

# “Making a Mark” – The Role of Trademarks in Branding

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# What is a Trademark?

- **TRIPS Agreement**
- **Article 15**  
*Protectable Subject Matter*
- 1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.
- 2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).
- 3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.
- 4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.
- 5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

# Important Concepts

- A trademark is any **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 trademark may be registered or not registered.

# Signs

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

# Important Concepts

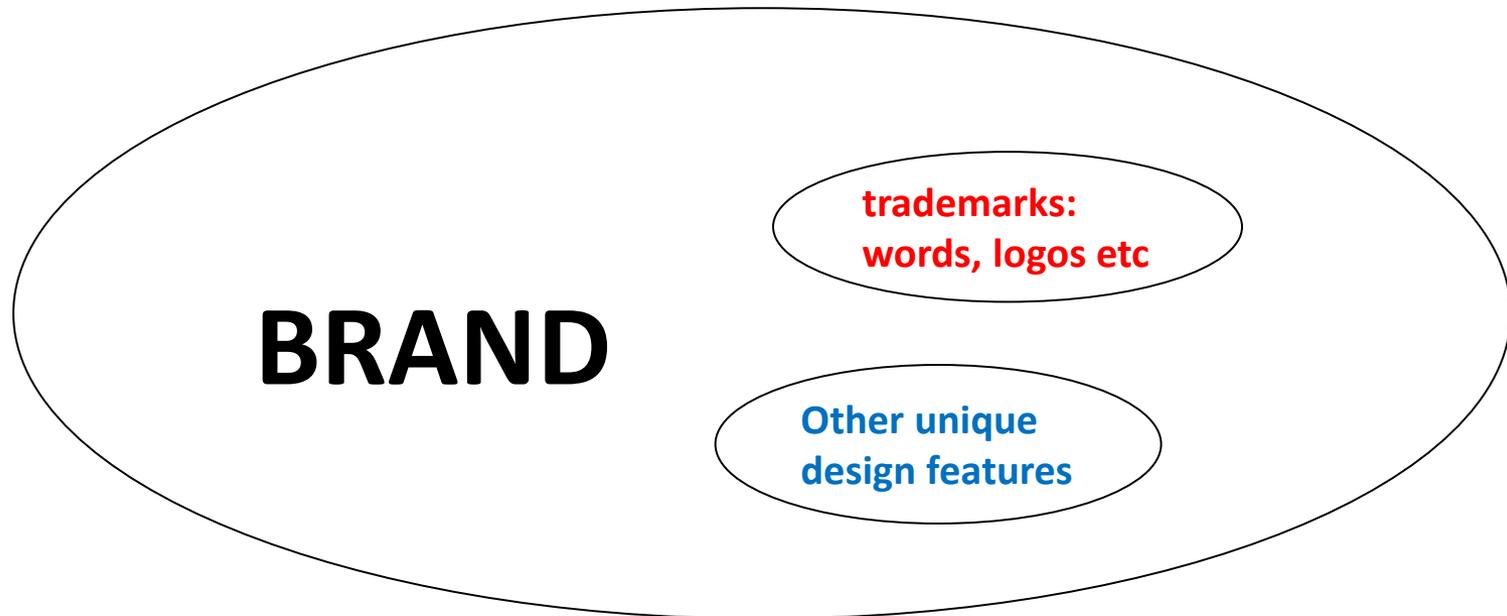
- It is not compulsory to register a trademark in order to use it.
- But, a trademark registration adds great value to a business.
- By filing for trademark registration, the trademark owner obtains a right to ownership and the right to prevent others from using a similar mark without his permission.

# Important Concepts

- Trademarks, 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.
- Trademarks 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 trademark 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

- Trademarks 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 trademark:
  - 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 Trademark

- ® and ™ are common symbols associated with trademarks.
- ® indicates that the mark is a registered trademark and hence protected under the trademark law such as US Lanham Act or Singapore Trademark Act.
- ™ is just a symbol used to indicate that the mark is being used by the company as a trademark.
- As a result of its use, it may be protected for example under the common law of passing off.

