

Intellectual Property Office of Singapore Case Summary: In the matter of a trade mark application by Marvelous AQL Inc. [2017] SGIPOS 3

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Marvelous AQL Inc. (the “Applicant”) filed an application to register the mark:  (the “Application Mark”) in Classes 9, 16, 28 and 41 for a variety of goods and services. In the course of examination, objections to the Application Mark on the basis of Sections 7(1)(b) and 7(1)(c) of the Trade Marks Act (Cap. 332) (the “Act”) were raised. After an *ex parte* hearing, the Registrar maintained both objections in respect of all the claimed goods and services.

Section 7(1)(c): Descriptiveness

Section 7(1)(c) prevents the registration of signs which are descriptive of the goods or services or some characteristic of them. The Applicant accepted that the word “MARVELOUS” carried a laudatory descriptive meaning. However, it submitted that the Application Mark should not be refused registration for the following reasons. 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 and services*”. Second, there was sufficient stylisation in the Application Mark such that it was not devoid of any distinctive character. Third, the Registrar had, in the past, allowed registration of marks which the Applicant considered to be descriptive.

In rejecting the Applicant’s first submission, the Registrar noted that the EU cases the Applicant had relied upon were relatively dated, and there had been significant developments in EU trade marks jurisprudence since then. One important development was the DOUBLEMINT case (*OHIM v Wrigley* (C-191/01 P)) wherein the European Court of Justice rejected the lower court’s “exclusively descriptive” test, which was in essence the same test as the one advanced by the Applicant. The DOUBLEMINT case made it clear that: (1) “*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”*”; (2) 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 [the mark in question] “*could be used for such purposes*”. On the facts, the Application Mark, in its normal usage, was found to be capable of designating all the goods and services claimed either directly or by reference to one of their essential characteristics. The laudatory term “MARVELOUS!” would indicate to consumers the kind or quality (i.e. superb, excellent, great) or intended purpose (i.e. to cause one to marvel in wonder, admiration or surprise).

In rejecting the Applicant’s second submission, the Registrar found the stylisation in the mark to be minor and in any case insufficient to confer upon the Application Mark any distinctive character.

In rejecting the Applicant’s third submission, the Registrar held that the registrability of a mark has to be considered on the facts of each case and considered the past registrations as ultimately being of no assistance.

Section 7(1)(b): Non-distinctiveness

Section 7(1)(b) prohibits the registration of signs which are devoid of any distinctive character. A mark which is unduly descriptive for the purposes of Section 7(1)(c) is necessarily devoid of distinctive character under Section 7(1)(b). Since the Registrar had found the Application Mark to be objectionable under Section 7(1)(c) and the Applicant was relying on the same arguments that it ran under Section 7(1)(c) under this ground, this objection was maintained as well.

As an ancillary note, the Applicant did not claim that the Application Mark had acquired distinctiveness as a result of the use made of it. This decision was based on the Applicant’s submissions, without evidence of use.

Disclaimer: The above is provided to assist in the understanding of the Registrar’s grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.