

# **“Making a Mark” – The Importance of Trademarks in Establishing a Distinct Identity in the Market Place**

**Training of the Trainers Program on Effective  
Intellectual Property Asset Management by  
Small and Medium Sized Enterprises (SMEs)**

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# Important Concepts

- What is a trade mark?
- A Trade Mark is a sign used by a person in the course of business to identify its goods or services and to distinguish his goods or services from those of others.
- A trade mark may be registered or not registered.

# Important Concepts

- A Registered Trade Mark is a mark that confers on the trade mark owner exclusive rights as granted to him under the governing Act. For example, in Singapore, it is the Trade Marks Act 1998 (“TMA”).
- These marks are found on the Trade Mark Register maintained at the national Trade Mark Registry.

# Important Concepts

- It is not compulsory to register a trade mark in order to use it.
- But, a trade mark registration adds great value to a business.
- By filing for trade mark registration, the trade mark owner obtains a right to ownership and the right to prevent others from using a similar mark without his permission.

# Important Concepts

- Trade marks, trade names and business identifiers
- All share a commonality in that they are all comprised of signs used by traders in the course of trade but there exists subtle differences between them.
- Trade marks are signs that traders use to distinguish their goods or services from those of others.
- Trade names refer to names used by traders in the conduct of a business or a profession. Trade names may include business names and company names.
- Sometimes, the trade name of a business is also the trade mark which is used in relation to the goods or services offered for sale under the business undertaking, but this need not always be the case.
- Business identifiers are like trade names as they are also used to identify any business.

