

**TRADE MARKS, LANGUAGE AND CULTURE:
THE CONCEPT OF DISTINCTIVENESS
AND *PUBLICI JURIS***

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The concept of ‘distinctiveness’ in the *Singapore Trade Marks Act 1999* plays a very important role as gate-keeper of what should be entered onto the trade mark register. For this reason, there must be proper understanding of how the statutory provisions on distinctiveness work. The aim of this article is to unravel the knots in these provisions, and to propose a construction of these provisions that furthers the policy underlying the distinctiveness requirement—namely, *publici juris*.

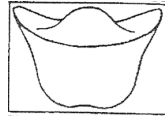
I. INTRODUCTION

As a starting point, it is easiest to explain the concept of ‘distinctiveness’ in trade mark law by reference to “descriptiveness”. A trade mark which is descriptive of the goods or services in question is said to be non-distinctive, and the general principle is that descriptive/non-distinctive trade marks do not enjoy protection. Whether a mark is descriptive for the purposes of trade mark law must, first of all, be answered in the context of the goods or services in relation to which the mark is used or proposed to be used. The word mark “JUICY” is clearly descriptive of fruits and hence non-distinctive for the purposes of trade mark law, whereas “JUICY” is not considered a descriptive trade mark when it is applied to bulldozers and other heavy construction machines.

Words and other symbols can also take on special descriptive meanings which find their roots in the cultural and traditional practices of the land. This, one might say, is a truism. Nonetheless, it is useful to see how this truism manifests itself in the trade mark scene of a multi-cultural, multi-lingual and multi-faith society like Singapore. I have chosen two local trade mark cases for this purpose. In *Cheng*

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Kang Pte. Ltd. v. Sze Jishian,¹ the trade mark was the picture of a hoof-shaped object which is reproduced below.



This turned out to be a pictorial representation of a silver or gold ingot used as currency in the ancient days in China. The Chinese call this ingot “元宝” (pronounced as “*yuan bao*”). The issue in the case before the High Court of Singapore was whether the picture of a “*yuan bao*” could be registered under the (then governing) *Trade Marks Act 1939* in respect of joss papers. Joss papers are pieces of paper which are burnt by the Chinese Buddhists and Taoists as offerings to the dead. According to the evidence tendered, joss papers were burnt in bundles or stacks or they were folded into various shapes before the burning. One such shape was that of a “*yuan bao*”, the belief being that the joss paper would emerge as money in the other world to be used by the dead. On the basis of this evidence, Rubin J.C. held that the picture of the “*yuan bao*” was not a distinctive trade mark and hence unregistrable.

The second case is a decision of the Singapore Trade Marks Registry. In *Kopitiam Investment Pte. Ltd. v. RC Hotels (Pte.) Ltd.*,² the subject-matter of the trade mark application was the word “*kopitiam*” and the specification of goods in the application listed the following services: “Cafes, cafeterias, canteens and provision of food and drinks; all included in Class 42.” To any person familiar with life in Singapore, the association between “*kopitiam*” and canteens and cafeterias is immediate. The word “*kopitiam*” is part of “Singlish”, a Creole that is so widely used in Singapore that there are online dictionaries dedicated to exploring the etymology of *Singlish* words and phrases, explaining their meanings and providing examples of their usage.³ “Singlish” words and phrases are derived not only from the four official languages of Singapore (English, Chinese, Indian and Malay) but also from Chinese dialects such as Cantonese and Hokkien. In the case of “*kopitiam*”, it is the fusion of “*kopi*” the Malay word for “coffee”, and “*tiam*” the English transliteration of the Hokkien word for “shop”. The word “*kopitiam*” literally means “coffee shop” but it has a more general meaning that encompasses canteens and food courts. Once this word is explained in the context of our culture, its descriptiveness for the services listed in the trade mark application in this case is obvious. The application, which was filed under the *Singapore Trade Marks Act 1999*,⁴ was rejected on the basis that its subject-matter did not satisfy the distinctiveness criterion.

A coined word may not have become so accepted by the general public in Singapore as to qualify for inclusion in the “Singlish” dictionary, but it can have a special

¹ [1992] 2 S.L.R. 214 [*Cheng Kang*].

² [2008] SGIPOS 8 [*Kopitiam*].

³ See e.g., *A Dictionary of Singlish and Singapore English*, online: <<http://www.singlish-dictionary.com>>; *The Cxford Singlish Dictionary*, online: <<http://www.talkingcock.com>>. For an overview of the origins and history of *Singlish* given by a linguist, see Bao Zhiming, “The Origins of Empty Categories in Singapore English” (2001) 16 *Journal of Pidgin and Creole Languages* 275 at 280-286.

⁴ Cap. 332, 1999 Rev. Ed. Sing. [*Singapore Trade Marks Act 1999 or 1999 Act*].

meaning amongst a specific group. Teenagers are particularly notorious for creating their own vocabulary. For example, a teenager in Singapore may say, “XYZ School’s tennis team won this year—it was so *imba!*” By this, the teenager means to say that the winning tennis team is so powerful and superior that the other school teams were no match at all for this winning team, and to this extent, the competition was imbalanced. This long explanation is delivered by the teenager in just one word: “*imba*”, a truncation of “imbalanced”. It seems that the tendency amongst teenagers to truncate words is attributable to the need in the online subculture for quick and efficient communication. In particular, playing real-time online action games does not permit the luxury of typing out words in full or complete sentences. It has been put in this way: “You die less if you get your meaning or instructions across faster”.⁵

When a trader seeks exclusive rights to use a word or symbol that has developed or is developing a descriptive meaning, linguists and anthropologists may be interested in its potential impact on the evolution of the language and on the relationship between language and culture. For example, if the word “*imba*” is registered as a trade mark for clothing and footwear, would this delay its journey to becoming a more widely used word in Singapore and earning a place in the “Singlish” dictionaries? On one view, such questions have no relevance to trade mark law, a business law concerned with fair trading in the marketplace. Yet, it is precisely this commercial objective that creates a link between trade mark law, linguistics and anthropology. What is, after all, “fair trading”? When a trader files a trade mark application, fair trading means that registration of the word or symbol in the application must not confer on this trader an unfair advantage; or, looking at it from the other side of the same coin, other traders must not be unfairly prejudiced by this registration. When a word or symbol is descriptive of the goods or services, it may be argued that such unfair prejudice is caused because *prima facie* this word or symbol is something which everyone would like to use and should have a right to use. There is a Latin phrase which encapsulates this argument: ‘*publici juris*’. As we shall see later, this is in fact what underpins the distinctiveness criterion in trade mark law. The concept of *publici juris* is very relevant when we are dealing with the languages and cultures of a land—these surely must belong to everyone in that land. A law that can create private legal rights over the building blocks of a language or elements of a culture must proceed with the “fencing off” of the public domain with caution. Viewed from this perspective, the distinctiveness criterion can (loosely) be said to have a part to play in safeguarding language and culture.

For the distinctiveness criterion to act as an effective gate-keeper, we need to have a good understanding of what it is all about. This article began with a very simplified explanation, by equating non-distinctiveness with descriptiveness. As indicated, this is just a starting point. The structure of the distinctiveness criterion in the current *Singapore Trade Marks Act 1999* is more complicated. The relevant provisions in this Act are sections 7(1)(a)-(d) and 7(2). The scope of each of the paragraphs in subsection (1), and their relationship with each other and with subsection (2), can be baffling. The aim of this article is to unravel some of the knots in this area. The suggested approach to making sense of these provisions is to construe these

⁵ See “Do You Know What We Mean?” *The Straits Times* (Singapore) (2 June 2009). This article reported on the phenomenon of teens using newly coined words to communicate with their peers.

provisions in a way that furthers the policy underlying the distinctiveness criterion—the concept of *publici juris*. The Singapore courts have provided some guidance on the interpretations of section 7, and their decisions will also be critiqued from this policy angle.

First, we must be convinced that the concept of *publici juris* is the rationale for the distinctiveness criterion, and that it is a sound reason.

II. DISTINCTIVENESS AND *PUBLICI JURIS* AT COMMON LAW

The concepts of distinctiveness and *publici juris* simultaneously appeared for the first time in the Singapore trade mark scene in 1899. The case was *Katz Brothers Ltd. v. Kim Hin & Co.*,⁶ a decision of Cox C.J. sitting in the Supreme Court of the Straits Settlement. This is the first trade mark case in Singapore involving descriptive marks.

The plaintiff had been selling for more than twenty years a cheap type of brandy under a label which featured an eagle. An eagle—the word itself or a representation of the bird—is in and of itself not descriptive of the product, in this case—brandy. The descriptive nature of the eagle label in the context of brandy came about in this way. Although the plaintiff claimed to be the only one in the brandy trade using an eagle label, there was evidence that many other traders of cheap brandy also used the representation of an eagle (albeit differing in some particulars from the eagle featured in the plaintiff's label) to sell their brandy. So extensive was this usage that consumers of this product in Singapore—whom Cox C.J. called 'the natives'⁷—had begun to refer to cheap and inferior brandy by the Malay term '*chop burong*', which means 'bird brand'.

That these words '*chop burong*' could acquire such a special meaning is not impossible. Two factors in particular must be borne in mind. First, in the early days of Singapore, Malay was the language commonly used for communication between the different racial groups of 'natives' (the Chinese, Malays and Indians) and to that extent, Malay was the *lingua franca* in Singapore then. Second, there is no equivalent for 'brandy' in the Malay language. In such circumstances, it is conceivable that when the eagle symbol was used by various traders selling cheap brandy, the natives adopted this symbol as a description of the product (brandy that they could afford) rather than as the trade mark of any particular trader. The influence of such cultural and linguistic factors on the public's perception of trademarks is also evident in other early trade mark cases from Singapore. For example, in a 1933 case,⁸ the plaintiff sold condensed milk under a label which had the words 'Rose Brand' and the design of a red rose. The native consumers, however, identified the plaintiff's mark either as '*chop bunga*' (Malay for 'flower brand') or '*whay piao*' (the English transliteration of the Chinese characters 花票 for 'flower brand'). The judge Whitley J. noted

⁶ [1900-01] VI S.S.L.R. 1 [*Eagle Brandy*].

⁷ *Ibid.* at 4.

⁸ *The Nestle & Anglo-Swiss Condensed Milk Co. v. The East Asiatic Co. Ltd.* [1933] M.L.J. 30. For a discussion of other trade mark cases where cultural and linguistic factors of Singapore were taken into account by the tribunal in arriving at their decisions, see Ng-Loy Wee Loon, *An Interdisciplinary Perspective on the Likelihood of Confusion: Consumer Psychology and Trademarks in an Asian Society*, [2008] 98 Trademark Reporter 950.

that the rose was an unknown flower to most natives in Singapore, being a flower grown only in a few private gardens (most likely owned by the English expatriates), and that there was no Malay word for this flower. Given these circumstances, the judge explained, it was natural for the natives to refer to the plaintiff's label as '*chop bunga*'. The defendant's label in this case had featured the words '*Lotus Brand*' and a picture of a red/pink lotus. Because the lotus was also comparatively a rare flower in Singapore, the court found the public would also refer to the defendant's mark as '*chop bunga*', and hence the co-existence of the plaintiff's mark and the defendant's mark had the potential to confuse the public. The court found for the plaintiff in this action for passing off.

In the *Eagle Brandy* case, the plaintiff was seeking an injunction to stop the defendant, a rival brandy trader, from using a representation of the eagle and the words '*chop burong*' or "*Eagle Brandy*". The plaintiff argued that, having used the eagle symbol for its brandy for more than twenty years, it was entitled at common law to the exclusive use of the eagle symbol in relation to brandy. The plaintiff's action was obviously for 'passing off', even though this term did not appear anywhere in the report of this case.⁹ To settle this dispute, Cox C.J. laid down the following principles:

[The] trade mark must in the first place be *distinctive*, *i.e.* not merely descriptive of a class of goods, but must indicate that the goods to which it is applied are the goods—whether manufactured, selected or imported—of a particular trader.... [A] plaintiff claiming to be entitled to a trade mark must prove that he has had the public and exclusive use of it so that the mark has become known in the market as indicating exclusively the plaintiff's goods. And if the mark has been used by other traders to such an extent and for such a period of time that it has ceased to denote exclusively the plaintiff's goods and nobody can be induced, from the use of it, that the goods to which it is applied are the plaintiff's goods, then any right which the plaintiff may have had to it originally is lost.¹⁰

This passage contains three very important points about 'distinctiveness'. First, it sets out what may be called the "common law" meaning of distinctiveness: a distinctive mark is one which indicates to the relevant sector of the public that the goods or services to which it is applied are those of a particular trader, to the exclusion of other traders. Today, when passing off is often characterised by reference to the "classical trinity" (goodwill, misrepresentation, damage) of the action,¹¹ the meaning of distinctiveness given by Cox C.J. is immediately recognisable as the goodwill

⁹ The absence of the term 'passing off' in this 1899 case is not very surprising. It was only in the second half of the 19th century that passing off took shape as an independent cause of action. Prior to that, traders who wished to stop their rivals from using their trade mark, or a confusingly similar mark, relied on *inter alia* the tort of deceit. The English case said to be the first to dispense with the need for intention to deceive, thereby paving the way for the development of the action for passing off is *Millington v. Fox* (1838) 3 My & Cr 338. In Singapore, the term 'passing off' made its first appearance only in 1928, in the case *Ingenohl v. El Oriente Fabrica De Tabacos* [1928] S.S.L.R. 212.

