”; and
- “arranging and conducting of conventions”

It is the purpose of the service and not the subject matter that is covered by the service that determines their classification in Class 41. By virtue of their dictionary definitions, the terms, “colloquiums”, “conferences”, “congresses”, “seminars”, “symposiums” and “conventions” refer to activities linked with training or education, both of which are proper to Class 41.

To illustrate, “arranging and conducting of conferences for commercial or advertising purposes” and “arranging and conducting of seminars for commercial or advertising purposes” are both classified in Class 41.

However, the item, “arranging and conducting of exhibitions”, is classified according to the purpose of the service. This is reflected in the NICE Classification which classifies “organization of exhibitions for commercial or advertising purposes” in Class 35, and “organization of exhibitions for cultural or educational purposes” in Class 41.

In practice, the Registry will accept the description “arranging and conducting of exhibitions”, without further qualification, in both Classes 35 and 41, by assuming that the services are for commercial or advertising purposes when filed in Class 35, and that the services are for cultural or educational purposes when filed in Class 41.

### **7.9 Providing a website**

The Registry accepts the description “providing a website” in Class 42, by interpreting the description as a form of website hosting services. As such, the description would not be acceptable in other services classes.

In cases where the website is used as a means for providing services, the applicant would be required to reword the description by specifying the services which are provided via the website. For example, “providing a website containing non-downloadable games” is not acceptable in Class 41, as the description refers to a type of website hosting services. On the other hand, “providing non-downloadable games via a website” is acceptable in Class 41, as it is a form of entertainment services provided via a website.

### **7.10 Computer services**

Given that computer related services are generally classified in Class 42, the Registry may, on a case by case basis, accept the description “computer services” in Class 42. Please note that such a claim in Class 42 does not include “computer services in the nature of installation, maintenance and repair of computer or computer hardware” which is classified in Class 37.

Similarly, the description “advice, information or consultation services relating to computer or computer hardware” or its equivalent is acceptable in Class 42 and is to be distinguished from “advice, information or consultation services relating to the installation, maintenance and repair of computer or computer hardware” which is classified in Class 37.

The descriptions “computer services” and “advice, information or consultation services relating to computer or computer hardware” or its equivalent, when filed in classes other than Class 42, is not acceptable because the exact nature of the services is unclear. Applicants would be requested to specify the exact nature of the services that they are claiming. The following are some examples of acceptable descriptions in Class 37:

- “Computer services, namely installation of computer hardware” (Class 37)
- “Advice relating to computer maintenance” (Class 37)
- “Computer consultancy relating to the repair of computer hardware” (Class 37)

### **7.11 Distribution services**

The description “distribution services” may involve services that straddle across Classes 35, 39 and 41. For example, the meaning of distribution services in Classes 35, 39 and 41 may be understood in the following contexts:

- Distribution services for the purpose of advertising, retailing or wholesaling (Class 35);
- Distribution services by way of transportation of goods, including the transport and supply of water, electricity and energy by pipeline and cable (Class 39);
- Distribution services relating to the process of making works of audio or visual production available to the public (Class 41).

In practice, the Registry will accept the description “distribution services” in Classes 35, 39 and 41, by assuming that it relates to distribution services rendered in the contexts of the respective classes as indicated above.

## **8 VAGUE DESCRIPTIONS**

Vague descriptions are not acceptable in specifications and should be amended for the purpose of clarity. The insertion of qualifiers such as “all included in this class”, “not included in other classes” or “all aforesaid in this class” will not render a vague item acceptable.

The following words or phrases are considered unclear and should be amended.

### **8.1 Apparatus, instruments, equipment**

The terms “apparatus”, “instruments”, “equipment” and their equivalent are acceptable only if they are further qualified to read as, for example, “lifting apparatus” (Class 7), “data processing equipment” (Class 9) or “surgical instruments” (Class 10).

### **8.2 Articles**

The word “articles” is used in the Class Heading of Class 21 (“articles for cleaning purposes”), Class 28 (“gymnastic and sporting articles not included in other classes”), and Class 34 (“smokers' articles”).

As long as the specification containing the word “articles” is clearly described, the Registry will not object to it. Description such as “articles of wood” in Class 19 is not acceptable and will need to be further qualified to “articles of wood for building purposes” in order to clearly indicate the goods intended.

Other examples of acceptable descriptions are “jewellery articles” in Class 14 and “thermal insulating articles” in Class 17.

### **8.3 Systems**

The use of the word “systems” is acceptable if the word is applied on goods which are clearly understood as being a system, e.g. “burglar alarm systems”, “computer systems” and “telecommunication systems”.

An example that is not acceptable would be “personal shower systems” as it is unclear what do such system consists of.

### **8.4 Goods, services**

Similar to the descriptions “goods” and “services”, phrases like “goods in this class”, or “services in this class” are not acceptable as they are vague. These descriptions are acceptable only if they are used with terms that adequately describe the type of goods or services, for example, “optical goods” is acceptable in Class 9 and “financial services” is proper to Class 36.

### **8.5 Parts and fittings (or components)**

“Parts and fittings (or components)” per se is vague and does not specify clearly the goods of interest. Therefore, it should not be accepted unless it relates to specific goods or is being further qualified. Thus, a specification of goods which reads “parts and fittings” will be objected to while a description in Class 9 which reads “parts and fittings of a television” will be acceptable.

### **8.6 Accessories**

As long as a specification containing the word “accessories” is clearly described, the Registry will not object to it.

For example, “regulating accessories for water or gas apparatus and pipes” in Class 11 and “air pumps (vehicle accessories)” in Class 12 are acceptable. However, descriptions such as “clothing accessories” in Class 25 is not acceptable as it could refer to items such as “brooches (clothing accessories)” in Class 26.

### **8.7 Use of terms “and the like”, “etc”**

A description of goods that reads, for example, “pouches and the like” is not acceptable as the expression, “and the like”, is vague. In the example given, it is not clear as to what other goods the applicant is claiming apart from pouches.

A description of services that reads, for example, “medical services, physiotherapy, physical therapy etc” in Class 44 is not acceptable as it is not clear what other services the applicant is claiming apart from medical services, physiotherapy and physical therapy.

### **8.8 Confinement services**

The term “confinement services” is too vague for acceptance per se in any class as it would cover babysitting, cooking, washing, massaging, and cleaning services, and all ancillary services that are required by the mother.

As the essential services for traditional confinement comprise: (1) doing household chores, and (2) taking care of the baby and mother, we will accept a description that reads, for example, “provision of confinement services, namely, babysitting” in Class 45; or “provision of confinement services, namely, nursing care and health care in domestic homes” in Class 44.

### **8.9 Desserts**

The Registry will not accept a specification consisting of “desserts” per se. This is in line with the IB’s view that the said item, without further qualification, is vague.

Examples of acceptable descriptions are:

- “Desserts [Jellies for food]” in Class 29
- “Fruit-based desserts” in Class 29
- “Chocolate-based desserts” in Class 30
- “Desserts [Ice cream]” in Class 30

#### **8.10 Vague descriptions relating to food**

A specification consisting of “prepared meals” per se, without further qualification, is vague and may fall within several classes. Applicants are required to specify the predominant ingredient of the prepared meals, and examples of acceptable descriptions are “prepared meals consisting of meat” in Class 29 or “prepared meals containing principally of rice” in Class 30.

This practice applies to similar vaguely described items such as:

- “frozen foods”
- “canned foods”
- “pre-packed meals”
- “nutritionally balanced low-calorie prepared meals”
- “foodstuffs in the form of prepared meals”
- “foodstuffs in the form of snack foods”
- “foodstuffs in the nature of spreads”
- “pre-cooked foodstuffs”
- “low calorie foodstuffs”
- “prepared food mixes”
- “processed foods”

Applicants are to specify the predominant ingredients of such items in order that the correct class can be determined.

#### **8.11 Ancillary services**

A description containing “ancillary services” or its equivalent, regardless of whether they are preceded or followed by a specific term, is not acceptable. This is because “ancillary” means “additional” or “subsidiary” which renders the nature of the ancillary services vague.

The addition of qualifiers such as “included in this class” or “all in this class” in such descriptions does not help in making those descriptions any clearer. The following are some examples of descriptions that are objectionable:

- “advertising services; services ancillary to the aforementioned included in this class”;
- “services ancillary to the provision of business management services; all in this class”;
- “all services ancillary to computer services; all included in Class 42”.

In such cases, the Registry will request that the applicant specify the “ancillary services” claimed so that the specification is clear and unambiguous.

### **8.12 Related services**

The Registry will accept descriptions containing “related services” or its equivalent, provided that the subject matter in which the services relate to is proper to the class applied for. The following are some examples of acceptable descriptions:

- Radio broadcasting related services (Class 38)
- Services relating to transport reservation (Class 39)
- Services related to education (Class 41)
- Services relating to the provision of food and drinks (Class 43)
- Legal advocacy related services (Class 45)

### **8.13 Association services**

The description “association services”, without further qualification, is not acceptable because the item is vague and may fall within several classes. Further qualification on the nature of the services provided by the association is required. The following are some examples of acceptable descriptions:

- “Association services, namely arranging business introductions” in Class 35
- “Association services in the nature of providing training for members of the association” in Class 41
- “Business promotion relating to the importance of health and nutrition, provided through an association” in Class 35

### **8.14 Mail order services**

“Mail order services” is not acceptable and should be reworded to “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order” or “mail order retail services” when filed in Class 35.

### **8.15 Manufacturing of goods**

“Manufacturing of goods” is not acceptable as it does not conform to the International Classification of Goods and Services. If a person is manufacturing goods, registration should be sought for the goods only.

As appropriate, the specification may be phrased as “custom assembling of materials [for others]” or “custom manufacturing of goods [for others]”. For example, where the items in question are cell cultures, it may be more appropriate to describe the service as “custom manufacturing of cell cultures [for others]”. However, if the goods in question are clothing, “custom assembling of clothing [for others]” would be more appropriate.

### 8.16 Provision of news

The Registry will accept “provision of news” and analogous descriptions in Class 41 by assuming that they refer to “news reporters services”. The following are some examples of acceptable descriptions in Class 41:

- Provision of news
- Reporting of current affairs
- Providing information relating to current affairs

Please note that if such services are filed in other classes, the corresponding subject matter or purpose of the services will have to be specified, in order to render them proper to the respective classes.

### 8.17 Retail services and other like services in Class 35

(a) The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods

The Registry will accept the description “the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods” without a need to qualify the means of bringing the goods together.

However, the Registry will continue to reject descriptions such as “mail order services” and “internet shopping”. These terms are considered vague as they include services more than retail and wholesale services.

The Registry will also accept the following descriptions in Class 35:

- Retail services
- Wholesale services
- Retail sale services
- Retail store services
- Wholesale store services
- Online retail services
- Online wholesale services
- Online retail store services
- Online wholesale store services
- Retail services in relation to *[list the goods]*
- Wholesale services in relation to *[list the goods]*
- The bringing together, for the benefit of others, of a variety of goods *[list the goods]* (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet

- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a wholesale outlet
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a wholesale outlet
- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a distributor outlet
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a distributor outlet
- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications
- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network
- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a departmental store
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a departmental store
- The bringing together, for the benefit of others, of a variety of goods [*list the goods*] (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a supermarket
- The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a supermarket

(b) Sale of [*goods of interest*]

The description “sale of [*goods of interest*]” is not an acceptable description of service. This is because the act of selling primarily benefits the seller and is not regarded as a service delivered to third parties.



An example of an acceptable description of service in Class 35 is “retail services relating to the sale of *[goods of interest]*”.

(c) Retailing of services

The Registry will not accept a specification containing a claim for “retailing of services” or “the bringing together, for the benefit of others, of a variety of services (excluding the transport thereof), enabling customers to conveniently view and purchase those services”. Applicants will be asked to clarify on the type(s) of services they are providing and to apply for such services in the appropriate class(es).

### 8.18 Kits

The Registry wishes to clarify that the description “kits” per se, without any further qualification, is considered too vague for classification purposes.

The applicant should specify the purpose of the goods to render the “kits” proper to the appropriate class, for example, “cosmetic kits” in Class 3 or “sewing kits” in Class 26.

Alternatively, the applicant can specify the composition of the “kits”, making sure that all the goods in the kits are classified under the same class. An example of an acceptable description would be “repair kits comprising screwdrivers, pliers and hammers” in Class 8.

### 8.19 Electronic machines

The Registry will not accept the description “electronic machines” in Class 9, as the description per se, without any indication of the purpose of the electronic machines, is vague.

“Machines” are generally classified in Class 7 in accordance to the Class Heading of Class 7, “Machines and machine tools”. As such, for descriptions containing “machines” that are filed in classes other than Class 7, the Registry requires the purpose of the machines to be clearly specified in order to justify its classification in the respective classes. The following are some examples of acceptable descriptions:

- Automated teller machines [ATM] (Class 9)
- Weighing machines (Class 9)
- Air purifying machines (Class 11)
- Electric coffee machines (Class 11)
- Arcade video game machines (Class 28)

## **INTERNATIONAL REGISTRATIONS / SUBSEQUENT DESIGNATIONS DESIGNATING SINGAPORE**

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**INTERNATIONAL REGISTRATIONS/SUBSEQUENT DESIGNATIONS  
DESIGNATING SINGAPORE**

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## **1. INTRODUCTION**

This chapter deals with international registrations / subsequent designations designating Singapore for trade mark registration.

## **2. RELEVANT RESOURCES**

Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

The above materials are available at [http://www.wipo.int/madrid/en/legal\\_texts](http://www.wipo.int/madrid/en/legal_texts).

Singapore Trade Marks Act

Singapore Trade Marks Rules

Singapore Trade Marks (International Registration) Rules

### 3. **ABBREVIATED EXPRESSIONS**

"**basic application**" means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**basic registration**" means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**Regulations**" means the regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and it is usually referred as the Regulations;

"**Contracting Party**" means any State or intergovernmental organization party to the Protocol;

"**Contracting Party of the holder**" means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Article 2 of the Protocol, to be the holder of an international registration;

"**Gazette**" means the periodical gazette referred to in Rule 32 of the Regulations;

"**holder**" means the natural person or legal entity in whose name the international registration is recorded in the International Register;

"**international application**" means an application for international registration filed under the Protocol;

"**IB**" means the International Bureau of the World Intellectual Property Organization;

"**International Register**" means the official collection of data concerning international registrations maintained by the International Bureau, which data the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

"**international registration**" means the registration of a mark effected under the Protocol;

"**Madrid Protocol**" and "**Protocol**" means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;



**"notification of Provisional Refusal"** means a declaration by the Office of a designated Contracting Party, in accordance with Article 5(1) of the Protocol;

**"Office"** means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9quater of the Protocol;

**"Office of Origin"** means the Office of origin defined in Article 2(2) of the Protocol; and

**"subsequent designation"** means the request for extension of protection ("territorial extension") under Article 3ter(1) or (2) of the Protocol, or such extension as recorded in the International Register.

#### **4. SINGAPORE AS DESIGNATED OFFICE**

In the same way that holders of Singapore trade marks may use their national mark as a basis for an international registration seeking protection in other member countries of the Protocol, holders of marks in other Protocol member countries may use their national trade marks as a basis for an international registration designating Singapore.

IPOS receives weekly electronic notifications from the IB containing the details of new international registrations/ subsequent designations designating Singapore. These marks will be indexed and assigned Singapore trade mark numbers. Once this is done, the mark details will be uploaded onto the Singapore Trade Mark Register and may be conveniently viewed online.

#### **5. EXAMINATION OF INTERNATIONAL REGISTRATIONS / SUBSEQUENT DESIGNATIONS DESIGNATING SINGAPORE**

##### **5.1 Same examination procedure as national applications**

International registrations/ subsequent designations designating Singapore are examined in the same way as national applications which are filed directly with IPOS. The international registrations/ subsequent designations are examined for registrability in accordance with the Trade Marks Act and Trade Marks Rules. These marks will also be examined for possible conflicts with prior marks on the Singapore Trade Mark Register.

##### **5.2 Provisional refusal of protection**

If the international registration / subsequent designation do not comply with the provisions of Singapore law, IPOS will notify the IB that protection of the mark has been refused in Singapore. This notification, known as a Provisional Refusal, must be sent to the IB within the applicable time limit of 18 months from the date of notification of the international registration / subsequent designation. Once the Provisional Refusal has been sent to the IB, the IB will forward it to the holder of the international registration / subsequent designation or the holder's representative.

If IPOS does not notify a Provisional Refusal to the IB within the applicable time limit, IPOS would lose the right to refuse protection to the international registration/subsequent designation, and the mark will therefore be deemed to be registered in Singapore.

As with national applications, IPOS will routinely expedite international registrations with a priority claim in order to minimize the risk of registering earlier filed trade marks which are similar or identical but without a priority claim.

### **Partial or Total Refusal**

Provisional refusals may relate to all the goods and / or services in the international registration / subsequent designation, in which case it is a Total Refusal, or to only some of the goods and / or services in the international registration / subsequent designation, in which case it is a Partial Refusal. Another kind of refusal known as a Provisional Refusal Based on Opposition may also be issued if a third party files a Notice of Opposition objecting to the mark being protected in Singapore.

If IPOS has examined an international registration / subsequent designation and found no grounds for refusal, it may issue a Statement of Grant of Protection.

## **5.3 Examination of the list of goods and services**

### **Misclassification of goods and/or services**

The classification and description of the goods and services claimed in the international application is checked by the IB prior to registration in the International Register. The IB is the final authority for the classification of the goods and services listed in an international registration. Designated offices are not able to raise a formal objection to the *classification* of goods and/or services via a Provisional Refusal.

