



TRADE MARKS

infopack



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

TRADE MARKS

infopack



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The information provided in this infopack is meant as a guide only and does not amount to legal advice. Please seek independent professional advice before acting on any matter contained in this infopack.

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OFFICE OF SINGAPORE

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INTRODUCTION AND FUNDAMENTALS

Intellectual Property (IP) refers to the product of your mind or intellect. IP can be an invention or innovation, special names and images used in trade, original designs or an expression of an idea. In Singapore, laws exist to protect such IP. This may be through a registration process such as patent grants for inventions, trade mark registration for signs used in trade, industrial design registration for designs applied to articles and grants of protection for plant varieties. Other forms of IP, that need not be registered, but may be protected nonetheless, include copyright, geographical indications, layout-designs of integrated circuits, confidential information and trade secrets.

Introduction

A Trade Mark is a sign used by a person in the course of business or trade to distinguish his goods or services from those of other traders.

Registering a trade mark gives the owner rights to enable him to control the use of the sign. A registered trade mark has to be capable of being represented graphically. This sign can be any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or a combination of these.

Rights Conferred by a Registered Trade Mark

The rights conferred by a registered trade mark extend throughout Singapore. It confers on the owner the right to prevent others from using in Singapore as a trade mark, a mark similar to the mark registered, in relation to the same or similar goods or services in Singapore, without the owner's permission. The registered trade mark can last indefinitely, subject to renewal every 10 years. A registered trade mark is a form of property; it can be licensed or assigned.

Other Marks

Certification Mark

A certification mark is a sign used to distinguish goods or services certified by the mark owner from other non-certified goods or services. In relation to the certified goods or services, the certification may relate to a characteristic, such as an indication of the origin, material, mode of manufacture of the goods, or performances of services, quality, accuracy or other characteristics.

Unlike trade marks, certification marks are not applied by those who trade in the goods or services but by the one who certifies the particular characteristics of the goods or services.

Collective Mark

A collective mark is a sign used to distinguish the goods or services offered by members of an association or group of traders from goods or services of those who are non-members of the association. An association can file for the registration of a collective mark. Once registered, members of the association are allowed to use the collective mark. A collective mark represents membership of the provider of goods or services to a particular association.

Marks used by Government Agencies (Rule 13)

IPOS maintains a separate database for logos and other devices of government bodies, statutory boards or institutions that may not qualify as trade marks either because they are not used or proposed to be used in the course of trade or no goods or services are provided. When a logo in this database is identical or similar to a trade mark sought to be registered, IPOS will request that the applicant seek the consent of the relevant government body or institution that has an interest in the logo.

Legislation Governing Trade Marks

The Trade Marks Act (2005 Revised Ed) (Cap. 332), together with its subsidiary legislation which consists of the Trade Marks Rules and Trade Marks (International Registration) Rules, form the legislation governing the registration of trade marks in Singapore.

- >> View the Trade Marks Act (Cap. 332) online at <http://statutes.agc.gov.sg> and the IPOS website <http://www.ipos.gov.sg> (Legislation).
- >> Copies of the legislation are available at <http://www.snpcorp.com/webshop> or SNP Corporation Ltd at 1 Kim Seng Promenade, Great World City East Tower, #18-01 Singapore 237994, Tel (65) 6826 9691.

Benefits of Trade Mark Registration

Although it is not compulsory to register a trade mark in order to use it, a trade mark registration adds great value to a business. By filing for trade mark registration, the trade mark owner obtains a right to ownership and the right to prevent others from using a similar mark without his permission.

- >> Please refer to "Not Registering a Trade Mark" on page 4 for more information on the common law action of "passing off" for trade mark protection.

The owner of the registered trade mark can exploit his mark in many ways. He may use it to better protect his market share (i.e. his profits) by barring others from copying it; he may license it to third parties for commercial returns (e.g. through a franchise); he may sell the mark outright for a specified value (e.g. in a company acquisition); or he may use the mark to raise equity for his business undertakings.

When to File

Unlike patents or registered designs, trade marks that are already in use may still be registered. There is no time limit as to when the owner may apply for a registration.

Although there is no time limit for filing, it should be noted that a suit for an infringement of a registered trade mark is only possible if the trade mark is registered. A trade mark registration takes effect from the date of filing.

Priority Claim

Singapore, like many countries, allows priority claims in trade mark applications. If an applicant has a corresponding application filed earlier in a Paris Convention country or a World Trade Organization member country (other than Singapore), he may claim priority from this first-filed application, provided the Singapore registration is filed within six months from the date of the first filing. When a priority is claimed, the filing date in Singapore dates back to the date of the first filing. Similarly, an application which is first filed in Singapore can be used to claim priority in a corresponding application filed in a Paris Convention country or a World Trade Organization member country, provided that the corresponding application is filed within six months from the date of the first-filed Singapore application.

