

**IN THE HEARINGS AND MEDIATION GROUP OF
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark No. T1403479I

**IN THE MATTER OF A TRADE MARK APPLICATION BY
MARVELOUS AQL INC.**

Hearing Officer: See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Mr Thomas Sim and Ms Karin Lee (Engelin Teh Practice LLC) for the Applicant

Cur Adv Vult

GROUND OF DECISION

Introduction

- 1 On 11 March 2014, Marvelous AQL Inc. (the “Applicant”) filed an application (“the Subject Application”) to register the following mark:



(the “Application Mark”)

- 2 The Application Mark was sought to be registered in Classes 9, 16, 28 and 41 in respect of the following goods and services:

Class

Specification of Goods / Services

- | | |
|---|--|
| 9 | Arcade games (apparatus for-) adapted for use with an external display screen or monitor; Telecommunication devices and apparatus; Electronic machines, apparatus and their parts; Consumer games (apparatus for-) adopted for use |
|---|--|

with an external display screen or monitor; Electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; Phonograph records; Metronomes; Electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; Downloadable music files; Exposed cinematographic films; Exposed slide films; Slide film mounts; Downloadable image files; Recorded video discs and video tapes; Electronic publications.

- 16 Banners of paper; Flags of paper; Hygienic hand towels of paper; Towels of paper; Table napkins of paper; Hand towels of paper; Handkerchiefs of paper; Paper and cardboard; Stationery and study materials; Printed matter; Paintings and calligraphic works; Photographs; Photograph stands.
- 28 Amusement machines and apparatus for use in amusement parks (other than arcade video game machines); Toys for domestic pets; Toys; Dolls; Go games; Japanese playing cards [Utagaruta]; Japanese chess [Shogi games]; Dice; Japanese dice games [Sugoroku]; Dice cups; Diamond games; Chess games; Checkers [checker sets]; Conjuring apparatus; Dominoes; Playing cards; Japanese playing cards [Hanafuda]; Mah-jong; Game machines and apparatus; Billiard equipment.
- 41 Educational and instruction services relating to arts, crafts, sports or general knowledge; Providing of electronic publications; Services of reference libraries for literature and documentary records; Publication of books; Planning or arrangement of showing movies, shows, plays or musical performances; Movie showing, movie film production, or movie film distribution; Presentation of live show performances; Direction or presentation of plays; Presentation of musical performance; Production of radio or television programs; Production of video tape film in the fields of education, culture, entertainment or sports [not for movies, radio or television programs and not for advertising and publicity]; Organization, management or arrangement of entertainment (excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and autoraces); Providing audio or video studio services; Providing amusement facilities; Providing game services used via the internet and providing information about this; Rental of records or sound-recorded magnetic tapes; Rental of image-recorded magnetic tapes; Rental of toys; Rental of amusement machines and apparatus; Rental of game machines and apparatus.

Examination Background

- 3 On 25 July 2014, the examiner examining the Subject Application issued the first office action with objections to the Application Mark under Sections 7(1)(b) and 7(1)(c) of the Trade Marks Act (Cap 332, 2005 Rev Rd) (“the Act”).
- (a) In brief, the examiner’s view under Section 7(1)(b) of the Act was that the Application Mark is devoid of any distinctive character. In this regard, his view was that the dominant element of the Application Mark (i.e. “Marvelous”) is “*simply a laudatory word connoting a high quality*” and that as a whole, the mark is likely to be “*perceived as a mere badge of quality that does not point to any trade*”

source in particular". The examiner also took the view that "*the overall getup of the mark does not render the mark any more distinctive*".

- (b) As regards Section 7(1)(c) of the Act, the examiner's view was that the Application Mark consists exclusively of signs or indications which may serve, in trade, to designate the quality of the goods and services claimed. In arriving at this view, the examiner noted that the dominant element (i.e. "Marvelous") has the dictionary meaning "superb; excellent; great", and when applied to the claimed goods and services, the mark in totality is "*merely descriptive of the quality of these goods and services*". The examiner also recorded his view that there "*is a lack of distinctive features in the mark*".
 - (c) At the conclusion of the first office action, the examiner invited the Applicant to file evidence of use in order to overcome the Section 7(1)(b) and 7(1)(c) objections.
 - (d) There were also objections to the specification in Class 9, but these are not in issue before me in the present matter. It has been the Applicant's intention to resolve the objections pertaining to the Application Mark before (more easily) addressing those pertaining to the specification in Class 9.
- 4 On 10 November 2014, the Applicant made submissions in response to the examiner's objections, but did not file evidence of use. It accepted, at the very outset, that "*[w]hile it may be the case that the plain word "marvelous" may lack distinctiveness and/or has descriptive/laudatory attributes, it must be emphasized that the [Application Mark] is not a word mark simpliciter*". It went on to point out what, in its view, were "*fanciful/distinctive features*" of the Application Mark, namely: a "*distinctive font with all the letters capitalised*"; a "*distinctive 3-D get-up*" with the "*letters slanting upwards from left to right*"; and an "*exclamation mark at the end of the [Application Mark]*". It argued that these features "*sufficiently ensure the [Application Mark] is capable of distinguishing*" its "*trade and/or services from those provided from any other person*". The Applicant also highlighted that the same mark had been accepted for registration in Australia.
- 5 On 16 March 2016, the Applicant was informed by a second examiner that the earlier objections under Sections 7(1)(b) and 7(1)(c) of the Act were maintained. The second examiner did not accept the Applicant's submissions relating to stylisation of the Application Mark. In essence, her view was that the stylisation was "*minimal*" and did not "*render sufficient distinctive character*". Insofar as the Australian registration was concerned, the second examiner pointed out that this was not binding and that examination practices may also differ.
- 6 On 31 March 2016, the Applicant made a formal request for reconsideration of the objections raised in respect of the Application Mark.
- 7 On 6 April 2016, the Applicant tendered registration certificates evidencing the fact that the same mark had been accepted for registration in Japan, Macau, Philippines, Russia, Taiwan, Korea, the United States of America, France, Spain, Portugal, Finland and Sweden. It also took the opportunity to repeat its earlier submission that the Application Mark had fanciful/distinctive features which "*sufficiently ensure that*" the Application Mark is "*capable of distinguishing [its] trade and/or services from those provided by any other person*".

