

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

Trade Mark Nos. 40201511598P and 40201511601W
24 September 2018

**IN THE MATTER OF TRADE MARK REGISTRATIONS
IN THE NAME OF
INTERCONTINENTAL EXCHANGE HOLDINGS, INC.**

AND

**APPLICATIONS FOR DECLARATION OF INVALIDITY THEREOF BY
CHICAGO MERCANTILE EXCHANGE INC.**

Hearing Officer: David Llewelyn
IP Adjudicator

Representation:

Mr Melvin Pang and Mr Nicholas Tong (Amica Law LLC) for the Applicant
Ms Yvonne Tang and Ms Jasmin Kaur Khosa (Drew & Napier LLC) for the Registered
Proprietor

GROUND OF DECISION

1 A registered trade mark is a potentially valuable property right that, even without any prior use in Singapore, may be used by its proprietor to prevent or restrain the use by another of the same or similar mark in relation to goods and/or services the same or similar to those for which the mark is registered. It is for that reason that the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) sets out various categories of marks that should not be accorded the significant benefits of registration (without evidence of

acquired distinctiveness) as to allow this would provide their owners with a legal right capable of being used to restrain legitimate competition. If, notwithstanding this, a mark has been registered, the Act provides a means for a subsequent attack on the validity of the registered mark on the ground that it did in fact fall within one or more of those categories at the time of application (provided it has not acquired distinctiveness as an indication of trade origin of the relevant goods or services after that date) and therefore should be removed from the register.

2 Another manner in which the trade mark registration system in Singapore seeks to ensure overall fairness between trade mark proprietors and other traders is to require that trade mark applicants state that either (a) the mark applied for has already been used in Singapore or (b) it is their bona fide intention that it be so used, in relation to the goods or services set out in the specification that forms an essential part of the application process and any registration that results. Unlike a patent, a registered trade mark is not accorded monopoly protection but instead its scope of protection is dictated by the specification of goods or services for which registration has been granted. Thus, this statement by trade mark applicants is not one that should be viewed lightly by legal advisers or made by their clients applying for trade mark registrations without careful consideration as to its veracity in the circumstances.

3 Intercontinental Exchange Holdings, Inc. is the Registered Proprietor (“the Proprietor”) of the following trade marks in Singapore:

Trade Mark No.	Mark
40201511598P	<p style="text-align: center;">BRENT</p> <p style="text-align: center;">(referred to in this decision as the “BRENT mark”)</p>
40201511601W	<p style="text-align: center;">BRENT INDEX</p> <p style="text-align: center;">(referred to in this decision as the “BRENT INDEX mark”)</p>

(collectively referred to as “the Subject Marks”)

The Subject Marks were registered on 6 July 2015 (“Relevant Date”) in Class 36 in respect of the following services:

“Financial services, namely, calculating, collecting, compiling, analyzing, estimating, evaluating, and reporting financial price indices and related information for use in transactions involving financial instruments; providing information in the field of financial transaction settlement rates, financial margin rates of financial instruments and currency exchange rates; operating a commodities and commodity derivatives exchange; providing financial exchange services for transactions involving currencies, commodities, futures, derivatives, securities, shares, stocks, options and bonds; financial clearing and clearing house services, namely, clearing financial transactions involving currencies, commodities, futures, derivatives, securities, shares, stocks, options and bonds; financial investment and advisory services; monitoring of global financial markets for others, also known as, global investment research services;

disseminating real-time and historic financial news, data and information for the purchasing, selling, administering, managing, monitoring, settling, clearing, pricing, valuing and tracking of global financial markets, currencies, commodities, futures, derivatives, securities, shares, stocks, options and bonds; financial research and analysis services; brokerage services involving currencies, commodities, futures, derivatives, securities, shares, stocks, options and bonds; financial planning; and providing all of the aforesaid services on-line from a global computer network, the internet and interactive electronic media in the nature of computer terminals and mobile communication devices.”

4 Chicago Mercantile Exchange Inc. (“the Applicant”) applied for declarations of invalidity (“the Applications”) on 27 July 2016. Counter-statements were filed by the Proprietor on 23 November 2016 in defence of the registrations of the Subject Marks. The Applicant filed evidence in support of its applications for declarations of invalidity on 9 May 2017. The Proprietor filed evidence in support of the registrations on 8 September 2017. The Applicant filed evidence in reply on 8 January 2018. Following the close of evidence, a Pre-Hearing Review was held on 7 February 2018. Leave was eventually granted to the parties to file supplementary evidence. The Proprietor filed its supplementary evidence on 5 June 2018. The Applicant filed its supplementary evidence in reply on 3 July 2018. The parties then filed their written submissions (“Written Submissions”) and, later, made their oral submissions before me on 24 September 2018.

Grounds of Invalidation

5 The Applicant relies on three grounds in the Act. They are Sections 7(1)(b), 7(1)(c) and 7(1)(d); all read with Section 23(1) which states:

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

Applicants’ Evidence

6 The Applicant’s evidence comprises the following:
in relation to the BRENT mark,

- (i) a Statutory Declaration made by Matthew J. Kelly, managing director and chief intellectual property counsel of the Applicant, on 5 May 2017 in Illinois, the United States of America (“Applicant’s SD-MJK-1”);
- (ii) a Statutory Declaration in Reply made by the same Matthew J. Kelly, on 7 December 2017 in Illinois, the United States of America (“Applicant’s SDR-MJK-1”);
- (iii) a supplementary Statutory Declaration in Reply made by the same Matthew J. Kelly, on 20 June 2018 in Illinois, the United States of America (“Applicant’s SDDR-MJK-1”); and,

in relation to the BRENT INDEX mark,

- (iv) a Statutory Declaration made by Matthew J. Kelly, managing director and chief intellectual property counsel of the Applicant, on 5 May 2017 in Illinois, the United States of America (“Applicant’s SD-MJK-2”);
- (v) a Statutory Declaration in Reply made by the same Matthew J. Kelly, on 7 December 2017 in Illinois, the United States of America (“Applicant’s SDR-MJK-2”); and
- (vi) a further Statutory Declaration in Reply made by the same Matthew J. Kelly, on 20 June 2018 in Illinois, the United States of America (“Applicant’s SDR-MJK-3”).

