

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

[2023] SGIPOS 10

Trade Mark No. 40202106900P

**IN THE MATTER OF A TRADE MARK APPLICATION BY
LOUIS VUITTON MALLETIER**

FOUNDATIONS OF DECISION

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**In the matter of a trade mark application by Louis Vuitton
Malletier**

[2023] SGIPOS 10

Trade Mark No. 40202106900P
Principal Assistant Registrar Mark Lim Fung Chian
20 February 2023, 9 March 2023

3 May 2023




Principal Assistant Registrar Mark Lim Fung Chian:

Introduction

1 The registration of a trade mark confers on the proprietor the exclusive rights to use the trade mark and to authorize other persons to use the trade mark, in relation to the goods or services for which the trade mark is registered (s 26(1) of the Trade Marks Act 1998 (“TMA”). This right is infringed by a person who uses in the course of trade a sign which is identical with the trade mark on such goods and services, without the proprietor’s consent (s 27(1) TMA). Infringement also occurs if the sign used is similar to the trade mark and is used in relation to goods or services which are similar to those for which the trade mark is registered, provided there exists a likelihood of confusion on the part of the public (s 27(2) TMA).

2 The question before me in this case is whether a pattern (specifically,




this pattern: (  ) may be registered as a trade mark.

Procedural background

3 On 9 December 2020, Louis Vuitton Malletier (the “**Applicant**”)



applied via the Madrid Protocol¹ to register “” (Trade Mark No. 40202106900P) (the “**Application Mark**”) for a long list of goods in Classes 9, 14, 18 and 25:




Class No.	Goods
9	Eyewear; sunglasses; spectacles [optics]; spectacle frames; spectacle lenses; spectacle chains; spectacle cords; spectacle cases; containers for contact lenses; sleeves for laptops; bags designed for laptop computers; cases especially made for photographic apparatus and instruments; covers for smartphones; cases for smartphones; straps for mobile telephones; protective films designed for smartphones; grips, rings and holders adapted for smartphones; selfie sticks; protective face shields; protective masks; protective chin straps; protective gloves; mouse pads; binoculars; protective helmets for sports; sports whistles; directional compasses; apparatus and instruments for sound or image recording, transmission, reproduction or processing; loudspeakers; headphones; earphones; hands-free kits for telephones; smart watches; connected bracelets [measuring instruments]; downloadable computer software applications; downloadable music files; digital or analog recording and storage media; USB flash drives; smartphones; electronic tablets; photographic apparatus; personal stereos; portable media players; compact disk players; cassette players; record players; microphones; sound recording disks; chargers for electronic apparatus; animated cartoons; downloadable game software; downloadable electronic publications; downloadable

¹ The Madrid Protocol for the international registration of marks is a treaty administered by the World Intellectual Property Organization. It gives trade mark owners the possibility of having a trade mark protected in several countries by filing one application directly with their own national or regional trade mark office, and designating the countries in which they seek to register the trade mark.

	graphic elements for mobile telephones; downloadable emoticons for mobile telephones.
14	Jewelry and jewelry articles; rings and finger rings [jewelry]; earrings; cuff links; bracelets [jewelry]; bracelets of embroidered textile materials [jewelry]; jewelry charms; brooches [jewelry]; chains [jewelry]; necklaces [jewelry]; pendants [jewelry]; medallions [jewelry]; amulets [jewelry]; jewelry cases; pins [jewelry]; tie pins; tie clips; jewelry boxes; boxes of precious metals and their alloys; medals; pearls [jewelry]; semi-precious stones; precious stones; diamonds; jewelry for bags; charms for key rings; key rings; statues of precious metals and their alloys; works of art of precious metals and their alloys; figurines and statuettes of precious metal; timepieces; watches; wristwatches; watch bands; watch cases; dials [timepieces]; watch chains; chronometers; presentation cases for watches; clocks; alarm clocks; chronometric instruments; movements for timepieces.
18	Bags; backpacks; handbags; traveling bags; suitcases [carrying cases]; attaché cases; wheeled bags; net bags for shopping; trunks [luggage]; suitcases; traveling trunks; vanity cases, not fitted; travel sets [leatherware]; garment bags and shoe bags for travel; hat boxes of leather; boxes of leather or leatherboard; wallets; purses; card cases [wallets]; business card cases; key cases; address tags for luggage; leather labels; leather cord; shoulder belts of leather or imitation leather; straps of leather or imitation leather; girths of leather; leather and imitations of leather; bags for transporting animals; collars for animals; leashes; clothing for pets; umbrellas; parasols and sunshades; whips; walking sticks; saddlery; furniture coverings of leather.
25	Clothing; tee-shirts; shirts; short-sleeve shirts; overalls; vests; sweaters and pullovers; jerseys [clothing]; knitwear [clothing]; coats; jackets; parkas; raincoats; overcoats; hoods [clothing]; ponchos; suits; combinations [clothing]; dresses; skirts; skorts; shorts; trousers; boxer shorts; leggings [trousers]; underwear and underclothing; pajamas; nightgowns; dressing gowns (robes); bathrobes; bathing suits; bathing trunks; corsets [underwear]; collars [clothing]; detachable collars; Ascots; cuffs [clothing]; kimonos; layettes [clothing]; belts [clothing]; money belts [clothing]; scarves and long scarves; shawls; stoles;

