

A Short Guide to

# **TRADE MARKS**

in Singapore

## What are trade marks?

A trade mark is a sign used to identify and distinguish the goods and services produced or provided by one business from the goods and services of other businesses.

Trade marks are valuable intellectual property as, over time, they come to signify not only the actual goods or services but also the reputation of the business. Trade marks therefore play an important role in the branding and marketing strategy of a business.

Words or logos are often used as trade marks. However, unconventional signs such as colours, shapes, product packaging, sounds and smells can also be considered trade marks if they function to identify the source of particular goods or services.

## Why register a trade mark?

If you register your trade mark in Singapore, it will be entered into the Singapore Trade Marks Register, which is administered by the Intellectual Property Office of Singapore (“IPOS”).

Registering your trade mark entitles you to the exclusive right to use the mark for 10 years and prevents your competitors from using or registering a confusingly similar mark.

You can maintain your trade mark registration by renewing the registration for further periods of ten years.

Registration of a trade mark provides direct evidence of your ownership. In a dispute, it is the onus of the challenger, and not the registered owner, to prove ownership.

## Is your mark registrable?

A trade mark is generally registrable if it is capable of distinguishing the goods or services of one business from those of another.

The first category of trade marks that do not have this distinguishing capability are those which are “*devoid of distinctive character*”. The following are examples of marks that would be generally considered unregistrable for this reason:

- ♦ **Descriptive Marks:** These are marks that consist exclusively of references to significant characteristics of the goods or services in question. For example, terms that describe characteristics such as an ingredient (“VANILLA” for ice-cream), an intended purpose (“RELIEF” for pain medication) or the value (“BUDGET” for hotels) of the specified goods or services are likely unregistrable as are qualitative or laudatory terms such as “BEST”. Marks that describe a geographic location associated with goods or services are also unregistrable (“BELGIAN” for chocolate). The rationale behind prohibiting the registration of such marks is that such descriptive signs should be freely available for use by all.
- ♦ **Customary Marks:** marks that consist exclusively of colloquial or generic terms that are commonly used to describe a characteristic of the goods or services may not be registrable. For example, the term “SELFIE” is now commonly used to describe a photograph taken of oneself and is unlikely registrable as a trade mark in relation to computer application software for allowing hands free photographs on portable electronic devices.
- ♦ **Deceptive Marks:** These are misdescriptive marks that are likely to mislead consumers as to the nature, quality or geographic origin of a product (“GERMAN” for audio equipment made in the United States).

Trade marks that are inherently devoid of distinctive character can be registered if it can be shown that, due to use of the mark in the course of trade, consumers have been educated to recognise the mark as an indicator of the source of the good or services provided under the mark. These marks are said to have acquired distinctive character or a secondary meaning through their use.

The second category of marks that are incapable of distinguishing the goods or services of one business from those of another are marks that are “not new” in the sense that they consist of the following:

- ♦ a mark that is identical with or confusingly similar to an already registered trade mark, and registration is sought in respect of goods or services identical with or similar to those specified for the registered mark; or
- ♦ the mark is identical with or confusingly similar to a well-known mark.

### **How can you find out if your trade mark does not conflict with registered trade marks?**

Before filing your trade mark application, you can carry out a trade mark search. Trade mark clearance searches are not compulsory. However, they can help you determine if the mark you have chosen is actually available for use and registration and is not already in use or registered by another business for identical or similar goods or services.

### **When should you file your trade mark application?**

Regardless of whether your trade mark is new or has been in use for some time, there is no time limit as to when you may apply for registration.

A trade mark registration does, however, take effect from the date of filing. Therefore, in the event that your mark conflicts with an identical or confusingly similar mark, it can be vital that, in comparison with the conflicting mark, your application bears the earlier filing date.

If you have filed a trade mark application for the same mark in a country that is a member of the Paris Convention or the World Trade Organisation, you may claim the filing date of the first-filed application provided that the Singapore application is filed within six months from the date of the first filing.

