

SERIES OF MARKS

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1 INTRODUCTION

This chapter deals with the grounds for registration of marks which constitute a series.

2 RELEVANT LEGISLATION

Trade Marks Act [Cap. 332, 2005 Ed.]

Registration of series of trade marks

17. —(1) A person may make a single application under section 5 for the registration of a series of trade marks in respect of the same goods or services, or of similar goods or services which fall within a single class in accordance with the system of classification referred to in section 6.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act and the Registrar is required under section 15 to register the trade marks, he shall register them as a series in one registration.

3 GENERAL REQUIREMENTS OF A SERIES

To qualify as a series of trade marks, the following requirements must be satisfied:

- (a) **Each mark in the series must resemble each of the others in the series in their material particulars**, i.e. the main features in each of the trade mark must be essentially the same.
- (b) **The differences between the marks must comprise only matters which, when considered as a separate element of the mark, be non-distinctive in nature.**

Examples of non-distinctive elements would include statements or representations relating to:

- (i) the goods/services in relation to which the trade marks are to be used;
- (ii) number, price, quality or names of places; and/or
- (iii) colour of any part of the mark.

- (c) **The differences between the trade marks must not comprise matters which in the context of the trade mark as a whole, substantially affect the identity of the trade marks.**

- (i) This is the over-riding requirement – the differences between the marks must not substantially affect their identity. The test is **not** merely whether the marks in the series would be regarded as confusingly **similar** to each other if used by unrelated undertakings. Even though the marks are confusingly similar, the marks may still not qualify as a series.
- (ii) Any variation in the non-distinctive features in the marks must leave the **visual, phonetic and conceptual identity** of each of the trade marks substantially the same. If there are substantial differences either visually or phonetically, the marks will generally not constitute a series even if they are conceptually similar.
- (iii) Whether the identity of the mark has been substantially affected is assessed based on the likely reaction to the marks of an average consumer of the goods/services in question

(See *Logica Plc's Application (UK Decision of Appointed Person in Case O-068-03)*).

4 APPLICATION OF PRINCIPLES TO DIFFERENT TYPES OF MARKS

(a) Upper and lower case presentation

In order to be acceptable as a series, the differences in upper and lower case must not result in the marks being perceived or pronounced differently. This is acceptable as a series:

CHERRY
Cherry

The marks below do not qualify as a series as SWEET and ORANGE are easily recognised as words in the first mark but not the second. Due to the way the upper caps are placed in the second mark, the pronunciation and concept in the second mark are different from that in the first mark.

SWEETORANGE
SweetoRange

(b) Conjoining words

If the marks are composed of two well known dictionary words and in both the conjoined and separated versions, the sound and meaning of the marks remain the same, the Registrar will accept the marks as a series.

CHERRYTREE
CHERRY TREE

The marks below do not qualify as a series as the first mark can be perceived as “Goods it” or “Good sit”. However, the second mark in the series is clearly pronounced as “Goods it”. Since the concept may differ between the two marks depending on how the consumer separates the words, the marks are not acceptable as a series.

GOODSIT
GOODS IT

MIXIT
MIX IT

The first mark in the series is the word MIXIT. The second mark is made up of the words MIX and IT. The latter part of the mark may be seen as the pronoun “it” or denoting information technology. As MIXIT has no apparent meaning, it will convey a different message to the average consumer when compared to MIX IT.

In some cases, the conjoining of two words will not substantially affect the identity of the mark e.g. “goodvalue” is still plainly 'good value'. The key distinction here is the degree of disguise afforded to the words, MIX and IT, when they are conjoined to form an invented word.

The separation of MIX and IT substantially affects the identity of the marks. Given the differences between the marks applied for and the fact that the separation of MIX from IT could be seen as giving a **different message** from MIXIT **to the average consumer**, the marks therefore contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of a series of marks.

(c) Positioning of elements

In order to qualify as a series, differences in positioning of elements of the mark must not substantially affect the identity of the series of marks. Despite differences in their respective layout, the following marks clearly share the same material particulars. The aural and conceptual impression remains the same. Consequently, the identity of both marks remains the same.



Live for Real!

If the difference in positioning of the elements results in conceptual differences and subsequently in the identity of the marks, they are unlikely to be acceptable as a series.

ABCD

AC
BD

Here, the difference in positioning of elements results in differences in the aural and conceptual identities of the marks. Consequently, the identity of the marks is substantially affected. Such marks are not acceptable as a series.

