

SERIES OF MARKS

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SERIES OF MARKS

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1. Introduction

This chapter deals with the grounds for registration of marks which constitute a series.

2. Relevant legislation

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

Registration of series of trade marks

17.—(1) A person may make a single application under section 5 for the registration of a series of trade marks.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act and the Registrar is required under section 15 to register the trade marks, he shall register them as a series in one registration.

Trade Marks Rules

Irregularities

83. Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct.

3. General requirements of a series

To qualify as a series of trade marks, the following requirements must be satisfied:

(a) Each mark in the series must resemble each of the others in the series in their material particulars, that is, the main features in each of the trade mark must be essentially the same.

(b) The differences between the marks must comprise only matters which, when considered as a separate element of the mark, be non-distinctive in nature.

(c) The differences between the trade marks must not comprise matters which, in the context of the trade mark as a whole, substantially affect the identity of the trade marks.

- (i) This is the over-riding requirement – the differences between the marks must not substantially affect their identity. The test is **not** merely whether the marks in the series would be regarded as **confusingly similar** to each other if used by unrelated undertakings. Even if the marks are confusingly similar, the marks may still not qualify as a series.
- (ii) Any variation in the non-distinctive features in the marks must leave the **visual, phonetic and conceptual identity** of each of the trade marks substantially the same. Even if the marks are conceptually similar, they will not constitute a series if there are substantial differences in the visual or aural identities of the marks.
- (iii) The assessment of whether the identity of the marks is substantially affected is based on the likely reaction to the marks of an average consumer of the goods/services in question.

(See [Logica Plc's Application \(UK Decision of Appointed Person in Case O-068-03\)](#)).

4. Application of principles to different types of marks

4.1. Upper and lower case presentation

In order to be acceptable as a series, the differences in upper and lower case of the words must not result in the marks being perceived or pronounced differently.

CHERRY
Cherry

Example 4.1.1

In Example 4.1.1 above, the series of two marks are acceptable as the difference in the letter case does not alter the pronunciation and meaning of the marks. The identity of the marks remains the same word “Cherry”.

MYSTORE
MyStore
Mystore
MystOre

Example 4.1.2

In Example 4.1.2 above, the series of four marks are not acceptable as a series. The first three marks are clearly interpreted as combinations of two common English words “My” and “Store”. As the average consumer will read these three marks as “My” and “Store” regardless of the difference in letter case, the visual, aural and conceptual identities of the three marks are substantially the same. However, for the fourth mark, it is not immediately apparent that this mark would be interpreted as a combination of “My” and “Store” without a side-by-side comparison with the first three marks. Due to the upper case in the letter “O” in the fourth mark, this mark may instead be interpreted as a coined term made up of “Myst” and “Ore”. Hence, the identity of the fourth mark is substantially different from that of the first three marks. The fourth mark would therefore not form a series with the first three marks. However, if the first three marks are filed as a series of three marks, they would be acceptable as a series.

SWEETORANGE
SweetoRange

Example 4.1.3

In Example 4.1.3 above, the two marks do not qualify as a series. The first mark may logically be interpreted as a combination of the English words “SWEET” and “ORANGE”, but the second mark could appear to be an invented term comprising “Sweeto” and “Range”. As the difference in letter case in the second mark is likely to render a different pronunciation and conceptual interpretation from the first mark, the two marks are not acceptable as a series.

ImGold
IMGOLD

Example 4.1.4

In Example 4.1.4 above, the two marks do not qualify as a series. Due to the upper case in the letter “G” in the first mark, this mark is clearly dissected into an invented term “Im” and the dictionary word “Gold”. However, as all the letters in the second mark are in upper case, it is not immediately apparent that this mark is made up of “Im” and “Gold”. Instead, the second mark appears to comprise a single invented word “IMGOLD”. Given that there are differences in the visual, aural and conceptual identities of the marks, the two marks are not acceptable as a series.

4.2. Conjoining words

Mark(s) consisting of two or more words separated by spacing, and another mark consisting of the same words conjoined into a single term may form a series if:

- (a) the marks are composed of two or more common English words, **and**
- (b) in the separated and conjoined versions, the pronunciation and meaning of the marks remain the same regardless of the placement of the spacing.

CHERRYTREE
CHERRY TREE

Example 4.2.1

In Example 4.2.1 above, the two marks are acceptable as a series. The marks are composed of two common English words “CHERRY” and “TREE”, and the pronunciation and meaning of the marks remain the same regardless of the presence of the spacing in the second mark in the series. There is also no substantial difference in the visual identity of the marks. Hence, the two marks would qualify as a series.

GOODSIT
GOODS IT

Example 4.2.2

In Example 4.2.2 above, the two marks are not acceptable as a series. The first mark may be interpreted as “GOODSIT”, “GOODS IT” or “GOOD SIT”, depending on how the average consumer perceives the conjoined term. The second mark would only be interpreted as “GOODS IT” due to the placement of the spacing. Given that there are multiple ways to interpret the first mark whereas there is only one way to interpret the second mark, the pronunciation and conceptual idea of the first mark may differ from the second mark. Hence, the two marks do not qualify as a series.

Q WIN
QWIN

Example 4.2.3

In Example 4.2.3 above, the two marks are not acceptable as a series. The first mark would be seen as comprising the letter “Q” and the word “WIN”, whereas the second mark may be interpreted in multiple ways, i.e. as a single coined term “QWIN” (similar pronunciation as “queen”) or as a combination of the letter “Q” and the word “WIN”. Without the benefit of a side-by-side comparison with the first mark, the second mark is open to different interpretations. Therefore, the two marks do not qualify as a series.

NARA
BOKU

NARA BOKU

NARABOKU

Example 4.2.4

In Example 4.2.4 above, the three marks are not acceptable as a series. The textual element in the first and second marks is dissected into two separate words, “NARA” and “BOKU”, whereas the textual element in the third mark is a single coined word “NARABOKU”. As the terms “NARA” and “BOKU” are not common English words, without a side-by-side comparison with the first and second marks, it is not clear that the third mark is intended to be broken into two terms “NARA” and “BOKU”. Consequently, the difference in the positioning of the textual element in the marks may cause the marks to be interpreted differently. The three marks therefore do not qualify as a series. However, if the first two marks are filed as a series of two marks, they would be acceptable as a series.