- 8 On 12 April 2016, the Applicant was informed by a third examiner that the Section 7(1)(b) and 7(1)(c) objections were maintained in respect of all classes and all of the claimed goods and services.
- (a) Her approach was similar to that of the earlier examiners. She found that the word “MARVELOUS” carries a laudatory descriptive meaning (which she noted that the Applicant did not dispute). As regards the exclamation mark, she considered it to be a “*common punctuation mark used after a word or sentence for emphasis*”. Her view was that the exclamation mark and “*the use of uppercase and decreasing font for the term “MARVELOUS” and the eye catching colour orange*” further amplified the message conveyed by the word “MARVELOUS”, that is, that the Applicant provides goods and services of excellent quality. She was not persuaded that the Application Mark went beyond this descriptive message.
 - (b) As far as the registration certificates were concerned, the third examiner’s view was that trade mark rights are territorial and subject to each jurisdiction’s applicable laws. She also stated that the fact that the mark is registered in other jurisdictions is not sufficient in establishing that a trade mark is eligible for *prima facie* registration in Singapore.
- 9 Since the third examiner’s response following the request for reconsideration was a final refusal, the Applicant had to request for an *ex parte* hearing if it wanted to pursue the Subject Application further.

The *Ex Parte* Hearing

- 10 On 21 July 2016, the Applicant requested for an *ex parte* hearing. The oral *ex parte* hearing was held on 19 September 2016. On 8 November 2016, I informed the Applicant of my decision (without full grounds) to maintain the Section 7(1)(b) and 7(1)(c) objections in respect of all the goods and services claimed. On 7 December 2016, the Applicant requested for the full grounds of decision.

MAIN DECISION

Relevant Provisions

- 11 Sections 7(1)(b) and 7(1)(c) of the Act provide as follows:

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

- (a) ...
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) ...

12 Section 7(2) of the Act provides as follows:

A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Relationship Between the Grounds

13 Although the grounds in Sections 7(1)(b) and 7(1)(c) of the Act are listed as distinct, they are in reality connected in that they are both concerned with distinctiveness. To be specific, Section 7(1)(c) is a particular example (or sub-set) of the objection in Section 7(1)(b). (See the High Court's decision in *Han's (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 ("*Han's*") at [59].) This view is consistent with the fact that both grounds of objection can be overcome with evidence of acquired distinctiveness through use under Section 7(2).

14 For the above reasons, it is more convenient to first deal with Section 7(1)(c) before turning to Section 7(1)(b).

Section 7(1)(c) of the Act

15 The purpose of Section 7(1)(c) is to prevent the registration of signs which are descriptive of the goods or services or some characteristic of them. These descriptive marks are excluded from registration because they consist of signs or indications which honest traders either use or may wish to use without any improper motive. (See Mellor, Llewelyn, et. al., *Kerly's Law of Trade Marks and Trade Names* (15th Edition), Sweet & Maxwell (2011) ("*Kerly's*") at p 215, [8-087].)

16 The Applicant's submissions were advanced along three main lines.

- (a) First, the presence of a laudatory element in a mark does not render it descriptive within the meaning of Section 7(1)(c) if it does not serve to directly and specifically designate or describe the goods or services in respect of which registration is sought. According to the Applicant, the laudatory nature of the word "MARVELOUS" is such that it does not directly and specifically designate or describe the goods or services in question.
- (b) Second, there is sufficient stylisation in the Application Mark such that the mark is not devoid of any distinctive character. (The Applicant's arguments in this regard were made primarily in the context of Section 7(1)(b). Nevertheless, if the Applicant is correct in submitting that the stylisation is sufficient to confer inherent distinctiveness, it should by that same token be able to overcome the Section 7(1)(c) objection as well.)
- (c) Third, the Registrar has, in the past, allowed the registration of marks such as "Body Health" in Class 30, "Fresh" in Class 3, "Super Color" in Class 16, "Health Boosters" in Class 3, and "Marvel Gel" in Class 3. The Applicant sought to argue by analogy that the Application Mark should, too, be accepted for registration.

First Issue: Whether the Section 7(1)(c) objection only applies where the mark serves to directly and specifically designate or describe the goods or services

17 The sole word element in the Application Mark is an ordinary English word: “MARVELOUS”. Thus, in considering whether the Application Mark is descriptive within the meaning of Section 7(1)(c), a good starting point is to look at the dictionary definition of “MARVELOUS”. An online dictionary search of “MARVELOUS” on www.dictionary.com reveals the following:

adjective

1. superb; excellent; great:
a marvelous show.