¹⁰ *Eagle Brandy*, *supra* note 6 at 4.

¹¹ The term 'classical trinity' for passing off was coined by Nourse L.J. in the English case, *Conorzio del Prosciutto di Parma v. Marks & Spencer Plc.* [1991] R.P.C. 351. The first time this term was used by the High Court of Singapore was in *Alteco Chemical Pte. Ltd. v. Chong Yean Wah* [2000] 1 S.L.R. 119 at para. 37. The first time it was used by the Singapore Court of Appeal was in *Novelty Pte. Ltd. v. Amanresorts Ltd.* [2009] 3 S.L.R. 216 at para. 37 [*Novelty*].

element in this trinity. If there is any need for authority to support this proposition, it can be found in this passage of Lord Oliver of Aylmerton explaining what goodwill is:

[The plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services.

Lord Oliver was rendering his judgment in the case *Reckitt & Colman Products Ltd. v. Borden Inc.*, one of the leading English passing off cases involving descriptive marks.¹² This passage is very much part of the law of passing off in Singapore, having been cited with approval by our courts in many cases.¹³

Second, in this common law meaning of distinctiveness, distinctiveness is acquired through use of the mark by the plaintiff. This feature of distinctiveness accords with the principle laid down by our Court of Appeal in later passing off cases: that goodwill is “normally generated by trading”.¹⁴ For this reason, a plaintiff having to prove the goodwill element in a passing off action usually tenders evidence such as the number of years he has used the mark for his goods or services, his sales volume, advertisements of his goods or services under this mark. Determining whether the plaintiff’s usage of the mark has educated the public to the point of associating the mark exclusively with the plaintiff’s goods or services is essentially a factual inquiry. For this reason, I shall refer to this common law concept of distinctiveness as ‘*de facto* distinctiveness’.

Third, *de facto* distinctiveness may be lost. This can happen, according to Cox C.J., as a result of usage of the mark by other traders. It can also happen as a result of its usage by the public. There are real-life examples of marks which have lost their *de facto* distinctiveness such as ‘escalator’, and marks which are at risk of losing their *de facto* distinctiveness such as ‘xerox’. The evidence lies in the way these words are defined in the *Oxford English Dictionary Online*:

- ‘Escalator’—Originally an invented word which was used as a trade name, but now it is also a noun for a “moving staircase made on the endless-chain principle so that the steps ascend or descend continuously, for carrying passengers up or down”. It is also used as a verb to mean “to increase or develop by successive stages”.
- ‘Xerox’—A proprietary name for photocopiers, but it is also used loosely as a noun to denote any photocopier

¹² [1990] 1 W.L.R. 491 at 499. The mark in this case was a yellow plastic squeeze pack that resembled in size, shape and colour of a lemon, and the product was lemon juice.

¹³ See *Tessensohn t/a Clea Professional Image Consultants v. John Robert Powers School Inc.* [1994] 3 S.L.R. 308 at para. 21; *CDL Hotels International Ltd. v. Pontiac Marina Pte. Ltd.* [1998] 2 S.L.R. 550 (C.A.) at para. 86 [*CDL Hotels (C.A.)*]; and *Novelty*, *supra* note 11 at para. 36.

¹⁴ See *CDL Hotels (C.A.)*, *ibid.* at paras. 46 and 52. See also *Lifestyle 1.99 Pte. Ltd. v. S\$1.99 Pte. Ltd.* [2000] 2 S.L.R. 766 (C.A.) at para. 19 [*Lifestyle 1.99*] (“Ordinarily goodwill is acquired by trading.”)

Should the plaintiff's mark lose its *de facto* distinctiveness, the plaintiff would correspondingly lose his common law rights to the mark. Therefore, when the plaintiff sues to enforce his common law rights, he must prove that *de facto* distinctiveness in the mark exists as at the relevant date, that is, the date on which the defendant's conduct complained of started.¹⁵ If, by this date, the mark has not acquired *de facto* distinctiveness or has lost its *de facto* distinctiveness, the plaintiff cannot be said to have any goodwill. The plaintiff in the *Eagle Brandy* case lost its case on these two grounds. Cox C.J. was not satisfied that the eagle symbol had acquired *de facto* distinctiveness as a result of the plaintiff's use of this symbol on its brandy. Alternatively, even if this symbol had at one time become distinctive exclusively of the plaintiff's brandy, the judge found that such *de facto* distinctiveness had been lost by the time the defendant started using the eagle symbol for its brandy.

Apart from laying down these three fundamentals governing distinctiveness, Cox C.J. also provided the reason underlying the need for distinctiveness. He said that the plaintiff could have no rights to the eagle symbol when it had become '*publici juris*'.¹⁶ This Latin legal term is used to express the notion that what is common property, or in the public domain, is free for all to use.¹⁷ Although Cox C.J. did not elaborate any further, he must have meant that the eagle symbol was something in the public domain because it was freely used in the market to refer to a particular type of brandy. This was what *publici juris* meant to Sinnathuray J. in the only other local trade mark case that has deployed this term.¹⁸ In *Fraser & Neave Ltd. v. Yeo Hiap Seng Ltd.*,¹⁹ the plaintiffs sold the drink sarsaparilla using a label comprising, *inter alia*, these three Chinese characters '沙士水'. The last character '水' means water, and hence the English transliteration of the three characters is 'sar see water' or 'sarsi water'. Evidence showed that the Chinese were using this term to refer to the sarsaparilla drink long before the plaintiffs started using the three characters in their label. The plaintiffs lost their suit against the defendants whose mark was "*Miranda Sarsi*" and who were also using the three Chinese characters in their advertisements of their sarsaparilla drink. The reason given by the trial judge, Sinnathuray J., was the following:

that the three Chinese characters were *publici juris*, that they are common to the trade, that they were used freely as indicating the character and quality of sarsaparilla. In my view they could not have been appropriated by the plaintiffs and claimed by them as exclusively belonging to them.²⁰

To say that marks which are descriptive of the goods or services are public domain and therefore must not be "fenced off" for the exclusive use of one particular trader,

¹⁵ For Singapore cases on the 'relevant date' for the purposes of a passing off action, see e.g., *CDL Hotels (C.A.)*, *supra* note 13 at para. 34.

¹⁶ *Supra* note 6 at 5.

¹⁷ See e.g. *Wilts and Berks Canal Navigation Company v. Swindon Waterworks Company* (1873-74) L.R. 9 Ch. App. 451 at 457 (the use of *publici juris* in disputes involving rights to use waters in public streams); and *International News Service v. Associated Press* (1918) 248 U.S. 215 at 234 (disputes involving rights to report news items).

¹⁸ For English trade mark cases which have used the term *publici juris*, see esp. *Ford v. Foster* (1872) L.R. 7 Ch. 611 at 628 (*per Mellish L.J.*), and the Court of Appeal judgment in *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd.* [1980] R.P.C. 30 at 65 and 71 (*per Buckley L.J.*), and at 75 (*per Goff L.J.*).

¹⁹ [1980-1981] S.L.R. 599 [*Sarsi Water*].

²⁰ *Ibid.* at 605.

sounds right. However, it would give us a better grasp of this area if we understand why in the first place such descriptive marks are in the public domain. To put it another way, why do traders in general want to use descriptive marks? From the marketing point of view, there are advantages to choosing a descriptive word or symbol as one's trade mark. For example, the 'yuan bao' mark, the 'kopitiam' mark and the '沙士' '水' mark immediately make known to the relevant public the purpose or nature of the goods or services provided by the trader. Other local trade marks in this category include "Electro-Reflexologist" for electric foot reflexology machines,²¹ and "COFFEEMIX" for an instant beverage mixture of coffee, creamer and sugar.²² Laudatory words or symbols like "imba" can also be useful trade marks because they will help extol the virtues of the goods or services. Local real-life examples include "益 补力" ("beneficial for restoring strength") for chicken essence.²³ These marketing advantages make descriptive marks a natural choice for some traders. As mentioned in the Introduction to this article, trade mark law is about fair trading, about maintaining an even playing field amongst the traders. When the law gives exclusive rights over a descriptive mark to a particular trader, the law is depleting the pool of words and symbols which other traders are likely to want to use—and that is not fair. Later on, we shall see this policy expressed in this way: the law must show disinclination towards granting "a monopoly in what others may legitimately desire to use".²⁴

One last point needs to be made about *de facto* distinctiveness before we move on to the trade mark registration system. In all the local decisions mentioned in this article so far, the tribunal held that the descriptive mark in question was not a distinctive mark. This is by no means an indication that a descriptive mark cannot acquire *de facto* distinctiveness. This was made very clear by the Singapore Court of Appeal when it said in the case of *Lifestyle 1.99*:²⁵ "Of course the fact that a name is descriptive does not mean that it could not become distinctive although it would be difficult."

In other words, there is no legal bar against a descriptive mark acquiring *de facto* distinctiveness but the plaintiff bears a heavy burden when proving that the descriptive mark has become distinctive of his goods or services. To be more precise, it is a burden which is heavier than if he had chosen a "fancy" mark, that is, a mark which is not descriptive of the goods or services.²⁶ The *Lifestyle 1.99* case is an example where the plaintiff successfully discharged this heavier burden of proof. The plaintiff's mark for its shops was 'ONE.99' and the business was selling all items in the shops at \$1.99. The Court of Appeal, in reaching the conclusion that there was distinctiveness in the name 'ONE.99', was impressed with the very intensive use and promotion of the mark by the plaintiff. It also took into account a survey which showed that at least

²¹ *OTO Bodycare Pte. Ltd. v. Hiew Keat Foong* [2005] SGHC 133.

²² *Super Coffeemix Manufacturing Ltd. v. Unico Trading Pte. Ltd.* [2000] 3 S.L.R. 145.

²³ *McAlister & Co. Ltd. v. Pasuma (1960) Ltd.* [1961] M.L.J. 298.

²⁴ *Infra* note 45 and accompanying text.

²⁵ *Supra* note 14 at para. 34.

²⁶ *Ibid.* at para. 37. See also *Pontiac Marina Pte. Ltd. v. CDL Hotels International Ltd.* [1997] 3 S.L.R. 726 (H.C.) at 741-742, *per* Chao Hick Tin J. ("Whether a word is termed descriptive or fancy, the significance lies in the fact that distinctiveness is very much more easily acquired for fancy words.")

40% of persons interviewed identified the name ONE.99 with the plaintiff's shops.²⁷ This case also shows that *de facto* distinctiveness in passing off does not require proof that 100% of the relevant sector of the public associate the mark with the plaintiff. The more descriptive the mark is of the goods or services, the more difficult it is to prove that the mark has acquired *de facto* distinctiveness and this translates into the need to show a higher degree of recognition amongst the relevant sector of the public.

Other than the *Lifestyle 1.99* case, the other passing off cases where the evidence satisfied the court that the descriptive mark had become *de facto* distinctive of the plaintiff's goods or services include the following: "*Mechanical Handling Engineering*" for cranes and hoists;²⁸ "*Carefree*" for female sanitary napkins (referring to the carefree life that this product offers to the female during that time of the month);²⁹ and "新加坡书法中心" (which means "*Singapore Calligraphy Centre*") as the name for a society whose objective is to promote Chinese calligraphy.³⁰

Although there is no legal bar against a descriptive mark acquiring *de facto* distinctiveness, there is one scenario where it is almost impossible for the plaintiff to discharge the heavy burden of proving *de facto* distinctiveness, namely, where the mark is so descriptive of the goods or services that it is the synonym for those goods or services. This proposition is illustrated by an example which has become famous in the trade marks circle: if a trader adopts the word "SOAP" as a mark for his soap, the public will never ever see the word 'soap' as being distinctive specifically and exclusively of this trader's soap no matter how long and how much this trader tries to promote the word 'soap' as his badge of origin.³¹ Since the public's association between this mark and the particular trader realistically can never happen, and the burden on the trader is to prove that this has happened, it is impossible to discharge this burden. In short, at common law, the bar against a generic mark becoming a distinctive mark is a factual one, not a legal one.