	bandanas [neckerchiefs]; pocket squares; neckties; suspenders; gloves [clothing]; fingerless gloves; mittens; muffs [clothing]; ear muffs [clothing]; neck scarves and mufflers; headwear; hats; beanies; headbands [clothing]; caps; cap peaks; socks; tights; stockings; masks for sleeping; footwear; footwear and shoes; sports footwear; boots; ankle boots; esparto shoes or sandals; sandals; gaiters; après-ski footwear; slippers and bedroom slippers.
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4 It can be seen that the Application Mark consists of three (3) devices

namely, “”, “” and “”, arranged in a particular manner. For ease of reference, I will adopt the Applicant’s terminology and refer to these devices as the “**Applicant’s Flower Quatrefoil² Marks**”.

5 On 7 May 2021, the trade mark examiner (the “**Examiner**”) refused the Application Mark on the basis that it is not distinctive as required under s 7(1)(b) TMA in relation to all the goods applied for. This section provides as follows:

Absolute grounds for refusal of registration

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

- (a) [omitted]
- (b) trade marks which are devoid of any distinctive character;
- (c) [omitted]; and
- (d) [omitted]

6 The Applicant sought to overcome the Examiner’s objections by filing submissions on 18 July 2021. On 5 January 2022, the Examiner maintained her

² The Merriam-Webster online dictionary (accessed on 3 April 2023) defines “*quatrefoil*” as “*a conventionalized representation of a flower with four petals or of a leaf with four leaflets*”.

objections. On 21 February 2022, the Applicant filed further submissions, which were rejected by the Examiner on 30 August 2022.

7 I will consider the Applicant’s submissions and the Examiner’s objections in greater detail below. In gist, the Examiner was of the view that “[i]t is common for the claimed goods in the application to adopt some form of graphical designs to enhance their visual appeal. Due to the prevalence of using graphical patterns on such goods... the relevant public will perceive the mark as embellishment rather than a trade mark to denote commercial origin.”³

8 In each reply to the Applicant, the Examiner invited the Applicant to file evidence showing that the mark has acquired technical distinctiveness as a result of the use made of it in Singapore. The Applicant declined to do so. Instead, it submits that the Application Mark is inherently technically distinctive, such that it may be registered without the need to adduce evidence of use.⁴

9 On 15 December 2022, the Applicant requested for an *ex parte* hearing under rule 24(2)(b) of the Trade Mark Rules 2008. The matter was heard by me on 20 February 2023. At the hearing, I directed the Applicant to provide some additional information and make further submissions on certain issues (discussed below). The Applicant duly did so on 9 March 2023.

³ IPOS letter to the Applicant dated 7 May 2021 at [5.1].

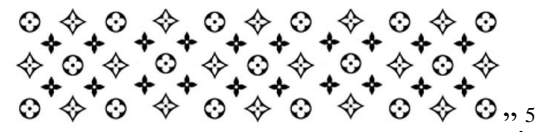
⁴ In these Grounds of Decision, I adopt the terminology put forward by the High Court in *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [119], [42] and [43]. Technical distinctiveness refers to the ability of a mark to distinguish the goods or services of one particular trader from those of another. A trade mark can have inherent technical distinctiveness in the sense that it can immediately function as a clear badge of origin of a trader. Technical distinctiveness can also be acquired through subsequent use by the proprietor of the trade mark.

Threshold Issue – Characterisation of Application Mark – Should it be construed as a repeating pattern?

10 As a threshold issue, I consider the Applicant’s argument that the Application Mark should be assessed on the basis that it “will be used in relation to the relevant goods or packaging thereof in the form that it was filed” (i.e.




), and that there is no basis to assume that it “is intended to be or will be further extended and reproduced as a pattern mark to be applied throughout the surface of the relevant goods or packaging thereof, e.g.,



11 I reject the Applicant’s submission on this issue. As observed in both: (i) the UK Intellectual Property Office’s Manual of trade marks practice (published on 23 August 2018 and updated until 20 February 2023), Part B: Alphabetical List of examination practice, Patterns (“**UKIPO Manual**”); and (ii) the European Union Intellectual Property Office (EUIPO) Guidelines for Examination (Part B – Examination) (Version 1.0 dated 31 March 2022), section on “Pattern Marks” (“**EUIPO Guidelines**”) at p. 413 (both of which the Applicant relies on in support of other aspects of its submissions), although patterns may be represented in the form of square or rectangular labels, they should nonetheless be assessed as if they covered the entire surface of the goods for which protection is sought.

⁵ See Applicant’s Written Submissions dated 6 February 2023 (“**AWS**”) at [19] and [21].

