

## **CERTIFICATION MARKS**

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**CERTIFICATION MARKS**

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## **1. INTRODUCTION**

This chapter deals with certification marks – what they are, how they differ from “ordinary” trade marks and how they would be examined and processed at the Registry.

## **2. RELEVANT LEGISLATION**

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

#### **Certification marks**

**61.**—(1) A certification mark is a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified.

(2) The provision of this Act shall apply to certification marks subject to the provisions of the Second Schedule.

#### **Second Schedule**

##### **General**

1.—(1) The provisions of this Act shall apply to certification marks subject to the provisions of this Schedule.

(2) For the purposes of this Schedule, “published” means made available to the public (whether in Singapore or elsewhere), and a document shall be taken to be published if it can be inspected as of right at any place in Singapore by members of the public, whether on payment of a fee or not.

##### **Signs of which a certification mark may consist**

2. In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1) (b) from those which are not so certified.

##### **Indication of geographical origin**

3.—(1) Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

### **Nature of proprietor's business**

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

### **Mark not to be misleading as to character or significance**

5.—(1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

### **Regulations governing use of certification mark**

6.—(1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

(3) Further requirements with which the regulations have to comply may be imposed by rules made under this Act.

### **Approval of regulations, etc.**

7.—(1) A certification mark shall not be registered unless —

- (a) the regulations governing the use of the mark —
  - (i) comply with paragraph 6(2) and any further requirements imposed by rules; and
  - (ii) are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the Registrar and pay the prescribed fee.

(3) If the applicant does not comply with sub-paragraph (2), the application shall be treated as withdrawn.

8.—(1) The Registrar shall consider whether the requirements mentioned in paragraph 7(1) are met.

(2) If it appears to the Registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(3) If the applicant responds within the specified period but fails to satisfy the Registrar that those requirements are met, or to file regulations that have been amended so as to meet those requirements, the Registrar may refuse the application.

(3A) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 13.

9. The regulations shall be published and notice of opposition may be given relating to the matters mentioned in paragraph 7(1), in addition to any other grounds on which the application may be opposed.

#### **Regulations to be open to inspection**

10. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

#### **Amendment of regulations**

11.—(1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may, in any case where it appears to him expedient to do so, cause them to be published.

(3) If the Registrar causes the regulations to be published, notice of opposition may be given relating to the matters mentioned in paragraph 7(1).

#### **Consent to assignment of registered certification mark**

12. The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

#### **Infringement: rights of authorised users**

13. The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark —

- (a) section 27(5);
- (b) section 82.

14. In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account; and

the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

### **Grounds for revocation of registration**

15. Apart from the grounds of revocation provided for in section 22, the registration of a certification mark may be revoked on the ground —
- (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4;
  - (b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1);
  - (c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark;
  - (d) that an amendment of the regulations has been made so that the regulations —
    - (i) no longer comply with paragraph 6(2) and any further conditions imposed by rules; or
    - (ii) are contrary to public policy or morality; or
  - (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

### **Grounds for invalidity of registration**

16. Apart from the grounds of invalidity provided for in section 23, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1).

## **Trade Marks Rules**

### **Application of Rules to collective marks and certification marks**

**62.**—(1) Except as provided in this Part, the provisions of these Rules shall apply in relation to collective marks and certification marks as they apply in relation to ordinary trade marks.

(2) In case of doubt in applying the provisions of these Rules, any party may apply to the Registrar for directions.

(3) The address of the applicant for the registration of a collective mark or certification mark shall be deemed to be the trade or business address of the applicant for the purposes of rule 9(4)(o).

### **Filing of regulations**

**63.** Within 9 months after the date of the application for the registration of a collective mark or certification mark, the applicant must file with the Registrar —

- (a) Form TM 10; and
- (b) a copy of the regulations governing the use of the mark.

### **Filing of amended regulations**

**64.**—(1) The filing of amended regulations pursuant to paragraph 7(2) of the First Schedule to the Act in relation to a collective mark or paragraph 8(2) of the Second Schedule to the Act in relation to a certification mark shall be made in Form TM 10.