Proprietor’s Evidence

7 The Proprietor’s evidence comprises the following:
in relation to the BRENT mark,

- (i) a Statutory Declaration made by David C. Clifton, vice president, associate general counsel of mergers and acquisitions of the Proprietor, on 6 September 2017 in Georgia, the United States of America (“Proprietor’s SDR-DCC-1”); and
- (ii) a supplementary Statutory Declaration made by the same David C. Clifton, on 31 May 2018 in Georgia, the United States of America (“Proprietor’s SSD-DCC-1”); and,

in relation to the BRENT INDEX mark,

- (iii) a Statutory Declaration made by David C. Clifton, vice president, associate general counsel of mergers and acquisitions of the Proprietor, on 6 September 2017 in Georgia, the United States of America (“Proprietor’s SDR-DCC-2”); and
- (iv) a supplementary Statutory Declaration made by the same David C. Clifton, on 31 May 2018 in Georgia, the United States of America (“Proprietor’s SSD-DCC-2”).

Applicable Law and Burden of Proof

8 As the applicable law is the Act, there is no overall onus on the Proprietor either before the Registrar during examination or in invalidation proceedings. The undisputed burden of proof in the present case falls on the Applicant.

Background

9 Both the Applicant and the Proprietor (or “Respondent”) are large corporations headquartered in the United States of America that are involved in the business of operating market exchanges, including the generation and dissemination of data, for a variety of financial products.

10 The Proprietor (known also as “ICE”), a Fortune 500 company, operates a number of leading exchanges such as the New York Stock Exchange and ICE Futures Europe (formerly known as the International Petroleum Exchange) and offers a broad range of trading, clearing and risk management services in relation to regulated futures and over-the-counter (“OTC”) markets, including the provision of a variety of market

information on historical and real-time prices, indexes and tick-data (as described in Annex A to both Proprietor’s SDR-DCC-1 and SDR-DCC-2).

11 The Applicant is one of the corporate entities forming CME Group Inc. (the others are the New York Mercantile Exchange Inc. (known as “NYMEX”), Commodity Exchange, Inc. (“COMEX”) and Board of Trade of the City of Chicago, Inc. (“CBOT”)) and operates marketplaces for the exchange, trading and clearing of both physical and derivative financial products, including interest rates, equity indices, foreign exchange, energy, agricultural commodities, metals, weather, and real estate (see Applicant’s SD-MJK-1, at [3]).

MAIN DECISION

12 The absolute grounds for refusal of a trade mark contained in Section 7(1)(b), (c) and (d) of the Act, relied on by the Applicant, are three of a number of bases on which a trade mark may be removed from the register after its entry thereon, upon an application for invalidity brought under Section 23(1) of the Act. The effect of a successful application under Section 23(1) is that the trade mark is removed forthwith and is treated as if it had never been registered, unless the Proprietor can avail itself of the exception provided by Section 23(2) by establishing that, notwithstanding having been unregistrable at the date of application, the trade mark has in fact acquired distinctiveness subsequent to that date. (It should be noted that both the Applicant, at [3] of its Written Submissions, and the Proprietor, at [9] of its Written Submissions, stated that the date relevant in these applications is 11 June 2015, the date from which priority is claimed by reason of the Proprietor’s corresponding trade mark applications in the United States of America. This is not correct: by virtue of Section 15(2) of the Act read with Section 5(4) of the same statute, the registration date of the Subject Marks is the date of application in Singapore. Thus, as stated above at [3], the Relevant Date is 6 July 2015.)

13 The three grounds of invalidity relied on by the Applicant, each of which needs to be considered independently, all relate to the question whether the BRENT mark and the BRENT INDEX mark was at the Relevant Date distinctive (in a trade mark sense) in relation to the services for which registration was obtained. As stated in [3] above, the Subject Marks are registered for “financial services”, a description that is then expanded upon in considerable detail in the remainder of the specification but encompasses a wide variety of services offered by various actors in that sector, including stock exchange operators and financial data providers.

14 In *Courts (Singapore) Pte Ltd v Big Box Corp Pte Ltd* [2018] SGHC 81, George Wei J set out, at [36]-[37], how the issue of distinctiveness should be approached:

“The general principles on distinctiveness are well established. Distinctiveness is the concept underlying ss 7(1)(b), (c) and (d) of the Act. That said, each ground must be assessed independently in relation to the proposed mark and the relevant goods and services and in light of the public interest underlying each ground: see Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) (*‘Leong on IP’*) at para 28.076.

Ultimately, the question whether a trade mark lacks distinctiveness is essentially one of degree and judgment. Some trade marks may comprise signs which are patently descriptive of the product or service in question or which bear an obvious and direct reference to the quality of the goods or services. In other cases, the descriptive content or allusion to quality, *etc.*, may be nuanced, subtle or less obvious. Indeed, at the other end of the spectrum are signs which are entirely meaningless (in themselves) or whose meanings are counter-intuitive in terms of the character, quality, geographical origin or nature of the goods or services.”

15 Likewise, in *Love & Co Pte Ltd v The Carat Club Pte Ltd* (“*Love & Co*”) [2009] 1 SLR(R) 561, Chan Seng Onn J summarised the relevant enquiry as:

“whether the average discerning consumer operating in that market place and environment can readily and immediately identify the trade mark viewed as a whole to be unequivocally designating the goods or services originating from the particular trader when he first encounters the trade mark on the goods or services – or will the average discerning consumer be unclear or uncertain as to the commercial source or origin of the goods or services nevertheless.” (At [35]).

The Average Consumer

16 Thus, before considering the distinctiveness issue, the antecedent question is, who is the average consumer or, in the words of Chan J, the “average discerning consumer” of the relevant goods or services? It is for and through this hypothetical person that distinctiveness must be assessed. In the present case, when considering the wide specification of financial services for which the BRENT mark is registered, as set out above at [3], the Applicant submitted that the relevant consumers are:

“financial services professionals- in particular investment professionals – or high net-worth or investment-savvy individuals.” (Applicant’s SD-MJK-1 at [20]).