- >> The corresponding application is a separate application filed outside Singapore for the same trade mark.

Registrable Marks

A trade mark can be letters, words, names, signatures, numerals, devices, brands, labels, tickets, shapes, colours, aspects of packaging or any combination of these. For a trade mark to be registered, it must be distinctive and capable of distinguishing the goods and/or services of the owner from similar goods and/or services of other traders.

Here are some examples:

Based on invented words -



Based on device, a combination of alphabet(s), or word(s) with picture -



1 - INTRODUCTION AND FUNDAMENTALS

Unregistrable Marks

The following are some common examples of the marks that cannot be registered under the trade mark law in Singapore:

Descriptive Marks:

Marks that describe the goods and services of the business. For instance, marks that describe the quality ('Super' or 'Best'), quantity ('One dozen'), value ('Cheap'), intended purpose ('Cleaner'), or geographical origin.

Marks 'Common to the Trade':

Marks that are signs or indications that are or have become customary in the trade. Some marks have become so well accepted that the term is used to describe the type of the goods or services in general, and no longer serves to distinguish the products offered. An example of a trade mark that has become customary in the industry is "escalator".

Marks Contrary to: Public Policy or

Marks that are generally contrary to public policy or morality. For example, a mark that could promote immoral behaviour cannot be registered.

Deceptive Marks:

Marks that attempt to deceive the public. For example, marks that misrepresent the nature, quality or geographical origin of the goods or services.

Marks that are Identical to: Earlier Marks

A trade mark will not be registered if it is identical with an earlier mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier mark is protected.

Marks that Could: Cause Confusion

A trade mark may not be registered if it is likely to cause the public to be confused under these circumstances:

- it is identical with an earlier mark and is to be registered for goods or services similar to those for which the earlier mark is protected;
- it is similar to an earlier trade mark and is to be registered for goods or services identical with those for which the earlier mark is protected; or
- it is similar to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.

Marks that are Identical: /Similar to Well Known Mark

A trade mark may not be registered if it is identical or similar to an earlier mark that is well known in Singapore. Please refer to page 6 on Well Known Marks.

>> IPOS provides public access to its records of trade mark applications and trade marks registered in Singapore. Any member of the public may access these records at the Public Search Area at IPOS or via eTrademarks at the IPOS website www.ipos.gov.sg

In general, trade marks that do not have a distinctive character cannot be registered. However, there may be exceptions where the company has built up its branding to such an extent that the mark is associated with the company, even though the mark in itself was not distinctive. For such cases, the mark may still be registered on the basis of substantial use resulting in the mark acquiring a distinctive character. "Sharp" (for televisions) and "Digital" (for computers) are examples of such marks.

Classification of Goods and Services

The scope of a trade mark registration is determined by the goods or services in relation to which the trade mark is registered. For the purpose of trade mark registration, Singapore uses the International Classification of Goods and Services as prescribed by the Nice Agreement to classify trade mark registrations. The Nice Agreement is an international agreement on classification of goods and services to which Singapore is a party. This classification sets out the list of goods and services for which the applicant may wish to register for in relation to his trade mark. The list groups these goods and services into classes in which these goods and services belong. There are a total of 34 classes of goods and 11 classes of services (page 17).

>> The Nice Classification is a tool for the classification of goods and services for the purposes of the registration of marks. It is used in more than 140 countries worldwide and in international applications for the registration of marks under the Madrid Agreement and Protocol.

Trade Mark Information Search

Before registering a trade mark, it is advisable to first conduct a search of the existing trade marks to ensure its registrability. There are resources available to help search for existing trade marks.

accessible via the IPOS website www.ipos.gov.sg, is a one-stop website to facilitate online trade mark searches and online filing of trade mark applications and related transactions in Singapore.

The eTradeMarks Search Terminals

available at IPOS' Public Search Area allow the public to access IPOS' records of trade mark applications and trade marks registered in Singapore. The relevant usage and printing fees will apply.

SurfIP (www.surfip.gov.sg)

is a One-stop First-stop IP portal which performs simultaneous worldwide searches on patents, trade marks and industrial designs databases. It introduces the Mine, Manage and Maximise approach to help businesses realise the full potential of their intellectual assets.

Note: These tools and resources provide non-exhaustive searches. Applicants are advised to check the databases of other countries for trade marks registered in the respective countries.

Identifying a Registered Trade Mark

® and ™ are common symbols associated with trade marks. ® indicates that the mark is a registered trade mark and hence protected under the trade mark law. ™ is just a symbol used to indicate that the mark is used by the company as a trade mark. It does not denote that the mark is registered nor protected under the trade mark law.

