



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Representation, Examination and Acceptable Evidence of Use of Non-Traditional Trade Marks in Singapore

*IP Key SEA Conference on Trademarks
Bangkok, Thailand*

15 October 2019

Vivis Tan
Trade Mark Examiner
Registry of Trade Marks
Intellectual Property Office of Singapore

Overview

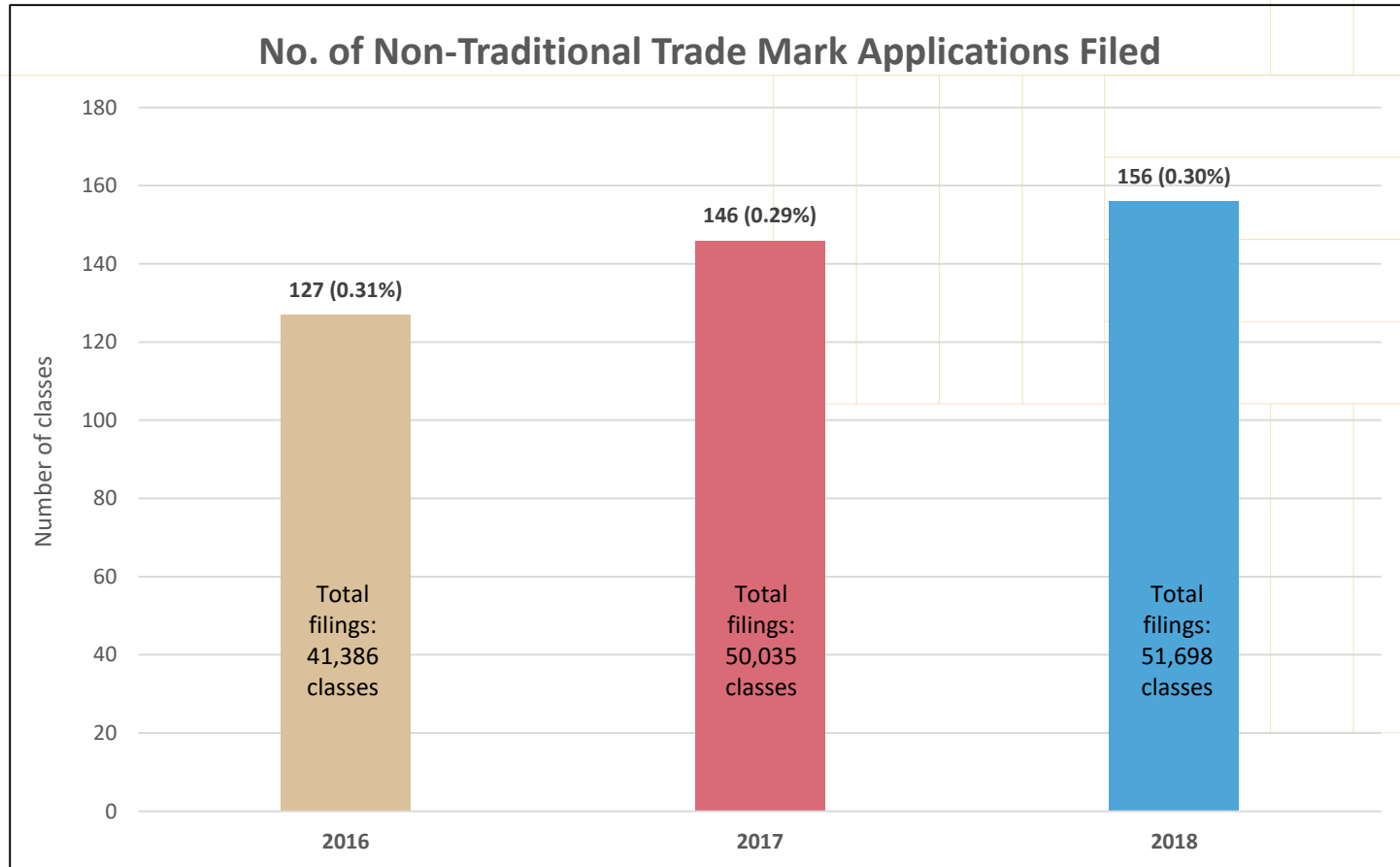
- **Statistics**
- **Examination Practices**
- **Acceptable Evidence of Use**