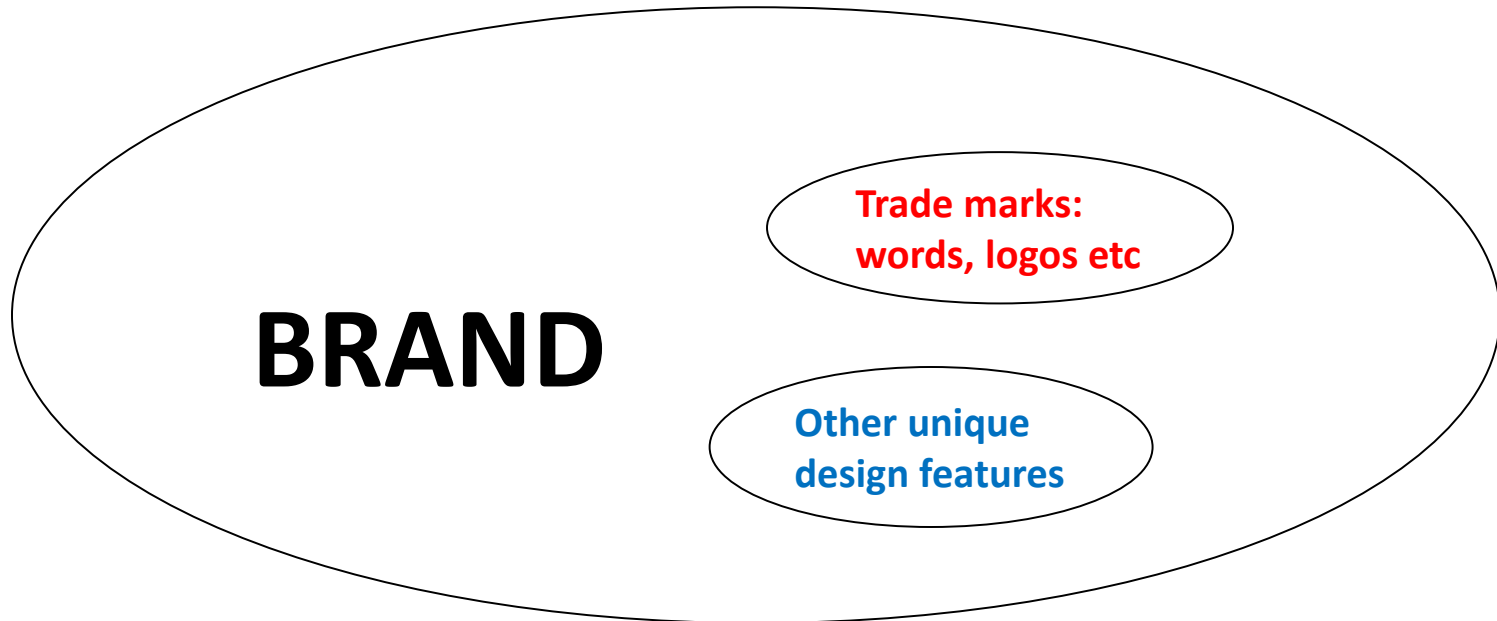
# Important Concepts

- Example
- “Apple Inc.” is a trade name for the American multinational company (that designs and sells consumer electronics, computer software, and personal computers) which grew out of the company first established on 1 April 1976 by Steve Jobs, Steve Wozniak, and Ronald Wayne to sell Apple personal computers.
- The word APPLE in the trade name is also one of the trade marks adopted by Apple Inc. to market and sell its personal computers. Besides the word mark APPLE, the company also owns the device mark below as well as other trade marks such as iPhone, iPod and iPad for other electronic and computer devices.



# Important Concepts

- Trade marks and brands



- Some brands have become cultural icons; “a representative symbol, especially of a culture or a movement; a person or an institution considered worthy of admiration or respect” and command a cult following, examples include “COCA-COLA”; “APPLE COMPUTER” and “HARLEY DAVIDSON”.

# Important Concepts

- Ways of exploiting a registered trade mark:
  - use it to better protect his market share (i.e. his profits) by barring others from copying;
  - license it to third parties for commercial returns (e.g. through a franchise);
  - sell the mark outright for a specified value (e.g. in a company acquisition);
  - use the mark to raise equity for his business undertakings.



# Identifying a Registered Trade Mark

- ® and ™ are common symbols associated with trade marks.
- ® indicates that the mark is a registered trade mark and hence protected under the trade mark law.
- ™ is just a symbol used to indicate that the mark is being used by the company as a trade mark.
- It does not denote that the mark is registered nor protected under the trade mark law.

# International Dimensions

- Trade Marks are territorial in nature
- Registration in the national states
- International Trade & International Registration
- Paris Convention 1883
  - Apply principle of national treatment i.e. to treat foreign nationals of contracting states as they would their own nationals
  - Protection of foreign marks

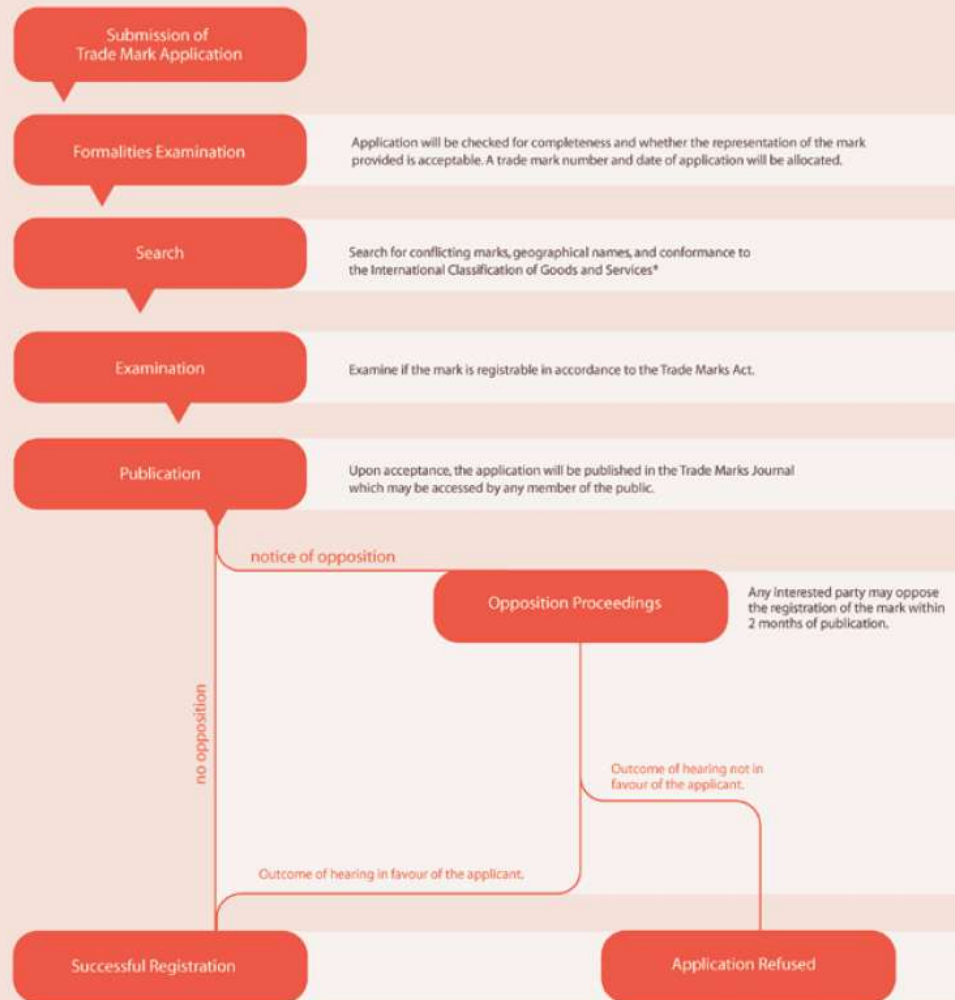
# OBTAINING PROTECTION FOR YOUR TRADE MARKS

