

WHAT IS A TRADE MARK?

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1 INTRODUCTION

This chapter is concerned with what constitutes a trade mark as well as issues relating to the graphical representation of trade marks.

2 RELEVANT LEGISLATION

Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

Interpretation

2. —(1) In this Act, unless the context otherwise requires —

...

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

"trade mark" means any **sign** capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

Application for registration

5. —(2) The application shall —

...

(c) contain a clear representation of the trade mark;

...

Withdrawal, restriction or amendment of application

14. —(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If the application has been published, the withdrawal or restriction shall also be published.

(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(4) The Minister may make rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

Registration subject to disclaimer or limitation

30. —(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

What is a trade mark?

- (2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.
- (3) The Minister may make rules as to the publication and entry in the register of a disclaimer or limitation.

3 DEFINITIONS – “TRADE MARK” AND “SIGN”

The definition of "trade mark" is a closed and exhaustive definition in that a “sign” must satisfy certain requisite conditions before it will qualify as a trade mark. The requisite conditions are:

- (i) the sign must be capable of being represented graphically; and
- (ii) the sign must be capable of distinguishing the goods or services dealt with or provided in the course of trade by a person from those provided by another person.

The definition of "sign" is an open or inclusive definition, in that the definition merely lists some examples of what may constitute a sign.

Based on the above, no type of sign is automatically excluded from registration unless it is clear that the sign does not constitute a trade mark based on the definition of a trade mark.

4 ACCEPTABLE FORMS OF GRAPHICAL REPRESENTATION

Section 2(1) provides that a trade mark is any sign capable of being represented graphically. Graphic representation requires that the sign must be able to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (see *Ralf Sieckmann (Case C-273/00)*). In that case, the ECJ decided that to be represented graphically, the mark must be presented in a way that is "clear, precise, self-contained, easily accessible, intelligible, durable and objective".

The purpose of the graphic representability requirement is:

- To define the mark and the protection on the Register.
The entry of the mark in a public register is to make it accessible to the competent authorities, the public and particularly to economic operators. Therefore, a trade mark must be **precise and clearly represented** so that the competent authorities know the nature of the signs of which the mark consists in order to be able to fulfill their obligations in relation to the prior examination of the registration application and to the publication and maintenance of an appropriate and precise register of trade marks.
- To enable the public to determine the precise nature of the mark sought for registration and the scope of the registration granted or sought for.
In order for third parties and users of the Register to know the precise nature of the mark sought for registration and the scope of the registration granted or sought for, the graphic representation in the register must be **self-contained, easily accessible and intelligible**. Applicants inspecting the register must be able to understand what the trade mark is. Applicants must be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.
- To fulfill the significance of a trade mark as a guarantee of origin.
In order to fulfill its role as a registered trade mark, a sign **must always be perceived unambiguously** and in the same way so that the mark is guaranteed as an indication of origin. It must represent no other sign except the one being applied for.
- To enable future renewals of the trade mark.
As a trade mark can be renewed every 10 years and maintained without any limit as to the total duration for as long as the proprietor wishes, it is necessary for the representation to be **durable**.
- To enable an objective assessment of the registration application.
The object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be **unequivocal and objective**. It must be possible to determine precisely what the sign is without the need for any samples or aids.

However, graphic representation does not mean visual representation. It does not matter that the mark cannot be perceived by a mere visual inspection. For example, in the case of sound marks, the relevant sound could be represented by musical notation even though it would not be possible to perceive the sound mark visually.

(a) Shape marks

For shape marks, a mere description of the shape would not be sufficiently precise to meet the graphical representation requirement (see *Swizzels Matlow Ltd's Application [1999] R.P.C. 879* below).

A shape mark should be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration as shown in the picture(s).

(i) Overall shape of goods or container claimed as the trade mark

Where the subject matter of the proposed registration consists of the overall shape of the goods or their container, it is inadequate to represent the shape by filing a single "front on" view of it because it would be difficult to ascertain from this one view whether the shape has a round profile or is four-sided. Unless the subject matter of the trade mark can be captured from a single perspective view, multiple views of the shape should be filed. The more complex the shape the more likely it is that multiple views will be necessary. Where multiple views are filed each view should be named accordingly, eg. front view, side view, etc.