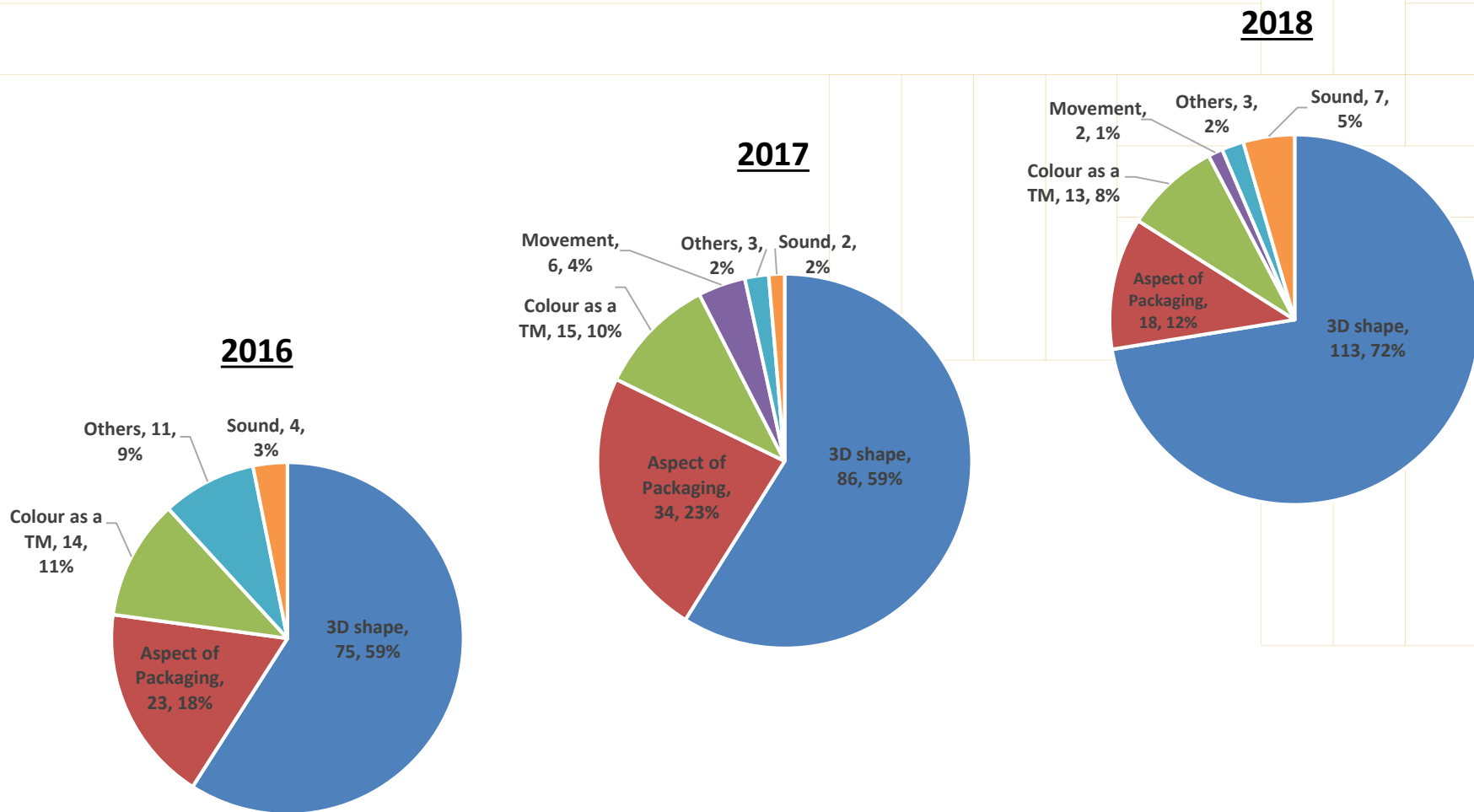
INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Statistics

Filing Trend (2016 – 2018)



Breakdown of Non-Traditional Mark Type filed





INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Examination Practices

Relevant Legislation under Singapore Trade Marks Act

Interpretation

Section 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;

Relevant Legislation under Singapore Trade Marks Rules

Representation of Trade Marks

16.—(1) The applicant shall provide **a clear and durable representation** of the mark in the space provided for that purpose in the application form.