But is this position governing generic marks at common law ideal? Is it sufficient that the lack of protection for generic marks in trade mark law is due only to a factual bar? When a mark is the generic description of the goods or services, granting exclusive rights over this mark is tantamount to granting a monopoly over the goods or services themselves or the business of selling those goods or services. Such a monopoly goes way beyond what trade mark law is meant to protect. Trade mark law is concerned with the rights to use *symbols* to indicate the trade source of goods or services, and not rights over the goods or services themselves or a business concept. If at all there should be monopolies over the latter subject-matter, this is the domain of other intellectual property regimes in particular patents and designs. Patent and

²⁷ Note that, although the plaintiff managed to prove distinctiveness and thereby the first element of goodwill, the plaintiff eventually failed in this passing off action because the court was not satisfied that the second element of the action, misrepresentation, had been proved.

²⁸ *Mechanical Handling Engineering (S) Pte. Ltd. v. Material Handling Engineering Pte. Ltd.* [1993] 2 S.L.R. 203.

²⁹ *Johnson & Johnson v. Uni-Charm Kabushiki Kaisha (Uni-Charm Corporation)* [2007] 1 S.L.R. 1082.

³⁰ *The Chinese Calligraphy Society of Singapore v. Koo Seng Kong* [2008] SGHC 121.

³¹ This example comes from Jacob J. in *British Sugar Plc. v. James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 302 [*British Sugar*]. See *infra* note 100 and accompanying text.

design rights have a limited period of protection.³² Not so trade mark rights (unless the mark is found to have lost its *de facto* distinctiveness) and therefore granting trade mark rights over a generic mark can have the effect of granting a perpetual monopoly over the goods or services or business concept. This is a very strong case for trade mark law to be particularly circumspect when generic marks are involved. In fact, it is so strong that the prohibition against granting exclusive rights over generic marks in trade mark law should arguably be made a *legal* one, and not merely left to be governed by a factual inquiry.

The common law concept of distinctiveness is not perfect. Apart from the criticism levied above in the special case of generic marks, its *de facto* nature also has other weaknesses viewed from the perspective of the business community. In particular, a trader who promotes a mark as the badge of origin for his goods has no guarantee that he will have the law on his side when he has to sue the rival for passing off. He will need to spend money gathering evidence that his promotion of the mark has resulted in the public making the association between the mark and his business. Such uncertainty does not foster a conducive business environment. This is a reason why the registration system was seen to be necessary.³³

III. DISTINCTIVENESS AND *PUBLICI JURIS* IN THE REGISTRATION SYSTEM

The trade mark registration system in Singapore started with the *Trade Marks Act 1939*. This was modeled, almost word-for-word, on the *U.K. Trade Marks Act 1938*.³⁴ The U.K. registration system started much earlier than 1938; it was established by the *Registration of Trade Marks Act 1875*.³⁵ The latter laid the first foundations of the registration system, and many of the concepts there remain core principles in modern registered trade mark law. It is useful therefore to begin with the *1875 Act*.

A. *The U.K. Trade Marks Act, 1875–1938*

The registration system under the *Registration of Trade Marks Act 1875* brought many benefits to the business community. Traders were able to inspect the register and determine with relative ease what trade marks were already protected and who owned these marks. Registered proprietors would also be spared the trouble and expense of having to prove *de facto* distinctiveness or goodwill when he sued for infringement under the Act. This was achieved by providing that the registration of a person as the proprietor of a trade mark shall be *prima facie* evidence of his exclusive rights to use the trade mark during the first five years of registration, and thereafter, it shall be conclusive evidence of his exclusive rights provided that he remained the

³² Patent protection is generally for 20 years: see *Patents Act* (Cap. 221, 2005 Rev. Ed. Sing.), ss. 36 and 36A. Design protection is for 15 years: see *Registered Designs Act* (Cap. 266, 2005 Rev. Ed. Sing.), s. 21.

³³ For the historical development of trade mark law in the U.K., see Lionel Bently, “The Making of Modern Trade Mark Law: The Construction of the Legal Concept of Trade Mark (1860-1880)” in Lionel Bently, Jane C. Ginsburg & Jennifer Davis (eds.), *Trade Marks and Brands: An Interdisciplinary Critique* (New York: Cambridge University Press, 2008).

³⁴ (Repealed 31.10.1994) (c. 22) [*1938 Act*].

³⁵ (38 & 79 Vict. c. 91) [*1875 Act*].

owner of the goodwill of the business using the trade mark.³⁶ Further, the definition of ‘trade mark’ in the *1875 Act* did not require prior use of the mark.³⁷ Registration and hence protection for an unused mark was possible, unlike in the common law system where rights to a mark derive from actual use of the mark. This meant that the proprietor of a registered but unused mark had the assurance that his money and effort spent in promoting the mark would be protected under the Act.

However, the registration system must not be seen as merely aiming to make life easier for registered proprietors. That was not at all the case. Precisely because registration of a mark was itself *prima facie* evidence—and possibly conclusive evidence—of a trader’s monopoly over a mark, the registration system had to be very careful that registration of a mark in the name of a trader was warranted. This caution manifested itself in the *1875 Act* in two principles. First, registration must not disturb or override any rights which existed in the trade mark at the time of the trade mark application. On this, the *1875 Act* provided that registration must be refused if the same mark, or one so nearly resembling it, was already registered in respect of the same goods or class of goods,³⁸ or if the trade mark applicant was not the rightful proprietor of the mark.³⁹ These provisions correspond to the registration criteria we have today concerning “conflicts with earlier rights”⁴⁰ and “bad faith” applications.⁴¹ Secondly, a mark must satisfy the distinctiveness criterion which was found in the statutory definition of ‘trade mark’ itself. Table A below sets out this definition, and also tracks the development of the distinctiveness criterion from the *1875 Act* till the *U.K. Trade Marks Act 1938*.

From the start, the registration system was relatively strict about what may be registered. For example, it was not enough that the subject-matter of the application was the name of a firm. To qualify as a ‘trade mark’, the firm name had to be ‘printed, impressed or woven in some particular and distinctive manner’.⁴² The reason for this caution was explained by the Court of Appeal in *In re Van Duzer’s Trade Mark*. According to Cotton L.J.:

although the intention of the Act was to benefit traders ... the Act was also intended to protect the public, by having a register of marks, so that they might know what it was that was protected by the trade-marks adopted, and also by cutting down the numerous forms of words and other things, by the use of which traders tried to secure themselves exclusive rights.⁴³

³⁶ S. 3 of the *1875 Act*. For the *Singapore Trade Marks Act 1999*, see s. 101. The current law in s. 101, however, only provides for a registration to be *prima facie* evidence of its validity. It does not provide that the registration is conclusive evidence of its validity after the 5-year period.

³⁷ S. 10 of the *1875 Act*. This definition is set out in the first column of Table A in the main text. See *infra* note 48 and accompanying text.

³⁸ S. 6 of the *1875 Act*.

³⁹ S. 5 of the *1875 Act*.

⁴⁰ S. 8 of the *Singapore Trade Marks Act 1999*.

⁴¹ S. 7(6) of the *Singapore Trade Marks Act 1999*. This ‘bad faith’ provision has been applied in cases of ‘hijacking’ where the trade mark applicant is not the rightful proprietor of the trade mark in question because he has misappropriated the trade mark belonging to another trader: See *Nautical Concept Pte. Ltd. v. Mark Richard Jeffery* [2007] 1 S.L.R. 1071.

⁴² This was an observation made in *Stephens, Ex parte* (1876) L.R. 3 Ch. D. 659.

⁴³ [1887] L.R. 34 Ch. D. 623 at 634. The marks in this case were ‘*Melrose Favourite Hair Restorer*’ for a toilet preparation and ‘*Electric*’ for velveteen (a mixture of silk and cotton). The Court of Appeal held that both these marks were not registrable.

Table A. What may be registered under the *UK Trade Marks Acts, 1875–1938*.

Trade Mark Registration Act 1875 (section 10)	Patents Designs & Trade Marks Act 1883 (section 64)	Patents Designs & Trade Marks (Amendment) Act 1888 (section 64)	Trade Marks Act 1905 (section 9)	Trade Marks (Amendment) Act 1919 (section 2) The register was split into two parts	Trade Marks Act 1938 (sections 9 and 10) The register remains split into two parts
A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner	A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner	A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner	The name of a company, individual, or firm, represented in a special or particular manner	Part A registration: The name of a company, individual, or firm, represented in a special or particular manner	Part A registration: The name of a company, individual, or firm, represented in a special or particular manner
A written signature or copy of a written signature of an individual or firm	A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark	A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark	The signature of the applicant for registration or some predecessor in his business	Part A: The signature of the applicant for registration or some predecessor in his business	Part A registration: The signature of the applicant for registration or some predecessor in his business

Table A. *(Continued)*

Trade Mark Registration Act 1875 (section 10)	Patents Designs & Trade Marks Act 1883 (section 64)	Patents Designs & Trade Marks (Amendment) Act 1888 (section 64)	Trade Marks Act 1905 (section 9)	Trade Marks (Amendment) Act 1919 (section 2)	Trade Marks Act 1938 (sections 9 and 10)
distinguish the applicant's goods from those of other persons. In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered	defined in the 1905 Act	for not less than two years, and were capable of distinguishing the goods of the applicant	mark, <i>i.e.</i> a mark which is adapted to distinguish the applicant's goods from those of other persons. In determining whether a trade mark is so adapted, the tribunal may have regard to the extent to which the mark is inherently adapted to distinguish, and in fact adapted to distinguish	the applicant's goods from those of other persons. In determining whether a trade mark is so capable, the tribunal may have regard to the extent to which the mark is inherently capable of distinguishing, and in fact capable of distinguishing	The register remains split into two parts

Table A. (Continued)

Trade Mark Registration Act	Patents Designs & Trade Marks Act	Patents Designs & Trade Marks (Amendment) Act	Trade Marks Act	Trade Marks (Amendment) Act	Trade Marks Act
1875 (section 10)	1883 (section 64)	1888 (section 64)	1905 (section 9)	1919 (section 2)	1938 (sections 9 and 10)
A special and distinctive word or words, or combination of figures or letters used as a trade mark before passing of this Act	Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before 13 th Aug 1875	Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before 13 th Aug 1875	Any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark before 13 th Aug 1875, and continued to be used down to the date of the application	The register was split into two parts	The register remains split into two parts

Lindley L.J. sent the same message, when he said that the registration system must not make it “intolerably burdensome upon other people who [had] not got registered trade-marks” and that the courts must be mindful that it did not “impose greater restrictions upon freedom of trade than [were] necessary for the purpose of carrying out the Act fairly and properly”.⁴⁴ These quotations made very clear the register’s role as a gate-keeper, watching out for the interests of the business community as a whole. There is also a hint from Cotton L.J. of the flaw in the common law system mentioned earlier in this article, namely, that certain words or symbols should be free for all to use and the common law system’s total reliance on use of the mark to resolve disputes between traders may tempt some traders to argue that they have a monopoly over the word or symbol by reason of *their* use thereof.

When looking for the policy underlying the distinctiveness criterion in the registration system, it is almost inevitable that the famous judgment of Lord Parker of Waddington in *W and G du Cros’ Application* will come to mind. This was a case decided under the *1905 Act*. It defined distinctiveness by reference to whether the mark was “adapted to distinguish” the applicant’s goods from those supplied by other traders. Both the test and the reason for this “adapted to distinguish” criterion are set out in this oft-cited passage of Lord Parker:

[T]he test for a mark’s adaptability to distinguish] is whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire the use of the same mark, or some other mark nearly resembling it, upon or in connection with their own goods. [The reason for this criterion is as follows:] It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use.⁴⁵

In this case, the mark was ‘W & G’ and the goods were motor vehicles. The letters in this mark were the initials of the names of the applicant’s predecessor in business. Lord Parker held that this mark had no adaptability to distinguish because there would be other traders whose name or firm name contained the initials ‘W’ and ‘G’ (such as ‘William Green’ or ‘Weston and Gibbs’) who might legitimately desire to use these initials in their business, and so there must be a “strong” reason to deprive them of this right to do so.⁴⁶ Lord Parker may not have used the specific term ‘*publici juris*’ in his judgment, but he clearly had in mind the same policy reason as that given by Cox C.J. in the *Eagle Brandy* case and by Sinnathuray J. in the *Sarsi Water* case for why the common law must be slow to confer a trader exclusive rights to a descriptive mark.

The passage from Lord Parker’s judgment was subsequently adopted by the House of Lords in *Smith Kline & French Laboratories Ltd. v. Sterling-Winthrop Group Ltd.*,⁴⁷ a case decided under the *1938 Act*. The latter Act reigned in the U.K. for over 56 years, until it was replaced by the *U.K. Trade Marks Act 1994*. In total, Lord Parker’s “would-other-traders-legitimately-desire-to-use-the-mark” test ruled

⁴⁴ *Ibid.* at 643.