Nonetheless, if any goods and/or services appear to be misclassified, IPOS may informally seek clarification from the IB. The examination of the international registration will be held in

abeyance by IPOS pending a reply or Correction Notice from the IB. However, the time limit of 18 months to issue a provisional refusal, if any, still continues to run during this period.

**Indication of goods and/or services considered too vague, incomprehensible or linguistically incorrect**

In some international registrations / subsequent designations notified to IPOS, there may be goods and/or services bearing an indication inscribed by the IB stating that a certain term is considered too vague, incomprehensible or linguistically incorrect. Such indications are inscribed by the IB where a holder failed to respond to an irregularity issued by the IB under Rule 13 of the Regulations for terms which the IB considers too vague, incomprehensible or linguistically incorrect.

Under Rule 19(2)(b)(ii)(A) of the Trade Marks Rules, IPOS may (independently or in view of the inscription by the IB), through a Provisional Refusal, object to descriptions of goods and / or services that are considered too vague, incomprehensible or linguistically incorrect. If IPOS does not receive a response to the Provisional Refusal by the given deadline of four months, the objected goods and/or services will be deleted. Where there are other goods and / or services which have not been objected to, those may proceed to acceptance and publication.

**6. ACCEPTANCE OF INTERNATIONAL REGISTRATION / SUBSEQUENT DESIGNATION DESIGNATING SINGAPORE**

If there are no objections to the international registration / subsequent designation designating Singapore, or where there are objections and these objections are overcome, the international registration / subsequent designation shall be published for opposition purposes in the IPOS Trade Marks Journal. A notice informing of the interim status of the international registration / subsequent designation containing the period of publication will be sent to the IB. This notice will also be sent to the Singapore agent (if any) appointed to act for the holder of the international registration / subsequent designation.

International registrations / subsequent designations designating Singapore are published in a separate section of the Trade Marks Journal entitled, “International Registration filed under the Madrid Protocol Published for Opposition under the Trade Marks Act (Cap. 332, 2005 Ed)”.

Published marks are open to opposition for an initial period of two months, with a possibility of a further extension of two months. This process is similar to the process for national trade mark applications.

## **7. CORRECTIONS FROM WIPO**

Under Rule 28 of the Regulations, where the IB, of its own volition or at the request of the holder or of an Office, considers that there is an error in the information recorded on the International Register, it will correct that information accordingly. The IB's practice with regard to the correction of the international registration is as follows:

- (a) where there has been an error on the part of the IB, the error will be corrected;
- (b) where there has been an obvious error and nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as the error comes to the IB's attention; and
- (c) where there is an objective error in a fact recorded in the International Register.

While the holder of the international registration or the Office may request for the correction of the international registration, the request for correction should be submitted by the Office of Origin of the Contracting Party in the event that the error results from a discrepancy between a document filed with the IB and what is recorded in the register of that particular Contracting Party. Accordingly, an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for

correction is received by the IB within nine months from the date of publication of the entry in the International Register.

There may be instances where the corrections would widen the scope of the list of goods and services originally filed. Additionally, there could even be instances where the corrections would result in a change to the representation and identity of the mark. In such cases, the international registration / subsequent designation designating Singapore may need to be re-examined. Also, in the event new goods or services appear in the international registration / subsequent designation after a correction, the international registration / subsequent designation will have to be re-examined in respect of those new goods and services. However, corrections which limit the scope of a mark are acceptable and will not need to be re-examined.

If the mark has been corrected substantially, it will be necessary to re-start the examination procedure with the corrected mark. If the international mark has already been published, it will be necessary to withdraw the publication.

### **Processing of correction notifications by IPOS**

If a correction notice has been received by IPOS, the trade mark examiners will make the necessary amendment.

In cases where the correction involves the replacement of the original mark with a new mark, the mark will have to be re-examined. A re-calculation of the 18-month time limit may be necessary. If the correction results in a new objection, IPOS will issue a Provisional Refusal following a Correction Notice to the IB.

Where a correction notification is received after an international registration / subsequent designation has been published in the Trade Marks Journal for opposition, a further publication may be made in the Corrigenda section of the journal stating the details of the correction after the correction notice has been processed.

Types of corrections which may be processed by IPOS could relate to:-

- (a) International Registration Date, Subsequent Designation Date, International Registration Notification Date, Subsequent Designation Notification Date
- (b) Name and/or Address of Holder
- (c) Mark
- (d) Mark Type
- (e) Goods/Services
- (f) Priority Details
- (g) Transliteration, Translation, Disclaimer, Color Claim, Mark Description, 3D Indicator

It is to be noted that not all correction notifications from the IB will require action on the part of IPOS. For example, there may be corrections for the inclusion or deletion of certain member countries from the designation list, or for the limitation of the list of goods and services which are not applicable to Singapore.

It is possible to receive more than one correction notification in an international registration. A second or subsequent correction notification may be issued by the IB to correct the details of the earlier corrections. The correction history is available for viewing online along with the other details of the mark.

#### **8. PROVISIONAL REFUSAL OF PROTECTION OF INTERNATIONAL REGISTRATION / SUBSEQUENT DESIGNATION DESIGNATING SINGAPORE**

The Provisional Refusal will indicate the grounds for refusal of protection together with a copy of the relevant laws in support of the objections. If any confusingly similar marks are cited, the details of these marks will also be attached to the Provisional Refusal.

The Provisional Refusal must state all the grounds on which the Provisional Refusal is based and if the refusal does not relate to all the goods and services of the international registration, it must state the goods and/or services which are affected by the refusal.

The Provisional Refusal will also provide guidance to the holder if he wishes to request for a review or file a notice of appeal against the Provisional Refusal. A time limit for such request will also be indicated therein. IPOS imposes a four-month deadline for the holder to respond to the Provisional Refusal. The four-month deadline is calculated from the date of the Provisional Refusal.

The IB will record the information contained in the Provisional Refusal and will forward it to the holder of the international mark or to his agent in the country of origin. The Provisional Refusal is also available for viewing online at WIPO's Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>).

## **9. IRREGULARITY NOTICE FROM WIPO ON PROVISIONAL REFUSAL**

The Provisional Refusal from the Office must meet the following conditions, among others:-

- (a) it must contain the international registration number;
- (b) it must indicate the grounds for the refusal; and
- (c) it is sent within the 18-month time limit;

If any of the above conditions are not met, the IB will send an Irregularity Notice to the Office highlighting the irregularities and will also inform the Office that the notification of Provisional Refusal is not valid. Where the irregularity relates to the contents of the notification, the Office may send a further notification in which the irregularity has been rectified, provided that this further notification is sent within the applicable time limit.

## **10. TIME LIMIT FOR NOTIFYING PROVISIONAL REFUSAL**

Any member country of the Madrid Protocol has the right to refuse protection of the international registration. The Provisional Refusal of protection must however be received by the IB within a given time limit.



In the case of Singapore, the time limit is 18 months from the notification date of the international registration or a subsequent designation. This applies to all notifications of Provisional Refusal of protection whether based on grounds refused ex officio by the Office or based on opposition.

In general, an Office which has not notified a Provisional Refusal to the IB within the appropriate time limit loses the right to refuse protection.

### **Late provisional refusal based on opposition possible**

A Provisional Refusal based on opposition may be notified to the IB after the end of the 18-month time limit. However, the member country must, before the expiry of the 18-month time limit, have informed the IB that there is a possibility that oppositions may be filed after the expiry of this time limit. Further, the notification of Provisional Refusal based on an opposition must have been sent to the IB before the expiry of:-

- (a) the period of one month from the expiry of the opposition period, or
- (b) the period of seven months from the beginning of the opposition period,

whichever is earlier.

## **11. OPPOSITION FILED NEAR THE END OF THE 18-MONTH TIME-LIMIT**

Where an Office has informed the IB that the opposition period will expire within 30 days before the end of the 18-month period, a Provisional Refusal that is based on an opposition filed within those 30 days, may be notified to the IB within one month of the opposition being filed.

Where an Office fails, before the expiry of the 18-month time limit, to notify the IB of the possibility of late Provisional Refusals based on opposition, the IB will disregard the Provisional Refusal and inform the Office accordingly. Similarly, where a Provisional Refusal based on an

opposition is notified after the end of the 18-month period, and the prior notification of this possibility had not been given, or had been given too late, the IB will disregard the Provisional Refusal and inform the Office accordingly.

## **12. AFTER THE EXAMINATION - REQUEST FOR A REVIEW**

The holder of an international registration designating Singapore which has been provisionally refused may request for a review of the refusal.

### **12.1 Address for service in Singapore**

Upon receiving the Provisional Refusal of protection issued by Singapore from the IB, the holder may request for a review of the Provisional Refusal. The request for review must include an address for service in Singapore. It is important that the holder provides a valid address for service in Singapore as it is this address to which all correspondence from IPOS will be sent.

The holder may appoint an agent in Singapore to act for him but this is not mandatory.

### **12.2 Four-month deadline by IPOS**

A Provisional Refusal of protection comes with a four-month deadline for the holder to respond. If the holder of the international registration does not respond with his submissions before the deadline the international registration faces two possible outcomes:-

- (a) If the international registration has been partially refused, the mark will be accepted and published only for those goods / and or services not affected by the provisional refusal.
- (b) If the international registration has been refused totally, the refusal will become final for all goods / and or services.

### **13. REINSTATEMENT OF RIGHTS**

It is possible to reinstate an international registration which is treated as withdrawn due to failure to respond within the four-month deadline. Reinstatement is done by filing Form CM13 with the requisite fee within six months from the deadline. However, holders should note that any request for reinstatement received after the six months will not be accepted.

Upon receiving Form CM13, IPOS will conduct a search for conflicting marks to ensure that there are no conflicting marks received or citations waived during the time when the holder's application was treated as withdrawn. If there are no conflicting marks received or citations waived during this period, the application will be restored and its status will be updated on the Trade Mark Register. If there are conflicting marks received or citations waived during this period, the reinstatement request will be refused.

### **14. PUBLICATION OF INTERNATIONAL REGISTRATION**

Every international registration / subsequent designation designating Singapore which has been accepted for protection will be published in our online Trade Marks Journal and are open to opposition for a period of two months. The two-month opposition period may be extended to four months, in exactly the same way as national applications.

International marks are published in the Trade Marks Journal in the section titled "International Registration filed under the Madrid Protocol Published for Opposition under the Trade Marks Act (Cap. 332, 2005 Ed.)".

### **15. OPPOSITION TO INTERNATIONAL REGISTRATION**

International marks are subject to the same opposition procedures as national marks. The opponent must file Form TM 11, together with a Statement of Grounds of Opposition and the

relevant fees. When an opposition action is initiated against an international mark which has been published, IPOS will issue a Provisional Refusal based on opposition.

A copy of the Form TM 11 and the Statement of Grounds of Opposition will be attached to the Provisional Refusal of protection based on opposition. Copies of the forms necessary for filing a counter-statement are also attached along with Form CM 1 for an address for service in Singapore to be appointed.

As with national marks, opposition hearings of international marks are dealt with by the Hearing & Mediation Department (HMD) within IPOS.

## **16. PROTECTION OF INTERNATIONAL REGISTRATION**

If there are no oppositions or where there are oppositions and the proceedings are resolved in favour of the holder, the international registration designating Singapore will be protected in Singapore.

It should be noted that no registration certificates are issued by IPOS with regards to protected international marks in Singapore. Instead, one of the following statements on the final status of the mark will be issued to the IB to inform on the conclusion of the proceedings in Singapore.

### **16.1 Statement of grant of protection where no notification of Provisional Refusal has been communicated**

With effect from 1 September 2009, an Office which has examined an international registration in which it is designated and found no ground for refusal must issue a Statement of Grant of Protection (“Statement of Grant”).

A Statement of Grant will be issued under this limb only if the mark is registered within the 18-month time limit from the date of notification of the international registration / subsequent

designation. However, the Statement of Grant will not be issued where the mark is registered after the 18-month time limit as the international registration will be regarded as protected in Singapore.

The Statement of Grant allows WIPO to close the case without the need to wait till the end of the 18-month period. WIPO will record and publish the Statement of Grant before forwarding the Statement of Grant to the holder.

IPOS will include in the Statement of Grant details such as particular features of mark and clauses reflected in the Trade Marks Register.

## **16.2 Statement of grant of protection following a Provisional Refusal**

If a Provisional Refusal of protection has been issued in respect of the international registration and protection of the mark is eventually granted whether wholly or partially, a statement would be issued indicating either:

- (a) That the provisional refusal is withdrawn and protection of the mark is granted for all the goods and services for which protection is requested; or
- (b) The goods and services for which protection is granted.

## **16.3 Confirmation of total Provisional Refusal**

If a total Provisional Refusal of protection has been issued in respect of the international registration and the total Provisional Refusal is maintained, a statement will be issued confirming the refusal of protection for all the goods and services i.e. that there is no protection accorded in Singapore.

## **17. DATE OF COMPLETION OF REGISTRATION PROCEDURE**

For the purposes of Rule 18 of the Trade Marks (International Registration) Rules, the date of completion of the registration procedure is the date on which the Statement of Grant is issued or one day after 18 months from the date of the notification of the international registration / subsequent designation, in a case where no Statement of Grant and no notification of Provisional Refusal has been communicated. This means that use of the mark must commence within five years from this date or the registration stands to be revoked.

## **18. COLLECTIVE/CERTIFICATION/GUARANTEE MARKS**

International applications may be filed for collective, certification or guarantee marks. As the international application form does not distinguish between these three types of marks, in all cases it will be necessary to raise a provisional total refusal of protection. The reason for this is that Singapore only accepts collective and certification marks and do not accept guarantee marks. The holder therefore needs to specify the type of protection applied for. It is also a requirement under the Trade Marks Act that regulations governing the use of collective or certification mark are filed.

## **19. PRIORITY CLAIMS**

Where priority is claimed, a statement to that effect appears in the notification of International Registration / Subsequent Designation.

IPOS will verify that the priority date falls within six months of the international registration / subsequent designation date.

## **20. CANCELLATIONS**

### **20.1 Cancellations effected for all the goods and/or services**

When the IB notifies IPOS that the international registration has been cancelled for all goods and/or services at the request of the Office of Origin, IPOS will keep in view the notification of cancellation from the IB for four months to allow time for transformation, if requested by the holder.

Under Article 9<sup>quinquies</sup> of the Protocol, holders of international registrations may file an application to transform an international registration / subsequent designation (cancelled at the request of the Office of Origin) into a national or regional application, within three months from the date on which the international registration was cancelled, provided certain conditions are met.

More about transformation is dealt with in Paragraph 21. When IPOS receives an application to transform all or some of the cancelled goods and / or services within the three month period, IPOS will ensure that the application is submitted by the same holder of the international registration, the application relates to all or some of the cancelled goods and / or services and the application for the identical mark.

The cancelled goods and/or services as applied for in the transformation application will then form the subject of a new national trade mark.

The transformed national application or registration retains any priority date(s) applicable to the goods and/or services from the international registration.

The process of examination, opposition or registration, whichever applicable, will continue with regards to the newly transformed national trade mark.

## **20.2 Cancellations effected for some of the goods and/or services**

Partial cancellations, that is, cancellations which relate to only some of the goods and services of an international registration at the request of an Office of Origin, are processed in the manner indicated in Paragraph 20.1. The difference is that only those goods and services in the international registration which are affected by the cancellation will be deleted from the international registration and eligible for transformation. Those goods and/or services not affected by the cancellation will remain in the International Registration.

## **20.3 Updating cancellations**

IPOS will process the cancellation notice from the IB in the following manner:

- In the case of a partial cancellation at the request of the Office of Origin, the goods and services partially cancelled will be deleted from the international registration designating Singapore.
- In the case of a full cancellation at the request of the Office of Origin, the status of the international mark will be set to “Withdrawn” for pending mark and "Cancelled" for registered mark.

## **21. TRANSFORMATION OF A CANCELLED INTERNATIONAL REGISTRATION INTO NATIONAL APPLICATION**

Where, during the five year dependency period following the date of international registration, the national application or registration on which IR is based is refused or cancelled, the Office of Origin is required to request that the international registration be cancelled, to the same extent. The IB will then notify all designated Contracting Parties of the cancellation.

Where the international registration designating Singapore is cancelled whether for all or some of the goods and services at the request of the Office of Origin, the holder is given the possibility to obtain protection of his mark in Singapore by transforming it into a national application within three months from the date of cancellation of the international registration. If the holder chooses



to do so, the filing date of the international registration is preserved. This is known as transformation.

The transformed national application will be treated as though it had been filed on the date of the international registration or the date of the subsequent designation, provided that:-

- (a) the national application is filed within three months from the date on which the international registration was cancelled;
- (b) the transformed national application is for the same mark and for the same or no wider goods and services than the international mark; and
- (c) all national filing requirements, including payment of fees, have been met.

The transformed national application shall also enjoy the priority which was enjoyed by the international registration.

Holders who wish to transform their cancelled international registrations to Singapore national applications may do so by completing Form MP 1 with the requisite fee.

If the transformation application is successful, the international registration / subsequent designation in national register will reflect the new national trade mark number, under the field "Transformation Application under Madrid Protocol". Likewise, it will also be indicated in the register that the new national trade mark has been transformed from an international registration.

Transformation may take place only where the international registration has been cancelled, either partially or totally in respect of the goods and services, at the request of the Office of Origin. It is not available where the international registration was cancelled at the request of the holder.

## **22. REPLACEMENT OF NATIONAL REGISTRATION WITH INTERNATIONAL REGISTRATION**

A national registration in Singapore is, under certain conditions, deemed to be replaced by an international registration of the same mark. These conditions are:-

- (a) both the national registration and the international registration are in respect of the same mark;
- (b) both the national registration and the international registration are in the name of the same holder;
- (c) the goods and services listed in the national registration that are to be replaced are covered in the international registration; and
- (d) the international registration is extended protection in Singapore on a date later than the date of the national registration.

