

CHAPTER 5

DISTINCTIVENESS

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CHAPTER 5: DISTINCTIVENESS

5.1 Trademarks devoid of any distinctive character

Section 23 of the Trademarks Act 2019 (the Act) contains the absolute grounds for not registering a trademark. This chapter focus on the registrability of a trademark under section 23(1) of the Act.

Under section 23(1)(b) of the Act, The Registrar must refuse to register a trademark on absolute grounds if the trademark is devoid of any distinctive character.

“Distinctive character” is a new term and is defined in the 2019 Act as meaning:

...the trademark shall be capable of distinguishing goods or services –

(a) *Which the proprietor of the trademark is or may be connected to in the course of trade from goods or services; or*

(b) *in the case of which no such connection subsists or where the trademark is registered or intended to be registered, subject to conditions, amendments, modifications or limitations,*

in relation to use within the extent of the registration.

This definition of “distinctive character” indicates that examiners should continue to apply the established tests for distinctiveness.

The term “distinctive character” also appears in the Trade Marks Act 1994 (UK), Article 3 of the Trade Marks Directive of the Council of European Communities and in the Trade Marks Act 2002 (NZ), though without the accompanying definition.

Jacob J. discussed the meaning of the phrase “devoid of any distinctive character” in the Treat case:

What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (North Pole for bananas) can clearly do so. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to use the word from the old Act, but the idea is much the same) devoid of any inherently distinctive character. (British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281)

Assessing distinctive character

Traditional trademarks will be devoid of any distinctive character if they are not **in any way** capable of distinguishing the applicant goods and services from those of other traders. These trademarks are generally ones which:

- are presently in common use and serve directly to designate the goods or services; or
- are otherwise clearly required by other traders in the ordinary course of their business.

The relevant tests are outlined in Chapter 5 and should be applied when assessing whether an absolute ground for objection exists under section 23(1)(b).

5.2 Trademarks not capable of distinguishing

Although the 2019 Act introduced new wording for concepts surrounding distinctiveness, many of the underlying principles are the same. **To determine whether an absolute ground for objection under section 23(1) applies to a trademark, examiners must assess whether a trademark is capable of distinguishing the goods and services of the applicant from those of other traders.**

The first question to be determined in deciding whether a trademark can distinguish the applicant's goods and/or services is: **to what extent is the applicant's trademark inherently adapted to distinguish their goods or services?**

The test for inherent adaptation used in many jurisdictions was set out in the speech of Lord Parker of Waddington in *W&G du Cros Ltd's Application* (1913) 30 RPC 660:

The applicant's chance of success in this respect (i.e. in distinguishing his goods by means of the mark, apart from the effects of registration) must, I think, largely depend on whether other traders are likely, in the ordinary course of their business, and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection to their own goods.

More recently, the High Court of Australia in its *Cantarella* decision clarified that the inquiry into the inherent adaptation of a trademark involves two steps:

Firstly, examiners must establish what the ordinary signification (or ordinary meaning) of the words or images comprising the trademark is to anyone in the country who purchases, consumes or trades in the relevant goods or services.

Secondly, examiners must assess whether it is likely that other honest persons will desire to use those words/images in connection with their goods or services because of that ordinary signification.

This assessment must be carried out without any regard to distinctiveness acquired through use and without considering the effect that registration would have on the trademark.

With these principles in mind, if a trademark:

1. **Has an ordinary signification that the target audience will understand to be a direct reference to the goods or services, and**
2. **Is likely to be desired to be used by honest traders because of that ordinary signification**

then the trademark will not be inherently capable of distinguishing.

5.3 Trademarks that are inherently capable of distinguishing

An objection under section 23(1) may not be imposed to a trademark that has some element of inherent distinctiveness.

A composite trademark which comprises of words and images will be inherently capable of distinguishing if:

(a) as a whole and considering the overall impression, the mark is distinctive, invented and is not directly referring to the goods or services applied, even if some individual elements are descriptive and lack the capacity to distinguish. Examples are given as below.



(b) the distinctive element in the mark is more prominent or larger than the descriptive element. Examples are given as below.



In all cases, examiners must take care to consider the trademark when assessing distinctiveness. In this regard, Lawrence J. in the Diamond T case noted at 40:

In determining the question of (whether a mark is adapted to distinguish the applicant's goods from goods of other manufacturers) it is, in my judgement, immaterial to consider whether any of its component parts are or are not registrable by themselves.

The difference between factor “Adapted to Distinguish” v. “Capable of Distinguishing” is that the inherent qualities of any mark must be ascertain purely from the mark itself; its factual qualities are most often a matter for evidence or other extraneous circumstances.

In “Cassella’s Application (Diamine)”, (1910) 27 R.P.C. 453, Farwell, L.J. said:

“The Act means that a trader may take a word which from something in the word itself – say the fact that no one had never heard the word before, that it was an invented word, or that it indicated the particular as distinguished from another trader, but always from something found in the word itself as distinguished from the way it is used – is such as to answer the description of being adapted to distinguish the goods.”

Harman, L.J put it this way in “Weldmesh” T.M., [1996] R.P.C. 220:

“By ‘inherently adapted’ I take the Act to mean adapted of itself, standing on its own feet.”