(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.

Relevant Legislation in the Singapore Trade Marks Act

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.

Representation of Non-Traditional Trade Marks

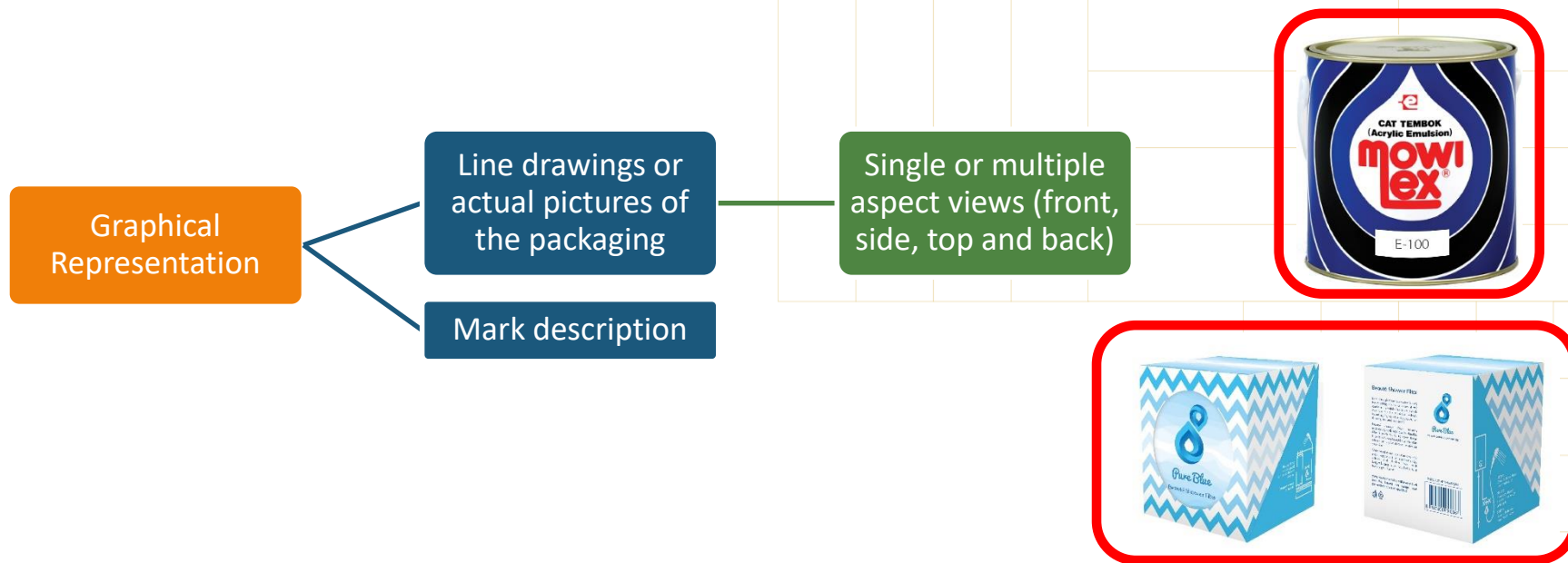
- Accept non-traditional trade marks if they can be **graphically represented** and are capable of distinguishing goods/services of one trader from another.
- Require a **clear and durable representation** of the mark.
 - ❑ To enable the public to determine the precise nature of the mark and its scope of protection, the mark representation needs to be clear:
 - May require different views of the mark to ensure that all features are seen
 - Require written description to define the graphical representation
 - Audio file is compulsory for sound marks
 - ❑ To allow future renewals of the trade mark, the mark representation must be durable.

Types of Non-Traditional Trade Marks

- Aspect of Packaging
- Colour(s) a Trade Mark
- Sound Marks
- Movement Marks
- Holograms
- Scent Marks
- 3D Shape Marks

Aspect of Packaging

“Aspect of packaging” refers to signs depicting the containers in which the goods are sold or the outer packaging which cover the containers.