Not Registering a Trade Mark

It is not compulsory to register a trade mark in Singapore. An individual, firm or company, who owns a trade mark and uses it in connection with his goods or services, acquires common law rights in that mark by virtue of the use and reputation of the mark.

>> Common law generally refers to the law based on past decisions and general principles, serving as precedent or is applied to situations not covered by statutes.

For a mark that is not registered, the owner can only rely on the common law action of "passing off" to protect his mark against imitation or infringement. This remedy, however, requires the owner of the mark to prove his reputation and goodwill. The requirement of proving reputation and goodwill may pose some problems where the business, or the use of the trade mark, has not been established for a substantial period of time.

A registered trade mark, on the other hand, grants the owner of the trade mark a statutory monopoly. If someone else uses the same or a similar mark on the same or similar goods or services in respect of which the mark is registered, the registered trade mark owner can rely on his registration as proof of his right to the mark and sue for infringement.

Entitlement to a Trade Mark

An individual, firm or company claiming to be the owner of a trade mark can file for a trade mark registration as long as they are using or intend to use the mark in the course of their business. There are no restrictions or discrimination as to nationality or residency. However, an applicant who is not a resident in Singapore must provide the Registry of Trade Marks with an address for service in Singapore to which all correspondences will be sent.

Term and Renewals

The registration of a trade mark is valid for 10 years from the date of application. Protection can last indefinitely subject to the payment of renewal fees every 10 years, and with proper use of the mark.

Proper and Continuous Use

The owner of the registered trade mark should use his mark properly and continuously. He should display the trade mark in every medium in which he uses to protect his brand or corporate logo. For example, displaying the mark prominently in packaging, labels, websites, advertisements, press releases, trade shows, business documents and the like.

Furthermore, the trade mark owner should be vigilant to ensure that the trade mark is used in its proper context. For example, he should not use a trade mark to describe the product itself, e.g. use "a XYZ copier" instead of "a XYZ" and "make two copies on a XYZ copier" instead of "XYZ two copies".

Such good practices may prevent a successful claim by an infringing party (defendant) that the mark has become a "generic" word and thus rendered unenforceable under the law. There are numerous examples of valuable trade mark names that have become common in the trade in this way (e.g. escalator). 'Genericide' occurs when a trade mark, previously used by an individual manufacturer for his products, becomes a description of the product itself.

Whenever and wherever possible, a registered trade mark should be actively applied to reinforce the trade mark identity with its associated type(s) of goods or services. Sufficient effort must be put in to prevent misuse or infringement of the registered trade mark.

If an infringing party uses a registered mark continuously for five years without being stopped by the trade mark owner, it may be deemed that the owner has consented to such a use. Therefore, if an infringement proceeding against the infringing party takes place after five years, the infringing party may defend himself on the basis of lack of action or protest by the trade mark owner.

If a registered trade mark has not been used consecutively for five years, there is a risk of the trade mark being removed from the Register. Any interested party can apply to the Registry of Trade Marks to have an inactive registered trade mark removed by showing proof of non-use (see "Revocation" on page 14).

Infringement of Registered Trade Mark Rights

Infringement occurs when a registered trade mark is used in the course of trade without the consent of the trade mark owner.

An infringement may come about through the use of

- an identical mark on identical goods or services; or
- an identical mark on similar goods or services, or a similar mark on identical/similar goods or services resulting in confusion on the part of the public.

The use of a sign similar to a registered trade mark which is well known in Singapore on goods or services that are dissimilar to the registered well known mark may also constitute an infringement if there exists a likelihood of confusion, an indication of connection, and possible damage to the interests of the owner.

Well Known Marks

Well known marks are offered greater scope of protection. Even if they are not registered in Singapore, the owner of the well known trade mark may take action against the use of a trade mark/ business identifier under the following circumstances:

1. The use of the trade mark/business identifier would indicate a connection between those goods or services and the owner of the well known trade mark, and is likely to damage the interests of the owner of the well known trade mark.
 2. If the trade mark is well known to the public at large in Singapore, where the use of the trade mark/business identifier would:
 - cause dilution in an unfair manner of the distinctive character of the well known trade mark; or
 - take unfair advantage of the distinctive character of the well known trade mark.
- >> Dilution means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether (a) there is any competition between the owner of the trade mark and any other party; or (b) there is any likelihood of confusion on the part of the public.
- >> Business identifier means any sign capable of being represented graphically which is used to identify any business.
- >> A number of factors that may be considered in determining whether a mark is well known in Singapore such as:
- the degree of knowledge/recognition by the relevant sector of the public in Singapore;
 - the duration, extent and geographical area of the use or promotion of the mark;
 - any registration/application for registration in any country;
 - any successful enforcement of the mark in any country;
 - any value associated with the mark.

