

Some Questions and Answers relating to the amendments to the Trade Marks Act via the Statutes Miscellaneous Amendments Act and amendments to the Trade Marks Rules and Trade Marks (International Registration) Rules, which came into effect on 1 January 2006.

Q1. When will IPOS raise objections pertaining to non-compliance with minimum filing requirements?

A1. With effect from 1st January 2006, IPOS will check TM 4 applications to ensure that they comply with all the formality requirements which are essential for filing date. Such formality requirements that are essential for a filing date to be accorded include:

(a) a request for registration of a trade mark – section 5(2)(a)

A request for registration is generally taken to be the provision of Form TM 4 which in itself requests registration. However, if a letter is received which clearly states that a request for registration of a trade mark is sought, this would be sufficient.

(b) the name and address of the applicant – section 5(2)(b)

The name and address of the applicant (who becomes the “proprietor” once the mark is registered) must be supplied. The name of the applicant must be the correct legal name (particularly in the case of companies) and not a trading name or style.

(c) A clear graphical representation of the trade mark

A clear graphical representation of the trade mark (or marks in the case of a series application) in the format that registration is sought must be provided. The clarity required here is in the sense of a precise and unambiguous graphic representation as well as quality of image. Some examples of what amounts to a precise and unambiguous graphic representation for each category of unconventional mark is detailed in the next question. In ascertaining whether the graphic representation is precise and unambiguous, the pictorial representation of the mark and the indication of what is claimed (3-D, aspect of packaging, colours as trade mark, other non-conventional mark) will be read together.

(d) a list of the goods or services in relation to which it is sought to register the trade mark – section 5(2)(d)

An application must include a list, or statement, of all goods and services (the specification) for which an applicant intends to use the trade mark. It is not essential to provide a class number in order to obtain a filing date, but this is a

requirement which must be met before the application can proceed further. The specification will not be examined by IPOS in any detail at this stage as this will be dealt at the examination stage.

(e) Use or bona fide intention to use – section 5(2)(e)

The applicant (or someone else with his consent) must either be currently using the trade mark applied for or have a bona fide (good faith) intention to use it in relation to the goods or services requested. The application must contain such a declaration.

(f) Fees – section 5(3)

Payment must be made together with the application(s).

If the above requirements are met, the filing date is the date of receipt of the application. If the above requirements are not met, the filing date will be the date on which IPOS receives the information/document(s) which put the application in order.

Q2. What will constitute a clear, graphical representation of the mark?

A2. As a general guide, the following criteria will be used to assess whether there is a clear, graphical representation of the mark:

(a) Shape marks

A shape mark should be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration as shown in the picture(s).

(b) Pictorial, figurative or word marks incorporating colour

Where the trade mark consists of colours in combination with other elements whether they be pictorial, figurative or word elements, a coloured image of the trade mark will be required to be lodged with the application. Colour identification codes will **not** be required for these types of marks, but will be recorded if filed. Applicants who provide only a black and white image of such marks with a statement that the mark consists or includes named colour(s) will not receive a filing date until the colour(s) have been adequately defined and it is clear which parts of the mark are in the colour(s) named.

(c) Colour(s) as a trade mark

Where the trade mark consists solely of colour(s), a sample of the colour(s) is required to be lodged with the application. In addition, the applicant should include a designation from an internationally recognised identification code

where the colour or shade exists in the coding system. However, the failure to indicate such a designation on the application form will not result in the application being denied a filing date. But, it should be noted that a mere sample of the colour on paper without any accompanying description will not be sufficient.

(d) Sound marks

A sound mark is considered to be graphically represented when it consists of a representation by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.

If a particular musical instrument is used to produce the sound forms part of the mark, this should be stated.

(e) Scent marks

Scent is one of the more unusual kinds of signs and is difficult to represent graphically. It is only registrable if it is possible for the public to identify the goods and services of a proprietor through the scent.