At the hearing, counsel for the Proprietor did not disagree with this submission, although Mr Clifton states on behalf of the Proprietor (Proprietor’s SDR-DCC-1 at [11]) that the relevant consumers:

“are likely to be specialist traders in the financial industry in Singapore who are dealing with and/or familiar with financial products in the oil futures and oil options markets”.

17 While Mr Clifton’s statement seems to be consistent with his apparent belief (as to which, as well as my comments thereto, see [28]-[30] below) that, contrary to the fact, the services for which the BRENT mark is registered are those relating to oil futures and oil options, I prefer the Applicant’s submission (at [16] above) in view of the breadth of the financial services for which the BRENT mark is actually registered. It is therefore through the eyes and ears of financial services professionals and investment-savvy individuals, in Singapore and at the Relevant Date, that the determination of distinctiveness should be made. For the avoidance of doubt, I

emphasise that this is not a case in which the man and woman on the MRT is the requisite standard and I would not expect such a person would have the same perceptions of and reactions to the BRENT mark as would the financial services professionals and investment-savvy individuals that are pertinent in deciding these Applications.

18 In this connection, I note also that the relevant consumers for the purposes of these Applications thus differ significantly from those in relation to which the Proprietor's linguistics expert, Emeritus Professor Ronald R. Butters of Duke University in the U.S.A. ("Professor Butters"), provided a report that was used in proceedings before the U.S. Trademark Trial and Appeal Board, which forms Annex M to both the Proprietor's SDR-DCC-1 and SDR-DCC-2. In that report, the "linguistically relevant public" were "persons engaged in extracting, processing, or distributing crude oil, including the financing thereof" (at [2] of the said report). However, as I have just stated, in deciding the Applications, it is the perceptions of financial services professionals and investment-savvy individuals that must be considered, as each of the Subject Marks, BRENT and BRENT INDEX, is registered for a broad range of financial services.

The Subject Marks

19 At the hearing before me, it was accepted by counsel for the Applicant that if its application for a declaration of invalidity fails on all grounds in relation to the BRENT mark, it must fail also in relation to the application in respect of the BRENT INDEX mark. On the other hand, counsel for the Proprietor maintained that, regardless of the decision on the grounds of invalidity of the BRENT mark, there is no evidence that the BRENT INDEX mark is devoid of distinctiveness, descriptive or generic. I shall therefore deal first with the Applicant's application for invalidity of the BRENT mark and then proceed to consider whether the BRENT INDEX mark should be treated differently.

Brent

20 There are many possible dictionary meanings of the word BRENT in the English language, including a person's first or last name and a north London borough named after the River Brent that runs through it. Indeed, the Proprietor cites seven possible dictionary meanings (SDR-DCC-1 at [12]), ranging from 'steep, precipitous' to 'suburb 3.2 km NW of Pensacola' and states that "none of [these] meanings relate in any way to the Registered Services and/or crude oil at all, and cannot be said to be descriptive of the same" (at [14]).

21 Notwithstanding this, the meaning must be viewed in the context of the services in respect of which the Proprietor has registered the Subject Marks and the meaning that is relevant for these Applications is one that has its origins around 50 years ago. Since that time, around the late 1960s/early 1970s, the term "Brent" has been used to refer to a particular type of light and sweet crude oil with specific characteristics, extracted from the North Sea. In the early years of the development of the North Sea oilfields in the 1960s, the term "Brent" was chosen to describe such crude oil by the Shell Oil Company in line with its policy of naming oilfields after birds (in this case the brent goose). "Brent blend" refers to crude oil with specific physical and chemical

characteristics and coming from the Brent, Forties, Oseberg and Ekofisk (BFOE) oilfields in the North Sea. Brent blend makes up nearly half of the internationally-traded supply of crude oil. (See generally: www.futuresknowledge.com/futures/energy/brent-crude-oil-futures/history-of-brent-oil-and-brent-oil-futures/, referred to in the Applicant's Written Submissions at [15]).

22 At [8] of his report referred to in [18] above, the Proprietor's expert Professor Butters states "within the industry the term Brent blend crude oil and the clipped forms Brent blend, Brent crude, Brent oil, and simply Brent gained the additional specialized meaning and/or were construed in context as 'oil blended to bear specified properties of normal Brent oil field crude oil'." Despite this and somewhat surprisingly, the Proprietor denies (Proprietor's SDR-DCC-1 at [61]) that "'BRENT" is a reference to crude oil found in parts of the North Sea".

23 In addition to its use in the physical crude oil market, "Brent" is a leading internationally-recognised benchmark for oil prices (along with *inter alia* West Texas Intermediate, Bonny Light, Dubai and Oman: see www.petroleum.co.uk/benchmarks, a screenshot of which forms part of Exhibit A to Applicant's SD-MJK-1). As such, it is the base price against which many derivative financial products are developed, priced, marketed and traded. Such products include crude oil futures, crude oil forwards, crude oil options and oil/petroleum product swaps, all of which derive their pricing and fluctuating value from the benchmark price of Brent crude. By way of example, the Applicant cites (in Applicant's SDR-MJK-2 at [57]) the S&P Global Platts May 2011 publication "Dated Brent: The Pricing Benchmark for Asia-Pacific Sweet Crude Oil":

"Platts dated Brent is the recognized benchmark price assessment of the spot market value of physical cargoes of North Sea light sweet crude oil. As a consistent underlying price it supports a broad range of derivative instruments accessible via futures exchanges and in over-the-counter markets worldwide. Dated Brent and its derivatives are used by active market participants to hedge their daily, short-term and long-term market price risk for crude oil, as well as for correlated refined oil products, natural gas, gas liquids and condensates." (At p2.)