⁴⁵ [1913] A.C. 624 at 635 [W & G].

⁴⁶ *Ibid.* at 635–636.

⁴⁷ [1975] 1 W.L.R. 914 at 922, *per* Lord Diplock [*Smith Kline*].

the day in the U.K. for 81 years. This is why Lord Parker's judgment in *W & G du Cros' Application* is so famous.

Thus far, we have seen that the policy underlying the statutory concept of distinctiveness criterion is the same as that for the common law concept of distinctiveness. However, it does not follow that the statutory concept of distinctiveness is exactly the same as the common law concept of *de facto* distinctiveness. The difference between the two was not immediately apparent at the start of the registration system. In the *1875 Act*, the word 'distinctive' appeared in the statutory definition of 'trade mark' but it was not clear whether this referred to distinctiveness acquired as a result of prior use of the mark by the trader. This was eventually resolved by the U.K. Court of Appeal which held that, although the language of the *1875 Act* was obscure, the intention of the Act was to allow registration of marks which had not been used prior to the application for registration.⁴⁸ In other words, under the *1875 Act*, an unused mark could be a distinctive mark. If the *1875 Act* was obscure on this point, the *1938 Act* was not. Because the *1938 Act* was the model used for the *Singapore Trade Marks Act 1939*, it is worth our while spending some time understanding what distinctiveness meant in the *1938 Act*.

The U.K. register, by the time of the *1938 Act*, had been split into two parts: Part A and Part B. The first clue that unused marks could be entered onto either parts of the register lies in a procedure provision in the *1938 Act*. This provided that any person claiming to be the proprietor of a trade mark "used or *proposed to be used* by him" may apply to register the mark in Part A or Part B of the register.⁴⁹ It was clear that the mark need not have been in use at the time of filing the application; for unused marks, the applicant need only have intention to use the mark. The second clue lies in the distinctiveness provisions for Part A and Part B registrations.

Part A registration was for "distinctive" marks. Part B registration was for marks with "capacity to distinguish". The latter was for marks which did not qualify as "distinctive" marks for Part A purposes, but nonetheless had some amount of distinctiveness. In other words, the threshold of distinctiveness needed to qualify for Part B registration was lower than that for Part A registration.⁵⁰ (Protection for a Part B trade mark was correspondingly less strong than that for a Part A trade mark.)⁵¹ The concepts of distinctiveness for Part A and Part B were as follows:

- Part A—A "distinctive" mark was one with "adaptability to distinguish", that is, a mark which (i) was inherently adapted to distinguish the applicant's goods or services from those of other traders, and (ii) was in fact so adapted to distinguish as a result of use of the mark or of any other circumstances.⁵²

⁴⁸ *In Re Hudson's Trade Marks* (1886) L.R. 32 Ch. D. 311.

⁴⁹ S. 17(1) of the *U.K. Trade Marks Act 1938*. The equivalent in the *Singapore Trade Marks Act 1939* is s. 12(1).

⁵⁰ *In Re Davis' Trade Mark* [1927] 2 Ch. 345 at 355–356, *per* Lord Hanworth M.R. (noting that 'capable of distinguishing' is 'a somewhat more benevolent test' than 'adapted to distinguish').

⁵¹ The critical difference was this: where the defendant's mark and goods were identical to those of the plaintiff, and the defendant could show that his use was not likely to cause confusion, he would escape liability if the plaintiff's mark was in a Part B registration but not if it was a Part A registration. See ss. 4–5 of the *U.K. 1938 Act*, and ss. 45–46 of the *Singapore Trade Marks Act 1939*.

⁵² S. 9(1)(e), (2) and (3) of the *U.K. Trade Marks Act 1938*. The equivalent in the *Singapore Trade Marks Act 1939* is s. 10(1)(e), (2) and (3).

- Part B—A mark with “capacity to distinguish”, that is, one which (i) was inherently capable of distinguishing the applicant’s goods or services from goods of other traders, and (ii) was in fact so capable of distinguishing as a result of use of the mark or of any other circumstances.⁵³

The type of distinctiveness referred to in (ii) for both Part A and Part B registrations, which was derived by reason of the applicant’s use of the mark, sounded very similar to the common law concept of distinctiveness. I shall refer to type (ii) distinctiveness also as ‘*de facto* distinctiveness’. The other component of distinctiveness for Part A and Part B registration in (i) was a type of distinctiveness assessed by reference to the mark’s inherent nature to distinguish. For this reason, I shall refer to type (i) distinctiveness as ‘inherent distinctiveness’. It should be apparent from the above dissection that statutory distinctiveness was different from distinctiveness at common law: statutory distinctiveness was a wider concept, encompassing but not limited to *de facto* distinctiveness.

Whether a mark had inherent distinctiveness for Part A or Part B registration was determined by the same test, namely, Lord Parker’s “would-other-traders-legitimately-desire-to-use-the-mark” test under the *1905 Act*.⁵⁴ Therefore, if the mark was something which other traders would not want to use, it had inherent distinctiveness. The likelihood of the other traders not wanting to use the mark would vary depending on the nature of the mark, and this had a direct impact on the “quantum” or degree of inherent distinctiveness in the mark. In the context of descriptive marks, this is how it worked: the more descriptive the mark is in relation to the goods or services, the more likely other traders would wish to use the mark, and hence the less inherent distinctiveness this mark possesses. At some point on this spectrum—exactly where, no one knew—the degree of inherent distinctiveness in the mark would be too little for the purposes of Part A registration, but this degree would still be sufficient for the purposes of Part B registration. It stands to reason that it was possible for the tribunal to assess a mark as having not an iota of inherent distinctiveness, in which case, there would be no inherent distinctiveness for either Part A or for Part B. The degree of *de facto* distinctiveness in a mark may also vary, increasing in direct proportion to the length and intensity of the use and promotion of the mark. When a mark was, in the minds of all those in the relevant sector of the public, immediately and inextricably linked to a particular trader’s goods as a result of his use, the mark was said to have acquired “100% *de facto* distinctiveness”.

The assessment of a mark’s distinctiveness under the *1938 Act* would proceed as follows. The more inherent distinctiveness in a mark, the less *de facto* distinctiveness was needed to qualify it for registration. It was possible for a mark to have so much inherent distinctiveness that the applicant was spared from proving any prior use of the mark that may boost the distinctiveness of the mark in the form of *de facto* distinctiveness. An example would be the signature of the trade mark applicant—what legitimate reasons could other traders possibly have for wanting to use the signature of another trader, something so personal to him? This signature mark

⁵³ S. 10 of the *U.K. Trade Marks Act 1938*. The equivalent in the *Singapore Trade Marks Act 1939* is s. 11.

⁵⁴ For Part A registration, see *Smith Kline*, *supra* note 47 at 922, *per* Diplock L.J. For Part B, see *YORK Trade Mark* [1984] R.P.C. 231 at 254, *per* Wilberforce L.J. [York].

was therefore registrable without any prior use by the applicant.⁵⁵ From the policy angle, this could be justified because it achieved the objective of the registration system of providing the certainty that trade mark owners were looking for, without compromising the other objective of ensuring free and fair competition.

Conversely, the less inherent distinctiveness in a mark, the more *de facto* distinctiveness was needed to qualify it for registration. However, if the mark had no iota of inherent distinctiveness, it would not be registrable in Part A or Part B even if the mark was shown to have become 100% *de facto* distinctive of the applicant's goods or services. This was the effect of the House of Lords' decisions in two leading cases on distinctiveness, *YORKSHIRE Trade Mark*⁵⁶ and *YORK Trade Mark*.⁵⁷ This was a significant departure from the common law. We have seen that the common law imposes no legal bar to a mark becoming distinctive; it is all a matter of proving *de facto* distinctiveness and a mark found to be 100% *de facto* distinctive of a trader's goods would certainly be protected at common law. When the House of Lords held that, as a matter of law, certain marks were just not registrable in spite of proof of *de facto* distinctiveness, even 100% *de facto* distinctiveness, they were in effect imposing a *legal bar* to a mark being considered distinctive under the *1938 Act*.

An interesting question then arises. How can a mark without an iota of inherent distinctiveness be shown to have become *de facto* distinctive of the applicant's goods? If this is possible, does it not call into question the assumption that the factual bar would knock out such marks from protection? In the *YORKSHIRE* and *YORK* cases, the marks 'YORKSHIRE' for copper tubes and 'YORK' for freight containers were found not to have any inherent distinctiveness for the Part A and Part B registration respectively because these words were the names of very important cities with big industrial and manufacturing sectors.⁵⁸ In both cases, there was no challenge to the fact-finding tribunal's conclusion that the marks had acquired 100% *de facto* distinctiveness as a result of very extensive and long usage by the applicants. The House of Lords was called upon only to answer a purely a legal question, namely, whether *de facto* distinctiveness alone was sufficient to register a mark. These cases are therefore not ideal for investigating the question raised. There is one Singapore case which can throw some light on this. It is time for us to turn to the Singapore system.

B. *The Singapore Trade Marks Act 1939*

It was mentioned earlier that the *Singapore Trade Marks Act 1939* was very heavily modeled on the *U.K. 1938 Act*. Thus, the Singapore register was also split into Part A and Part B. The provisions on distinctiveness for these two parts in the *Singapore 1939 Act* were almost identical with the equivalent provisions in the *U.K. 1938 Act*.

⁵⁵ This is why the signature of the trade mark applicant was listed in the *U.K. 1938 Act* as an example of a 'distinctive' mark for the purposes of Part A registration. The other examples were the name of the applicant represented in a special or particular manner, non-descriptive words, and invented words. See s. 9(1)(a)–(d) of the *U.K. Trade Marks Act 1938* and s. 10(1)(a)–(d) of the *Singapore Trade Marks Act 1939*.

⁵⁶ [1954] W.L.R. 554 [*Yorkshire*]. This was a decision on Part A registration. See also the House of Lords in *A Bailey & Co. Ltd. v. Clark, Son & Morland Ltd.* (1938) 55 R.P.C. 253.

⁵⁷ See *York*, *supra* note 54. This was a decision on Part B registration.

⁵⁸ In the case of 'YORK', it was also a common surname in the U.K.

Not surprisingly, the courts in Singapore adopted the principles established in English cases interpreting these provisions on distinctiveness. It is useful to summarise what these principles are, by reference to Singapore cases. First, the registration system must be mindful that it did not create monopolies which prejudice other traders. Second, the test for determining if a mark had sufficient distinctiveness to qualify for registration was Lord Parker's test. Third, the threshold of distinctiveness required for Part B registration was lower than that for Part A registration. All these three principles can be found in the Court of Appeal decision in *Kellogg Co. v. Pacific Food Products Sdn Bhd*.⁵⁹ Fourth, a mark's *de facto* distinctiveness alone, even if it was 100% *de facto* distinctiveness, was insufficient to justify registration. This principle can be found in the Court of Appeal decisions in *Tobacco Importers and Manufacturers Sdn Bhd v. Registrar of Trade Marks*⁶⁰ and *Rainforest Coffee Products Pte. Ltd. v. Rainforest Café Inc.*⁶¹

The Singapore case which can provide the answer to the question raised in the last section is *Yomeishu Seizo Co. Ltd. v. Sinma Medical Products (S) Pte. Ltd.*⁶² The plaintiffs' registered trade mark for its medicated wine included the Chinese characters '养命酒'. The English transliteration of these characters is 'life nourishing wine'. The defendants' label for their wine from China '中国养命酒' (meaning 'China life nourishing wine') included the plaintiff's registered trade mark. They were sued for trade mark infringement and for passing off. The case came before Chan Sek Keong J. (as he then was) when the plaintiff applied for an interlocutory injunction. Chan J. dismissed the plaintiff's application. He had severe reservations about the validity of the plaintiffs' registered mark. He referred to the Privy Council decision in a Canadian trade mark case, *Canadian Shredded Wheat Co. Ltd v. Kellogg Co. of Canada Ltd.*⁶³ The product was shredded wheat made from the berries of wheat in a process involving boiling, drying, compression, mashing and passing through a special shredding machine. This product and the manufacture process were invented by the plaintiff. The plaintiff was also the one to coin the term 'shredded wheat' as a trade mark for this new product. The patents expired in 1914, but the plaintiff continued to enjoy a *de facto* monopoly over this product for many years thereafter. The defendants came into the market selling this product in 1934, calling it 'shredded wheat'. The Privy Council found that the defendants were not liable for the following reason:

It must be remembered that 'shredded wheat' was not only the name given by the inventor to a new product which could be baked into a biscuit, but was also descriptive of the product as to both its composition and its appearance. It must also be remembered that for a lengthy period the plaintiff company enjoyed a legal monopoly of making and selling in Canada the product shredded wheat baked into biscuits, and that ... the plaintiff company continued to be the sole maker of the product, baked or otherwise. In these circumstances, it was inevitable that the words 'shredded wheat' and shredded wheat biscuits should become associated in Canada with the goods of the plaintiff company, since many members of the

⁵⁹ [1999] 2 S.L.R. 651 at paras. 25 and at 7.

