

**NAMES AND/OR REPRESENTATIONS OF FAMOUS PEOPLE, FICTIONAL
CHARACTERS, STORIES AND BUILDINGS**

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This Work Manual Chapter (Version 3.1) has been updated on 11 November 2022. This update seeks to ensure that the cited legislation and corresponding references in the chapter are current, as a result of the legislative amendments and fee updates implemented on 29 April 2022. There are no substantive amendments made to the previous Version 3, December/2020.

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1. INTRODUCTION

This chapter is concerned with marks which contain or consist of the name or representation of a famous person, fictional character, story or building.

2. RELEVANT LEGISLATION

Trade Marks Act 1998 (2020 Rev. Ed.)

Absolute grounds for refusal of registration

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

...

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

...

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

...

(6) A trade mark must not be registered if or to the extent that the application is made in bad faith.

Trade Marks Rules

Persons living or recently dead

14. — (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

3. NAMES AND/OR REPRESENTATIONS OF FAMOUS PEOPLE

A mark may contain or consist of the name and/or representation of a famous personality, which can be an individual or a group. The name need not be the famous personality's full name, it may be the surname, given name or even the nickname, so long as the name has become interchangeable with the famous personality's full name such that the average consumer would understand the name as referring back to the famous personality. The representation may be a photograph, a picture, a drawing or other forms of image portraying the famous personality, such that the average consumer would be able to identify the famous personality from the representation.

Two issues will have to be looked at when determining the registrability of a trade mark that contains or consists of the name and/or representation of a famous personality. Firstly, whether the name or representation is capable of functioning as a badge of origin and secondly, whether authorisation, if required, has been obtained for the use of that name or representation of the famous person.

3.1 Inherent distinctiveness of the mark

The question is whether the name or representation is likely to be taken as an indication that the goods and/or services originate from a single trade source or whether it will be seen as denoting some characteristics of the goods and/or services, for example, a description of the subject matter of the goods and/or services.

This is assessed by looking at the goods and/or services applied for under the mark and the perception of the average consumers of such goods and/or services in Singapore (who are assumed to be reasonably well informed, observant and circumspect). If the average consumer would not expect all the goods and/or services claimed in the application bearing the famous name or representation to originate from a single undertaking, an objection under section 7(1)(b) will arise. In addition, in cases where the mark is descriptive of the goods and/or services claimed in the application, it will be objectionable under section 7(1)(c).

The issue here is whether the name or image is likely to be taken as an indication that the goods or services have come from a particular source, or if the use of the name/image in relation to the goods or services will merely be seen as a commemoration of that famous person or an indication that they are about that person. In this regard, if a famous personality's name or representation is likely to result in a demand for memorabilia or commercial consumer items, then the general public is unlikely to see that name or representation as anything other than an indication of the content or characteristic(s) of the goods.

The following is a non-exhaustive list of goods and services in which a famous name or representation is, more often than not, the subject matter, and thus descriptive of the goods and services:

- Recording discs; electronic publications; computer game software etc. (Class 09)
- Printed matter; printed publications; photographs; stickers etc. (Class 16)
- Toys; playthings etc. (Class 28)
- Broadcasting services; transmission of audio and video content etc. (Class 38)
- Production of music and film; presentation of live performances etc. (Class 41)

In assessing whether to raise an objection, the examiner would have regard to how the famous person's name or image is perceived and whether it is required for descriptive purposes. This in turn requires the examiner to consider, among other things:

- (i) the nature and extent of the reputation of the famous person;
- (ii) the nature of the goods in respect of which registration is sought;
- (iii) how other traders would use the name or image of the famous person;
- (iv) whether any existing trade in souvenirs, memorabilia, etc. exists or can be expected to arise;
- (v) (in the case of literary or artistic figures) the extent to which the life and works of the famous person are kept alive either by general public interest or media coverage, etc. in such a way as to generate demand for commercial consumer items;
- (vi) how the public would view the use of the name or image of the famous person.

3.1.1 Mark contains or consists of personal name and/or representation

It should be noted that an individual does not have an exclusive and unqualified right to the use of his/her name and/or representation for commercial purposes. This was affirmed in *ELVIS PRESLEY Trade Marks [1997] RPC 543* ("*ELVIS 1997*"), where Elvis Presley is the name of an internationally famous rock and roll singer in the early 1950's, where the judge said, "*Just as Elvis Presley did not own his name so as to be able to prevent all and any uses of it by third parties, so Enterprises can have no greater rights. Similarly, Elvis Presley did not own his appearance. For example, during his life he could not prevent a fan from having a tattoo put on his chest or a drawing on his car which looked like the musician simply on the basis that it was his appearance which was depicted. For the same reason under our law, Enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any of the myriad of photographs, including press photographs, and drawings in which it does not own the copyright simply by reason of the fact that they contain or depict a likeness of Elvis Presley. Nor could it complain if a fan commissioned a sculptor to create a life-size statue of the musician in a characteristic pose and then erected it in his garden. It can only complain if the reproduction or use of the likeness results in the infringement of some recognised legal right which it does own.*"

