

**In The Matter Of An Application By
Singapore Street Festival Ltd
For Declaration Of Invalidation**

Of

**Registered Trade Mark T04/12796D
In The Name Of Tan Yueh Han
Trading As SCC Square**

*Before Principal Assistant Registrar Ms Lee Li Choon
12 April 2007*

Trade Mark Registration – Application for Invalidation – Whether Respondents’ mark satisfies the definition of a trade mark - section 7(1)(a) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Registration – Application for Invalidation – Whether Respondents’ mark is devoid of any distinctive character - section 7(1)(b) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Registration – Application for Invalidation – Whether Respondents’ mark has become customary - section 7(1)(d) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

The Applicant, Singapore Street Festival Ltd (“the Applicants”), sought to invalidate Registration No. T04/12796D for the mark consisting of the word “COSPLAY” in Class 14 in respect of “arranging and conducting of workshops; books (publication of books); club services (entertainment or education); competitions (organization of entertainment activities); exhibitions for cultural or educational purposes; planning party (entertainment); trainings (demonstration); studios (movie)”, a registration obtained in the name of Tan Yueh Han Trading as SCC Square (the “Registered Proprietor”).

The Applicants relied on section 23 stating that the mark does not satisfy the definition of a trade mark; that the mark is devoid of distinctive character and that the mark consists exclusively of a word or term that has become customary in the current language or in the bona fide and established practices of the trade and thus, the registration is in breach of section 7 (1) (a), 7 (1) (b) and 7 (1) (d) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed) (“the Act”).

The Applicant submitted evidence of emails and online blogs of individuals and Google search results and webpages showing the use of the word, “cosplay”. The Applicant argued that the word, “cosplay” had its origins from a Japanese term known as “Ko-su-pu-re”, which term, when loosely translated into English, means “costume play” and that it is thus incapable of distinguishing the services applied for. Then, the Applicant pointed to the evidence lodged (Google search results, webpages and content of emails and online blogs of individuals), all of which, contended by the Applicant, point to the word, “cosplay” being descriptive of a particular activity, much like the word, “tennis” is used for tennis, the sport. The Applicant submitted that the fact that “cosplay” is found on so many websites goes to show that the word, “cosplay” clearly has a descriptive meaning. The Applicant also pointed to evidence of entries showing the definition of “cosplay” in Urban Dictionary, an online dictionary, Reference.com and Wikipedia.

Held, allowing the application for invalidation.

1. In assessing a mark for distinctiveness, it must be considered from the perspective of the relevant customer and as at the date of application. On the origin of the word, the hearing officer said there was no connection between the origin of the word, “COSPLAY” from the Japanese word and the lack of distinctiveness of the word. The fact that the word is derived from a Japanese word which in Japanese means, “costume play” does not mean that the word, when given a phonetic spelling in English, also shares the same meaning as the word in Japanese. The hearing officer also noted that the Applicant could not say that “cos” is a known abbreviation of “costume” and that therefore, the word, “cosplay” is a mere combination of two known words, “costume” and “play”, resulting in the combined word having a known meaning as “costume play”.
2. On the evidence, the hearing officer considered the evidence of emails and blogs to be hearsay evidence that is unreliable and inadmissible since firstly, the deponents of the emails and blogs did not make statements attesting to the making of those statements found in the emails and blogs and secondly, a lot

- of the blog entries are identified through online pseudonyms or online identities, making it unclear as to who the “real persons” are that made those blog entries.
3. Nonetheless, on assessing the evidence in totality, the hearing officer concluded that the evidence points to the word, “cosplay” having a generic, descriptive meaning or significance, viewed at from the perspective of the average consumer or general public. And that is the case as at the application date, August 2004. The hearing officer found the more persuasive evidence to be that found in the Straits Times article published on ‘The Sunday Times’ on October 1, 2006, titled, “Cos and effect” with a side snippet titled, “Don’t play, play, cosplay is hot” and the article titled, “THE DREAMER” featured in the Sunday Times, Lifestyle, where Mr Tan Yueh Han, the person who obtained the subject registration and the deponent of the Registered Proprietor’s Statutory Declaration of 4th January 2007 (the Registered Proprietor’s SD), was interviewed. The hearing officer pointed to the various uses of the word, “cosplay” in these articles which show the word “cosplay” being freely used as a descriptive word and even as a root word (for example, in “cosplayer”).
 4. On the whole, the hearing officer concluded that the word “cosplay” means a particular type of “subculture” or activity whereby people dress up in costumes, mostly to look like some fictional or movie characters, particularly anime characters. Moreover, the services registered under “cosplay” have to be considered, using notional and fair use of the word across the entire specification of services. When considering the word against the specification, it was also concluded that the services registered under the mark, “cosplay” are related to “cosplay” type of activities.
 5. Thus, the word, “cosplay” is clearly descriptive in relation to the registered services. As a result, the mark, is devoid of distinctive character in relation to the Registered Proprietor’s services and therefore the registration was invalid under section 7 (1) (a) and 7 (1) (b) read with section 23 (1).
 6. As for the ground in section 7 (1) (d), the rationale is to prevent registrations which would inhibit honest traders from customarily using in trade, signs which are generic, in the normal course of business. Thus, as long as the word has become customary, its registration would be invalid under section 7(1)(d). As it was found that the word “cosplay” is descriptive in relation to the registered services and connotes services related to costume play or “cosplay” in the minds of an average consumer and is widely used by consumers in general, people engaged in the hobby or subculture of costume play, and people who offer services related to costume play, the conclusion is that the registration of cosplay would inhibit the use of the word “cosplay” as a descriptive word in the normal course of business of other honest traders. Thus, the registration also falls foul of section 7 (1) (d) and the registration is declared invalid under section 7(1)(d) read with section 23.

Provisions of legislation discussed

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.), Sections 7(1)(a), 7(1)(b) and 7(1)(d)

Cases referred to

- British Sugar v James Robertson & Sons [1996] R.P.C. 281 at 302
- LIGHT GREEN, OHIM Third Board of Appeal [1999] E.T.M.R.214, para 20
- “MINICLAW” [1999] E.T.M.R.505
- PROFITMAKER [1994] RPC 613

Representation

- Mr Samuel Seow assisted by Ms Audrey Chiang (M/s Samuel Seow Law Corporation) for the Applicants
- Mr Adrian Ee (M/s Ramdas & Wong) for the Registered Proprietors