

**In The Matter Of An Application For A Mark
“Makes Life Better” By
Aki Habara Electric Corporation Pte Ltd
In Classes 7, 9 and 11**

And

Refusal Of Registration Under Section 12 Of Trade Marks Act And Rule 24 Of The Trade Mark Rules

*Before Principal Assistant Registrar P Arul Selvamalar
5 April 2004*

Trade Mark Application – Refusal of Registration – Whether Applicants’ mark registrable under section 7(1)(b) and (c) of the Trade Marks Act (Cap. 332, 1999 Ed.)

Trade Mark Application – Refusal of Registration – Whether the Applicants’ mark had acquired distinctiveness through use – Whether use of a composite mark is sufficient to prove that individual elements in the composite mark have acquired distinctiveness under section 7(2) of the Trade Marks Act (Cap. 332, 1999 Ed)

The Applicants, Aki Habara Electric Corporation Pte Ltd, applied to register a trade mark which comprised the words MAKES LIFE BETTER in Classes 7, 9 and 11 in respect of electronic products for home and personal use. The Assistant Registrar examining the applications raised objections to the mark under sections 7(1)(b) and 7(1)(c) of the Trade Marks Act . The Applicants filed evidence of use which showed that their mark is used with the work AKIRA appearing in capital letters in a larger font above the words “makes life better” in a smaller and different font. They submitted that the mark was not objectionable under these sections but the Assistant Registrar maintained her objections except the section 7(1)(b) objection in Class 7. The Applicants requested for a hearing. In the ex parte hearing, the Applicants argued that the new Trade Marks Act 1998 was intended to make it easier for proprietors of trade marks to obtain registration. They also submitted that because the Trade Marks Act provides that it is not an infringement of a registered trade mark, if a sign is used to indicate the kind, quality, intended purpose, or other characteristic of goods or services and such use is honest, the Registrar need not be overly concerned that the registration of their mark would prevent other honest traders from using the words in their mark in a descriptive sense.

The Applicants also submitted that slogans are not unregistrable per se, and that the test of whether a mark is capable of possessing distinctiveness depends on whether the mark may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance. They submitted that MAKES LIFE BETTER is not the normal way of referring to the goods in classes 7, 9 and 11.

The Applicants also submitted that evidence of use of the mark applied for MAKES LIFE BETTER, together word AKIRA, is sufficient to establish that the words MAKES LIFE BETTER have become capable of distinguishing the goods of the Applicants and that therefore section 7(2), the proviso to section 7(1), applies.

Held, maintaining the refusal of the application,

- The Registrar applied the decision in Libertal [2003] ECR I-3793 where the ECJ stated that the examination of applications for registration must not be minimal but must also be stringent and full in order to prevent trade marks from being improperly registered and to make sure that, for reasons of legal certainty and sound administration, trade marks whose use could be successfully challenged before the courts are not registered. The Registrar found that the fact that honest traders may use in a descriptive manner words which are registered trade marks, does not justify the liberal registration of words which are objectionable under the provisions of the law.
- Although the policy of the Trade Marks Act 1998 was to make it easier for proprietors to obtain registration, that does not mean that when the test is applied to applications for registration, the test must be applied in a manner which makes it easy for applications to proceed to registration. The applications must still satisfy the requirements of the Trade Marks Act.
- Following the Nestle SA and British Sugar case, the test in the present case is whether the sign MAKES LIFE BETTER is capable of identifying the goods as originating from the applicants, without first educating the customer that it is a trade mark. On the facts, it was found that reasonably circumspect and observant consumers of the type of electronic goods sold by the Applicants would be of the view that the words describe

the products, in that, these products make life better when they are used. Only after the consumers are educated that it is not a description and that it is a trade mark, would the words be able to do the job of distinguishing the Applicants' goods from those of other undertakings. Hence, it was found that the words, MAKES LIFE BETTER, offend section 7(1)(b) of the Trade Marks Act.

- As the words, MAKES LIFE BETTER, are descriptive of the Applicants' products, they would be treated as designating the kind of goods or the quality of the goods or the intended purpose of the goods, and would be descriptive under section 7(1)(c) of the Trade Marks Act.
- Evidence of use of the individual elements of a composite mark should not be required as the only evidence that will be able to satisfy the Registrar that an individual element has become capable of identifying the goods as originating from a particular source. However, the evidence of use must be able to show that that individual element has become able to identify the goods as originating from a particular source to the public, which happens only when the individual element on its own, if shown or spoken to consumers, would elicit a response from a substantial number of consumers, that shows that they identify the goods or services as originating from a particular source. Evidence of use of a composite mark must lead each element to come to a point, a turning point, when the consumer recognises that individual element, on its own, as an identifier of origin. Whether any individual element has reached that point is a finding of fact based on the evidence of use.
- The Applicant's evidence showed that the mark has been used for about 6 months (April 2001 to 11 October 2001) before the date of application and the revenue from sales for a period of one year April 2001 – March 2002 was about S\$ 3 million. This evidence was insufficient to show that the mark MAKES LIFE BETTER has reached a point that, if consumers are told or shown the words MAKES LIFE BETTER, a substantial number of them would respond in a manner that shows that they identify the goods being sold as originating from the Applicants. Therefore, the evidence of use filed in this case was insufficient to show that the mark had acquired distinctiveness, and the mark did not come within the section 7(2) proviso to section 7(1).

Provisions of Legislation discussed:

- Trade Marks Act (Cap. 332, 1999 Rev Ed), Sections 2(1), 7(1)(b), 7(1)(c) and 7(2).

Cases referred to:

- MY MUM's COLA [1988] RPC 130
- Proctor & Gamble v Office of Harmonisation in the Internal Market (OHIM) (Baby Dry) [2002] RPC 17 ECJ
- Nestle S A's Trade Mark Application (HAVE A BREAK) [2004] FSR 2
- Case No. 2111/2000-2 Ringling Bros – Barnum & Bailey Combined Shows Inc. 23 March 2001, Board of Appeal, OHIM
- Case C-64/02 OHIM v Erpo Möbelwerk GmbH 21 October 2004
- Libertal [2003] ECR I-3793
- British Sugar v James Robertson & Sons [1996] RPC 281
- West v Fuller, Smith & Turner Plc [2003] EWHC Civ 48
- Case T-128/01 Daimler Chrysler Corp v OHIM 6 March 2003, Court of First Instance
- Linde AG v Dueutsche Patent-und Markenamt [2003] RPC 45
- TORQ-SET [1959] RPC 344

Representation:

- Mr Han Lim Siew (Alban Tay Mahtani & de Silva) for the Applicants