⁶⁰ [1975-1977] S.L.R. 161 at para. 10.

⁶¹ [2000] 2 S.L.R. 549 at paras. 46-47.

⁶² [1991] S.L.R. 499 [*Yomeishu Seizo*].

⁶³ [1938] 1 All E.R. 618.

public would get to know that the product shredded wheat was in fact the plaintiff company's product.

This, however, is far from establishing the required meaning of distinctiveness, which must carry with it the feature that the goods distinguished are the goods manufactured by a particular person, and by no other. A word, or words, to be really distinctive of a person's goods, must, generally speaking, be incapable of application to the goods of anyone else.⁶⁴

This passage makes clear the Privy Council's skepticism towards the argument that a trader's use of a generic description of the product could ever reach the point where the description becomes *de facto* distinctive of that trader's products to the exclusion of all others. There are really two aspects to the point made by the Privy Council. First, it is impossible to prove that as a result of prior usage the public associates the generic mark with the plaintiff exclusively—this is the factual bar mentioned earlier. Second, even if the evidence indicated that the public made the connection between the generic mark and the plaintiff exclusively, this may not be the kind of *de facto* distinctiveness that trade mark law is looking for.

The above passage from the Privy Council's judgment was cited with approval by Chan J. in the '养命酒' case. The plaintiff claimed that it had used the mark '养命酒' in Singapore for about 10 years prior to the registration of the mark. Chan J. considered this to be an irrelevant point. He clearly shared the Privy Council's skepticism about evidence of prior use when he said that the mark '养命酒' fell into the same category of expressions such as 'shredded wheat'.⁶⁵ It is submitted that the real message Chan J. intended to deliver is this: in cases involving marks which are generic or almost generic descriptions of the goods or services, there is no point looking at prior usage of the mark by the plaintiff at all. It would not be useful, and even worse, there would be a risk of the tribunal being misled into thinking that the prior use has conferred *de facto* distinctiveness on the mark when that is not the case. It is further submitted that this judge-made legal bar is now enshrined in the distinctiveness concept in the *Singapore Trade Marks Act 1999*.

IV. DISTINCTIVENESS IN THE *SINGAPORE TRADE MARKS ACT 1999*

The *Singapore Trade Marks Act 1939* was repealed and replaced by the *Singapore Trade Marks Act 1999* with effect from 15 January 1999. According to *Hansard*, the reasons for enacting the *1999 Act* included the need to comply with Singapore's obligations under the *WTO/TRIPS Agreement*⁶⁶ and to modernise and simplify trade mark law.⁶⁷ The simplification of trade mark law took the form, *inter alia*, of abolishing the distinction between Part A and Part B of the register.⁶⁸ This was also

⁶⁴ *Ibid.* at 631.

⁶⁵ *Yomeishu Seizo*, *supra* note 62 at 505.

⁶⁶ *Agreement on Trade-Related Aspects of Intellectual Property Rights*, Apr. 15, 1994, *Marrakesh Agreement Establishing the World Trade Organisation*, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [*WTO/TRIPS Agreement*].

⁶⁷ See speech of Minister of State for Law, Associate Professor Ho Peng Kee in Sing., *Parliamentary Debates*, vol. 69, col. 1698 (29 November 1998) [*Hansard*].

⁶⁸ *Ibid.* at col. 1700-1701. It was also revealed that almost all applications filed under the *Singapore Trade Marks Act 1939* were for registration in Part A.

said of the substantive law governing registration:

[The 1999 Act] provid[es] for less stringent criteria for registration of trade marks. This will make it easier for proprietors to obtain registration. The test for registrability will generally be similar to that for a Part B registration under the present Trade Marks Act [1939], that is, a mark must be capable of distinguishing the goods or services of its proprietor.⁶⁹

In the *1999 Act*, the distinctiveness criterion is found in section 7(1)(a)-(d) and (2). Section 7(1)(a)-(d) has to be read with the definition of ‘trade mark’ in Section 2(1) wherein reference is made to a type of distinctiveness, namely, the mark’s capacity to distinguish. Combining this aspect with section 7, and taking the liberty of substituting ‘sign’ with ‘mark’, this is what the distinctiveness provisions look like:

- 7(1) The following shall not be registered:
- (a) marks which has no capacity to distinguish 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 persons;
 - (b) marks with such capacity to distinguish, which are devoid of any distinctive character;
 - (c) marks with such capacity to distinguish, which consist exclusively of marks 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; and
 - (d) marks with such capacity to distinguish, which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- 7(2) A mark which has such capacity to distinguish shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Within these provisions, what is covered by section 7(2) is probably the most familiar—this refers to distinctiveness that may result from use and promotion of the mark prior to the date of application. This is *de facto* distinctiveness existing as at the date of the application.⁷⁰ Apart from this, it is not immediately apparent what the scope of each paragraph in section 7(1) is and the relationship between them and with section 7(2). What is a mark which does not have ‘capacity to distinguish’ in paragraph (a)? What is a mark which has capacity to distinguish but which is devoid

⁶⁹ *Hansard*, *supra* note 67 at col. 1701.

⁷⁰ On the point of *de facto* distinctiveness, there is another provision which is relevant when the mark is already registered and the validity of this registration is challenged in rectification proceedings under s. 23. This is s. 23(2) which provides that, if the registration was found to be invalid on the basis of s. 7(1)(b)-(d), it shall not be declared invalid if, in consequence of the use of the mark which has been made of it, it has after registration acquired a distinctive character. This means that, while s. 7(2) looks at whether the mark has acquired *de facto* distinctiveness as at the time of the application for registration, s. 23(2) looks at whether the mark has acquired *de facto* distinctiveness after the date of the application for registration.

of distinctive character in paragraph (b)? Since section 7(2) is expressed to be applicable to a mark falling into paragraphs (b)-(d) only, this must mean that section 7(2) cannot apply to marks falling into paragraph (a)—why, and what is the impact of this exclusion?

It is well known that these provisions are modeled on in section 3(1)(a)-(d) and its proviso in the *U.K. Trade Marks Act 1994*, the successor to the *U.K. 1938 Act*. These English provisions, in turn, mirror Articles 3(1)(a)-(d) and (3) of the *EU Trade Marks Directive 1988*. Perhaps less well known is the fact that these English/European provisions are themselves amalgamations of the distinctiveness provision found in the *Paris Convention for the Protection of Industrial Property (1967)*⁷¹ and in the *WTO/TRIPS Agreement*.⁷² However, there is not much else that these international instruments, or their *travaux préparatoire*, say that can help clarify the questions raised about the provisions.⁷³ In the U.K., these questions have been answered by the English courts and by the European Court of Justice (ECJ). In Singapore, we have three decisions on distinctiveness from our courts which merit very close attention. They are (decided in this sequence): *Nation Fittings*,⁷⁴ *LOVE*,⁷⁵ and

⁷¹ 21 U.S.T. 1583 [*Paris Convention*]. See Art. 6 *quinquies*. B(2) providing that registration of the following may be refused or invalidated:

Marks which are devoid of distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed. In determining the distinctive character of a mark, all the factual circumstances must be taken into consideration, particularly the length of the time the mark has been in use.

This provision was introduced into the *Paris Convention* by the *Act of Washington 1911*. This provision in the *Paris Convention* also forms part of the obligations to be complied with by WTO members: see Art. 2(1) of the *WTO/TRIPS Agreement*, *supra* note 66.

⁷² See *WTO/TRIPS Agreement*, *ibid*. In particular, the concept of a mark's "capacity to distinguish" is found in Art. 15(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.

⁷³ Note, though, that on the ambit of Art. 6 *quinquies*. B(2) of the *Paris Convention*, Mr. Arpad Bogsch (former Director-General of WIPO, the international organisation responsible for administering the Paris Convention) had this to say in his book, *The First Hundred Years of the Paris Convention for the Protection of Industrial Property*, 22 *INDUS. PROP.* 187, 195-212 (1983) at p. 42:

Lack of distinctive character was illustrated at the same time by trademarks that consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production of the goods, and by trademarks that have become customary in the current language or in the bona fide and established practices of the trade of the country, It is customary to say...that a trademark which merely designates the kind, quality, etc., of the goods is "descriptive", whereas the signs or indications that have become customary in the current language are "generic". For example, 'nylon'—originally a protected trademark—has, because of the way it is now used in the current language, become, in most countries, generic and can no longer enjoy trademark protection.

⁷⁴ *Nation Fittings (M) Sdn Bhd v. Oystertec Plc.* [2006] 1 S.L.R. 711 [*Nation Fittings*].

⁷⁵ *Love & Co. Pte. Ltd. v. The Carat Club Pte. Ltd.* [2009] 1 S.L.R. 561 [*Love & Co.*].

Rooster Brand.⁷⁶ The first two are decisions of the High Court, and the third is the first case on distinctiveness from the Court of Appeal. It is also necessary to mention another case. This is *Richemont International SA v. Da Vinci Collections Pte. Ltd.*, where Ang J. said this:

It is clear that a mark or sign that is merely descriptive of certain characteristics of goods or services is denied protection because it is in the public interest that they be freely used by all.⁷⁷

It is plain that *publici juris* is still the driving force behind the distinctiveness criterion in the 1999 Act.⁷⁸ This sets the stage for us to examine section 7(1)(a)-(d) and section 7(2).

A. *What is the Intra-relationship Between Sections 7(1)(b)-(d),
and Their Relation to Section 7(2)?*

These are the easy questions. Paragraph (b) rejects marks which are devoid of distinctive character. Paragraph (c) rejects descriptive marks. Paragraph (d) rejects marks which, for the time being and for convenience, will be called “marks customary in the trade”. It is well established that, of these three, paragraph (b) is the broadest in scope. In the *LOVE* case, Chan Seng Onn J. described (b) as “akin to a sweep up ‘exclusion from registration clause’ for trade marks that lack an inherent distinctive character”.⁷⁹ To put it another way, descriptive marks in paragraph (c) and marks customary in the trade in paragraph (d) are specific examples of marks which are devoid of distinctive character. Chan J. also held that, although there was an overlap between these three paragraphs, each of them operated independently.⁸⁰ Therefore, a mark that offends any of these three paragraphs is not registrable (unless it has acquired sufficient *de facto* distinctiveness and is thereby ‘saved’ by sub(2)).

It has also been established that the distinctive character of a mark for the purposes of paragraphs (b)-(d) is assessed by reference to the mark on its own, assuming no use. In the *LOVE* case, Chan Seng Onn J. held that the distinctive character of a mark “arises from the inherent nature, features and characteristics of the mark, absent consideration of any use by the trade mark applicant in relation to his goods

⁷⁶ *Wing Joo Loong Ginseng Hong (Singapore) Co. Pte. Ltd. v. Qinghai Xinyuan Foreign Trade Co. Ltd.* [2009] 2 S.L.R. 814 [*Rooster Brand*].

⁷⁷ [2006] 1 S.L.R. 401 at para. 38. For this proposition, Ang J. cited the decision of the ECJ in *OHIM v. Wm Wrigley Jr. Company (Doublemint)* [2004] R.P.C. 18.

⁷⁸ The U.K. endorses the same policy: see *Procter & Gamble Ltd.’s Trade Mark Applications* [1999] R.P.C. 673 at 679 [*Procter & Gamble*], where Robert Walker L.J. said that when determining if a mark had ‘distinctive character’ for the purposes of s. 3(1)(b) of the *U.K. Trade Marks Act 1994*, the guiding principle was to have in mind “traders who are in competition with each other in the marketplace, and to whom Parliament wishes to accord proper protection but not any exorbitant monopoly”.

⁷⁹ *Love & Co.*, *supra*, note 75 at para. 44. The U.K. has the same principle: see *Procter & Gamble, ibid.* (Robert Walker L.J. described paragraph (b) as performing a “residual or weeping-up function, backing up paragraphs (c) and (d)”). See also Advocate-General’s Opinion in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v. Boots- und Segelzubehör Walter Huber* [2000] 2 W.L.R. 205 at paras. 28-29.

⁸⁰ *Love & Co.*, *supra* note 75 at para. 45.

or services”.⁸¹ The judge also gave this very useful test to help determine whether a mark possesses inherent distinctive character:

The relevant question to bear in mind (assuming no prior use whatsoever by the trader) will be whether the average discerning consumer operating in that market place and environment can readily and immediately identify the trade mark, viewed as a whole, to be unequivocally designating the goods or services originating from the particular trader when he first encounters the trade mark on the goods or services—or will the average discerning consumer be unclear or uncertain as to the commercial source or origin of the goods or services nevertheless?⁸²

A descriptive mark, by this test, obviously has no inherent distinctive character since the average consumer would see the mark, first and foremost, as a description of the goods or services.