Summary of inherently capable of distinguishing

	Inherently capable of distinguishing	Inherently capable of distinguishing, to a certain degree	Not capable of distinguishing
Ordinary Signification	<p>Ordinary signification of the trademarks does not refer to a character or quality of goods or services, or refers to it in a skilful, covert, or allusive way.</p> <p>** The trademark does not refer to the character of quality of the goods or services, or refer to the mark in a skilful, covert or allusive manner.</p>	<p>Ordinary signification of the trademark contains some reference to the quality or character of the goods or services but not directly, or is a somewhat common representation of the goods or services</p> <p>** The trademark has some reference to the quality or character of the goods or services however the reference is not direct.</p>	<p>Ordinary signification of the trademark refers to a character, quality or a common representation of the goods or services.</p> <p>** The trademark refers directly to the character, quality or a common representation of the goods or services.</p>
Likelihood other traders will desire to use	<p>Other traders unlikely to legitimately desire to use the trademark.</p> <p>Other traders do not want to use the trademark and do not have the intention to use the trademark.</p>	<p>There is not a demonstrated likelihood other traders will legitimately desire to use the trademark for its ordinary signification; it is unlikely, or it is 50/50-</p> <p>Other traders might want to use the trademark or might have the intention to use the trademark.</p>	<p>Other traders will legitimately desire to use the trademark for its ordinary signification</p> <p>Other traders want to use the trademark or have the intention to use the trademark.</p>
Options to overcome (Appeal/Hearing)	Evidence of use not required.	Depending on the trademark, the evidence of use might be required.	Evidence of use is required.
Outcome	No objection and the mark can be accepted.	<p>Whether the trademark will be accepted or not will depend after the Registrar assessed the evidence of use if the Registrar had asked for evidence of use to be submitted.</p> <p>Trademark may be accepted or may be refused based on absolute grounds (S.23).</p>	<p>Absolute ground for objection applies.</p> <p>Refused on absolute grounds (S.23)</p>

The following tables illustrate the example of distinctiveness for trademarks under the Act with the relevant considerations.

Inherently capable of distinguishing	Inherently capable of distinguishing, to a certain extent	Not capable of distinguishing
No objection	Whether the trademark will be accepted or not will depend after the Registrar assessed the evidence of use if the Registrar had asked for evidence of use to be submitted. An objection may be appropriate under S. 23	Objection under section 23
<p style="text-align: center;">PRIME CITY</p> <p>Class 29: Meat, meat products</p> <ul style="list-style-type: none"> • Prime has a relevant dictionary meaning (best quality) and is commonly used in respect of meat • The overall composition of the trademark is inherently capable of distinguishing 	 <p>Class 29: Meat, meat products</p> <ul style="list-style-type: none"> • Prime has a relevant dictionary and common use meaning (best quality) • Even though the device is of an alpaca, it is relatively stylised and in combination with the irregularly shaped background provides sufficient capacity to distinguish. However, the Registrar might require the owner to provide evidence of use. 	<p style="text-align: center;">PRIME</p> <p>Class 29: Meat, meat products</p> <ul style="list-style-type: none"> • Prime has a relevant dictionary and common use meaning (best quality)
 <p>Class 43: providing food and drink</p> <ul style="list-style-type: none"> • The overall composition of the trademark is inherently capable of distinguishing. 	 <p>Class 43: providing food and drink</p> <ul style="list-style-type: none"> • The 'chicken head' is distinctive • However, the word 'The Chicken Rice Shop' is prominent. • This trademark may be accepted subject to the evidence of use submitted and the words 'The Chicken Rice Shop' will be disclaimed. 	<p style="text-align: center;">I LOVE CHICKEN RICE</p> <p>Class 43: providing food and drink</p> <ul style="list-style-type: none"> • 'I love chicken rice' is a common term that refers to a preference of food. • These words should be refused under S. 23.

Inherently capable of distinguishing	Inherently capable of distinguishing, to a certain extent	Not capable of distinguishing
 <p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The word qleen has no dictionary meaning As a whole, the mark is capable of distinguishing. 	 <p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The word `kleen' is a misspelling of the word `clean'. However, the letter `v' before the word `kleen' has the capability of distinguishing. The mark may be accepted after submitting the evidence of use. 	 <p>Class 3: Cleaning preparations</p> <ul style="list-style-type: none"> The mark is not distinctive on cleaning preparations. To be refused under absolute grounds.
 <p>Class 12: Bicycles</p> <ul style="list-style-type: none"> Whilst the mark includes a picture of the goods (bicycle), it also includes a cartoon animal driver. Overall, the mark is inherently distinctive. 	 <p>Class 12: Bicycles</p> <ul style="list-style-type: none"> Whilst this includes an obvious simplified version of a bicycle, the addition of the plug in the wheels is unusual and not common to the trade. The additional material provides sufficient capacity to distinguish. 	 <p>Class 12: Bicycles</p> <ul style="list-style-type: none"> A clear representation of a bicycle. The image is a common, basic and usual version of the goods.
<p>Fil-osoph-e</p> <p>Class 16: Books</p> <ul style="list-style-type: none"> While the word is a misspelt word of philosophy, the hyphen in between of the words may create a distinctive feature to the mark 	 <p>Class 16: Books</p> <ul style="list-style-type: none"> Philosophy has a relevant dictionary and common use meaning (subject matter of goods). However, the word is very small and not prominent. The picture of the head in sculpture can be 	<p>Philosophy</p> <p>Class 16: Books</p> <ul style="list-style-type: none"> Philosophy has a relevant dictionary and common use meaning (subject). The word indicates the subject matter of the goods.