2. such as to cause wonder, admiration, or astonishment; surprising; extraordinary.

3. improbable or incredible:
the marvelous events of Greek myth.

A search of “MARVELOUS” using the Oxford English Dictionary (OED) website (at www.oed.com) yields similar results. According to the online OED, the word has carried various meanings over time. I reproduce the definitions (for the word as it is presently used) below:

adj.

...

Such as to excite wonder or astonishment (chiefly in a positive sense); wonderful, astonishing, surprising; worthy of admiration. Also (esp. from the later ME. period until 16th cent.): having remarkable or extraordinary (and as if supernatural) properties.

...

colloq. In weakened sense (formerly sometimes regarded as an affectation in speech): extremely good or pleasing; splendid.

18 In its submissions for the *ex parte* hearing, the Applicant accepted that “MARVELOUS” is “*a broad laudatory term*”, which “*can be used to extol an almost infinite array of different products or services in the market*”.¹

19 Interestingly, the Applicant did not consider such an approach to be detrimental to its case. It took the view that the case law established the principle that “*a laudatory element [here: “MARVELOUS”] in a mark does not render it [i.e. the Application Mark] descriptive if it does not serve to directly and specifically designate or describe the goods or services in which registration is sought*”. Or, phrased in another way (by the Applicant), “*it is permissible for a mark to contain a laudatory word or term as long as the said mark would not permit the consumer to immediately make a definite and direct association with the specific goods or services in question*”.² In the Applicant’s submission, what this meant was that a word like “MARVELOUS” which “*arouses associations of ideas, contains an element of subjective assessment*” and “*is devoid of all specificity*” is not objectionable

¹ Applicant’s Written Submissions at [16].

² Applicant’s Written Submissions at [15].

under Section 7(1)(c) because it “*does not directly designate or describe the classes of goods and services*” in respect of which registration is sought.

- 20 The Applicant relied on a trio of EU decisions from the Court of First Instance (“CFI”) (now known as the General Court) in support of its arguments: *Dart Industries v OHIM* (T-360/00) dated 9 October 2002 (subject mark “ULTRAPLUS”) (“*ULTRAPLUS*”); *Deutsche Post EURO EXPRESS GmbH v OHIM* (T-334/03) dated 12 January 2005 (subject mark “EUROPREMIUM”) (“*EUROPREMIUM*”); and *Bank für Arbeit und Wirtschaft AG v OHIM* (T-87/00) dated 5 April 2001 (subject mark “EASYBANK”) (“*EASYBANK*”). In each case, the CFI found the subject mark not objectionable under the EU provision equivalent to our Section 7(1)(c).
- 21 However, I am not persuaded that the principles stated by the CFI in *ULTRAPLUS*, *EUROPREMIUM*, and *EASYBANK* represent the approach that I should adopt in assessing whether the Application Mark is objectionable under Section 7(1)(c). Those decisions are relatively dated, and there have been significant developments in European trade marks jurisprudence since then, as elaborated below.

BABY-DRY and the state of EU trade marks law at the time

- 22 *ULTRAPLUS* and *EUROPREMIUM* were decided having regard to, among other things, the principles stated in the Court of Justice’s decision in *Procter & Gamble v OHIM* (C-383/99) dated 20 September 2001 (subject mark “BABY-DRY”) (“*BABY-DRY*”). As it will be seen in the discussion below, *BABY-DRY* and the other cases decided around that time were indicative of the highly permissive attitude that the EU courts had (then) adopted towards descriptive marks.
- 23 In *BABY-DRY*, the goods in question were babies’ nappies. The Court of Justice held that in assessing whether the mark was distinctive, the question was whether the word combination in question (i.e. “BABY-DRY”) “*may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance*” (at [42]). The Court of Justice accepted that marks like “BABY-DRY” “*unquestionably allude to the function which the goods are supposed to fulfil*”. However, because of its “*syntactically unusual juxtaposition*” which was “*not a familiar expression in the English language, either for designating babies’ nappies or for describing their essential characteristics*”, the mark was found to be not objectionable under EC Reg. No. 40/94³: *BABY-DRY* at [43]. The court went further to say that the combination of the two words was a “*lexical invention*” which bestowed a distinctive character on the mark.
- 24 Echoes of *BABY-DRY* can be found in the CFI’s reasoning in *ULTRAPLUS* (wherein the subject mark was sought to be registered in respect of ovenware). In *ULTRAPLUS*, the CFI doubted that the relevant public would “*immediately and without further reflection make a definite and direct association between plastic ovenware and ‘UltraPlus’*” (at [26]). It held that where a trader “*extols, indirectly and in an abstract manner, the excellence of its products by way of a sign*” like “ULTRAPLUS”, yet “*without directly and immediately informing the consumer of one of the qualities of specific characteristics of the ovenware, it is a case of evocation and not designation for the purposes of [Section 7(1)(c)]*” (at [27]). The CFI concluded that it had not been shown by the Board of Appeal (which considered

³ Section 7(1)(c) of the Act is *in pari materia*.

the mark to be descriptive) that “ULTRAPLUS” served to designate those goods directly (at [28]). In the result, the CFI considered that the Board of Appeal erred in finding “ULTRAPLUS” to be descriptive under Art 7(1)(c) of EC Reg. No. 40/94.⁴