4.3. Spelling

4.3.1. American and British spelling

Differences in the same word(s) due to the American or British spelling of the word(s) are generally acceptable, provided that there is no substantial difference in the visual, aural and conceptual identities of the marks in the series, as shown in the following examples:

PAUL’S CENTER
PAUL’S CENTRE

Example 4.3.1.1

ABC JEWELRY
ABC JEWELLERY

Example 4.3.1.2

4.3.2. **Misspelling**

If the differences in spelling change the visual, aural or conceptual identities of the marks in the series, the marks may not constitute a series.

EXOTEK
EXOTEC

Example 4.3.2.1

In Example 4.3.2.1 above, the two marks are not acceptable as a series. The marks “EXOTEK” and “EXOTEC” are coined or invented words with separate identities, even though they may be pronounced in the same way. The use of the letters “K” and “C” in the first and second marks respectively also results in a substantial visual difference between the two marks. Hence, the two marks do not qualify as a series.

ALL 4 YOU
ALL FOR YOU

Example 4.3.2.2

The two marks in Example 4.3.2.2 above are not acceptable as a series. The numeral “4” is not a conventional and grammatically-correct replacement for the English word “for”, and therefore the misspelling results in substantial visual and conceptual differences between the first and second marks.

4.4. Punctuation

Punctuation is used to create sense, clarity and stress in sentences. Punctuation marks are used to structure and organise a phrase or sentence. Where the marks in a series differ as to their punctuation, the series is acceptable provided that the punctuation does not substantially alter the visual, aural and conceptual identities of the marks. Otherwise, the marks would not qualify as a series.

The following examples are acceptable series of marks despite the inclusion or alteration of the punctuation marks:

TRICK N TREAT
TRICK 'N' TREAT
TRICK-N-TREAT

Example 4.4.1

In Example 4.4.1 above, the three marks are acceptable as a series, as the marks would be interpreted as a phrase made up of the terms “TRICK”, “N” and “TREAT”. The addition of the apostrophes and hyphens in the second and third marks in the series does not substantially affect how the three marks would be interpreted. The three marks in the series would be pronounced in the same way, and there is no substantial difference in the visual identity of the marks. Therefore, the three marks qualify as a series.

UKNY
U.K.N.Y

Example 4.4.2

In Example 4.4.2 above, the two marks are acceptable as a series. Regardless of the presence of the full stops in the second mark in the series, the two marks would both be interpreted as the same abbreviation comprising the letters “U”, “K”, “N” and “Y”. Hence, the two marks qualify as a series.

On the other hand, if the addition or removal of punctuation marks causes the marks to differ visually, phonetically or conceptually, the marks will not be acceptable as a series. The following marks are not acceptable as a series.

ESCAPE
E’SCAPE

Example 4.4.3

In Example 4.4.3 above, the first mark will be seen and pronounced as the English word “ESCAPE”. However, the introduction of an apostrophe to the second mark serves to ‘divide’ the mark and changes the identity of the mark to “E” and “SCAPE”. The two marks will therefore not qualify as a series.

RHop
RHop!

Example 4.4.4

In Example 4.4.4 above, the two marks are visually and conceptually different due to the addition of the exclamation mark to the second mark. The exclamation mark contributes an expression of surprise or excitement, which is not present in the first mark. Therefore, the marks do not qualify as a series.

Create. Innovate. Design. Create Innovate Design

Example 4.4.5

In Example 4.4.5 above, the punctuation affects the interpretation of the phrases. The addition of the full stops in the first mark breaks it up into three separate sentences. The second mark, without any punctuation, will be interpreted as an ungrammatical phrase. Consequently, the two marks have different conceptual identities and do not qualify as a series.

4.5. Symbols and special characters

Where the marks in a series contain symbol(s) or special character(s), the series of marks are acceptable provided that the symbol or special character does not substantially alter the visual, aural and conceptual identities of the marks. Otherwise, the marks would not qualify as a series.

Williams and Smith Williams & Smith

Example 4.5.1

In Example 4.5.1 above, the two marks are acceptable as a series. The ampersand is a conventional symbol that is commonly used in place of the word “and”. The substitution of the word “and” with an ampersand symbol in the second mark thus does not substantially alter the meaning of the two marks. Hence, the two marks qualify as a series.

The substitution of letters with special characters in a series of marks is generally not acceptable, unless the special characters do not substantially alter the visual, aural and conceptual identities of the marks.

IPOS Café IPOS Cafe

Example 4.5.2

In Example 4.5.2 above, the two marks are acceptable as a series. The difference in the two marks lies in the words “Café” and “Cafe”. English dictionaries show that the two words are used interchangeably. Hence, the special character “é” in the first mark does not render the visual, aural and conceptual identities of the first mark different from that of the second mark. The marks therefore qualify as a series of two marks.

ADIDE ADIDÉ

Example 4.5.3

In Example 4.5.3 above, the two marks are not acceptable as a series. The words “ADIDE” and “ADIDÉ” are coined terms with no meaning. Unlike in the previous Example 4.5.2, the

substitution of the letter “E” with the accented letter “É” in this case is not acceptable. As the average consumer in Singapore generally understands that certain foreign languages (such as French) contain words with accented letters, he/she may infer that the second mark is a foreign word due to the accented letter “É” in the second mark. Given that the presence of the accented letter “É” in the second mark may result in different interpretations of the two marks, the two marks have different identities and do not qualify as a series.

IPOS CAFE
IPOS C@FE

Example 4.5.4

The two marks in Example 4.5.4 above are not acceptable as a series. The substitution of the letter “A” with the symbol “@” in the second mark is not acceptable, as the symbol “@” is normally pronounced as “at” and is not a conventional symbol for the letter “A”, in the manner that the ampersand is a conventional symbol for “and”. Hence, the two marks have different visual, aural and conceptual identities. The marks therefore do not qualify as a series of two marks.

RHop
#RHop

Example 4.5.5

In Example 4.5.5 above, the two marks are not acceptable as a series. The first mark is a word whereas the second mark, with the addition of a hash sign “#”, will be interpreted as a hashtag. A hashtag is used to classify or categorise the word or phrase following the hash sign, or identify a keyword or topic of interest and facilitate a search for it. The hash sign “#”, although lacking in distinctive character, changes the identity of the second mark from a word to that of a hashtag. Hence, the second mark is conceptually different from the first mark, and the two marks do not qualify as a series.

4.6. Stylisation

Variations in stylisation should be minimal and of a non-distinctive nature such that the differences do not substantially affect the identities of the marks in the series.