Therefore, if the holder of the international registration designating Singapore already owns an existing Singapore national registration(s), it is possible for the holder to replace the national registration(s) with the international registration if the conditions above are met.

While the list of goods and services in the national registration that is to be replaced must also be listed in the international registration, the international registration need not have an identical list of goods and services.

As replacement is deemed to take place automatically as long as the above conditions are met, there is, technically, no action required by the holder. However, such replacement will only be recorded by a particular designated country if a request to record is made. Such a recordal is necessary for the information of the third parties. As such, the holder is advised to request IPOS to record on the national register the fact that the national registration has been replaced by the international registration.

Notwithstanding the replacement, it will be in the interest of the holder of the international registration to renew the Singapore national registration(s) during the five-year period which the international registration is dependent on the fate of the basic application /registration. For more

information, please see the chapter on “International Applications where Singapore is the Office of Origin”.

The holder of the international registration wishing to record the fact of replacement on the register can do so by completing Form MP 2.

If the replacement application is successful, the international registration in national register will reflect the national trade mark number that it replaces, the class number(s), the date of protection, the good and/or services that it replaces and the priority claim details (if any) under the field "Replacement Application under Madrid Protocol".

Where IPOS has taken note of the replacement in register, following a request made by the holder, it will also notify the IB accordingly. Such a notification will include the international registration number, the filing date, trade mark number, the priority date (if any) and the goods and/or services of the national registration which has been replaced. The IB will record the indications so notified in the International Register and will also inform the holder. This information is also published in the WIPO Gazette.

### **Citation of replaced national application / registration**

A reference to a replaced national registration in a citation against a later trade mark application will continue to be maintained by the international registration which replaced the national registration. This is because the holder of the international registration enjoys the filing date and the priority date from the replaced national registration.

## **23. CHANGE OF NAME AND / OR ADDRESS**

A request to record a change in the name and/or address of the holder must be presented on the official form MM9(E) established by the IB.

The request may be presented to the IB directly by the holder or through the Office of the Contracting Party of the holder.

The IB records the change in the International Register and notifies the designated offices. It will also inform the holder and where the request was presented by an Office, that Office.

When IPOS receives such notifications, it will also update the change in the national register.

## **24. CHANGE OF OWNERSHIP**

A request to record a change in ownership must be presented on the official form MM5(E) established by the IB.

The request may be presented to the IB by the holder, through the Office of the Contracting Party of the (recorded) holder or through the Office of the Contracting Party of the new owner (transferee).

The change in ownership may relate to all the goods and services covered by the international registration, or to only some of those goods and services. Similarly, the change in ownership may be in respect of all the Contracting Parties designated or only some of them.

## **25. RENEWAL OF INTERNATIONAL REGISTRATION**

Under the Madrid Protocol, an international registration is valid for a period of 10 years from the date of the international registration. The international registration can be renewed every 10 years upon payment of the required fee.

The renewal of an international registration is a matter between the holder and the IB. The IB will send an unofficial notice, six months before the expiry of each 10-year term of protection, to

remind the holder and representative (if any) of the impending expiry of the international registration.

WIPO has implemented the electronic renewal of international registrations which can be accessed under Forms at <http://www.wipo.int/madrid/en/forms> and also under the Madrid Online Services at <http://www.wipo.int/madrid/en/services/>.

The IB records the renewal of the international registration in the International Register, by inscribing the date on which it was due. The IB will also notify the Offices of the designated Contracting Parties concerned and send a certificate to the holder. The relevant data concerning the renewal will also be published in the Gazette.

Apart from reflecting in its records of the extended term of protection of the international registration, an Office which is notified of the renewal needs to take no other action.

## **26. LICENCES**

Licences may be recorded against an international registration. However, as Singapore has declared that the recording of licences in the International Register has no effect in Singapore, a holder of an international registration wishing to record a licence of an international registration designating Singapore has to lodge form CM6 with the requisite fee to IPOS.

## **27. CHANGES NOT ACCEPTABLE IN THE INTERNATIONAL REGISTER**

The following changes are not allowed:-

- (a) Changes to marks that have been recorded in the International Register are not allowed even if such changes are minor in nature. If the holder of the international registration wishes to obtain protection of a mark which differs from the mark recorded, the holder may only do so by filing a new international application.

- (b) Requests to extend the list of goods and/or services in the international registration are not allowed. If the holder of the international registration wishes to extend protection beyond the scope of the goods or services indicated in the recorded international registration, the holder has to file a new international application.

## **28. DOS AND DON'TS FOR INTERNATIONAL REGISTRATIONS DESIGNATING SINGAPORE**

<b>S/No</b>	<b>Description</b>	<b>Practice / Recommendations</b>
1	Amendment to the list of goods and services to overcome an objection raised in a Provisional Refusal issued by IPOS	No amendment form or fee is required. A letter to inform IPOS of the final list of goods and/or services will be sufficient. If the amendment overcomes the objection, IPOS will effect the amendment.
2	Amendment to the list of goods and/or services <b><u>NOT</u></b> due to a Provisional Refusal raised by IPOS	Do <b>NOT</b> lodge an amendment form to amend the list of goods and services. The amendment must be effected through the IB using their official form. The IB will record such changes in the International Register and inform the relevant designated Contracting Parties.
3	Request for the recordal of a Change in Name and / or Address of the Holder	Do <b>NOT</b> lodge Form CM2 to update the change in name and / or address of the holder. The change must be effected through the IB using their official form, MM9(E). The IB will record such changes in the International Register and inform the relevant designated Contracting Parties.
4	Request for the recordal of a Change in Ownership	Do <b>NOT</b> lodge Form CM8 to update a change of ownership of a trade mark. The change must be effected through the IB using their official form, MM5(E). The IB will record

		such changes in the International Register and inform the relevant designated Contracting Parties.
5	Renewal of the international registration	Do <b>NOT</b> lodge Form TM 19 to apply for renewal of the international registration. The renewal must be effected through the IB using their official form, MM11(E). The IB will record the renewal in the International Register and inform the relevant designated Contracting Parties.
6	Changing the particulars of the international registration (eg. 3-dimensional claim, colour claim etc.)	IPOS will examine the international registration / subsequent designation as notified by the IB. Any request to change the particulars of the international registration / subsequent designation (such as inserting or deleting the 3-dimensional claim, colour claim) will have to be made through the IB. If the IB is satisfied that there is an error concerning such claims, it will correct the error and notify the holder and the relevant designated Contracting Parties.
7	Issuance of Registration Certificates for Protected International Trade Marks (Singapore)	<p>IPOS does not issue registration certificates for protected international trade marks designating Singapore.</p> <p>An international registration / subsequent designation is automatically protected within 18-months from the date of notification of the international registration / subsequent designation.</p> <p>In most cases, however, the holder would receive a Statement of Grant of Protection as confirmation of the fact that the international registration / subsequent designation is protected in Singapore.</p>

## **INTERNATIONAL APPLICATIONS WHERE SINGAPORE IS THE OFFICE OF ORIGIN**

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**INTERNATIONAL APPLICATIONS WHERE  
SINGAPORE IS THE OFFICE OF ORIGIN**

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## **1     INTRODUCTION**

This chapter deals with international applications where Singapore is the Office of Origin.

## **2. RELEVANT RESOURCES**

**Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

**Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

**Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

The above materials are available at [http://www.wipo.int/madrid/en/legal\\_texts](http://www.wipo.int/madrid/en/legal_texts).

**Singapore Trade Marks Act**

**Singapore Trade Marks Rules**

**Singapore Trade Marks (International Registration) Rules**

### 3. **ABBREVIATED EXPRESSIONS**

"**Agreement**" means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on September 28, 1979;

"**applicant**" means the natural person or legal entity in whose name the international application is filed;

"**basic application**" means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**basic mark**" means the National trade mark upon which the international application is based.

"**basic registration**" means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**Contracting Party**" means any State or intergovernmental organization party to the Protocol;

"**designated Contracting Party**" means a Contracting Party for which the extension of protection ("territorial extension") has been requested under Article 3ter(1) or (2) of the Protocol, or in respect of which such extension has been recorded in the International Register;

"**holder**" means the natural person or legal entity in whose name the international registration is recorded in the International Register;

"**international application**" means an application for international registration filed under the Protocol;

"**International Bureau**" or "**IB**" means the International Bureau of the World Intellectual Property Organization.

"**International Register**" means the official collection of data concerning international registrations maintained by the International Bureau, which data the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

"**international registration**" means the registration of a mark effected under the Protocol;

"**Madrid Protocol**" and "**Protocol**" means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

"**Office**" means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9<sup>quater</sup> of the Protocol;

"**Office of Origin**" means the Office of origin defined in Article 2(2) of the Protocol;

"**subsequent designation**" means the request for extension of protection ("territorial extension") under Article 3<sup>ter</sup>(1) or (2) of the Protocol; it also means such extension as recorded in the International Register;

#### **4. THE MADRID PROTOCOL**

The Madrid System of international registration of marks is governed by the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol”). The Madrid System is administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

Singapore acceded to the Protocol on 31 July 2000 and the Madrid Protocol came into operation in Singapore on 31 October 2000.

#### **5. BRIEF DESCRIPTION OF THE MADRID PROTOCOL**

The Madrid Protocol is a treaty providing for the international registration of trade marks.

Under the Madrid Protocol, a trade mark owner can obtain an international registration, by filing a single application (called an international application) and paying one set of fees, to seek protection of the trade mark in several countries that are parties to the Madrid Protocol. The list of countries that one can seek protection is available at [WIPO's website](#). The Madrid Protocol therefore offers an alternative to filing separate applications directly with individual countries where trade mark owners intend to seek registration.

#### **6. ADVANTAGES OF THE MADRID PROTOCOL**

The advantage of using the Madrid Protocol is that applicants may protect their trade marks in several countries simultaneously by means of a single international application filed at their own national trade mark office. Further, the applicant uses only one language and pays only in a single currency.

The trade mark owner enjoys similar benefits when the registration has to be renewed or changed i.e. a single request, in a single language accompanied by payment in a single currency.

## **7. FILING AN INTERNATIONAL APPLICATION**

An international application must be presented to the IB through the national trade mark office of a Madrid Protocol member state where local protection of the trade mark has been sought. This office is known as the Office of Origin for the international application and in the context of this manual would be IPOs.

International applications can be filed through IPOs if the applicant meets the following requirements:

- A. The applicant or applicants must:
  - i. be a citizen of Singapore; or
  - ii. have a business in Singapore; or
  - iii. be domiciled in Singapore; or
  - iv. have a real and effective industrial or commercial establishment in Singapore; and
  
- B. The applicant or applicants must have a trade mark application or registration with IPOs (known as the basic mark) for the mark that is sought to be protected in the international application.

The international application must be filed via the national trade mark office where the basic mark is held as it is required to certify that the information contained in the application form accords with the details of the basic mark(s). When certified, the application can then be passed to WIPO.

At WIPO a formalities check of the application will be carried out and the mark is translated into the three languages of the system, English, French and Spanish. The mark is then registered and details of the registration will be published in the WIPO Gazette of International Marks.

The IB then notifies the national trade mark office of each Contracting Party in which protection of the mark has been requested (also known as the designated Contracting Party). Each country will examine the mark according to their national systems and must inform WIPO within a set time limit whether or not the mark may be protected in that country. Notifications of provisional

refusals in designated contracting parties will be published in the WIPO Gazette and also forwarded to the applicant for the mark.

### ***The International Trademark Registration Process***



#### **International Application Form (MM2(E))**

International applications must be made on the official WIPO form MM2(E) which may be obtained from [the WIPO website](#). The form MM2(E) may be submitted to IPOS electronically through IP<sup>2</sup>SG. IPOS charges a handling fee for every MM2(E) form submitted.

For more detailed information on how to complete the form, please refer to [WIPO's explanatory notes for the form](#).

The applicant may designate one or more Contracting Parties, but not the member state where the international application originates from. For example, if the international application originates from Singapore, the applicant cannot designate Singapore in the list of Designated Contracting Parties.

#### ***Special cases***

- (a) Where the United States of America is designated, it is compulsory for the applicant to lodge the form MM18 for the declaration of intention to use the mark.



- (b) Where the European Union (EU) is designated, the applicant must indicate a second working language before the Office of the European Union. The four official languages are French, German, Italian and Spanish. The second language serves as a language in which third parties may lodge opposition and cancellation proceedings before the Office of the European Union.

#### Seniority claim (where the European Union is designated)

The European Union Trade Mark system (EUTM system) is a unified trademark registration system in Europe, whereby one registration provides protection in all member states of the EU. The EUTM system allows the owner of a registered trade mark in an EU member state to claim seniority of that earlier mark when the owner applies for registration of an identical mark with the European Union Intellectual Property Office (EUIPO) as long as the goods and/or services claimed are covered by the earlier mark. Seniority claim has the sole effect under the EUTM Regulation that, where the proprietor of the EUTM surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

To claim seniority, applicants are required to lodge the WIPO form MM17 together with the international application form. They will have to indicate:

- (a) each member state in or for which the earlier mark is registered;
- (b) the date from which the registration was effective;
- (c) the number of the registration; and
- (d) the goods and services for which the earlier mark is registered.

#### Fees for International applications

The fees to be paid to obtain an international registration comprise:

- A basic fee (note that this fee is higher where the reproduction of the mark is in colour);

- A complementary fee for each designated country which does not require an individual fee, or an individual fee for those designated countries that require it; and
- A supplementary fee (for each class of goods and/or services over three classes in the international application. This fee does not apply if all the designated countries have individual fees).

The WIPO Fee Calculator at <https://madrid.wipo.int/feecalapp/> will help you to estimate your international application fees. In selecting the relevant date in the online Fee Calculator, applicants should select a date on which the international application is to be submitted to IPOS or the fees calculated may not be accurate.

Fees must be paid in Swiss francs (CHF) and via one of the following payment methods:

- Deduction from a [WIPO Current Account](#)
- Bank transfer to the WIPO bank account
- Postal transfer to WIPO postal account (within Europe only)

For payment of fees notified in WIPO irregularity letters or other WIPO communications concerning Madrid systems, payment can be via [E-Payment](#) by credit card or through a WIPO Current Account.

Further information about the fees under the Madrid system and the payment methods is available at <http://www.wipo.int/about-wipo/en/finance/madrid.html>.

### *Basic fee*

WIPO charges a basic fee for all international applications.

This fee is based on whether the mark sought for registration is in black and white or in colour. The basic fee for a black and white reproduction of the mark is 653 Swiss francs. If a coloured reproduction of the mark is lodged, the basic fee payable is 903 Swiss francs.

It does not matter that the applicant intends to limit the mark to colour(s) or claim colour(s) as a trade mark or claim colour as a distinctive feature of the mark. As long as the mark is in colour(s), the higher fee is payable.

### *Complementary fee*

Applicants must pay a Complementary fee for each designated Contracting Party which opts to charge complementary fee instead of Individual fee. The complementary fee set by WIPO is 100 Swiss francs for each designated Contracting Party. This means that if there are five designated Contracting Parties which collect Complementary fee, the complementary fee will be 500 Swiss francs.

### *Supplementary fee*

For Contracting Parties that charge a complementary fee and where the application contains more than 3 classes, a supplementary fee of 100 Swiss francs is payable for each additional class. The fee will be charged where at least a Contracting Party that collects complementary fee is designated and the amount charged will depend on the number of classes applied beyond the first 3 classes. For instance, if there are five designated Contracting Parties with two of them charging complementary fee and application is filed for 10 classes, the supplementary fee will be 700 Swiss francs. The supplementary fee is only applicable to Contracting Parties that charge a complementary fee. Hence if the applicant only designates Contracting Parties that charge individual fees, it would not be necessary to pay supplementary fees.

### *Individual fee*

A number of countries, including Singapore, have opted to receive an individual fee instead of a complementary/supplementary fee.

The quantum of the individual fee varies for each Contracting Parties and depends on the number of classes and type of mark applied for (in particular, certification and collective marks have a higher fee).

Some Contracting Parties that require an individual fee may also request for fees to be paid in two parts, the first part at the time of filing the international application and the second part at a later date, which is determined in accordance with the law of that Contracting Party. The list of individual fees, including information on Contracting Parties that have a two part fee is at:

[http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html)

*Indication of payment in the international application form MM2(E)*

The applicant is required to enter the name of the party making the payment under “Identity of the party effecting the payment” at part c of the “Fee Calculation sheet” of the international application form MM2(E). The IB will notify the party indicated at part c if the payment is insufficient or where there is a partial or total reimbursement.

To confirm that the payment has been made and to allow the IB to attribute the payment correctly, the payment details of the bank's transfer transaction must be indicated in the appropriate space on form MM2(E) at the time of filing. Hence, applicant should make payment to the IB first before submitting form MM2(E) with IPOS. IPOS requires a photocopy of the bank's transaction advice to be furnished together with the international application. Applicants should also note that they are responsible for all relevant bank charges when making an international bank transfer.

WIPO has introduced an E-Payment Service, which allows payment of fees notified in their irregularity notices or other WIPO communications, with regard to international applications or registrations. Irregularity notices are notices issued by WIPO in respect of certain errors or deficiency found in forms or letters which may require rectification by the applicant or the Contracting Parties.

**Certifying process**

All international applications must be sent to the IB by the Office of Origin. The IB will not accept any international applications directly from applicants or their agents. This is because the Office of Origin must certify:

- 1) The filing date of the international application; and
- 2) That the details on the international application accord with those on the basic mark.

### **Filing date of the international application**

As the Office of Origin, IPOS is responsible for certifying, among other things, the filing date of the international application.