(d) Spelling

Differences in spelling due to the American or British spellings of the word are generally acceptable. In addition, there should be no change in the visual, aural and conceptual identities, as shown here:

**PAUL'S CENTRE
PAUL'S CENTER**

Other common or obvious mis-spellings can be allowed provided the pronunciations and meanings remain unaffected. In the example below, the average consumer is likely to view "PELIKAN" as an obvious mis-spelling of "PELICAN" and hence remember it as such.

**PELICAN
PELIKAN**

Similarly, for

**TECMARK
TEKMARK**

the aural and visual identities remain substantially the same. Conceptually both "Tek" and "Tec" will be viewed as "Tech", i.e. short for "Technical".

**EUROPE CRAZE
UROPE CRAZE**

In comparison, the mis-spelling of the first letter in the second mark above would substantially affect its visual identity when compared to the first mark. Conceptually, they are also different as it is not obvious that "UROPE" is to be regarded as a misspelling of "EUROPE". In the circumstances, the marks are not acceptable as a series.

**BYE, PAIN
BYE, PAYNE**

Although phonetically identical, visually they are quite different and if viewed in isolation, "Payne" is unlikely to be regarded as a misspelling of "Pain". Hence, the Registrar would not consider these two marks to be a series.

(e) Punctuation

Differences in punctuation are allowed only if the punctuation does not alter the pronunciation and meaning of the marks.

Any inclusion of punctuation should not lead to the component words in the marks being perceived or pronounced differently. The general guideline is to determine whether the letter or word mark is pronounceable. If the letter or word mark is not pronounceable and the addition of punctuation to the mark does not affect it phonetically or visually, the two marks may constitute a series, as shown here:

THREAD 'N' THREAT	
THREAD'N'THREAT	UKNY
THREAD-N-THREAT	U.K.N.Y
THREAD N THREAT	

On the contrary, the letter and word marks below are pronounceable. Hence, the punctuation in the marks would cause the marks to differ phonetically and visually. These marks would not be acceptable as a series.

ODAK	ESCAPE	SMILE
O.D.A.K	E'SCAPE	S-MILE

(f) Colour

Differences in colour are acceptable in a series only if the colour is a subordinate and indistinctive feature of the mark.

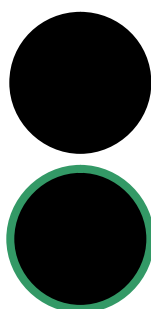
In the following example, although the second mark is limited to the colour orange, the colour adds little to the material particulars of the second mark. Colour is viewed as a subordinate feature in the second mark and is non-distinctive. Its presence does not substantially affect the visual identity of the marks. It is therefore acceptable as a series:

-----**HIP ALLIANCE**-----
-----**HIP ALLIANCE**-----

The second mark in the series is limited to the colour orange as shown on the form of application.

Where colour is the major or the only distinctive element within the mark, the absence or variation of the colours in another mark will prevent them from being a series.

The addition of colour to simple geometric shapes will often give a substantial effect on the identity of the marks. The following example illustrates that colour, being the major distinctive element in the second mark, prevents the two from being a series as colour has added a material particular which is absent in the first.



The second mark in the series is limited to the colours as shown on the form of application.

(g) Stylistation

Variations in stylisation should be minimal and of a non-distinctive nature such that the differences do not add material particulars to the marks. The same word in different scripts or fonts may form a series if the scripts or fonts are conventional scripts or fonts and are not stylised in a fanciful manner.

For instance,

TURN IT ON!!
TURN IT ON!!
TURN IT ON!!
TURN IT ON!!

The different fonts are conventional scripts that are not stylised in a fanciful manner. They are considered non-distinctive and when used in the marks, do not add material particulars to the marks.

The addition of a device element to a word trade mark almost always substantially affects the identity of the mark. However, it is generally noted that a simple, conventional embellishment, such as the addition of a line or simple border, contributes nothing of a distinctive nature to the trade marks as a whole. Such variations are generally acceptable since they contribute no material particular to the marks.

Bellyson

Trafwicbook

Bellyson

Trafwicbook

Where the stylisation is fanciful, or where material particulars are present in one but not in others in the series, the marks do not form a series. In this example, the first mark has a higher and further distinctive character, i.e. the light bulb. The two marks are not acceptable as a series.

I ? O S
 I P O S

In the following example, the heavy stylization in the second mark creates a very different visual impact from the first mark. The two marks cannot be considered to be a series.

Indiana Roberto James



(h) Chinese characters

The same Chinese words in traditional and simplified characters are acceptable as a series if the characters are in conventional scripts or fonts.