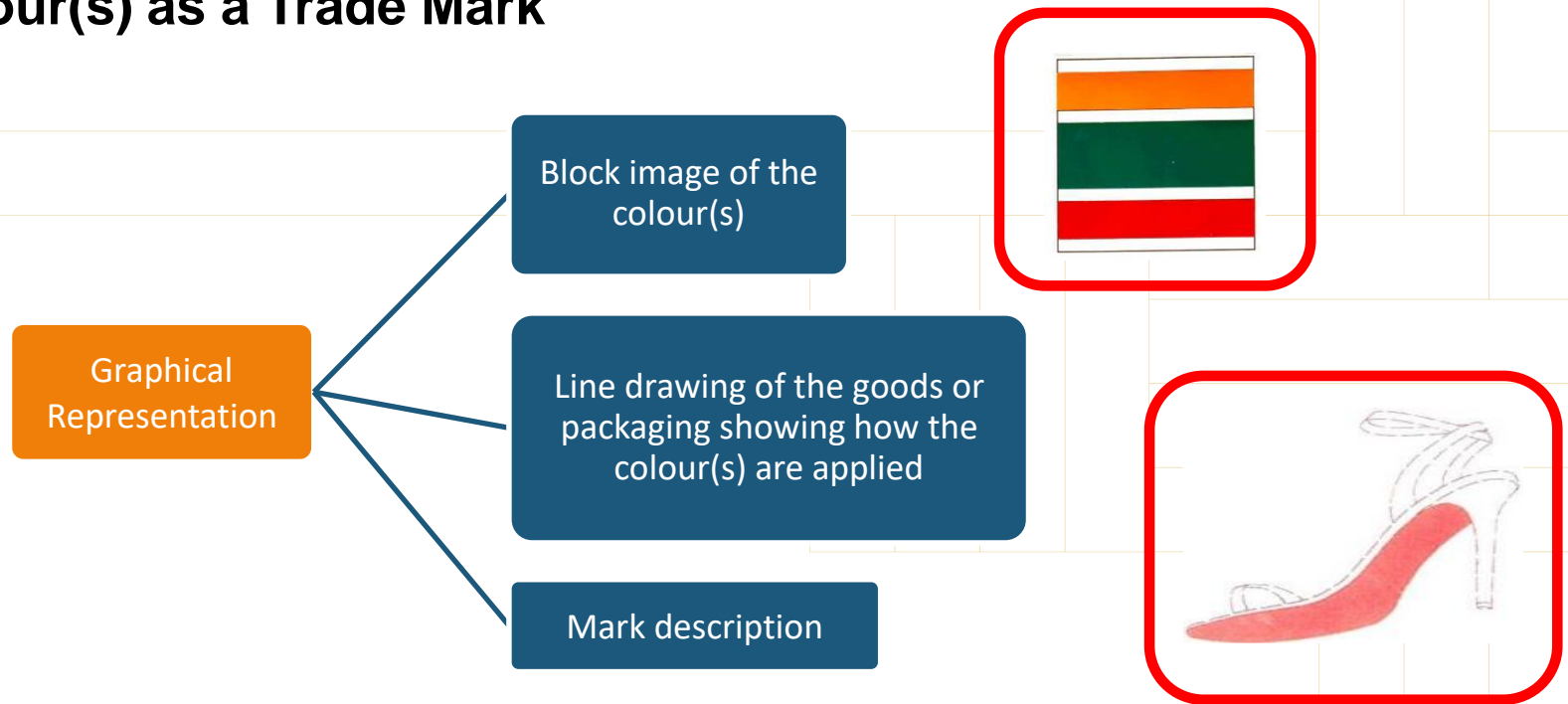


Mark Description:

The mark consists of the packaging of the goods, with the words and devices appearing thereon, as shown in the representation on the form of application.

The mark consists of a packaging which is a box in blue and white with the words "Pure Blue" and device of two water droplets appearing thereon as shown in the representation on the form of application.