Pictures should not be put forward as mere **examples** of the shape described in words, the graphical representation requirement would not be met since this way of representation would fall foul of the requirement for "a fixed point of reference".

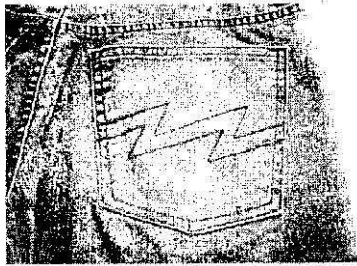
(ii) Parts of or essential particulars of a shape claimed as the trade mark

Where the subject matter of the proposed registration consists of only **part of a shape or the essential particulars of a shape** (such as the shape of a lid for a container), or the **position of something** (such as a label) attached to a three-dimensional object, such as a container, it is not necessary for the representation of the mark to show more of the shape of the three-dimensional container etc than is necessary to disclose the subject matter of the proposed registration. For example, it may only be necessary to show the shape of the lid and the position of the label thereon. It would also not be necessary to show all perspectives of the shape that do not disclose the essential particulars of the shape sought for registration.

In such a case, the parts of the configuration claimed to constitute the trade mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines. Alternatively if the unclaimed parts are not in broken lines but the

description of the mark makes it clear that some aspects of the pictorial representation shown are not claimed, it would also be acceptable.

Example



Description of mark:

“The trade mark consists of a device of zig zag stitches applied to the pockets of the goods, as shown in the representation on the application form.”

In summary, the description and the pictorial representation of the shape of the trade mark should together clearly define all the details which constitute the trade mark.

Examples

- The trade mark consists of the shape of a biscuit, as shown in the representation on the application form.
- The trade mark consists of the 3-dimensional shape of a rooster applied to the roof of a vehicle, as shown in the representation on the application form, where the vehicle itself is represented as dotted lines.
- The trade mark consists of a 3 dimensional shape of a perfume bottle with the words and device appearing thereon, as shown in the representation on the application form.

In the case where the pictorial representation is clear and all features of the mark are obvious, a briefer description of the trade mark will be acceptable.

Example

The trade mark consists of a 3 dimensional shape of a cookie container as shown in the representation on the application form.

NOTE: A term such as "as exemplified in the representation" is not sufficiently precise, and should not be accepted. This term does not clearly specify what the trade mark is. It merely says that an example of what the trade mark might be is attached to the application form.

Summary of Swizzels Matlow Ltd’s Application

An application was lodged in the UK on 3 March 1997 for “Non medicated confectionery” in Class 30. In place of the graphic representation was the statement: “The trade mark consists of a circular compressed tablet bearing a raised heart outline

on both flat surfacing and containing with the heart outline on one side any one of several different words or phrases.”

It was indicated that the mark was three dimensional.

Section 3(1)(a) objection was raised on the basis that the mark was not represented graphically since there could be several permutations of marks. Section 3(1)(b) and (c) objections were also raised on the basis that the mark was devoid of distinctive character and was a sign which other traders may wish to use.

During the hearing, evidence was filed in the form of brochures, advertisements and various aids. It was found that the sign was always used with the house mark SWIZZELS and the trade mark LOVE HEARTS.

The Section 3(1)(c) objection was eventually waived.

The Section 3(1)(a) objection was maintained for the following reasons:

- (a) The applicant did not demonstrate that the sign applied for was capable of being graphically represented by reference to the representation of the mark filed.
- (b) It was unclear from the description filed what was the exact meaning of “circular compressed tablet” and the term “raised heart outline” did not define the mark clearly. It was not possible to be certain about the positioning, size of the heart outline or the circumference of the circular compressed tablet.
- (c) A sign would be considered graphically represented only when the graphical representation can stand in place of the sign used and represents only that sign. In this case, it is not possible as the description could represent a significant number of other signs.
- (d) It was impossible for anyone inspecting the register or reading the journal to understand from the description what exactly the trade mark consisted of.

The Section 3(1)(b) objection was also maintained as it was found that the sign was likely to be regarded by the public as mere decoration since the outline of a heart was a commonly used device for the products in question.

At the hearing, the applicants offered to amend the description by adding a limitation via Section 13 of the UK Trade Marks Act 1994. The limitation reads as:
“The mark is limited to goods which are 19mm in diameter and 4.76mm in length.”

