

## Singapore's comments in relation to the areas of convergence identified in document SCT/35/4

Singapore's comments in relation to the areas of convergence discussed in the Protection of Country Names Against Registration and Use as Trade Marks are set out in the following paragraphs.

### **1. Area of Convergence No. 1 (Notion of Country Name)**

*At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.*

#### **1.1 Legal Basis of Trade Mark Protection**

The legal basis of trade mark protection in Singapore includes:

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

and other subsidiary legislation to the Trade Marks Act.

#### **1.2 References to Terms "Country" and "Geographical Origin"**

Trade marks legislation in Singapore does not define the term "country". Instead, there are references to the term "geographical origin" in the Trade Marks Act. While the absolute grounds of refusal includes references to the term "geographical origin", the term "geographical origin" is also not defined further.

The references to the term "geographical origin" are made in section 7(1)(c) and section 7(4)(b) of the Trade Marks Act as follows:

**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;

...

—(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).

Given that the term "country" is not defined in Singapore's trade marks legislation, it is unclear whether country names would include "the official or formal name of the country, the name that is in common use, translation and transliteration of that name, the short name of the country, as well as use of the name in abbreviated form and as an adjective".

Singapore's obligations under Article 6<sup>ter</sup> of the Paris Convention are enshrined in section 56 of the Trade Marks Act. The section provides that a trade mark which consists of or contains the armorial bearings or any other state emblem of or an official sign or hallmark adopted by a Paris

Convention or WTO member country shall not be registered without the authorisation of competent authorities. In implementing section 56 of the Trade Marks Act, Singapore is guided by document SCT/15/3, and understands that the protection under Article 6*ter* (and the corresponding section 56) is limited to “armorial bearings, flags, State emblems as well as official signs and hallmarks indicating control and warranty adopted by States”. Country names, however defined, appear to be specifically excluded from protection under Article 6*ter* (and the corresponding section 56).

### **1.3 Practical Concerns**

Singapore has practical concerns relating to the inclusion of the country name that is in common use, translation and transliteration of the country name, the short name of the State, as well as use of the country name in abbreviated form as part of the definition of “country name”, as it is difficult in practice to ascertain what these could be.

Presently, in determining whether a country name is objectionable in the course of examination of an application for trade mark registration, a trade mark examiner would rely on general internet searches and WIPO’s Article 6*ter* Structured Search (<http://www.wipo.int/ipdl/en/6ter/>).

However, Singapore is of the view that the general internet searches may not yield comprehensive results on the translation and transliteration of the country name, as there are many languages and hence possible transliterations of a country name. Also, we note that countries generally have multiple short names, names that are in common use, and abbreviations of their country names. For instance, some short names and common names for the Republic of Singapore include “Singapore”, “Singapura” and “Lion City”, and common abbreviations used to refer to Singapore include “SG”, “SGP” or “SIN”. Therefore, searches may not yield all the possible short names, common names or abbreviations of a country name.

### **1.4 Proposal**

If the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) intends to proceed with mandatory protection of country names against registration and use as trademarks, WIPO may wish to consider creating a centralised database to house “the official or formal name of the country, the name that is in common use, translation and transliteration of that name, the short name of the country, as well as use of the name in abbreviated form and as an adjective” of the countries the protection applies to, for IP Offices to refer to in the course of examination of applications for trade mark registrations.

## 2. Area of Convergence No. 2 (Non-registrable if Considered Descriptive)

*At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.*

### 2.1 Absolute Grounds for Refusal of Registration for Marks which are Descriptive or Non-Distinctive

Under section 7(1)(b) of the Trade Marks Act, a trade mark which is devoid of any distinctive character shall not be registered.

Under section 7(1)(c) of the Trade Marks Act, a trade mark comprising country name would be refused registration if it is found to consist exclusively of signs or indications which may serve, in trade to designate the geographical origin of goods or of rendering of services.

The objections in section 7(1)(b) and (c) can be overcome if the trade mark, before the date of application of registration, has in fact acquired a distinctive character as a result of the use of it, under section 7(2) of the Trade Marks Act.

### 2.2 Examination Practices

In practice, Singapore's examination practices for marks comprising names denoting geographical locations (i.e. geographical names) can be found in Chapter 5 of our Trade Marks Work Manual on "Geographical Names" (available at <https://www.ipos.gov.sg/AboutIP/TypesofIP/WhatIsIntellectualProperty/WhatIsatrademark/Trademarkresources.aspx>).

In summary, where the geographical location has a reputation for the goods or services listed in the application or closely related goods or services, the application for registration of a trade mark comprising of the name of that geographical location will be refused.