Colour(s) as a Trade Mark



Mark Description:

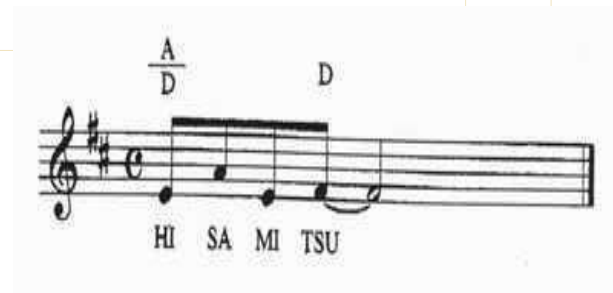
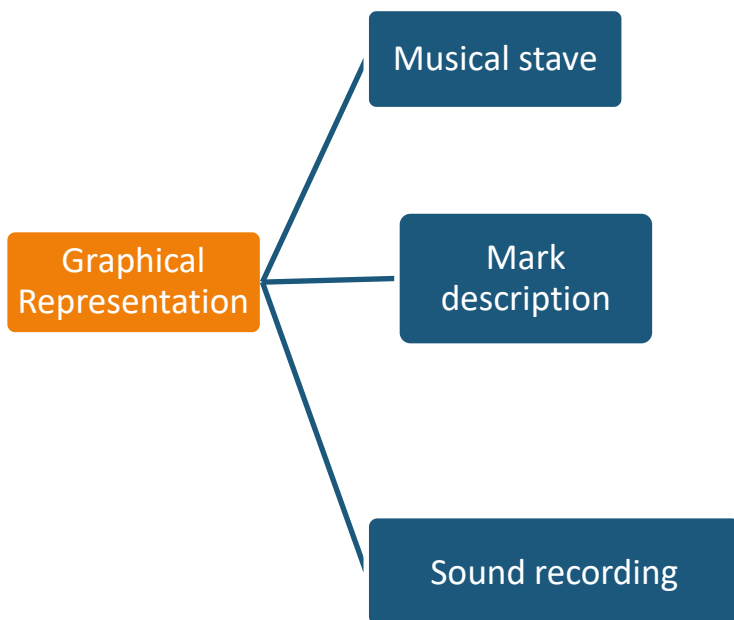
The trade mark consists of three horizontal stripes in the colours orange, green and red on a white or neutral backdrop, as shown in the representation of the trade mark on the form of application.

The mark consists of the colour red (Pantone No. 18.1663TP) applied to the sole of a shoe (the outline of the shoe is not part of the mark but is intended to show the placement of the mark) as shown in the representation on the notification of international registration.

Colour(s) as a Trade Mark

- Consumers are not accustomed to making assumptions about the origin of goods based on their colour or the colour of their packaging.
- Generally, colour marks may only be accepted on the basis of acquired distinctiveness.
 - ❑ Assess evidence of use:
 - Whether the applicant has been promoting the colour(s) as something apart from the house mark or the packaging of the goods
 - In the case of combination of colours, whether they are always used in the same manner
 - Colour(s) commonly used for the goods/services in question will not serve as a commercial origin

