

Intellectual Property Office of Singapore
Case Summary: *Eley Trading Sdn Bhd v Kwek Soo Chuan* [2017] SGIPOS 15

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This case concerns an application to invalidate the following trade mark:

菩提

(“the Mark”) registered in the name of Kwek Soo Chuan (“the Proprietor”). The Mark was registered on 9 April 2013 in respect of goods in Class 3, namely, “*incense; incense sticks; incense coils; incense cones; incense sprays; joss sticks; scented oils; scented preparations*” (“the Goods”).

The Mark, “菩提” (pronounced “Pu Ti”) is a Chinese word meaning “Bodhi” or “Enlightenment”. It was not disputed that the incense products are used by practising Buddhists, or that enlightenment is the ultimate goal of Buddhism.

Eley Trading Sdn Bhd (“the Applicant”) applied on 24 April 2015 for the Mark to be declared invalid. Very broadly, the bases for the application are that the Mark: (a) is not distinctive, (b) is descriptive of the intended purpose of the Goods, (c) was applied for in bad faith, and (d) is confusingly similar to its



earlier trade mark for which is registered for the same products.

The evidence showed that other traders in Singapore have been calling their incense “菩提香” (“香” (pronounced “Xiang”) is a Chinese word meaning “fragrance”) and such products have been available in Singapore long before 9 April 2013. Further, bearing in mind that “菩提” is the ultimate goal of Buddhism and the burning of incense is an integral part of Buddhism, the Registrar also found that “菩提” is a term which other traders of the Goods may wish to use for legitimate reasons. As such, the Registrar found that the Mark was not capable of distinguishing the goods of one trader from another and for public policy reasons should not be monopolised by a single trader.

The Registrar, however, did not agree with the Applicant’s very specific claim, based on a single article from the Internet (which says that “when Mahayana Buddhists light incense, they are affirming to those who are already enlightened that their purpose is to help others reach enlightenment, too”) that “菩提” designates the intended purpose of incense.

In order to avoid the declaration of invalidity, the Proprietor tried to show that the Mark has in fact acquired distinctiveness as a result of use by the Proprietor. Among other things, the Proprietor showed that his business name represented in Chinese characters is “菩提佛教文物批发中心”¹ and he has used



the signage on his shop signboard, company vehicles, office stationery (such as name cards, letterheads and invoices), calendars and product packaging. The Proprietor also gave evidence to the effect that he has been linked with the words “菩提” and he is referred to as such by his customers. The Registrar, however, held that the fact that the Proprietor is referred to as “菩提” does not necessarily mean that his goods are also distinguished by the sign “菩提”. Whether acquired distinctiveness has been shown depends on the nature of the use and the effect that use is likely to have on the consumer. In the instant case, the signs “菩提佛教文物批发中心” and



, in the context in which they are used, merely designate the distributor

¹ Pronounced “Pu Ti Fo Jiao Wen Wu Pi Fa Zhong Xin” meaning “Bodhi Buddhism Cultural Relic Wholesale Centre”.

or retailer of the Goods. They have never been used to designate the Goods themselves, which bore their own trade marks. The signs may perhaps have been used as a trade mark for wholesale or retail services of incense products, but it was certainly not used as a trade mark for the Goods.

The Applicant also did not succeed on its ground of invalidation that the Mark was applied for in bad faith. Although the Proprietor admitted that at the time of applying for the Mark, he knew there were many other traders who were already selling incense labelled with the words “菩提” and that he applied to register the Mark in order to stop other traders from selling incense bearing the words “菩提”, the Registrar found that this per se is not evidence of bad faith. Given that the Proprietor has been trading under the name “菩提佛教文物批发中心”, the Registrar accepted the Proprietor’s evidence that the Mark was filed to help him protect his perceived interest (whether rightly or wrongly held) in the words “菩提”. The fact that this was triggered by other traders’ use of “菩提” makes no difference although it explains the timing of the application.

The Applicant also failed in its ground of invalidation that the Mark is confusingly similar to its earlier



trade mark for which is registered for the same products. The Registrar found that the marks were more dissimilar than similar.

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