知識產權
知识产权

If there is stylisation of any or all of the characters, the different stylised forms do not constitute a series, as shown here:

知识产权


(i) Cartoon characters

A series of cartoon characters may constitute a series if the characters are clearly the same, wearing the same clothing, or holding or using same props in each mark in the series. The following cartoon characters would be acceptable as a series:



(j) Dominant features

Although the distinctive element is more prominent in one of the marks, there is no difference in the material particulars and hence these are acceptable as a series.

DENOSAUOR FORUM

**DENOSAUOR
FORUM**

Care would be required where the non-distinctive element is enlarged so as to dominate the mark, as that may attract a Section 7(1)(b) objection for insufficient surplus.

M O L E C U L A R
M O L E C U L A R

The above does not constitute a series as the non-distinctive letter “C” in the first mark is considered much larger than the other letters, so that it is a material particular in the first but not the second.

(k) Domain names

A trade mark series cannot consist of a trade mark on the one part and a domain name or internet address on the other part.

ipos
ipos.gov.sg

A domain extension (e.g .com, .com.sg, .gov.sg, or .org.sg) at the end of a trade mark although lacking in distinctive character, changes the *identity* of that trade mark from a word or words to an Internet address. The primary function of an Internet address is to locate a web-site and this is how most people would regard an Internet address when they see one. An Internet address can of course function as a trade mark, but this is a subsidiary use to its prime function. Accordingly, while the addition of .com or .gov.sg, etc to a trade mark satisfies the first part of Section 17(2) of the Trade Marks Act (i.e. matters of a non-distinctive character), it fails on the second part of Section 17(2) of the same act (i.e. differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark) as it substantially affects the identity of the trade mark.

If the series consists of the same trade mark but different Internet domain extensions, it may form a valid series provided the domain extensions are well known and easily recognizable, and identifies the same type of commercial organization. Therefore, their addition to the distinctive element does not substantially affect the identities of the marks.

Acceptable Marks:

WEBWEBSITE.COM
WEBWEBSITE.CO.UK

ipos.com
ipos.com.sg

However, where the domain extension is not common, its presence in the mark may not be recognisable as being based upon an internet address, hence, rendering its conceptual identity different from the other marks in the series.

CHAPTERNIL.BI
CHAPTERNIL.NET
CHAPTERNIL.COM.SG

In the above illustration, the identity of the first mark is ambiguous as “BI” is not a well known component of a domain name and the average consumer would be uncertain as to its conceptual identity. In the second mark, “.NET” indicates that the user is an internet service provider. On the other hand, the message conveyed by the third mark is different to the message conveyed by the first and second mark. The conceptual identities of all three marks are different and do not constitute a series with one another.

There will be instances where **trade marks** that would normally constitute a valid series will not form a valid series when represented as **domain names**. This is because the variation between the trade marks results in each representation forming a different domain name and therefore a different identity.

Valid series:

ABC1

ABC2

ABC3

Invalid series:

ABC1.COM

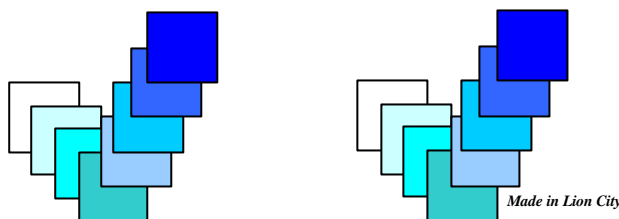
ABC2.COM

ABC3.COM

(I) Geographical components

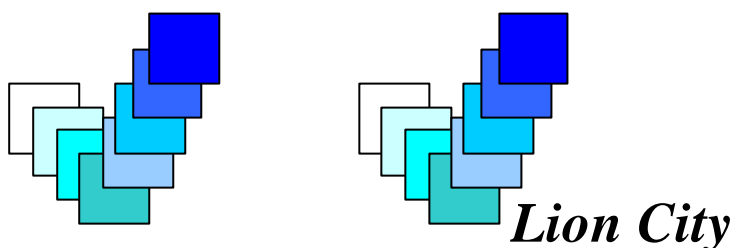
Geographical components are not necessarily immaterial or non-distinctive. The variations in the geographical components must not add material particulars to the trade marks for them to qualify as a series.

Acceptable:



Variation is made only by the addition of statements or representations of the name of a place “Made in Lion City” in the second trade mark which is not distinctive and does not substantially affect its identity compared to the first. They would constitute a series.