(f) Moving marks

Moving marks can be represented by a sequence of still pictures in the correct sequence that corresponds to the mark in use and a written description describing the nature of the mark represented by the still pictures. The description should include the following information:

- That the mark is a moving image
- What the images depict i.e. what the change in appearance is
- How many images are involved
- What is the sequential order of the images
- That there is a single sequence of the movement (and not a variable sequence)

(g) Holograms

Each of the various views of the hologram must be depicted in the representation so that all the material features of the mark are apparent.

For simple holograms where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

Q3. The amendments created a new status, “treated as withdrawn”. Previously, applications that are abandoned due to non-response are “deemed abandoned”. Why is there a need to amend the status of an application from “deemed abandoned” to “treated as withdrawn”?

A3. Previously, if there was no response to the examination report issued by IPOS, the status of the application would be updated as “abandoned”. This is so whether the non-response was intentional or the result of the applicant’s oversight. There was no official avenue for re-instatement of “abandoned” trade marks to help applicants who missed the deadline due to oversight. IPOS re-instated abandoned applications through an *informal* process of appeal, assessing each appeal based on a set of internal guidelines. However, as re-instatement was previously not provided for in the legislation, not all applicants were aware of this process. This is not desirable.

The amendment to allow “abandoned” applications to be “treated as withdrawn” is accompanied by an amendment allowing applications to request to restore “treated as withdrawn” applications thus saving time and money, and safeguarding his priority to register the mark.

Creating this new category of status of “treated as withdrawn” applications is also to differentiate those which can be restored from those which cannot be. Further, once the 3-month period for restoration has expired and if no request for restoration has been made, the status of the mark will be updated as “abandoned”.

Q4. For TM 1 (Request to appoint or change an agent or to enter or change an address for service), in particular box 3, can the applicant select “Others” and specify “For all transactions”?

A4. No. Form TM 1 is for the purpose of updating the address for service based on the specific category of transactions ticked. We will reject Form TM 1 with a tick against the box “Others” and with the words “For all transactions”.

If agent/ address for service is authorized for all matters pertaining to a pending mark or a registered mark where there is no outstanding transaction(s), please tick against the box for “Application for registration/Registration” or “Renewal and registered proprietor”, whichever is appropriate.

The option “Others” is to cater for matters that have not been specifically stated in Part 3 of the Form, for example, “Rectification of the register”.

Q5. When can an applicant apply for a restoration of a “treated as withdrawn” application?

A5. For applications which may be restored, IPOS will now proactively inform applicants when they miss our deadline. Applicants are given 3 months from the date of our notification to apply for restoration. IPOS will only apply the new provision to deadlines issued by IPOS on or after 1 January 2006.

Q6. Can an applicant use the new restoration procedure to restore a registration that has expired or removed due to non-renewal?

A6. No. The application for restoration of “treated as withdrawn” applications is applicable only to the cases listed in rule 77B. There is separate procedure for late renewal of registrations and restoration of registrations that have been removed due not non-renewal.

Q7. What kinds of trade mark applications can be restored through the new restoration procedure?

A7. Three kinds of trade mark applications can be restored.

First, applications for trade mark registration that have been treated as withdrawn due to the applicant’s non-response to IPOS’ queries or objections can be restored.

Second, applications for collective or certification trade marks can be restored if they have been treated as withdrawn due to the applicant’s failure to file the accompanying regulations within the specified timeframe. These regulations govern matters such as the control and use of the mark, and are a required component of applications for collective or certification marks.

Previously, if these regulations are not filed within the specified period, the application will be rejected, and the applicant will have to re-file a fresh application and pay the full fee again.

Third, renewal applications that have been treated as withdrawn due to non-response or inadequate response to issues raised in the renewal applications within the deadline given can be restored through the new restoration procedure.

Q8. Why is there a need to amend the definition of “Convention country”?

A8. The previous definition of Convention Country, which was modeled after UK legislation, did not cover Singapore. As unregistered well known trade marks are only protected under our Trade Marks Act if they are owned by persons who are

nationals of, or domiciled in, Convention Countries, or who have a commercial establishment in a Convention Country, this causes uncertainty over whether Singaporean-owned unregistered well-known marks are protected. The amendment clarifies this, ensuring that Singaporean owners of unregistered well-known marks will be protected under the Act.