## REGISTRATION

# Four Important Criteria

- **Bona Fide Intention to Use Mark.**
- **Satisfy the definition of a Trade Mark under the TMA.**
- **Must not fall within any of the absolute grounds for refusal: Distinctiveness, Deceptiveness, Good Faith and Related Objections**
- **Must not fall within any of the relative grounds for refusal: Conflicts with Earlier Marks or Earlier Rights.**

## Flowchart of a Trade Mark Application



Source: IPOS website

# How to Choose a Trade Mark for your Business?

# Registered Trade Marks

A "trade mark" is defined as:

- any sign;
- Which is **capable of being represented graphically**;  
and
- which is **capable of distinguishing goods or services** dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.
  - Section 2(1) TMA

# Registered Trade Marks

- What is a “sign”?
  - It includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof.
  - Section 2(1), TMA
- The categories listed in the definition are illustrative only.



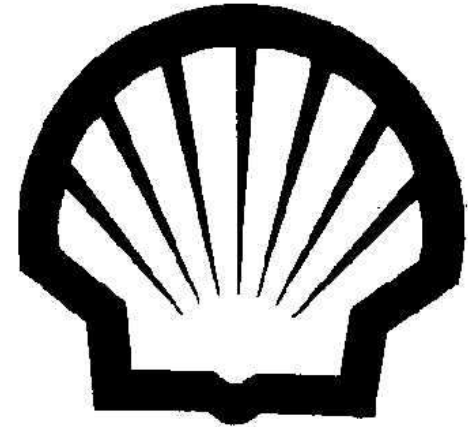
# Signs

- Word
- Pictorial/Graphic/Device
- Colour
- Shape of goods and aspect of packaging
- Smell
- Sound
- Gestures/Moving signs
- Holograms
- Interior décor
- Buildings
- Grilles

# DIFFERENT TYPES OF TRADE MARKS



**BP**



**NUS**



**APPLE**

# Registrable Trade Marks

- For a trade mark to be registered, it must be -
  - (a) capable of being represented graphically; and
  - (b) distinctive i.e. capable of distinguishing the goods and/or services of the owner from similar goods and/or services of other traders.

# Registrable Trade Marks

- **Capable of being represented graphically – not all signs can satisfy this requirement**
- Conventional Trade Marks – words, letters, numerals, pictorial devices and others.
- Non-conventional Trade Marks – shape, colours, smells, sounds and others. Are these signs capable of being represented graphically?