Generally, if a mark is well known to a relevant sector of the public in Singapore, it can be considered well known in Singapore. This "relevant sector" may include actual/potential customers of the goods/services, those involved in the distribution of goods/services or businesses dealing in the goods/services.

Enforcement of Registered Trade Mark Rights

Once an infringement of a registered trade mark is established, the owner can enforce his rights as conferred by the Trade Marks Act. He can take legal action against the infringing party by seeking relief in the form of an injunction and either demanding for the profits gained by the infringing party at his expense or seeking damages for the loss suffered.

When awarding damages, the Court may also award on account of profits attributable to the infringement that have not been taken into account in computing the damages.

In an infringement action involving the use of a counterfeit trade mark in relation to goods or services, the owner of the registered trade mark has an additional alternative remedy of statutory damages.

>> A counterfeit trade mark is any sign that is identical with or so similar to the registered trade mark as to be calculated to deceive and is applied to goods or services without the consent of the owner to falsely represent the goods or services to be the genuine goods or services of the owner of the registered trade mark.

Making False Representation – A Criminal Offence

It is a criminal offence to falsely represent a trade mark as registered when it is not registered or if it is pending registration, or make a false representation as to the goods or services for which a trade mark is registered.

Trade Marks and Internet Domain Names

The Internet has become an important marketing channel and trading platform for products and services in recent years.

As marketers continue to exploit their registered trade marks on the Internet, domain names have inevitably become part of their invaluable brand assets.

In practice, domain names are registered on a first-come-first-served basis. If a trade mark has the potential of becoming valuable, the unscrupulous may decide to register the domain name using the trade mark name and later offer it to the trade mark owner in exchange for a huge sum of money. To avoid being victims of these so-called 'cybersquatters', a registered trade mark owner should register his domain name before anyone else does.

>> A domain name is an electronic address that identifies a location on the Internet, somewhat like street names in cities, e.g. the domain name of Intellectual Property Office of Singapore (acronym IPOS) is www.ipos.gov.sg.

In Singapore, local domain names (those with the extension ".sg") are assigned by the Registrars accredited by the Singapore Network Information Centre (SGNIC) www.nic.net.sg. On request and upon payment of a fee, the Registrar will assign your company a domain name. As the registration is administered on a first-come-first-served basis, it may be possible that someone else would have registered the domain name before you.

Filing the Application

The applicant may file the application form and pay the prescribed fee electronically via eTradeMarks, accessible from the IPOS website www.ipos.gov.sg, or directly to the Intellectual Property Office of Singapore.

The applicant needs to furnish the following information to obtain a filing date: (1) a statement that a request for registration is sought, (2) name and address of the applicant, (3) a clear graphical representation of the mark, (4) a list of goods and services sought for registration, classified according to the International Classification of Goods and Services, (5) a declaration of use/intent to use the trade mark, and (6) the prescribed fee. From 2nd July 2007, the applicant may file for registration in one application in respect of several classes of goods or services. When several classes of goods or services are filed in one application, the application leads to only one registration.

The application will be processed when the above particulars are furnished in the prescribed form.

- For marks comprising of a three-dimensional shape of the goods or packaging, the representation may be represented by line drawings. If a single-view line drawing is insufficient, multiple aspect views but up to a maximum of six views should be provided.
- For marks with non-English words and/or non-Roman characters, the English translation and/or transliteration (i.e. pronunciation) must be given in the application.
- >> Before filing an application for the registration of a trade mark in Singapore, it is advisable to first conduct a search of the existing trade marks in the records maintained by the Registry of Trade Marks. This is to ensure that there is no prior trade mark that is identical or similar to the one you intend to use, particularly in the area of your business. The search can be conducted at the IPOS Public Search Area or via eTradeMarks at the IPOS website www.ipos.gov.sg.
- >> In Singapore, the application process for the registration of collective marks and certification marks is similar to the trade mark process. However, the applications must be accompanied by a set of Regulations governing the use of the collective and certification marks within nine months from the date of filing the application. Please refer to the requirements in the First and Second Schedules of the Trade Marks Act (Cap. 332, 2005 Ed.) for the requirements for the registration of collective marks and certification marks. The marks are published in the Trade Marks Journal in a separate section titled "Collective and Certification Marks Applications Published for Opposition Purposes" for opposition purposes before protection is granted.

Priority Claim

If the applicant wishes to claim priority, the claim has to be made at the point of filing the application. It is possible to claim priority from more than one priority application, or for some but not all the goods or services in the priority application. Priority documents and translations (if applicable) will only need to be furnished if it is requested for by the Registry of Trade Marks.