24 In addition to numerous foreign publications (of which this is one example), certain of which, it is not unreasonable to assume, will have been seen by at least some of the investment professionals in Singapore active in the relevant markets for oil-related derivatives, the Applicant has also adduced evidence of references to "Brent" as a benchmark price for crude oil in the *Straits Times* and *TODAY* newspapers prior to the Relevant Date, 6 July 2015 (Exhibit B, Applicant's SD-MJK-1). For example, on 15 January 2015, the former reported that "Analysts are tipping that the prices of benchmark Brent crude could fall to as low as US\$40 a barrel" and on 26 February 2015, in an article on price hikes by petrol companies, it was stated "The benchmark Brent crude came close to a six-year low last month", while on 22 May 2015 it was reported that Claire Miller, a spokeswoman for ICE [the Proprietor], said "ICE Futures Singapore will not offer trading in Brent crude, gold or yuen derivatives until the second half of the year". On 14 May 2015, *TODAY* reported that Singapore Airlines had said that "it is 40.9 per cent hedged in Singapore Jet Kerosene and 4 per cent hedged in Brent", while on 8 January 2015 in an article on the pollution challenges for India and

China the newspaper reported “Brent crude, a benchmark for more than half of the world’s oil, dropped 48 per cent last year”.

25 These representative examples of evidence of the use prior to the Relevant Date of “Brent” as a descriptor of both a particular physical product and a benchmark for financial products based on it is bolstered by use of the term in Parliament during the same period. In a debate on 19 January 2015 about the impact of falling oil prices on Singapore’s economy and petrol pump prices, the Minister for Trade and Industry, Mr Lim Hng Kiang, noted:

“Since June 2014, the benchmark Brent oil price has declined from a peak of US\$115 a barrel to around US\$50 per barrel recently”.

The following month, on 13 February 2015, the then Second Minister for Trade and Industry, Mr S Iswaran, in responding to a question on likely reductions in electricity and gas tariffs, explained:

“The fuel cost component of the electricity tariff is based on the average forward fuel oil and dated Brent prices in the first two and a half months in the preceding quarter, and makes up approximately half of the electricity tariff. For town gas, the fuel oil cost component is based on the average forward fuel oil and naphtha prices for the quarter, and makes up about 40% of the tariff.”

(Screenshots of the relevant extracts from the Parliament of Singapore website form Exhibit C, Applicant’s SD-MJK-1).

26 In addition to the Applicant’s evidence, the Proprietor adduced evidence (Proprietor’s SSD-DCC-1 at [34] and Annex O) of 17 articles using the term BRENT to refer to either crude oil or financial products based on it that appeared in local newspapers in the period from 1990 and 1999, often along with reference to the International Petroleum Exchange (IPE) (now the Proprietor’s ICE Futures Europe). Eight of those articles were related to the prospect and then the fact of a cooperation between the Singapore International Monetary Exchange (SIMEX) and IPE under which SIMEX launched Brent futures contracts: for example, *The Straits Times* article on 16 June 1994 quoted the Chief Executive of IPE as saying in an interview with the newspaper “that talks on launching the Brent oil futures contract were almost concluded.” The article continued: “Brent is a trading contract based on North Sea oil which is pioneered by IPE.”

27 To like effect, in its Written Submissions (at [72]) the Proprietor cites, in support of its submission that “the Respondent has used the term “BRENT” as a trade mark”, two excerpts from two pages (pp 66-67) from Exhibit E in the Applicant’s SD-MJK-1 that comprises screenshots of certain pages from the Proprietor’s website www.theice.com. These state:

“Supporting the importance of Brent in the global pricing of crude oil, commodity indices continue to increase their allocation to Brent” (page 66);

and

“... in response to this rising demand, the Brent futures contract was developed in 1988 by the oil industry in consultation with the International Petroleum Exchange, which is today ICE Futures Europe.” (page 67).

28 Mr Clifton, the Proprietor’s Associate General Counsel of Mergers & Acquisitions, asserts that “it is the sole provider of the Brent pricing benchmark, in the context of the relevant goods or services, i.e. futures” (Proprietor’s SSD-DCC-1, at [16]). Regarding this assertion, it must be emphasised that (a) being the only provider of a named product does not in itself mean that the name is registrable as a trade mark and (b) the specification of services for which the Subject Marks are registered is far wider than just “futures”.

29 In relation to (a) (at [28] above): if, for example, a financial institution or exchange were to decide to introduce a derivative financial product based on the average price of a selected number of brands of Champagne from which they derived a CHAMPAGNE INDEX, it would not mean that it was entitled to register CHAMPAGNE or CHAMPAGNE INDEX as a trade mark for financial services: both would be refused as either descriptive, if used on financial products related to sparkling white wine made by the *méthode champenoise* from grapes grown in the Champagne region of France, or laudatory or deceptive, if not. I return to this at [41] below.

30 As regards (b) (at [28] above), I draw attention to the fact that the Applicant has chosen not to rely on the ground of bad faith under Section 7(6) of the Act, notwithstanding the extremely broad specification of services for which both the BRENT mark and the BRENT INDEX mark are registered and the assertion by the Proprietor’s Associate General Counsel quoted above at [28]. Nevertheless, in the light of the evidence before this tribunal, I have considered carefully whether I have the power under the Act to decide of my own volition, in the public interest, that a registration was obtained in bad faith by reason of that evidence, coupled with the Proprietor’s statement in the relevant trade mark application that it did have an intention to use in relation to the broad specification of financial services set out at [3] above. Somewhat reluctantly, I have concluded that I do not (needless to say, had I considered it arguable that I do, I would have asked for submissions from the parties on the question). In all the circumstances of this case, if I had such power, I would have exercised it in favour of the Applicant: it is clear from the Proprietor’s own description of its business and other evidence submitted by Mr Clifton on its behalf that the Proprietor has never used nor at the Relevant Date had any intention to use either of the Subject Marks in relation to any financial services except those importing a reference to sweet crude oil from the BFOE oilfields (“Brent”, as the Proprietor’s expert Professor Butters describes it, see [22] above) or the price thereof from time to time. Whilst I note, and respectfully agree with, the decision of the Principal Assistant Registrar in *Audi AG v Lim Ching Kwang* [2017] SGIPOS 2 that a finding of bad faith should not be made from the mere fact of an overly broad specification, there are additional circumstances in this case that would have justified such a finding were it possible for me to make it.