This was rejected as it did not serve to overcome the Section 3 objections and the request did not fall within the provisions of Section 13 nor Section 39(2) of the UK Act. It was decided that Section 13 could be used to limit the representation of the mark in a manner that amounted to an amendment of the representation of the mark itself.

A further appeal was made on 29 January 1999, but the appeal also failed. On appeal, it was affirmed that a mere description of the mark would be inadequate. To satisfy

the requirement of graphical representation, it is essential that the description must stand on its own to identify the trade mark. While it is possible that a mere description of a mark may be enough to meet the requirements of being “graphically represented”, it is unlikely to be good enough unless the description is sufficiently precise.

(b) Pictorial, figurative or word marks incorporating colour

Where the trade mark consists of colours in combination with other elements whether they be pictorial, figurative or word elements, a coloured image of the trade mark will be required to be lodged with the application. Colour identification codes will **not** be required for these types of marks.

(c) Colour(s) as a trade mark

Where the trade mark consists solely of colour(s), a sample of the colour(s), in the form of a graphical representation, is required to be lodged with the application. In addition, the Registrar recommends that the applicant includes on the application form, a designation from an internationally recognised identification code where the colour or shade exists in the coding system. However, the failure to indicate such a designation on the application form will not result in the application being denied a filing date.

There are a number of colour code identification systems in existence e.g. Pantone®, RAL and Focoltone®. It is not an exhaustive list and it is the choice of the applicant to decide which system to use.

An appropriate description should also be included in the application form to indicate whether the mark consists of the colour(s) applied to the goods or their packaging or to other commercial item. Where colour is applied to the whole (or substantially the whole) surface of the object in question, a statement in words to this effect will suffice. In other cases a picture or diagram may be necessary to identify the area(s) of the item to which the colour(s) is/are applied. Example:

“The trade mark consists of the colour green (RAL ___), applied to the cap of a container as shown in the representation on the application form.”

Note: A claim for colour as “an essential element” is unacceptable terminology as it neither restricts the trade mark to colour, nor gives any useful information as to the use of the colour within the trade mark.

In *Heidelberger Bauchemie GmbH (Case C-49/02)* the ECJ held that a graphic representation consisting of 2 or more colours, designated in the abstract and without contours, must be **systematically arranged by associating the colours concerned in a predetermined and uniform way**. The mere juxtaposition of 2 or more colours, without shape or contours, or a reference to 2 or more colours “in every conceivable

form”, as was the case here, lacks precision and uniformity. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

Consequently, it is important for the applicant to be precise about his claims for protection. If the distinctive character of the mark used by the applicant depends in part on other factors, such as a specific arrangement of colours or the manner of application of colour(s) to goods and he did not make that clear in his application form, it will not be possible for him to amend his application later on to include such claims since such an amendment would affect substantially the identity of the mark sought to be registered.

(d) Sound marks

The ECJ ruled in *Shield Mark BV v Joost Kist h.o.d.n. Memex (Case C-283/01)* that the following would not be sufficient graphical representation of a sound mark:

- (i) a description using written language showing an indication that the sign consists of notes going up to make up a musical work;
- (ii) an indication that the mark consists of the cry of an animal;
- (iii) an indication by means of simple onomatopoeia without more;
- (iv) an indication by means of a sequence of musical notes without more.
- (v) merely stating the name of a specific piece of music is not acceptable as it requires prior knowledge of what the sound is.

A sound mark is considered to be graphically represented when it consists of a representation by a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.

If a particular musical instrument is used to produce the sound forms part of the mark, this should be stated.

The description and the representation of the trade mark should together clearly define all the details which constitute the trade mark.

Example

The trade mark consists of the spoken letters AT&T in the rhythm of an eighth note triplet (AT&T) and one quarter note (for the final T) superimposed over musical sounds in the key of B flat major, namely, the melody notes F, B flat, G and C in the same rhythm as expressed above, along two accompanying chords, one of the four notes F, B flat, C and F and the other of two notes F and F. Both notes are of half note value. In musical notation, the mark is as shown in the representation attached to the application form.

(e) Scent marks

Scent is one of the more unusual kinds of signs and is difficult to represent graphically. It is only registrable if it is possible for the public to identify the goods and services of a proprietor through the scent.