If distinctive character in sections 7(1)(b)-(d) is understood in terms of the mark’s inherent nature to distinguish, then the relationship between these paragraphs and section 7(2) is not difficult to understand. A mark without inherent distinctive character—for example, it is descriptive of the goods—but which is shown to have acquired *de facto* distinctiveness, as at the date of the application, satisfies the distinctiveness criterion in the *1999 Act*. Unlike the *1939 Act* which barred marks from registration based solely on its *de facto* distinctiveness, no such legal bar exists within sections 7(1)(b)-(d) and section 7(2). [But, as we shall see in a little while, the legal bar exists somewhere else.]

It is appropriate at this junction to take stock of what we have learnt about distinctiveness at common law, under the *1939 Act* and under the *1999 Act*. The differences may be illustrated in terms of these ‘formulae’:

Passing off:	Distinctiveness = <i>De facto</i> distinctiveness
<i>1939 Act</i> :	Distinctiveness = Inherent distinctiveness and <i>de facto</i> distinctiveness
<i>1999 Act</i> , s. 7(1)(b)-(d) and s. 7(2):	Distinctiveness = Inherent distinctive character or <i>de facto</i> distinctiveness

To the extent that it is now possible to register a mark based on its *de facto* distinctiveness alone, the current law has relaxed the distinctiveness criterion compared to the old law. In this regard, the *1999 Act* does provide for “less stringent criteria for registration of trade marks” as indicated in *Hansard*.⁸³ However, the above ‘formula’ of distinctiveness for the *1999 Act* is derived from the notion of “distinctive character” as set out in sections 7(1)(b)-(d) and section 7(2). It is not a complete one because there is still section 7(1)(a) to contend with.

B. What Does Section 7(1)(a) Add to the Above Analysis? Does it Embody a Third Threshold of Distinctiveness?

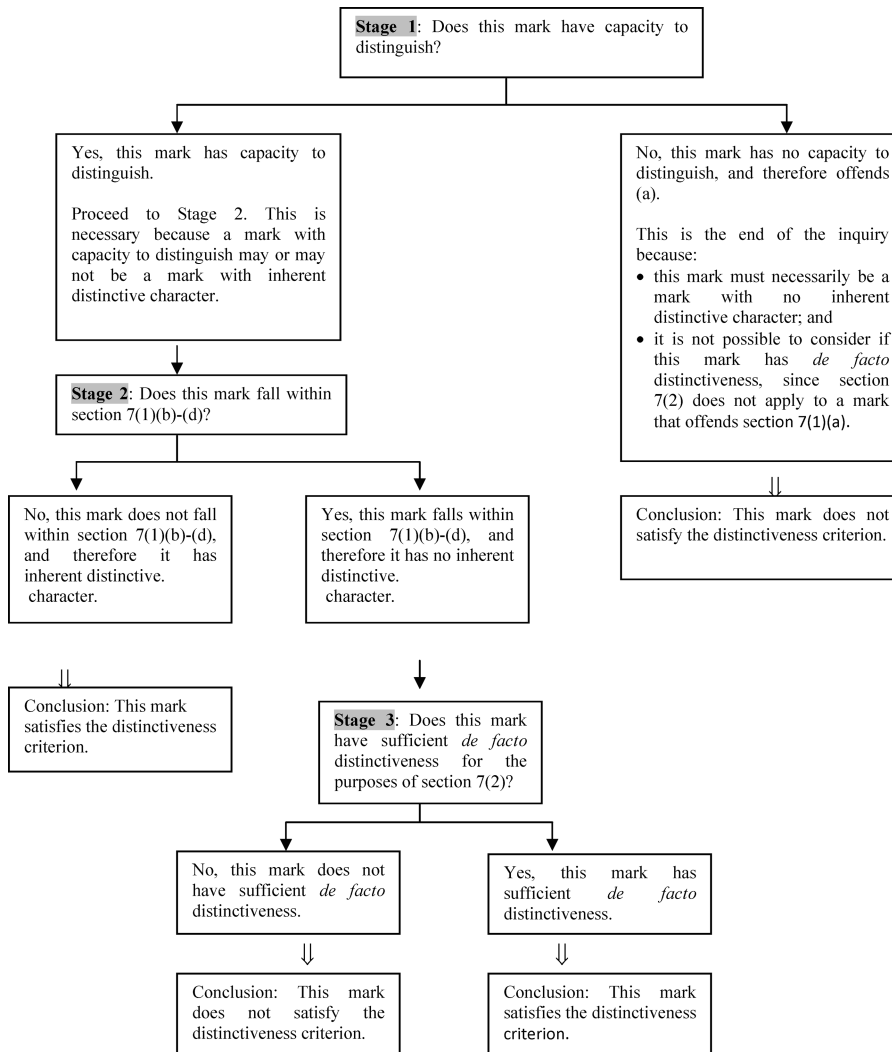
Section 7(1)(a) envisages that there are marks which have no capacity to distinguish. Such marks are not registrable. Sections 7(1)(b)-(d) envisage that

⁸¹ *Ibid.* at para. 35. The U.K. has the same principle: see *British Sugar*, *supra* note 31 at 306.

⁸² *Ibid.*

⁸³ *Supra* note 67.

there are marks which have capacity to distinguish, but which do not have distinctive character. Such marks are also not registrable. This must mean that there are two different thresholds of distinctiveness: capacity to distinguish, and distinctive character, with capacity to distinguish as the lower threshold. Two conclusions follow from this proposition. First, a mark without capacity to distinguish is necessarily a mark without inherent distinctive character, and secondly, a mark with capacity to distinguish may be a mark without inherent distinctive character. When the capacity-to-distinguish threshold and the inherent-distinctive-character threshold are combined with *de-facto*-distinctiveness threshold in section 7(2), the number of thresholds of distinctiveness in the 1999 Act totals three. Below is a diagrammatic representation of the 3-stage inquiry that should, at least in theory, apply to the assessment of a mark's distinctiveness under the 1999 Act.

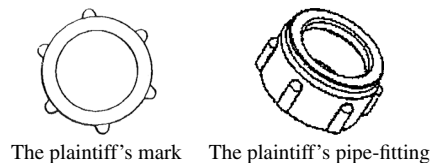


It is also possible to look at the impact of paragraph (a) by expanding on the ‘formula’ of distinctiveness devised on the basis of sections 7(1)(b)-(d) and section 7(2):

1999 Act, ss. 7(1)(a)-(d) and 7(2): Distinctiveness = Capacity to distinguish and inherent distinctive character; or Capacity to distinguish and *de facto* distinctiveness

From this final ‘formula’ of distinctiveness, it is obvious that the mark’s capacity to distinguish is the prerequisite to the whole assessment of distinctiveness under the *1999 Act*. Because section 7(2) does not permit the reliance on *de facto* distinctiveness acquired as a result of prior use in cases where the mark lacks capacity to distinguish, the capacity-to-distinguish threshold actually operates as a *legal* bar to registration. It is in this way that the legal bar exists in the current law, as much as there was one in the *1939 Act*. Section 7(2), in effect, enshrines that principle which emerged from the ‘养命酒’ case, namely, in cases involving generic or almost generic marks like ‘养命酒’ and ‘shredded wheat’—which, in the *1999 Act*, are called marks with no capacity to distinguish—it is irrelevant to look to prior use of the mark because such use will never result in true *de facto* distinctiveness.

The above analysis of distinctiveness under the *1999 Act* is based on a statutory interpretation of section 7(1)(a)-(d) and section 7(2). This is the interpretation which is favoured by the Singapore courts. The first case on this point is *Nation Fittings*.⁸⁴ The plaintiff’s mark was the two-dimensional plan view of the shape of a pipe-fitting (that is, viewed from the top). The plaintiff’s mark and the three-dimensional version of its pipe-fitting are shown below.



The plaintiff’s mark The plaintiff’s pipe-fitting

There was an advantage to having a round-shaped pipe-fitting with ‘ribs’ around it: this pipe-fitting could be used in concealed pipes where the fastening of the pipe-fitting could be more easily achieved by the use of a hammer and screwdriver.⁸⁵ Andrew Phang J. (as he then was) held that this mark did not pass “even the relatively low threshold criterion” of capacity to distinguish and, as such, it would follow that the mark had no inherent distinctive character for the purposes of paragraph (b).⁸⁶ The inquiry for distinctiveness for the purposes of registration did not proceed any further than this.

Subsequently, in *LOVE*, Chan Seng Onn J. also held that a mark must first pass the capacity to distinguish test.⁸⁷ The judge provided this very useful Venn diagram,

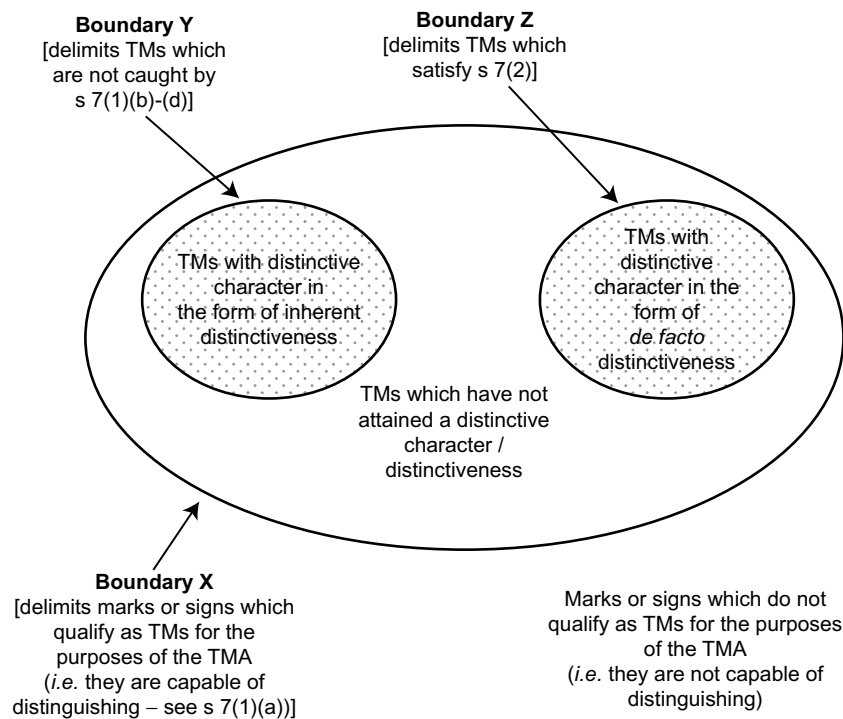
⁸⁴ *Supra* note 74.

⁸⁵ *Ibid.* at para. 171.

⁸⁶ *Ibid.* at paras. 136-137.

⁸⁷ *Love & Co.*, *supra* note 75 at para. 48.

to illustrate the interplay between the three thresholds of distinctiveness:



The mark before Chan J. was the word ‘LOVE’ *simpliciter*. He held that this mark had capacity to distinguish in the context of the goods in question (jewellery), but it did not have any inherent distinctive character for the purposes of sections 7(1)(b) and (c). The judge also found that this mark had not acquired any *de facto* distinctiveness.

Finally, the three-threshold test of distinctiveness was affirmed by the Court of Appeal in the *Rooster Brand*⁸⁸ case. The mark was a picture of a rooster, the English words “ROOSTER BRAND” and their Chinese equivalent 雄雞. It is set out below.



The goods in this case were cordyceps. At first glance, it is not immediately apparent why distinctiveness was an issue in this case. Cordyceps are used in Traditional Chinese Medicine because they are believed to improve blood circulation, strengthen the immune system and benefit the human body in other ways. They are actually fungi which grow on a type of caterpillar found in the high altitudes of some Asian countries, notably China, where this fungus is called 冬蟲夏草. Apart from the caterpillar,

⁸⁸ *Supra* note 76.

no other animal—and definitely not the rooster—is associated with cordyceps. The complaint that the mark lacked distinctiveness was based on the allegation that the rooster mark was a common mark used by various suppliers of cordyceps from China and, to the relevant public (the traders and consumers of cordyceps, who were mainly Chinese), this mark meant cordyceps from China. This complaint resembled that advanced in the 1899 *Eagle Brandy* case, where it was shown that the symbol of the eagle, although *prima facie* having no descriptive connotations in the context of brandy, was used by traders to sell cheap and inferior brandy to the extent that the ‘natives’ in Singapore described this inferior class of brandy by the Malay term ‘*chop burong*’.