# Non-Traditional Marks

- Three-Dimensional Marks



# Non-Traditional Marks

- Color Marks



The mark comprises the shade of yellow Pantone No. 1225

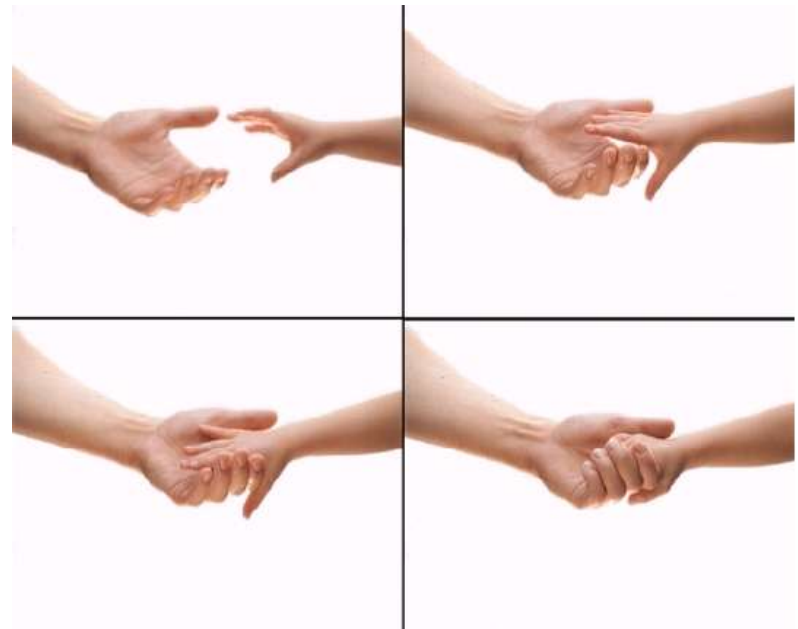
# Non-Traditional Marks

- Hologram Marks



# Non-Traditional Marks

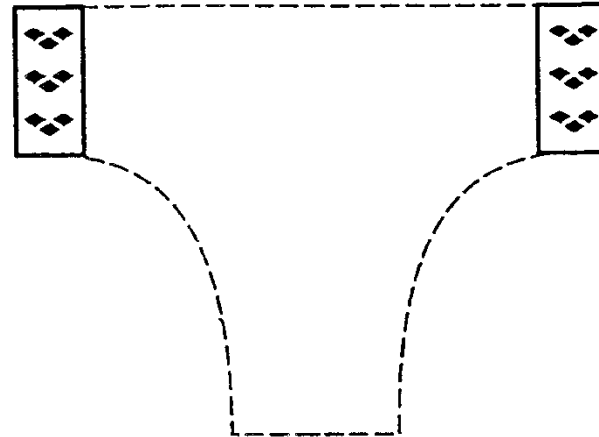
- Motion or Multimedia Marks





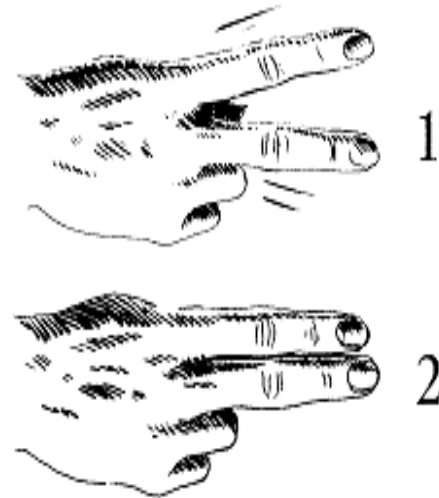
# Non-Traditional Marks

- Position Marks



# Non-Traditional Marks

- Gesture Marks



# Non-Traditional Marks

- Sound Marks
- Musical works
- Naturally occurring sounds



# Non-Traditional Marks

- Olfactory Marks
- Taste Marks
- Texture/Feel Marks

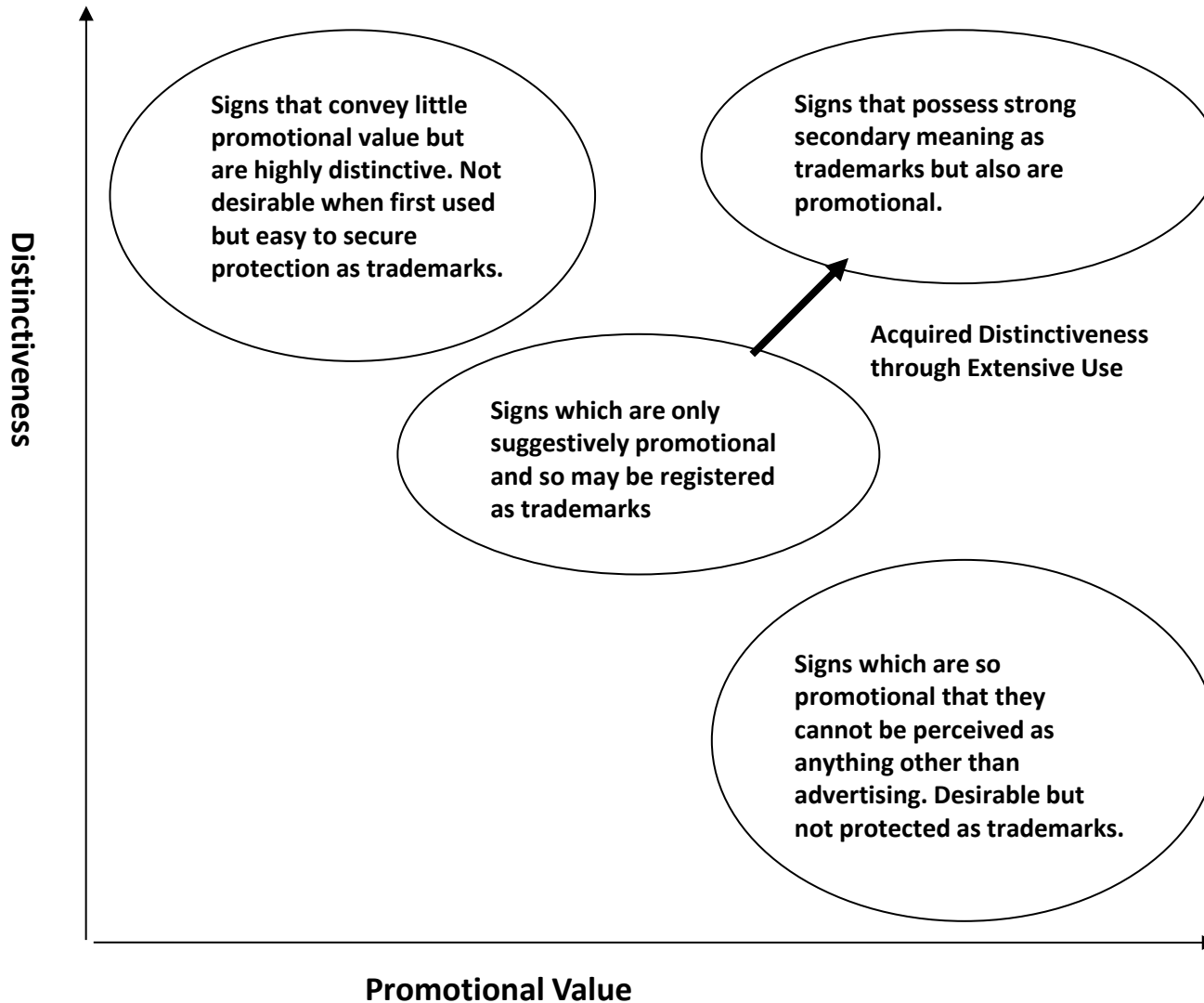
*See WIPO/STrad/INF/4*

# Registrable Trade Marks

- Marks must be **distinctive**
- **Different levels of distinctiveness:**

<p><b>Inventive or Fanciful</b> Examples: <b>KODAK; EXXON;</b> <b>GOOGLE;</b> a leaping tiger'; 'an eagle with wide-spread wings'; 'an axe'; a uniquely designed logo; a one-of-the-kind signature; and an arbitrary combination of numerals or letters.</p>	<p><b>Arbitrary</b> Examples: '<b>APPLE</b>' for computers;  '<b>SHELL</b>' for petroleum and other chemical products</p>	<p><b>Suggestive</b> Examples: '<b>BONUS GOLD</b>' for investment account services;  '<b>LOVE</b>' for jewellery</p>	<p><b>Descriptive</b> Examples: '<b>EASY CREDIT</b>' for financial services;  '<b>DOUBLEMINT</b>' for chewing gum;  '<b>ASIA'S GLOBAL BUSINESS SCHOOL</b>' for education services  Extreme example: <b>SOAP</b> for soaps</p>
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# PROMOTION VALUE vs DISTINCTIVENESS



# Signs to Avoid

# Non Registrable Trade Marks -Descriptive Marks

- Marks that describe the goods and services of the business.
- For instance, marks that describe the quality ('Super' or 'Best'), quantity ('One dozen'), value ('Cheap'), intended purpose ('Cleaner'), or geographical origin.



# Non Registrable Trade Marks - Marks 'Common to the Trade'

- Marks that are signs or indications that are or have become customary in the trade.
- Some marks have become so well accepted that the term is used to describe the type of the goods or services in general, and no longer serves to distinguish the products offered.
- Examples of trade marks that have become customary in the industry is “ESCALATOR”; “SHREDDED WHEAT”; “LINOLEUM” and “GRAMOPHONE”

# Marks devoid of distinctiveness; descriptive marks; marks common to the trade

- These marks can only be registrable if factual evidence is adduced to prove that they are able to distinguish goods or services.
- This means the consumers see the sign as a badge of origin.
- Example in *Love & Co Pte Ltd v The Carat Club Pte Ltd* (2009) (Singapore High Court)