Inherently capable of distinguishing	Inherently capable of distinguishing, to a certain extent	Not capable of distinguishing
	<p>accepted if it is not of a known person</p> <ul style="list-style-type: none"> The overall composition of the trademark is capable of distinguishing. 	
 <p>PAY BY PHONE</p> <p>Class 36</p> <ul style="list-style-type: none"> Words describe an exact characteristic of the services provided. The addition of the highly stylised cartoon telephone creates a memorable element making the mark capable of distinguishing. The words “PAY BY PHONE” will be disclaimed. 	 <p>Class 36</p> <ul style="list-style-type: none"> Words describe an exact characteristic of the services provided. The device of the phone is not capable of distinguishing. Prima facie, the mark will be refused on absolute grounds. May be accepted with evidence of use. 	<p>Pay By Phone</p> <p>Class 36</p> <ul style="list-style-type: none"> Describes an exact characteristic of the services provided – allows users to pay using their phone. Refused under absolute grounds.
 <p>Class 1: Fertilisers Class 5: Herbicides</p> <ul style="list-style-type: none"> The term WEED N FEED has a known meaning in relation to the goods. The mark includes a highly stylised version of a mower, with cartoon elements. Overall, the mark is inherently distinctive. 	 <p>Class 1: Fertilisers Class 5: Herbicides</p> <ul style="list-style-type: none"> The term WEED N FEED has a known meaning in relation to the goods. Although there are additional elements aside from the words, the overall representation of the mark can be regarded as referring to the goods applied The mark may be accepted after submitting the evidence of use. 	 <p>Class 1: Fertilisers Class 5: Herbicides</p> <ul style="list-style-type: none"> The term WEED N FEED is an ordinary way of indicating the nature of the goods.

5.4 Descriptiveness of goods and services

General principles

Section 23(1)(c) of the Act stipulates that an absolute ground for objection will apply to trademarks **which consists exclusively of** signs or indications which **may serve**, in trade, to designate the **kind, quality, quantity, intended purpose, value, geographic origin, other characteristics of goods or services or the time of production of goods or rendering of services.**

The purpose of this section is to prevent the registration of marks which are descriptive of goods or services or some characteristic of them. These descriptive marks are excluded from registration because, in the words of the OHIM Third Board of Appeal in the case of *Global Chiller [2000] ETMR 234*:

They must remain available for general use, since competitors have a legitimate interest in employing, without hindrance, in a descriptive manner such indications relating to the very nature of the claimed goods.

The principle is an old one, yet has been reiterated in recent UK decisions in the case of *PROFITMAKER Trade Mark [1994] RPC 613 at 616*:

The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others.

The European Court of Justice (ECJ) addressed the purpose of section 23(1)(c) in the case of *Procter & Gamble v OHIM (BABY DRY Trade Mark)* [2001] CEC 325, paragraph 37:

... the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is ... to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

Interpretation

“Which consist exclusively of...”

The word “exclusively” refers to the content of the mark. It does not mean that section 23(1)(c) of the Act only applies when the sole meaning that can be given to the mark is the descriptive meaning.

In the words of the OHIM Third Board of Appeal in the case of *Complete* [1999] ETMR 664:

... it would be sufficient that any one meaning ... is understood by the average consumer, who is reasonably well-informed and reasonably observant and circumspect ... to describe ... the appellant’s goods.

For example, the mark PROMPT would not be registrable in respect of courier services under section 23(1)(c) of the Act even though, aside from being descriptive of the speed of the services, it also means “something said to incite to action, or to help the memory” and hence has a meaning that is not descriptive of courier services.

For section 23(1)(c) of the Act to apply, the mark need not designate each and every characteristic of the goods or services in question. It is sufficient if the mark designates one characteristic of the goods or services.

If a mark does not consist only of one or more signs or indications that designate a characteristic or characteristics of the goods or services, it cannot be refused registration under section 23(1)(c) of the Act. However, such a mark may still be refused registration under section 23(1)(b) of the Act on the grounds that it has no distinctive character.

“May serve in trade...”

The term “may serve” means “does, or is liable to, serve”.¹

Section 23(1)(c) of the Act applies when the signs concerned are in use by other traders to designate a characteristic or characteristics of the goods or services in question, as well as when those signs are likely to be used **in the future**.²

¹ Kerly's Law of Trade Marks and Trade Names, 13th edition, Sweet & Maxwell, London, p. 165.

² See *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779, paragraph 37. While the European Court of Justice made these comments with regards to geographical names, they are applicable to all signs of a descriptive nature.

5.4.1 Kind

‘Kind’ includes the name of the goods or services claimed and any words recognised as indicating size or type. Similarly, **generic descriptions which describe the goods would not inherently capable of distinguishing.**

For example, the words SEDAN and STATION WAGON are commonly used to indicate vehicle size in the auto trade and would not be acceptable for cars. Words like LARGE and SMALL would be difficult to register for any goods or services.

The following trademarks are not registrable:

Trademark	Good and/or Services	Decision
	<i>Class 30: Chocolate products; Cocoa-based spreads; Chocolate-based spreads</i>	Object. The mark indicates the kind of goods.
	<i>Class 30: Coffee, coffee extracts, coffee-based beverages and preparations</i> <i>Class 43: Provision of food and beverages, coffee shops; provision of coffee machines.</i>	Object. The mark indicates the purpose of goods for making coffee.
YO ! ICE CREAM	<i>Class 30: ice cream, food powder, fruit powder, ice cream material</i>	Object. The mark indicates the kind of goods.

5.4.2 Quality

Laudatory words or word combinations such as SUPERIOR, GOOD, BEST, EXCELLENT, PERFECT, SUPREME and NUMBER ONE **are**

indications of quality commonly used by traders to promote their goods and/or services and are not inherently capable of distinguishing.

