

Question Q181

Conditions for registration and scope of protection of non-conventional trademarks

V. Questions:

Groups are invited to answer the following questions under their national laws.

1. *How is the scope of what constitutes a registrable trademark defined? Does that definition list specific examples of permissible types of trademark?*

The Singapore Trade Marks Act 1998 does not define what is a registrable trade mark in Singapore. Instead, the Act lists situations in which a trade mark application shall be refused. Section 7 of the Singapore Trade Marks Act 1998 states the "absolute grounds for refusal of registration" of a trade mark in Singapore and Section 8 of the Singapore Trade Marks Act states the "relative grounds for refusal of registration". Section 9 of the Act deals with the situation of raising of relative grounds in the case of honest concurrent use.

The Singapore Trade Mark Act 1998 does not contain such a list of specific examples of permissible types of trade mark.

2. *What categories of signs are capable of registration as a trademark? Are any categories of signs excluded from registrability as a trademark?*

Section 2(1) of the Singapore Trade Marks Act 1998 defines trade mark as "any visually perceptible 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."

Section 2(1) further defines a sign to include "any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof."

In relation to relative grounds for refusal of registration of a trade mark, section 2(1) defines an earlier trade mark to mean:

- "a. a registered trade mark or 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 mark; 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 entitled to protection under the Paris Convention or the TRIPS Agreement as 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."

Section 7(3) of the Singapore Trade Marks Act states that "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."

The Act therefore excludes three-dimensional signs that would be better suited to registration as either an industrial design or a patent from being registrable as trade marks.

3. Where applications to register a colour per se or a combination of colours per se may be accepted for registration:

In general, applications to register a colour per se or a combination of colour per se are considered under sections 7, 8 and 9 of the Trade Marks Act. Therefore, the application to register a colour per se or a combination of colours per se must first pass the hurdles of distinctiveness as laid down in the Act in section 7. The Act does not contain specific provisions dealing exclusively with applications to register colour marks and there are no specific exclusions of any colour per se or colour combination per se as being registrable in Singapore. However, the group wishes to respond to the questions below as follows:

3.1 in relation to goods, is such an application acceptable if it does not specify the outline, contours or proportions in which or the shape or object to which the colour is to be applied;

An application for a colour per se (as outlined) is acceptable under the Act subject to the absolute grounds for refusal of registration in section 7 and the relative grounds for refusal of registration in section 8.

3.2 is such an application registrable in relation to services and, if so, under what conditions;

An application for a colour per se (as outlined) is acceptable under the Act in relation to both goods and services, subject to the absolute grounds for refusal of registration in section 7 and the relative grounds for refusal of registration in section 8.

3.3 is an applicant required to file a sample of the colour(s) applied for and/or a colorimetric reference or other colour code;

A representation of the trade mark colour should be submitted to the Intellectual Property Office of Singapore. A colorimetric reference or other colour code may also be submitted to better define the trade mark.

3.4 can the mark be considered inherently distinctive in relation to certain goods or services;

The Intellectual Property office of Singapore (IPOS) would in practice, require substantial evidence of prior use of the colour mark before accepting the mark for registration.

3.5 *will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;*

Yes.

3.6 *are certain colours denied registration on the basis that there is a need to keep them free for general use; and*

There is no express prohibition on specific colours.

3.7 *to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*

The use of the mark should be such as to satisfy the Registrar that it is the colour per se (as opposed to other signs / words) which distinguishes the goods and services from those of other traders.

4. *Where applications to register three-dimensional signs may be accepted for registration:*

4.1 *what form of representation of the three-dimensional sign is accepted as part of the application for registration;*

Representations of the three-dimensional sign from all the relevant angles should be submitted to the IPOS for consideration as to registrability of the mark.

4.2 *what are the criteria for assessing whether the three-dimensional sign can be considered capable of distinguishing the goods or services of one undertaking from those of another;*

The governing section in the Singapore Trade Marks Act 1998 is section 7. A three-dimensional sign must not fall within any of the categories stated in section 7(1).

Section 7(1) states that 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;
- 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.

However, it is important to note section 7(2) provides that a trade mark that falls within the grounds of refusal in subsection 1(b), (c) or (d) may nevertheless be registrable if it can be shown that "before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

Apart from the usual criteria for distinctiveness, Section 7(3) of the mark specifically prohibits registration of "signs" which consist 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."

It is also important to note a three-dimensional mark shall not be registered if it is contrary to public policy or to morality or if its use is prohibited in Singapore by any written law or rule of law or if the application is made in bad faith. Refer to sections 7(4), 7(5) and 7(6).