(2) Form TM 10 shall be accompanied by a copy of the amended regulations with the amendments shown in red.

### **Opposition to registration**

**65.**—(1) Any person may, within 2 months after the date of the publication of an application for registration of a collective mark or certification mark, give written notice to the Registrar in Form TM 11 opposing the registration; and rules 29 to 40 shall apply, with the necessary modifications, to the proceedings thereon.

...

(3) In case of doubt, any party may apply to the Registrar for directions.

### **Amendment of regulations**

**66.**—(1) An application for the amendment of the regulations governing the use of a registered collective mark or certification mark shall be filed with the Registrar in Form TM 10.

(2) The application shall be accompanied by a copy of the amended regulations with the amendments shown in red.

(3) Where it appears expedient to the Registrar that the amended regulations should be made available to the public, the Registrar may publish a notice indicating where copies of the amended regulations may be inspected.

### **Opposition to amendment of regulations**

**66A.**—(1) Any person may, within 2 months after the date of the publication of the notice referred to in rule 66(3), file with the Registrar —

- (a) a notice of opposition to the amendment to the regulations in Form TM 11; and
- (b) a statement indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of the First Schedule to the Act, or paragraph 7(1) of the Second Schedule to the Act, as the case may be.

(2) The person filing the notice and statement under paragraph (1) shall, at the same time, serve copies of the notice and statement on the proprietor.

(3) Rules 29(3) to (7) and 31 to 40 shall, with the necessary modifications, apply to the proceedings thereon as they apply to an opposition to an application for registration of a trade mark.

(4) For the purposes of the application of the rules referred to in paragraph (3) —

- (a) references in those rules to the applicant shall be treated as references to the applicant for the amendment of the regulations;
- (b) references in those rules to the application shall be treated as references to the application for the amendment of the regulations;
- (c) references in those rules to the date of the publication of the application for registration shall be treated as references to the date of the publication of the notice referred to in rule 66(3);
- (d) references in those rules to the notice of opposition shall be treated as references to the notice and statement referred to in paragraph (1); and
- (e) references in those rules to the opponent shall be treated as references to the person who filed the notice and statement referred to in paragraph (1).

**3. DISTINCTION BETWEEN CERTIFICATION MARKS AND “ORDINARY” TRADE MARKS**

Section 61 of the Act defines a certification mark as “a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to the origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified”.

The main feature of a certification mark is that it serves as a badge of quality used not by the proprietor of the mark, but by his authorised users as a guarantee to the relevant public that goods or services possess a particular characteristic. Usually, the proprietor of the mark will authorise the use of the mark to anyone who can demonstrate that the goods or services possess that characteristic.

Certification marks distinguish the goods or services of a class of traders who are certified from those who are not certified. In contrast, “ordinary” trade marks function as a badge of origin which distinguishes the goods or services of one trader from those of other traders.

Certification Mark	"Ordinary" Trade Mark
<ul style="list-style-type: none"> <li>Serves as a badge of quality used not by the proprietor of the mark, but by his authorised users, as a guarantee to the relevant public that the goods or services possess a particular characteristic</li> </ul>	<ul style="list-style-type: none"> <li>Serves as a badge of origin which distinguishes the goods or services of one trader (i.e. a single trade source or entity) from those of other traders</li> </ul>

## 4. EXAMINATION OF CERTIFICATION MARKS

### 4.1 Distinctiveness

Certification marks must be examined for distinctiveness just like in the case of “ordinary” trade marks. When considering the distinctiveness of a certification mark it is important to appreciate that the distinguishing function of certification marks differs from that of “ordinary” trade marks.

Paragraph 2 of the Second Schedule of the Act provides:

*In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1)(b) from those which are not so certified.*

Due to the differences in the distinguishing function, marks which may not be acceptable as “ordinary” trade marks (as it cannot point towards a single trade source), may sometimes be acceptable as certification marks if it is able to distinguish goods which are certified from those which are not so certified.