The following trademarks are not registrable:

Trademark	Good and/or Services
BEST	<i>Class 29: Butter; Cheese; Coconut oil</i>
SUPERIOR	<i>Class 3: Cotton wool, cotton sticks</i>
PERFECT ONE	<i>Class 35: Retail services for cosmetics</i>
	<i>Class 5: Pharmaceutical and veterinary preparations for medical purposes</i>

Relevant case law:

SURE-LOC 

Goods: Ironmongery, Door Locks, Cylindrical Locks, Rim Locks, Latches, Padlocks, Floor Springs of Metal, Hinges, Door Handles, Pull and Push Bars and Plates of Metal

Since the words “SURE-Loc” which is phonetically sounds as “SURE-Lock”, when pronounced, would surely compute a meaning in the minds of the general public that “certainly the lock would secure something”, these words surely cannot be invented words as invented words do not carry a meaning until it becomes a generic word.

.....

.....

Based on the above, the Court finds that the Appellant’s Trade Mark is not registrable pursuant to Section 10(1)(c) of the TMA 1976 as the Appellant’s Trade Mark “SURE-Loc” is not an invented word, hence not fulfilling this criterion either.

Ramly Haji Ali J in Titan (M) Sdn Bhd v Pendaftar Cap Dagangan Malaysia, [2009] 7 CLJ

5.4.3 Quantity

Indications of quantity are frequently used by traders for a wide range of goods and services and are not prima facie capable of distinguishing. Indications of amount, including reference to numerals, are needed to indicate volume, area, model, or batch number, and would be unlikely to function as trademarks. See also entries on numerals and combinations of letters and numbers.

The following trademarks are not registrable:

Trademark	Good and/or Services	Decision
100 FACETS	<i>Class 14: Loose diamond</i>	Object. “100 FACETS” would be understood as a description of the cut or type of diamond being offered.
SERIES 7	<i>Class 9: Solar panel</i>	Object. It is devoid of any distinctive character as it merely refers to a product series.

5.4.4 Intended Purpose

Some words that **describe the function of a range of goods or the result of a range of services are not inherently capable of distinguishing the goods or services.** For example: STICKS TO METAL describes a use to which glue can be put; ROACH FREE describes the result of pest eradication services. In respect of printed material and software, this would include trademarks which consist of a mere description of the subject matter contained therein.

The following trademarks are not registrable:

Trademark	Good and/or Services	Decision
SUSU UNTUK SENDI DAN LUTUT	<i>Class 29: Milk products</i>	Object. The trademark is commonly used in the industry to describe the goods being applied for.
PEGADAIAN <i>Syariah</i>	<i>Class 36: Providing loan service based on pledges and fiduciary law.</i>	Object. The words “Pegadaian” and “Syariah” is descriptive of the services applied which refers to pawn services providing loan based on the Islamic law.
EXTENDED WARRANTY	<i>Class 36: Insurance</i>	Object. When applied in the context of the services provided, the mark merely describes a purpose of applicant services.

5.4.5 Value

Words which **emphasise the worth, importance or value of a product or service are not generally capable to distinguishing**. Examples are TWO FOR ONE, MORE and WORTH THEIR WEIGHT IN GOLD.

The following trademarks are not registrable:

Trademark	Good and/or Services	Decision
	<i>Class 35: Operation of programme under which members will earn and accumulate points for qualifying purchases from participating retailers and other companies which points can be redeemed by the members for awards from catalogue</i>	Object. The words “More Rewards” directly describe the added value or benefit of a rewards programme.
LUBE-XTRA	<i>Class 4: Lubricants</i>	Object. It is devoid of any distinctive character as it merely suggests that the lubricant offers extra performance, protection, or value.
	<i>Class 25: Clothing</i>	Object. It is phonetically equivalent to 100% which directly conveys the idea that the goods applied are of perfect and original quality.

5.4.6 Geographical Origin

A mark will not be registrable if it consists only of a sign that designates the geographical origin of the goods or services.

Signs that may serve, in trade, to designate the geographical origin of specified goods and/or services cannot be registered. The geographic origin of goods or services may influence consumers' purchasing decisions as it could indicate quality or other characteristics of the category of goods or services. Therefore, it is in the public interest that signs designating geographic origin remain free for traders to use.³

Indications of geographical origin usually indicate the place where the goods were or could be manufactured, or the place where the services were or could be provided. However, indications of geographical origin may also indicate other things, such as the place where the goods were or could be sold, or the fact that the goods or services were "conceived or designed in the geographical location concerned".⁴

Section 23(1)(c) prohibits the registration of signs that "may" serve to designate geographic origin. Therefore, an examiner will consider what is reasonably likely to designate geographic origin in the future.⁵

Prima facie, if the examiner found out that the trademark consists of geographical origin, the examiner will raise a provisional refusal. The applicant needs to provide evidence of use during an appeal or hearing to show that the trademark which consists of the geographical origin had achieved distinctiveness in the public's mind.

³ The European Court of Justice interpreted Articles 3(1)(c) and 3(3) of the First Council Directive 89/104/EEC of 21 December 1988 ('the European Directive') in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779 paragraphs 26, 29 and 30.

⁴ Ibid.

⁵ Ibid.

Place names that already designate geographic origin of the specified goods or services

An objection will be raised if the geographic location holds a reputation for producing or being the commercial source of the specified category of goods or services; use of such a name is likely to be perceived as indicating the geographic origin of those goods or services. An examiner can draw on their own knowledge to determine whether a geographic location is renowned for a category of goods or services. Internet searches may also assist examiners to determine whether a geographic location is renowned for being the source of the specified category of goods or services.

For instance, BUKIT BINTANG is renowned for retail and entertainment services therefore the name of this location would not be registrable for either of these services as it likely to be perceived as designating a name of a place.

Geographic place name that is well-known but not in relation to the specific category of goods or services

Even if the name of a geographic location does not have a reputation for producing or being the commercial source of the specified category of goods or services, the name of a well-known geographic location might still not be eligible for registration. This is because a geographic location that is well-known is likely to be perceived as designating the geographic origin of goods or services.

