

AIPPI

Singapore National Group Report

Question Q 168

Use of a Mark “As a Mark” as a Legal Requirement in Respect of Acquisition, Maintenance and Infringement of Rights

1. Is there any requirement for use of a mark “as a mark” for the purposes of:

1.1. acquiring a mark (if rights may be acquired by use according to national law);

Yes.

Refer to s 5(2) Trade Marks Act 1998 (“TMA 98”)

The application shall state 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 that he has a bona fide intention that it should be so used.

Refer to s 7(2) TMA 98

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.

Note: s 7(1) (a) to (d) states the absolute grounds for refusal of registration and these are:

- (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 or services, or other characteristics of goods or services;
- (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.

1.2 maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use); or

Yes.

Refer to s 22 TMA 98

S 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.

S 22(2)

For the purposes of subsection (1), use of a trade mark includes use in the 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 labeling or packaging of goods in Singapore solely for export purposes.

1.3 establishing infringement

Acts amounting to infringement of registered trade mark.

S 27 TMA 98

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because:

- a. the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- b. the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public.

A person infringes a registered trade mark which well known in Singapore if:

- a. without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with or similar to the trade mark, in relation to goods or services which are not similar to those for which the trade mark is registered;

- b. the use of the trade mark in relation to those goods or services would indicate a connection between goods or services and the proprietor and would be likely to cause confusion to the public;
- c. there exists a likelihood of confusion on the part of the public because of such use; and
- d. the interests of the proprietor are likely to be damaged by such use.

A person uses a sign if he

- a. applies it to goods or the packaging thereof; or
- b. offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies under the sign; or
- c. imports or exports goods under the sign; or
- d. uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or
- e. uses the sign in advertising.

2. Is there any definition of what is use “as a mark” either in statute or case law?

There is a definition section for use of a sign for purposes of infringement of trade marks. Refer to s 27(4).

A person uses a sign if he

- a. applies it to goods or the packaging thereof; or
- b. offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies under the sign; or
- c. imports or exports goods under the sign; or
- d. uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or
- e. uses the sign in advertising.

3. Is there any difference in the assessment of use “as a mark” between the acquisition, maintenance and infringement of rights?

Under the TMA 98, there is no apparent difference in the assessment of use “as a mark” in the three instances.

4. Is any of the following considered to be use “as a mark”:

4.1 use on the Internet, as a metatag, in linking or framing;

In general, there is no legal provision for this type of trade mark use in Singapore. Therefore, it is likely that in any court case on such an issue, the court would follow international trade mark practices. In our view, all the instances of use apply within the context of what was identified above:

- The use of the trade mark in the context of a linking or a metatag, or as part of a web frame, the trade mark owner will apply his trade mark to identify his business (so, use in relation to goods or services for which the trade mark is registered). Therefore, indeed, the use can be considered as legally relevant use to acquire and/or maintain the validity of a trade mark right.

- As to whether unauthorised use in this context constitutes trade mark infringement, has not been decided in Singapore case law yet. Likely, courts will follow international practice. It has been determined in various cases especially in the United States, that linking as such does not qualify as infringing trade mark use, nor does a metatag or framing. This may not be surprising, as all these features are very much essential to the functioning of the Internet. The situation will be different only, when there is question of additional circumstances whereby there is a misleading factor of using somebody else's trade mark as part of a metatag or link to, for example, attract business to a website, or to defame the products or the trade mark owner. Same applies to framing, in particular if such is done to give the impression that the consent of somebody else's website belongs to another website, or that there is question of giving the impression of some other type of relationship with another firm whereas this in reality does not exist.

4.2 use by fan clubs or supporters;

There is no statutory law or case law available to cover this situation in Singapore. In general, any of the three use perspectives will apply to this situation.

- As to whether a trade mark right can be acquired by this type of use, or whether use qualifies to actually maintain existing trade mark rights, a formal link between the trade mark owner and the third party concerned is relevant. For the trade mark owner, in order to benefit from the use by this third party, a licence under s.42 TMA 98 needs to be made. A mere consent given to fan clubs or supporters to use the trade mark will not be sufficient: there should be a formal contract, whereby apart from general requirements under contract law, the trade mark owner is able to exercise effective quality control on the products. For a licence, it is required that the registered trade mark rights of the owner comprises the use by these third parties. For example, use of the trade mark on merchandise articles will not be supportive for acquiring or maintaining trade mark rights in relation to (other) products actually marketed by the trade mark owner and covered in his trade mark registration.

- When the trade mark owner did not authorise the use by fan clubs or supporters, an infringement could be established in two ways:

(1) When there is question of use in the course of trade, under s. 27 (2) a TMA 98 in the case of the trade mark being identical and used for identical or similar goods

covered. This may be the case when the club or supporters are actually marketing products provided with the trade mark;

- (2) When there is no question of use in the course of trade (think of use on posters, banners, et cetera that will not be marketed), the situation is a bit more complicated. Here, s. 27 (6) TMA 98 applies, saying: “Nothing in subsections (1) to (5) shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, but any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark *if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.*” (pm: italics added) So, in that case the basis for the trade mark owner to take action is quite narrow.

4.3 parody;

There is no statutory law or case law available to cover this situation in Singapore. This situation should be considered only in the context of infringing trade mark use, as use for acquiring/maintaining a trade mark right rather refers to use by or with permission of the trade mark owner himself, not by thirds. Parody will likely not occur in the course of trade. In that case, trade mark infringement can be construed under the already mentioned s. 27 (6) TMA 98.

4.4 comparative advertising.

There is no statutory law or case law available to cover this situation in Singapore specifically. Narrowly defined exceptions allowing competitive advertising as apply in for example Europe, do not exist. The situation therefore may be captured also under s. 27 TMA 98 on trade mark infringement, in particular when the sign is identical to the trade mark and used in relation to products identical to those for which the trade mark is registered. Contrary to the use in a parody-sense as referred to above, comparative advertising definitely is use practised in the course of trade, although not in order to distinguish goods of the party concerned, but rather to *refer* to goods marketed by the trade mark owner. Nevertheless, in this situation the use certainly would be “in relation to” goods identical to those of the trade mark owner and therefore qualify as trade mark infringement under s. 27 (1) TMA 98.

5. If, under the Group’s national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g unfair competition or trade practice laws).

Unfair competition or trade practice laws are not well developed here in Singapore. There are no relevant statutes enacted by the Singapore parliament in this area and thus far, there are also no cases on point.

The law of passing off may be relevant with regard to unconventional uses of trade marks.

6. If use “as a mark” in the traditional sense is required to establish infringement, are “well-known”, “famous”, “notorious” or “reputed” marks used on dissimilar goods and services protected?

Yes. Refer to s 8 (3).

A trade mark which is identical with or similar to an earlier trade mark and is to registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if

- a. the earlier trade mark is well known in Singapore;
- 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 would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
- c. there exists a likelihood of confusion on the part of the public because of such use; and
- d. the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.