4.6.1. Conventional fonts

For marks containing textual elements, the same word(s) in different scripts or fonts are acceptable as a series if the scripts or fonts are conventional and not fancifully stylised.

BLACK KNIGHT BAR
BLACK KNIGHT BAR
BLACK KNIGHT BAR
BLACK KNIGHT BAR

Example 4.6.1.1

In Example 4.6.1.1 above, the four marks are acceptable as a series. The different fonts depicted above are conventional scripts that are not stylised in a fanciful manner. The difference in the fonts is considered non-distinctive as it does not substantially affect the identity of the marks. Therefore, the marks qualify as a series of four marks.

4.6.2. **Fanciful stylisation**

A word mark which contains stylised letter(s) may be acceptable in a series, provided that the stylisation of the letters is not overly fanciful and does not render the mark(s) to be substantially different in identity from the other mark(s) in the series.

SEESAW
SEESAW

Example 4.6.2.1

In Example 4.6.2.1 above, the two marks are acceptable as a series. The stylisation of the letter “S” in the second mark in the series is simple and does not substantially affect the identity of the mark. The marks therefore qualify as a series of two marks.

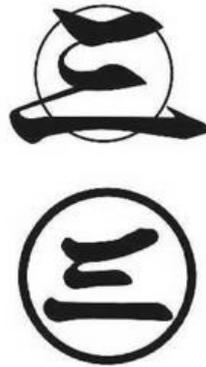
Where the stylisation is fanciful and results in a substantial visual, aural, or conceptual change in any of the marks, the marks will not be acceptable as a series.

I P O S
| ? O S

Example 4.6.2.2

In Example 4.6.2.2 above, the first mark has all the letters “IPOS” in the same conventional font, whereas the second mark contains a stylised “P” in the shape of a light bulb with the other letters “I”, “O” and “S” depicted in plain font. The stylised “P” in the second mark renders it visually and conceptually different from the first mark. As such, the marks are not acceptable as a series.

For device marks, slight differences in the stylisation would generally render them unacceptable as a series.

*Example 4.6.2.3*

In Example 4.6.2.3 above, the difference in the stylisation of the two marks creates a very different visual impact. Hence, the two marks do not qualify as a series.

4.6.3. Addition of device element

The addition of a device element to a word mark almost always substantially affects the identity of the mark and would therefore render the marks unacceptable as a series. However, a plain conventional embellishment, such as the addition of a line or a simple border, contributes nothing of a distinctive nature to the trade mark as a whole. Such embellishments are generally acceptable since they contribute no significant difference to a mark. This principle is demonstrated in the examples below.

Bellson

Bellson

Example 4.6.3.1

Trafwicbook

Trafwicbook

Example 4.6.3.2

4.7. Positioning of elements

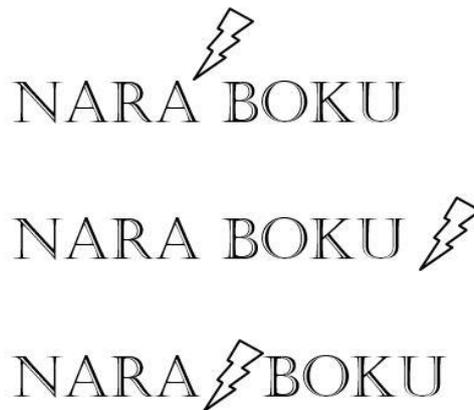
In order to qualify as a series, differences in the positioning of the elements in the marks must not substantially affect the overall identity of the series of marks.

*Example 4.7.1*

In Example 4.7.1 above, the two marks are acceptable as a series. Despite the differences in their respective layouts, the marks share the same visual, aural and conceptual identities. As such, the marks qualify as a series of two marks.

If the difference in the positioning of the elements results in visual, aural or conceptual dissimilarities which substantially affect the identities of the marks, the marks will not be acceptable as a series.

4.7.1. Positioning of elements in marks containing meaningless terms



Example 4.7.1.1

In Example 4.7.1.1 above, the three marks are acceptable as a series. The first and second marks in the series will be read as individual words “NARA” and “BOKU” due to the spacing in between the words. Similarly, the device element in the third mark in the series separates the textual elements such that the mark is also pronounced as “NARA” and “BOKU”. The positioning of the device element in the third mark does not substantially alter the visual, aural and conceptual identities of the three marks. Hence, the three marks qualify as a series.

4.7.2. Positioning of elements in marks with meaning



Example 4.7.2.1

In Example 4.7.2.1 above, the three marks do not qualify as a series. The first and second marks will be interpreted as “WE FOOD” with a heart device. However, due to the positioning of the heart device between the two words “WE” and “FOOD” in the third mark, the average consumer may also interpret this mark as “WE LOVE FOOD”, as the heart device may connote the meaning “love”. Therefore, there is an additional way to interpret the third mark as

compared to the first and second marks. Hence, the identity of the third mark is substantially different from the first and second marks, and it does not qualify as a series with the first two marks. Only the first and second marks are acceptable as a series of two marks.

4.8. Prominence of elements

Increasing the prominence of one or more elements in the mark over others, where it does not significantly affect the visual, aural and conceptual identities of the marks, is acceptable in a series.



Example 4.8.1

In Example 4.8.1 above, the three marks are acceptable as a series. As the word and device elements are equally distinctive in the three marks, the difference in the size of the word and device elements does not significantly affect the visual, aural and conceptual identities of the marks. Hence, the three marks qualify as a series.

ZAAR'S CAKES
ZAAR'S CAKES

Example 4.8.2

In Example 4.8.2 above, the two marks are acceptable as a series. The distinctive element in the two marks is the word "ZAAR'S". Hence, the difference in the size of the word "CAKES" in the second mark in the series does not contribute to a conceptual difference in the marks. Both marks would be interpreted as "cakes from the brand or person named Zaar". Given that there is no substantial difference in the visual, aural and conceptual identities of the marks, the two marks qualify as a series.

If the difference in the prominence of the elements results in visual, aural or conceptual dissimilarities which substantially affect the identities of the marks, the marks will not be acceptable as a series.