- ‘LOVE’ for jewellery - has it acquired a factual distinctiveness in respect of the goods or services for which it is registered?
- Singapore High Court held that it had not.

# Non Registrable Trade Marks - Marks Contrary to Public Policy or Morality

- Marks that are generally contrary to public policy or morality.
- For example, a mark that could promote immoral behaviour cannot be registered.

# Non Registrable Trade Marks - Deceptive Marks

- Marks that attempt to deceive the public. For example, marks that misrepresent the nature, quality or geographical origin of the goods or services.

# Non Registrable Trade Marks - Marks that are Identical to Earlier Marks

- A trade mark will not be registered if it is identical with an earlier mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier mark is protected.
- Attaining priority in registration is therefore important.

# Non Registrable Trade Marks - Marks that could Cause Confusion

- A trade mark may not be registered if it is likely to cause the public to be confused under these circumstances:
- it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier mark is protected;
- it is similar to an earlier trade mark and is to be registered for goods or services identical with those for which the earlier mark is protected; or
- it is similar to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.

# Non Registrable Trade Marks - Marks that are Identical/Similar to Well Known Marks

- A trade mark may not be registered if it is identical or similar to an earlier mark that is well known in Singapore in respect of identical, similar or dissimilar goods.

# Use in the Course of Trade

- Trade Marks must be used in relation to goods or services in the course of trade
- Cannot register trade marks in a vacuum
- Must register trade marks in relation to specifications of goods or services
- Example TREAT for “dessert sauces and syrups; all included in Class 30”



# Classification of Goods and Services

- The scope of a trade mark registration is determined by the goods or services in relation to which the trade mark is registered.
- For the purpose of trade mark registration, Singapore uses the International Classification of Goods and Services as prescribed by the Nice Agreement to classify trade mark registrations.
- The Nice Agreement is an international agreement on classification of goods and services to which Singapore is a party.
- This classification sets out the list of goods and services for which the applicant may wish to register for in relation to his trade mark.
- The list groups these goods and services into classes in which these goods and services belong.
- There are a total of 34 classes of goods and 11 classes of services.