Distinctiveness as a Trade Mark

31 I now move to consider the evidence under the three grounds for invalidity relied on by the Applicant. As noted already at [13] above, each should be assessed

independently and relate to the question of distinctiveness. In *Société des Produits Nestlé SA and another v Petra Foods Limited and another* [2016] SGCA 64, at [23], Sundaresh Menon CJ on behalf of the Court of Appeal explained that the policy rationale underlying the requirement of distinctiveness:

“may be summarised in two basic ideas. First, a mark that merely describes either the product or the trader will not generally be regarded as distinctive because, if it were otherwise, the monopoly associated with the recognition of a trade mark would effectively extend over words or other “sign[s]” (as defined in s 2(1) of the TMA) which are merely descriptive and, to that extent, would unfairly and undesirably exclude other traders in the market from using them. Second, if a mark is indeed merely descriptive, then the trader has no valid basis to say that it operates as a warranty of origin.”

Ground of Invalidation under Section 7(1)(c)

32 I take first the ‘exclusively descriptive’ ground of refusal contained in Section 7(1)(c):

“The following shall not be registered:

...

(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...”

Decision on Section 7(1)(c)

33 This ground of refusal or, as in this case, invalidity was considered in *Love & Co*, in which Chan J explained its purpose, at [70]:

“[David Kitchin et al, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14th Ed, 2005) (“*Kerly*”)...] at para 8-080 explains the rationale behind s 7(1)(c): The purpose of this ground of objection is to prevent the registration of signs which are descriptive of the goods 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.

A mark must be refused registration under s 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: (*DOUBLEMINT Case* R216/1998-1, OHIM (Bd App) at [32]). It does not matter that there are other synonyms, other more usual signs or indications which can also serve to designate the same characteristic or other characteristics of the goods or services as s 7(1)(c) does not prescribe that the mark under examination should be the only way of designating the particular characteristic in question: (*Kerly* at para 8-082). The characteristic of a particular good or service includes “the *kind, quality, quantity, intended purpose, value, geographical origin, the time of production or the goods or of rendering of services, ...*” as enumerated under s 7(1)(c). Section 7(1)(c) has a sweep-up limb

to it that is very broad in that the trade mark must also not consist exclusively of signs or indications, which may serve in the trade to designate any “... *other characteristics of goods or services*””. [emphasis in original]

34 In view of all the evidence submitted by the Applicant, a representative sample of which is set out above at [21] to [27], it is clear that (to adapt the wording of Chan J to the facts here): at least one of the possible meanings of BRENT designates a characteristic of the financial services set out in the specification reproduced at [3] above in respect of which the Proprietor uses or intends to use the BRENT mark; namely, financial services relating to or connected with Brent crude oil. I have considered carefully both the Proprietor’s attempted rebuttal of the Applicant’s evidence (SDR-DCC-1 at [60] to [96]) and all the Proprietor’s evidence as to its business as an operator of market exchanges and a provider of financial data including its various trading activities utilising the word BRENT, both in Singapore and elsewhere. It is particularly in the context of the latter, while also taking into account the former, that I have arrived at my conclusion that the BRENT mark is exclusively descriptive of the services for which it is registered.

35 By way of example only, in relation to the two excerpts relied on by the Proprietor that I refer to above at [27], I note that the first excerpt is preceded immediately by the words:

“ICE Brent is the global benchmark for light sweet crude reaching its 18th consecutive annual volume record in 2014 of nearly 174 million contracts traded”;

and the second forms part of a page headed:

“ICE BRENT CRUDE: THE GLOBAL CRUDE OIL BENCHMARK”

with the subheadings:

“ICE BRENT CRUDE COMPLEX” and “WHY ICE BRENT REPRESENTS THE GLOBAL OIL MARKET”.

As can be seen clearly from these examples, from the Proprietor’s own website, the relevant use of a trade mark is ICE BRENT, and not BRENT *simpliciter*, which is used exclusively as a description of or reference to the crude oil in question.

36 To the extent that the Proprietor has attempted to pray in aid its own use of the word BRENT as a short-form of ICE BRENT to justify its contention that the BRENT mark is distinctive as a trade mark (as it does, for example, in Proprietor’s SDR-DCC-1 at [73]), this is rejected. In light of the specification of financial services for which the BRENT mark is registered, a word “Brent” that is descriptive in the context of crude oil and related financial services cannot be transformed into a distinctive mark properly registrable on its own as a trade mark for financial services merely through use by the Respondent, albeit over a significant period, of the word in a descriptive way or together with a distinctive (in trade mark terms, dominant) element ICE, which they may choose for convenience to drop occasionally in their own promotional materials. Likewise, by adding a broad range of services to those for which a particular mark is incontestably

intended to be and is used, but which limited use would be exclusively descriptive, the proprietor of a mark that has been registered cannot save the registration from removal in an application for invalidity relying on Section 7(1)(c): the specification must be considered in the context of all the facts before the tribunal.

37 In this respect, I note and agree with the analysis by the EU General Court at [36] and [37] in *Intercontinental Exchange Holdings, Inc v EU Intellectual Property Office* (Case T-430/16, Tab 6 in the Applicant’s BoA) when rejecting the appeal by the trade mark applicant (in these Applications, the Proprietor) against the decision of the EUIPO Board of Appeal to refuse registration of BRENT INDEX for various goods and services, including a specification of financial services in Class 36 identical to those at issue in these Applications. In responding to the applicant’s argument (at [36]) that some of the services in the specification are “neither connected to crude oil or to indexing services”, the General Court stated at [37]:

“it is apparent from settled case-law that, although the competent authority refusing registration must, in principle, state reasons in respect of each of the goods or services concerned, the competent authority may nevertheless use purely general reasoning where the same ground of refusal is used in a category of goods or services which are interlinked in a sufficiently direct and specific way, the point where they form a sufficiently homogenous category or group of goods or services”.

38 Although no case law in Singapore on this point was cited by the Applicant, the General Court’s approach is a common-sense one that should be adopted when considering the interlinked services at issue in these Applications, especially as to do so accords with the view expressed in the final sentence of [37] above, that the specification must be viewed in context. In this regard, I should make clear that I have considered, although the Applicant did not specifically request this, whether to order partial invalidation of the specification of services (to delete all services where the BRENT mark would be used in relation to the crude oil product known as Brent or a financial product relating in some way to that crude oil or its price) as is permitted by Section 23(9) of the Act. At the hearing, counsel for the Applicant submitted for consideration print-outs of three registered trade marks, Nos. T1416171E, T1203006J and T9613253F, registered for various financial services that include in the specification of services a carve-out: including, in the first, ‘none of the foregoing [services] relating to petroleum and natural gas price indices and data’.

