

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 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. This is because of the principles laid down by the ECJ in the case of *Procter & Gamble Company v OHIM (Case C-383/99P)* in relation to BABY-DRY for babies’ nappies. Singapore’s laws in relation to absolute grounds of refusal for the registration of trade marks are similar to the EC Council Regulation No. 40/94 on community trade marks. In that case, the ECJ held that whether a trade mark is descriptive or not should be assessed in relation to the trade mark as a whole. The Court noted that,

“As regards trade marks composed of words, such as the mark at issue (there – the mark being “BABY-DRY”), descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common practice of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

“whilst each of the two words in combination may form part of expressions used in everyday speech to designate the function of babies’ nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies’ nappies or for describing their essential characteristics.”

On this basis, the ECJ held that the word combination “BABY-DRY” was not descriptive.

(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 – see the recent case of *Deutsche Post EURO EXPRESS GmbH v OHIM (Case T-334/03, January 2005)*. In that case, the mark EUROPREMIUM covering packaging materials in class 16, goods of wood and cork in class 20, advertising and various business services in class 35 and postal services in class 39 was sought to be registered. The Board of Appeal held that the prefix 'euro' would be understood as a reference to the adjective 'European' and 'premium' means in English 'of high quality'. Thus, the composite word created gives the impression in the consumers' mind that the trader is dealing with quality goods and services coming from Europe. But when referred to the European Court of First Instance (CFI), the CFI did not share the same view as the Board of Appeal. The CFI pointed out that in determining whether a mark is wholly descriptive, one must first decide what the essential characteristics of the goods/services in question are. The CFI felt that although the word 'euro' may well allude to a geographical characteristic, there was no reason why geographical origin was an essential characteristic of postal services, packaging or goods made of cork.

Further, the CFI was of the view that the word “premium” in the meaning adopted by the Board of Appeal is merely a laudatory term evoking a characteristic that the applicant seeks to attribute to its own goods, yet without informing consumers of the specific and objective characteristics of the goods and services offered. The word “premium” cannot therefore serve to designate the type of goods/services in question, either directly or by reference to their essential characteristics. In the result, the mark EUROPREMIUM was therefore not composed of elements descriptive of the goods/services in question and registration could not therefore be refused on the ground that the mark consists exclusively of descriptive elements.

The CFI was influenced by the earlier decision in *Dart Industries Inc. v OHIM (Case T-360/00)* for ULTRAPLUS in which it held that a term flattering in nature, such as “UltraPlus”, was, however, not descriptive of the goods at issue, in that case plastic ovenware, since it did not permit the consumer to immediately and without further reflection to make a definite and direct association with the goods in question.

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.

This decision is in line with the decision on *Bank für Arbeit und Wirtschaft AG v OHIM (Case T-87/00)* for EASYBANK in relation to financial and banking services, taken by the European Court of First Instance which held that,

“the word easy is merely a general laudatory term of current language. It arouses associations of ideas, contains an element of subjective assessment and is devoid of all specificity. Combined with bank and relating more particularly to an on-line bank, the word easy is intended to give the potential clientele the agreeable general impression that the on-line bank in question is accessible without difficulty or effort.” But, *“the term in question does not, for example give information as to how, once access is obtained, transactions such as an application for credit, the cashing of a cheque....will be handled, or in particular, as to the result, whether positive or negative, of such an on-line transaction for the potential customer.”*

(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.