### **What are the basic filing requirements for a trade mark application?**

You will have to complete an application form in which you must furnish the applicant’s name and contact details, a description of goods and/or services in relation to which the mark is to be used and a clear representation of the mark. The application form must be filed together with the prescribed filing fee.

Applications for marks that comprise or contain words in a language other than English will require the additional submission of certified English translations and/or transliterations.

### **What are trade mark classes?**

Your trade mark will be registered in relation to the goods and/or services specified in the trade mark application.

In Singapore, goods and services are grouped into classes in accordance with the International Trademark Classification System, which has 45 classes: 34 classes for goods and 11 for services. Goods and services are grouped according to their areas of trade and each grouping is identified by its class number.

It is important that you carefully consider and identify the goods or services which require protection and ascertain their appropriate classes as rights against infringement extend only to the particular goods or services covered in the specification.

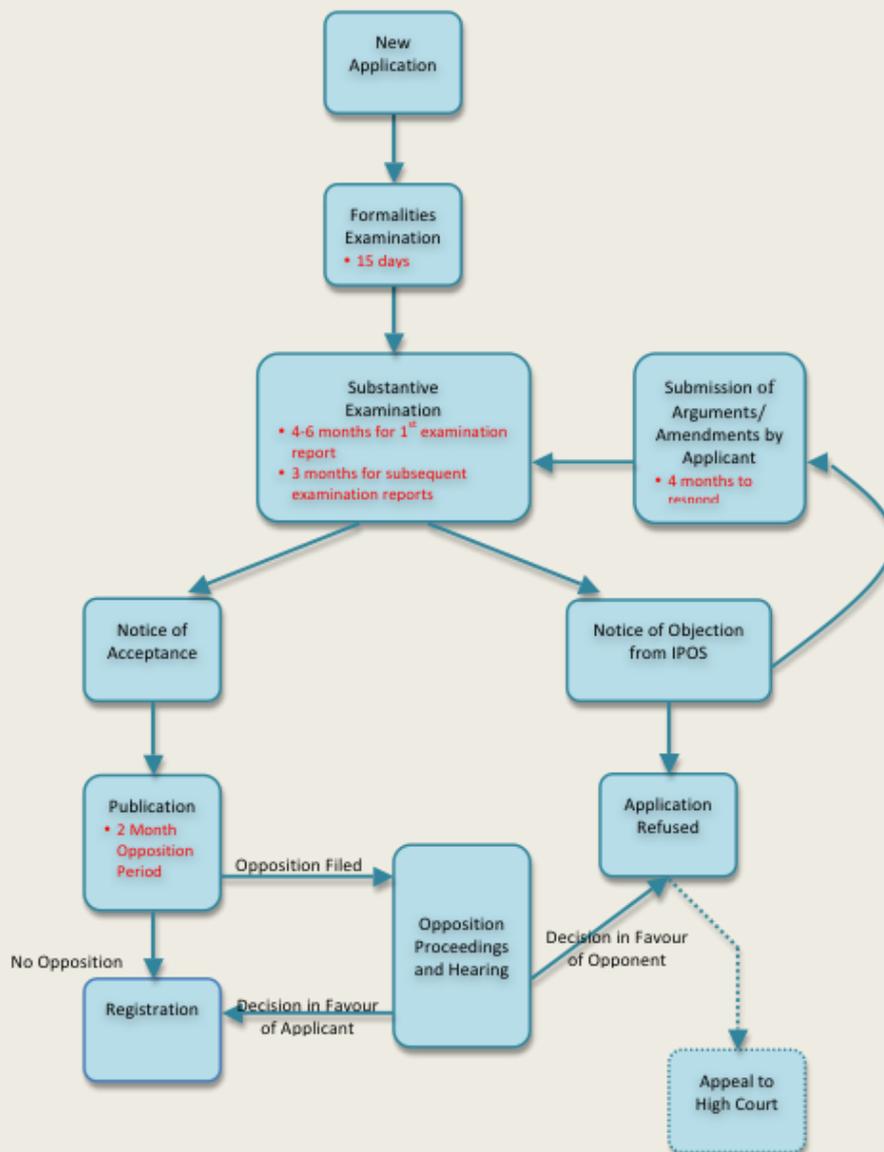
### **What are the steps taken by IPOS after a trade mark application is filed?**

