

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 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.

Evidence of distinctiveness acquired through 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.

Evidence of distinctiveness acquired through use

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 (*Soci t  Des Produits Nestl  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 aDualit 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

Evidence of distinctiveness acquired through use

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, 1999 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, 1999 Ed.).

1 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.

(a) to overcome Section 7(1) objections (distinctiveness)

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.

(b) to overcome Section 7(4) objections (deceptiveness)

The Registrar may have taken the view that your mark is deceptive because it may lead the public to believe that the goods/services you are offering have a particular quality when, according to the specification you have applied for, in fact they do not possess that quality.

In these circumstances, you may wish to provide evidence of long and substantial use of the mark to show that the mark has not, or will not, deceive the public. Your evidence should therefore include a statement confirming that there have been no instances of deception reported by the public. We may also require you to provide supporting declarations from retailers or suppliers.

(c) to overcome Section 8 objections (conflicting earlier marks)

We may have objected to the registration of your mark because it is identical with or similar to a mark or marks already on the register or pending registration.

However, if the applicant is able to show to the satisfaction of the Registrar that despite the citation, the Applicant possesses a reasonable level of goodwill in their mark through use of the mark in respect of the goods and services in Singapore, the Registrar may waive the citation. Such goodwill in the Applicant's mark should have arisen through use of the mark in good faith and without the proprietor of the earlier cited mark opposing such use. Such "honest concurrent use" should be extensive and noticeable such that the proprietor of the earlier mark knew or would have known of the Applicant's activities. It is difficult to state with absolute certainty the duration of use required because much will be dependant on the facts of each case, eg the intensity of the use, the relevant trading channels, and the nature of the goods and services claimed.

Please note that even if we may allow your application to proceed to publication in the Trade Marks Journal, the owner of any earlier mark still has the right to oppose the registration of your mark. He does so by instituting opposition proceedings against your application. Acceptance by the Registrar therefore does not guarantee registration. Should your application be opposed, the Registrar will inform you accordingly.

2 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.

Evidence of distinctiveness acquired through use

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.

Sample Statutory Declaration

TRADE MARKS ACT (Cap. 332, 1999 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 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”.*]

Evidence of distinctiveness acquired through use

Class : _____[goods/services] first used in the year _____
Class : _____[goods/services] first used in the year _____
Class : _____[goods/services] first used in the year _____

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]*

19..	S\$
19..	S\$
19..	S\$
19..	S\$
19..	S\$

8 There is now produced and shown to me Exhibit 'B' which consists of sales invoices showing use of the mark on the goods/services. *[The sales invoices must be dated **before** the date of your application]*

Exhibit B1 are sales invoices showing use of the mark on the goods/services in Class _____.

Exhibit B2 are sales invoices showing use of the mark on the goods/services in Class _____.

Exhibit B3 are sales invoices showing use of the mark on the goods/services in Class _____.

Evidence of distinctiveness acquired through use

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

19..	S\$
19..	S\$
19..	S\$
19..	S\$
19..	S\$

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 relating to the goods/services. *[The samples must be of those used before the date of your application]*

Exhibit C1 are samples of promotional material relating to the goods/services in Class _____.

Exhibit C2 are samples of promotional material relating to the goods/services in Class _____.

Exhibit C3 are samples of promotional material relating to 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 2000 (Cap 211, 2001 Ed.), 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 empowered to administer oaths]

[Status of person empowered to administer oaths]