39 I have decided, however, that it is not appropriate on the evidence in these Applications either to partially invalidate the BRENT mark or to so qualify the specification of services, as it would leave on the Register a registered trade mark that would inevitably become open to attack on the grounds of non-use under Section 22 of the Act immediately after five years from the completion of registration. Instead, on the basis of that evidence, I decide in favour of the common-sense approach of invalidating the BRENT mark in respect of the financial services for which it is registered *in toto* as these are, in the words of the EU General Court (cited above at [38]), a sufficiently homogenous category.

40 I do not find that the decisions of the EUIPO Cancellation Division and the Examining Attorney at the United States Patents and Trade Marks Office, that both

found BRENT for financial services to be descriptive and are relied on by the Applicant (Written Submissions at [58] and [59]), add to or detract from the strength of the Applicant's case. Nevertheless, I do find helpful the view of the EUIPO Cancellation Division Decision of 29 March 2017 (a copy of which is at Tab 7 of the Applicant's Bundle of Authorities, ("BoA")) on the contention by the proprietor of the EUTM "BRENT" (the Proprietor in these Applications) that:

"save for some services in Class 36, "the relevant goods and services are not connected to crude oil at all so the link between the term and the services is not close enough to be considered devoid of distinctiveness" (Applicant's BoA at [162], first complete para).

The EUTM was registered for a range of goods in Class 9 and services in both Class 36 and 42 and the Cancellation Division found that "all the contested goods and services can be linked to the financial sector and consequently to 'BRENT' as a benchmark in trading"; seeing no reason to depart from the Fourth Board of Appeal's earlier decision on 'BRENT INDEX' (Case R 8/2016-4). The Cancellation Division said of the Class 36 specification (which was identical to those for which the Subject Marks are registered):

".. all the services in Class 36 are specifically linked to the provision of on-line services in the financial sector. Broadly speaking, they consist of financial services connected to financial price indices, the provision of information on rates, the provision of financial exchange services, financial clearing services, financial investment and advisory services, monitoring of global financial markets for others, disseminating financial news, financial research and analysis, brokerage services and financial planning. In view of the undisputed definition of BRENT as a benchmark for the prices of other crude oils, this term conveys obvious and direct information regarding the subject-matter, kind and intended purpose of these services. For instance, the contested trade mark will be considered as a descriptive indication of the content of financial news (news and information on BRENT oil process and rates as a benchmark), or that the investment, clearing and brokerage services regard options or futures tied to the BRENT benchmark." (Emphasis in original. Applicant's BoA, at [162], fifth complete para).

41 In concluding on this ground of invalidation, it should be re-emphasised that much as the Proprietor may repeat the statement that it is the sole provider of "BRENT" pricing information (Proprietor's SDR DCC-1 at [62], [63], [76]; Proprietor's SSD DCC-1 at [8], [16], [25]) and since 1 April 2015 has been regulated in doing so by the UK's Financial Conduct Authority (SSD DCC-1 at [13]), this does not lead inexorably to the conclusion that 'Brent' is a registrable trade mark or, if registered, is validly so. For example, if a regulated body is the only one that issues information on, say, the Singapore real estate market that does not make the words SINGAPORE REAL ESTATE registrable by that body as a trade mark for financial services: they are devoid of distinctive character, exclusively descriptive and generic and therefore would not be registered by reason of Section 7(1)(b), (c) and (d) of the Act. Other honest traders are likely to want to use the words 'Singapore real estate' and they should not be forced to rely on a defence under the Act in order to do so.

Conclusion on Section 7(1)(c)

BRENT Mark

42 The ground of invalidation under Section 7(1)(c) therefore succeeds in respect of the BRENT mark.

BRENT INDEX Mark

43 In relation to the BRENT INDEX mark, this can be dealt with relatively succinctly.

44 It is self-evident that certain trade marks for financial indexes are registrable as trade marks for financial services as they are not exclusively descriptive of such services (or devoid of distinctive character or generic). Examples would include STRAITS TIMES INDEX, DOW JONES INDUSTRIAL AVERAGE, FTSE 100 INDEX or NIKKEI INDEX, where the inclusion of the distinctive word(s) or acronym ‘Straits Times’, ‘Dow Jones’, ‘FTSE’ (for Financial Times Stock Exchange) and ‘Nikkei’ makes registrable its combination with the descriptive word(s) ‘index’ (or ‘industrial average’). Should evidence on this be necessary, it is found at Applicant’s SD MJK-4 at Exhibit E, including pp 72-75 that reproduces the pages from Wikipedia for the entry “Index (economics)” as at 2 January 2017. Among the indices cited (at pp 73-74) are S&P/TSX Composite Index, S&P Leveraged Loan Index, Case-Schiller index, Russell Global Index, Russell Europe Index, MCSI World Index, Reuters-CRB Commodities Index. All of these are distinctive trade marks by virtue of the inclusion in them of ‘S&P’, ‘Case-Schiller’, ‘Russell’, ‘MCSI’ or ‘Reuters-CRB’, respectively. On the other hand, Stock Market Index, Consumer Price Index and Producer Price Index (mentioned at pp 72-74) are purely descriptive and could not be registered as trade marks for financial services (although they could be registered, for example, for shoes, restaurant services or clothing). If it were the case that the latter indices are provided exclusively by a particular entity this would make no difference.

45 I note the Proprietor’s contention that the Committee of the Fair and Effective Markets Review (carried out at the request of the Chancellor of the Exchequer and the Governor of the Bank of England in the U.K.) “recognized that the Registered Mark [BRENT INDEX] is distinctive of the Respondent’s Registered Services” (Proprietor’s SDR DCC-2 at [22]). In support thereof, Mr Clifton cites the Committee’s August 2014 interim report and its Final Report of June 2015 that followed a public consultation (copies of both are included in Annex D to Proprietor’s SDR DCC-2). The former stated (at [51]-[52]):

“In the crude oil market, the main UK-based benchmarks relate to a basket of physical oil cargoes in the North Sea ... There are a number of benchmarks set by Price Reporting Agencies (PRAs) based on the physical market. The main financial benchmark is the price of ICE Brent futures contract traded on the ICE Futures Europe (IFEU) exchange. In 2012, ICE Brent became the world’s largest crude oil futures contract in terms of volume, and it is used by a wide range of financial market participants as well as producers and consumers of oil”; and

“given the importance of ICE Brent to the market as a whole and its dependency on physical markets outside the scope of regulation, the Review considers that ICE Brent meets all its criteria”;

and the latter (at p42), in a list of major FICC (Fixed Income, Currencies and Commodities) benchmarks:

“... ICE Brent Index, the crude oil futures market’s principal financial benchmark.”