12 In this regard, I also note that the articles submitted by the Applicant to IPOS⁶ contain numerous photographs depicting the Applicant’s apparel and bags/suitcases with repeating patterns comprising the Applicant’s Flower

Quatrefoil Marks and its house mark (). There is not a single instance where any combination of these marks is used in the form of a square or rectangular label.

Whether Patterns can be Registered as Trade Marks

13 I therefore proceed to assess the Application Mark on the basis that it is a pattern mark (i.e. it consists of a set of elements that is repeated regularly).

14 S 7(1)(b) TMA (reproduced at [5] above) makes clear that trade marks which are devoid of any distinctive character cannot be registered. As noted by Professor Ng-Loy Wee Loon, S.C. in *Law of Intellectual Property of Singapore* (Third Edition, 2021, Sweet & Maxwell) (“*Ng-Loy*”) at [21.3.1]: “Distinctiveness is a term of art in trade mark law. It refers to the ability of a mark to function as the badge of origin of the goods or services in question.”

15 The requirement of distinctiveness is central to the core purpose of trade mark protection. A trade mark must help consumers to identify the source of the goods or services in question.

⁶ The Applicant submitted the following three (3) articles: (i) “A brief history of Louis Vuitton’s famous monogram” (*Vogue Paris*, 29 March 2019), (ii) “The history behind the hype: Louis Vuitton’s Monogram” (*Lifestyle Asia Singapore*, 17 January 2017) and (iii) “The World’s Most Famous Monogram Logo” (*Trésor Graphic & Digital Design*, 30 July 2013). These articles were enclosed as Annexes C, D and E to the letter from the Applicant to IPOS dated 18 July 2021.

16 As noted above (at [7]), the Examiner rejected the Application Mark on the basis that “the relevant public will perceive the mark as embellishment rather than a trade mark to denote commercial origin.”

17 To overcome the Examiner’s objections, the Applicant raised several arguments to the Examiner and also at the hearing before me.

Other types of intellectual property available to protect a pattern

18 Before reviewing these submissions, I briefly note that apart from protection as a registered trade mark, patterns may also be protected as registered designs and/or as copyright works.⁷

19 A pattern which is new may be protected as a registered design (see s 5(1) read with the definition of “design”⁸ in s 2(1) of the Registered Designs Act 2000 (“**RDA**”). To obtain protection, the design must be registered. This protection lasts for a maximum period of 15 years from the date on which the application for registration is filed (s 21 read with s 20 RDA).

20 A pattern may also be protected under copyright law as an artistic work (defined in s 20 of the Copyright Act (“**CA**”)) (see *Ng-Loy* at [6.1.24] to [6.1.33])

⁷ At the oral hearing before me, the Applicant’s agent confirmed that the Application Mark is not protected as a registered design, and that he was not aware of any copyright protection for the Application Mark.

⁸ “Design” is defined to mean “features of shape, configuration, colours, *pattern* or ornament applied to any article or non-physical product that give that article or non-physical product its appearance” (emphasis added). This is subject to various exceptions which are not applicable in the present case.

for a detailed discussion of artistic works). Generally, copyright protection expires 70 years after the end of the year in which the author dies (s 114 CA).⁹

21 In contrast, the protection of a registered trade mark is potentially perpetual.¹⁰ This is not objectionable since protection conferred by registered designs, copyright and registered trade marks serve different purposes. A time-limited monopoly allows designers and copyright owners to recoup their investment in the creation of new designs and copyright works respectively. Thereafter, the public benefits from the increased pool of designs and creative works, which are now freely available for use.

22 In the case of trade marks, as long as a trade mark continues to help consumers to identify the source of the goods or services in question, there is no reason why it should not continue to enjoy protection as a registered trade mark. But this discussion underscores the need for a pattern to be able to function as a badge of origin for the goods or services in question in order for it to be registered as a trade mark in the first place.


⁹ However, where an artistic work has been industrially applied (this occurs when more than 50 reproductions in three dimensions are made of the artistic work for the purposes of sale or hire), copyright protection is greatly circumscribed. For example, if the artistic work also qualified for protection as a design under the RDA, copyright protection is not available; such artistic works/ registered designs can only be protected under the RDA. (See ss 270 to 276 CA, and the analysis of these provisions in *Ng-Loy* at [11.4.1] – [11.4.20]. A discussion of this complex area of law is not necessary in the present case.)

¹⁰ A trade mark is registered for a period of 10 years from the date of registration, and may be renewed continually for further periods of 10 years. (See s 18 (read with s 15(2)) and s 19 TMA.) It may be revoked e.g. on the basis of non-use or because it has become the common name in the trade for the product or service for which it is registered (for details, and for other grounds for revocation, see s 22 TMA).

What is the test for registration of pattern marks?

23 I now proceed to consider the main issue in the case before me, namely,



whether a pattern (specifically, this pattern: ) may be registered as a trade mark.