Address for Service

An address for service in Singapore must be provided in all trade mark applications. This is the address to which all correspondences from the Registry of Trade Marks will be sent. Where there is a change in the address for service, the applicant has to notify the Registry of Trade Marks by filing the relevant form with the prescribed fee.

Estimated Processing Time

The application should be processed and examined within one to two months of the filing date, and we will inform the Applicant in writing if the application is in order for acceptance and publication, or if there are objections affecting the application.

Forms and Fees

A list of the forms and fees pertaining to trade marks is enclosed at the back of this infopack. All forms are available at the Registry of Trade Marks and are downloadable from the IPOS website www.ipos.gov.sg (Forms and Fees>Trade Marks).

eTradeMarks

eTrade Marks, accessible at the IPOS website www.ipos.gov.sg, is a one-stop solution to facilitate online trade mark searches and online filing of trade mark applications and related transactions in Singapore.

eTradeMarks services include

1. Search of the trade marks database for:
 - similar trade marks; and
 - other information on trade marks such as image of the trade mark, owner details and goods and services claimed.
2. Online filing of:
 - application for the registration of a trade mark;
 - application for the registration of a collective mark or certification mark;
 - request to appoint or change an agent or to enter or change an address for service;
 - change of name or other particulars of applicant/proprietor;
 - application to register a change of ownership;
 - request to change details of an application;
 - request for an extension of time to respond to the Registrar's written notice in relation to:
 - the application for registration,
 - the application for renewal or restoration of a removed trade mark, and
 - the application to register an assignment, or licence or grant of any security interest; and
 - renewal of trade mark registration.

For an updated list of services offered by eTradeMarks, please visit the IPOS website www.ipos.gov.sg.

Application Submission

The application may be sent to the Registry of Trade Marks by hand, mailed to the address below or electronically filed using eTradeMarks, available at the IPOS website www.ipos.gov.sg.

Address: Registrar of Trade Marks
Registry of Trade Marks
Intellectual Property Office of Singapore
51 Bras Basah Road
#04-01 Manulife Centre
Singapore 189554

Business Hours: Monday to Friday: 8:30am to 5:30pm
Saturday, Sunday and Public Holiday: CLOSED

Payment Hours: Monday to Friday: 8:30am to 5:00pm

Payment can be made by NETS, cashcard, GIRO, cheques (crossed), money order and bank draft (in Singapore dollars) made out to Intellectual Property Office of Singapore.

For submission by mail, the application form must be completed and duly signed, and be accompanied with all the required documents as well as payment in the form of a cheque/money order/bank draft/the request for GIRO payment.

Customer Enquiry Hotline : (65) 6339 8616
Fax : (65) 6339 0252
Email : ipos_enquiry@ipos.gov.sg

Process After Submission

Formalities Examination

The Registry of Trade Marks would conduct a formalities examination upon receipt of the application and fees. This entails a check that the application contains the minimum required information and the fee paid, whereupon a trade mark number and a filing date will be allocated. The application is also checked if it is made in the prescribed form and that the classification of goods and services has been indicated.

Search

After the application has passed the formalities examination, the Trade Mark Examiners in the Registry of Trade Marks will conduct a search to see if the mark applied for looks or sounds the same as any other trade mark which is already registered or has already been applied for by someone else for the same or similar goods or services. The examiners will also search to see if the mark consists of or contains a geographical name. In the case of pharmaceutical products, the Registry of Trade Marks will also need to check whether the mark consists of a protected International Non-Proprietary Name (INN). The INNs, furnished by the World Health Organization, are generic names for specific pharmaceutical substances. All of the above may give rise to grounds for objections raised against the trade mark application.

In addition, the specification of goods or services will be checked to ensure that it conforms to the International Classification of Goods and Services. A wrong classification will result in the application being rejected by the Registrar and a fresh application may have to be filed. From the applicant's perspective, a wrong classification may result in the applicant's mark not being asserted in priority vis-à-vis later applications.

Examination

After the searches have been conducted, the application will be examined to determine whether the mark is registrable in accordance with the law. The examiner will check to ensure that the mark does not fall into the areas not allowed by law, for example, marks that are devoid of any distinctive character.

If the examiners have any objections to the mark, they will inform the applicant of their objections, and grant the applicant a specified period of time in which to overcome the objection. The applicant may also request for an extension of time in which to answer such objections.

Publication

Once the objections have been overcome, or if there are no objections, the applicant will be informed of the acceptance of the application for registration and the acceptance will be published for public information in the Trade Marks Journal. Any interested party may oppose the registration of the mark within two months of the publication.

>> The latest Trade Marks Journal may be downloaded from eTrademarks available at the IPOS website www.ipos.gov.sg.

Opposition

Opposition is the process whereby members of the public, or any interested third party may object to the grant of a trade mark registration if they have valid grounds for doing so. The grounds of opposition may include reasons such as the application is similar to a registered or pending mark, and so forth.

