

## **GEOGRAPHICAL NAMES**

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## GEOGRAPHICAL NAMES

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## **1 INTRODUCTION**

This chapter deals with the grounds for registration of a mark which contains or consists of geographical name(s).

## 2 RELEVANT LEGISLATION

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

#### Absolute grounds for refusal of registration

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

...

(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; and

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(4) A trade mark shall not be registered if it is —

...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

#### First Schedule

##### Indication of geographical origin

3. —(1) Notwithstanding section 7(1)(c), a collective 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).

#### Second Schedule

##### 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).

### 3 TRADE MARKS CONSISTING EXCLUSIVELY OF SIGNS OR INDICATIONS DESIGNATING GEOGRAPHICAL ORIGIN OF THE GOODS OR RENDERING OF SERVICES

A mark consisting exclusively of designations of geographical origin must be refused registration under Section 7(1)(c). The purpose of this objection is so that signs that designate geographical origin remain open to use by all traders to indicate a connection with a particular geographical area. A mark designates a geographical origin if, the relevant class of persons (the persons in the trade and the average consumers), already associates the mark with the goods/services listed in the application, or where there is no current association, but the name is liable to be used in the future by undertakings as an indication of the geographical origin of the goods/services concerned (decision of the ECJ in *Windsurfing Chiemsee v Boots (Case C-108/97)*).

In making an assessment of whether the name is liable to be used as a designation of the geographical origin of the goods/services, the Registrar will consider the following matters:

- (a) Whether the geographical location has a reputation for the goods/services listed in the application;
- (b) If not, what are the characteristics of the geographical origin and whether the characteristics of the geographical location indicate that the place is, or in the future, is liable to become, a geographical source for the goods/services listed in the application; and
- (c) The extent to which the location is known to the relevant class of persons in Singapore – and what it is known for.

The Registrar will determine the above assessment on the balance of probabilities. The mark may be registered if the relevant class of persons (i.e. persons in the trade and potential consumers) will **not** reasonably assume that the goods/services originate from the place concerned. The test is not really whether it is impossible for the goods/services to originate from the place concerned nor whether objection should be raised “*simply because some place upon the earth’s surface had been called it*” (*Magnolia Metal Company [1897] 2 Ch 371*). As long as there is no likely connection (now or future) between a particular geographical name and the goods or services provided, the mark may have sufficient distinctive character and can be accepted prima facie.

If consumers may associate the goods/services with the geographical name, the mark will be objectionable under this ground even though the goods are not manufactured in that place.

Association could be to the place of manufacture, production or design of goods, or the place to which, or from which, services are provided or any other association that establishes the geographical location as the commercial origin of the goods/services.

**Examples**

- (a) SENTOSA would be unacceptable for Tee-shirts because the name characterizes the goods as mementoes from Sentosa (whether or not they are made or even designed there).
- (b) It is unlikely a mark is objectionable purely because it is the name of a particular place if that place can hardly be regarded as indicating the geographical origin of the goods. However, where the place concerned has a reputation for the retailing of particular goods, the name of a retail area may become associated with the goods in question, e.g. SIM LIM for computers or KATONG for Laksa.

In determining if a mark comprising exclusively of a sign that serves to designate the geographical origin should be excluded from registration or not, it is irrelevant if a defence under Section 28(1)(b)(i) will be applicable (see the ECJ's judgement in *Libertel Groep BV v Benelux-Merkenbureau (Case C-104/01)*).

#### **4 EXAMINATION PRACTICE IN RELATION TO SECTION 7(1)(c) OBJECTION**

##### **(a) Places with a reputation (or in an area with a reputation)**

Where the geographical location has a reputation (or is in an area with a reputation) for the goods/services listed in the application or closely related goods or services, the application will be refused.

##### **(b) Goods which are natural produce**

The names of places which, because of their characteristics, are likely to be the source of natural produce (such as fresh vegetables, fruits, eggs, milk, cream, water and minerals) are unlikely to be registrable. This is because the public will reasonably assume that the goods are from the geographical origin indicated in the trade mark, unless the place is so small (in terms of area as well as population) or obscure that the place is unlikely to mean anything to the relevant public. This is so even if the place identified by the mark has no specific reputation for the goods.

##### **(c) Local services**

A cautious approach will be taken to the registration of geographical names for neighbourhood services such as hairdressing and retail type services.

##### **(d) Places with no reputation and the application does not include natural produce or local services**

The registrability of the geographical places with no reputation and where the application does not include natural produce or local services will be assessed against the following criteria:

###### **(i) How well known the name is as a geographical location**

Well known geographical locations are less likely to be registrable compared to the names of obscure or remote places. However, names of well known places which are fanciful or exotic in relation to the type of goods or services listed in the application will not be refused simply because it is well known.

For example, MARRAKECH would be a fancy and exotic name in relation to motor cars but may be a plausible indication of the geographical source of other goods, such as carpets, and therefore not registrable for those goods.