For example, a composite mark consisting of the words “100% Organic” combined with designs would not be acceptable as an “ordinary” trade mark as it is unlikely that the average consumer would regard it as identifying a single trader but may be acceptable as a certification mark if it is capable of identifying goods which are certified from those which are not.

#### **Not acceptable:**

### **100% ORGANIC**

#### *Example 4.1.1*

The above mark will face an objection under the following sections:

- Section 7(1)(b) - as it is incapable of distinguishing, in the eyes of the average relevant consumer, the goods certified by the applicant organisation from the goods not so certified.
- Section 7(1)(c) – as descriptive indications should be kept free for all traders to use.
- Section 7(1)(d) – as monopolies over signs that are already customary in the trade should not be given.

### 4.2 Geographical names

Geographical names (and other such signs or indications) are usually not registrable as “ordinary” trade marks and would be objected to under section 7(1)(c) of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration.

(Reference should be made to the Trade Marks Work Manual's section on "Geographical Names" for general guidelines on when a geographical name is registrable as a trade mark.)

However, paragraph 3(1) of the Second Schedule of the Act provides:

*Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.*

This means that the Registrar has a discretion (note that this is not an automatic right of acceptance) to accept geographical names as certification marks. In general, the Registrar will accept geographical names only if they are capable of distinguishing goods and services which are certified from those which are not. In exercising this discretion, the Registrar will look at existing practices in the market and consider whether due to custom and practice, the geographical name is capable of distinguishing the goods or services certified from those which are not.

It should be noted that paragraph 3(2) of the Second Schedule provides that if a geographical name is accepted for registration, the proprietor of such a mark is not entitled to prohibit the use of the name in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use the geographical name.

#### **4.3 Geographical indications (GIs)**

An application to register an "ordinary" trade mark which consists solely of a GI would face insurmountable objections as GIs should not be monopolised by any single trader. Furthermore, the function of a GI is to guarantee geographical origin and not trade origin. However, GIs are registrable as certification marks since it sends the message to the consumer that the goods are certified as being the produce of the particular location.

#### **4.4 Evidence of acquired distinctiveness**

Section 7(2) of the Act provides that a trade mark shall not be refused registration by virtue of section 7(1)(b), (c) or (d) of the Act, if, before the application date for registration, it has in fact acquired a distinctive character as a result of the use made of it.

This provision applies to applications for certification marks as well.

In proving acquired distinctiveness, the applicant needs to show that the mark has become capable of certifying a characteristic of goods or services, by the date of application. It is not essential that the mark should have been used that way prior to the relevant date.

In other words, the test is whether consumers have been educated as to the distinguishing function of the mark and not whether consumers have been educated who is certifying the goods/services or that goods/services have in fact been certified.

(Reference should be made to the Trade Marks Work Manual's section on "Evidence of Distinctiveness Acquired Through Use" for general guidelines on the determination of acquired distinctive character through prior use made of the mark.)

#### **4.5 Other absolute grounds of refusal**

The other absolute grounds of refusal applicable to certification marks, include the following:

- That the certification mark consists exclusively of certain shapes (thus objectionable under section 7(3) of the Act);
- That the certification mark is contrary to public policy or morality (thus objectionable under section 7(4)(a) of the Act);
- That the certification mark which is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service) (thus objectionable under section 7(4)(b) of the Act);
- That the use of the certification mark is prohibited in Singapore (thus objectionable under section 7(5) of the Act);
- That the certification mark was applied for in bad faith (thus objectionable under section 7(6) of the Act); and
- That the certification mark in question consists of or contains an emblem protected under section 56 and section 57 of the Act (thus objectionable under section 7(11) of the Act).

#### **4.6 Existence of prior conflicting mark(s)**

The process of examination of certification marks also involves a search of the register to ascertain if there are any earlier marks (certification, collective or “ordinary” trade marks) which conflict with the subject application.