Where the international application is certified and forwarded to the IB within **two months** from receipt by IPOS, the date of receipt by IPOS will be the date recorded for the resulting International Registration. Otherwise, the filing date of the international application will be the date on which the IB receives the international application. This filing date will, upon registration of the mark by the IB, become the international registration date. Rights acquired by protection of the mark will run from this date.

A later filing date may also be accorded to an international application by the IB if there are deficiencies in the form MM2(E) and the deficiency is not rectified within the stipulated time. When this happens, the priority claim, if any, may be lost if the later filing date is more than 6 months after the priority date.

### **Certification of particulars**

This process requires the office to ensure that the basic trade mark(s) and the international application details are in accord. This means checking the following:

- 1) The applicant of the international application and the owner of the basic mark are the same
- 2) The addresses are the same or the differences explained
- 3) The marks are identical

This means if the basic mark is in black and white, so must the mark in the international application.

The Madrid Protocol does not provide for a series of marks to be registered. Where the basic mark is a series of trade marks, the applicant should select one of the marks in the series for the international application. If the applicant wishes to apply for an international registration for all the marks in the series, the applicant must file a separate international application for each mark in the series.

- 4) The goods and services claimed on the international application are the same or narrower than those covered by the basic trade mark

If the basic trade mark has not yet been accepted, the specification of the basic trade mark(s) should be checked to ensure it is in the correct class. Although IPOS only has to certify that the goods and / or services cover those specified in the international application, IPOS should also ensure that classification is correct before certifying the international application before forwarding it to the IB.

- 5) Certain indications appearing on the international application also appear on the basic trade mark(s)

Any endorsements or written descriptions of the trade mark must be the same on the international application and the basic trade mark(s). This includes translations, transliterations, colour limitations, colour claims and descriptions of non-conventional trade marks.

- 6) The applicant's entitlement to file must be stated

If there is more than one applicant, all joint applicants must state their nature of entitlement to file. This need not be the same criterion for each person.

### Irregularities

If the international application cannot be certified, the applicant or the applicant's agent will be notified of the irregularities in writing. The Irregularity Letter will include:

- Suggestions to resolve the irregularities, where possible; and
- A reminder that the filing date of the international application will be lost if both the international application and the office's certification are not received by the IB within two months of the date IPOS received the application.

If the international application is in order and has been certified, IPOS will transmit the international application to the IB electronically.

## **8. ACTION TAKEN BY THE IB**

Upon receiving the international application, the IB will conduct formalities examination.

In formalities examination, the IB checks that all filing requirements have been complied with, that the classification of the goods and services listed on the international application is correct and that all appropriate fees have been paid.

### **Irregularities in the international application**

If the IB identifies irregularities in an international application, the IB will notify both the Office of Origin and the applicant by way of an irregularity notice. The irregularities must be remedied either by the IPOS or the applicant, depending on their nature.

The IB will highlight the nature of the irregularities in the notice, giving a three-month deadline to remedy them. If the irregularities are not rectified during the prescribed period, the international application is considered abandoned. This deadline is not extendable.

### **Types of irregularities**

The applicant may deal with the IB directly on any irregularities relating to fees.

However, if the irregularity may only be remedied by changing the contents of the application, then that irregularity must be responded to by the Office of Origin. For example, if IB holds the view that the description of goods does not comply with the ICGS, the IB will issue the irregularity notice with proposed alternative description to the Office of Origin. The Office of Origin will liaise with the applicant on the issues raised by IB and the office will then inform IB of the applicant's response accordingly.

If the irregularity relates to a classification of goods and services, the IB may propose a reclassification which could require additional class fees.

For irregularities concerning terms which are (i) deemed to be too vague for the purposes of classification, (ii) incomprehensible, or (iii) linguistically incorrect, the IB may suggest a

rewording or deletion of the objected terms. If the Office of Origin and the applicant are able to remedy the irregularity within the given deadline, the IB will make the changes. However, if no acceptable proposal is received by the IB within the deadline, the IB will include the term in the international registration but with a proviso that they consider the term to be too vague for classification purposes, incomprehensible or linguistically incorrect. It is then left to the individually designated Contracting Parties to object to the objectionable terms.

## **9. REGISTRATION**

If the international application is in order, the IB will assign it an international registration number and published it in the [WIPO Gazette](#) as an international registration. A Certificate of Registration will be sent to the applicant who is now known as the “holder” of the international registration. The IB also advises the Office of Origin of the IR number.

Although the international application is registered upon the completion of the formalities examination, this does not amount to protection of the mark in the designated Contracting Parties, as the international registration is still subject to substantive examination in those countries.

For an overview of the whole filing process of form MM2(E), please refer to Annex at the end of this manual.

## **10. SUBSEQUENT DESIGNATIONS**

If the owner of an international registration wishes to extend protection of his trade mark to other Contracting Parties, in addition to those already designated, he can subsequently designate more Contracting Parties in the same international registration. Subsequent designations may only be made after the international application has resulted in an international registration.

Subsequent designation is made using the official WIPO form MM4. Unlike international applications, subsequent designations need not be filed through the Office of Origin but may be filed directly with WIPO. In fact, direct filing with WIPO is recommended.



Similar to an application for international registration, the IB will conduct formalities check on the subsequent designation filed. Applicants will be given three months to rectify any irregularities. Once the formalities check is complete, the subsequent designation will be registered and published in the [WIPO Gazette](#). Details of the subsequent designation will be sent to the newly designated Contracting Parties. The acquired rights in each newly designated Contracting Party will run from the date of subsequent designation.

Applicants may wish to note that the period of protection under the subsequent designation will expire on the same date as the international registration. For example, if an international registration mark has already been registered for 9 years and the subsequent designation is filed at the end of the 9<sup>th</sup> year, the mark will only be protected for 1 year in the newly designated Contracting Parties. Assume an international registration mark is registered on 15 June 2000 and the designated country is Japan. A subsequent designation is filed on 1 January 2009 and the country designated is China. The protection of the mark in Japan and China expire on the same date, ten years after the date of international registration.

## **11. DEPENDENCY AND CENTRAL ATTACK**

For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark applied for or registered in the Office of Origin (i.e. the basic mark). The period of five years is known as the “dependency period” and the consequence of it is the ceasing of effect of the international registration which may be partial or full.

As the Office of Origin, IPOS needs to notify the IB when:

- 1) A basic trade mark ceases to exist within this period; or
- 2) The scope of the basic trade mark is restricted during this period; or
- 3) The basic trade mark ceases to exist or is restricted as a result of an action which commenced within this period.

IPOS must therefore monitor Singapore basic trade marks for any of the following changes:

- 1) The basic trade mark application is refused, withdrawn or treated as withdrawn
- 2) The scope of the basic trade mark application or registration is restricted (i.e. some of the goods and/or services are deleted)
- 3) The basic trade mark registration is cancelled, revoked or invalidated
- 4) The basic trade mark registration is not renewed

Once notified, the IB cancels the international registration to the same extent, and notifies all designated countries as well as the holder of the International Registration.

After the expiry of the dependency period, the international registration becomes independent of the basic application(s) or the basic registration(s). This means that any challenge or withdrawal of the basic application or basic registration will not have an impact on the international registration.

There is no separate dependency period for subsequent designations. The only dependency period is the one which runs from the date of the international registration. For instance, the date of international registration is 1 February 2010 and the date of subsequent designation is 1 February 2012. The dependency period for both the international registration and subsequent designation is within five years from the date of the international registration.

The international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees directly to the WIPO.

## **12. TRANSFORMATION INTO NATIONAL APPLICATION**

If an international registration is cancelled as a result of the ceasing of effect of the basic application or the basic registration, the holder of the international registration can apply to transform international registration into one or more national applications (in the designated Contracting Parties). This is known as “transformation”.

The process of transformation helps to mitigate the vulnerability of the five-year dependency feature in the Madrid Protocol, as the national applications resulting from this transformation will be treated as if they had been filed on the date of the original international registration. In other words, the filing date of the international registration is not lost upon cancellation of the international registration, if it is transformed into national applications.

To qualify for transformation, the holder must apply for transformation within three months of the date of the cancellation of the international registration.

Transformation may take place only where the international registration has been cancelled, in respect of all or some of the goods and services at the request of the Office of Origin. When this happens, the Office of Origin will inform the IB. After the international registration has been cancelled, the holder will have three months from the date of cancellation to file the transformation request directly with the designated Contracting Parties. Transformation is not available where the international registration has been cancelled at the request of the holder. If an international registration originating from Singapore has been cancelled and the applicant wishes to transform it to a national application in the designated Contracting Parties, the applicant will have to file the request for transformation with the respective designated Contracting Parties. It is to be noted that the transformation process and requirements may differ between the Contracting Parties.

### **13. CHANGES AFFECTING THE INTERNATIONAL REGISTRATION**

The International Register is kept at WIPO. Therefore, WIPO must be informed of changes relating to international registrations. Most of these changes can be filed directly with WIPO by the holder of the international registration.

#### **13.1 Change of Ownership (MM5)**

The holder of an international registration may transfer ownership of the international registration to another party (i.e. the transferee).

To do so, the holder must use the official WIPO form MM5 and a fee in Swiss francs is payable. The request may be presented to the IB by the holder directly, or through the national trade mark office of the holder or the national trade mark office of the transferee.

In order for the transfer to be recorded on the international register, the transferee must also be entitled to own the mark under the Madrid Protocol. This means that the transferee must:

- (a) have a real and effective industrial or commercial establishment; or
- (b) be domiciled in the contracting party, or
- (c) be a national of the contracting party.

The condition known as the entitlement to hold the mark must be indicated on the form MM5.

### **13.2 Limitation, Renunciation and Cancellation (MM6, MM7 & MM8)**

To restrict the scope of protection of an international registration, the applicant may choose to record a limitation, renunciation or cancellation with the IB.

The differences are:

**(a) Limitation**

Limits some of the goods and services in some or all of the designated Contracting Parties.

**(b) Renunciation**

Affects all the goods and services in some but not all of the designated Contracting Parties.

**(c) Cancellation**

Cancels some or all of the goods and services in respect of all designated Contracting Parties.

	<b>Goods and services</b>	<b>Contracting parties affected</b>
<b>Limitation</b>	Some	Some or all
<b>Renunciation</b>	All	Some but not all
<b>Cancellation</b>	Some or all	All

Although a limitation and a cancellation have much in common, there is one important difference. If some goods and services have been removed following a limitation, the applicant can lodge a

subsequent designation if protection for these goods and services is required in the future. The goods and services are not permanently removed from the international registration. Similarly, goods and services that have been renounced can be designated again.

A cancellation, on the other hand, removes the goods and services permanently from the international registration. The applicant will not be able to apply for a subsequent designation to seek protection of the cancelled goods and services. The only way to do so is by filing a fresh international application.

### **13.2.1 Limitation of the list of goods and services (MM6)**

The official form to record a limitation is the official WIPO form MM6 and a fee is payable for each Contracting Party to which the limitation applies.

This form may be presented directly to the IB by the applicant or through the national office of the applicant. Alternatively, limitations may also be filed electronically via WIPO's website. Once the limitation is recorded and published in the WIPO Gazette, the notification of limitation will be sent to the Contracting Parties concerned.

### **13.2.2 Renunciation (MM7)**

If the applicant no longer wishes to protect his mark in one or more (not all) designated Contracting Parties, the applicant may lodge the official WIPO form MM7 to request for a complete withdrawal for protection of a mark in those countries. It should be noted that if the applicant wishes to renounce the mark in all the designated Contracting Parties, the applicant should request for a cancellation rather than a renunciation.

The form may be sent directly to the IB or through the national office of the applicant. A request to record a renunciation is free of charge.

Like a request to record a limitation, the renunciation will be recorded and published in the WIPO Gazette before the notifications are sent to the relevant Contracting Parties.

### **13.2.3 Cancellation of the International Registration (MM8)**

Cancellation affects some or all of the goods and services in all the designated countries.

The applicant may lodge the official WIPO form MM8 to request for a cancellation. Upon cancellation, the goods and services are removed from the international registration permanently.

The applicant will have to indicate on the form if the cancellation is in respect of some or all of the goods. If the cancellation relates to specific goods and/or services, the applicant will have to list these goods and/or services in part 4(b) of the form.

The completed form may be submitted directly by the applicant or through the national office of the applicant. A request to record a cancellation is free of charge. The request will be published in the WIPO Gazette and all the designated Contracting Parties will be notified accordingly.

### **13.3 Renewal (MM11)**

Renewal of an International Registration is due 10 years from the date of the International Registration. The IB will send the holder an unofficial reminder six months before the IR is due for renewal.

This may be done by way of letter or by using the official renewal form MM11. Alternatively, renewals may also be filed electronically via WIPO's website.

It is possible to renew the IR six months after the expiry of the registration. However, if renewal requests are filed during this six month grace period, a surcharge would be added to the renewal fees.

Applicants are encouraged to file the renewal directly with WIPO. If the renewal is filed through IPOS, a handling fee of S\$85 is payable.

### **13.4 Change in name and/or address of the holder (MM9)**

Where there has been a change in the name and/or address of the holder, WIPO form MM9 is to be used to record the change and a fee in Swiss francs is payable. Applicants can lodge one form to effect the change for several international registrations that belong to them. The request may be lodged directly with the IB by the holder or through the national office of the holder.

### **13.5 Appointment of a representative (MM12)**

Appointment or change of a representative may be done at any time via a simple letter or WIPO form MM12. Such communication may be presented to the IB by the new representative, the applicant or the representative on record. If it is presented by the representative on record, it must be signed by the holder or the new representative. One form or letter may be used for multiple international registrations. However, all the international registrations affected must be clearly stated.

### **13.6 Change in name and/or address of representative (MM10)**

To update the details of the applicant's representative on record, the request may be made by way of a simple letter or WIPO form MM10. This form is free of charge and one form may be lodged for multiple international registrations. However, all the international registration numbers of the affected international registrations must be specified. The form may be sent directly to the IB or through a national office.

Do note that form MM10 may only be used to amend the details of the agent or representative on record. It cannot be used to appoint a new representative.

## **14. REPLACEMENT OF NATIONAL REGISTRATION**

An international registration may replace an existing national registration in any of the designated Contracting Parties under certain circumstances. When this happens, the international registration will substitute the national registration.

For replacement to take place, the international registration must:

- (a) Have been granted protection in the relevant country;
- (b) Be in respect of the same mark;
- (c) Be held by the same holder; and
- (d) Cover the goods and services listed in the national registration that it seeks to replace.

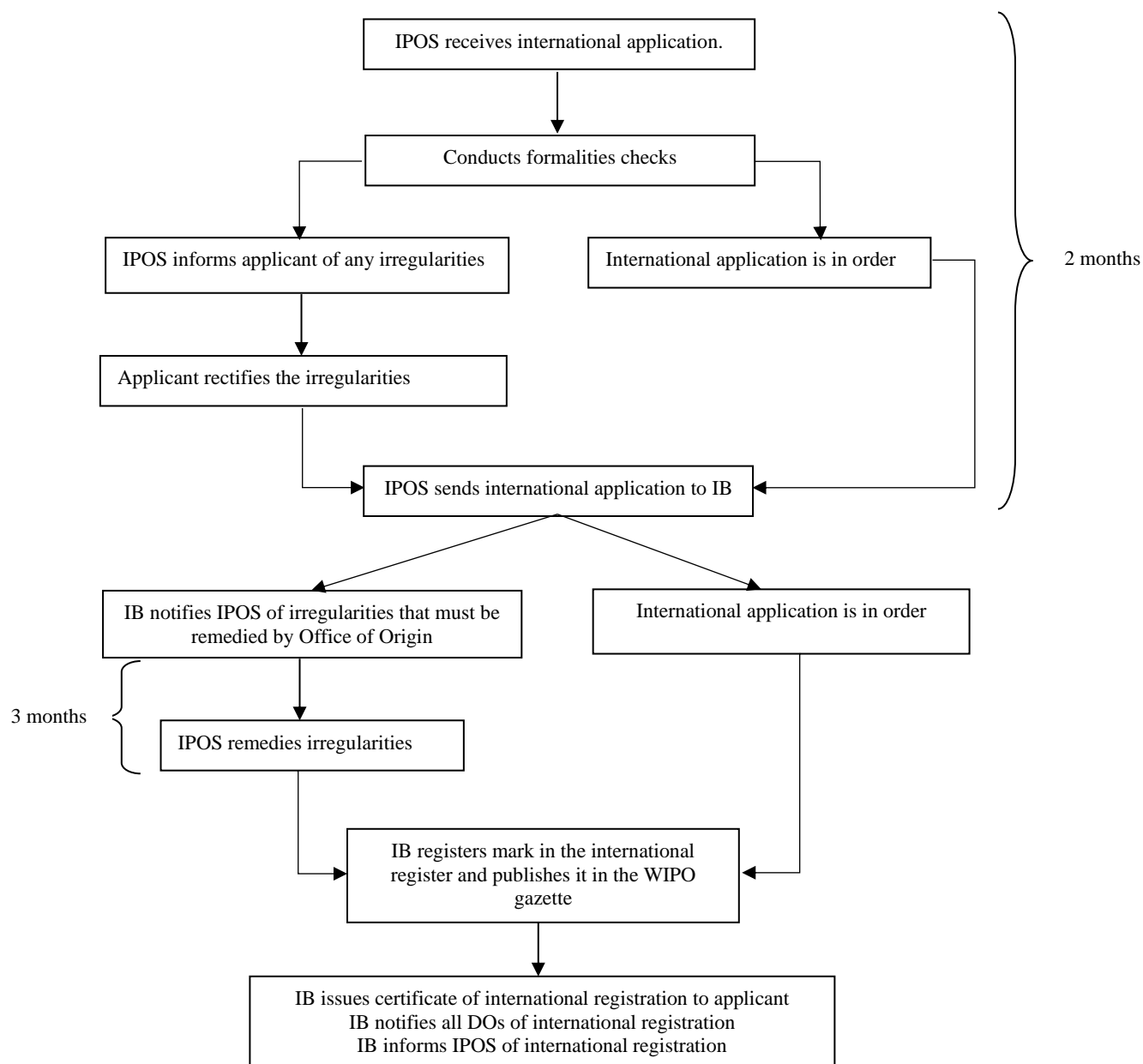
Although replacement is deemed to happen automatically if the above conditions are met, it is only recorded by the designated country if a request to record is made.