For this reason, the names of cities in Malaysia and major cities overseas are unlikely to be eligible for registration. The size of the location and the reason for it being well-known is not as relevant – the primary consideration is whether the relevant class of persons is likely to perceive the mark as indicating the geographical origin of the specified goods or services – if it is a well-known location, the likelihood that it will be perceived as designating geographic origin is increased.

However, an objection may not be raised if those encountering the trademark are unlikely to perceive the sign as designating the geographic origin owing to the characteristics of the geographic location, the characteristics of the specified goods/services and the nature of the relevant class of persons. For example, NORTH POLE for bananas in class 31 is unlikely to designate geographic origin as it is not a climate conducive to producing bananas.

Further general guidance

Whether a geographic origin objection is raised will depend on the facts surrounding each application. However, the following table is intended to provide general guidance to examiners.

Geographic reference	Guidance
MALAYSIA	A mark consisting the name MALAYSIA, or containing MALAYSIA in combination with non-distinctive elements, will not be eligible for registration.
Countries, regions,	A mark consisting a country name, its informal name, the name of a region or derivatives is unlikely to be

<p>informal names, derivatives</p>	<p>registrable; such names are generally well-known and likely to be perceived as designating geographic origin.</p> <p>For example, UNITED STATES and ITALIA would not be eligible for registration.</p> <p>Marks that are phonetically similar to country names, regions, informal names or derivatives might not be registrable</p>
<p>Superseded country names</p>	<p>A mark consisting a superseded name of a country is unlikely to registrable if it is still recognised as the name of a geographical location-</p> <p>For example, CEYLON for tea would not be registrable. While Ceylon is now Sri Lanka, there remains a reputation for tea from Ceylon. The public will still regard Ceylon as a name of a place.</p>
<p>Provinces, Towns, Cities, Suburbs</p>	<p>A mark consisting the name of a Malaysian state, city or large town is unlikely to be registrable-</p> <p>For example, IPOH would not be eligible for registration for any goods or services.</p> <p>For example, LANGKAWI would not be registrable for <i>Hotel and resort services</i> because the location is already associated with tourism.</p>
<p>Streets, Roads,</p>	<p>A mark consisting of the name of a street or road is unlikely to be registrable.</p> <p>For example, JALAN TAR / PETALING STREET would not be registrable for any services.</p> <p>For example, 5th AVENUE or BOND STREET would not be registrable for fashion goods, and WALL STREET would not be registrable for services related to the share market or investments. This is similar to</p>

	<p>the use of the name Harajuku for fashion items, as the area is widely recognized for its unique Japanese street fashion.</p>
<p>Any geographical location that, because of its characteristics, is likely to be the customary source for the category of goods (for example, natural produce, water or wine)</p>	<p>A mark consisting the name of any geographic location is unlikely to be registrable if the category of goods is customarily sourced from the type of location referred to.</p> <p>For example, ATLANTIC - being the name of an ocean - would not be registrable for seafood in class 29.</p>
<p>Combinations of geographical names</p>	<p>A mark consisting a combination of geographical names are not registrable.</p> <p>For example, KUALA LUMPUR TO MALACCA will not be registrable for transportation services.</p>
<p>Device marks</p>	<p>A device mark might not be registrable if it may serve to designate geographic origin. This includes simple depictions of countries such as maps or silhouettes.</p> <div style="text-align: center;">  </div>
<p>Devices that provide both a representation</p>	<p>Trademarks which consist of multiple elements are always to be assessed on the whole, a case-by-by-case basis. Nevertheless, the combination of a device</p>

<p>of the goods and an indication of geographical origin</p>	<p>that provides an indication of geographic origin with a device that provides an ordinary depiction of the goods or is common to the trade will not necessarily be sufficient to render the mark prima facie capable of distinguishing. For example, in <i>National Software Pty Ltd</i> in the case of [1991] ATMO 63, the applicant applied to register the following mark for 'computer software; computers, computer discs and magnetic recording tapes':</p> <div data-bbox="794 719 1086 972" data-label="Image"> </div> <p>The Registrar's delegate said:</p> <p><i>Consisting as it does of a representation of goods included in the specification surrounded by the outline of the map of Australia, the subject mark is markedly lacking in its capability to distinguish the applicant's goods.</i></p>
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5.4.7 Time of Production of Goods or Rendering of Services

Trademarks consisting of references to a time frame when the goods were produced or when the services are to be available are not capable of distinguishing. This could include expressions such as READY IN ONE HOUR for photographic development, VINTAGE 1990 for wines or AUTUMN ISSUE for magazines.

5.4.8 Other Characteristics

Section 23(1)(c) of the Act lists seven specific characteristics of the goods or services that signs or indications may designate, namely “kind”, “quality”, “quantity”, “intended purpose”, “value”, “geographical origin” and “time of production of goods or of rendering of services”. This list is not exhaustive, as evidenced by the concluding “or other characteristics of goods or services”.

5.5 General guidance

5.5.1. Letters

Single letter trademarks

One letter trademark, unless represented in an unusual manner, generally possess limited capability of distinguishing the goods or services and usually require evidence of use.

Where a trademark applied for registration consists of a single letter in an existing typeface or in a style such that other letters could easily be envisaged in the same typeface family, it cannot be accepted, without evidence of lengthy use.⁶

Where a trademark, although based on a single letter, is presented purely as a device and all impression of the letter is lost, it may be accepted *prima facie*.⁷ Example of such trademark:

⁶ Paragraph 12.179 Manual of Trade Marks Law & Practice (2003) Second Edition.

⁷ *Ibid* at Paragraph 12.182.