Once a notice of opposition is received, the applicant must respond with a counter-statement to respond to the opposition. Both the applicant and opponent must supply evidence to support their respective cases. The parties will then appear before a Registrar of the Hearings and Mediation Division, whereupon a decision on the application will be made after hearing both parties.

After the hearing, the Registrar will give the grounds of decision based on the information and evidence presented by both parties.

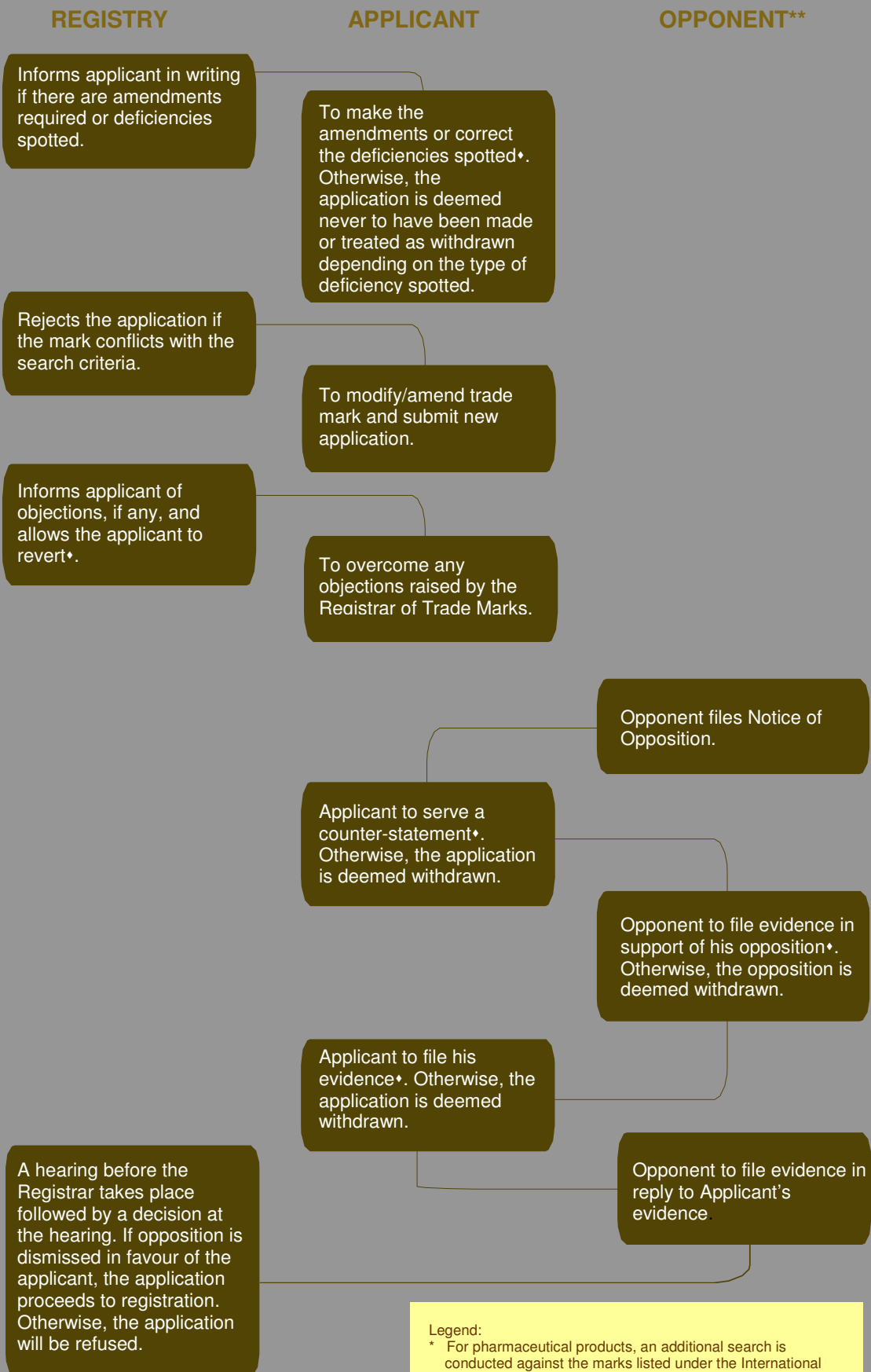
>> Summaries of the recent hearing decisions are available at the IPOS website www.ipos.gov.sg (Resources>Legal Decisions).

Registration

If the opposition to the registration is resolved in favour of the applicant, or if there are no opposition, the trade mark will be registered and a registration certificate will be issued.