25 In **EUROPREMIUM** the subject mark was applied for in respect of, *inter alia*, postal transportation services and goods in the nature of packaging materials relating to transport. The CFI applied **BABY-DRY** for the proposition that “*only those signs descriptive of the essential characteristics of the goods or services in question, which as such may serve in common parlance to designate those goods or services, come within the prohibition*” (at [35]). As far as the EURO- prefix was concerned, the CFI was not persuaded that the origin of the goods (i.e. whether European or not) was an essential characteristic of goods or services relating to postal transport. It concluded that the prefix did not designate the goods and services at issue “*either directly or by reference to one of their essential characteristics and is therefore not descriptive of them*” (at [36]). As regards the suffix -PREMIUM, the CFI considered it to be one which extolled “*indirectly and in an abstract manner, the excellence of its products*” without “*directly and immediately informing the consumer of one of the qualities or specific characteristics of the goods and services in question*” (at [37], citing, *inter alia*, **ULTRAPLUS** at [27]). The CFI considered that as a whole, “**EUROPREMIUM**” was merely evocative of the “*impression of high-quality European goods and services without showing that that characteristic would enable the consumer to immediately and without further thought to establish a direct and concrete link*” to the goods and services in question (at [45]).

26 **BABY-DRY** is not without controversy.

- (a) In Tan Tee Jim, S.C., *Law of Trade Marks and Passing Off in Singapore* (3rd Edition), Sweet & Maxwell (2014), Vol. 1, the learned author states that the “*practical effect of [the **BABY-DRY**] decision was to lower the threshold of distinctiveness in respect of a composite word mark in the EU. Such a mark would be registrable if it is not an everyday term, has an opaque grammatical structure or is suggestive, elliptical, indirectly descriptive or unusual*” (p 330 at [7.056]).
- (b) Other commentators have described the case as being “*now generally viewed as the high point of the Court of Justice’s liberal attitude to registrability of descriptive marks*”: Cornish, Llewelyn & Aplin, *Intellectual Property: Patents, Copyright, Trade Marks & Allied Rights* (8th Edition), Sweet & Maxwell (2013) (“*Cornish, Llewelyn & Aplin*”) at p 723. The authors of *Cornish, Llewelyn & Aplin* go on to explain that the later Court of Justice decision in **OHIM v Wrigley** (C-191/01 P) (subject mark “**DOUBLEMINT**”, dated 23 October 2003) (“**DOUBLEMINT**”) “*indicates a realisation... that matters had gone too far and needed to be reined in: in refusing registration of “Doublemint” for chewing gum (critically, without evidence of acquired distinctiveness), the court held that there is a public interest that descriptive terms may be freely used by all traders. This is so whether the use by other traders has already occurred or may in the future, and whether it is “commercially essential or merely ancillary*”: Cornish, Llewelyn & Aplin at p 723.

⁴ See footnote 3 above.

- (c) A similar refrain is found in *Kerly's* where the learned authors consider that “*parts of [the “BABY-DRY” case] are wrong and the remainder requires substantial qualification by reference to later Court of Justice judgments*”: *Kerly's* at [8-094], p 218.

EU trade marks law after DOUBLEMINT

27 The Court of Justice’s decision in *DOUBLEMINT* is significant because it declined to follow the approach that it had earlier laid down in *BABY-DRY*. (In *DOUBLEMINT* the application was for mint flavoured chewing gum.)

- (a) The lower court (then the CFI) had held that the mark was registrable. Pivotal to the CFI’s conclusion was its finding that “*DOUBLEMINT*” carried two possible meanings: either twice the usual amount of mint, or flavoured with two varieties of mint. Because of this “*ambiguous and suggestive meaning which is open to various interpretations*”, the CFI was of the view that the term did not “*enable the public concerned*” to “*immediately and without further reflection... detect the description of a characteristic of the goods in question*”. It concluded that “*DOUBLEMINT*” was not “*exclusively descriptive*”: Case T-193/99 at [30] – [31].
- (b) On appeal, the Court of Justice overturned the CFI’s ruling. In so doing, it rejected the “*exclusively descriptive*” test applied by the CFI. In the Court of Justice’s view, the flaw in the CFI’s approach was that it had failed (by its application of the “*exclusively descriptive*” test) to “*ascertain whether the word at issue was capable of being used by other economic operators to designate a characteristic of their goods and services*” (at [34]). The Court of Justice considered that a sign must be refused registration under the provision if “*at least one of its possible meanings designates a characteristic of the goods or services concerned*”. In this respect, it is “*not necessary that the signs and indications composing the mark*” in question “*actually be in use at the time of the application for registration in a way that is descriptive of goods or services*”; rather, it is sufficient that it “*could be used for such purposes*” (at [32]).

28 There were further developments in EU trade marks law after *DOUBLEMINT* which confirmed that the Court of Justice had moved away from a highly permissive treatment of descriptive marks represented by cases such as *BABY-DRY*.

Principles

29 The position in Singapore is aligned with the post-*DOUBLEMINT* position in the EU. The High Court in *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 (the “*Love*” case) expressly relied on *DOUBLEMINT* at [70], as well as on *Kerly's* at [70], [74] and [80]. As such, it is apposite to refer to *Kerly's* (at [8-089], pp 215 – 217) where the learned authors have distilled and summarised the essential principles relating to the descriptiveness objection under European trade marks law. (The relevant provisions in the Act have been substituted for the relevant European provisions.)