Two letter trademarks

Two letter trademarks in common use in a specific field will usually not be prima facie capable of distinguishing. For example, GT and LS are used by a number of traders in class 12 to indicate performance or luxury levels and do not serve to distinguish one trader's goods from another's.

Two letter trademarks with dictionary meanings should be examined based on their definition. If they convey a descriptive meaning a ground for objection is appropriate. If they do not convey a descriptive meaning, then they are capable of distinguishing. Words such as "UP", "NO" or "HE" would fall in this category, whether in upper or lower case. This is based on the UK practice as outlined in *I.Q. trade mark*. However, the inclusion of punctuation could alter the identity of the word. "U.P." would most likely be seen as letters rather than a word and therefore examined on that basis.

Example of registrable trademark:



Three or more letter trademarks

Trademarks consisting of three or more letters are prima facie capable of distinguishing because there is likely to be less need for use of these combinations. However, they will lack capability in distinguishing if they

are well-known acronyms or abbreviations used on or in relation to the goods and/or services concerned.

Example of registrable trademark:

LGV **CNSK**

Combination of letters and words

The distinctiveness of trademarks combining letters and words depends on their overall impression. If the word is descriptive (e.g., "X Coffee" or "G Tech"), the letters must add distinctiveness to be registrable. Conversely, if the word is arbitrary (e.g., "RavenX" or "ZyloP"), the mark is more likely to be accepted. Acronym-like formations are assessed based on consumer perception—if commonly used (e.g., "E-Biz"), they may lack distinctiveness, while less familiar combinations (e.g., "QT Style") may be registrable. Unique stylization or font can enhance distinctiveness (e.g., "AeroX" in a futuristic font). If both elements are weak or widely used, the mark may face objections.

Example of registrable trademark:

F – Z E R O

L-com

TSure

5.5.2. Monograms and Cyphers

Where a monogram is a combination of letters entwined in such a way as to not show any sequential order it will be considered prima facie capable of distinguishing.

Two-letter monograms and cyphers may be accepted. Several examples are given below.⁸

Monograms	Cyphers
	

Three-letter monograms and cyphers may be accepted. An example of each of these is illustrated below.⁹

Monograms	Cyphers
	

Three-letter marks in which only two of them from a monogram or cyphers may be accepted. An example of this kind of mark is given below.¹⁰

⁸ Ibid at Paragraph 12.198.

⁹ Ibid at Paragraph 12.199.

¹⁰ Ibid at Paragraph 12.200.



5.5.3. Abbreviations and acronyms

Letter trademarks, irrespective of the number of letters they contain, that are recognised abbreviations for words which are not capable of distinguishing are themselves not prima facie capable of distinguishing.

For example:

- "OOTD" (Outfit Of The Day) is not capable to distinguish fashion goods.
- "BYO" (Bring Your Own) is not capable to distinguish restaurant services.
- "ROM" (Read Only Memory) is not capable to distinguish certain goods in class 9.

Other letter combinations could attract grounds for objection because they are often used as an indication of quality e.g., "AAA".

Acronym/Abbreviation combination trademarks

A trademark comprising an acronym and other material which serves only to emphasise the acronym or does not diminish the impact of the acronym, is generally considered to have a low level of capability in distinguishing. This is because the inclusion of a potentially registrable element on its own does not render the trademark as a whole prima facie capable of distinguishing (see Lawrence J comments in Diamond T at 380).

A trademark comprising an acronym and plain words would be considered in the same manner. However, a trademark must be considered in its

entirety and if a trademark containing an acronym also contains other material of a significant nature, the combination could be prima facie capable of distinguishing. Therefore, the positioning of the acronym and whether it reinforces the descriptive or direct reference contained within the trademark, may affect whether a section 23 ground for objection is appropriate.

For example, an application for:

- CERTIFIED PRACTICING RISK EVALUATION AUDITOR (CPREA) might not be prima facie capable of distinguishing risk evaluation services as the acronym does no more than abbreviate the descriptive words. Regardless of whether the acronym is known in the relevant trade, if the size or placement does not add to the distinctive character of the entire trademark, the addition of the acronym does not render the trademark capable of distinguishing.
- Example shown below would be capable to distinguish risk evaluation services as the size and placement of the acronym renders the trademark, as a whole, capable of distinguishing.

CPREA

Certified Practicing Risk Evaluation Auditor

5.5.4. Punctuated words

Punctuation may take the form of full stops, stars, hearts or other graphic elements. Punctuated words consisting of **three or more letters** will normally be treated as words rather than letters. The longer the word, the more likely it is that it will be read as a word rather than as a series of initials (see *Re Appn by Waterbed Association of Retailers and*

Manufacturers (1990) 20 IPR 605 (“W.A.R.M.”). This is particularly so if the word in question is a known dictionary word.

Examples:

Trademark	Good and/or Services	Decision
FIR-ST	<i>Class 9: Computer software; Downloadable cryptographic keys for receiving and spending crypto assets</i>	Object. The trademark “FIR-ST” is a misspelling of the word “first.” Hence, the trademark is merely descriptive of the quality of the goods and services applied.
Litter-Robot	<i>Class 21: Automated pet appliances, namely, litter boxes.</i>	Object. The words “litter robot” gives an indication that the goods provided are equipped with robots or automated device that handles rubbish or pet litter.
c.CRYSCOO	<i>Class 7,9,11,37</i>	Accept

5.5.5. Slogans, phrases, and multiple words

A trademark may be composed of a few words. Trademarks composed of more than one word include phrases, mottos, maxims, epigrams, proverbs, and adages. Multi-word trademarks of this type may be categorised as slogans. They are commonly used during trade and advertising to promote a cause, an idea, or a product.