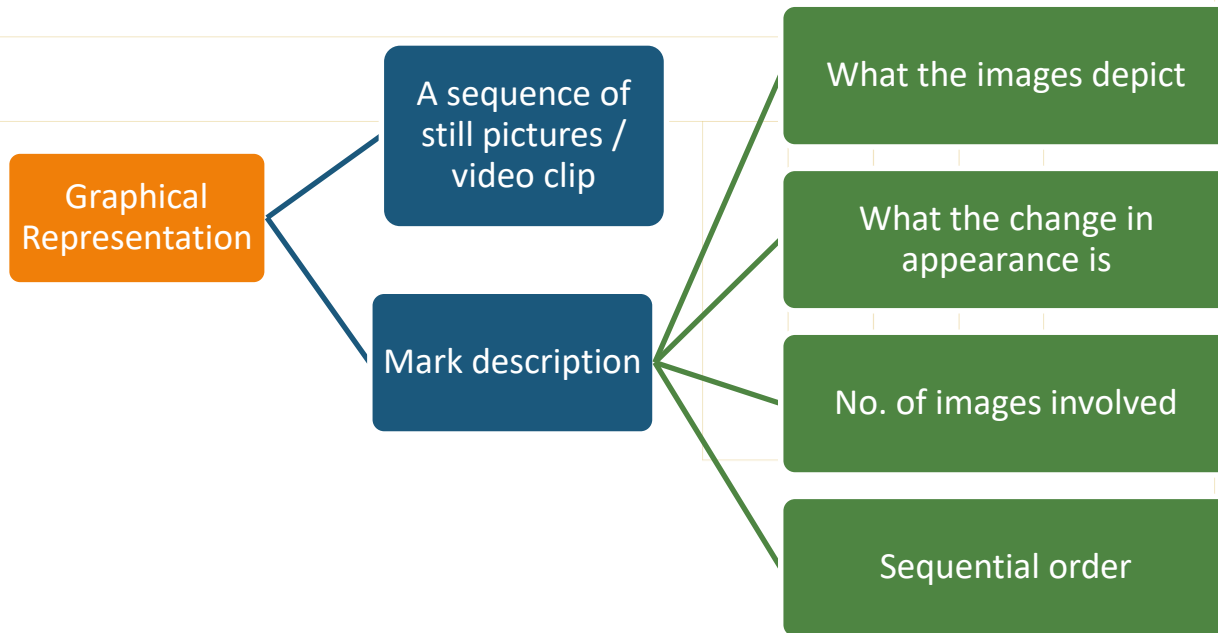
Sound Marks



Mark Description:

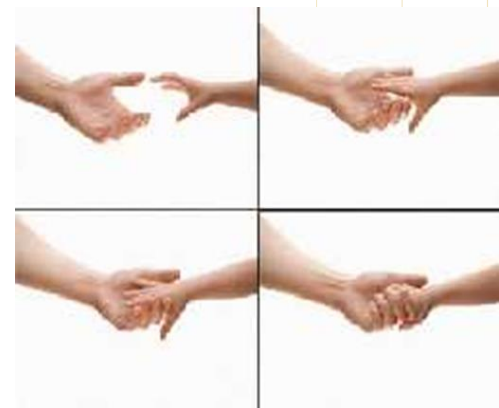
The mark consists of a sound mark in which the word "HISAMITSU" is sung over four musical tones, namely E, A, E and F sharp, in the musical notation as shown in the representation in the application form. The first three notes are eighth notes and the final note is a tied eighth note and half note.

Movement Marks

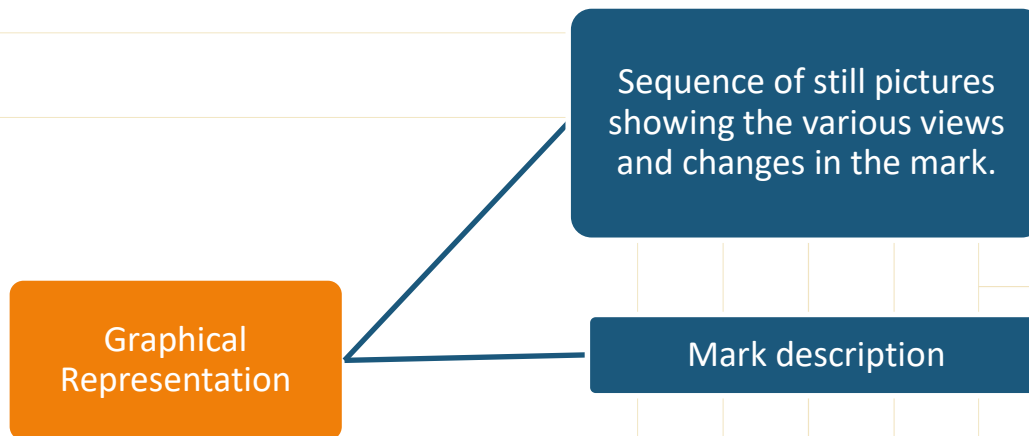


Mark Description:

The trade mark is a movement mark consisting of an animation of a man's hand and a child's hand which appear in a sequence of four images as shown in the representation on the form of application, whereby the man's hand and the child's hand converge in the positions illustrated in the top left and right figures, and the man's hand and the child's hand touch and clasp in the positions illustrated in the bottom left and right figures respectively.