THE COOK HOUSE
 THE **COOK** HOUSE
THE COOK **HOUSE**

Example 4.8.3

In Example 4.8.3 above, the three marks are not acceptable as a series. The three words “THE COOK HOUSE” in the first mark are of equal size and the mark would only be read as the phrase “THE COOK HOUSE”. However, the relatively larger size of the word “COOK” in the second mark and the words “THE HOUSE” in the third mark gives visual emphasis to these words. Generally, the average consumer has a natural tendency to first focus on the most prominent element(s) in a mark. Therefore, he/she will be drawn to look at “COOK” first followed by “THE HOUSE” in the second mark, and “THE HOUSE” first followed by “COOK” in the third mark. Hence, in addition to interpreting the second and third marks as a single phrase “THE COOK HOUSE”, they may also be interpreted as “COOK” and “THE HOUSE” separately. There are additional ways to interpret the second and third marks as compared to the first mark. As a result, the three marks do not qualify as a series due to the significant differences in the visual and conceptual identities of all three marks.

4.9. Colour

Differences in colour in the elements of the marks are acceptable in a series only if the colours do not substantially affect the identities of the marks.

The criterion for marks to be acceptable as a series is not about the size of the element in which the colour difference lies, or whether the marks would be seen as pointing to the same trade source. Even if the colour difference lies within a minor portion of the marks or if it is clear that the marks belong to the same trade source, the marks may still be found to be unacceptable as a series if there are substantial differences in the identities of the marks. This is explained further in the following sections.

4.9.1. Colour difference in word marks

Generally, for word marks in a series, the distinctive feature lies mainly within the meaning of the word(s). The aural and conceptual identities of the word marks play a more important role than their visual identity. If the colour difference does not change the way the word(s) in the marks in a series are read or interpreted, the marks would be acceptable as a series.

HIP ALLIANCE
HIP ALLIANCE

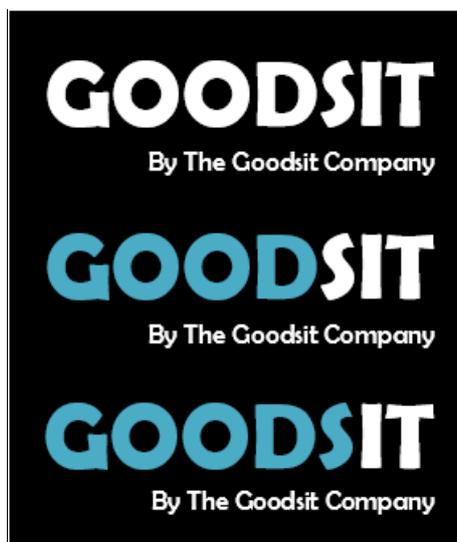
Example 4.9.1.1

In Example 4.9.1.1 above, the two marks are acceptable as a series. Although the second mark in the series is in orange, the difference in the colour of the textual element does not substantially affect the visual impact of the marks as both marks are presented in a single colour. Moreover, in this case, colour is a subordinate and non-distinctive feature of the marks. The difference in the colour of the textual element therefore does not substantially affect the identities of the marks. Consequently, the two marks qualify as a series.

IPPZ
 IPPZ
 IPPZ
 IPPZ
 IPPZ

Example 4.9.1.2

In Example 4.9.1.2 above, the five marks are also acceptable as a series. The difference in the colour of the letters does not change the way the marks are interpreted. The five marks are all pronounced as “I-P-P-Z”, and the textual element “IPPZ” is meaningless. The five marks therefore qualify as a series.



Example 4.9.1.3

In Example 4.9.1.3 above, the three marks are not acceptable as a series even though the marks appear to point to the same trade source, “The Goodsit Company”. The dominant textual element “GOODSIT” in the first mark may be interpreted as “GOODSIT”, “GOODS IT” or “GOOD SIT”, depending on how the average consumer perceives the conjoined term. However, the colour contrast in the second and third marks dissects the textual element such that it could only be interpreted as “GOOD SIT” and “GOODS IT” respectively. Given that all three marks may be interpreted differently due to the colour differences, the three marks do not qualify as a series.

4.9.2. **Colour difference in marks consisting of device(s)**

Generally, for device marks in a series, colours may play an important role in the distinctiveness of the marks, such that any variation in the colours may substantially alter the visual and/or conceptual identities of the marks.

Where colour is the primary or only distinctive element of a mark consisting of device(s), the absence or variation of colour(s) in the other mark(s) will disqualify them as a series.

The addition of colours to simple shapes will occasionally add distinctiveness to an otherwise non-distinctive mark. In such cases, the marks will not qualify as a series given that a distinctive element of the mark, that is, the colour, is not the same in all of the marks. This principle is illustrated in the following examples:



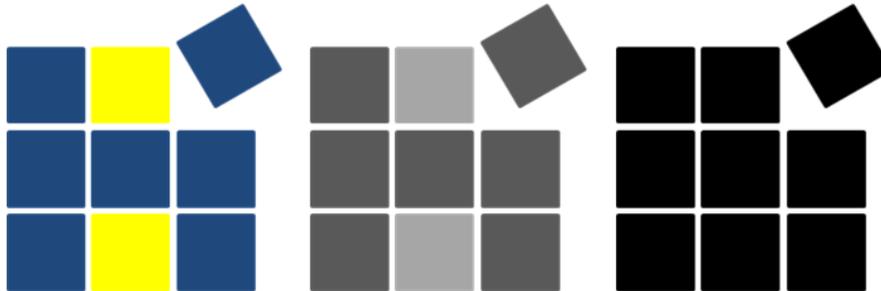
Example 4.9.2.1



Example 4.9.2.2

Where colour is not the primary or only distinctive element of the marks, the difference in colour(s) should not bring substantial difference to the identities of the marks in order for them to be acceptable as a series.

Generally, applicants lodging coloured mark(s) in a series together with a non-coloured version of the same mark should furnish the non-coloured mark in greyscale tones rather than in pure black-and-white tones. This is because certain features present in the coloured version(s) may not be clearly perceivable in the pure black-and-white version of the mark, thereby resulting in differences in the visual identity of the marks.



Example 4.9.2.3

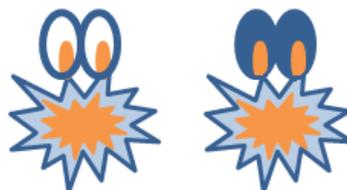
In Example 4.9.2.3 above, the three marks are not acceptable as a series. The contrasting colours in the first mark are discernible in the monochrome shades of the greyscale mark (second mark) but not in the black-and-white colours of the third mark. As there are substantial differences in the visual identity of the third mark as compared to the first and second marks, the third mark does not form a series with the first and second marks. Only the first and second marks would qualify as a series.