24 The Applicant submits that pattern marks may be inherently technically distinctive. It does not rely on any judgment by a court or tribunal, whether in Singapore or elsewhere, which has addressed this issue. Instead, it relies on guidelines set out in the UKIPO Manual, the EUIPO Guidelines and the Hong Kong Trade Marks Registry Work Manual dated 23 April 2010, chapter on “Pattern Marks” (“**HK Work Manual**”). In this regard, the Applicant also points out that the relevant statutory provisions relating to inherent technical distinctiveness in these jurisdictions are very similar to Singapore’s.¹¹

25 The Applicant summarises its submissions on this issue as follows:

In summary, the Applicant submits that the inherent distinctiveness of a pattern mark may be assessed having regard to the following guidelines and considerations:

- (i) Pattern marks that are “descriptive or customary in the trade, or otherwise indistinctive” are objectionable (pursuant to the HK Work Manual).
- (ii) Pattern marks that are... “composed of extraordinarily complex designs” (which do not “allow the design’s individual details to be committed to memory”) are objectionable (pursuant to the EUIPO Guidelines).
- (iii) Pattern marks that are “fanciful, unusual and/or arbitrary, [or] departs from the norm or customs of the

¹¹ See AWS at [25]-[34] and Applicant’s Supplementary Written Submissions (“ASWS”) at [10]-[12].

sector” can be inherently distinctive (pursuant to the UKIPO Manual).¹²

26 I note that the Singapore Trade Marks Registry has not issued any guidelines for the examination of pattern marks.

27 I agree with the proposition in [25(i)] that pattern marks that are descriptive or customary in the trade, or otherwise indistinctive are objectionable. Such marks would not help consumers to identify the source of the goods or services in question. Further, a single trader should not be permitted to monopolise such patterns, which other traders should be free to use.

28 The proposition in [25(ii)] that pattern marks “composed of extraordinarily complex designs” are also objectionable merits some elaboration. Briefly, the rationale is that the complexity of the overall design will not allow the design’s individual details to be committed to memory. Consequently, the targeted public would perceive such patterns as merely decorative elements (see EUIPO Guidelines). I also agree with this proposition. A pattern which the average consumer is not even able to remember can hardly serve to designate origin.

29 However, with regard to the proposition in [25(iii)], it is not clear to me that a pattern would function as a badge of origin just because it is “fanciful, unusual and/or arbitrary, [or] departs from the norm or customs of the sector”.

30 Having considered the matter, and bearing in mind the core function of a trade mark, which is to help consumers to identify the source of goods or services, I am prepared to accept that this proposition may be applicable for

¹² ASWS at [12].

goods and services which do not normally bear any patterns at all. In such cases, it may well be that consumers seeing a fanciful, unusual and/or arbitrary pattern on these goods or services may view the pattern as denoting origin.

31 However, for goods and services which may normally bear patterns (e.g. clothing), it is unlikely in my view that a consumer will think that a pattern denotes origin, even if the pattern is fanciful, unusual and/or arbitrary. It is more likely that a consumer would still regard such a pattern as being decorative.

32 I accept that it may be possible for such a pattern to acquire technical distinctiveness as a result of the use made of it in Singapore. However, the Applicant has made clear that it is not relying on the use of the Application Mark to establish acquired technical distinctiveness in the present case.¹³

Registrability of Application Mark

33 I turn now to consider whether the Application Mark in the present case should be accepted for registration.

34 In support of its position, the Applicant makes the following arguments:

(a) Firstly, the Application Mark consists of the Applicant's Flower Quatrefoil Marks, each of which is separately registered as a trade mark in relation to the relevant goods. The Application Mark should similarly be registrable.

(b) Secondly, the Application Mark is inherently technically distinctive as it is "fanciful, unusual and/or arbitrary, [or] departs from the norm or customs of the sector."

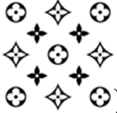
¹³ See AWS at [12] and ASWS at [3].

(c) Thirdly, the Application Mark is comparable to other pattern marks which have been accepted for registration in Singapore.

(d) Fourthly, the Application Mark has been successfully registered in numerous other jurisdictions around the world.




35 I will examine each of these arguments in turn.

Applicant's 1st Argument: Each component of the Application Mark is separately registered as a trade mark

36 To recap, the Application Mark () consists of three (3) devices

namely, “”, “” and “”, arranged in a particular manner.

37 Each of these devices is separately registered as a trade mark in the relevant classes.¹⁴ The Applicant submits that each of these devices must be accepted to be inherently technically distinctive having regard to s 101(a) TMA which states that “[i]n all legal proceedings relating to a registered trade mark or any right thereunder... – the register is prima facie evidence of anything

¹⁴  is registered in Classes 9, 14, 18 and 25 as T0512682A, T0512683Z, T0512684H and T0512685F respectively;  is registered in Classes 9, 14, 18 and 25 as T0504440Z, T0514535D, T0514536B and T0514537J respectively; and  is registered in Classes 9, 14, 18 and 25 as T0504441H, T0514538I, T0514539G and T0514540J respectively. See AWS at [4] read with Annex B.

contained therein.” Consequently, the Application Mark, being a combination of three (3) inherently technically distinctive registered trade marks, ought also to be found to be inherently technically distinctive.¹⁵

38 The Examiner rejected this argument and observed as follows:

While each of the flower quatrefoil marks may be distinctive, the repetition of such distinctive marks does not equate to the resulting pattern being also inherently distinctive.