# International Dimensions

- Trademarks 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

# Important Trademark Treaties

- Paris Convention
- TRIPS Agreement
- Trademark Law Treaty
- Singapore Trademark Law Treaty
- Madrid Protocol

# Different Types of Trademarks



**BP**



Google



APPLE



L.12.12

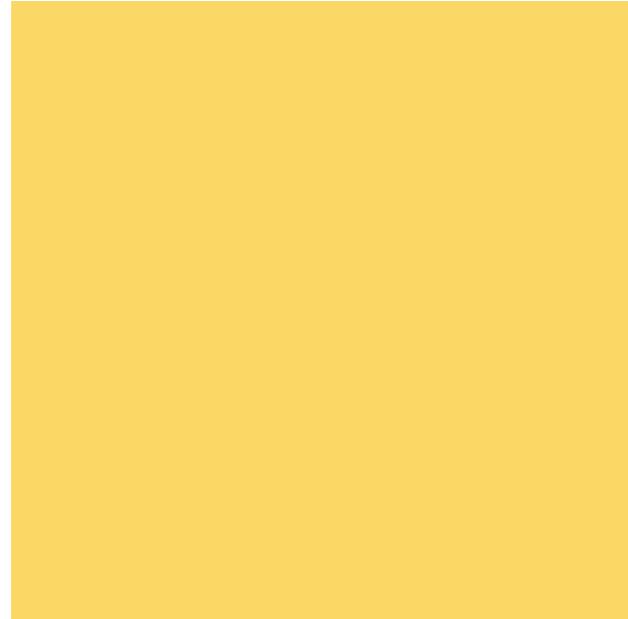
# Non-Traditional Marks

- Three-Dimensional Marks



# Non-Traditional Marks

- Color Marks