Example 4.9.2.4

In Example 4.9.2.4 above, the three marks are acceptable as a series. The distinctive features of the characters in the marks are essentially the same and colour is not the primary distinctive element in the marks. As the difference in the colours of the characters does not substantially alter the identity of the marks in the series, the three marks would qualify as a series.

However, if the difference in colours brings substantial differences to the identities of the marks, the marks will not be acceptable as a series.



Example 4.9.2.5

In Example 4.9.2.5 above, the two marks are not acceptable as a series. The difference in the colours of the ‘eyes’ renders the characters to appear noticeably different, such that they are not recognised as being the same character. As the difference in the colours of the characters in this case has substantially altered the identities of the marks, the two marks do not qualify as a series.

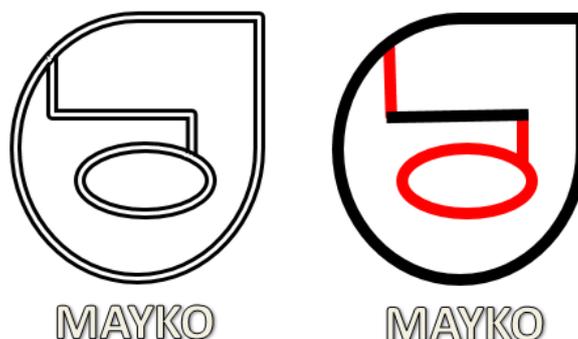
4.9.3. Colour difference in composite marks

Composite marks are marks that contain both word and device elements. Generally, for composite marks in a series, the marks are assessed in their entirety with consideration to the dominant and distinctive features of the marks. The criterion for examining whether composite marks constitute a series is the same as for word marks and for device marks. If the colour difference does not substantially affect the visual, aural and conceptual identities of the marks as a whole, the marks would be acceptable as a series.



Example 4.9.3.1

In Example 4.9.3.1 above, the two marks are acceptable as a series. The differences in the colours in the marks do not substantially change the visual, aural and conceptual identities of the marks. The distinctive feature of the device lies in the overall representation of the device, and the difference in the colours does not significantly alter the visual identity of the device. Likewise, the colour difference in the word element does not change the way the word is read or interpreted, as it still reads “MAY-KO” in both marks. Hence, the two composite marks share the same visual, aural and conceptual identities when assessed in their entirety, and the two marks qualify as a series.



Example 4.9.3.2

However, in Example 4.9.3.2 above, the two marks are not acceptable as a series. The differences in the colours of the device element in the marks in this case have significantly altered the visual identity of the marks. The colour red in particular parts of the device element in the second mark results in this device appearing significantly different from the device in the first mark. With reference to section “4.9.2. Colour difference in marks consisting of device(s)” (which states that colour variations that substantially alter the visual and/or conceptual identities of the marks would disqualify the marks as a series), the colour difference in this example results in a significant change in the visual identity of the two marks. When compared in their entireties, the two composite marks do not share the same identities. Hence, the two marks do not qualify as a series.

4.10. Chinese characters

In order for marks comprising Chinese characters to qualify as a series, any variations between the Chinese characters must leave the visual, aural and conceptual identities of the marks essentially the same.

4.10.1. Traditional and simplified Chinese characters

The same Chinese characters presented in both traditional and simplified forms are acceptable as a series if the characters are in the same conventional scripts. The following example illustrates an acceptable series of marks:

知识产权局
知識產權局

Example 4.10.1.1

4.10.2. Stylisation of Chinese characters

Differences in the stylisation of the Chinese characters would generally render the marks unacceptable as a series, given that the visual identities of the marks would be substantially different. The following example illustrates an unacceptable series of marks due to differences in the stylisation:

知识产权
知识产权

Example 4.10.2.1

4.10.3. Positioning of Chinese characters

Chinese characters are usually read from left to right or from top to bottom. This principle is applicable for assessing Chinese characters as a series of marks.



Example 4.10.3.1

The two marks in Example 4.10.3.1 above are not acceptable as a series, because the difference in the positioning of the Chinese characters alters the identity of the marks. As Chinese characters would generally be read from left to right, the first mark would be read as “草莓 微笑” and the second mark would be read as “微笑 草莓”. This results in the two marks being substantially different in their visual, aural and conceptual identities. Hence, the two marks do not qualify as a series.

4.10.4. Chinese characters in other languages

Some Chinese characters have been borrowed by and incorporated into other languages, such as Japanese (*kanji*) and Korean (*hanja*). These Japanese *kanji* or Korean *hanja* characters are written in the same way as the Chinese characters but are pronounced differently and may have different meanings.

For a series of two marks consisting of one mark with Chinese characters in simplified form and another mark with the same characters in traditional form which could also be read in Japanese and/or in Korean, the two marks would be acceptable as a series. This principle is illustrated in the following example:

马车
馬車

Translation clauses:

- 1) The transliteration of the Chinese characters in the mark is “Ma Che” meaning “Horse-drawn carriage”.
- 2) The transliteration of the Japanese characters in the mark is “Basha” meaning “Horse-drawn carriage”.
- 3) The transliteration of the Korean characters in the mark is “Macha” meaning “Horse-drawn carriage”.

Example 4.10.4.1

In Example 4.10.4.1 above, the two marks are acceptable as a series. The characters “马车” in the first mark in the series can only be read in Chinese, whereas the characters “馬車” in the second mark in the series can be read in Chinese, Japanese and/or Korean. The pronunciation of the characters “馬車” in Chinese is different from the way the same characters are pronounced in Japanese or in Korean. However, the two marks would still qualify as a series since both marks can be interpreted in the same language (Chinese) with the same pronunciation and meaning.

In addition, it would be acceptable if the applicant requests to include the Japanese and/or Korean translation clause(s) for the characters “馬車” in the application. The endorsement of translation clauses in multiple languages—in this case, Chinese, Japanese and Korean—for the same characters does not affect the assessment of whether the marks in the application qualify as a series.

4.11. Foreign words

4.11.1. Foreign words containing special characters

For applications in which one of the marks in the series contains special characters such as diacritics or accents, the identities of the marks have to remain the same in order for the marks to be acceptable as a series.

mere
mère

Example 4.11.1.1

In Example 4.11.1.1 above, the two marks are not acceptable as series. The first mark “mere” is an English word. On the other hand, the second mark “mère” is a French word with the meaning “mother” and is pronounced as “mair”. The average consumer in Singapore generally does not understand French and may not recognise the second mark as a French word or know how the word “mère” is really pronounced. However, the existence of the accent symbol on the letter “e” in the word “mère” would inform the average consumer that the second mark is not the English word “mere”, and he/she would hesitate to interpret the mark as an English term and pronounce it as “mere”. He/She may pronounce the word “mère” in different ways, such as “meh” or “meh-reh”. As there are substantial differences in the aural and conceptual identities of the two marks, they do not qualify as a series.