4.3 what are the criteria for assessing whether the three-dimensional sign can be considered inherently distinctive in relation to certain goods or services;

As in 4.2

4.4 will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;

Not necessarily.

4.5 are certain shapes denied registration on the basis that there is a need to keep them free for general use;

There is no express prohibition on the registration of any specific shape as such. However, if the IPOS deems that a shape should be available for general use, the Examiner would refuse registration of the shape as a trade mark. In other words, the shape must pass the tests of distinctiveness in order to be registered.

4.6 to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark; and

Section 7(3) of the mark specifically prohibits registration of "signs" which consist 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."

Therefore, the shape of a hook which is used for hanging things may be objected to under Section 7(3)(b).

4.7 to what extent do technical or functional considerations prevent registration?

Referring to section 7(3) of the Act, if the three-dimensional mark consists exclusively the shape of goods which is necessary to obtain a technical result, this will prevent the three-dimensional mark from being registered. Please refer to 4.6 above.

5. Where applications to register smells may be accepted for registration:

5.1 what form of representation or description of the smell is accepted as part of the application for registration;

5.2 how is the capacity of the smell to function as a trademark and/or its distinctiveness assessed; and

5.3 *how is the mark made available to the public on publication of the trademark application and thereafter?*

Under the current Trade Mark Act in Singapore, olfactory marks are not registrable.

6. *Where applications to register a sound mark may be accepted for registration:*

6.1 *what form of graphical representation of the mark applied for is required as part of the application for registration;*

6.2 *can audio recordings of a sound mark be filed as part of the application for registration; and*

6.3 *if such audio recordings are filed as part of the application for registration, how are these recordings made available to the public on publication of the trademark application and thereafter?*

Under the current Trade Mark Act in Singapore, sound marks are not registrable.

7. *Where applications to register moving images or holograms may be accepted for registration:*

7.1 *what form of representation of the moving image or hologram is accepted as part of the application for registration; and*

There is no specific provision in the Trade Marks Act relating to the registration of moving images or holograms.

Although there is no express prohibition in the Act disallowing the registration of moving images or holograms, the main difficulty faced in an application to register moving images or holograms lies in the fulfillment of the definition of trade mark – “any visually perceptible 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.” The condition that the mark in question must be capable of being represented graphically is a very specific requirement in the Act.

We have discussed this with the IP Office of Singapore. The position take is that this requirement would prohibit the possibility of registering hologram and moving images marks as such.

We would suggest using the series marks provision to assist proprietors of such marks by filing an application of the separate variants of the moving image or hologram, represented as stills in a single trade mark application and claiming them as a series of marks.

However, this is an imperfect solution and may be possible only for simple hologram or moving image marks where the same image with only slight and non-material variants is shown in each still.

Series marks protection will not be available if there are material differences between the stills.

Please note that series marks “resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”.

7.2 *how is the moving image or hologram made available to the public on publication of the trademark application and thereafter?*

Not applicable to us.

8. *How is the scope of protection of "non-conventional" trademarks assessed? In particular, are registrations for "non-conventional" trademarks treated any differently than registrations for "traditional" forms of trademark either in substantive or procedural terms?*

Non-conventional trademarks, at least in the case of colours and three-dimensional marks, go through similar assessment as the other traditional trademarks in Singapore. They are not treated any differently from registrations for "traditional" forms of trade mark.

9. *To what extent is assessment of the registrability of "non-conventional" trademarks influenced by issues relating to enforcement and the scope of protection which should be afforded to those marks?*

None under our current legislation. However from our discussions with our trade mark office officials, it appears that that considerations of the uncertainty of the scope of protection and enforceability of the registration do have some effect on the assessment of the registrability of moving images and hologram marks.

10. *To what extent is the assessment of the registrability of "non-conventional" trademarks influenced by the fact that there may be a limited number of certain "non-conventional" marks (such as colours or shapes) available for general use?*

None under our current legislation.

11. *To what extent is the assessment of the registrability of "non-conventional" trademarks influenced by the fact that consumers may be less used to understanding "non-conventional" marks as an indicator of origin?*

None under our current legislation. However in practice, the applicant may be required to show that the unconventional mark in questions is indeed used as a trade mark i.e. as an indicator of origin, rather than as an embellishment on the product.

As well as stating the laws of their respective countries on the above-listed questions, Groups are invited to make any proposals for harmonisation of national laws which they consider desirable and to offer any further comments or observations of interest.