However, I do not consider that any of this evidence supports the apparent contention that BRENT INDEX (or BRENT) is a distinctive trade mark. Indeed, the inclusion of the distinctive acronym ICE in each of these three uses of Brent or Brent Index suggests the opposite.

46 Thus, in relation to the BRENT INDEX mark, I again note and agree with the analysis of the EU General Court in *Intercontinental Exchange Holdings, Inc v EU Intellectual Property Office* (Case T-430/16, Tab 6 in the Applicant’s BoA), pertinently in this context at [33] to [35]:

“[33].. it is common ground that the expression ‘brent index’, which is merely the juxtaposition of the words ‘brent’ and ‘index’, does indeed refer, as the examiner pointed out, to a figure system or scale representing the average value of prices, shares, and so forth of a crude oil coming from the Brent field in the North Sea, which is also used as a benchmark for the prices of other crude oils.

[34] Furthermore, the juxtaposition of the terms ‘brent’ and ‘index’, which are separated by a space, is consistent with English lexical and grammatical rules and does not contain any unusual element in its syntax which would make it possible for that expression to be anything other than the mere combination of the words ‘brent’ and ‘index’.

[35] Associated with the goods and services at issue, the mark applied for will therefore inform professionals concerned immediately, without any thought being necessary, of the intended purpose of those goods and services, namely the fact that they are linked to finance.”

47 It is patently clear on the evidence submitted by the Applicant, a representative sample of which is set out at [21] to [27] above, that the average consumer of the relevant services in Singapore, i.e. financial services professionals and investment-savvy individuals, could not fail to be informed immediately by use of the BRENT INDEX mark of the intended purpose and nature of the particular financial services. This is the exact opposite of what is necessary in order to be a registered trade mark: in the words of Chan J in *Love & Co* already cited at [15] above but worth repeating here:

“whether the average discerning consumer operating in that market place and environment can readily and immediately identify the trade mark viewed as a whole to be unequivocally designating the goods or services originating from the particular trader when he first encounters the trade mark on the goods or services.”

48 In addition, I apply *mutatis mutandis* to the BRENT INDEX mark my decision on possible partial invalidity at [39] above.

49 The ground of invalidation under Section 7(1)(c) therefore succeeds in respect of the BRENT INDEX mark.

Acquired Distinctiveness

50 The Proprietor has submitted that in any event the BRENT mark has acquired distinctiveness, presumably after the Relevant Date, “by reason of, *inter alia*, long and extensive use of the mark” (Written Submissions at [51]). In support of this, the Proprietor sought *inter alia* to rely on (a) the volume of Brent futures contracts in 2013 and 2018, 159 million lots and 112 million lots respectively, that were traded on the proprietor’s exchanges using the Proprietor’s benchmark price of Brent crude oil as compared with 14 million traded by other entities (in Annex D, Proprietor’s SDR DCC-2) and (b) the expenditure of sums in Singapore between \$30,000 and \$80,000 each year from 2008 to 2017 on promoting the services under the BRENT INDEX mark (Proprietor’s SDR DCC-1 at Annex J) and between \$30,000 and \$80,000 also on promoting the services under the BRENT mark (Proprietor’s SDR DCC-2 at Annex I). However, neither of these facts (even if they are accepted on their face, which must be questionable in relation to the promotional sums) indicates one way or the other whether the Subject Marks or either of them has acquired distinctiveness as a trade mark for the services. Again, it must be re-iterated that use and promotion of a word mark that is descriptive in context does not of itself make it worthy of trade mark registration (or maintenance on the register in the event of an invalidity application, as here).

Family of Marks

51 In addition to the BRENT mark, the Proprietor is the registered proprietor of the following BRENT-variant marks in Singapore:

No.	Mark	Mark No.	Class	Status
1.	BRENT NX	T1201355G	36	Registered
2.	BRENT NEW EXPIRY OPTIONS	T1114637E	36	Registered
3.	BRENT NX OPTIONS	T1114635I	36	Registered
4.	BRENT NEW EXPIRY FUTURES	T1114634J	36	Registered
5.	BRENT NX FUTURES	T1114633B	36	Registered
6.	BRENT INDEX	40201511601W	36	Registered
7.	ICE BRENT INDEX	40201511609V	36	Registered
8.	ICE BRENT	40201511605X	36	Registered

52 The Proprietor contends that use of this family of marks “gives rise to an enhanced distinctiveness on the part of the Registered Marks” (Written Submissions at [77]) and relies on *Carolina Herrera, Ltd v Lacoste* [2014] SGIPOS 3 at [37] in support of its contention.

53 I reject this sophistry also: it cannot be the case that by adding distinctive matter (of whatever degree of distinctiveness) to a descriptive or generic word and thereby forming a composite mark that may be registered as a trade mark (as the combination is not *devoid* of distinctive character, *exclusively* descriptive and/or generic (emphasis added)), its proprietor can pray in aid the combination's registration to support an argument that the descriptive word is registrable on its own. Instead, if the word *simpliciter* (or the word together with another descriptive word) is unregistrable under Section 7(1)(b), (c) and/or (d), it becomes no less unregistrable merely because it forms part of one or more registered trade marks. Were the position otherwise, a deep-pocketed trader could obtain registration of the most banal and descriptive words by securing earlier registrations in which the word is combined with a clearly distinctive word or device. In coming to this finding, I should emphasise that I am making no comment on the validity of all or any of the 7 registered trade marks in the above table that are not challenged in these Applications, although I have noted already the extensive use of the registered trade marks ICE BRENT and ICE BRENT INDEX, both on the Proprietor's website www.intercontinentalexchange.com and elsewhere.