If the eagle can be descriptive of a class of brandy, it is not impossible for the rooster to be descriptive of a class of cordyceps. It was a matter of adducing evidence to prove that the symbol of a rooster had this descriptive connotation. The evidence in this case convinced Kan Ting Chiu J. sitting in the High Court that the mark was descriptive. He found that the term ‘rooster cordyceps’ was understood amongst the relevant public to mean cordyceps originating from China, although the degree of descriptiveness was not such that the rooster mark itself was seen to be synonymous with cordyceps, not the way the word ‘thermos’ is synonymous with vacuum flasks.⁸⁹ However, the Court of Appeal was not convinced that the evidence showed *any* link between roosters and cordyceps in general or specifically to cordyceps originating from China,⁹⁰ and hence overturned Kan J.’s finding of fact.

Nonetheless, the Court of Appeal went on to deal with the arguments on lack of distinctiveness. There were two allegations: first, the rooster mark had no capacity to distinguish [section 7(1)(a)], and secondly, it was a mark with no inherent distinctive character because it was customary in the trade [section 7(1)(d)]. The Court of Appeal gave a detailed analysis of these two paragraphs. One important aspect of its judgment is the affirmation of the presence of three thresholds of distinctiveness in sections 7(1)(a)-(d) and (2). On this, it specifically approved the approach taken in *Nation Fittings* which treated the capacity to distinguish requirement as a “threshold criterion” that must be satisfied.⁹¹ It also referred to the ECJ’s decision in *Philips Electronics NV v. Remington Consumer Products Ltd.*⁹² This is the landmark case on the interplay of Articles 3(1)(a)-(d) and Article 3(3) in the *EU Trade Marks Directive*, the equivalents of our sections 7(1)(a) and 7(2) respectively. The Court of Appeal referred to this passage of the ECJ’s judgment:

[T]here is no category of marks which is not excluded from registration by Art 3(1)(b), (c) and (d) and Art 3(3) of the Directive which is none the less excluded from registration by Art 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.⁹³

⁸⁹ [2008] 3 S.L.R. 292 [*Rooster Brand (H.C.)*] at para. 33. For my further analysis of Kan J.’s judgment, see Chapter 7 on “Intellectual Property” in the *Singapore Academy of Law Annual Review of Singapore Cases 2008*, at paras. 17.16-17.27.

⁹⁰ *Rooster Brand*, *supra* note 76 at para. 64.

⁹¹ *Ibid.* at para. 96.

⁹² [2003] R.P.C. 2 [*Philips*].

⁹³ *Rooster Brand*, *supra*, note 76 at paras. 95-96, quoting from para. 40 of the ECJ’s judgment.

According to the Court of Appeal, this passage accorded with the approach taken in *Nation Fittings*. In other words, the Court of Appeal believes that the ECJ set out three thresholds of distinctiveness for the EU. It must be noted that the Court of Appeal's interpretation of the ECJ's decision in the *Philips* case is not shared by some academics in the EU or the U.K. The alternative interpretation from these writers, one might even say, points in exactly the opposite direction. This alternative interpretation is premised on the ECJ's confirmation, made in the passage cited above, that every mark with inherent distinctive character must necessarily be one with capacity to distinguish and every mark with *de facto* distinctiveness must necessarily be one with capacity to distinguish. This being the case, these writers argue, the real gate-keepers that keep out non-distinctive marks from the register are the inherent distinctive character threshold and the *de facto* distinctiveness threshold. Therefore, an inquiry under Articles 3(1)(a)-(d) and Article (3) can ignore the capacity to distinguish threshold altogether, and instead focus on assessing if the mark has inherent distinctive character or *de facto* distinctiveness. This interpretation of the *Philips* case changed the approach in the U.K. after 18 June 2002 (the day on which the ECJ delivered its judgment). Where previously the U.K. courts assessed the distinctiveness criterion by applying the three-threshold approach,⁹⁴ the assessment post-*Philips* involves a two-threshold approach. This explains why the U.K. Court of Appeal in 2003 was able to dismiss the words 'capacity to distinguish' as being "merely epeexegetical of the inherent distinctive character and *de facto* distinctiveness thresholds".⁹⁵

The Court of Appeal in *Rooster Brand* was fully aware of this alternative interpretation given to the *Philips* case. For example, it referred to Professors Lionel Bently and Brad Sherman who took the position that the *Philips* ECJ's case stood for the proposition that Article 3(1)(a) was not a separate ground for invalidating the registration of a trade mark.⁹⁶ Nonetheless, the Court of Appeal preferred the three-threshold approach. It specifically pointed out that the three-threshold approach was supported by the express wordings of sections 7(1)(a)-(d) and 7(2). Elsewhere, in an article analysing the *Nation Fittings* case, where I had highlighted the two-threshold approach taken in the EU, I had given 'conceptual clarity' as a reason in support of the three-threshold approach adopted by the High Court in Singapore.⁹⁷ This article expands on this reason, formulating it in terms of the furtherance of the policy to keep free what is *publici juris*. This policy is so important that the registration system, in the *1939 Act* and now in the *1999 Act*, has seen it fit to put in place a legal bar to distinctiveness that is missing in the common law system. In the *1999 Act*, it is

⁹⁴ See e.g., *British Sugar*, *supra* note 31 ; *AD2000 Trade Mark* [1997] R.P.C. 168; *Philips Electronics NV v. Remington Consumer Products Ltd.* [1998] R.P.C. 283; *JERLY LYNN Trade Mark* [1999] F.S.R. 491; *Rugby Football Union and Nike European Operations Netherlands BV v. Cotton Traders Ltd.* [2002] E.T.M.R. 76 [*Rugby Football Union*]; *Premier Luggage & Bags Ltd. v. Premier Co. (U.K.) Ltd.* [2002] E.T.M.R. 69.

⁹⁵ *West (t/a Eastenders) v. Fuller Smith & Turner Plc.* [2003] F.S.R. 44 at para. 62.

⁹⁶ *Rooster Brand*, *supra* note 76 at para. 99 where the court referred Lionel Bently & Brad Sherman, *Intellectual Property Law*, 2nd ed. (New York: Oxford University Press, 2004) at 799.

⁹⁷ Ng-Loy Wee Loon, "Time to Re-thin the Ever Expanding Concepts of Trade Marks? Re-Calibrating Singapore's Trade Mark Law after the US-Singapore FTA" [2008] E.I.P.R. 151 at 156. See also Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Singapore: Sweet & Maxwell Asia, 2008) at para. 21.3.6.

submitted that this legal bar takes the form of the capacity-to-distinguish threshold. It acts to avoid the risk of trade mark law creating undeserving monopolies for marks which are the generic description of the goods or services.

Marks which are generic descriptions to the goods or services are not limited to word marks. They can also be marks which are the shape of the goods like the one in the *Nation Fittings* case, and even marks which are the smell of the product. For 3-dimensional shape marks, it is true that there are other provisions in the *1999 Act*, namely, sections 7(3)(a)-(c), that can be invoked to reject certain natural, functional and ornamental shapes of the goods.⁹⁸ In the case of smell marks and other non-visually perceptible marks, the requirement for graphic representation in the definition of 'trade mark' in section 2(1) would present obstacles to their registration.⁹⁹ The fact that other provisions exist that may prevent registration is not a good reason to ignore the legal bar in the form of the capacity to distinguish threshold. There would be cases where these other provisions do not or cannot apply. For example, the mark in the *Nation Fittings* case was a two-dimensional mark and therefore sections 7(3)(a)-(c) could not be considered.

*C. Since Singapore Has the 'Capacity-to-Distinguish' Threshold
in Section 7(1)(a), What Does This Threshold Sieve Out?*

From the discussion so far, it should be apparent what the submission will be on this question. The types of marks that cannot cross the 'capacity-to-distinguish' threshold are marks which are generic descriptions of the goods or services, or so descriptive that they could be considered generic descriptions. Before the ECJ judgment in the *Philips* case, when the English courts still gave consideration to the capacity-to-distinguish requirement as a threshold, there are two cases which support this proposition. The first is *British Sugar Plc. v. James Robertson & Sons Ltd.*, where Jacob J. (as he then was) said that 'SOAP' for soap was a mark with no capacity to distinguish.¹⁰⁰ The second case is *JERYL LYNN Trade Mark* where the late Laddie J. said that the proper name of a product cannot be a mark with capacity to distinguish.¹⁰¹ In this case, the mark was 'Jerly Lynn', the name given to a particular strain of mumps virus. It was held that it had no capacity to distinguish in relation to the goods in question, which was the vaccine for this mumps virus.

In Singapore, the *LOVE* and *Rooster Brand* cases are authorities for this proposition. In the *LOVE* case, Chan Seng Onn J. gave the following as examples of word marks which would probably not have any capacity to distinguish in the context of jewellery: 'JEWELLERY', 'GOLD' and 'DIAMONDS'. These words, he explained, were so descriptive of jewellery that they were "nearly synonymous with jewellery itself".¹⁰² The word mark 'LOVE' that he had to consider, on the other hand, had

⁹⁸ This is how the Advocate-General in the *Philips* case described the ambit of Art. 3(1)(e) of the EU Trade Marks Directive, which is the equivalent of our s. 7(3)(a)-(c): [2001] R.P.C. 38 at para. 16.

⁹⁹ This graphic representation requirement has been strictly interpreted by the ECJ in *Sieckmann* [2003] R.P.C. 38, a case that has been cited in Singapore with approval: see *Nation Fittings*, *supra* note 74 at para. 47.

¹⁰⁰ [1996] R.P.C. 281 at 302.

¹⁰¹ [1999] F.S.R. 491.

¹⁰² *Love & Co.*, *supra* note 75 at para. 40.

capacity to distinguish because it was “plainly not generic of jewellery”.¹⁰³ In the *Rooster Brand* case, the Court of Appeal considered a mark comprising the word ‘cordyceps’ or a picture of cordyceps as marks which had no capacity to distinguish cordyceps.¹⁰⁴ More will be said of this aspect of the decision in a little while.

Another local case on this point is the *Kopitiam* case. The Singapore Trade Mark Registry held that the word ‘kopitiam’ had no capacity to distinguish because it was “so commonly and generically used in the local parlance to mean an eating place or coffee shop”.¹⁰⁵

D. *Since the ‘Capacity-to-Distinguish’ Threshold Sieves Out Generic Marks, What is the Interplay Between Sections 7(1)(a) and (d)?*

There is one more knot that needs to be unraveled. According to the Court of Appeal in the *Rooster Brand* case, generic marks are dealt with under section 7(1)(d).¹⁰⁶ Marks falling within section 7(1)(d) thus far have been referred to as “marks customary in the trade”. The exact expression used in this provision is the following:

marks which are capable of distinguishing which consists of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

In holding that genericism was dealt with under section 7(1)(d), the Court of Appeal relied on *Hormel Foods Corp. v. Antilles Landscape Investments NV* where the U.K. High Court held that the essence of the objection in paragraph (d) was that the mark was “generic either amongst the general public or amongst the trade”.¹⁰⁷ It should be noted that this English case was decided after the ECJ judgment in *Philips*. Since the effect of the *Philips* case is to do away with the ‘capacity-to-distinguish’ threshold in paragraph (a), generic marks in the U.K. must be dealt with under paragraph (d). In Singapore, where the capacity to distinguish threshold is very much an alive one, it is necessary to examine more closely what is the divide between paragraphs (a) and (d) in the treatment of generic marks. There are two possible ways of reconciling these two paragraphs.

The first option focuses on the two words “have become” in paragraph (d). In this option, both paragraphs (a) and (b) deal with generic marks but with this distinction: (a) is targeted at marks which are *ab initio* generic marks, whereas (d) is targeted at marks which *have become* generic descriptions by the time of the trade mark application. Take, for example, two applications are filed today to register ‘SOAP’ for soap, and ‘ESCALATOR’ for moving staircase. The ‘SOAP’ application would be caught by paragraph (a) because ‘SOAP’ is the generic word *ab initio* for soap. The ‘ESCALATOR’ application, on the other hand, would be caught by paragraph (d) because the word ‘ESCALATOR’ started off as an invented word but it has become the proper noun for the goods themselves by the time the application is filed.

¹⁰³ *Ibid.* at para. 50.

¹⁰⁴ *Rooster Brand*, *supra* note 76 at para. 100.

¹⁰⁵ *Kopitiam*, *supra* note 2 at para. 42.

¹⁰⁶ *Rooster Brand*, *supra* note 76 at paras. 72 and 74.

¹⁰⁷ *Hormel Foods Corp. v. Antilles Landscape Investments NV* [2005] R.P.C. 28 at para. 155. The Court of Appeal also referred to ECJ decisions such as *Alcon Inc v. OHIM* [2005] E.T.M.R. 69.