For Singapore's approach on recording a replacement, please refer to the Trade Marks Work Manual Chapter on "International registrations / Subsequent designations designating Singapore".



## ANNEX

### Flowchart for Office of Origin



## **PRIORITY CLAIMS**

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## PRIORITY CLAIMS

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## **1. INTRODUCTION**

This chapter is concerned with the claim of priority in trade mark applications.

## **2. RELEVANT LEGISLATION**

### **Trade Marks Act [Cap. 332, 2005 Rev. Ed.]**

#### **Interpretation**

**2.** — (1) In this Act, unless the context otherwise requires —

“Convention country” means —

(a) in section 10 and paragraph 13 of the Third Schedule, a country or territory, other than Singapore, which is —

(i) a party to the Paris Convention; or

(ii) a member of the World Trade Organisation; and

(b) in any other provision of this Act, a country or territory which is —

(i) a party to the Paris Convention; or

(ii) a member of the World Trade Organisation;

“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;

“Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883, as revised or amended from time to time;

“WTO Agreement” means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

#### **Claim to priority of Convention application**

**10.** — (1) Subject to subsection (6), where —

(a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;

(b) that application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (referred to in this section as the first Convention application); and

(c) within 6 months after the date on which the first Convention application is filed, that person or his successor in title applies under this Act for the registration of the trade mark in respect of all or any of those goods or services,

that person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from (and including) the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark shall not be affected by any use of the trade mark in Singapore in the period between —

- (a) the date the first Convention application was filed; and
- (b) the date the application under this Act was filed.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) For the purposes of subsection (4), “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the subsequent fate of the application.

(6) Where a subsequent application concerning the same subject as an earlier application is filed, whether in the same or a different Convention country, and these are the first 2 applications concerning that subject to be filed in any Convention country, the subsequent application shall be considered the first Convention application if, at the date the subsequent application is filed —

- (a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) the earlier application has not yet served as a basis for claiming a right of priority.

(7) For the avoidance of doubt, where subsection (6) applies —

- (a) the date on which the subsequent application was filed, rather than that of the earlier application, shall be considered the starting date of the period of priority under subsection (2); and
- (b) the earlier application may not thereafter serve as a basis for claiming a right of priority.

(8) The Minister may make rules as to the manner of claiming priority under this section.

(9) A right of priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the applicant’s “successor in title” shall be construed accordingly.

### **Claim to priority from other relevant overseas application**

**11.** — (1) The Minister may, by order, confer on a person who has filed an application for the registration of a trade mark in a country or territory to which the Government has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(2) An order under this section may make provision corresponding to that set out in section 10 or such other provision as appears to the Minister to be appropriate.

### **Revocation of acceptance**

**16.**—(1) Notwithstanding section 15(1), if, before a trade mark is registered, the Registrar is satisfied —

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, the Registrar may revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance —

- (a) the application is taken to have never been accepted; and
- (b) section 12 again applies in relation to the application.

### **Trade Marks Rules**

#### **Claim to priority**

**18.** — (1) Where a right of priority is claimed by reason of an application for the registration of a trade mark filed in a Convention country under section 10 of the Act or in another country or territory in respect of which provision corresponding to that set out in section 10 of the Act is made under section 11 of the Act (referred to in this rule as the priority application), particulars of that claim shall be included in the application form at the time of filing the application form.

(2) The particulars referred to in paragraph (1) are —

(a) the country or territory in which —

- (i) the priority application; or
- (ii) where there is more than one priority application, each priority application, was filed;

(b) the date on which —

- (i) the priority application; or
- (ii) where there is more than one priority application, each priority application, was filed;

(c) where the right of priority is claimed in respect of one or more, but not all, of the goods or services for which registration was sought in the priority application, the goods or services in respect of which the right of priority is claimed; and

(d) where the right of priority is claimed through more than one priority application, the goods or services in respect of which the right of priority is claimed through each priority application.

(3) The Registrar may at any time require the applicant to file a certificate by the registering or other competent authority of the country or territory concerned certifying or verifying to the satisfaction of the Registrar —

- (a) the date of filing of the priority application;
- (b) the country or territory, or the registering or competent authority;
- (c) the representation of the mark; and
- (d) the goods and services covered by the priority application.

(4) Where the certificate referred to in paragraph (3) is not in the English language, there shall be annexed to the certificate a translation in English of the contents of the certificate, certified or verified to the satisfaction of the Registrar.

## **Trade Marks (International Registration) Rules**

### **Priority**

**10.** — (1) Subject to paragraph (2), the provisions of section 10 of the Act shall apply so as to confer a right of priority in relation to protection of an international registration designating Singapore, as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.



### **3. CLAIM OF PRIORITY**

#### **3.1 Convention countries**

A Convention country is a foreign country or region of a kind prescribed under Section 2 of the Trade Marks Act (the “**Act**”). A Convention country is defined as:

- a. A party to the Paris Convention; or
- b. A member of the World Trade Organisation (WTO).

A list of the contracting parties to the Paris Convention and members of the WTO may be viewed at the websites of the World Intellectual Property Office (WIPO) and the WTO respectively.

#### **3.2 Eligibility & Effect**

An earlier application made in a Convention country (also known as a “**priority application**”) may be eligible for a claim of priority in a Singapore trade mark application. This Singapore trade mark application, in the context of claiming priority, is referred to in this document as a “**Singapore application**”. For a claim for priority in a Singapore application to succeed, the following factors must be satisfied –

- (a) The Singapore application must be made by the applicant of the priority application or its successor in title;
- (b) The Singapore application must be for the same trade mark as that of the priority application;
- (c) The Singapore application must have at least one corresponding good or service covered by the priority application; and
- (d) The Singapore application must be filed within six months after the day on which the priority application was first made in the Convention country.

An elaboration of each of the factors is set out further below. Singapore applications which are successful in claiming priority will have their rights dated back to the filing date of the priority application (“**priority date**”).

For the purposes of renewal, the registration will expire 10 years from the date of application in Singapore instead of from the priority date.

##### **3.2.1 Applicant**

Priority can be claimed only by the applicant of the priority application or its successor in title. In the latter case, a transfer must have taken place prior to the filing date of the Singapore application.



Subsidiary or associated companies of the applicant are not considered to be the same entity as the applicant and are not eligible to file for a priority claim in their own names.

A change of the applicant's name between the filing of the priority application and the filing of the Singapore application does not impact on the eligibility of the applicant to file for the Singapore application.

### 3.2.2 Representation of the mark

The Singapore application must be for the same trade mark as that of the priority application.

#### Example 1: Priority claim with respect to representation of mark

	Priority Application	Singapore Application
Mark	 (Application for a series of two marks)	

Elaboration of Example 1: The priority claim is acceptable as the mark applied for in the Singapore application is one of the marks in the series represented in the priority application.

### 3.2.3 Specification of goods and/or services

There must be at least one corresponding good or service covered by both the priority application and the Singapore application. The priority claim will only apply to goods and/or services contained in the Singapore application which are common to both the priority application and the Singapore application.

#### Example 2: Priority claim with respect to all the goods and/or services

	Priority Application	Singapore Application
Goods and/or services	Coffee, tea, cocoa and artificial coffee; bread, pastry and confectionery; edible ices; sugar, honey, treacle.	Coffee, tea, cocoa and artificial coffee.

Elaboration of Example 2: The priority claim is acceptable as the specification of goods in the Singapore application is wholly within the scope of the specification applied for in the priority application.

**Example 3: Priority claim with respect to some of the goods and/or services**

	Priority Application	Singapore Application
Goods and/or services	T-shirt and shorts.	T-shirt, shorts and shoes.

Elaboration of Example 3: The priority claim for the Singapore application applies only to “T-shirt and shorts” and does not include the item "shoes" as it is not within the scope of the specification applied for in the priority application.

*Priority claim of goods and/or services in different classes*

Priority claim for goods and/or services that have been classified in different classes in the priority application and the Singapore application is acceptable as long as the goods and/or services claimed in the Singapore application are also claimed in the priority application. The goods and/or services of the priority application may fall in a different class number from the Singapore application due to the change in edition and/or version of the Nice Classification or the difference in classification practices among the intellectual property offices worldwide.

**Example 4: Priority claim with respect to the same goods and/or services in different classes**

	Priority Application	Singapore Application
Filing Date	15 December 2011	9 February 2012
Class Number	9	7
Goods and/or services	Vending machines.	Vending machines.

Elaboration of Example 4: The priority claim is acceptable even though the class number is different as the specification of goods in the Singapore application is also claimed in the specification applied for in the priority application.

**3.2.4 Timing of the Singapore application**

A Singapore application should be filed within six months after the day on which the priority application was made in the Convention country.

When calculating the six-month period, the day on which the priority application was made in the Convention country is not included in the calculation. For example, if the priority application was filed in a Convention country on 1 January 2015, the Singapore application must be filed by 1 July 2015. If the last day for claiming priority falls on an official holiday, or an “excluded day” declared by the Registrar, the deadline is extended until the next working day.

**Example 5: Calculation of the six-month period for priority claim**




	Priority Application	Singapore Application
Filing Date	14 January 2015	≤ 14 July 2015
Goods and/or Services	Clothing; headgear; footwear.	Clothing; headgear; footwear.

Elaboration of Example 5: The priority application was made on 14 January 2015. Therefore, the Singapore Application must be filed on or before 14 July 2015 for it to be able to claim priority for the goods “Clothing; headgear; footwear”.

**3.3 Partial priority claim**

Partial priority claim refers to the claim of priority made in respect of only part of the Singapore application.

**Example 6: Partial priority claim with respect to representation of marks**

	Priority Application	Singapore Application
Mark		  (Application for a series of two marks)

Elaboration of Example 6: The priority claim for the first (top) mark in the series of the Singapore application is acceptable.

**Example 7: Partial priority claim with respect to goods and/or services**

	Priority Application	Singapore Application
Goods and/or services	Computer hardware; computer software.	Computers; computer hardware; computer peripheral devices; computer software; magnetic data carriers.

Elaboration of Example 7: The priority claim for “computer hardware and computer software” of the Singapore application is acceptable.

### 3.4 Multiple priority claims

A situation of multiple priority claims refers to more than one priority claim made with respect to the Singapore application.

#### *Principle of first filing*

In making multiple priority claims, it should be noted that the priority applications must follow the principle of first filing. If more than one priority application for the trade mark has been filed in respect of particular goods and/or services in the various Convention countries, the Singapore application must be filed within six months after the day on which the earliest of the priority applications was made. This is to prevent the cascading of priority rights, and is known as the principle of first filing.

#### **Example 8: Principle of first filing in multiple priority claims**

	Priority Application 1	Priority Application 2	Singapore Application
Filing Date	31 January 2013	1 July 2014	22 August 2014
Goods and/or services	Toys.	Toys.	Toys.
Convention Country	Thailand	Malaysia	(not applicable)

Elaboration of Example 8: The Singapore application cannot make a claim for priority. This is because the first filing made in a Convention country was Priority Application 1 in Thailand on 31 January 2013, and the Singapore application was filed more than 6 months from the date of Priority Application 1. The Singapore application cannot claim priority from Priority Application 2 filed in Malaysia even though the Singapore application was made within 6 months from Priority Application 2, as Priority Application 2 is not the first priority application made in a Convention country.

The examples below are illustrative of multiple priority claims:

**Example 9: Multiple priority claims with respect to representation of mark**

	Priority Application 1	Priority Application 2	Singapore Application
Mark	<b>ABC</b>	<b>ABC</b>	<b>ABC</b> <b>ABC</b> (Application for a series of two marks)
Filing date	2 January 2015	2 March 2015	1 April 2015

Elaboration of Example 9: The marks in Priority Application 1 and 2 form the series of two marks applied for in the Singapore application. The priority claims for the priority applications are acceptable, with the priority date of 2 January 2015 for the first (top) mark in the series and 2 March 2015 for the second (bottom) mark in the series of the Singapore application.

**Example 10: Multiple priority claims with respect to goods and/or services**

	Priority Application 1	Priority Application 2	Singapore Application
Goods and/or services	Services for providing food and drink.	Temporary accommodation.	Services for providing food and drink; temporary accommodation.
Filing date	2 January 2015	2 March 2015	1 April 2015

Elaboration of Example 10: The priority claims for the Singapore application based on Priority Application 1 and Priority Application 2 are acceptable, with the priority dates of 2 January 2015 for "services for providing food and drink" and 2 March 2015 for "temporary accommodation".

#### **4. MAKING A CLAIM FOR PRIORITY**

To claim a right of priority, an applicant must file notice of the priority claim on Form TM4 at **the point of application**. Under Rule 18 of the Trade Mark Rules (the “**Rules**”), the notice must include the following details:

- a. the Convention country in which the earlier application was filed;
- b. the date on which the earlier application was filed, and
- c. the goods and/or services in respect of which the right of priority is claimed.

If priority is claimed on the basis of more than one earlier application, the notice of the claim for priority must contain the above details for each of the earlier applications.

## 5. EXAMINING PRIORITY CLAIM



### 5.1 Documentation

Documentation regarding the priority application claimed is generally **not** required. However, under Rule 18(3) of the Rules, the Registrar may request for documentation certifying the validity of the priority claim during the examination of the application.

### 5.2 Conflicting marks

When conducting a similar mark search for the current Singapore application during the examination stage, a later filed application with a priority date which is earlier than the filing date of the current application being examined, and which is considered to be identical or confusingly similar to the current application, will be cited against the current application by virtue of the definition of “earlier trade mark” under Section 2 of the Act. Please refer to the Trade Marks Work Manual’s section on Relative Grounds for Refusal of Registration for more information.

#### **Example 11: Citation concerning conflicting mark with priority claim**

	Singapore Application 1	Singapore Application 2
Mark		
Filing date	2 January 2015	26 February 2015
Priority date	(no priority claim)	1 December 2014

Elaboration of Example 11: Although Singapore Application 2 has a later filing date of 26 February 2015 as compared to the filing date of 2 January 2015 of Singapore Application 1, Singapore Application 1 will not be cited against Singapore Application 2. This is because the priority date of 1 December 2014 in Singapore Application 2 is earlier than the filing date of 2 January 2015 in Singapore Application 1. Hence Singapore Application 2 is an earlier trade mark and will be cited against Singapore Application 1.

In the event that the mark to be cited has already been published but has not proceeded to registration, the Registrar will revoke the acceptance of the mark under Section 16 of the Act.

#### Marks with the same priority/filing date

When there are two identical or confusingly similar marks with the same filing or priority date, the Registrar will not raise relative grounds objection by citing the other application. The Registrar will separately inform both parties of the existence of the other mark and it will



be up to the two parties to decide if they wish to carry out opposition proceedings against each other.

### **5.3 Priority claim in more than one countries with the same date and scope**

When priority is claimed in two or more countries with the same priority date and scope, the Registrar will allow such claims and not request for the deletion of any priority claim country.

#### **Example 12: Multiple priority claims with the same priority date and scope**

	Priority Application 1	Priority Application 2	Singapore Application
Filing date	2 January 2015	2 January 2015	1 April 2015
Goods and/or services	Printed matter.	Printed matter.	Printed matter.
Convention country	Malaysia	Thailand	(not applicable)

Elaboration of Example 12: The Singapore application is filed within six months of the same priority date of 2 January 2015 for both Priority Application 1 and 2. Hence both priority claims will be endorsed in the Singapore application.

### **5.4 Priority claim date is the same date as filing date**

When the priority date claimed is the same as the filing date of the Singapore application, the Registrar will allow such claim(s) in the application. However, the rights conferred to the Singapore application is not affected by the priority claim since the priority date is the same as the filing date.

## **ASSIGNMENT**

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**ASSIGNMENT**

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## **1. INTRODUCTION**

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This chapter is concerned with the Registry's practice relating to assignment or transfer of trade mark ownership matters.

## 2. RELEVANT LEGISLATION

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### **Trade Marks Act [Cap. 322, 2005 Rev. Ed.]**

#### **Co-ownership of registered trade mark**

**37.—**(1) Where a registered trade mark is granted to 2 or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) Subsections (3) to (8) apply where 2 or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor may not, without the consent of the other or others —

...

(b) assign or charge his share in the registered trade mark.

#### **Assignment, etc., of registered trade mark**

**38.—**(1) A registered trade mark is assignable and transmissible in the same way as other personal or movable property, and is so assignable or transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) Subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(5) Subsections (1) to (4) shall apply to assignment by way of security as they apply to any other assignment.

(6) A registered trade mark may be the subject of a charge in the same way as other personal or movable property.

(7) Nothing in this Act shall be construed as affecting the assignment or transmission of an unregistered trade mark as part of the goodwill of a business.

### **Registration of transactions affecting registered trade mark**

**39.**—(1) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions under subsection (1):

(a) an assignment of a registered trade mark or any right in it;

...

(d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;

(e) an order of the Court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for the registration of the prescribed particulars of a registrable transaction referred to in subsection (2)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction.

(4) A person who becomes the proprietor of a registered trade mark by virtue of any registrable transaction referred to in subsection (2)(a), (c), (d) or (e) is not entitled to damages, an account of profits or statutory damages under section 31(5)(c) in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the date of the application for the registration of the prescribed particulars of the transaction.