Flowchart of a Trade Mark Application





Legend:
 * For pharmaceutical products, an additional search is conducted against the marks listed under the International Non-proprietary Names for Pharmaceutical Substances maintained by the World Health Organization.
 ** Any interested party.
 ♦ Within a permitted time limit.

After Registration

Term and Renewals

The registration of a trade mark is valid for 10 years from the date of application. Protection can last indefinitely subject to the payment of renewal fees every 10 years, and with proper use of the mark.

Rectification or Correction of any Error

Any interested party may apply to rectify or amend an error in the Register.

Revocation

The registration of a trade mark may be revoked on any of the following grounds:

- without valid reasons, the owner of the registered mark has not commenced use of the mark within a period of five years after the completion of the registration procedure;
- without valid reasons, the use of the mark was suspended for an uninterrupted period of five years;
- due to the owner's act or inactivity, the mark has become a common name in the trade for the goods or services which it is registered; and/or
- the manner in which the mark was used would mislead the public, particularly as to the nature, quality or geographical origin of the goods or services applied for.

Invalidation

The registration of a trade mark may be declared invalid on the following grounds that:

- it is in breach of the basic requirements of a trade mark registration as specified in the Trade Marks Act;
- it is in conflict with an earlier mark;
- there is fraud in the registration; and/or
- there is a misrepresentation in the course of the trade mark application.

Alteration of Registered Trade Mark

The Registry of Trade Marks allows for alteration to the name or address of the applicant in the mark if the mark comprises such elements as long as the alteration does not affect the identity of the registered mark substantially. An alteration of the mark in any other respect will not be allowed and a fresh application will have to be lodged.

Cancellation

An application may be submitted to the Registry of Trade Marks to cancel some or all of the goods or services for which the mark is registered.

4

APPLYING FOR A TRADE MARK OUTSIDE SINGAPORE

Introduction

Trade mark protection is territorial in nature. A separate registration will have to be made in each of the countries where trade mark protection is desired. To obtain protection outside Singapore, it is necessary to file applications in the countries concerned either individually or via the Madrid Protocol.

The Madrid Protocol

The Madrid Protocol provides for a system of international registration of marks. This process produces the same effect as if an application for the registration of the trade mark has been made in each country designated by the applicant. The Madrid Protocol allows a trade mark owner to seek protection for his trade mark in several countries simultaneously by filing one application with a single office, in one language, and with one set of fees in one currency (Swiss francs).

The Madrid Protocol is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

Country of Origin

Under the Madrid Protocol, a trade mark must first be registered or applied for in the country of origin before filing for an international application. A country of origin is a country that is a party to the Madrid Protocol where the applicant is a resident or national of, or has a real and effective industrial or commercial establishment.

The Madrid Protocol is open to its members only. An international application must be initiated in a member country seeking trade mark protection in other member country/countries. To apply, an applicant submits a single application to the trade mark office in his home country or the International Bureau of WIPO in Geneva. In his application, he can designate the country or countries in which he wishes to seek protection for his trade mark.

An international registration lasts 10 years. It may be renewed for further periods of 10 years by paying the prescribed fees to WIPO via the country of origin.

For the first five years, the international registration remains dependent on the validity of the mark registered or applied for in the country of origin.

>> Singapore is a contracting country under the Madrid Protocol. An international application may be filed with IPOS in Singapore.

Singapore may also be designated as a country for trade mark protection in an international application filed through a country that is member of the Madrid Protocol.

Advantages

1. The applicant enjoys the convenience of filing only one application, in one language, and pays one fee to one office, instead of filing separate applications in the trade mark offices of the various contracting parties in different languages, and paying a separate fee to each trade mark office.
2. The applicant does not have to wait for a positive response from the office of each contracting party in which protection is sought. If no refusal is notified by the trade mark office in a designated country within the applicable time limit, the mark is protected in the contracting party concerned.
3. Should the applicant need to make subsequent changes to his registration, such as a change in the name or address of the owner, a change in ownership or a limitation of the list of goods and services, he can easily effect the change through a simple single step of filing the application with the International Bureau and the payment of a single fee.

Flowchart of an International Application under the Madrid Protocol

Before filing an international application under the Madrid Protocol, a trade mark has to be registered or applied for in the country of origin.

File IA and Designate Countries

An international application (IA) submitted to Registry of Trade Marks at IPOS or International Bureau at WIPO.

Recorded and Published

The mark is recorded in the International Register and published in the WIPO Gazette.

Designated Countries Notified

International Bureau notifies each designated country.

Processed by Each Designated Country

The mark goes through a similar process as a national application in the designated countries. Refer to Flowchart of a Trade Mark Application on page 12.