- (1) [Section 7(1)(c)] is in the public interest, *to ensure that descriptive terms may be freely used by all*. Recently the Court of Justice has taken to referring to the “general

- interest” underlying the provisions in [Section 7(1)(c)], rather than the public interest.
- (2) The signs and indications referred to in [Section 7(1)(c)] are those which may serve *in normal usage from a consumer’s point of view* to designate, *either directly or by reference to one of their essential characteristics*, goods or services such as those in respect of which registration is sought.
 - (3) The situations specifically covered by [Section 7(1)(c)] are those in which the sign *is capable of designating* a “characteristic” of the goods or services referred to in the application. The terms mentioned in [Section 7(1)(c)] must all be regarded as characteristics, but the list is not exhaustive.
 - (4) The provision extends to *any characteristic whatsoever* of goods or services, *irrespective of how significant the characteristic may be commercially*.
 - (5) The property [or characteristic] in question must be easily recognisable by the relevant class of persons.
 - (6) *It is not necessary that such descriptive terms are actually in use, it is sufficient that such signs and indications could be used* to designate a characteristic of the goods or services.
 - (7) Accordingly, a sign must be refused under [Section 7(1)(c)] *if at least one of its possible meanings* designates a characteristic of the goods or services concerned.
 - (8) Likewise, *it is irrelevant if there are other, more usual signs or indications for designating a particular characteristic* of the goods or services. These provisions *do not require that the sign or indication under examination should be the only way of designating the characteristic in question. It is irrelevant if there are synonyms*. It follows that [Section 7(1)(c)] *does not require the sign at issue to be the usual means of designation*.
 - (9) As a general rule, *a mere combination of elements, each of which is descriptive of characteristics of the goods or services, itself remains descriptive. However, the combination may not be descriptive if there is a perceptible difference between the resultant combination and the mere sum of its parts, where the unusual nature of the combination in relation to the goods or services creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts or the combination has acquired its own meaning, with the result that it is now independent of its components*.
 - (10) The existence of a specific defence [Section 28(1)(b)] does not limit the scope of [Section 7(1)(c)]. In fact the existence of the defence discloses the need for [Section 7(1)(c)] to be applied to any sign which may designate a characteristic of the goods or services for which registration is sought.
 - (11) The term “exclusively” requires a purposive approach.

(Emphasis in italics added.)

I consider the above principles to be of guidance in interpreting and applying Section 7(1)(c).

- 30 Returning to the present case, it is clear from the above principles that the Applicant’s proposition is too narrow. It is incorrect to say that this ground of refusal only applies where the mark allows the average consumer to “*immediately make a definite and direct association with the specific goods or services in question*”. The Applicant’s suggested approach is in essence the same as the “*exclusively descriptive*” test which was applied by the CFI but subsequently rejected by the Court of Justice in **DOUBLEMINT** and I see no reason why I should accept it.
- 31 The Applicant also relied on **EASYBANK** (which was decided prior to **BABY-DRY**) for the same proposition (i.e. that a laudatory element in a mark does not render it descriptive if it does not serve to directly and specifically designate or describe the goods or services in respect of which registration is sought). For the reasons above, the Applicant’s reliance on this case is misplaced.
- 32 Further and in any event, the Application Mark has only one word element: “MARVELOUS”. On the other hand, in each of the CFI cases relied on by the Applicant the subject mark was formed from a combination of two different words: i.e. EASY+BANK, EURO+PREMIUM, and ULTRA+PLUS. The present case is thus distinguishable on this basis as well.

Application

- 33 In the table below, I apply the relevant principles to the specific goods or services in the relevant classes applied for under the Subject Application.

Class / Goods or Services	Decision
<u>Class 9</u> Arcade games (apparatus for-) adapted for use with an external display screen or monitor; Telecommunication devices and apparatus; Electronic machines, apparatus and their parts; Consumer games (apparatus for-) adopted for use with an external display screen or monitor; Electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; Phonograph records; Metronomes; Electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; Downloadable music	From the consumers’ point of view, the Application Mark, in its normal usage, is capable of designating all the goods applied for either directly or by reference to one of their essential characteristics. This is especially so given that the goods in respect of which registration is sought relate to technology of some sort, and the laudatory term “MARVELOUS!” would thus indicate to consumers the kind or quality (<i>i.e.</i> superb, excellent, great) or intended purpose of the goods (<i>i.e.</i> to cause one to marvel in wonder, admiration or surprise). Indeed, the term “MARVELOUS!” can be used descriptively, for instance, to describe telecommunication devices (such as mobile phones) . The same would apply, for example, to phonograph records, or downloadable music files, as claimed. In arriving at this conclusion I am

files; Exposed cinematographic films; Exposed slide films; Slide film mounts; Downloadable image files; Recorded video discs and video tapes; Electronic publications.

mindful that it is irrelevant how significant the characteristic may be commercially, and that it is irrelevant whether “MARVELOUS!” is *in fact* in use for such goods. It is also irrelevant that there could be other ways of designating the goods or the characteristic in question. All that I need to be satisfied of is that at least one of the Application Mark’s possible meanings *could* be used to designate the goods (or any of their characteristics). The objection is thus maintained.

Class 16

Banners of paper; Flags of paper; Hygienic hand towels of paper; Towels of paper; Table napkins of paper; Hand towels of paper; Handkerchiefs of paper; Paper and cardboard; Stationery and study materials; Printed matter; Paintings and calligraphic works; Photographs; Photograph stands.