4.12. Cartoon characters

When assessing whether marks comprising cartoon characters are acceptable as a series, the following factors are considered:

- Overall appearance of the characters
- Clothing worn by the characters
- Props used/held by the characters
- Names ascribed to the characters
- Positions assumed by the characters
- Activities undertaken by the characters
- Extent to which the props, clothing, name and/or activities undertaken by the character dominate the mark

Generally, marks comprising cartoon characters may qualify as a series if the characters are wearing the same clothing, holding/using the same props, and/or are ascribed with the same name (if applicable). Even if the marks appear to be portraying the same character, the marks may not be acceptable as a series if the differences between the characters substantially affect the identities of the marks. This is explained in greater detail in the sections below.

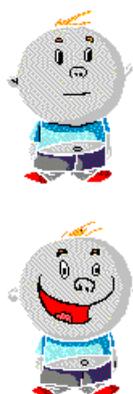
4.12.1. Facial expression of cartoon characters

Differences in the facial expression of a series of marks comprising cartoon characters are acceptable as long as the facial expression is not the primary distinctive feature of the characters.



Example 4.12.1.1

In Example 4.12.1.1 above, the three marks are not acceptable as a series. The facial expression of the cartoon characters plays an important role in the distinctiveness of the marks, as there is little other distinctive element(s) in the marks. Hence, the difference in the facial expression substantially changes the identities of the marks, and the three marks do not qualify as a series.



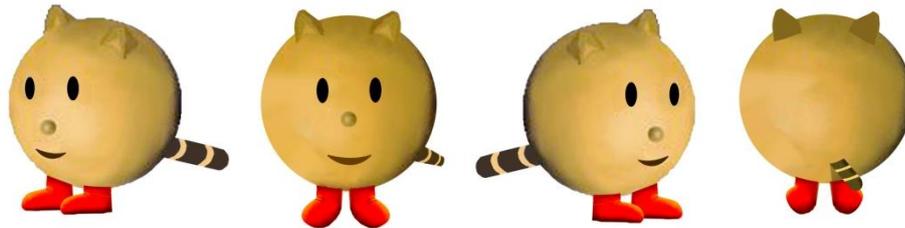
Example 4.12.1.2

In Example 4.12.1.2 above, the two marks are acceptable as a series. Facial expression is not the primary distinctive feature of the character in the two marks in the series, as the character comprises other distinctive features such as the overall appearance and the clothing worn by

the character. Hence, the difference in the facial expressions of the character does not substantially affect the identity of the marks in the series. The marks therefore qualify as a series of two marks.

4.12.2. Different positions of cartoon characters

For cartoon characters that assume different positions to be acceptable as a series, the extent to which the differences affect the identities of the marks should be considered. Differences which substantially affect the identities of the marks would disqualify the marks from being accepted as a series.



Example 4.12.2.1

In Example 4.12.2.1 above, the four marks are not acceptable as a series. The distinctive elements making up the character (i.e. the round face/body with pointed ears, facial features, protruding tail, and red shoes) are all clearly visible in the first, second and third marks. On the other hand, the facial features of the character are not visible in the fourth mark. The absence of facial features in the fourth mark renders the identity of that mark substantially different from the first, second and third marks. Hence, only the first, second and third marks would qualify as a series of three marks.

4.13. Background

Variations to backgrounds in a series of marks may be permissible if the backgrounds are merely a subordinate and non-distinctive feature of the marks and the difference in backgrounds does not substantially affect the identity of the marks.



Example 4.13.1

In Example 4.13.1 above, the two marks are acceptable as a series. The difference between the two marks in the series lies in the backgrounds. In this case, the backgrounds are merely decorative embellishments that are non-distinctive features of the marks. As the visual, aural

and conceptual identities of the two marks are not substantially affected by the difference in backgrounds, the two marks qualify as a series.

However, an addition or a change in a simple background may, in some instances, substantially affect the identities of marks, as illustrated in the following example.



Example 4.13.2

In Example 4.13.2 above, the two marks are not acceptable as a series. The elements within the first mark are encompassed within a circular background whereas the second mark appears to not have any background element. The absence of a circular background in the second mark renders the visual identity of the second mark significantly different from that of the first mark. The two marks therefore do not qualify as series.

4.14. House mark in combination with indication of goods/services

A house mark is a trade mark that appears on and identifies all of a company's goods and services. When a house mark is used in combination with descriptor(s) of goods and services, the assessment of whether the marks are acceptable as a series is based on two criteria, namely, the distinctiveness of the house mark and the descriptor(s) of goods and services.

The presence of a highly distinctive house mark in combination with clear or obvious descriptions of the goods/services claimed in the application is acceptable in a series of marks. This principle is illustrated in the following examples.

decoim paper
decoim pencil
decoim eraser

Application filed in Class 16 for "Paper, pencils, erasers".

Example 4.14.1

In Example 4.14.1 above, the three marks are acceptable as a series. The word “decoim” is a distinctive house mark and the words “paper”, “pencil” and “eraser” in the series of marks refer to the goods claimed in the application. Hence, the three marks qualify as a series.

IANNA YELLOW
IANNA RED
IANNA GREEN
IANNA BLUE
IANNA PURPLE
IANNA BLACK

Application filed in Class 2 for “Paints”.

Example 4.14.2

In Example 4.14.2 above, the six marks are acceptable as a series. The marks comprise the house mark “IANNA” and conventional descriptors of the colours of the paints claimed in the application. Hence, the six marks qualify as a series.

However, if the house mark is of low distinctiveness because it is a common or descriptive dictionary word(s), the marks are unlikely to qualify as a series.

POWER MACHINES
POWER TOOLS
POWER MACHINE TOOLS

Application filed in Class 7 for "Machines and machine tools".

Example 4.14.3

In Example 4.14.3 above, the three marks are not acceptable as a series. The common element “POWER” in the marks may be intended as a house mark. However, when used in combination with the descriptors “MACHINES”, “TOOLS” and “MACHINE TOOLS”, the combinations of the words (i.e. “POWER MACHINES”, “POWER TOOLS” and “POWER MACHINE TOOLS”) are descriptive of the purpose and/or characteristics of the goods claimed. Hence, the word “POWER” is unlikely to be perceived as a house mark in these three marks. The three marks therefore do not qualify as a series.