### **Trusts and equities**

**40.** — (1) No notice of any implied or constructive trust shall be entered in the register, and the Registrar shall not be affected by any such notice.

(1A) A notice of an express trust or of the beneficiary of an express trust, or both, may be entered in the register; but —

(a) the Registrar shall not be affected by any such notice in the register; and

(b) for the avoidance of doubt, a failure to enter such notice in the register does not affect any rights or duties under the trust.

(2) Subject to the provisions of this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal or movable property.

### **Application for registration of trade mark as object of property**

**41.** —(1) The provisions of sections 36, 37, 38 and 40 shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.

...

(3) Any person claiming to be —

- (a) entitled to an interest in or under an application for registration of a trade mark by virtue of a registrable transaction; or
- (b) affected by a registrable transaction,

may give to the Registrar notice of the prescribed particulars of the transaction.

(4) The following are registrable transactions under subsection (3):

- (a) an assignment of an application for registration of a trade mark or any right in it;
- ...
- (d) the making by personal representatives of an assent in relation to an application for registration of a trade mark or any right in or under it;
- (e) an order of the Court or other competent authority transferring an application for registration of a trade mark or any right in or under it.

(5) The Registrar shall maintain a record of each notice given to him under subsection (3).

(6) Until the notice referred to in subsection (3) has been given to the Registrar in respect of a transaction referred to in subsection (4)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the application for registration of a trade mark in ignorance of the transaction.

### **Registration to be prima facie evidence**

**101.** In all legal proceedings relating to a registered trade mark or any right thereunder (including proceedings for rectification of the register) —

- (a) the register shall be prima facie evidence of anything contained therein;
- (b) the registration of the prescribed particulars of any registrable transaction under section 39 shall be prima facie evidence of the transaction; and



(c) the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of —...

(ii) any subsequent assignment or other transmission of the registration.

## **Second Schedule**

### **Certification Marks**

#### **Consent to assignment of registered certification mark**

**12.** The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

## **Third Schedule**

### **Transitional Provisions**

#### **Existing registered marks**

**2.—(4)** In any other case, any note indicating that an existing registered mark is associated with any other mark shall cease to have effect on 15th January 1999.

**3. —(1)** A condition entered in the register kept under the repealed Act in relation to an existing registered mark immediately before 15<sup>th</sup> January 1999 shall cease to have effect on that date.

#### **Assignment, etc., of registered mark**

**8.—(1)** Section 38 of this Act shall apply to transactions and events occurring after 15th January 1999 in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before that date.

(2) Entries in the register kept under the repealed Act relating to the assignment of registered trade marks and of the benefits of applications for registration of trade marks shall be deemed to be transferred on 15th January 1999 to the register kept under this Act and have effect as if made under section 39 of this Act.

(3) Provision may be made by rules for putting entries referred to in sub-paragraph (2) in the same form as is required for entries made under this Act.

(4) An application for registration of an assignment of a registered trade mark or of an assignment of the benefits of an application for registration of a trade mark, made to the Registrar before 15th January 1999, shall be treated as an application for registration under section 39 of this Act and shall proceed accordingly.

(5) The Registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

(6) An application for registration under section 43 of the repealed Act which has been determined by the Registrar but not finally determined before 15th January 1999 shall be dealt with under the old law; and sub-paragraphs (2) and (3) shall apply in relation to any resulting entry in the register.

(7) Where before 15th January 1999 a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after that date shall be made under section 39 of this Act.

(8) In cases to which sub-paragraph (4) or (7) applies, section 43 (2) of the repealed Act continues to apply (and section 39(3) and (4) of this Act do not apply) as regards the consequences of failing to register.

## **Trade Marks Rules**

### **Signature on documents**

**6.—**(1) A document to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed by —

- (a) all the partners;
- (b) any partner stating that he signs on behalf of the partnership; or
- (c) any other person who satisfies the Registrar that he is authorised to sign the document on behalf of the partnership.

(2) A document to be signed for or on behalf of a body corporate shall be signed by a director, the secretary or other principal officer of the body corporate, or by any other person who satisfies the Registrar that he is authorised to sign the document on behalf of the body corporate.

(3) A document to be signed by or on behalf of an unincorporated body or association of persons may be signed by any person who appears to the Registrar to be qualified to so sign.

(4) For the purposes of this rule, “document” means a document to be given or sent to, filed with or served on the Registrar in respect of any matter under the Act or these Rules.

### **Address for service**

**9.—**(4)

- (j) where an applicant for the registration of a change in the ownership of a registered trade mark furnishes an address for service in Form CM8, the address for service may, at the option of the applicant, be effective —

- (i) for the purposes of all proceedings in respect of the trade mark, including the application for the registration of the trade mark; or
- (ii) only for the purposes of the registration of the change in the ownership of the registered trade mark, in which case the applicant must furnish another address for service for all other proceedings in respect of the trade mark, including the application for the registration of the trade mark, on a separate Form CM8.

### **Entry in register of particulars of registrable transactions**

**54.—**(1) The prescribed particulars of a transaction to which section 39 of the Act applies to be entered in the register are —

- (a) in the case of an assignment of a registered trade mark or any right in it —
  - (i) the name and address of the subsequent proprietor;
  - (ii) the date of the assignment; and
  - (iii) where the assignment is in respect of any right in the trade mark, a description of the right assigned;—
- ...
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it —
  - (i) the name and address of the person in whom the trade mark or any right in or under it vests by virtue of an assent; and
  - (ii) the date of the assent; and
- (e) in the case of an order of the Court or other competent authority transferring a registered trade mark or any right in or under it —
  - (i) the name and address of the transferee;
  - (ii) the date of the order; and
  - (iii) where the transfer is in respect of a right in the trade mark, a description of the right transferred.

(2) In each of the cases mentioned in paragraph (1), there shall be entered in the register the date on which the entry is made.

### **Application to register or give notice of transaction**

**55.—**(1) An application to register particulars of a transaction to which section 39 of the Act applies shall be made, and a notice to be given to the Registrar of particulars of a transaction to which section 41 of the Act applies shall be —

- (a) in the case of any assignment or transaction other than a transaction referred to in sub-paragraphs (b) and (c), in Form CM8;
- ...
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark, an application for registration of a trade mark, or any right

in or under a registered trade mark or an application for registration of a trade mark, by way of a written request; or

- (e) in the case of an order of the Court or any other competent authority transferring a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, by way of a written request accompanied by a copy of the order.

(2) Where an application under paragraph (1) is filed other than by means of the electronic online system, the application shall be —

- (a) signed by or on behalf of all the parties to the assignment or transaction, in the case of an assignment or transaction referred to in paragraph (1)(a);
- (b) signed by or on behalf of the personal representative, in the case of the making by a personal representative of an assent referred to in paragraph (1)(d);
- (c) accompanied by any documentary evidence which in the Registrar's view is sufficient to establish the transaction, in the case of an order of the Court or other competent authority referred to in paragraph (1)(e)

(3) Where an application under paragraph (1) is filed by means of the electronic online system, the application shall be authorised by all relevant parties and be validated by such means as the Registrar considers fit.

(3A) Where an application under paragraph (1) is not signed in accordance with paragraph (2)(a), (b) or (d), or not authorised and validated in accordance with paragraph (3), the application shall be accompanied —

- (a) in the case of an assignment (of a registered trade mark or an application for registration of a trade mark) referred to in paragraph (1)(a), at the option of the applicant, by —
  - (i) a copy of the contract of assignment;
  - (ii) an extract of the contract of assignment, being an extract which shows the change in the ownership of the registered trade mark or application for registration;
  - (iii) a certificate of transfer of the registered trade mark or application for registration in such form as the Registrar may require, being a certificate signed by all parties to the assignment;
  - (iv) a transfer document relating to the registered trade mark or application for registration in such form as the Registrar may require, being a document signed by all parties to the assignment; or
  - (v) a copy of any documentary evidence which in the Registrar's view is sufficient to establish the assignment; —...

- (d) in any other case, by a copy of any documentary evidence which in the Registrar's view is sufficient to establish the transaction.

(3B) Where an application under paragraph (1) is filed by means of the electronic online system, the document referred to in paragraph (3A)(a)(i), (ii), (iii), (iv) or (v) shall be filed within such time as the Registrar may specify.

(3C) The Registrar shall refuse to accept an application under paragraph (1) if paragraph (2), (3), (3A) or (3B) is not complied with and in such event, the Registrar may require a fresh application to be made.

(5) The Registrar may require the applicant to furnish such other document, instrument and information in support of the application as the Registrar thinks fit, within such time as the Registrar may specify.

## **Trade Marks (International Registration) Rules**

### **Notification of transactions**

**8.**—(1) The following are notifiable transactions for the purpose of this rule:

...

- (b) an order of the Court or other competent authority transferring –
  - (i) a protected international trade mark (Singapore)
  - (ii) an international registration designating Singapore; or
  - (iii) any right in or under a protected trade mark (Singapore) or an international registration designating Singapore;

(2) On application being made to the Registrar by —

- (a) a person claiming to be entitled to an interest in or under a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction; or
- (b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the register.

(3) The following are relevant transactions for the purpose of this rule:

- (a) an assignment of –
  - (i) a protected international trade mark (Singapore);
  - (ii) an international registration designating Singapore; or
  - (iii) any right in a protected international trade mark (Singapore) or an international registration designating Singapore;

(b) the making by personal representatives of an assent (other than an assent to a license) in relation to –

- (i) a protected international trade mark (Singapore);
- (ii) an international registration designating Singapore; or
- (iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore;

...

(4) Until —

(a) in the case of any notifiable transaction referred to in paragraph (1) (b), an application has been made for the registration of the relevant particulars of the transaction; or

(b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in or under the protected international trade mark (Singapore) or the international registration designating Singapore in ignorance of the transaction.

(5) A person who becomes the proprietor of a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction mentioned in paragraph (1)(b) or relevant transaction is not entitled to damages, an account of profits or statutory damages under section 31(5)(c) of the Act in respect of any infringement of the protected international trade mark (Singapore) or the international registration designating Singapore occurring –

(a) after the date of the transaction and before the date of the application for the registration of the relevant particulars of the notifiable transaction, or

(b) after the date of the transaction and before the relevant transaction is recorded in the International Register,

as the case may be.

(6) In this rule, “relevant particulars” means –

...

(b) in relation to a notifiable transaction mentioned in paragraph 1(b) –

- (i) the name and address of the transferee;
- (ii) the date of the order; and
- (iii) where the transfer is in respect of a right in or under a protected international trade mark (Singapore) or an international registration designating Singapore, a description of the right transferred.

**Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007)**

**Article 2 - Securing Protection through International Registration**

- (1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,
- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
  - (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

...

**Article 9 - Recordal of Change in the Ownership of an International Registration**

At the request of the person in whose name the international registration stands, or at the request of an interested Office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

**Article 9ter - Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

**Regulations under the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (as in force on February 1, 2020)**

**Rule 25 - Request for Recording**

**(1) [Presentation of the Request]**

- (a) A request for recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:
  - (i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;
  - ...
  - (b) The request shall be presented by the holder or by the Office of the Contracting Party of the holder; however the request for the recording of a change in ownership may be presented through the Office of the Contracting Party, or of one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).
  - ...
  - (d) Where the request is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

**(2) [Contents of the Request]**

- (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate
  - (i) the number of the international registration concerned,
  - (ii) the name of the holder or the name of the representative where the change relates to the name or address of the representative,
  - (iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as "the transferee"),
  - (iv) in the case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the transferee fulfills the conditions under Article 2 of the Protocol to be the holder of an international registration,



- (v) in the case of a change in the ownership of the international registration, where the address of the transferee given in accordance with item (iii) is not in the territory of the Contracting Party, or of one of the Contracting Parties, given in accordance with item (iv), and unless the transferee has indicated to be a national of a Contracting State or of a State member of a Contracting Organization, the address of the establishment, or the domicile, of the transferee in the Contracting Party, or in one of the Contracting Parties, in respect of which the transferee fulfills the conditions to be the holder of an international registration,
  - (vi) in the case of a change in the ownership of the international registration that does not relate to all the goods and services and to all the designated Contracting Parties, the goods and services and the designated Contracting Parties to which the change in ownership relates, and
  - (vii) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.
- (b) The request for the recording of a change in the ownership of the international registration may also contain,
- (i) where the transferee is a natural person, an indication of the State of which the transferee is a national;
  - (ii) where the transferee is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized.
- (c) The request for recording of a change or a cancellation may also contain a request that it be recorded before, or after, the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.
- ...
- (4) [*Several Transferees*] Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration.

### 3. BACKGROUND

---

A registered trade mark or application for registration of a trade mark or any right in it, is assignable and transmissible in the same way as other personal or movable property. An “Assignor” (or “Current Proprietor”) is the person who makes an assignment and an “Assignee” (or “Subsequent Proprietor”) is the person to whom an assignment is made. The assignment (or “change in ownership”) of a trade mark may relate to all the goods and services covered by the mark, or to some of the goods and services.

While it is not compulsory for parties to record changes in ownership, it is important for new assignees to update the Register when there is a change of ownership. Any delay in recording of the prescribed particulars of the transaction may also affect the assignee’s rights to claim damages, account of profits and statutory damages in the event of trade mark infringement.

#### Assignment of Singapore registered trade mark, or an application for a Singapore registered trade mark

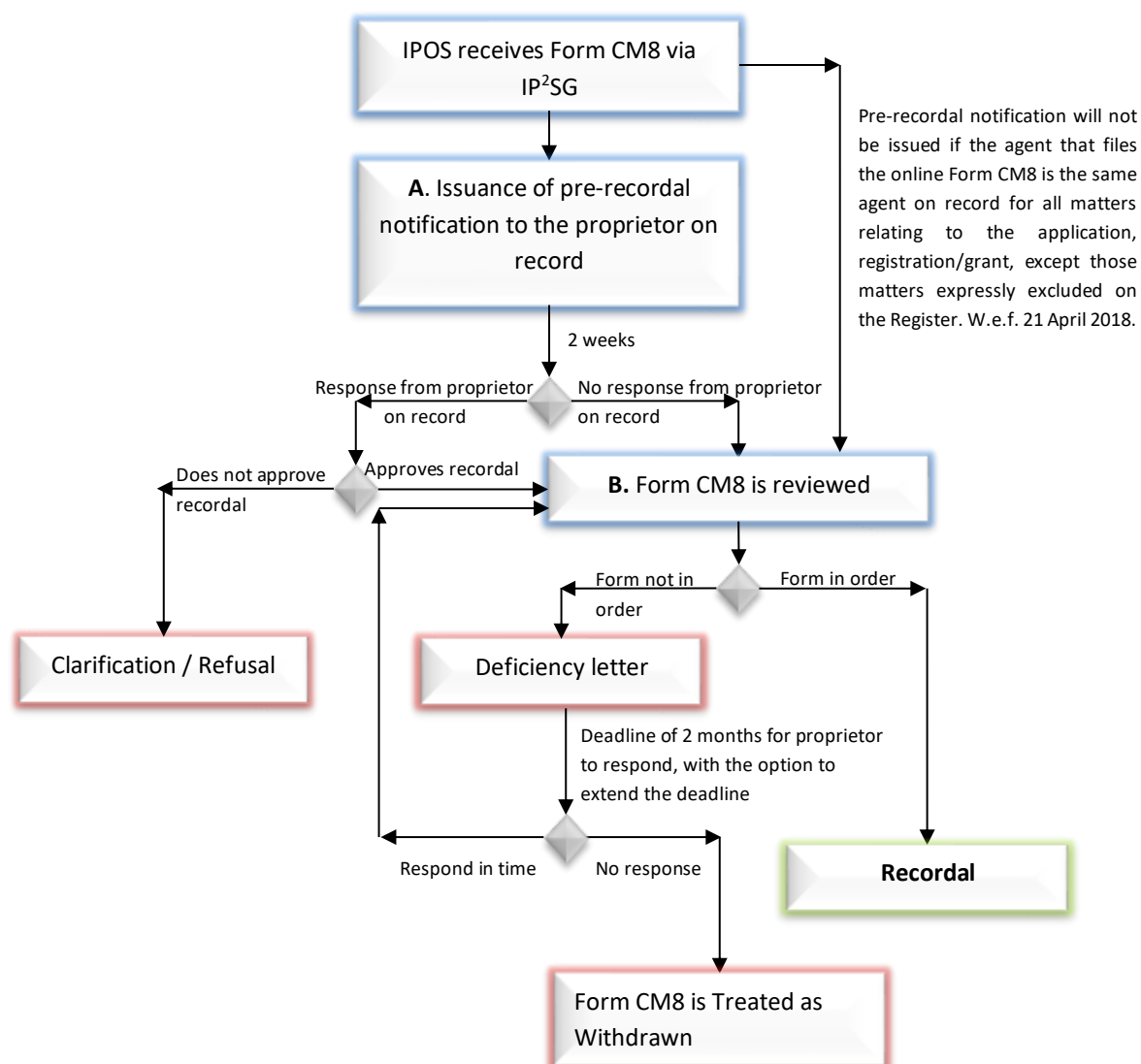
- An application to record an assignment for a Singapore registered trade mark, or an application for a Singapore registered trade mark is to be made on Form CM8.

#### International Registrations (“IR”) designating Singapore filed under the Madrid Protocol

- Requests for recordal of assignments for IRs are strongly encouraged to be presented to the International Bureau of the World Intellectual Property Organization (WIPO) directly by the holder (or his recorded representative) on WIPO’s official Form MM5(E) to avoid any delay which may affect your right to damages or account of profits in respect of infringements. Form MM5(E) is available for download at <http://www.wipo.int/madrid/en/forms/>.