Holograms

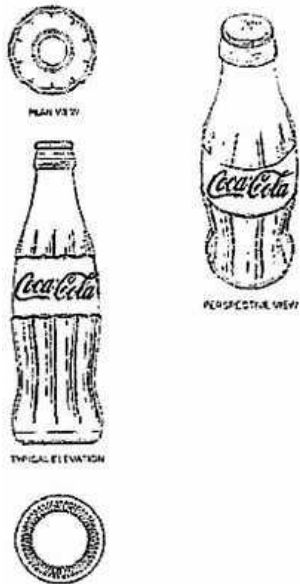
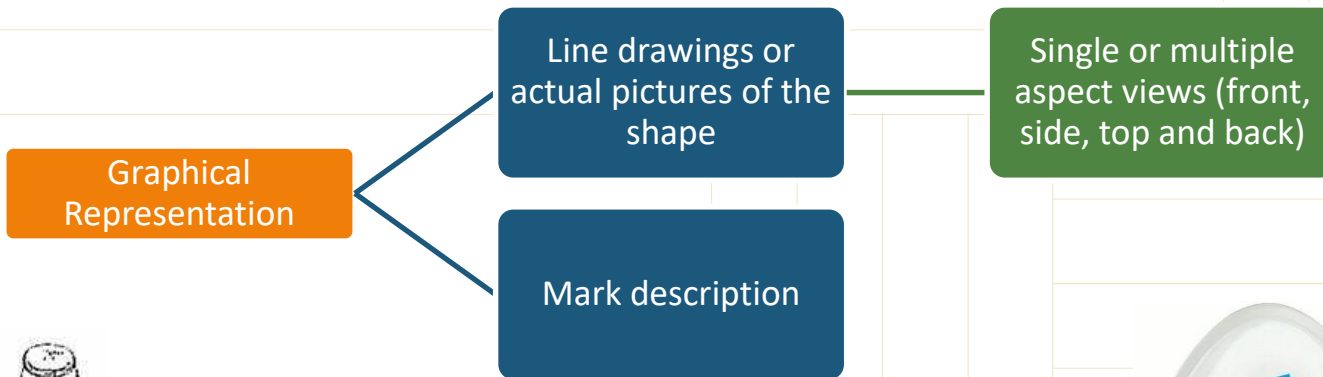


Mark Description:
The mark consists of a simple hologram.

Scent Marks

- No scent mark registered in Singapore presently, as it is difficult to have a graphical representation for scent that is stable, unambiguous and objective
- Difficulty in graphically representing scents:
 - Few people recognize a chemical formula as representation of a scent. Moreover, a chemical formula does not identify a scent, but of the substance itself
 - A written description alone is not sufficiently clear, precise and objective to represent the scent
 - A deposit of a scent sample is not sufficiently stable or durable

3D Shape Marks



Mark Description

The mark consists of a three-dimensional shape of a cubic shaped product and its packaging in silver colour, with a laughing cow device in red, white, black and blue colour appearing on one side of the cube as shown in the representation on the notification of international registration.

Relevant Legislation in the Singapore Trade Marks Act relating to 3D Shape Marks

Absolute grounds for refusal of registration

7. —(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.

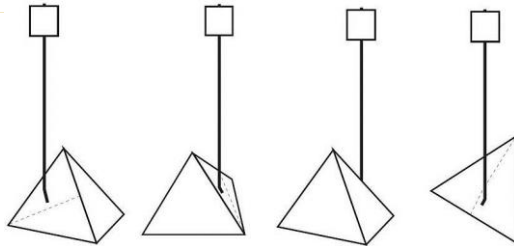
- **Objections under these grounds cannot be overcome by evidence of use**

Examination Practice for 3D Shape Marks

❑ Test of distinctiveness

- Criteria for distinctiveness are the same as for conventional marks
-
- ❑ 3D shape mark should not consist exclusively of shape that:
 - is **customary in trade**;
 - is **essential** to perform a **technical result**;
 - **adds substantial value** (eye appeal or functional effectiveness) to the goods

3D Shape Marks with possible technical functions



Mark Description:

The mark consists of a three-dimensional shape of a coffee bag as shown in the representations attached to the application.

“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.

3D Shape Marks with possible technical functions

- **Two-stage test (to determine technical result, or not)**

Stage 1: Identify the essential characteristics of the 3D shape mark

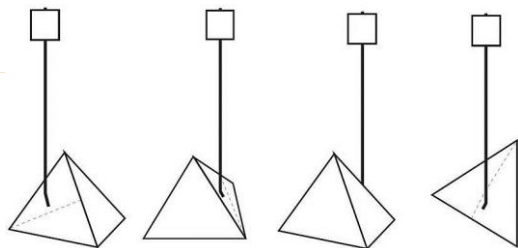
- Undertaken from the perspective of an average consumer
 - Who are the average consumers of the goods?
 - Which are the elements that have the most visual impact on average consumers



Stage 2: Whether the identified essential characteristics are necessary to obtain a technical result

For each of the essential characteristics identified, determine whether it would obtain a technical result

3D Shape Marks with possible technical functions



Mark Description:

The mark consists of a three-dimensional shape of a coffee bag as shown in the representations attached to the application.