#### 2.2.1 Examination Practices for Marks comprising Geographical Names on Goods which are Natural Produce

Particularly, Singapore's stand would be stricter for application of goods which are natural produce. The names of places, which because of their characteristics, are likely to be the source of natural produce are unlikely to be registrable. The following is an example of a mark filed in Singapore:

Mark Detail	Decision
<p>Singapore Trade Mark No. 40201505876V</p> 	<p>Objectionable.</p> <p>The mark is descriptive of the geographical origins of the goods applied, indicating that they are from New Zealand ("NZ"). New Zealand is the world's largest exporter of dairy commodities, representing approximately one third of the international dairy trade each year.</p>

<p>Goods applied for: Class 29 Dairy products; cheeses of all types; cheese and dairy spreads; milk and milk products; protein for human consumption.</p>	
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**2.2.2 Examination Practices for Marks comprising Geographical Names on Goods and Services (Other than Natural Produce)**

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 a geographical location and
- (ii) the goods and services with which the place is currently associated.

Applying these criteria, 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, such as financial services, entertainment or travel and accommodation.

The following are examples of marks filed in Singapore which illustrate the above principles:

Mark Detail	Decision
<p>Singapore Trade Mark No. T1416495A</p>  <p>Australian Migration Agents</p> <p>Services applied for: Class 45 Migration agent services (immigration and immigrant services).</p>	<p>Acceptable.</p>
<p>Singapore Trade Mark No. 40201509620T</p>  <p>DARLING DOWNS - WAGYU - AUSTRALIA</p> <p>Services applied for: Class 35 Wholesaling and retailing of food including but not limited to meat, meat extracts, fish,</p>	<p>Acceptable.</p>

<p>poultry and game; wholesaling and retailing of meat and beef including wagyu beef.</p>	
<p>Singapore Trade Mark No. 40201505398Q</p> <p style="text-align: center;"><b>THAI TOWN</b></p> <p>Services applied for:</p> <p><u>Class 35</u> Advertising; Sales promotion (for others); Import-export agencies; Business inquiries; Commercial information agencies; Business management and organization consultancy; Professional business consultancy; Auctioneering; Commercial administration of the licensing of the goods and services of others; Marketing.</p> <p><u>Class 43</u> Canteens; Restaurants; Tea room services; Providing food and drink; Cafes; Bar services; Hotels; Self-service restaurants; Food and drink catering; Snack-bars; Rental of cooking apparatus.</p>	<p>Acceptable.</p>
<p>Singapore Trade Mark No. T1205498I</p> <p style="text-align: center;"><b>MOZAMBIQUE GAS</b></p> <p>Goods and services applied for:</p> <p><u>Class 4</u> Crude oil, natural gas and liquid natural gas.</p> <p><u>Class 40</u> Energy production services.</p> <p><u>Class 42</u> Energy exploration services, namely, exploration services in the fields of oil, gas, liquid natural gas and other hydrocarbons.</p>	<p>Objectionable.</p> <p>The mark is descriptive of the origin of the goods and denotes that the services are provided in relation to such goods.</p>

### 2.3 Overcoming Absolute Grounds Refusals on basis of 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. 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, such as the United States of America, the United Kingdom, France or China.

### 3. Area of Convergence No. 3 (Non-registrable if Considered Misleading, Deceptive or False)

At least for the purposes of examination, trademarks consisting of or containing a country name should be refused where the use of that name renders the mark as a whole misleading, deceptive or false in relation to the origin of the goods or services.

#### 3.1 Absolute Grounds for Refusal of Registration for Marks which are Deceptive

Under section 7(4)(b) of the Trade Marks Act, a trade mark comprising country name would be refused registration if it is found to be of a nature as to deceive the public, for instance, as to the geographic origin of the goods or services.

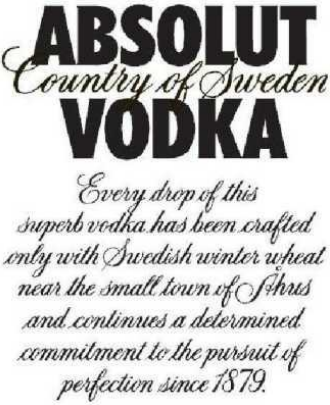

#### 3.2 Examination Practices



In practice, Singapore's examination practices for marks comprising geographical names can be found in Chapter 5 of our Trade Marks Work Manual on "Geographical Names" (available at <https://www.ipos.gov.sg/AboutIP/TypesofIP/WhatIsIntellectualProperty/Whatisatrademark/Trademarkresources.aspx>).

##### 3.2.1 Examination Practices for Marks comprising Geographical Names used in relation to Goods

In relation to goods, the use of a geographical name in a trade mark would lead consumers to view the mark as an indication of the source of the goods and would be objectionable if the goods do not originate from the location. However, if the geographical name in the trade mark appears merely to be a fanciful association, this would be acceptable.