We are of the view that in this case, when the three flower quatrefoil marks are repeated to form a pattern and applied to the goods claimed, the subject mark would be viewed by the average consumer as a design to enhance the visual appeal of the goods. Consequently, it is unlikely that the average consumer would recognize such a pattern as an indicator of trade origin, and would instead perceive the mark as nothing more than an embellishment.¹⁶

39 I agree with the Examiner. I note that this position is consistent with the HK Work Manual, which draws a distinction between two situations: (i) where the registered mark can on immediate impression stand out from other elements of the mark, for example because of its prominent size or position; and (ii) where the distinctiveness of the registered mark in the applied-for mark is subsumed (for example because of its insignificant size, position or presentation in relation to other elements of the mark) so that the applied-for mark is on immediate impression merely perceived as a repeating pattern for decorative purposes. In my view, the current case falls within the second situation.


40 Further, I note that permitting the Application Mark to be registered would give rise to uncertainty as to the scope of rights conferred on the Applicant.

¹⁵ AWS at [15] and [16].

¹⁶ Letter from IPOS to Applicant dated 5 January 2022 at [2].

41 In *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 2 SLR 382 (“*City Chain*”), the appellant launched a range of watches in Singapore bearing the SOLVIL trade mark as well as flower devices (“Solvil Flower”) on its dial and strap. The respondent alleged that one of its flower quatrefoil marks



(namely, ) had been infringed by the appellant’s use of the Solvil Flower on the Solvil watches. The Court of Appeal noted that “the Solvil Flower is displayed in a randomly-repeated pattern on the inner and outer Solvil watch dial; the shape and size of the Solvil Flowers on the Solvil watch dial are varied (some Solvil Flowers have small diamantes included while others do not); some petals of the bigger Solvil Flowers in the inner Solvil watch dial are cut off; and incomplete Solvil Flowers are present on the Solvil watch strap which do not have a circle in the middle of the flower). With no uniformity on how the Solvil Flowers are represented on the Appellant’s watches, we find that the predominant use of the Solvil Flower is for decorative purposes.” The court therefore found that such use was not infringing as it was not trade mark use.¹⁷

42 It is interesting to note that, in *City Chain*, the appellant’s Solvil watches had been seized pursuant to search warrants issued by a magistrate¹⁸, and the appellant had subsequently been charged for offences under s 49(c) TMA. At the High Court, the trial judge dismissed the appellant’s application to quash the search warrants and allowed a claim against the appellant for trade mark

¹⁷ *City Chain* at [38]. See also the discussion of this case in *Ng-Loy* at [23.3.5].

¹⁸ On 16 May 2007.

infringement.¹⁹ As noted in the preceding paragraph, the appellant was ultimately vindicated by the Court of Appeal.²⁰

43 If the Application Mark, which comprises the Applicant’s Flower Quatrefoil Marks arranged in a pattern, is allowed to proceed to registration, other traders using allegedly similar flower devices arranged in a pattern may find it difficult to argue that such use is for decorative purposes. This would expose such traders to the risk of both civil and criminal liability.

Applicant’s 2nd Argument: Application Mark is inherently technically distinctive

44 The Applicant’s argument that the Application Mark is inherently technically distinctive flows in part from its first submission that the Application Mark consists of three (3) devices which have each been registered as trade marks in the relevant classes.²¹ I have already addressed this argument in the preceding section of my grounds of decision.

45 The Applicant also asserts that, in any event, the Application Mark is inherently technically distinctive as it is “fanciful, unusual and/or arbitrary, [or] departs from the norm or customs of the sector” (as per the UKIPO Manual).²²

46 During the hearing, I asked the Applicant how a tribunal is supposed to assess this without the benefit of any filed evidence. I also asked the Applicant if it would like to adduce evidence via a statutory declaration to demonstrate

¹⁹ *Louis Vuitton Malletier v City Chain Stores (S) Pte Ltd* [2009] 2 SLR(R) 684 (judgment dated 29 January 2009).

²⁰ The Court of Appeal issued its judgment allowing the appeal on 19 May 2009.

²¹ AWS at [31]-[32].

²² AWS at [25]-[34] and ASWS at [10]-[12].

that the Application Mark “departs from the norm or customs of the sector.” In its Supplementary Written Submissions, the Applicant confirmed that it will not be filing a Statutory Declaration as it is proceeding on the basis that the Application Mark is inherently distinctive. It submitted that the assessment of inherent distinctiveness is conducted from the viewpoint of the “hypothetical average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect” (*Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 at [33]). For the claimed goods in Classes 9, 14, 18 and 25 (being consumer goods which can be purchased by ordinary members of the public directly from traders), the hearing officer can make the assessment based on his / her practical experience and knowledge as a notional average consumer of the goods in question (*Fox Racing, Inc. v Fox Street Wear Pte Ltd* [2014] SGIPOS 13 (“**Fox Racing**”) at [85]. Further, allowing the Application Mark to proceed to registration without having the benefit of evidence or arguments from a contrary viewpoint in the matter “is a feature, not a flaw, of the trade mark examination process”; a third party who objects to the registration of the Application Mark may file an opposition during the publication phase and “put forward some other evidence ... or arguments for the Registrar’s consideration”. In such event, the hearing officer “is not bound by this present decision and will be able to consider the issue afresh.” (*In the matter of a Trade Mark Application by Floor Xpert Pte. Ltd.* [2022] SGIPOS 9 (“**Floor Xpert**”) at [41] and [5])²³