In *Ralf Sieckmann* an application was made in classes 35, 41 and 42 with the following description in the application form:

“Trade mark protection is sought for the olfactory mark deposited with the Deutsches Patent- und Markenamt of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula is set out below. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt.



The applicant also lodged an odour sample of the sign in a container and described the scent as “balsamically fruity with a slight hint of cinnamon”.

The ECJ held that the requirements of graphic representability of a “scent mark” are not satisfied by a chemical formula, a description of the scent in words, the deposit of an odour sample or by a combination of these elements. The reasons are as follows:

- a) Few people would recognise a chemical formula as representing the actual odour. In addition, a chemical formula does not represent the odour of a substance, but the substance itself. Therefore the chemical formula cannot be regarded as a graphic representation.
- b) As for a description of an odour in words, although it is graphic, it is not sufficiently clear, precise and objective.
- c) As for the deposit of an odour sample, it does not constitute a graphic representation as an odour sample is not sufficiently stable or durable.

NOTE: It appears that at present stage of technology, there has not been found an acceptable graphical representation for “scent marks”.

(f) Moving marks

Moving marks can be represented by a sequence of still pictures in the correct sequence that corresponds to the mark in use and a written description describing the nature of the mark represented by the still pictures. The description should include the following information:

- That the mark is a moving image
- What the images depict i.e. what the change in appearance is

- How many images are involved
- What is the sequential order of the images
- That there is a single sequence of the movement (and not a variable sequence)

Example

UK Trade Mark No. 2235348 owned by British Telecom which shows in a combination of pictures and words, the moving image of a revolving globe. The application consists of 286 images representing the globe as it revolves. Their description reads as:

“The trade mark is an animated sequence consisting of a rotating globe device, in which the continents are depicted in the colours red, pink, purple, blue, green, yellow and orange, which is produced by sequentially displaying the attached images in the order given, starting from the top left corner moving across the row to the far right, returning to the second left row and moving across again to the far right, continuing in this order from left to right, ending with the bottom right corner, whereupon the sequence will recommence.”

(g) Holograms

Each of the various views of the hologram must be depicted in the representation so that all the material features of the mark are apparent.

For simple holograms where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

NOTE: The Registry has received two applications for hologram marks through the Madrid Protocol. They are:

- (i) T01/08194G - T01/08196C in Classes 03, 24 and 25



NITYA

The description originally reads as “Mark consisting of a hologram.”

This mark has been registered as the applicant confirmed that the hologram consists of a simple image whereby the features do not change according to the angle in which it is viewed. The description of the mark was allowed to be amended to read as:

“The mark consists of a simple hologram as shown in the representation attached to the application form.”

(ii) T03/18748C in Class 10



The description of the mark reads as “The trademark comprises a hologram.”

The applicant has clarified that the mark is a hologram because:

Seen from top to bottom:

Colour changes: the writing of the trade mark logo turns blue except for the dash and the underline (the word “balance” written in green turns blue, the red dash stays red, the yellow line under “Head” stays yellow).

Seen from bottom to top:

Colour changes: the writing of the trade mark logo turns green. “Head” written in blue turns green, red dash stays red, the yellow line under “Head” stays yellow.

However, due to administrative issues, the application has been abandoned.

5 FAILURE TO COMPLY WITH THE REQUIREMENTS FOR GRAPHIC REPRESENTATION

Singapore’s current practice

As long as the application contains a clear (i.e. good quality) representation of the trade mark, a filing date will be granted to the application. No deficiency notice will be sent out even if the representation fails to satisfy the requirements for graphic representation. Such an objection will only be raised during the examination stage. However it will not be possible to amend the mark after filing unless the amendment is justified under Section 14. Where the amendment cannot be justified under Section 14 as an obvious mistake for example, the applicant would have forgone his filing fees.

Singapore’s new practice

If the application does not contain a graphical representation of the mark sought for registration, the Registrar will object to it under Section 5(2)(c) of the Act. No filing date will be granted. The Registrar will then write to the applicant or his representative raising the deficiency and allow two months for things to be put right.

If the deficiency is corrected, the filing date will be the date on which a representation of the mark or marks is presented to the Registrar.

If inadequate representations are deleted from a series of marks, which included marks which were graphically represented, the original filing date will be allocated.

If the deficiency is not corrected/required information is not provided within the two month period, the application will be treated as never having been made. The two month period cannot be extended.