In addition, a name which is unique to a particular person does not mean that it possesses distinctive character as a trade mark. In ***DIANA, PRINCESS OF WALES Trade Mark [2001] ETMR 254*** (“***DIANA, PRINCESS OF WALES***”), where Diana was a member of the British royal family with the title of Princess of Wales, the Hearing Officer refuted the claim that a name which is unique to a particular person must by definition have distinctive character as a trade mark in the following extract, “*Personal names do not usually allude to non-origin attributes of the goods and services. Indeed, most personal names are readily taken as denoting the trade source of the goods, e.g. ‘Laura Ashley’, ‘Harry Ramsden’ and ‘Dorothy Perkins’. However, where a famous name is concerned (other than names which are famous as indicators of trade source, as in these examples) there is the possibility that the name will serve to signify not the trade source of the goods/services but merely the subject matter. The Elvis case is an example of this.*”

It was held in ***DIANA, PRINCESS OF WALES***, that the essential function of a trade mark is to guarantee that the items bearing it had originated under the control of a single undertaking responsible for their quality. Thus, the use of a famous name to endorse a product does not constitute trade mark use unless the proprietor takes responsibility for the quality of the goods and/or services to which it is applied. In this case, the average consumer would not have expected all commemorative items bearing Diana's name to be marketed under the control of a single undertaking. In addition, Diana's name was not used for commercial purposes by her during her life. Although her name was often used, none of this use of her name indicated any trade connection between the source of any goods and services and the Princess. The reasonably well informed and observant average consumer would be aware that there was a long history of use on mementoes featuring the royal family, which had no significance as to the trade source of the goods. Hence, it is unlikely that they would attach any trade mark significance to the name as at the date of the application when they had not done so when she was alive.

Similarly, in ***ELVIS PRESLEY Trade Marks [1999] RPC 567*** (“***ELVIS 1999***”), the marks “Elvis” and “Elvis Presley”, were refused as members of the public purchased Elvis Presley merchandise not because it came from a particular source but because it carried the name or image of Elvis Presley.

The distinctiveness of a name or representation is assessed at the date of application of the mark (see ***TARZAN Trade Mark [1970] RPC 450*** (“***TARZAN***”). If at that date the personality was so famous that its name or representation possessed very little inherent distinctiveness, the name or representation is not registrable. Hence, the greater the fame of a personality, the lesser the inherent distinctiveness that its name or representation will have. This was affirmed in ***ELVIS 1997***, where the judge citing ***TARZAN*** said, “*These passages emphasise that the more a mark has come to describe the goods to which it is to be applied or to indicate some quality of those goods, the less it is inherently adapted to carry out the trade mark function of distinguishing the trade origin of the proprietor's goods from the origin of similar goods from other sources. This is consistent with Mr. Meade's argument that the more famous Elvis Presley*

is, the less inherently distinctive are the words “Elvis” and “Presley”. They are peculiarly suitable for use on the wide range of products sold as Elvis Presley memorabilia. He therefore does not contest but adopts Enterprises’ assertion that “Elvis is about as famous a name as could be, made famous by the efforts of Elvis Presley. ... Why else do members of the public wish to [purchase] Elvis merchandise?” Just as members of the public will go to see a Tarzan film because it is about Tarzan, so they will purchase Elvis merchandise because it carries the name or likeness of Elvis and not because it comes from a particular source.”

3.1.2 Mark contains or consists of invented name

Although invented word(s) are generally distinctive as they are meaningless, it is possible for them to lose their distinctiveness if they have acquired a meaning as a result of the use made of it over time. The relevant date for assessing the meaning of the mark is as at the date of application and not the date when the mark was coined. The fact that the mark was already widely known to be the name of the music group by the application date meant that the mark was no longer meaningless. The term need not become a dictionary term in order for it to attract an objection under sections 7(1)(b) and 7(1)(c) (see ***LINKIN PARK [2006] ETMR 74***, where “LINKIN PARK” is the name of an American rock band that rose to international fame with their debut album in 2000).

The name or image of an artist or group of artists affixed to compact discs and displayed on packaging merely indicates the name of the performer whose performance is recorded on the compact disc. If the use of the name is not likely to be understood as indicating the trade source of the good, then such use would be descriptive only. Similarly, such a name or image appearing on goods such as posters, calendars, photographs, transfers and figurines is likely to be seen as the subject matter of such goods and the mark would be precluded from registration under sections 7(1)(b) and 7(1)(c). Having said that, whether or not an objection is appropriate will depend on the fame of the person or group. The more famous the person or group, the more likely it is that there will be a market for goods bearing the name or image of the person or group and the less likely it will be regarded as acceptable for registration.