##### *4.6.1 Where there is an earlier identical collective or “ordinary” trade mark for same goods or services*

In the event that the search reveals the existence of an earlier identical collective or “ordinary” trade mark for the same goods or services, this would be taken as prima facie evidence that the subject certification mark cannot serve the function of distinguishing goods/services which are certified from those which are not (thus objectionable under section 7(1)(b) of the Act), and is liable to mislead the public as regards the character or significance of the mark (thus objectionable under paragraph 5 of the Second Schedule of the Act).

These objections cannot be overcome with consent from the proprietor of the earlier conflicting mark. The fact that the proprietor of the earlier conflicting mark is the owner of the subject certification mark is also irrelevant.

If the prior conflicting mark and the subject certification mark belong to the same proprietor, it is possible to convert the mark type of the subject mark or to voluntarily cancel the prior conflicting mark in order to overcome the objection.

Further, the existence of the prior conflicting mark may also give rise to an objection under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual’s section on “Relative Grounds for Refusal of Registration” for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

4.6.2 Where there is an earlier identical or similar certification mark for identical or similar goods or services in the name of a different owner

In the event that the search reveals the existence of an earlier identical or similar certification mark for the identical or similar goods or services, the subject certification mark may be objectionable under section 8(1) or section 8(2) of the Act, depending on the facts of the case and the likelihood of confusion or deception resulting from the use of the mark under consideration.

4.6.3 Where there is an earlier identical “ordinary” trade mark for the same goods or services in the name of the same owner

The registration of a certification mark is prohibited if the owner trades in the goods or services to be certified. The owner of a certification mark is responsible for setting and regulating the standards which the goods or services bear the mark must meet. Therefore the applicant must be independent of the supply of those goods and services to do this effectively and consistently.

Where this occurs, the objection is taken under paragraph 4 of the Second Schedule of the Act. A detailed explanation of this ground of objection is set out at paragraph 6 below.

4.6.4 Where there is an earlier similar collective or “ordinary” trade mark and the goods or services are only similar in the name of a different owner

Where there is an earlier similar collective or “ordinary” trade mark and the goods/services are only similar, acceptance of the mark for registration may be possible.

The key factors for consideration by the examiner are the degree of similarity between the respective marks and the goods or services covered by the respective marks.

The Examiner must be satisfied that there is no real likelihood of confusion or deception resulting from the use of the mark under consideration.

(Reference should be made to the Trade Marks Work Manual’s section on “Relative Grounds for Refusal of Registration” for more details on the assessment of similarity of marks, similarity of goods and services and the likelihood of confusion.)

**4.7 Correcting the nature of the mark**

Applicants may change the nature of the trade mark application, for example from an “ordinary” trade mark to a certification mark or vice versa. This is not considered a correction that materially alters the meaning or scope of the application and will therefore be allowed.

## 5. **MARK NOT TO BE MISLEADING AS TO CHARACTER OR SIGNIFICANCE**

A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if the mark applied for is likely to be taken as something other than a certification mark (paragraph 5(1) of the Second Schedule of the Act).

This means that an objection will be raised if the mark is likely to be taken as something other than the true designation of the mark, i.e. that it is more likely to be taken as an “ordinary” trade mark as opposed to a certification mark. For example, there is little in the mark “Global Training Consultancy” to indicate to the general public that it is a certification mark.

To overcome this objection the Registrar may require that the mark include some indication that it is a certification mark (paragraph 5(2) of the Second Schedule of the Act). This may be made in one of the following ways:

- Include the following statement in the regulations:  
*“It is a condition that the mark shall not be used in Singapore in any manner including use in advertisement or any form of publicity in Singapore without indicating that it is a certification mark.”*
- Amend the representation of the mark to include the words "certification mark" within the representation of the mark. This form of amendment is permissible notwithstanding section 14(3) of the Act.

**6. APPLICANT NOT TO BE INVOLVED IN THE SUPPLY OF GOODS OR SERVICES OF THE KIND CERTIFIED**

A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified (paragraph 4 of the Second Schedule of the Act). In other words, the applicant must not be supplying goods or services identical to those for which he is certifying.