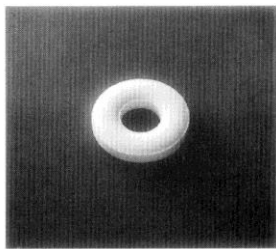
On the question whether the application meets the requirement that the sign is capable of being graphically represented, this assessment will be done at the examination stage. Where the graphical representation does not meet the criteria required for a sign to be deemed as capable of being graphically represented, objections will be raised and applicants will be given a time line to respond to the deficiencies raised.

Amendment of graphic representation after filing

Once a filing date has been given, the mark can only be amended if the applicant can satisfy Section 14 i.e. only if the amendment is to correct an obvious mistake and does not substantially affect the identity or material features of the original mark.

This means that when the mark (which is graphically represented) is not distinctive prima facie, no amendment can be made to the mark to limit the mark for example to colours unless he can satisfy Section 14. One cannot disguise the amendment under Section 30 (via limitation of the goods, size of mark or colour of the mark) or via restriction of the specification when in truth it is an amendment of the mark (see *Société des Produits Nestlé SA v Mars UK Ltd [2004] EWCA Civ 1008*).

In *Société des Produits Nestlé SA v Mars UK Ltd*, it was held that the UK equivalent of Section 30 deals with limitations to “the rights conferred by the registration”. The hearing officer’s requirements of colour and size did not limit “the rights conferred by the registration” of the mark identified in the application. The limitations apply to the description of the mark itself. Limitations applying to the description of the mark should appear as part of the graphic representation. The mark in this case found to be lacking in distinctiveness was:



The amendments that were not allowed

A limitation under UK’s equivalent of Section 30:

“The rights are limited so as to exclude use other than in connection with white sugar confectionery having an external diameter of approximately 2 cm.”

Amendment under UK’s equivalent of Section 14(1) to restrict the specification to:

“White, mint flavoured, compressed confectionery of the shape shown in the form of application and having an external diameter of approximately 0.8 cm and a minimum thickness of approximately 0.4 cm.”

Example of how the mark should be re-filed:

Description of mark: “White, mint flavoured, compressed confectionery of the shape shown in the form of application and having an external diameter of approximately 0.8 cm and a minimum thickness of approximately 0.4 cm.”

6 “CAPABLE OF DISTINGUISHING THE GOODS OR SERVICES...”

This requirement in Section 2(1) entails that the trade mark must be capable to the limited extent of being not incapable of distinguishing goods or services (*AD2000 [1997] R.P.C. 168*).

In other words, before a sign can be elevated to the status of “trade mark” and be registered as such, it must possess a distinctive character.

Jacob J in *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, at p. 305 said:

“Capable of distinguishing means whether the mark can in fact do the job of distinguishing. So the phrase in section 1(1) (Singapore’s Section 2(1)) adds nothing to section 3(1) (SG’s Section 7(1)) at least in relation to any sign within section 3(1)(b)-(d) (SG’s Section 7(1)(b)-(d)). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the Applicants will be unable to prove the mark has become a trade mark in practice - “Soap” for “soap” is an example. The bar (no pun intended) will be factual not legal.”

In considering whether a sign is “capable of distinguishing”, it is permissible to take into account the use which has been made of the sign in so far as the prior use affects the meaning of the sign, even though it is not permissible to apply the proviso to Section 7(2) to Section 7(1)(a). In other words, use can affect meaning but any distinctive character acquired by use must be ignored.

The test to be applied has a very low threshold. The question could be expressed as - is this a sign which, hypothetically at least, could perform the function of identifying all

goods marked with it as coming from the control of the same undertaking? If the answer to this question is yes, the “sign” is a trade mark.

The ECJ in *Philips v Remington (Case C-299/99)* ruled that there is no special category of marks which, even though distinctive in fact are nonetheless incapable of distinguishing as a matter of law. This decision would mean that if a non-distinctive sign is nevertheless proven to have acquired a distinctive character, then that sign must be capable of distinguishing the goods/services of one person from another.

Accordingly, it is unlikely that the Registrar will raise an objection that the mark is not capable of distinguishing goods/services. If acquired distinctiveness can be established then there must be an underlying capacity to distinguish. If acquired distinctiveness cannot be established, it is immaterial whether the mark is objected to under Section 7(1)(a) or some other limb of Section 7(1).