If the descriptors of goods and/or services appearing in the marks are not clear or obvious indications of the goods and/or services claimed in the application, the presence of a distinctive house mark will not assist in rendering the marks acceptable as a series.

NEWEN SKIN

Beauty jelly

NEWEN SKIN

Eye serum

NEWEN SKIN

Gel cleanser

NEWEN SKIN

Purifying toner

Application filed in Class 3 for “Cosmetic moisturisers; serum for cosmetic use; skin cleansers (cosmetic); skin care products including facial toners (cosmetic)”.

Example 4.14.4

In Example 4.14.4 above, the four marks are not acceptable as a series. Despite the presence of the distinctive house mark “NEWEN SKIN” in the four marks, the first mark does not constitute a series with the remaining three marks. This is because the descriptor “Beauty jelly” in the first mark is not a clear and obvious description of the goods claimed in the application. On the other hand, the descriptors “Eye serum”, “Gel cleanser” and “Purifying toner” in the second, third and fourth marks respectively are obvious descriptions of the goods claimed. As such, only the second, third and fourth marks would qualify as a series of three marks.

Further, if the application contains a trade mark which is a house mark on its own, and other marks which are combinations of the same house mark with indications of the goods/services, the application would not be acceptable as a series of marks.

decoim

decoim paper

decoim pencil

decoim eraser

Application filed in Class 16 for “Paper, pencils, erasers”.

Example 4.14.5

In Example 4.14.5 above, the four marks are not acceptable as a series. The first mark consists of the house mark “decoim” on its own and does not include an additional descriptor element that is present in the second, third and fourth marks. On the other hand, the second, third and fourth marks are signs which describe the goods (i.e. papers, pencils and erasers by “decoim”). Hence, the additional descriptor elements in the second, third and fourth marks result in conceptual differences between these marks and the first mark. The four marks therefore do not qualify as a series. Only the second, third and fourth marks would qualify as a series of three marks.

4.15. House mark in combination with numbers

House marks in combination with different numbers may constitute a series if the numbers can clearly be interpreted as being merely model numbers following the house mark, and it is common for the claimed goods to be described in terms of model numbers.

ESTON 1
ESTON 2
ESTON 3

Application filed in Class 9 for “Colour printers; computer printers; photo printers”.

Example 4.15.1

In Example 4.15.1 above, the three marks are acceptable as a series. The word “ESTON” is distinctive and can clearly be interpreted as being the house mark in all three marks. The addition of the numbers behind “ESTON” does not substantially alter the identities of the marks given that the numbers merely indicate the models or serial numbers of the claimed goods. The marks therefore qualify as a series of three marks.

However, there are marks wherein the house mark is not distinguishable from the numbers and is considered an integral rather than a separate element from the numerals. In such cases, the identity of each mark will reside in the specific combination of letters and numbers in the marks. Each mark may be perceived as a whole to be a product model or serial number, which typically consists of a string of letters and numbers. We will be cautious in allowing the registration of a series of serial and model numbers if we assess that the application may be an attempt to protect a wide array of product model or serial numbers. The following example illustrates an unacceptable series of marks based on this principle:

IN01
IN02
IN03

Example 4.15.2

4.16. Indication of business entity

A series mark cannot consist of a trade mark on the one part and the same trade mark with an indication of its business entity on the other part.

Carolina
Carolina Private Limited

Example 4.16.1

In Example 4.16.1 above, the two marks are not acceptable as a series. The first mark would be regarded as an individual's name whereas the second mark refers to a business entity (i.e. a Private Limited company). Hence, the two marks are conceptually different and do not qualify as a series.

Where the marks in an application differ as to indications or types of business entities, the marks would not be acceptable as a series. The marks do not qualify as a series as they possess different conceptual identities.

Carolina Private Limited
Carolina Pte. Ltd.
Carolina LLP

Example 4.16.2

In Example 4.16.2 above, the three marks are not acceptable as a series. The first and second marks are seen as reference to the same business entity (i.e. a Private Limited company), whereas the third mark refers to a different business entity (i.e. a Limited Liability Partnership). Consequently, the third mark is conceptually different from the first and second marks. Only the first and second marks are acceptable as a series of two marks.

4.17. Domain names

A series mark cannot consist of a trade mark on one part and a domain name or an Internet address on the other part.

Although a domain extension (e.g. “.com”, “.com.sg”, “.gov.sg”, or “.org.sg”) lacks distinctive character, the addition of a domain extension at the end of a trade mark changes the identity of that mark from a word(s) to an Internet address. The primary function of an Internet address is to locate a website and this is how most people would regard an Internet address when they see one. Hence, the addition of a domain extension may substantially affect the identity of the mark.

ipos
ipos.gov.sg

Example 4.17.1

In Example 4.17.1 above, the two marks are not acceptable as a series. The identity of the first mark is “ipos”, whereas the second mark indicates an Internet address due to the presence of the domain extension “.gov.sg”. Hence, the two marks are conceptually different and do not qualify as a series.

4.17.1. Well-known/common domain extensions

Marks consisting of Internet domain names with different domain extensions may form a series of marks if the domain extensions are well-known and easily recognisable and the marks as

wholes point to the same entity (e.g. the same commercial organisation or government organisation). The following examples are acceptable series marks:

WEBSITE.COM
WEBSITE.CO.UK

Example 4.17.1.1

ipos.com
ipos.com.sg

Example 4.17.1.2

4.17.2. Uncommon domain extensions

The average consumers generally do not recognise an Internet domain name with uncommon domain extension as an Internet address. Hence, a mark which contains an uncommon domain extension may be regarded to have a different conceptual identity from mark(s) with well-known/common domain extensions. Such marks would not qualify as a series of marks.

CHAPTERNIL.TM.ZA
CHAPTERNIL.COM
CHAPTERNIL.COM.SG

Example 4.17.2.1

In Example 4.17.2.1 above, the three marks are not acceptable as a series. The identity of the first mark is ambiguous as “.TM.ZA” is not a well-known domain extension and the average consumer would be uncertain as to the conceptual identity of the mark. The first mark could also be regarded as three terms separated by full stops. On the other hand, the second and third marks contain the well-known domain extensions “.COM” and “.COM.SG” that point to the same entity and the marks would be easily recognised as domain names. The conceptual identity of the first mark is thus different from that of the second and third marks. Only the second and third marks would qualify as a series of two marks.

