

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) 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).

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)

We 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 us 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)

We may have taken the view that your mark is deceptive because it might 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.

In these circumstances, you may provide evidence to show “honest concurrent use” of the marks involved. You may show that your mark has been used at the same time as the other mark(s). This evidence may be an indication that the public are used to distinguishing between your mark and the earlier mark(s) and thereby satisfy us that your mark has not been confused with other earlier marks.

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, we will inform you accordingly.

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.

Sometimes, we 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.