This first option finds support in the Court of Appeal's judgment in *Rooster Brand*. The appellate court gave its support in this context. The rooster mark was alleged to have no capacity to distinguish because other traders of Chinese cordyceps were using the rooster mark at the time the applicant filed the application. In the High Court, Kan J. took into account the prior use of the rooster mark by 'multiple users' in his conclusion that the mark had no capacity to distinguish the applicant's goods from those of other traders.¹⁰⁸ In arriving at this conclusion, the judge relied on the English case, *Bach and Bach Flowers Remedies Trade Marks*.¹⁰⁹ In this case, there was a Dr. Edward Bach who created herbal remedies which he called "Bach Flower Remedies". He encouraged others to make and use his herbal remedies and to call them by this name. Over time, and specifically by 1979, retailers and the general public used the words "Bach Flower Remedies" and even the word 'Bach' as a generic term to describe herbal remedies made in accordance with Dr. Bach's teachings and recipes. In 1979, some followers of Dr. Bach registered the word 'Bach' in respect of herbal preparations derived from herbs or flowers for medicinal purposes. In 1997, there was an application to expunge the registered mark 'Bach' from the register on the grounds that it lacked distinctiveness. The hearing of this application before the U.K. Court of Appeal took place before the ECJ decision in *Philips*, and therefore the U.K. Court of Appeal approached distinctiveness using the three-threshold approach. On the question whether the mark 'Bach' had capacity to distinguish at the time of the application in 1979, the U.K. Court of Appeal held that it was permissible to have regard to prior use of the mark when assessing a mark for capacity to distinguish. In this case, the mark 'Bach' had no capacity to distinguish since, by the date of the trade mark application, it had become generic through use.

The Court of Appeal in *Rooster Brand* disagreed with Kan J.'s approach in using prior use of the mark to decide the question of capacity to distinguish. The appellate court preferred the other approach, taken by the U.K. Court of Appeal in *Philips*, which assesses a mark's capacity to distinguish by reference to the inherent features of the mark alone.¹¹⁰ It held that, unlike a mark comprising the word 'cordyceps' or a picture of cordyceps, the rooster mark was clearly capable of distinguishing one trader's cordyceps from those of other traders. In other words, the rooster mark, on its own and with no reference to any prior use, had no descriptive meaning whatsoever for cordyceps. As for the *Bach* case, the Court of Appeal remarked that it might perhaps have been better dealt with under paragraph (d) as a mark which had become customary through use. This indicates that, in the appellate court's mind, a mark which is generic *ab initio* (such as 'cordyceps' for cordyceps) falls into paragraph (a) whereas a mark which has become generic by the time of the application (such as the one in the *Bach* case) falls into paragraph (d).

The second way of reconciling paragraphs (a) and (d) is to focus on the words "of the trade" in paragraph (d). This second option, like the first option, allows both paragraphs (a) and (d) to deal with genericism but the distinction lies in the *degree* of genericism: (a) is targeted at marks which are generic *to the general public* (whether they are generic *ab initio* or became generic through use) whereas (d) is targeted at marks which have become generic *to the trade* only. In this second

¹⁰⁸ See *Rooster Brand (H.C.)*, supra note 89 at para. 45.

¹⁰⁹ [2000] R.P.C. 513.

¹¹⁰ *Rooster Brand*, supra note 76 at para. 96, citing *Philips*, supra note 92 at 817.

option, the mark in the *Bach* case would be dealt with under (a) because the evidence showed that not only those in the trade such as the retailers and manufacturers of flower herbal remedies, but the general public also referred to the herbal remedies by the name 'Bach'. A case involving a mark which has a generic meaning only to the trade is the ECJ decision in *Alcon Inc. v. OHIM*.¹¹¹ The mark was 'BSS' and the specification of goods listed "ophthalmic pharmaceutical preparation and sterile solutions for ophthalmic surgery". To the general public, 'BSS' has no meaning in relation to these goods. But to those in the relevant trade, that is, ophthalmologists and ophthalmic surgeons, 'BSS' was readily understood to mean 'balanced salt solution' or 'buffered saline solution' which were goods falling within the specification of goods. The mark was refused registration under paragraph (d).

Which is the more appropriate interplay between paragraphs (a) and (d)? From the statutory interpretation point of view, the second option may be a weaker case because it requires reading paragraph (d) as if it contains two commas in the following locations:

marks which are capable of distinguishing which consists of signs or indications which have become customary in the current language, or in the bona fide and established practices, of the trade.

From the policy angle, however, the first option may not be the ideal approach. The critical importance of paragraph (a) is that it operates as a legal bar which prohibits reliance on *de facto* distinctiveness to get the mark onto the register. Underlying this legal bar is the fear that tribunals will be misled by evidence of association between the mark and the applicant's goods or services which is not true *de facto* distinctiveness protected by trade mark law. This risk exists as much for an application to register 'SOAP' for soap as for an application to register the word 'ESCALATOR' for moving staircase. Therefore, if *at the time of the application* the general public sees the mark as generic of the goods or services, paragraph (a) should be invoked, regardless of whether the mark started off life with or without the generic meaning.

Some may point to section 7(2) as the reason why the first option gives the better approach. Section 7(2), it is said, prohibits reference to prior use in cases caught by paragraph (a) and this means that the mark's capacity to distinguish must arise from looking at the mark itself, with no regard to prior use. This argument, it is submitted, contains a misconception about the impact of section 7(2). What this subsection prohibits is reference to prior use for the purpose of determining if the mark, as a result of the use, has acquired *de facto* distinctiveness. It does not prohibit reference to prior use for the purpose of determining if the mark, as a result of the use, has acquired a descriptive meaning in relation to the goods or services listed in the application. The difference between these two purposes is what distinguishes the *Philips* case from the *Bach* case. In the *Philips* case, the mark was the shape of the faceplate of a shaver and the goods were shavers. The trial judge Jacob J. held that this shape mark had no capacity to distinguish because the shape mark was the shaver itself. However, in the course of assessing the evidence before him, he referred to this shape mark as a 'limping trade mark' by which he meant that evidence showed that the shape mark was in some way 'associated' with the Philips company, the trade

¹¹¹ [2005] E.T.M.R. 69.

mark proprietor.¹¹² This ‘association’ came about because the Philips company, which had patent rights over the shaver, was the only source of these shavers in the U.K. for a long time. On appeal, the Philips company argued that Jacob J. was wrong to conclude that the shape mark had no capacity to distinguish, that this conclusion was incongruent in the light of his finding of some ‘association’ between the shape mark and the Philips company. Here, the Philips company was relying on prior use of the shape mark to show that the mark had *de facto* distinctiveness in order to correct the mark’s lack of capacity to distinguish. This is clearly prohibited by the wording of the English equivalent of our section 7(2). There was good reason for the Court of Appeal to reject this argument. It was in this context that the court laid down the principle that the mark’s capacity to distinguish depended on its features alone and not on prior use.¹¹³

The *Bach* case was concerned with the other possible purpose for referring to prior use of a mark. When the U.K. Court of Appeal took into account the prior use of the ‘Bach’ mark by the general public and the trade, it was to determine if this mark has acquired descriptive connotations for the herbal remedies as a result of the use made of it. Section 7(2) has no relevance in this scenario, when the reference to prior use is not to establish *de facto* distinctiveness. In principle, there is no reason to deprive the tribunal of evidence which can point to the meaning of the mark in the public square. For example, in the *Kopitiam* case, to establish what the word ‘*kopitiam*’ means to the public in Singapore, the Principal Assistant Registrar of Trade Marks relied on the use of this word by *inter alia* the media and in the brochures of 200 companies to show that this word is taken to mean ‘coffee shop’.¹¹⁴ This, it is submitted, is permitted.

From the policy angle, the second option of reconciling paragraphs (a) and (d) arguably fits better into the scheme of things. When genericism exists within the relevant trade only, there is probably less risk that one trader is able to convince a tribunal that the rest of the traders, who should be more sophisticated when compared to the general public, associate the mark with that trader’s goods only. If so, it is probably less important for the legal bar to operate in this scenario. For this reason, this lesser degree of genericism is taken out of the ambit of paragraph (a) and dealt with separately in (d), thereby making possible the invocation of section 7(2) for such marks.

There is a third way of making sense of paragraphs (a) and (d), which involves a rather radical interpretation. As mentioned earlier, in the U.K., all generic marks are now dealt with under (d), since the capacity-to-distinguish threshold in (a) has been abolished. In Singapore, we could take the position that the capacity-to-distinguish threshold in (a) sieves out *all* generic marks, regardless of whether they started off life as generic marks or became generic marks through use and regardless of whether they have generic meanings to the general public or only to the relevant trade. In other words, in this radical interpretation, paragraph (a) is all about genericism and paragraph (d) is *not* about genericism at all. After all, the operative word of paragraph (d) is ‘customary’ and this does not necessarily mean genericism. In fact, the ECJ has said in *Merz & Krell GmbH & Co.* that a mark caught by (d) does not even have

¹¹² [1998] R.P.C. 283 at 296.

¹¹³ [1999] R.P.C. 809 at 817.

¹¹⁴ *Kopitiam*, *supra* note 2 at paras. 35 and 45.

to be descriptive of the goods or services.¹¹⁵ In this case, the mark ‘BRAVO’ in the context of typewriters was held to be caught by (d) because evidence showed that this term of praise was often used in advertising of various goods and services. Another example is the English case *Rugby Football Union and Nike European Operations Netherlands BV v. Cotton Traders Ltd.*, where the mark was a rose device and the goods were rugby jerseys.¹¹⁶ There was evidence that members of the England rugby team had worn jerseys with an embroidered red rose since 1871, and over the years since then, various traders selling rugby jerseys used the rose to associate their jerseys with the national team. The U.K. High Court held that the rose device was caught by paragraph (d).

There is a further argument which supports this radical interpretation. This argument compares paragraph (d) with the other provision in the *1999 Act* which deals with genericism, namely, section 22(1)(c). Section 22 is the revocation provision permitting a party to apply to revoke a registration on the grounds that, while the initial registration was valid, occurrence of certain events after the registration has made the registration no longer valid. Section 22(1)(c) sets out one of these events, that is:

in consequence of acts or inactivity of the proprietor, [the mark] has become the common name in the trade for the product or service for which it is registered.

There is no overlap between section 22(1)(c) and section 7(1)(d): if both of them are aimed at genericism, section 22(1)(c) deals with genericism that results from the proprietor’s own action or inaction after the registration, whereas section 7(1)(d) deals with genericism existing at the date of the application for registration. Between these two provisions, it is clearer that section 22(1)(c) by the use of the phrase “*common word* in the trade for the product or service” is targeted at generic marks. If section 7(1)(d) has the same aim, shouldn’t the same words ‘common word’ be used in (d), instead of ‘customary’? From a statutory interpretation point of view, it could be argued that ‘customariness’ in section 7(1)(d) is less than genericism.

V. CONCLUSION

This year 2009 marks the 110th anniversary of *Eagle Brand*, the trade mark case which anchored the law governing descriptive marks in the concept of *publici juris*. At the 10th anniversary of our *1999 Act* this year, it is useful to remind ourselves that this 110-year-old concept remains a core value in our trade mark law today, so much so that there is a statutory legal bar in the form of the ‘capacity-to-distinguish’ threshold to protect certain aspects of what is *publici juris*. If Singapore has diverged from the U.K. in the treatment of this requirement, this is not the first time we have chartered our own path in trade mark law.¹¹⁷ Trade marks, languages, cultures and

¹¹⁵ [2002] E.T.M.R 21.

¹¹⁶ See *Rugby Football Union*, *supra* note 94.

¹¹⁷ On two other issues, Singapore courts have already taken a position which may be seen as different from the U.K. On the question of whether there is an implicit requirement in the infringement provision section 27 for the offending use to be ‘trade mark use’, compare *Nation Fittings*, *supra* note 74, with the ECJ judgment in *Arsenal Football Club Plc. v. Reed* [2003] R.P.C. 9. On the question of whether the assessment in the provision on conflicts with earlier marks should adopt a ‘global assessment’ or a

traditions of a land are linked in some way to one other, and these links are probably stronger in multi-racial Singapore. This in itself is a reason to enforce the concept of *publici juris* more rigorously when interpreting the distinctiveness criterion in our trade mark law.¹¹⁸ Otherwise, we risk our business community in general losing the right to use symbols that mark us out as Singaporeans, like the word ‘*kopitiam*’.

step-by-step approach, compare *The Polo/Lauren Co., LP v. Shop-In Department Store Pte. Ltd.* [2006] 2 S.L.R. 690 with the ECJ judgments in *Sabel BV v. Puma AG* [1998] R.P.C. 199 and in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117.

¹¹⁸ Further, this rigorous application should not be affected in any way by the existence of the so-called ‘descriptive use’ defence in s. 28(1)(b) and s. 55A(1)(b) in the *Singapore Trade Marks Act 1999*. The policy reason, according to the Singapore High Court in *Cheng Kang*, *supra* note 1 at 277, is this: “When considering registration, one is not concerned to look too closely at what would constitute infringement or a defence thereto; the privilege of a monopoly should not be conferred where it might require honest men to look for a defence.”