When deciding whether a multi-word trademark can distinguish the applicant's designated goods or services, the same inquiries are made as for a single word. In the case of *W&G Du Cros Ltd's Application (1913) 30 R.P.C. 660 at 672*, the question of whether a trademark is capable of

distinguishing will in either case 'largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it'.

A trader may adopt a well-known slogan, modify a well-known slogan, or invent a new slogan. As in the case of single words, evidence, get-up and/or any other circumstances may establish that a trademark can distinguish the applicant's goods or services where this cannot be decided otherwise.

Example:

Trademark	Good and/or Services	Decision
YOUR BROWS BUT BETTER	<i>Class 3: Make-up preparations</i>	Object. The words applied are common words used as promotional slogan
STEP IN AND GO	<i>Class 25: Footwear</i>	Object. The words applied are common words used as promotional slogans
LONG LIVE THE LAZY	<i>Class 20: Furniture</i>	Accept

5.5.6. Phonetic equivalents, misspellings, combinations of known words

Words consisting of **obvious phonetic equivalents, simple combinations, misspellings, minor changes or trifling variations of descriptive words are not prima facie capable of distinguishing.** However, unlikely grammatical constructions of words which would otherwise attract grounds for objection, including inversions, play on words and portmanteau words (two words telescoped together – *means*

to make or become shorter by reducing the length of the parts), may be capable of distinguishing.

Although the word "invention" is not mentioned in the Act, the concept is still of relevance in assessing whether a word is capable of distinguishing. Words with a degree of invention usually possess a capacity to distinguish. Existing case law on what constitutes invention is relevant in giving guidance on these matters. As discussed in the case law, some grammatical constructions which would not be capable to distinguish are:

- The addition of a diminutive or a short and meaningless syllable to a known word (see *Eastman Photographic Material Co's Application ('Solio') (1898) 15 RPC 476*).
- Minor variations in spelling.
- Combinations of two or more known words, such as 'Vapo-Rub', as stated in the case of *De Cordova v Vick Chemical Co (1951) 68 RPC 103*.

Examples:

Trademark	Good and/or Services	Decision
	<p><i>Class 5: Saline solution for medical purposes</i></p>	<p>Object. This is because the mark is phonetically equivalent to the words 'clean & care', which are common and descriptive in nature</p>
	<p><i>Class 6: Door locks, cylindrical locks, rim locks, latches, padlocks</i></p>	<p>Object. 'Sure', implying reliability, and 'Loc', a phonetic misspelling of 'lock'. As a whole, the term immediately conveys to consumers that the product ensures a secure locking function</p>

5.5.7. Common formats for trademarks

Some words are commonly used in combination to identify the nature or extol the virtues of a particular product or service. These include:

a) Mr, Mrs, Miss etc. trademarks

Although the word MISTER can have a laudatory connotation when combined with a word describing a subject matter and applied to a person, the view is now taken that the laudatory significance is somewhat reduced when such words are considered in the context of goods or services. However, it is descriptive for fitness competitions; Applications for marks consisting of the word MISTER or the abbreviation MR, combined with the name of the goods or services will, in future, be regarded as capable of distinguishing and therefore, acceptable.

The above rules of practice should be applied with proper regard to the facts of each case. For example, the mark 'D. Mister', although seemingly within the preceding paragraph, would not be acceptable if the goods were demisters, since it is the phonetic equivalent of the name of the goods and so totally unregistrable for them. An example the other way would be "Mister Spud" for potatoes; here the mark could be accepted since 'spud' is only a slang term for the goods, and so is not one normally required by traders.

The laudatory reference of Master and Mister do not carry over so strongly in the case of their feminine equivalents. Nevertheless, words such as Madame and Miss are commonly used in relation to goods for young women and ladies and are not distinctive for such goods. As always, each application must be judged on its own merits.

The inclusion of Mister, Mr, Mrs, Miss, Ms in a trademark will not generally give rise to a distinctiveness objection. However, there are some circumstances in which a ground for objection may be appropriate:

- Where the trademark consists of the word Mr, Mister, Mrs etc. followed by a common surname e.g. MR LIM CHIN CHIN, PUAN FARIDAH. Such trademarks should be examined based on the criteria for registration of surnames.
- Where research clearly supports a ground for objection. Examples may include MR MALAYSIA for *bodybuilding competitions* and MISS BEAUTIFUL for *beauty contests*.

Example:

Trademark	Good and/or Services	Decision
	<i>Class 37: Cleaning-office, residential, factory, buildings, contract celaning, building construction; repair, renovation, cleaning services</i>	Object. It conveys a clear message that the services will result in cleanliness.
MR. BIRYANI	<i>Class 43: Services for providing food and drinks (restaurant)</i>	Object. The word 'Biryani' directly refers to a popular and specific type of dish, indicating the nature or speciality of the services.
Mr. Monkey	<i>Class 9: Cell phone straps; Cases for smartphones; Protective films adapted for smartphones</i>	Accept

b) Abah, Mama, Abang, Makcik, Mat, etc. trademarks

Trademarks using common Malay familial or familiar terms like Abah, Mama, Abang, Makcik, Mat, etc., may face distinctiveness challenges as they are widely used in daily language. Such marks are generally non-distinctive if used alone but may be registrable if combined with unique elements like stylized fonts, logos, or additional words that create a distinctive identity. To qualify for registration, the mark must not be generic or descriptive of the goods/services but should acquire distinctiveness through unique branding or extensive market recognition.