The owner of a certification mark is responsible for setting and regulating the standards which the goods or services bear the mark must meet. Therefore the applicant must be independent of the supply of those goods and services to do this effectively and consistently.

The Examiner must therefore run a proprietor search and if it reveals that the applicant has “ordinary” trade marks for identical goods or services (regardless whether the marks are the same, similar or different), raise an objection under paragraph 4 of the Second Schedule of the Act. The fact that the applicant owns “ordinary” trade marks is *prima facie* evidence that the applicant is trading in those goods and services.

This objection can be overcome if the applicant withdraws or surrenders the “ordinary” trade mark, produces evidence to show that he does not trade in the goods or services (such as company incorporation documents, or company profile brochures), or confirms in writing that he does not carry on a business in the goods or services certified.

It should be noted however that grounds for revocation and invalidation exist (upon application from a third party) should this prove to be false or to become false by the applicant beginning to trade in the goods or services.

**7. SPECIFICATION OF GOODS AND/OR SERVICES FOR CERTIFICATION MARKS**

As with “ordinary” trade marks, certification marks must be filed in respect of specific goods and/or services in the appropriate classes under the International Classification of Goods and Services (ICGS).

The specification for certification marks should denote the goods and services being certified i.e. the goods and services of the authorised users (as opposed to the goods and services of the applicant). This is because when in use, the certification mark would appear on the goods and services of persons who have been certified by the proprietor.

Applicants are reminded that failure to use a certification mark in the appropriate manner may render it vulnerable to revocation for non-use.

## **8. COMPETENCE OF THE APPLICANT**

The applicant of a certification mark must show that it has the competency to certify and operate the certification scheme (paragraph 7(1)(b) of the Second Schedule of the Act). This requirement is usually satisfied if the applicant is an established trade body or a government department.

Otherwise, the applicant will be asked to provide information to clarify why they are competent to certify. There is no set manner of providing this information and an explanation of the applicant's history in the particular field will often suffice.

Unlike collective marks, there is no restriction on who can be a proprietor of a certification mark. In practice, certification marks are normally applied for by trade associations or other similar bodies who have an interest in monitoring and maintaining standards in their particular field.

The applicant of a certification mark must have legal capacity to hold property in its own name. If it is apparent from the applicant's name or from the content of the regulations that the applicant has no legal personality, then the examiner may raise an objection on this ground.

## **9. EXAMINATION OF THE REGULATIONS**

### **9.1. Requirement of regulations**

An applicant seeking registration of a certification mark must file a copy of the regulations governing the use of the certification mark with the Registry within 9 months after the date of the application (rule 63 of the Trade Marks Rules), failing which, the application shall be treated as withdrawn (paragraph 7(3) of the Second Schedule of the Act).

The applicant may apply for an extension of time if more time beyond 9 months after the date of application is required to compile the regulations. As with any extension of time applied for under the Act, the application for extension of time is made by way of filing Form CM5 together with the requisite fee (if any), and the request should be accompanied by adequate reasons explaining why the extension of time is required (if applicable).

For ease of reference and clarity, the regulations should be incorporated in a single document providing the required information (see below). An applicant may attach supplementary documents by way of annexure to the regulations and cross reference to them in the regulations but such documents cannot themselves constitute the regulations.

### **9.2. Content of regulations**

Paragraph 6(2) of the Second Schedule to the Act prescribes the content required in the regulations, namely:

- Who is authorised to use the mark;
- The characteristics to be certified by the mark;
- How the certifying body is to test those characteristics and to supervise the use of the mark;
- The fees (if any) to be paid in connection with the operation of the mark; and
- The procedures for resolving disputes.

Annex A contains more details on what the regulations must minimally contain.

It is to be noted here that in examining the regulations, the Registrar has a role in ensuring that the regulations are not contrary to public policy or morality (paragraph 7(1)(a)(ii) of the Second Schedule to the Act).

### **9.3. Amendment of regulations**

If the regulations filed by the applicant do not meet the statutory requirements, the Examiner will inform the applicant and give the applicant an opportunity to make representations or file amended regulations, within a specified period.