###### **(ii) The goods and services with which the place is currently associated (if any)**

The Registrar will take into account the types of goods or services with which the place is already associated. For example, if the mark consists of the name of a town with a significant manufacturing industry, it will be reasonable to assume that the town is, or will become, a source of other manufactured products. Conversely, a rural location is less likely to be the source of a product which requires heavy industry, such as vehicles or their parts and fittings, and may therefore, not be objectionable in relation to such goods.

**(iii) Other characteristics of the place, including its size**

For most goods, the larger the location, the more likely it will appear as a source of goods. Consequently, there are likely to be difficulties in registering the names of well known towns and cities around the world as trade marks for many types of products.

**(e) Names of overseas locations**

The Registrar will apply the same criteria set out above in relation to the names of overseas places as well. However, the names of geographical locations outside Singapore are generally acceptable for services, unless the services are of the sort that are likely to be provided in Singapore from overseas, e.g. financial services, entertainment or travel and accommodation.

**(f) Oceans, seas, lakes, rivers, mountains, deserts**

The names of oceans, seas, lakes, rivers, mountains and deserts will be registrable if the goods or services are not associated with its reputation and the name concerned is not a likely source of origin for the goods or location of the services.

Examples of registrable marks:

**ATLANTIC** for footwear

**MT EVEREST** for paper, stationery

If the geographical name characterizes the location of the goods or services concerned, the mark will face an objection. For example,

**MEDITERRANEAN** for transport services

**ATLANTIC** for prawns

The Registrar will generally object to names of oceans, seas, lakes, rivers for marine produce or for example, boat charters. The same applies to names of mountains for agricultural produce.

**(g) Names of streets, roads, districts and suburbs**

These are treated like any other geographical name. If a street name, road name, or district has a reputation for the designated goods or service, an objection will be raised. Such names would not have the inherent capacity to distinguish.

Many towns have streets or other areas well known for certain goods or services. For example, WALL STREET (New York financial district) will be objectionable in respect of financial services; ORCHARD ROAD will be objectionable in respect of most consumer goods and services.

**(h) Superseded geographical names**

Superseded geographical names that have no connection with the goods such as BYBLOS (class 25) which is the ancient name for the Lebanese town of Jubayl may be *prima facie* acceptable.

Other names which have been officially superseded recently but are still in popular usage may require some evidence or could be accepted if there are any other circumstances which support doing so. These could include names such as PEKING, CEYLON and LENINGRAD where the original geographical meaning is still very much the primary signification of the name and is still being used interchangeably with the new name. The Registrar will also assess if the name of the ancient place would still have tourist significance, albeit the name of the ancient place is no longer a populated centre. If so, the mark may attract a ground for rejection, especially if the services claimed are related to tourism.

**(i) Phonetically similar geographical names**

Generally, a mark will not be objected to merely because of phonetic similarity to existing geographical names. Well known place names have well known spellings and variations on these spellings can often afford a word with sufficient distinctive character for *prima facie* acceptance. However, minor misspellings which are phonetically the same and visually very similar to well known place names may not be objectionable *prima facie*, for example, TOKIO for electrical items.

## **5 HOW TO OVERCOME SECTION 7(1)(c) OBJECTION?**

### **(a) Exclusion in specification**

A Section 7(1)(c) objection cannot be overcome by a limitation to exclude the goods originating from/services provided in the place whose name they carry.

However if the objection is taken in respect of only part of the specification, it may be possible to delete the objectionable item in order to overcome the Section 7(1)(c) objection.

### **(b) Acquired distinctiveness**

A mark consisting exclusively of a sign designating geographical origin can be registered if in fact, it has acquired a distinctive character as a result of use before the date of application for registration (Section 7(2)).

However, it may be near impossible to overcome the objection on the basis of use if the mark comprises exclusively the name of a country or a major city, such as USA, New York, UK, London, France, Paris, China or Beijing.

## 6 EXAMINATION PRACTICE IN RELATION TO SECTION 7(4)(b) OBJECTION

Section 7(4)(b) provides that a trade mark which is of such a nature as to deceive the public as to nature, quality or geographical origin of the goods/services must be refused registration. A trade mark will be deceptive if it misrepresents that the goods or services originate from a geographical area with a given quality, reputation or other characteristic.

### (a) When to raise Section 7(4)(b) objection?

Section 7(4)(b) provides that signs that designate geographical origin should not be misleading. Hence, an objection based on Section 7(4)(b) may arise if a mark contains/consists of a geographical name and the primary significance of the mark is its geographical location.

#### (i) For goods

The use of a geographical name in a trade mark on goods would lead consumers to view the mark as an indication of the source of the goods. This is commonly seen for names of places well-known for certain goods. For example, BRAZIL for coffee or FRANCE for wine.

If, however, the geographical name in the trade mark appears merely to be a fanciful association, for example MISS AMERICA for textiles, the mark would be acceptable (see also "*Roman Holiday*" *Trade Mark [1964] R.P.C. 129* where the trade mark, ROMAN HOLIDAY, was considered registrable for perfumes and cosmetics).