47 I am prepared to accept that the assessment of inherent technical distinctiveness of the goods of interest in the present case can be conducted without the need for the Applicant to file evidence to establish that the pattern depicted in the Application Mark is “fanciful, unusual and/or arbitrary, [or]

²³ ASWS at [3], [14], [17]-[18], [34]-[35].

departs from the norm or customs of the sector.” As observed in *Fox Racing* (at [85]), in opposition proceedings before this Tribunal (and before the High Court on appeal), parties normally do not put forward any evidence from the trade on the issue of whether the parties’ respective goods are similar.²⁴ This practice is consistent with IPOS being a low-cost forum to resolve disputes in trade mark opposition proceedings.²⁵ The requirement to furnish evidence would inevitably increase costs for parties, and is arguably not necessary in situations where a hearing officer can make an assessment based on his / her practical experience and knowledge as a notional average consumer of the goods in question. This rationale applies with greater force at the trade mark application stage, where transaction costs for parties (which include many small and medium-sized enterprises, as well as individuals) should be kept low.

48 It does not follow, however, that a trade mark examiner (or this Tribunal) should not be vigilant when assessing whether an application should be permitted to proceed to registration. Registration of a trade mark confers on the proprietor powerful rights which can be asserted against competitors (see, for example, [1] above). It is for this reason that a trade mark must satisfy various criteria²⁶, including the requirement that it must be technically distinctive, before it can be registered.

49 In *Floor Xpert*, the hearing officer observed that the “Applicant made substantial efforts to use and advertise the Application Mark over the 8 years

²⁴ This is one of the elements which an opponent must establish to succeed in an opposition under s 8(2)(b) TMA.

²⁵ This is evidenced, for example, by the Trade Mark Rules making clear that costs awarded in proceedings before IPOS are not intended to compensate the parties for the expense to which they may have been put (Rule 75(2)), and the Fourth Schedule in the Rules prescribing a Scale of Costs, which caps the costs claimable.

²⁶ Set out principally in ss 7 & 8 TMA.

leading up to the Relevant Date” and that “there was no other trader in the marketplace using ‘Floor Xpert’.”²⁷ It was in this context that he commented (at [41]) that allowing the “Floor Xpert” mark to proceed to registration without having the benefit of evidence or arguments from a contrary viewpoint “is a feature, not a flaw, of the trade mark examination process”.

50 Ultimately, trade mark examiners (and this Tribunal) must strike a balance between safeguarding the integrity of the trade mark register by disallowing registration of unmeritorious applications, and not being overly pedantic in the examination of trade mark applications. In attempting to do so, it is inevitable that some applications will be allowed, which a reasonable person might legitimately feel should have been refused (or *vice versa*). It is in this context that the hearing officer in *Floor Xpert* observed (at [5]) that: “after the mark is accepted for registration, it will next be published in the Trade Marks Journal where, for a period of time, any party may oppose the registration of the mark. Even after the window for opposition passes (and the mark proceeds to registration), any party may apply to invalidate a registered trade mark. In the event of any challenge, the person hearing the matter is not bound by this present decision and will be able to consider the issue afresh.”

51 In the present case, albeit not without some hesitation, I am prepared to allow the Application Mark to proceed to registration in respect of the following goods²⁸, which in my experience as a consumer do not normally bear any

²⁷ *Floor Xpert* at [40]. The decision examines the evidence in considerable detail.

²⁸ I note that the list of items for which I allow the Application Mark to proceed to registration bears some similarity to the specification of goods which was allowed in the UK (see [59(b)] below). The reasons for the position taken in the UK are not known to me.

patterns at all (see discussion at [23] – [32] above on the registrability of pattern marks in such situations):