For more information on the Madrid Protocol and International Registrations please refer to “Chapter 19 - International registrations / Subsequent designations designating Singapore” of the Trade Marks Work Manual.

#### 4. PROCEDURES AND TIMELINES FOR FORM CM8



##### 4.1 Lodgement of Form CM8 with the requisite fee via IP²SG

An applicant (i.e. the current proprietor or subsequent proprietor) or their agent should request to record an assignment of a trade mark by filing Form CM8 (Application to Register Transfer of Ownership) online at <https://ip2sg.ipos.gov.sg>. The filing fee for Form CM8 is \$70 in respect of each trade mark number.

## **A. PRE-RECORDAL NOTIFICATION**

Upon receipt of an application to record an assignment, the Registry will send a pre-recordal notification to the current proprietor on record (or his agent for all matters relating to the application, registration/grant, except those matters expressly excluded on the Register), of the trade mark to be assigned. This notification serves to inform the proprietor that an application to record an assignment in respect of his trade mark has been filed with the Registry, providing the proprietor with the opportunity to object to the assignment if it was not so authorised by him.

If the Registry does not receive any objection from the current proprietor or his agent within the time prescribed in the notification, the Registrar will proceed to review the assignment recordal application.

In the event where the current proprietor objects to the application to record the assignment, the Registry will issue a letter to the applicant seeking the assignment (or his agent, if any) to seek clarification, giving the applicant two months to respond. Thereafter, the Registry will only proceed to process the application if it has received a written authorisation from the current proprietor on record.

To expedite the application process, the current proprietor may reply to our pre-recordal notification via IP<sup>2</sup>SG (and quoting the IPOS reference number indicated on the pre-recordal notification) to confirm his authorisation to the application to record the assignment.

With effect from 21 April 2018, IPOS will cease the sending of pre-recordal notifications if the agent that files the online Form CM8 is the same agent on record for all matters relating to the application, registration/grant, except those matters expressly excluded on the Register.

## **B. PROCESSING OF FORM CM8**

Where the request for assignment under Form CM8 meets the requirements for recordal, the Registry will proceed to record the change of ownership on the Register. A notice will be sent to the applicant who sought the assignment recordal once the Registry approves the assignment recordal application.

Where the request for assignment under Form CM8 does not meet the requirements for recordal, the Registrar may issue a deficiency letter the grounds of refusal and/or the additional information required. The applicant will be given two months to respond to the deficiency letter. As directed by the Registrar, the applicant may be required to provide a written response via IP<sup>2</sup>SG clarifying the matter or through CM4 (Request for Correction of Error) at S\$50 to correct the error(s) in the Form CM8.

Applicants will be notified of the outcome the application through IP<sup>2</sup>SG within 2.5 months from the date of receipt of the application.

### *EXTENSION OF TIME*

If the applicant is unable to reply within two months, he may request for an extension of time via Form CM5 (Request for Extension of Time; no charge for first and second filing, S\$50 for third and subsequent filing) via IP<sup>2</sup>SG before the expiry of the deadline. Please note that cogent reasons would be required for the third and subsequent request for extension of time before the extension is granted.

## 5. FILING GUIDE FOR ONLINE FORM CM8

### Step 1: Insert TM No.

- Insert the TM no. to be transferred in Part 2.<sup>1</sup>
- Each Form CM8 can accommodate up to 50 marks (owned by same proprietor). Please file a second Form CM8 if there are more than that.

### Step 2: Insert details of Assignor and Assignee

- The assignor could be the current proprietor on record and the assignee could be the subsequent proprietor; or
- In the case of multi-step recordals, the assignee of a preceding assignment or the assignor of a subsequent assignment

### Step 3: Select person making the request

- Part 6: Please note that the “requestor (interested party other than current or subsequent proprietor) does not refer to an agent who is filing this form on behalf of his/her client.
- Tax invoice will be issued to the entity or individual as selected in Part 6B.

### Step 4: Select Full/Partial transfer

- Full transfer: If all goods and/or services are to be transferred; or
- Partial Transfer: If the assignment does not apply to all the goods/services, clearly demarcate the goods or services for each trade mark.

### Step 5: Insert Effective Date

- The Effective date (or “date of transfer of ownership”) is when the subsequent proprietor took ownership of a trade mark.
- Effective date cannot be earlier than the trade mark application’s filing date.

### Step 6: Contact details – Select Option A/B

- **Option ‘A’:** All official correspondences concerning the trade marks listed in the CM8 for all matters including assignment and renewal will be sent electronically via IP<sup>2</sup>SG
- **Option ‘B’:** All official correspondences relating to the particular assignment will be sent electronically via IP<sup>2</sup>SG account. Complete Part 14.

### Step 7: Validation/Evidence

- Select “Validation” if the assignment has been duly authorised by all relevant parties; or
- Select “Documentary Evidence” and upload the file. Refer to 5(b) on the following page for more information.

### Step 8: Additional Details and Payment

- Submit and payment by eNETs Credit/Debit card/GIRO
- Hear from us soon!

<sup>1</sup> Each entity/individual on record is tagged with a Unique Entity Number (UEN)/Company Code identifier. However, an entity/individual may have multiple UEN/Company Code identifiers if there are slight variations to the name and/or address. When trade mark application numbers with different UEN/Company Codes are inserted in Part 2 of the Form CM8, the following error message will appear: “Part 2 Application No. – This IP No. belongs to a current applicant/proprietor that is different from the IP No(s). keyed in earlier. Please check, and/or file a separate application form”. The user may contact our officer at +65 6339 8616 to request for the consolidation of the multiple UEN/Company Codes to a single identifier. Otherwise, the user may file separate Form CM8.

## **5.1 Address for service (AFS)**

The address for service (AFS) entered in Part 10, (if option ‘A’ of the Form CM8 is selected) will be taken as the contact details for the subsequent proprietor. Thus, other than for situations stated in paragraph 5.1.1 of this guide, Form CM1 (Request to appoint, change or remove an agent) or CM2 (Request to Change Name, Address and Singapore Address for Service of Agent, Applicant, Proprietor or Other Interested Persons) will not be required in general.

### **5.1.1 When is Form CM1/CM2 required?**

Form CM1 will be required when a new agent is appointed for renewal and/or all matters relating to the application(s)/registration(s) after Form CM8 is approved. In other words, the new agent as indicated in Form CM1 (and not the agent as indicated in the Form CM8) will receive official correspondence for the proprietor electronically via their IP<sup>2</sup>SG account.

Form CM2 will be required when there is a change in the subsequent proprietor’s AFS after Form CM8 is approved. In other words, the subsequent proprietor of the Form CM8 will receive official correspondence electronically via their IP<sup>2</sup>SG account.

## **5.2 Validation / Supporting documents**

### **5.2.1 Validation**

If the applicant seeking the assignment is duly authorised by all relevant parties to record the assignment, he may select the ‘validation’ option in the online Form CM8. Documentary evidence would not be required<sup>2</sup>.

### **5.2.2 Documentary evidence / Assignment agreements**

If the online Form CM8 is not submitted via ‘validation’ option, the form shall be accompanied with either of the following<sup>3</sup>:

- i. A copy of the contract of assignment; or
- ii. An extract of the contract of assignment, which shows the change in the ownership of the registered trade mark or application for registration; or

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<sup>2</sup> In such case, while the Registrar does not require the documentary evidence to be furnished, please be reminded that Form CM8 is not a substitute for an assignment agreement.

<sup>3</sup> An electronic copy of the documentary evidence should be attached to the form at Part 13.

- iii. A certificate of transfer of the registered trade mark or application for registration in such form as the Registrar may require, being a certificate signed by all parties to the assignment; or
- iv. A transfer document relating to the registered trade mark or application for registration in such form as the Registrar may require, being a document signed by all parties to the assignment; or
- v. A copy of any documentary evidence which in the Registrar's view is sufficient to establish the assignment.

### **5.2.3 Requirements of an assignment agreement**

As a general guide, an assignment agreement shall contain the following:

- i. The trade mark number(s) being assigned;
- ii. Assignor and assignee's names and addresses;
- iii. The date of the assignment;
- iv. (Where the assignment is made by an agreement) The consideration of the assignment;
- v. (Where the assignment is made by deed) The words "signed, sealed and delivered"<sup>4</sup>;
- vi. Names, designations and signatures of the assignor and the assignee (or their personal representatives, if applicable).

The documentary evidence should substantiate the content of the online Form CM8. If such documentary evidence furnished is found to be deficient or inconsistent with the details on Form CM8, the Registrar may issue a deficiency letter to the applicant seeking the assignment to seek clarification.

To assist users, a sample assignment agreement is attached in Page 44 of this chapter.

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<sup>4</sup> The Registry will also accept a deed of assignment which is not sealed, if consideration is provided for.



#### **5.2.4 Amendment to the assignment agreement**

Amendment(s) made to the original document(s) must be countersigned by the relevant parties. If the original documents evidencing assignment are unavailable despite the parties' best efforts, the assignor and assignee may amend on a certified true copy of the documentary evidence, accompanied with statutory declaration (SD) confirming that the loss of the original document.

The Registrar may exercise his discretion to accept such amended documents which in his view is sufficient to establish the assignment.

#### **5.2.5 Translations of documents not in the English language**

The Registry will accept submissions of documentary evidence which are not in the English language only if it is accompanied by a certified English translation<sup>5</sup>.

The Registry may also accept certified translations from persons who are not professional translators if the following conditions are met:

- i. The name and designation of the translator is stated in the document;
- ii. A declaration by the translator that he or she is proficient in the English language and the language which is used in the documentary evidence;
- iii. A declaration by the translator that the translation provided is true, accurate and complete; and
- iv. The translation is signed by the translator.

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<sup>5</sup> A certified translation refers to a translation which is certified by a professional translator or a translation company.

## 6. PARTIAL ASSIGNMENT

A registered trade mark, or an application for registration of a trade mark, can be partially assigned/transferred by the assignor to the assignee.

In other words, the assignment or transfer of trade mark ownership may apply to some of the goods, services or right in respect of which the trade mark is registered or applied for.

Where a partial assignment is sought, the goods or services which are to be assigned should be clearly demarcated from the goods or services which will not be assigned with no overlap. This also means that the combined scope of protection of the marks belonging to the resultant assignee(s) (also known as the “Child Marks”) should not exceed that of the original scope of protection of the mark to be assigned (also known as the “Parent Mark”).

After the recordal of the partial assignment, the Parent Mark would bear the status “Split (Partially Assigned)”. The Child Marks will take on the trade mark number of the Parent Mark with a dual-digit suffix extension (e.g. “-01”, “-02” and etc.). The status of the Child Marks will inherit the status of the Parent Mark prior to the partial assignment.

Please refer to illustration below.

	Prior to partial assignment	After partial assignment	
	<i>‘Parent Mark’</i>	<i>‘Child Mark’ 1</i>	<i>‘Child Mark’ 2</i>
<b>TM Number</b>	40201600001A	40201600001A-01	40201600001A-02
<b>Status</b>	Registered	Registered	Registered
<b>Goods</b>	Computer software; computer hardware; cables	Computer software	Computer hardware; cables

Each partially assigned Child Mark will retain the following details of the Parent Mark:

- Filing date;
- Expiration/Renewal date; and
- All clauses, limitations or claims to an interest in or right, in respect to the relevant classes being assigned.

If the Child Marks are pending, each Child Mark will be examined, advertised and registered independently of each other.

If the Child Marks are registered, prior to their expiry, the Registry will send a reminder letters to the assignee(s)/agents of the Child Marks, notifying them of the date of expiry of the registration.

## 7. PARTICULARS OF THE ASSIGNMENT ENTERED IN THE REGISTER

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When the assignment or change of ownership is successfully recorded, the following details are entered in the Register:

- The assignee's name and address;
- An indication of whether the assignment is full or partial;
- Where it is a partial assignment, the description of goods and/or services which have been assigned;
- The contact details of the assignee (or his agent, if applicable);
- The date of assignment (i.e. effective date);
- The date of lodgement of Form CM8;
- The date of entry of the recordal of assignment in the Register; and
- Where it is an assignment of any right in the trade mark, a description of the right assigned.

After the assignment has been recorded, in the case of a registered mark, the registration certificate which was previously issued to the previous proprietor will not be re-generated to be updated with the subsequent proprietor's details. This is because registration certificates are intended to reflect the details of the registration at the moment in which the trade mark is registered.

Nevertheless, the assignee (also known as the subsequent proprietor, or his agent, if any) may request for a ***certified copy of the prevailing application or registration*** via Form CM12 (Request for Certified Copy of Entry in Register or Certified Extract from Register / Request for Certified Document Relating to Patent or Application for Patent).

The certified copy of the prevailing application/registration will reflect the ownership of the trade mark(s) is now under the name of the assignee(s). The certified copy also contains other essential information of the mark, for example, the trade mark number, mark representation, filing date, specification of goods and/or services, application type and mark clauses (if any).

## 8. CHANGE OF BUSINESS CONSTITUTION AND OWNERSHIP AS DISTINCT FROM CHANGE OF NAME

Where a corporate proprietor undergoes a change of business constitution or ownership structure, the Registry considers that a new entity has been formed, and the marks belonging to the proprietor should be assigned to the new entity to reflect the change of ownership of those mark(s).

This is distinct from the situation where a corporate proprietor undergoes a mere change of name, with no change to its business constitution or ownership structure. Where there is a change to the name of the proprietor, Form CM2 (Request to change name, address and Singapore address for service of agent, applicant, proprietor or other interested person) should be lodged to change the relevant details of the marks belonging to such proprietor.

The table below sets out some examples (not exhaustive) where filing of Form CM8 is required.

	<b>Transfer of ownership of a trade mark application</b> (e.g. “ABC Pte Ltd” transfers ownership of trade mark application/registration to “XYZ Pte Ltd”)
	<b>Change in business constitution</b> (e.g., “ABC LLP” becomes “ABC Pte Ltd”)
	<b>Addition or removal of partners in a partnership</b> (e.g., “Jonathan Low, Timothy Tan” to “John Low, Timothy Tan, Alvin Chan”)
	<b>Merger and Division</b> (e.g., Merger of “Kelly Corporation” and “BAC Corporation” to “Kelly Corporation”)
	<b>Sole proprietorship to partnership and vice versa</b> (e.g., “Jonathan Low, Timothy Tan” to “Jonathan Low”)
	<b>Reincorporation of business entity in a new country</b> (e.g., ABC Ltd in Singapore becomes ABC Ltd in France)
	<b>Reincorporation of business entity in another States (applicable for United States of America)</b> (e.g., ABC Ltd in Delaware, USA becomes ABC Ltd in California, USA)

Whether there is a change in business constitution or legal entity depends on the laws of the country where the proprietor company is incorporated.

## 9. CO-OWNERSHIP / PARTNERSHIP / SOLE PROPRIETORSHIP

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### 9.1 Co-ownership of a registered trade mark

A registered trade mark can be granted to two or more persons jointly, each person being known as a “co-proprietor”. Each co-proprietor is entitled to an equal undivided share in the mark, subject to any agreement to the contrary.

Subject to any agreement to the contrary, while each co-proprietor is entitled, by himself or his agents, to use or exploit the registered mark, a co-proprietor cannot assign his share in the mark without the consent of the other co-proprietor(s).

#### **Death of a co-proprietor**

In the event of a death of a co-proprietor, the equal undivided share in the registered trade mark passes to his estate.

If such share is intended to be dealt with, for example to transfer the deceased co-owner’s share to the other co-proprietors(s) or to some other person or entity, an assent from the personal representative(s) of the deceased is required.

The particulars of the assent shall be registered by way of a written request and submitted together with the relevant documents proving the capacity of the personal representative(s), for example, a letter of administration or grant of probate.

The effective date of transfer would be the date as indicated on the written request or the issuance date of a letter of administration or grant of probate, whichever is applicable.

Refer to [here](#) for a sample template for registering particulars of assent.

### 9.2 Partnership

For trade marks that belong to a partnership<sup>6</sup>, the ownership of such trade marks among the partners is determined in accordance with the partnership agreement.

Subject to any agreement between the partners, where no fixed term has been agreed upon for the duration of the partnership, a partnership is dissolved if a partner retires from the partnership, and a new partnership must be formed.

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<sup>6</sup> For the definition of “partnership”, please refer to the Partnership Act (Cap. 391). Briefly, a “partnership” is a relation between persons carrying on a business with a view to profit, and exclude a company registered under the Companies Act (Cap. 50) or any association formed or incorporated by any statute or law.

In such case, the trade marks belonging to the former partnership shall be assigned to the new partnership formed.

The supporting documentary evidence, if any, is to be signed by all the partners. It may also be signed by a partner stating that he signs on the partnership's behalf or signed by someone authorised to sign on the partnership's behalf.

#### **Death of a partner**

Subject to any agreement between the partners, the partnership will dissolve in the event of a death of a partner, and a new partnership must be formed.

In such case, the trade marks belonging to the former partnership shall be assigned to the new partnership formed.

### **9.3 Sole Proprietorship**

A sole proprietorship is not considered separate and distinct from the individual running the sole proprietorship. In other words, a trade mark which is owned by the sole proprietorship is in fact owned by the individual running the sole proprietorship.

Trade mark applications for sole proprietors are recorded in the name of the sole proprietor trading under a trade name (e.g. "Peter Tan trading as Priser & Tan").

Therefore, where there is a change to the name of the sole proprietorship, in other words, a change to the trade name for sole proprietors (e.g. "Peter Tan trading as Tommy & Tan" to "Peter Tan trading as Tommy Lee & Tan" or "Peter Tan"), no assignment has taken place. Such change may be recorded using Form CM2 (Request to change name, address and Singapore address for service of agent, applicant, proprietor or other interested person) via IP<sup>2</sup>SG.