The goods applied for in this class fall into two broad categories: paper (and related products such as stationery); and artistic products such as paintings and photographs (and related accessories such as photograph stands). “MARVELOUS!” in its normal usage can be used to describe the quality of paper (and related products). For instance, paper, stationery and study materials can be lauded as being “MARVELOUS!” in quality or characteristic. As for artistic products such as paintings and calligraphic works, or photographs, “MARVELOUS!” may denote the intended purpose of the goods (that is, to cause one to marvel at the art works in admiration) or as a description of their high quality. To my mind, it is clear that the objection must be maintained in respect of all the goods as well.

Class 28

Amusement machines and apparatus for use in amusement parks (other than arcade video game machines); Toys for domestic pets; Toys; Dolls; Go games; Japanese playing cards [Utagaruta]; Japanese chess [Shogi games]; Dice; Japanese dice games [Sugoroku]; Dice cups; Diamond games; Chess games; Checkers [checker sets]; Conjuring apparatus; Dominoes; Playing cards; Japanese playing cards [Hanafuda]; Mah-jong; Game machines and apparatus; Billiard equipment.

The goods applied for in this class all relate to games and related equipment or apparatus of different types. These goods can either directly or by reference to their essential characteristics be described as being “MARVELOUS!” and therefore the reasoning in the sub-paragraphs above would apply here as well. Thus I maintain the objection in respect of all the goods in this class for which registration is sought.

Class 41

Educational and instruction services relating to arts, crafts, sports or

The services claimed in this class are varied, and fall into three general categories: educational

general knowledge; Providing of electronic publications; Services of reference libraries for literature and documentary records; Publication of books; Planning or arrangement of showing movies, shows, plays or musical performances; Movie showing, movie film production, or movie film distribution; Presentation of live show performances; Direction or presentation of plays; Presentation of musical performance; Production of radio or television programs; Production of video tape film in the fields of education, culture, entertainment or sports [not for movies, radio or television programs and not for advertising and publicity]; Organization, management or arrangement of entertainment (excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and autoraces); Providing audio or video studio services; Providing amusement facilities; Providing game services used via the internet and providing information about this; Rental of records or sound-recorded magnetic tapes; Rental of image-recorded magnetic tapes; Rental of toys; Rental of amusement machines and apparatus; Rental of game machines and apparatus.

services; entertainment services; and rental services. I consider “MARVELOUS!” to be obviously descriptive of the first two categories (educational and entertainment services). In the case of services relating to education, “MARVELOUS!” may naturally be used to describe the kind, quality and intended purpose of the services. The same would apply for entertainment services.

Although an argument can be made that one does not routinely describe rental services *in themselves* as being “MARVELOUS!”, I cannot simply disregard what is being rented out (as claimed in the specification of services). Here, protection is sought in respect of rental services relating to products such as magnetic tapes, toys, amusement machines, and game machines and I have found (see sub-paras (a) and (c) above) that the Application Mark is descriptive of such these goods (and related goods).

In the premises, I maintain the objection for all the services claimed in this class.

Second Issue: Whether the stylisation is sufficient to overcome the Section 7(1)(c) objection

34 For ease of reference, the Application Mark is set out below.



35 I am mindful that in assessing the Application Mark for inherent distinctiveness, it is not appropriate for me to dissect the mark into separate components and assess each component

without having regard to the mark as the whole. (See Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 (“Ng-Loy”), p 342 at [21.3.37], citing *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [35].)

36 It is a trite and long standing principle that the inherent distinctiveness of a mark “*must be assessed by reference to the goods or services in respect of which registration is sought as well as the perception of the relevant persons, namely the consumers of those goods or services*” (see *Societe des Produits Nestle SA v Petra Foods Limited* [2016] SGCA 64 at [33])⁵.

37 I note that in the *Han’s* case, Wei JC (as he then was) sitting in the High Court found that the plain word marks “Han’s” and “HAN’S” were devoid of any distinctive character (although they had acquired distinctiveness through use). However, the fact that “Han’s” as a word did not possess distinctive character on its own was considered to be no impediment to a finding that the Han’s composite marks (represented below) possessed a much higher level of inherent distinctiveness which provided them with a distinctive character. In his view, the “*unique stylisation and typeface of the Han’s composite marks (within the framed outline)*” were “*sufficient to support the conclusion that [the said composite marks] possess a distinctive character*” (at [95]).



38 The Applicant referred to *Han’s* and argued, by analogy, that the Application Mark should similarly be considered to be distinctive “*due to the deliberate and imaginative design features incorporated within the [Application Mark]*”.⁶ These design features, according to the Applicant, are the “*distinctive 3D get-up, with the orange-coloured capital letters slanting upwards from left to right*” and “*[e]ach letter in the [Application Mark being] also asymmetrical and decreas[ing] in font size from left to right*”. The Applicant further contended that the Application Mark “*incorporates a distinctive inconsistency or ‘imperfection’ into its design*” in that the letters M, A and R are “*conjoined while the subsequent letters are not*”. It described the “*deliberately asymmetrical and imperfect design*” of the Application Mark as one which reflected the Japanese aesthetic concept of “*wabi-sabi*”. To explain what this meant, the Applicant tendered a Wikipedia article on “*wabi-sabi*” together with its written submissions.