However, if the words "Made in XYZ" appear on the mark, it would be evident that the geographical name indicates the source of the goods.

#### (ii) For services

The use of a geographical name in a trade mark for services is usually more acceptable as it is less likely to be regarded as an indication of the origin of the services. However, where the geographical name suggests that the services are of a particular nature, objections can be raised. For example: THAI for massage services.

#### (iii) Geographical indications (GI)

The Registrar will raise an objection under Section 7(4)(b) where the mark **consists of or contains** a geographical indication but the goods/services do not

possess the qualities or the reputation that are attributable to that geographical indication.

A geographical indication or GI is a sign used on goods that have a specific geographical origin and possess qualities or a reputation that are due to that place of origin. Most commonly, a geographical indication consists of the name of the place of origin of the goods. Agricultural products typically have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil. Whether a sign functions as a geographical indication is a matter of national law and consumer perception. Geographical indications may be used for a wide variety of agricultural products, such as, for example:

- TUSCANY for olive oil produced in a specific area of Italy; and
- ROQUEFORT for cheese produced in France

The use of geographical indications is, however, not limited to agricultural products. They may also highlight specific qualities of a product which are due to human factors that can be found in the place of origin of the products, such as specific manufacturing skills and traditions. That place of origin may be a village or town, a region or a country. An example is "Switzerland" or "Swiss", which is perceived as a geographical indication in many countries for products that are made in Switzerland and, in particular, for watches.

The concept of geographical indication encompasses appellations of origin. Appellations of origin are used on products that have a specific quality that is exclusively or essentially due to the *geographical environment* in which the products are produced.

A geographical indication tells consumers that a product is produced in a certain place and has certain characteristics that are due to that place of production. It may be used by all producers who make their products in the place designated by a geographical indication and whose products share typical qualities.

Hence GIs are not registrable as a trade mark.

#### **(iv) Geographical names as collective and certification marks**

However, GIs may be registrable as a certification or collective mark. Geographical names may be registrable as certification marks provided that the name is capable of distinguishing goods or services which are certified from those which are not. Similarly, collective marks consisting of geographical names may be accepted for registration provided that they are capable of distinguishing the goods or services of the members of the association from those of other traders.

In assessing such an application, the Registrar will consider if the application is still objectionable under either Section 7(1)(b) and (c), (on the basis that the GI in question has become a generic description of the claimed goods). Geographical indications may become generic if the term is used as the designation of a kind of

product, rather than an indication of the place of origin of that product. If this happens, the term no longer functions as a geographical indication. For example, "Dijon Mustard" now denotes a certain kind of mustard, regardless of its place of production. Alternatively, if the goods do not bear the characteristics that are due to that GI, Section 7(4)(b) may be raised.

**(b) How to overcome Section 7(4)(b) objection?**

**(i) Restriction of specification**

In some circumstances, a restriction of the applicant's specification to reflect the composition or geographical origin of the goods will answer an objection that the mark is deceptive.

**Example**

SWISS MISS for preparations for making chocolate or cocoa beverages will be deceptive if the goods are not of Swiss origin (*Swiss Miss [1997] R.P.C. 219*). The judge rejected the argument that SWISS used in conjunction with MISS would merely be taken as evoking a particular ambiance or as indicating the style or flavour of the product or its healthy qualities. Although Switzerland has no reputation for cocoa powder, it has a reputation for chocolate and chocolate confectionery. Both chocolate and cocoa powder are produced from cocoa beans and manufacturers of cocoa powder are also manufacturers of chocolate.

SWISS CHALET for chocolate would also be deceptive unless the specification is limited to "chocolate the product of Switzerland" (*Chocosuisse v Cadbury [1998] R.P.C. 117*).

However, the Registrar may not choose to raise an objection where an applicant already has a registration for the same mark or an insignificant variation of the same mark for the same unrestricted goods or services.

**Consequences of limiting specification**

Limiting an applicant's specification does not limit a registered owner's rights to sue for infringement. A registered owner can sue for infringement for unauthorised use of his mark on goods or services that are similar to those for which his mark is registered (Section 27(2)).

**(ii) Evidence of use**

Evidence of use can be of assistance in overcoming Section 7(4)(b) objections: the likelihood of deception may be reduced due to the fact that the public will not likely be deceived as to the geographical origin as a result of the effect of use by the applicant.

## **7 EXAMINATION PRACTICE IN RELATION TO SECTION 7(1)(d) OBJECTION**

Section 7(1)(d) of the Act prevents the registration of signs or indications which are customary in the current language or in the trade. The Registrar will take objection where the Registrar has cause to believe that the sign has in fact become customary. When raising such an objection, the Registrar may make reference to extracts from relevant publications or examples of the trade mark in customary use to support the objection.

Examples of such signs or indications would include:

- SWISS ROLL for cakes; and
- PEKING DUCK for food