Filing an International Application in Singapore

As Singapore is a contracting country under the Madrid Protocol, an international application may be filed with IPOS in Singapore. For the list of members of the Madrid Protocol, please refer to the WIPO website. Before making an international application:

- the applicant must have an application or a registration in Singapore on which to base his international application ("Singapore mark");
- the goods or services in the applicant's international application must be covered by his Singapore mark; and
- the applicant must be a resident or national of, or have a real and effective industrial or commercial establishment in Singapore.

All forms pertaining to the international registration of a trade mark are available at the WIPO website and the fees for such forms should be made out to WIPO. There are forms by the Registry of Trade Marks at IPOS in relation to the implementation of the Madrid Protocol in Singapore. These forms are available at the Registry of Trade Marks and downloadable from the IPOS website www.ipos.gov.sg>Forms and Fees>Trade Marks>IPOS Forms in Relation to International Registrations, and the relevant fees are payable to IPOS.

All applications, forms and communications submitted via the Registry of Trade Marks at IPOS must be in English.

Designating Singapore in an International Application

International applications designating Singapore under the Madrid Protocol are treated in the same manner as Singapore national applications, and are therefore published in the Trade Marks Journal for opposition purposes before protection is granted. They are published in a separate section of the Trade Marks Journal entitled "International Registrations filed under the Madrid Protocol Published for Opposition Purposes under the Trade Marks Act". Unlike Singapore national applications, they are published according to the international registration number instead of the class of goods or services.

>> The latest Trade Marks Journal may be downloaded from eTrademarks available at the IPOS website www.ipos.gov.sg.

Goods & Services

The class headings give general information about the types of goods and services which belong to each class. A specification indicating the class heading does not amount to a claim for all the goods or services in that class. This list is not exhaustive and serves as a quick reference to help you locate the correct class.

For the registration of your trade mark, you are required to state the exact class number and appropriate specification according to the Nice Classification. Details are available at the WIPO website www.wipo.int.

CLASSES OF GOODS

Class 1

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry

Class 2

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices

Class 4

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting

Class 5

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores

Class 7

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines

Class 8

Hand tools and implements (hand-operated); cutlery; side arms; razors

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus

and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus

Class 10

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes

Class 12

Vehicles; apparatus for locomotion by land, air or water

Class 13

Firearms; ammunition and projectiles; explosives; fireworks

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments

Class 15

Musical instruments

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks

Class 17

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery

Class 19

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics

Class 21

Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes

Class 22

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials

Class 23

Yarns and threads, for textile use

Class 24

Textiles and textile goods, not included in other classes; bed covers; table covers

Class 25

Clothing, footwear, headgear

Class 26

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers

Class 27

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees

Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams; compotes; eggs; milk and milk products; edible oils and fats

Class 30

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice

Class 31

Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages

Class 33

Alcoholic beverages (except beers)

Class 34

Tobacco; smokers' articles; matches

CLASSES OF SERVICES

Class 35

Advertising; business management; business administration; office functions

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs

Class 37

Building construction; repair; installation services

Class 38

Telecommunications

Class 39

Transport; packaging and storage of goods; travel arrangement

Class 40

Treatment of materials

Class 41

Education; providing of training; entertainment; sporting and cultural activities

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software

Class 43

Services for providing food and drink; temporary accommodation

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services

Class 45

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals

Frequently Used Terms in Trade Marks

Frequently Used Terms in Trade Marks

Classes	Goods and Services are divided into different classes according to the Nice Classification system. There are presently 34 classes of goods and 11 classes of services.
Descriptive Mark	A mark that contains only of elements that describe the features of, or elements that provide a description of the goods or services. Such a mark is not registrable.
Distinctive Mark	A mark that is unique and is easily differentiated from other marks.
Distinguishing	Differentiating
Examination	The process by which the trade mark examiner decides if a mark is registrable in accordance to the law.
Opposition	The process by which a member of the public, or an interested third party may object to the registration of a trade mark.
Priority Claim	The date officially established when the applicant first files for a trade mark application in a country that is a member of the Paris Convention or the World Trade Organization.
Representation	This refers to the drawing, image or photograph depicting the trade mark.
Search	The process by which the examiner searches for any existing and conflicting trade marks, as well as for geographical names, and names of pharmaceutical substances.



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

The Intellectual Property Office of Singapore or IPOS (<http://www.ipos.gov.sg>) is the lead government agency that formulates and regulates intellectual property (IP) laws, promotes IP awareness and provides the infrastructure to facilitate the greater development of IP in Singapore. With IP fast becoming a critical resource in today's new economy, IPOS' vision is to foster a creative Singapore where ideas and intellectual efforts are valued, developed and exploited. Formerly known as the Registry of Trade Marks and Patents, IPOS was established as a statutory board of the Ministry of Law on 1 April 2001.