#### **Death of sole proprietor**

In the event of a death of a sole proprietor, the ownership of the registered trade mark passes to his estate.

If such registered mark is intended to be dealt with, for example to transfer the mark to another person or entity, an assent from the personal representatives of the deceased is required.

The particulars of the assent shall be registered by way of a written request and submitted together with the relevant documents proving the capacity of the personal representative, for example, a letter of administration or grant of probate.

The effective date of transfer would be the date as indicated on the written request or the issuance date of a letter of administration or grant of probate, whichever is applicable.

Refer to [here](#) for a sample template for registering particulars of assent



## **10. ASSIGNMENT OF CERTIFICATION AND COLLECTIVE MARKS**

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*For more information on the nature of certification and collective marks, please refer to “Chapter 15 - Collective Marks” and “Chapter 16 - Certification Marks” of the Trade Marks Work Manual.*

The assignment of a certification mark is not effective without the consent of the Registrar. This is to ensure that the assignee, or subsequent proprietor, has the necessary competence to certify and administer the certification scheme and is not involved in the supply of the goods and/or services certified.

As an assignment of a collective or certification mark will involve amendments to the regulations, the applicant seeking the assignment shall attach a copy of the draft amended regulations together with the Form CM8 and the requisite fee. Prior to receiving further instruction(s) from the Registrar, applicants are encouraged to withhold from filing Form TM10 (Filing or Amendment of Regulations governing the Use of a Collective mark or Certification mark) to amend the regulations.

If the Registrar does not have any objections to the draft amended regulations, the applicant seeking the recordal of the assignment shall be required to file Form TM10 (Filing or Amendment of Regulations governing the Use of a Collective mark or Certification mark) online to formalise the amendments. The assignment will be recorded after Form TM10 has been submitted and approved.

## 11. ASSIGNMENT OF LOGOGRAMS

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*For more information on the nature of logograms, please refer to “Marks used by Government Agencies (Rule 13)” in the [“Trade Marks Infopack”](#).*

Proprietors of logograms are encouraged to update the ownership details of these logograms on the Register. This ensures that interested parties seek consent from the correct proprietor to the use of the logogram.

Form CM8 is not required for the assignment of logograms. In most cases, a letter of authorisation from the current proprietor/assignor would suffice for the assignment of logogram(s). In general, the letter of authorisation should contain the following information:-

- i. A representation of the logogram
- ii. The logogram number(s)
- iii. The name and contact details of the assignee
- iv. The name and details of a contact point within the assignee - this is meant for correspondence between IPOS and the assignee of the logogram and will not be reflected on the Register.

A sample letter of authorisation for the assignment of a logogram is attached in Page 45 of this chapter.

**Example 1:** SBX intends to transfer the ownership of a logogram to ZBS. SBX may notify the Registry and provide the details of the new proprietor(s) in writing. Alternatively, ZBS may obtain a letter of authorisation from SBX for the transfer of ownership of the logogram from SBX to ZBS (see Page 45 for a sample template of a letter of authorisation).

**Example 2:** ABS is the owner of a logogram on the Register. ABS will be undergoing restructuring to form two new statutory boards, namely BSB and BSC. ABS will cease to exist on 1 October 2016 and the logogram will be transferred from ABS to BSB and BSC. BSB and BSC are joint owners of the logogram.

Before 1 October 2016, ABS may notify the Registry in writing, stating that pursuant to the dissolution of the ABS into BSB and BSC, the logogram in the name of ABS will be jointly owned by BSB and BSC and to request for the Register to be updated on 1 October 2016.

Alternatively, either BSB or BSC may notify (on behalf of the other party) the Registry on or after 1 October 2016 about the transfer of logogram pursuant to the statute (if any) creating BSB and BSC.

## 12. MULTI-STEP RECORDALS

Where there are multiple transactions involving a change of ownership, to ensure that all transactions are recorded accurately, applicants are strongly encouraged to attach a cover letter with the Form CM8 stating:

- i. Trade mark numbers involved.
- ii. Sequence of events; and
- iii. Exact nature of each transaction

### Scenario 1: Where there are two or more assignments; and when the first assignment (i.e. Company A → B) has not been approved:

- First assignment: Company A → Company B
- Second assignment: Company B → Company C

1. First Form CM8: Applicant is to indicate “Company A” and “Company B” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company A” to “Company B”.

**PART 4**  
Details of Current Applicant/  
Proprietor\*

S/N	Name	Address
1	Company A	51 BRAS BASAH ROAD MANULIFE CENTRE Singapore 189554

Remove Add

**PART 5**  
Details of Subsequent Applicant/  
Proprietor\*

S/N	Name	Address
1	Company B	80 BENDENEER ROAD HYFLUX INNOVATION CENTRE Singapore 339948

Remove Add

2. Second Form CM8: Applicant is to indicate “Company B” and “Company C” in Parts 4 and 5 of the form respectively even though Part 3 of the form reflects “Company A”. Applicant will need to manually remove and insert the correct details in Part 4 of the form. The documentary evidence (if any) should also relate to the assignment from “Company B” to “Company C”.

**PART 4**  
Details of Current Applicant/  
Proprietor\*

S/N	Name	Address
1	Company B	88 BENDENEER ROAD HYFLUX INNOVATION CENTRE Singapore 339949

Remove Add

**PART 5**  
Details of Subsequent Applicant/  
Proprietor\*

S/N	Name	Address
1	Company C	1 PARLIAMENT PLACE PARLIAMENT HOUSE COMPLEX Singapore 178880

Remove Add

Upon receiving the approval letters for the transactions, the applicant may verify the records on the Register. Should there be any discrepancy, the applicant may contact us.

**Scenario 2: Where there is a recordal in the change of name (Form CM2) between two assignment transactions; and when the first assignment (i.e. Company A → Company B) has not been approved:**

1. Form CM8: Company A → Company B
2. Form CM2: Company B → Company B1
3. Form CM8: Company B1 → Company C

As Form CM2 will be processed immediately upon submission, it is advisable to lodge Form CM2 only after the first Form CM8 has been approved.

1. First Form CM8: Applicant is to indicate “Company A” and “Company B” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company A” to “Company B”.

**PART 4**  
Details of Current Applicant/  
Proprietor\*

S/N	Name	Address
1	Company A	51 BRAS BASAH ROAD MANULIFE CENTRE Singapore 189554

Remove Add

**PART 5**  
Details of Subsequent Applicant/  
Proprietor\*

S/N	Name	Address
1	Company B	88 BENDENEER ROAD HYFLUX INNOVATION CENTRE Singapore 339949

Remove Add

2. Form CM2: After the first Form CM8 has been approved, the applicant may proceed to lodge Form CM2. Please note that the change in name via Form CM2 is almost immediate (Form CM2 will be processed after 15 minutes) and “Company B1” will be reflected as the proprietor on record.
3. Second Form CM8: Following the submission of Form CM2, applicant may proceed to file the second Form CM8. Applicant is to indicate “Company B1” and “Company C” in Parts 4 and 5 of the form respectively. The documentary evidence (if any) should also relate to the assignment from “Company B1” to “Company C”.

Upon receiving the approval letters for the transactions, the applicant may verify the records on the Register. Should there be any discrepancy, the applicant may contact us for advice.

### 13. CORRECTION, AMENDMENT, RECTIFICATION

The relevant form to correct, amend or rectify the details of an assignment would depend on the circumstances of each case. The tables listed in 13.1 and 13.2 below shows a non-exhaustive list of scenarios and the recommended forms to be lodged to correct, amend or rectify the detail(s) of an assignment request or the Register.

Should the assignment need to be re-recorded and re-examined, a new Form CM8 with the requisite fees may be required.

#### 13.1 Correction of details within a pending Form CM8

**Example 1: Erroneous insertion of subsequent proprietor's details in Part 5 ("Details of Subsequent proprietors") of Form CM8. Form CM8 has not been approved.**

- ABC Pte Ltd wishes to record the assignment of its trade mark to DEF Pte Ltd. However, the applicant has erroneously inserted GHI Pte Ltd as the subsequent proprietor in Form CM8.

**What should ABC Pte Ltd do?**

- ABC Pte Ltd may verify the status of the assignment recordal request via IP<sup>2</sup>SG. If Form CM8 has been approved, the proprietor on record will be reflected as "GHI Pte Ltd". Otherwise, if the register is still showing the proprietor on record as "ABC Pte Ltd", it indicates that Form CM8 has not been approved.
- If Form CM8 has not been approved and the transaction has not been recorded on the Register, ABC Pte Ltd should contact the Registry immediately to request that the Registry withhold from processing the request. The Registry may direct ABC Pte Ltd to file lodge Form CM4 to correct the error(s) in Form CM8 and attach a new set of documentary evidence (if applicable).

#### **Other Examples - Correction of details within pending Form CM8**

<b>Nature of corrections</b>	<b>Form to effect correction</b>
Effective date of transfer	Form CM4 + new set of documentary evidence (if applicable)
Subsequent proprietor's details (e.g. name, address, country of incorporation, etc.)	
Scope of transfer – specification of goods and services	

### 13.2 Correction of details after Form CM8 has been approved

#### **Example 1: Correction of Error in relation to the Effective Date Of Transfer**

- ASL Pte Ltd lodged Form CM8 to record the assignment of its trade marks to DEF Pte Ltd. Following the recordal of the assignment, DEF Pte Ltd notified the Registrar that the effective date of transfer was erroneous.

#### **What should DEF Pte Ltd do?**

- DEF Pte Ltd may lodge Form TM27 accompanied with supporting documents in support for the rectification of the Register.

#### **Example 2: Recordal of Transfer of Ownership Should Not Have Taken Place**

- Agent, ASL Law LLC, was engaged by ABC Pte Ltd and DEF Pte Ltd to be their transfer of ownership agent. Form CM8 was lodged to transfer the mark from ABC Pte Ltd to DEF Pte Ltd. The Form CM8 was subsequently approved and ASL Law LLC remained as the transfer of ownership agent. However, another agent is now representing DEF Pte Ltd for all matters in relation to the registration.
- A year later, ASL Law LLC took the instruction of ABC Pte Ltd to request for the reversion of the assignment as the assignment should not have taken place (i.e. Form CM8 should not have been lodged).

#### **What should ASL Law LLC do?**

- If ASL Law LLC has been instructed by DEF Pte Ltd to act on their behalf, ASL Law LLC may lodge Form CM1 to appoint themselves as the agent for all matters, followed by Form TM27 accompanied with supporting documents in support for the rectification of the Register.
- Examples (not exhaustive) of supporting documents include (i) letter of consent from DEF Pte Ltd informing the Registrar that the recordal of assignment should not have taken place, or (ii) a letter indicating the particular facts and circumstances for the erroneous assignment. The Registrar may call for such written explanation of the reasons for the request or evidence in support of the request in order to be satisfied that there is an error or a mistake. Requestors are advised to contact the Registry before lodging Form TM27.
- Alternatively, ABC Pte Ltd may consider lodging Form TM28 (Application for Revocation/Invalidation/Rectification) and attach a statement of grounds.

**Example 3: Correction of Errors in relation to the Particulars of Subsequent Proprietor(s) – after Form CM8 has been approved.**

- Particulars of subsequent proprietor(s) such as country and/or states of incorporation, name and/or address may be corrected via Form CM2, provided that the proprietor(s) on record remains the same.
- The filer of Form CM2 for the correction of the particulars of the proprietor on record shall be the agent/proprietor on record.



#### **14. WITHDRAWAL OF ASSIGNMENT APPLICATION**

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The application to record an assignment may be withdrawn before the recordal on the Register. Applicants may verify the status of the assignment recordal request via IP<sup>2</sup>SG. The transaction will be recorded on the register if Form CM8 has been approved.

In the event where an applicant seeking an assignment does not wish to proceed, he/she should contact the Registry immediately to request that the Registry withhold from processing the request.

Once an assignment request has been approved and recorded on our register, it cannot be withdrawn.

## **15. EFFECTS OF BANKRUPTCY OR INSOLVENCY ON THE OWNERSHIP OF TRADEMARKS**

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### **(a) Proprietor (individual) is bankrupt**

In the case where an individual (being the proprietor of a mark) is bankrupt, the High Court will usually appoint Official Assignee to deal with the assets of the individual including the ownership of trade mark(s) belonging to the bankrupt.

In the event that the Official Assignee intends to assign the trade marks in the name of the bankrupt, he should file Form CM8.

### **(b) Proprietor (company) is insolvent**

The Official Receiver or liquidator (as the case may be) may step into the shoes of the trade mark owner to assign the mark to a third party. In this case, the Official Receiver or liquidator may lodge Form CM8 on behalf of the trade mark owner. Please note that the assignment of the trade mark(s) as part of the sale of the asset precedes the dissolution of the company.

For more information on bankruptcy and corporate insolvency, please refer to Ministry of Law's website.

## **16. EFFECTS OF CORPORATE MERGERS ON THE OWNERSHIP OF TRADEMARKS**

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Assignments or transfers of trade mark ownership may occur as a result of a corporate merger. In such situations, the applicable law governing the merger may provide that the transfer of the merging company's trade marks, to the new corporate entity, is effective upon the registration of the merger with the corporate registration authority in the jurisdiction where the new corporate entity is incorporated.

To record the transfer, the new corporate entity may:

- (i) File Form CM8 online and validate the application to record the assignment on the Register;

Or

- (ii) File Form CM8 online accompanied by a copy of any document evidencing the transaction, e.g. a Certificate of Merger or a certified extract from the companies' or commercial register, or Notary Public as appropriate in such cases.

## **17. ASSOCIATION OF MARKS**

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All conditions, including association clauses, ceased to have effect on 15 January 1999 when the new Act came into effect (Section 3(1) of Third Schedule). Therefore, a mark can be assigned independently from other associated marks.

## 18. INTERNATIONAL REGISTRATIONS

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For international registrations (“IR”) designating Singapore, in accordance with Rule 25 of the “Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks”, a request for the recordal of a change in ownership may be presented to the International Bureau of the World Intellectual Property Organisation (WIPO) directly by the holder (or his recorded representative) on WIPO’s official Form MM5(E), through the Office of the Contracting Party of the (recorded) holder, or through the Office of the Contracting Party of the new holder (transferee). Form MM5(E) is available for downloading at <http://www.wipo.int/madrid/en/forms/>.

Form CM8 should not be lodged for such recordation of change in ownership.

Where Singapore is the Office of Origin, requests for recording of changes in the ownership in respect of the international registration must also be presented to the International Bureau of the World Intellectual Property Organisation (WIPO) directly by the holder. However, Form CM8 may be lodged (if appropriate) to record the change in ownership of the basic application or basic registration.

In order for the transfer to be recorded on the international register, the assignee must also be entitled to own the mark under the Madrid Protocol. In a transfer of ownership request to be recorded in respect of an IR, the assignee must indicate the Contracting Party or Parties in which he fulfils any of the following requirements (where appropriate):

- a) Have a real and effective industrial or commercial establishment in the Contracting Party;  
or
- b) Be domiciled in the contracting party; or
- c) Be a national of the contracting party.

The aforesaid requirements known as the entitlement to hold the mark must be indicated on the Form MM5(E). Where the request for the recording of a change in the ownership of the IR mentions several transferees, that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the requirements to be the holder of the IR in respect of that contracting party.

Detailed information on changes in ownership can be found in the section ‘Change of ownership’ of the “Guide to the International Registration of Marks under the Madrid Protocol” via this link: <https://www.wipo.int/publications/en/>.

**SAMPLE ASSIGNMENT AGREEMENT**

*[Draft/Sample Only]  
Without prejudice*

**ASSIGNMENT OF TRADE MARK**

\_\_\_\_\_ [Please state the Assignor's company name in full], having its registered office address at \_\_\_\_\_ [Please state the Assignor's company address in full] (Assignor), now wishes to assign Trade mark \_\_\_\_\_ [Please state the Trade Mark no.]

to

\_\_\_\_\_ [Please state the Assignee's company name in full], having its registered office address at \_\_\_\_\_ [Please state the Assignee's company address in full] (Assignee).

NOW THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged,

The Assignor hereby sells, assigns, transfer to the Assignee all right, title, and interest in and to the Trademarks, together with all of the good will of the business, including common law rights, for consideration of \_\_\_\_\_ [Please state the amount in the relevant currency].

The Assignor hereby assigns, sells, transfer all claims for damages for reason of past infringement of the Trademarks, as well as the right to sue for and collect the same for its own use and enjoyment, without further obligation to Assignor with respect thereto.

IN WITNESS WHEREOF, Assignor has caused this Assignment of Trademark to be executed on its behalf by its duly authorized representative on this \_\_\_\_\_ [Please state the date in day, month, year].

.....  
**Assignor :**

\_\_\_\_\_ [Please state the Assignor's company name in full]

..... [Name]

..... [Designation]

**Assignee :**

\_\_\_\_\_ [Please state the Assignee's company name in full]

..... [Name]

..... [Designation]

**This document is signed in front of a notary public.**

.....

Notary Public

Notary Seal

**SAMPLE TEMPLATE FOR LETTER OF AUTHORISATION (ASSIGNMENT)**

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**Authorisation letter**

In the matter of *[Insert Logogram No.]*

*[Insert mark  
representation]*

*[Insert name of current proprietor]* hereby authorises the change of ownership of *[Insert Logogram No.]* (the “logogram”) from *[Insert name of current proprietor]* to *[Insert name of subsequent proprietor]*, *[Insert address of subsequent proprietor]*.

**Signed for and on behalf of the**

***[Insert Name of current proprietor of  
logogram]***

Name of Authorised personnel:

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Signature of Authorised personnel:

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Designation of the Authorised personnel:

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Date:

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