3.1.3 Signatures

Signatures are generally considered more distinctive than the name in ordinary typeface as it is presented in a form which visually distinguishes it from the name, thereby conferring the mark with a higher degree of distinctiveness. Therefore, it should be noted that a name in perfect script or nearly resembling such that it is no different from an ordinary typeface will not be regarded as a signature.

In the example below, “Ah Seng” is the name of a famous personality. Signature A would be considered more distinctive as it differs from the ordinary typeface of the name. On the other hand, Signature B would be less distinctive as it resembles the ordinary typeface and can be easily discerned as “Ah Seng”.



Signature A



Signature B

3.2 Authorisation for the registration and use of the mark

An application to register the name/representation/signature of a famous personality or a recently deceased famous personality may face an objection under section 7(6) which provides that, a trade mark must not be registered if or to the extent that the application is made in bad faith. The application could attract a bad faith objection when it covers goods and/or services with which the famous personality is associated. For example, an application to register the name of a famous footballer for “footballs” would be objectionable because it is likely to indicate either the patronage of the footballer, or that he/she is involved in the production of the goods and thereby take unfair advantage of the footballer’s reputation.

Bad faith objections can be overcome if the applicant obtains the written consent of the famous personality or his/her legal representative to the registration and use of the mark.

Under rule 14 of the Trade Marks Rules, the Registrar may, before proceeding to register a mark in which the name or representation of any person appears, require the applicant to furnish the Registrar with the consent of the person. Where consent is required by the Registrar, the applicant must furnish the person's consent to the registration and use of the mark for the specified goods and/or services.

4. NAMES AND/OR REPRESENTATIONS FAMOUS FICTIONAL CHARACTERS AND STORIES

4.1 Names of famous fictional characters and stories

The names of fictional characters/stories will be accepted on a prima facie basis as long as it is perceived as a sign indicating the origin of the goods and/or services. Similar considerations as discussed in section 3.1 above regarding the inherent distinctiveness of the mark apply.

If the name in question is widely known, it is possible that it will only be viewed as the name of the character in the story concerned and not as an indication of trade source (as held in *TARZAN*). In such cases, the mark may be seen as serving some other function, for example, designating that the goods feature the story/character concerned and will thus face section 7(1)(b) and (c) objections. For example, "CINDERELLA", which is the name of a famous fairy tale character who is exploited by her family as a servant but eventually meets and marries Prince Charming with the help of a fairy godmother, on goods such as dolls may be seen to serve the sole purpose of designating a characteristic of the goods and not as a badge of origin. Thus, it will be open to section 7(1)(b) and (c) objections.

In order to decide whether the name has become "famous", the critical date to look at is the date of the application (as held in *TARZAN*). If at the date of application, the name is not widely known, the applicants' own success at promoting the name after the date of application should not jeopardise the application. Conversely, if the name is already widely known as at the date of the application, promotional activities after the date of application by the applicant will not benefit the applicant even if it has brought about a certain level of association with the applicant.

It is to be noted that assessment of distinctiveness is based on whether the name is capable of functioning as a badge of trade origin in respect of the goods and/or services claimed. The fact that the applicant created the fictional character, owns the copyright or some other exclusive right to produce or reproduce materials associated with the fictional characters/stories is irrelevant to the issue.

4.2 Representations of famous fictional characters

Similar considerations apply when assessing the distinctiveness of the representations of famous fictional characters. However, as there are many ways to depict the same character, a representation of a famous fictional character may be acceptable if certain element(s) such as stylisation in the representation is able to confer the mark with sufficient degree of distinctiveness.

5. NAMES AND/OR REPRESENTATIONS OF FAMOUS BUILDINGS

Some factors to consider when determining the registrability of a mark bearing the name and representation of a famous building under section 7(1)(b) and (c) of the Trade Marks Act 1998 are:

- (i) whether the name or representation of the famous building is likely to generate demand for memorabilia as in the case for tourist attractions. For example, the representation of the Esplanade on memorabilia such as magnets, key chains etc. is likely to be seen by consumers as an indication of souvenirs from visiting Esplanade rather than signifying trade origin of the magnets.
- (ii) whether the building concerned has an association with the goods and/or services applied for, either because it is famous for the goods and/or services or it is a likely source of location of the goods and/or services.

Objections under section 7(6) may also arise if the applicant is not the owner or developer of the building. This objection will be waived if consent from the owner or developer of the building is obtained.

6. ACQUIRED DISTINCTIVENESS

Notwithstanding that a mark may fall afoul of the grounds in section 7(1)(b) and/or (c) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under section 7(2) of the Act.

The Registrar will consider whether there has been use of a mark as a trade mark, and whether as a result of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking.

(Reference should be made to the Trade Marks Work Manual's section on Evidence of Distinctiveness Acquired Through Use for more information.)