4.17.3. Trade marks and domain names

There may be instances where trade marks that would normally constitute a valid series of marks do not form an acceptable series when they are represented as domain names. Generally, Internet addresses are character and case-sensitive, and a specific character string points to a particular source. Variations of the domain names, no matter how minor, would bring about differences to the source of the domain names. Therefore, different domain names do not possess the same identity and would not form a series. This principle is illustrated in the example below:

Acceptable series:

IPOS1
IPOS2
IPOS3

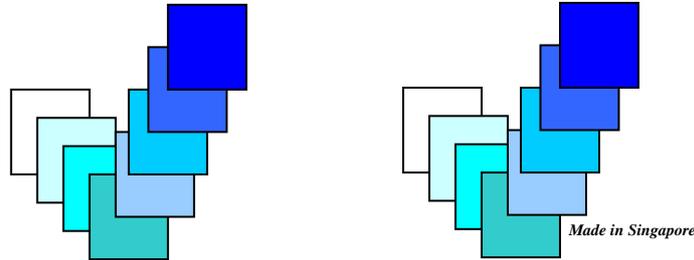
Unacceptable series:

IPOS1.COM
IPOS2.COM
IPOS3.COM

Example 4.17.3.1

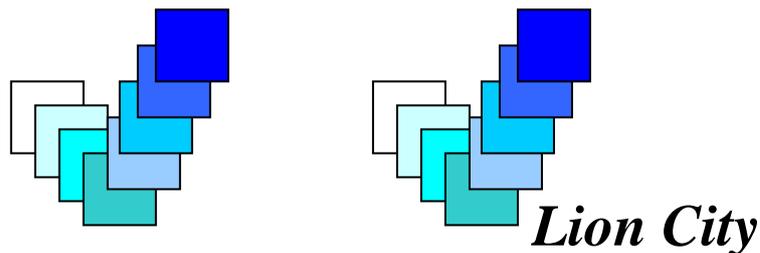
4.18. Geographical components

The addition of a statement containing geographical component(s) to a mark to indicate the geographical origin may not substantially affect the identity of the marks in a series if the statement is non-distinctive and does not add material particulars to the mark.



Example 4.18.1

In Example 4.18.1 above, the two marks are acceptable as a series. The statement “Made in Singapore” in the second mark in the series would be taken as non-trademark matter that merely indicates the geographical origin of the goods. The textual element is not distinctive and its addition does not change the identity of the marks in the series. Therefore, the two marks qualify as a series.



Example 4.18.2

In Example 4.18.2 above, the two marks are not acceptable as a series. Unlike the mark in the Example 4.18.1 with the statement “Made in Singapore”, it is not obvious that the words “Lion City” in the second mark in the example above indicate the geographical origin of the goods or services. The words “Lion City” is a distinctive feature in the second mark. Thus, this introduces material particulars to the second mark which renders it substantially different from the first mark. Therefore, the two marks do not qualify as a series.

4.18.1. Geographical names

Geographical names added to distinctive words may be regarded as making no substantial difference to the identities of the marks, if the geographical names are clearly descriptive of the goods or services claimed in the application.

**PLOED’S NEW YORK
PLOED’S PARIS
PLOED’S LONDON**

Application filed in Class 16 for “Travel guides”.

Example 4.18.1.1

In Example 4.18.1.1 above, the three marks are acceptable as a series. The common element in the three marks “PLOED’S” is a coined term of high distinctiveness. When the marks are applied onto the claimed goods “travel guides”, the geographical names “NEW YORK”, “PARIS” and “LONDON” merely denote the subject matter of the goods (i.e. the travel guides are for the locations New York, Paris and London respectively). Given that the geographical names do not contribute any substantial difference to the identities of the marks, the three marks qualify as a series.

Where it is not obvious that the geographical names in the marks are descriptive of the goods or services claimed in the application, the identities of the marks would be assessed as a whole, i.e. the geographical names would not be regarded as being purely informative matter. Hence, if the inclusion of the geographical names substantially affects the identities of the marks, the marks would not qualify as a series.

**NORTH POLE BANANAS
ANTARCTIC BANANAS**

Application filed in Class 31 for “Fresh bananas”.

Example 4.18.1.2

In Example 4.18.1.2 above, the two marks are not acceptable as a series. The common element in the two marks is the word “BANANAS”, which is descriptive of the goods claimed in the application. It is not obvious that the geographical names “NORTH POLE” and “ANTARCTIC” in the marks denote the geographical locations from which the goods originate, given that bananas are not known to be produced in the North Pole and the Antarctic. The geographical name in each mark therefore contributes distinctiveness to the mark as a whole. Consequently, the two marks “NORTH POLE BANANAS” and “ANTARCTIC BANANAS” are distinctive marks with separate identities, and would not qualify as a series.

5. Examination of applications which face series mark objections

Where an application does not comprise marks in a series, the trade mark examiner would raise a series mark objection against the application. The examiner may, where practical, indicate in the examination report whether any of the marks in the series applied for could be accepted as a series, and if so, which of the marks would form a series.

To overcome the series mark objection, the applicant may choose to:

- (a) Retain only the marks that constitute a series in the mark representation and remove the other marks. The series mark claim should also be amended accordingly; or
- (b) Retain only a single mark in the mark representation and remove the other marks. The series mark claim should also be deleted.

The applicant should effect the above amendments via Form TM27 with the requisite fee. A representation of the mark(s) intended to be retained in the application should also be submitted in the Form TM27 for the Registry to replace the existing representation.

Once a mark has been removed from a series in the application, the removed mark cannot be reinstated unless there are circumstances which allow the Registrar to treat the matter as a correction of irregularity in procedure under Rule 83 of the Trade Marks Rules.

6. Where absolute grounds objections for refusal of registration have been raised

In examining the trade mark application for absolute grounds for refusal of registration (i.e. under Section 7 of the Trade Marks Act), the examiner may raise an objection in respect of one or more marks in the series.

In such cases, the applicant must overcome the absolute grounds objection before the series of marks may be accepted for publication. The applicant may also consider deleting the objectionable mark(s) from the series to overcome the series mark objection.

7. Series of marks with priority claims

An application may be filed in Singapore for a series of marks with priority claim(s) for only one mark or for multiple marks in the series, based on one priority application in a Convention country or more than one priority applications in multiple Convention countries.

For more information on priority claims, please refer to the chapter on “Priority Claims” in our Trade Marks Work Manual.