The application will initially undergo a formalities examination to ensure that it complies with the administrative requirements of IPOS. IPOS normally takes around 15 days to review the application and send you an acknowledgment letter allocating the application with a filing date and trade mark number.

The application will then undergo substantive examination. IPOS generally takes from four to six months to issue the initial examination report on the acceptability of the mark for registration. If the mark is not acceptable, the report will set out the objections and you will then be given an opportunity to submit written arguments or propose suitable amendments in response to the Registrar's objections. You will normally be given four months from the date of the Registrar's examination report to file a response.

Once any objections have been overcome, the application will be accepted by the Registrar and advertised in the Trade Marks Journal. Any interested third party has two months following the date of advertisement of the application in which to oppose the registration. If the application is not opposed, the Registrar will issue the Certificate of Registration.

### Trade Mark Registration Procedure in Singapore



## What is the scope of your Singapore trade mark registration?

The legal rights arising from your trade mark registration are limited to the territory of Singapore unless your trade mark can be considered a well-known mark.

The owner of a well-known trade mark can in many countries stop a third party from registering or using an identical or similar mark which (i) dilutes the distinctive character of the well-known mark or (ii) takes unfair advantage of the distinctive character of the well-known mark.

## How can you register your trade mark abroad?

If you wish to commercialise your goods and services in foreign markets, it is highly advisable to register your trade mark abroad. This will allow you to grant licences to others to use your mark and thereby help build a reputation for your brand in other countries.

Once you have registered your mark in Singapore, there are three main ways to register your mark in other countries.

### 1. National Trade Mark Registrations

You may file corresponding applications in the national trade mark offices of each country in which you desire to protect your mark.

If your business has an interest in only a small number of overseas countries, this may be the most cost-effective option.

### 2. Regional Trade Mark Registrations

For businesses operating in the European Union (EU), the Community Trade Mark (CTM) system is a cost effective way of protecting your trade mark across the region.

If the CTM application fulfils certain distinctiveness requirements, it can proceed to

registration. Unlike most national trade mark applications, a CTM application will not be examined on the basis of conflict with existing earlier marks.

A CTM registration will protect your mark in all member states of the EU. It is unitary in nature which means that other trade mark proprietors with earlier national rights in an EU member state may be able to successfully oppose or invalidate the CTM registration in its entirety. However, there are provisions to convert CTM applications into national applications in countries where prior rights do not exist.

Other regional trade mark offices are:

- ♦ African Regional Industrial Property Office;
- ♦ Benelux Trademark Office; and
- ♦ Organisation Africaine de la Propriété Intellectuelle

### International Trade Mark Registrations

The international trade mark system enables businesses to protect their trade marks in any country which has signed the Madrid Agreement or the Madrid Protocol. As Singapore is a signatory to the Madrid Protocol, Singapore businesses may apply for an international registration provided that they have first filed an application for their mark in Singapore.

An international registration is effectively a bundle of separate national rights which can ease administrative burdens associated with separate national filings and with respect to maintaining the separate national rights.

The filing of an application for the international registration of a mark must be accompanied by an application fee and a fee for each designated country. It will then be examined centrally by the World Intellectual Property Office (“WIPO”) before being forwarded to the national trade mark registries of each designated country where it will undergo examination according to the relevant national laws. Each national trade mark office will notify WIPO of the acceptance or rejection of the application.

The information in this guide is intended only as a summary of the subject matter and should not be relied upon as a substitute for professional advice.

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