Essential Feature(s)	Technical Result
Pyramid shaped bag	The pyramid shape lets the freshly-ground coffee move and tumble about inside the bag for a plunger quality brew.
Square paper tag and string attached to the bag	String and square tag allows the holding of the pyramid shaped bag.

Decision

- Not distinctive (section 7(1)(b))
- Shape of goods is necessary to obtain a technical result (section 7(3)(b))

Acceptable Evidence of Use to show Acquired Distinctiveness of Non-Traditional Trade Marks

Relevant Legislation in the Singapore Trade Marks Act

Absolute grounds for refusal of registration

7. —(2) A trade mark should 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.

Evidence of Use of Non-Traditional Trade Marks

- Evidence of use required to show acquired distinctiveness of NTTM are the same as that required for conventional marks
- Generally assessed in the same way as evidence of use for conventional marks
- ✓ May overcome objections under Section 7(1)(b), (c) and (d)
- ✗ Cannot overcome objections under Section 7(3)

Evidence of Use of Non-Traditional Trade Marks

Form/Nature of Evidence:

- Must be in the form of a Statutory Declaration (SD)
- Should show use of the mark in Singapore
- Evidence produced must be before the date of application
- Evidence should show use of the mark as a trade mark
- Should show use of the mark as applied for
- May also include opinion polls, surveys, statements from industry players

Evidence of Use of Non-Traditional Trade Marks

Use of the sign with other trade marks

- A sign can acquire distinctive character even if the sign is always accompanied by other trade marks
- No requirement that the sign has to be used in isolation for it to become distinctive in its own right. However, the fact that the sign has never been used solely as a badge of origin is an important factor to take into account
- Therefore whether or not the mark is used in isolation or with other marks, it must still be proven that the sign has become a badge of origin in its own right

(see Societe des Produits Nestle v Petra Foods Ltd, [2014] SGHC 252)

Evidence of Use of Non-Traditional Trade Marks

Observations in respect of 3D shape marks

- Factually challenging to determine if the average consumer would appreciate the trade mark significance of a shape without being educated that the shape is used for that purpose
- For a shape to be registrable as a trade mark, it is insufficient that the shape is unusual, new or visually distinctive but that the shape in itself must convey trade mark significance
- A shape which departs significantly from the norms and customs of the sector would not necessarily fulfil the function of indicating trade origin
- The average consumer is not in the habit of making assumptions about the origin of the products on the basis of their shape in the absence of any graphic or word element

Evidence of Use of Non-Traditional Trade Marks

Can “limping marks” (such as NTTMs) acquire distinctive character?

- “Limping marks” refer to marks which have never been used as the sole means of identifying trade origin, but have always been used alongside other trade marks
 - Possible (albeit difficult in practice) to prove that a mark has acquired distinctive character even though it has always been used in conjunction with other marks
 - No absolute rule that a mark that has only been used with other trade marks cannot also on its own distinguish the relevant goods and services
 - All depends on the evidence

(see Societe des Produits Nestle v Petra Foods Ltd, [2016] SGCA 64)

Evidence of Use of Non-Traditional Trade Marks

Acquired Distinctive Character

- This is a question of fact
- The examiner will make an overall assessment of all the relevant evidence to establish if there is acquired distinctiveness

Endorsement of clause:

If the examiner is satisfied that the evidence of use provided by the applicant has proved that the mark has acquired distinctiveness as a result of the use made of it before the date of application, the examiner shall accept the mark with the endorsement of the following clause:

- ***“Proceeding because of acquired distinctiveness through use.”***

Examples of NTTMs accepted based on Acquired Distinctiveness



Mark Description:

The mark consists of the colours yellow, red and white as applied to the exterior surface of the premises used for the provision of the goods and services, as shown in the representation on the form of application.



Mark Description:

The mark consists of the three-dimensional shape of a bottle with the devices appearing thereon as shown in the representation on the notification of international registration.



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Thank you