39 In my judgment, it is plain to see that the mark has only one central semantic element: the word “MARVELOUS” (its meaning having been set out at [17] above), accentuated by an exclamation mark. I note that the Application Mark is represented in block capital letters in the colour orange and features some minor stylisation. There are two key aspects of the stylisation which are apparent to the eye. One: the font size of each letter appears to

⁵ Although the decision was issued after this *ex parte* hearing, the Court of Appeal was simply restating a well established principle.

⁶ Applicant’s Written Submissions at [25].

decrease with each successive letter. Two: the letters in the Application Mark appear to be slanted. Their combined effect is that a viewer is given the impression that the Application Mark is angled to one side.

- 40 However, I must confess that I had difficulty noticing that the letters M, A and R are conjoined at the base whereas the remaining letters are not. On my part, I was not aware of this until the Applicant drew it to my attention, and I very much doubt that the average consumer exercising ordinary care and attention would notice such a feature. I also find it hard to see how the stylisation in the Application Mark amounts to a 3D get-up. (In any case, the Application Mark is not applied for in three dimensions.) The most that can be said is that the angled-to-one-side effect gives the Application Mark the illusion of depth.
- 41 As regards the concept of “*wabi-sabi*”, the Applicant may have intended for the Application Mark to contain aspects of asymmetry and imperfection. But any asymmetry inherent in the Application Mark is simply part of the angled effect and is not, to my mind, a design feature which conveys trade mark significance. Even if (a point which I am unable to accept) average consumers in Singapore were to notice that there is imperfection in the Application Mark in that there are 3 joined letters but 6 unjoined letters, surely they would attribute this as nothing more than part of the visual depth effect. (For completeness, I should also state that while I have noted the contents of the Wikipedia article on “*wabi-sabi*” as being explanatory of what the Applicant means (by its use of that term), I make no finding of fact in this regard. After all, any documents that the Applicant wished to tender as evidence of a fact should have been filed by way of Statutory Declaration: see for e.g. *Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd* [2014] SGIPOS 11 at [15] – [25]; *Stora Enso Oyj v PT Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia TBK Ltd* [2016] SGIPOS 12 at [119] – [122].)
- 42 All things considered, the stylisation does not serve to confer upon the Application Mark any distinctive character. The features on which the Applicant laboured, at some length, are unlikely to alter the public perception of the Application Mark as a direct description of the quality, intended purpose or other characteristics of the goods and services. At best, the stylisation accentuates the one descriptive and laudatory message conveyed by the Application Mark: that the goods or services under the Application Mark are indeed “MARVELOUS”! Ultimately, the Application Mark is a very different mark from the composite marks in the *Han’s* case, which were stylised to a significant degree. By way of illustration, consider the letters “a” and “n” in the Han’s composite marks. The unique typeface for the letter “a” (represented as “”) is such that a viewer needs to fill in the gaps mentally in order to recognise it as the letter “a”, as opposed to simply a circle, a semi-circle, and a vertical line. As for the letter “n” in , it is essentially comprised of two bold vertical columns which are not even joined together such that it could be viewed as “ll” (as in “Hall’s”) instead of “n”. On the other hand, each of the letters in the Application Mark is in ordinary typeface.
- 43 For the reasons above, I find that the stylisation in the Application Mark is not sufficient to support a conclusion that it enjoys inherent distinctive character.

Third issue: Significance of other cases where the subject mark was accepted for registration

44 It was argued that the Registrar of Trade Marks had, in the past, allowed the registration of marks such as “Body Health” in Class 30, “Fresh” in Class 3, “Super Color” in Class 16, “Health Boosters” in Class 3, and “Marvel Gel” in Class 3.

45 However, I do not consider these registrations of various vintage as being of assistance in the present case. It has been said that although conformity of the register is desirable, registry decisions in the past can do no more than give an indication of what has or has not been thought acceptable, and the registrability of a mark has to be considered on the facts of each case and in particular the goods or services in respect of which registration is sought: see **KUDOS TRADE MARK** [1995] RPC 242 at page 245.

46 Support for this approach may also be found in **British Sugar PLC v James Robertson & Sons Ltd.** [1996] RPC 281 at 305 where Jacob J stated as follows:

Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. **MADAME Trade Mark** and the same must be true under the 1994 Act. I disregard the state of the register evidence.

Section 7(1)(b)

47 I now address the other objection to the Application Mark under Section 7(1)(b) of the Act, *i.e.* that it is “*devoid of any distinctive character*”.

48 A mark can be devoid of any distinctive character for the purposes of Section 7(1)(b) without also being unduly descriptive for the purposes of Section 7(1)(c). However, a mark which is unduly descriptive for the purposes of Section 7(1)(c) is necessarily devoid of distinctive character for the purposes of Section 7(1)(b). (See *Kerly’s* at [8-057], pp 203 – 204 and the case law cited therein.)

49 I have found that the Application Mark is unduly descriptive and hence objectionable under Section 7(1)(c). For these same reasons I find that the Application Mark is devoid of distinctive character, in that it is not likely to function as a readily obvious and reliable badge of origin in the eyes of the average discerning consumer when it is used in relation to the goods and services claimed in Classes 9, 16, 28 and 41. (See principles in **Love** at [53].)

50 During oral submissions the Applicant confirmed that the cases relied on in respect of the Section 7(1)(c) ground (*i.e.* **ULTRAPLUS**, **EUROPREMIUM** and **EASYBANK**) are also relied on for the purposes of this ground. The analysis at [20] to [33] above, and the reasons for why I consider these cases to be unpersuasive, apply here as well.