Class No.	Goods ²⁹
9	<p>Eyewear; sunglasses; spectacles [optics]; spectacle frames; spectacle lenses; spectacle chains; spectacle cords; spectacle cases; containers for contact lenses; sleeves for laptops; bags designed for laptop computers; cases especially made for photographic apparatus and instruments; covers for smartphones; cases for smartphones; straps for mobile telephones; protective films designed for smartphones; grips, rings and holders adapted for smartphones; selfie sticks; protective face shields; protective masks; protective chin straps; protective gloves; mouse pads; binoculars; protective helmets for sports; sports whistles; directional compasses; apparatus and instruments for sound or image recording, transmission, reproduction or processing; loudspeakers; headphones; earphones; hands-free kits for telephones; smart watches; connected bracelets [measuring instruments]; downloadable computer software applications; downloadable music files; digital or analog recording and storage media; USB flash drives; smartphones; electronic tablets; photographic apparatus; personal stereos; portable media players; compact disk players; cassette players; record players; microphones; sound recording disks; chargers for electronic apparatus; animated cartoons; downloadable game software; downloadable electronic publications; downloadable graphic elements for mobile telephones; downloadable emoticons for mobile telephones.</p>
14	<p>Jewelry and jewelry articles; rings and finger rings [jewelry]; earrings; cuff links; bracelets [jewelry]; bracelets of embroidered textile materials [jewelry]; jewelry charms; brooches [jewelry]; chains [jewelry]; necklaces [jewelry]; pendants [jewelry]; medallions [jewelry]; amulets [jewelry]; jewelry cases; pins [jewelry]; tie pins; tie clips; jewelry boxes; boxes of precious metals and their alloys; medals; pearls [jewelry]; semi-precious stones; precious stones; diamonds; jewelry for bags; charms for key rings; key</p>

²⁹ For ease of comparison, I have reproduced the list of goods for which registration is sought. I allow the Application Mark to proceed to registration for the items highlighted in green, but not for the items which are struck out.

	<p>rings; statues of precious metals and their alloys; works of art of precious metals and their alloys; figurines and statuettes of precious metal; timepieces; watches; wristwatches; watch bands; watch cases; dials [timepieces]; watch chains; chronometers; presentation cases for watches; clocks; alarm clocks; chronometric instruments; movements for timepieces.</p>
18	<p>Bags; backpacks; handbags; traveling bags; suitcase cases [carrying cases]; attaché cases; wheeled bags; net bags for shopping; trunks [luggage]; suitcase cases; traveling trunks; vanity cases, not fitted; travel sets [leatherware]; garment bags and shoe bags for travel; hat boxes of leather; boxes of leather or leatherboard; wallets; purses; card cases [wallets]; business card cases; key cases; address tags for luggage; leather labels; leather cord; shoulder belts of leather or imitation leather; straps of leather or imitation leather; girths of leather; leather and imitations of leather; bags for transporting animals; collars for animals; leashes; clothing for pets; umbrellas; parasols and sunshades; whips; walking sticks; saddlery; furniture coverings of leather.</p>
25	<p>Clothing; tee-shirts; shirts; short-sleeve shirts; overalls; vests; sweaters and pullovers; jerseys [clothing]; knitwear [clothing]; coats; jackets; parkas; raincoats; overcoats; hoods [clothing]; ponchos; suits; combinations [clothing]; dresses; skirts; shorts; trousers; boxer shorts; leggings [trousers]; underwear and underclothing; pajamas; nightgowns; dressing gowns (robes); bathrobes; bathing suits; bathing trunks; corsets [underwear]; collars [clothing]; detachable collars; Ascots; cuffs [clothing]; kimonos; layettes [clothing]; belts [clothing]; money belts [clothing]; scarves and long scarves; shawls; stoles; bandanas [neckerchiefs]; pocket squares; neckties; suspenders; gloves [clothing]; fingerless gloves; mittens; muffs [clothing]; ear muffs [clothing]; neck scarves and mufflers; headwear; hats; beanies; headbands [clothing]; caps; cap peaks; socks; tights; stockings; masks for sleeping; footwear; footwear and shoes; sports footwear; boots; ankle boots; esparto shoes or sandals; sandals; gaiters; après-ski footwear; slippers and bedroom slippers.</p>

Applicant's 3rd Argument: Application Mark is comparable to other pattern marks which have been accepted for registration in Singapore

52 The Applicant also argues that the Application Mark should be accepted for registration as (according to the Applicant) a number of pattern marks which are comparable to the Application Mark have been accepted for registration. Essentially, the argument is that the Registry should adopt a consistent practice when examining such marks. The Application Mark is therefore also deserving of registration by parity of reasoning.³⁰

53 This submission was rejected by the Examiner for the following reason:

“... the precedents submitted are not in this instance useful, as the impression conveyed by the precedents is not similar to that conveyed by the subject mark. We would also like to highlight that the Registry’s 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.”³¹

54 I agree with the Examiner. I also note that three out of the four prior pattern marks relied on by the Applicant³² seem to include the respective proprietors’ monograms as part of the pattern. It is arguable that it is the inclusion of the monogram which renders these marks sufficiently distinctive as a whole.³³

³⁰ AWS at [22], [35]-[54].


³¹ Letter from IPOS to Applicant dated 30 August 2022 at [2].


³² Reproduced at [22] of AWS.

³³ For the avoidance of doubt, I make no such finding in the present case.

55 In this regard, I note that in its submissions to the Examiner, the



Applicant had relied on its signature monogram mark () which has been registered in Singapore for many years for the same goods claimed in Classes 9, 14, 18 and 25.³⁴ The Examiner rejected this comparison on the basis that the

Applicant's house mark () is absent in the Application Mark.³⁵ I agree.