The following are examples of marks filed in Singapore which illustrate the above principles:

Mark Detail	Decision
<p>Singapore Trade Mark No. T1207452A</p>  <p>Goods applied for: Class 33 Alcoholic beverages (except beers).</p>	<p>Objectionable.</p> <p>The mark will lead consumers to believe that the goods on which the mark is applied are vodka originating from Sweden.</p> <p>Application was only accepted after the specification of goods was restricted to "Alcoholic beverages, <u>namely, vodka originating from Sweden</u>".</p>
<p>Singapore Trade Mark No. T1413659A</p>  <p>Goods applied for: Class 30 Chocolate.</p>	<p>Objectionable.</p> <p>The mark will lead consumers to believe that the goods on which the mark is applied originate from Switzerland.</p> <p>Application was only accepted after the</p>

	specification of goods is restricted to “Chocolate <u>originating from Switzerland</u> ”.
<p>Singapore Trade Mark No. T1408076F</p>  <p>Goods applied for: <u>Class 23</u> Yarns or thread made wholly or in substantial part of cotton.</p> <p><u>Class 24</u> Fabrics, bed sheets, pillowcases, bedspreads, towels and bed blankets, comforters, draperies, handkerchiefs, and tablecloths made wholly or in substantial part of cotton.</p>	<p>Objectionable.</p> <p>The term “USA” in the mark is indicative of the geographical origin of the cotton which the goods are made of.</p> <p>Application was only accepted after the specification of goods was qualified with “<u>all made wholly or substantially of cotton originating from USA</u>”.</p>
<p>Singapore Trade Mark No. T1219637F</p>  <p>Goods applied for: Class 25 Clothing, shoes and hats.</p>	<p>Acceptable.</p> <p>Consumers would not regard “Japan” as the geographical origin of the goods, and would consider it as a description of the style or fashion of the goods.</p> <p>The geographical name in the mark is seen as a mere fanciful association.</p>

### 3.2.2 Examination Practices for Marks comprising Geographical Names used in relation to Services

In relation to services, the use of a geographical name in a trade mark is usually more acceptable as it is less likely to be regarded as an indication of the origin of the services. The following is an example filed in Singapore which illustrates this principle:

Mark Detail	Decision
Singapore Trade Mark No: 40201510518Q	Acceptable.



Services applied for: Class 35  
Wholesaling and retailing of food including but not limited to meat, meat extracts, fish, poultry and game; wholesaling and retailing of meat and beef including wagyu beef.



#### **4. Areas of Convergence No. 4 (Consideration of Other Elements of the Mark)**

*At least for the purposes of examination and unless the applicable law specifies otherwise, trademarks consisting of a country name, among other elements, should be refused where the use of that name renders the mark as a whole non-distinctive, misleading, deceptive or false in relation to the origin of the goods or services.*

##### **4.1 Distinctiveness**

For marks containing a country name together with other elements, the mark would be examined as a whole to determine whether it would be distinctive. Hence, such marks containing a country name may not be refused if it is deemed to be distinctive as a whole. Please refer to comments under Point 2 Areas of Convergence No. 2.

##### **4.2 Deceptiveness**

For marks containing a country name together with other elements, the presence of other elements in the mark is not a relevant factor in determining whether the mark would be deceptive. Please refer to comments under Point 3 Areas of Convergence No. 3.

## **5. Areas of Convergence No. 5 (Invalidation and Opposition Procedures)**

*The grounds for refusal described in possible areas of convergence No. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.*

### **5.1 Opposition**

Under section 13 of the Trade Marks Act, any person may, within the prescribed time from the date of publication of the application, give notice to the Registrar of opposition to the registration, by including a statement of the grounds of opposition and other related matter.

The grounds of opposition includes absolute grounds for refusal of registration relating to marks descriptive of the place of origin of the goods or services (possible area of convergence no. 2 and 4) and marks which deceive the public to the geographic origin of the goods or services (possible area of convergence no. 3 and 4).

### **5.2 Invalidation**

Under section 23 of the Trade Marks Act, the registration of a trade mark may be declared invalid on the grounds that the trade mark was registered in breach of absolute grounds for refusal of registration.

Absolute grounds for refusal of registration include marks descriptive of the place of origin of the goods or services (possible area of convergence no. 2 and 4) and marks which deceive the public to the geographic origin of the goods or services (possible area of convergence no. 3 and 4).

## **6. Areas of Convergence No. 6 (Use as a Mark)**

*Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.*

### **6.1 Legal Provision**

The Trade Marks Act does not have provisions for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.