The mark comprises the shade of yellow Pantone No. 1225

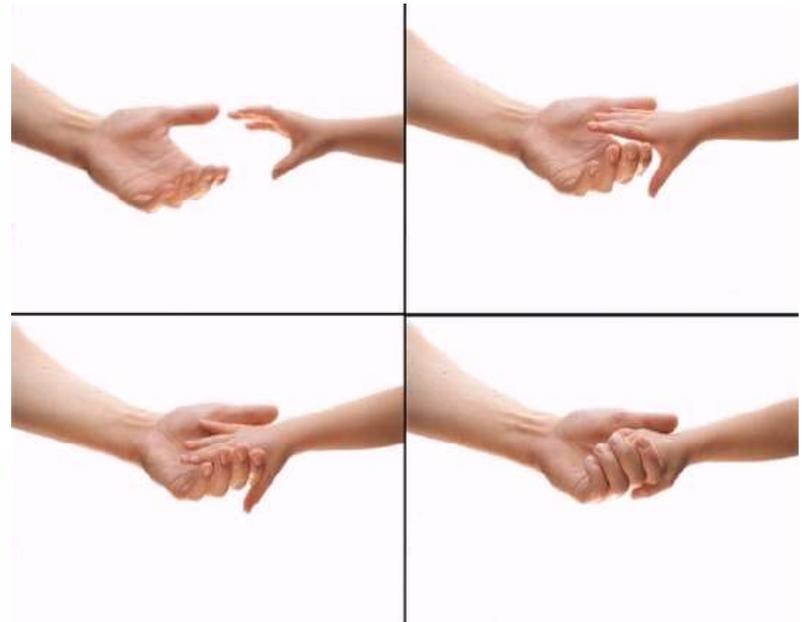
# Non-Traditional Marks

- Hologram Marks



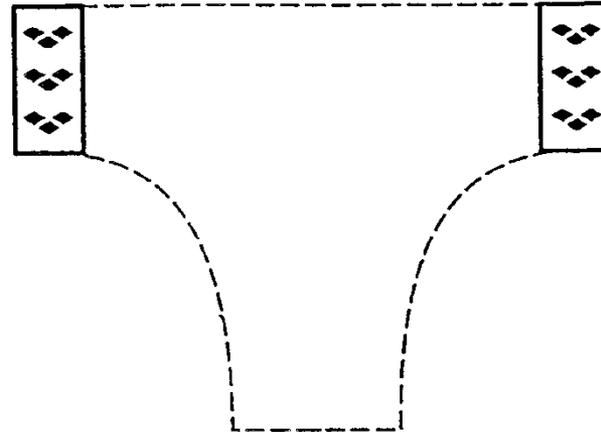
# Non-Traditional Marks

- Motion or Multimedia Marks



# Non-Traditional Marks

- Position Marks



# Non-Traditional Marks

- Sound Marks
- Musical works
- Naturally occurring sounds



# Non-Traditional Marks

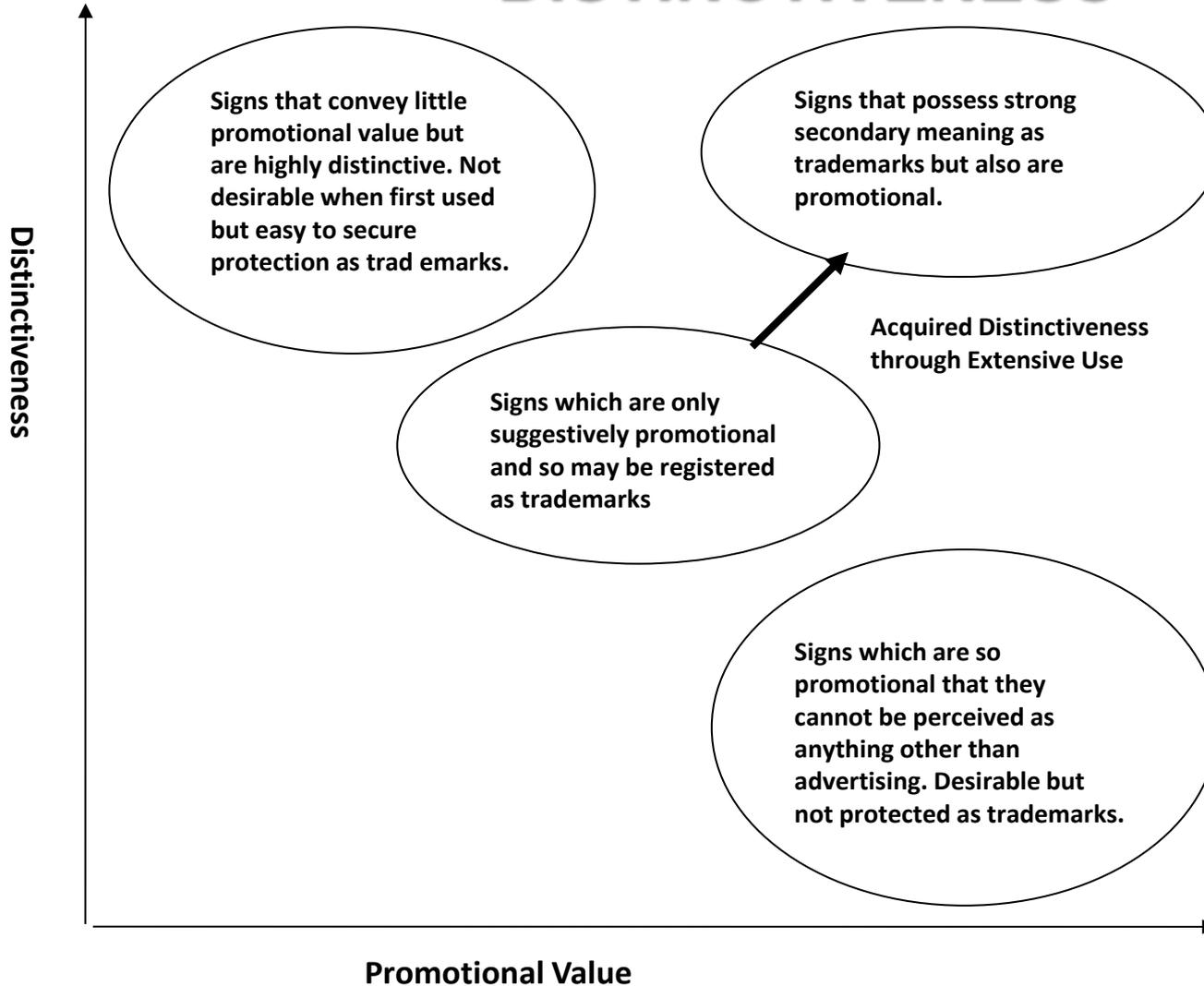
- Olfactory Marks
- Taste Marks
- Texture/Feel Marks