# Use of the Trade Mark

- **Bona Fide Intention to Use Mark.**
  - An applicant for trade mark registration under the 1998 Act must show that the trade mark seeking registration has been used by the applicant to distinguish goods or services or there is a bona fide intention on the part of the applicant to so use the trade mark.
  - **Non-use of a trade mark**
  - Grounds for the mark to be revoked
- **Inappropriate use or wrong use of a trade mark**
  - Trade mark may become generic and loses its distinctiveness. Grounds for revocation.

# Exclusive Rights

- A registered trade mark does not give a right to the proprietor to use, only a mere right to exclude.
- Therefore, he may not override passing off rights, another registered trade mark or an earlier competing right.

# Exclusive Rights

- Registered trade marks rights are territorial in nature. Registration is required for each country in which the owner seeks protection.
- Any alleged infringement of the registered trade mark rights must be committed in Singapore to be actionable.
- An act done outside Singapore without the proprietor's consent does not constitute an infringement of a trade mark registered in Singapore.

# Trade Mark Term

- 10 years from date of registration, and renewable for further periods of 10 years
- Trade marks are in essence **perpetual rights** provided they are used in relation to the goods or services for which they are registered.

# Trade Marks which are not registered

- For a mark that is not registered, the owner can only rely on the common law action of "passing off" to protect his mark against imitation or infringement.
- Must prove goodwill; misrepresentation and damage.
- The requirement of proving reputation and goodwill may pose some problems where the business, or the use of the trade mark, has not been established for a substantial period of time.

# Well Known Marks

- Compared to other trade marks, well known trade marks are accorded with additional enhanced protection.
- New anti-dilution rights.
  - Dilution
  - Takes unfair advantage of the distinctive character of the well known mark

# Well Known Marks

- ‘well known mark’ means –
  - (a) any registered trade mark that is well known in Singapore; or
  - (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who –
    - (i) is a national of a Convention country; or
    - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore.



# Well Known Marks

- The criteria for determining whether a mark is well known in Singapore:
  - The degree of knowledge or recognition of the mark by the relevant sector of the public in Singapore;
  - The duration, extent and geographical area of any use of the mark;
  - The duration, extent and geographical area of any promotion of the mark, including advertising or publicity;
  - any registrations or applications for registration of the trade mark in any country or territory in which the trade mark is used or recognised and the duration of such registration or application;
  - any successful enforcement of rights in the trade mark in any country or territory, and the extent to which the trade mark was recognized as well known by competent authorities of that country or territory;
  - any value associated with the mark.

# Concept of Trade Mark Dilution

- “Dilution”
  - “the *lessening of the capacity of the trade mark to identify and distinguish goods or services*, regardless of whether there is (a) any competition between the proprietor of the trade mark and any other party; or (b) any likelihood of confusion on the part of the public.”

# Concept of Trade Mark Dilution

- Legal jurisprudence in Europe and in the United States has essentially categorized dilution into at least two broad categories: (a) blurring and (b) tarnishment.
  - Dilution by blurring is often described by the courts as the “whittling away” of a well known mark’s distinctiveness. Example, ‘Rolls Royce’ applied to watches, clothes, restaurants, chocolates etc.
  - Dilution by tarnishment on the other hand refers to the degradation of a mark’s positive image or associations when it is used in relation to goods or services of an inferior quality, immoral or obscene nature.

# Well known mark cases in Singapore



## Nutella v Nutello

# Well known mark cases in Singapore



## Louis Vuitton v City Chain

# WHEN IS A USE OF ANOTHER'S TRADE MARK NON-INFRINGEMENT?

# Acts Not Amounting to Infringement

- (1) Use of own name in accordance with honest practices in industrial and commercial matters ;
- (2) Use of a sign to indicate certain descriptive characteristics of goods or services (such as the kind, quality ... etc) in accordance with honest practices in industrial and commercial matters;
- (3) Use of the registered trade mark to indicate the intended purpose of goods (in particular as accessories or spare parts) or services in accordance with honest practices in industrial and commercial matters;
- (4) Fair Use in Comparative Commercial Advertising or Promotions;
- (5) Non-Commercial Use;
- (6) News Reporting or News Commentary;
- (7) Exhaustion of rights

**Thank You!**  
**Questions?**