If the applicant responds within the specified period but fails to satisfy the Examiner that those requirements are met, or file the regulations that have been amended so as to meet those requirements, the Examiner may refuse the application (paragraphs 8(2) and 8(3) of the Second Schedule to the Act).

If the applicant fails to respond within the specified period, the application shall be treated as withdrawn (paragraph 8(3A) of the Second Schedule to the Act).

The filing of the amended regulations shall be made on Form TM10 with the requisite fee.

## **10. PUBLICATION OF CERTIFICATION MARKS**

Once the examination process is complete, and the Examiner is satisfied that the application of the certification mark and the regulations meet the relevant criteria for registration, the Examiner will accept the mark and the regulations for publication.

Before accepting the mark, the Examiner should also ensure that the approved regulations (without unnecessary documents such as covering letters) are correctly attached, so that the regulations are correspondingly uploaded to the register when the mark is published.

Once published, the regulations governing the use of the certification mark can be viewed online and are open to public inspection in the same way that "ordinary" trade marks are open to public inspection. The regulations are open to opposition on the matters listed in paragraph 7(1) of the Second Schedule to the Act.

After this point, any amendment of the regulations governing the use of the certification mark is not effective until and unless the amended regulations are filed with the Registrar and approved by the Registrar.

## **11. AMENDMENT OF REGULATIONS**

Once a certification mark has been accepted and published for opposition purposes, any amendment of the regulations governing the use of a registered certification mark (including any schedules attached to it) is not effective unless and until the amended regulations are filed with the Registrar and accepted by him. This means that the Registrar has to examine the amended regulations in the same way as newly filed regulations.

Where the Registrar considers it appropriate, the amended regulations will be published for opposition purposes. In fact, this will be the case in most if not all cases, save where the amendment is insignificant or minor.

If no oppositions are received, the regulations will become effective.

## **12. ASSIGNMENT OF CERTIFICATION MARKS**

The assignment of a certification mark is not effective without the consent of the Registrar (paragraph 12 of the Second Schedule of the Act). This is to ensure that the new proprietor has the necessary competence to certify and administer the certification scheme (as outlined in paragraph 8 above) and is not involved in the supply of the goods and services certified (as outlined in paragraph 6 above).

Usually, the change in ownership of the certification mark would necessitate the amendment of the regulations to reflect the new name of the owner. If so, the request should be made in the manner as detailed in paragraph 11 and should be filed at the same time as the request for consent to the assignment.

## **ANNEX A - GUIDELINES FOR STRUCTURE & CONTENT OF REGULATIONS GOVERNING CERTIFICATION MARKS**

**Note: This guide is intended to assist applicants in preparing regulations to accompany applications for registration of certification marks.**

### General guidelines

1. The regulations may be titled “Regulations Governing the Use of Certification Mark [Trade Mark No.]”.
2. Regulations should be incorporated in a standalone document so that it can be easily read and understood.
3. Annexures, if any, should be properly labelled and cross-referenced.
4. The Licensing Agreement is not the regulations governing the use of the certification mark.

The regulations should minimally deal with the following, and may be structured in the following manner:

#### **(1) Persons authorised to use the mark**

The regulations must indicate the persons who are authorised to use the mark. This does not mean to say that the applicant needs to identify the exact persons who at any given time are authorised users. It is sufficient for the applicant to state objectively the category of persons who would be eligible if they demonstrate the characteristics being certified.

The regulations should state clearly whether:

- The certification mark is available to use by any person whose goods or services demonstrate the relevant characteristics being certified; or
- The certification mark is only available to certain categories of persons, for example, only persons possessing particular qualifications, due to the nature of goods/service being certified, may be authorised to use the mark.

This is to ensure that there is no discrimination in authorising the use of the mark and provide absolute certainty for potential users to assess whether they qualify to apply to be certified.

#### **Example:**

The certification mark is available for use by any individual and/or any organization who complies with the regulations and who provide the goods having the certified quality or characteristics as specified in the regulations herein.

#### **(2) Characteristics to be certified by the mark**

The regulations must indicate the characteristics to be certified by the mark.