# Registrable Trademarks

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

|  |   |  |  |
|--|---|--|--|
| <p><b>Invented or Fanciful</b><br/>Examples:<br/><b>KODAK; EXXON;</b><br/><b>GOOGLE;</b><br/>‘a leaping tiger’; ‘an eagle with wide-spread wings’; ‘an axe’;<br/>a uniquely designed logo; a one-of-the-kind signature; and an arbitrary combination of numerals or letters.</p> | <p><b>Arbitrary</b><br/>Examples:<br/>‘<b>APPLE</b>’ for computers;<br/><br/>‘<b>SHELL</b>’ for petroleum and other chemical products</p> | <p><b>Suggestive</b><br/>Examples:<br/>‘<b>BONUS GOLD</b>’ for investment account services;<br/><br/>‘<b>LOVE</b>’ for jewellery</p> | <p><b>Descriptive</b><br/>Examples:<br/>‘<b>EASY CREDIT</b>’ for financial services;<br/><br/>‘<b>DOUBLEMINT</b>’ for chewing gum;<br/><br/>Extreme example:<br/><b>SOAP</b> for soaps</p> |
|--|---|--|--|

# PROMOTION VALUE vs DISTINCTIVENESS



# Signs to Avoid

# Non Registrable Trademarks -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 Trademarks - 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 trademarks that have become customary in the industry is “ESCALATOR”; “SHREDDED WHEAT”; “LINOLEUM” and “GRAMOPHONE”

# Acquired Factual Distinctiveness

- **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 or source of origin rather than the product itself.
- 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 Trademarks - 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 Trademarks - 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 Trademarks - Functionality

- A sign shall not be registered as a trade mark if it consists exclusively of
  - a. the shape which results from the nature of the goods themselves;
  - b. the shape of goods which is necessary to obtain a technical result; or
  - c. the shape which gives substantial value to the goods.
- Community Trademark Regulation Article 7(1)(e)
- Singapore Trademark Act, section 7(3)
- US trademark law – doctrine of functionality

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

- A trademark will not be registered if it is identical with an earlier mark and the goods or services for which the trademark 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 Trademarks - Marks that could Cause Confusion

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

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

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

# Use in the Course of Trade

- Trademarks must be used in relation to goods or services in the course of trade
- Cannot register trademarks in a vacuum
- Must register trademarks 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 trademark registration is determined by the goods or services in relation to which the trademark is registered.
- For the purpose of trademark registration, Singapore uses the International Classification of Goods and Services as prescribed by the Nice Agreement to classify trademark 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 trademark.
- The list groups these goods and services into classes in which these goods and services belong.

# Use of the Trademark

- **Bona Fide Intention to Use Mark.**
  - An applicant for trademark registration must show that the trademark 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 trademark.
- **Non-use of a trademark**
  - Grounds for the mark to be revoked
- **Inappropriate use or wrong use of a trademark**
  - Trademark may become generic and loses its distinctiveness.
  - Grounds for revocation.

# Exclusive Rights

- **TRIPS AGREEMENT**

- **Article 16**

- *Rights Conferred*

- 1. The owner of a registered trademark shall have the **exclusive right to prevent all third parties not having the owner's consent from using in the course of trade** identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.
- 2. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.
- 3. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

# Trademark Term

- **TRIPS AGREEMENT**
- ***Article 18***
- *Term of Protection*
- Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.
- In Singapore
- 10 years from date of registration, and renewable for further periods of 10 years
- trademarks are in essence **perpetual rights** provided they are used in relation to the goods or services for which they are registered.

# Trademarks which are not registered

- For a mark that is not registered but is used by the owner, he can 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 trademark, has not been established for a substantial period of time.

# Well Known Marks

- Compared to other trademarks, well known trademarks are accorded with additional protection.
- Anti-dilution rights.
  - Dilution
  - Takes unfair advantage of the distinctive character of the well known mark

# Concept of Trade Mark Dilution

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

# Concept of Trademark 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.

# Takes unfair advantage of the distinctive character of the well known mark

- Intended to encompass a whole range of uses, activities or practices possibly dealt with under unfair competition laws.
- An example of the type of practice most probably envisaged by this section is free-riding by a third party on the goodwill or reputation of the well-known mark
- An example of free-riding is given by Advocate General Jacobs in *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2003] 1 CMLR 14 when he spoke about the use of the mark Rolls Royce to sell whisky.
- *L'Oreal SA v Bellure BV*
- *Whirlpool Corp v Kenwood Ltd*

# Trademark Infringement? Trademark Dilution?



Vs



# Trademark Infringement? Trademark Dilution?



## Nutella v Nutello

# Trademark Infringement? Trademark Dilution?



## Louis Vuitton v City Chain

# When is a Use of Another's Trademark Non-Infringing?

# 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 trademark 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?**