Unacceptable:



The addition of the word “Lion City” is not so obviously a non-distinctive indication of the geographical origin of the goods and hence affects the identity of the marks in a material manner. They are not acceptable as a series.

PLOED’S NEW YORK
PLOED’S PARIS
PLOED’S LONDON

Class 16: Travel guides.

Geographical names added to **distinctive words**, may be regarded as making no substantial difference to the identities of the marks. The above is acceptable as a series.

However, where the geographical element in the marks is not obviously so non-distinctive that the average consumer would be bound to ignore it as purely informative matter and the identities of the marks depend in part on the inclusion of the geographical names, the marks might not constitute a series. This may be because the geographical names are not well known, the non-geographical name portion of the mark is not very distinctive, or the geographical name may be distinctive in the light of the goods/services applied for. The following two marks would not constitute a series.

**NORTH POLE BANANAS
ANTARTIC BANANAS**

(m) House mark in combination with indication of goods/services

The presence of a highly-distinctive invented house mark in combination with a clear or obvious description of the goods/services is acceptable as a series. The following would be acceptable:

**decoim paper
decoim pencil
decoim eraser**

Class 16: Paper, pencils, erasers.

Conversely, if the common element in the marks is a common and descriptive or semi-descriptive dictionary word, the marks would not qualify as a series.

Unacceptable as a series:

**POWER MACHINE
POWER TOOLS
POWER APPARATUS**

Class 7: Machines and machine tools; apparatus for controlling.

(n) House mark in combination with indication of numbers

If the differing numerals can clearly be seen as merely model numbers following the dominant and distinctive word and it is common for such goods to be described in terms of model numbers, the overall identity remains the same and the marks may constitute a series.

**ESTON 1
ESTON 2
ESTON 3**

However, where the numerals are not seen as a separate element but as an integral part of the mark, the identity of the each mark may reside partially in the specific combination of numbers. The alteration of the numerals therefore substantially affects the overall identities of the marks.

**IN01
IN02
IN03**

(o) Device Marks



The differences in the patterns are sufficiently significant to modify the impact on the perceptions and recollections of the relevant average consumer. Hence, **there are differences which are sufficiently significant to modify the distinctive character of the marks in issue.**

5 OPTION IF THE MARKS ARE NOT CONSIDERED TO BE A SERIES

If the marks are not considered to be a series, the applicant may delete any of the marks to leave only those that constitute a series (Rule 21(2)). Once a mark has been deleted from an application filed for a series on the grounds that the Registrar does not consider that the marks form a series, it cannot be reinstated (unless there are circumstances which allow the Registrar to treat the matter as a correction of irregularity in procedure (Rule 83)).

6 EXAMINATION OF APPLICATIONS WHICH ARE OBJECTED TO AS NOT BEING A SERIES

The examiner, when raising a series objection should, where practical, indicate whether any of the marks in the series applied for could be accepted as a series and if so, which of the marks would form a series. The applicant should be invited to choose one of the trade marks or a group of trade marks and request deletion of the remainder. If the marks do not constitute series in any possible way, the Registrar will request deletion of any reference in the application to a series. The inclusion in the report of a photocopy of the application and “alleged” series where each trade mark has been numbered for easy reference may be useful to the applicant and the examiner. A photocopy of the numbered series should be kept on file and scanned into File Management System (FMS).

The first examination report should be as complete as possible. Where the trade marks of an invalid series all contain a common feature and which is likely to be retained as part of the application, a search for conflicting marks should be conducted and included in the examination report.

Where however the trade marks in the series incorporate different words or other signs, it is not appropriate to carry out a search for conflicting marks or re-search to establish registrability until the applicant advises which of the trade marks is to be retained. In such cases, the objection to the mark as a series should be raised before the application is examined on absolute and relative grounds.

7 WHERE ABSOLUTE GROUNDS OF REFUSAL HAS BEEN RAISED

Where Section 7 objections have been raised and if it is found that only one of the trade marks is distinctive of the applicant's goods or services, then the application will only be accepted for that trade mark, not for the series of trade marks.

8 SERIES MARKS INCLUDING PRIORITY CLAIMS

An application may be filed in Singapore for a series but with a claim to priority for just one mark. Partial priority claims are allowed so priority can be allowed for the mark which matches the one in the Convention application.

If an application containing a series of marks is made in Singapore and the applicant is claiming priority from a country in which separate applications were made for the marks on different dates (multiple claims), the priority claims may also be allowed.