The regulations should not simply list the goods and services being certified, they should explain the specific characteristic present in the goods and services being certified. These characteristics of the underlying goods and/or services must be set out in a clear, objective and detailed fashion.

This is for transparency to allow anyone reading the regulations to know precisely what characteristic is being certified.

**Example:**

A certification mark is used to distinguish foods, in particular confectionary (candies), and over-the counter pharmaceuticals (throat and cough lozenges, syrups) which—by virtue of the absence of fermentable sugars and excessive amounts of acids—are "tooth-friendly", i.e. do not harm the teeth.

**(3) Test and supervision of the certification mark**

The regulations must indicate how the applicant intends to test the presence of the characteristics to be certified by the mark and to supervise use of the mark.

The regulations must state the methodology and/or process for testing. In the event that the testing is not done by the applicant of the mark, the details of the entity responsible for testing must be stated.

In addition, the regulations must explain how the certifying body will subsequently supervise the use of the mark by authorised users.

Examples of methods of supervision include, but are not limited to:

- Periodic site visits to premises of users of the certification marks by certifying body
- Provision of periodic reports and samples to the certifying body by users of the certification marks
- Issuance of compliance certificates to evince compliance with the certification regime by certifying body

The regulations should include the checks that are in place and specify any timeframes at which inspections will occur.

The Registrar needs to be satisfied that there is adequate control over the use of the mark.

**Example:**

The [Applicant/any authorised certification authority] will conduct routine site visits to the area in which the tea are produced.

Samples of the tea produced in that area will be subject to the following tests:

T1 Quality tests:

To be observed by eyes, by touching, by tasting; to determine the categories by its shape; to determine the colour, aroma and using new tea of the year as a standard.

T2 Sampling tests:

To be tested in accordance with XYZ01

T3 Water content test:

To be tested in accordance with XYZ02

T4 Residue test:

To be tested in accordance with XYZ03

The rules of the testing are as follows:

1. The products should be tested by batches. Quality of products in the same batch and the same category should be the same.
2. The products should be tested in accordance with the regulations and can only be sold after the requirements are met.
3. The tests are divided into "transfer tests" and "routine tests".

Routine tests should be carried out in any one of the following situations:

- (a) when the standard packaging is changed;
- (b) where there is significant change in the production method or origin of fresh tea leaves;
- (c) once every year under normal production circumstance;

In transfer tests, if the tea does not meet the requirements of the regulations, an additional sample may be taken from the same batch of product and put for tests again.

**(4) Fees to be paid for the use of the certification mark (if any)**

The regulations must indicate the fees (if any) to be paid in connection with the operation of the mark.

The structure and frequency of any fees stipulated must be fully described in the regulations.

The Registrar would not require the actual amount of fees to be laid down in the regulations if the regulations state that the fees can be found on the applicant's website.

If fees are not applicable, this should be stated in the regulations.

This is to ensure that the fees are transparent and not excessively high so as to prevent would be users from accessing the scheme.

**Example:**

Annual fees have to be paid by an authorised user to the [Applicant] of the mark in connection with the operation of the mark. The total amount of annual fees payable by each authorised user (an individual and/or an organization) is [-----] per year.

**(5) Dispute resolution procedures**

The regulations must indicate the procedure for resolving any disputes between the certifying body and an authorised user (or would be authorised user) of the mark.

Essentially under this item the Registrar is looking for the right of appeal to an independent person or body such as a specialist arbitrator or tribunal or the courts, for example, where the proprietor has refused to authorise use of the mark to a particular user.

The purpose of requiring the right to appeal to an independent tribunal is to ensure that decisions would be fair and impartial.

**Example:**

Where a dispute between the [Applicant] and an authorised user (or would be authorised user) regarding the [Applicant's] decision not to allow use of the mark arises, the dispute should be resolved via international arbitration centres, including but not limited to the Singapore International Arbitration Centre.

Any appeals from the decision of the arbitration authority will be subject to the jurisdiction of the courts in which the arbitration authority is located.