54 Having reviewed all the evidence submitted by the Proprietor, I find that it has failed to satisfy the heavy burden under Section 23(2).

Ground of Invalidation under Section 7(1)(b)

55 It is now necessary to consider separately whether the BRENT mark is also devoid of distinctiveness contrary to Section 7(1)(b).

Section 7(1)(b) of the Act reads:

(1) The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character

...

Decision on Section 7(1)(b)

56 When determining whether a trade mark is devoid of distinctive character, regard must be had to the specification in respect of which registration is sought or, in the case of an invalidity application, has been obtained. As stated by George Wei JC (as he then was) in *Han's (F&B) Pte Ltd v Gusttino World Pte Ltd* ("*Han's*") [2015] 2 SLR 825, a decision concerning the registrability of a trade mark but equally applicable to an application for invalidity that relies on Section 7(1)(b), at [78]:

"When the law addresses the question posed by Section 7(1)(b) of the TMA ... the question is not to be answered in the abstract. The definition of trade mark relates to the use of the sign in the course of trade on goods or services in circumstances where the sign has a capability of distinguishing the goods or services. The goods or services are those in respect of which the applicant is seeking registration. The question to be answered is whether the trade mark is devoid of any distinctive character in terms of its ability to distinguish those goods or services in the course of trade."

57 As the learned judge noted in *Han's* at [93], “it must be accepted that there is no easy answer to the question of how much distinctive character there must be to constitute a registrable mark.” I note in passing that the learned judge proceeded to refer, at [94], to a passage in *Kerly's Law of Trade Marks and Trade Names* that states:

“assessment of distinctive character is not an exact science, it requires a judgment to be made based on all relevant factors. It is the type of multi-factorial assessment which is not susceptible of an appeal unless the assessment displays an error of principle”.

However, it should be borne in mind that this is not the state of the law in Singapore as regards appeals from decisions of the Registrar where the matter is considered *de novo*.

58 Notwithstanding the difficulty mentioned by the learned judge in *Han's* to which the term ‘devoid of any distinctive character’ may give rise in particular cases, it is clear as a matter of simple logic that a trade mark that is exclusively descriptive cannot have any distinctive character as an indication of origin. In other words, it is not capable of distinguishing the trade origin of the particular services of one undertaking from those of others offering or wishing to offer the same or similar services.

59 Thus, for these purposes it is necessary only to repeat the reference to the evidence cited in [21] to [27] above, along with the decision in [39] as regards the specification of services, to decide that the BRENT mark is devoid of any distinctive character contrary to Section 7(1)(b). Likewise, in relation to the BRENT INDEX mark, I repeat [45] and [46] above, along with [48], and find that mark so devoid also.

Conclusion on Section 7(1)(b)

60 The ground of invalidation under Section 7(1)(b) therefore succeeds in relation to each of the Subject Marks.

Ground of Invalidation under Section 7(1)(d)

61 I now proceed to consider, again separately, the third ground of invalidity relied on by the Applicant. Section 7(1)(d) of the Act reads:

“The following shall not be registered:

...

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”

Decision on Section 7(1)(d)

62 Once again, the essential question to be answered is whether at the Relevant Date the BRENT mark was distinctive as an indication of trade origin or whether it was a generic sign or indication that should be kept free for honest traders to use without hindrance. This ground for refusal was explored by the Court of Appeal in *Wing Joo Loong Ginseng (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814. In its analysis, the Court of Appeal clarified, at [77], that the

onus of proving that the challenged mark is generic is not easy to discharge, and it falls on the party making the claim.

63 However, in view of the particular evidence cited above in relation to Section 7(1)(b) and 7(1)(c) and my finding that the BRENT mark is both devoid of distinctive character as a trade mark for the specification of services for which it is registered and exclusively descriptive of at least one of the characteristics of those services, it must again follow logically that the Applicant has discharged this onus in relation to the BRENT mark. I am cognisant of the fact that a finding under Section 7(1)(d) requires an independent consideration of the evidence and does not flow merely from a finding that the ground of invalidity in either or both of Section 7(1)(b) and 7(1)(c) has been established. Thus, that evidence has established that Brent is a sign that at the Relevant Date was used customarily in the language of those involved in trading and otherwise dealing with financial derivatives connected with or directly or indirectly related to the oil and oil-products markets to describe a sweet crude oil with a particular geographical origin. In other words, it was a generic word in the relevant market that it is in the public interest should be owned by no trader as a registered trade mark for services provided to those in that market. On BRENT INDEX, I need only repeat the statements of the EU General Court referred to in [46] above, which I respectfully endorse, and my finding in [47] above. Reciting further evidence on what, it will be evident, I have found to be a clear case of invalidity would serve only to lengthen these Grounds of Decision, not to make them more or less correct.

Conclusion on Section 7(1)(d)

64 The ground of invalidation under Section 7(1)(d) therefore succeeds.

Overall Conclusion

65 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that both the applications for a declaration of invalidity succeed on all grounds. The Subject Marks are hereby declared invalid. In accordance with Section 23(10) of the Act, the registrations are deemed never to have been made, but this shall not affect transactions past and closed. The Applicant is entitled to costs to be taxed, if not agreed.

66 Lest it be misunderstood by those not fully conversant with the workings of the system for the registration of trade marks in Singapore, it must be emphasised that in no way should this decision be interpreted as critical of the fact that the Subject Marks were admitted to registration. It is only in the circumstances of a third party opposition before registration or an application for invalidity after registration that detailed evidence and legal argument submitted by both parties permit an in-depth evaluation of whether, in the former, a trade mark should be rejected under one or more of the absolute or relative grounds for refusal contained in Sections 7 and 8 of the Act or, in the latter, should have been so rejected at the relevant date (or, if so, has acquired distinctiveness thereafter). Such evidence and argument is not available to the Registrar in the absence of the aforesaid third party opposition or application for invalidity.

67 Finally, I would like to thank counsel for both the Applicant and the Proprietor for the assistance they provided at the hearing and to commend particularly Ms Khosa

for her articulate and determined advocacy on behalf of her client, notwithstanding that it was ultimately unsuccessful.

Date of Issue: 29 November 2018