51 The Applicant also argued, under this ground, that I should take into account the stylisation in the Application Mark. I have dealt with this submission in [35] – [43] above and my findings therein apply here equally.

Relevance of Foreign Registrations

52 It was also argued that I should take into account the fact that the Application Mark has been accepted for registration in various other jurisdictions, and that this shows that it possesses, at the minimum, some distinctiveness. However, registrations in foreign jurisdictions may serve, at most, as a guide to what the relevant consumers in other jurisdictions, sometimes in non-English speaking countries, may regard as possessing inherent distinctive character (assuming that is even the applicable test in those other jurisdictions, a matter on which there is no evidence). Ultimately I have to decide by reference to the relevant consumer in Singapore and in my judgment the Application Mark is devoid of any distinctive character.

Evidence of Acquired Distinctiveness Through Use

53 The Applicant had the option of overcoming the Section 7(1)(b) and 7(1)(c) objections by filing evidence (by way of Statutory Declaration) to show that the Application Mark had become distinctive through use prior to the application date of 11 March 2014, so as to satisfy Section 7(2). However, it did not do so.

54 During the hearing, I asked whether the Applicant could consider filing evidence of use of the Application Mark in Singapore. In response, I was told that the Application Mark had only been adopted 2 years ago in 2014 when Marvelous AQL Inc. became Marvelous Inc., and that the use was mainly online, hence it was harder to show evidence of use.

55 Although the Applicant did not file any evidence of acquired distinctiveness through use, it invited me to consider a few documents which were submitted together with its written submissions. These documents purported to show some use of the Application Mark (presumably outside of Singapore, especially since some of them contain characters in the Japanese language). This was clearly improper. As explained at [40] above, any documents that the Applicant wished to tender as evidence of a fact should have been filed by way of Statutory Declaration. I therefore do not take these documents into account.

56 However, even if I were to take the documents into account, I find it difficult to see how any of them assisted the Applicant's case. I was referred to the document at page 18 of the Applicant's Written Submissions, which was introduced as being a cover of a Nintendo 3DS game. My attention was drawn to the lower right corner of the cover which contained a representation of the Application Mark. I must say that it is very small indeed and did not catch the eye. This is consistent with what I was told during oral argument: that on each cover, I would see the title of the game itself, which is of greatest prominence. I was also told that the mark was not conspicuous *because the main selling point is the name of the game itself*. I was further informed that this was the same way in which the Application Mark was used in the other samples of video game covers (and having looked through them I agree that this is the case). In my view, based on the documents annexed to the Applicant's written submissions, if this is indeed the manner in which the Application Mark has been used outside of Singapore, it only confirms that average consumers would not regard the Application Mark as an indicator and badge of origin. Instead, average consumers would

regard it as no more than a broad laudatory assertion that the game contained within the case or box is indeed one which is “MARVELOUS!” in the descriptive sense.

Disclaimer

57 I do not have to consider the issue of whether the Subject Application should be allowed if the word “MARVELOUS” was disclaimed, as such a disclaimer was not offered in submissions before me. However, even if it were, I would be mindful that the public, including other traders, would not necessarily be aware of the existence of a disclaimer on the register. At the same time, once one is aware that the register could or should be inspected for any limitations or disclaimers, I recognise that it is relatively straightforward to check the register, which is accessible online. The considerations in [58] and [59] below are also relevant in a disclaimer scenario. It may be useful to revisit this issue in a future case, with the benefit of full submissions.

Conclusion

58 The effect of allowing a sign to be registered on the Trade Marks Register is to give an applicant a monopoly over the sign in respect of goods and services claimed. The monopoly extends to similar marks if used on identical or similar goods and/or services, such that there exists a likelihood of confusion on the part of the public: Section 27 of the Act. If another trader, acting *bona fide*, uses the plain word “MARVELOUS” in relation to computer software (which are goods claimed by the Applicant here), he would be faced with uncertainty whether his use of “MARVELOUS” would infringe the Application Mark



. This should not be the case. With regard to nearly-descriptive marks, the following observations in *Nichols Plc's Trade Mark Application* [2002] EWHC 1424 (Ch) at [14] are instructive:

[I]n the practical world powerful traders will naturally assert their rights even in marginal cases. By granting registration of a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark one is placing a powerful weapon in powerful hands. Registration will require the public to look to its defences. With such words or phrases the line between trade mark and descriptive use is not always sharp. Moreover, it must not be forgotten that the monopoly extends to confusingly similar marks. In any marginal case defendants, SMEs particularly, are likely to back off when they receive a letter before action. It is cheaper and more certain to do that than stand and fight, even if in principle they have a defence.

59 In a similar vein, Wei J opined in *Han's* at [65]-[66], [88]:

Allowing a trader to register and obtain a monopoly on words and phrases which other traders may wish to use in respect of their goods and services for entirely legitimate purposes (including competition) is clearly not in the public interest... This is why the law shies away from granting rights over descriptive phrases and words of praise... The fact that there is a defensive limitation which may mitigate some of the effects of registration does not mean that the Registry of Trade Marks or courts are to lean in favour of registration.

60 In conclusion, I uphold the examiners' objections under Sections 7(1)(b) and (c) of the Act. The Subject Application is thus refused in respect of all goods and services applied for.

Dated this 6th day of February 2017

See Tho Sok Yee

Principal Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore

[The appeal from this decision to the High Court was dismissed.]