56 Finally, at the oral hearing before me, I asked the Applicant whether it had located similar pattern marks which had been rejected by the examiner based on its searches of the Register. The Applicant replied that it had only conducted a search for registered pattern marks and did not search for rejections. Accordingly, even if it were permissible to look to prior applications to try to ascertain a consistent practice at the Registry when examining pattern marks, this would clearly not be possible in the present case since the picture presented to me is incomplete.

Applicant's 4th Argument: Application Mark has been successfully registered in numerous other jurisdictions around the world

57 To buttress its other arguments, the Applicant relies on the registration of the Application Mark in around 38 jurisdictions around the world, including the EU and the UK, whose laws relating to inherent technical distinctiveness are generally aligned with Singapore law. While the Applicant accepts that these registrations are not binding, it "submits that it would be inconceivable for the Applicant to be able to use and protect the Application Mark in an international market and setting, but not be able to protect it in Singapore, a jurisdiction which

³⁴ Applicant's letter to IPOS dated 18 July 2021 at [6]-[8].

³⁵ IPOS letter to Applicant dated 5 January 2022 at [2].

we understand strives to be an intellectual property hub for the world’s international brands.”³⁶

58 While I can accept the Applicant’s submission as an abstract proposition, it is not helpful in specific cases. This is because the relevant laws and practices in different jurisdictions may differ. The submissions made and evidence adduced before the Registries in these jurisdictions may also be different. Further, cultural differences in various jurisdictions may point to certain types of patterns being commonplace in some jurisdictions but not others.

59 In the present case, I also note that the outcomes of the applications in the various jurisdictions relied upon by the Applicant are in any event not consistent. At the hearing before me, I noted that the status of the Madrid Protocol application in the UK and New Zealand included the following statement: “Partial provisional refusal of protection”.³⁷ I therefore asked the Applicant to let me know the status of the Applicant’s corresponding applications in these as well as various other common law jurisdictions, which the Applicant duly did in its Supplemental Written Submissions.³⁸ I set these out below:

³⁶ AWS at [55]-[58].

³⁷ See Annex E to AWS.

³⁸ ASWS at [4]-[6] and documents enclosed as Annex A.

(a) In the European Union, Hong Kong and New Zealand, the Applicant has obtained registration of the Application Mark for nearly identical goods in Classes 9, 14, 18 and 25.³⁹

(b) In the UK, the Applicant only obtained registration of the Application Mark for a greatly restricted list of goods in Classes 9 and 14, namely:

Class No.	Goods
9	Selfie sticks; binoculars; sports whistles; apparatus and instruments for sound or image recording, transmission, reproduction or processing; loudspeakers; connected bracelets [measuring instruments]; downloadable computer software applications; downloadable music files; digital or analog recording and storage media; USB flash drives; earphones; photographic apparatus; personal stereos; portable media players; compact disk players; cassette players; record players; microphones; sound recording disks; chargers for electronic apparatus.
14	Chains [jewelry]; pearls [jewelry]; semi-precious stones; precious stones; diamonds; statues of precious metals and their alloys; watch chains.

(c) In Canada and the US, the applications are still pending, though it appears from the Applicant's submissions that the reasons for objection may not be due to the lack of inherent technical distinctiveness of the Application Mark.

³⁹ Examples of some of the minor differences in the goods for which the Application Mark secured registration include "spectacles" (in the EU and HK registrations) compared to "spectacles (optics)" in the Application Mark. (For reasons unknown, the item "*beanies*" in Class 25 was deleted in the New Zealand registration.) I also note that the Application Mark has been accepted in Australia: see Annex F to letter from Applicant to IPOS dated 18 July 2021.

Summary and Conclusion

60 In summary, I find that:

(a) the Application Mark should be assessed on the basis that it will be used as a pattern mark to be applied throughout the surface of the relevant goods or packaging thereof;

(b) in the absence of evidence of use (such as in the present case), pattern marks would generally not be distinctive, as required under s 7(1)(b) TMA; the average consumer would normally regard a pattern as decorative and not as a trade mark designating commercial origin;

(c) notwithstanding, a pattern mark may be inherently technically distinctive **if** it is used on goods or services which normally do not bear any patterns **and** the pattern sought to be registered is fanciful, unusual and/or arbitrary, or departs from the norm or customs of the relevant sector;

(d) for consumer goods which can be purchased by ordinary members of the public directly from traders, this assessment can be made by an examiner or hearing officer based on his / her practical experience and knowledge as a notional average consumer of the goods in question;

(e) applying this test, the Application Mark is inherently technically distinctive only for the goods in Classes 9, 14 and 18 set out at [51] above; and

(f) as this finding is made on an *ex parte* basis, it is open to challenge by third parties in any subsequent opposition or invalidation proceedings.

61 To conclude, protection in Singapore is conferred on the Application Mark in respect of the restricted specification of goods in Classes 9, 14 and 18 set out at [51] above.

Mark Lim Fung Chian
Principal Assistant Registrar

Mr Jon Chan Wenqiang, Ms Maria Xenia Robles Lafiguera and
Mr Harren Yip Shuen Kai (Ravindran Associates LLP) for the
Applicant