Examples:

Trademark	Good and/or Services	Decision
	<i>Class 25: Baby clothes; Baby footwear; Baby bibs</i>	Object. Suggesting that the goods are a preferred or recommended option by mothers.
	<i>Class 30: Bakery goods; cookies; almond cookies; fortune cookies; filled cookies; danish butter cookies; egg roll cookies</i>	Object. It is merely descriptive of the goods claimed.

c) Dr trademarks

The inclusion of Dr or Doctor in a trademark will not generally give rise to a distinctiveness objection. However, there may be some circumstances in which a ground for objection may be appropriate:

- Where the trademark consists of the word Dr or Doctor followed by a common surname. Such trademarks should be examined based on the criteria for registration of surnames.

- Where the term Dr or Doctor is combined with another word and research clearly supports a section 23 ground for objection. For example, EYE DOCTOR for *medical services*.

Examples:

Trademark	Good and/or Services	Decision
Dr.vet	<i>Class 5: Medicines for veterinary purposes</i>	Object. These words are understood as a short form for “Doctor Veterinary”
DR. ORTHO	<i>Class 5: Pharmaceutical, veterinary, ayurvedic, herbal and sanitary preparations</i>	Object. The word ‘ortho’ in medical conveys that the meaning relating to the musculoskeletal system is essentially orthopaedics
Dr. Kilido	<i>Class 3: Hair rinses; Laundry preparations; Soap</i>	Accept

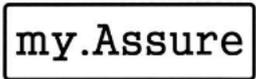
d) “My” trademarks

“My” trademarks consist of the word “My” followed by a descriptive word/s associated with the applicant’s goods or services (e.g. MY PLUMBER for *plumbing services* and MY FLORIST for *florist services*).

Where research shows that the combination of the word “My” and word/s describing the goods or services (or some attribute of the goods or services) is a commonly used and understood expression, a distinctiveness objection should be raised.

In Malaysia, when the applicant used the abbreviation “MY” (capital letter) - usually refer to “Malaysia” - prima facie, it will be objected. For example, MY HOTEL.

When considering whether a phrase containing the word “My” is capable of distinguishing (see table below), consideration must be given to the ordinary signification of the phrase. Whether or not the trademark is capable of distinguishing, will depend upon if the phrase is something ‘other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same phrase, or some phrase so nearly resembling it’. Trademarks containing the word “My” that form an expression that is not considered capable of distinguishing will require evidence of use to achieve acceptance. See examples in table below:

Trademark	Goods and/or services	Decision
	Class 36: Insurance services	Object. The trademark as a whole indicates the type of service being provided.
	Class 25: Clothing, footwear and headgear	Object. The trademark as a whole merely descriptive of the goods claimed and ‘MY’ refers to Malaysia.
	Class 43: Service for providing food and drinks	Object. The trademark as a whole indicates the kind of the service being provided.
	Class 42: Computer programs [downloadable software]; Electronic publications, downloadable	Object. ‘MY’ refers to Malaysia.

e) Ultra trademarks

"Ultra" is an ordinary term currently used as a superlative, denoting anything which is claimed to be ultimate in its field. The word "ultra" on its own or in combination with an adjective or common suffix which describes a character or quality of the goods or services has limited capability of distinguishing. Examples where a ground for objection is warranted include ULTRA CREAMY for milk and ULTRA FAST for delivery services.

Examples:

Trademark	Goods and/or services	Decision
UltraGlass	<i>Class 9: Cases for smartphones; Protective films for smartphones</i>	Object. The trademark as a whole indicates the quality and characteristics of the goods.
	<i>Class 12: motors and engines for vehicles</i>	Object. The trademark as a whole indicates the quality and characteristics of the goods.

f) World and land trademarks

Trademarks consisting of WORLD, WORLD OF, LAND, LAND OF in combination with the name of, a direct reference to, or an attribute of, the designated goods or services will not generally be considered prima facie capable of distinguishing.

WORLD or LAND trademarks which form an expression commonly used to define a particular field of interest or activity will usually possess

insufficient capacity to distinguish goods or services in that field. Such trademarks will usually need evidence of use to achieve acceptance.

Trademark	Goods and/or services	Decision
WORLD OF WATCHES	<i>Class 16: Magazines [periodicals]</i>	Object. The trademark as a whole indicates the kind of the goods.
	<i>5: Herbal extracts for medical purposes; Medicinal herbs</i>	Object. The trademark is merely descriptive of the goods claimed.

g) Trademarks containing a unit of time

Trademarks containing a unit of time such as DAY, WEEK or MONTH in combination with a word or expression that defines, describes or indicates a particular field of interest or activity may not be capable of distinguishing particular goods and or services.

Examples:

Trademark	Goods and/or services	Decision
WORLD WISH MONTH	<i>Class 45: Charitable services, namely, granting wishes to children with critical illnesses.</i>	Object. Ground for objection likely to be appropriate as the services are indicative of the type and target audience of charitable services in class 45.
ASIA FASHION WEEK	<i>35: Production, organization and presentation of fashion shows for advertising or promotional purposes</i>	Object. Ground for objection likely to be appropriate as the services in class 35 relate to a week long event which features or showcases Asia fashion.

h) New terminology and fashionable words

Language and its usage are constantly changing. There are many words used today which were not in vogue or did not even exist five years ago, or which have changed their meaning with the passage of time. Examiners should take this into account when assessing the registrability of trademarks and should try to be aware of emerging trends in the use of language.

For example, market interest in environmental issues has been characterised by use of words such as "Green" and "Ozone", and abbreviations such as "Eco".

The popularity of new words or phrases is not restricted to the environment. Many areas including modern technology, the Internet, and fashion develop new language and new uses of existing language which quickly become generic.

For examples, the word/abbreviation "ORI" would generally refer to "original", or the word "LICIOUS" for "delicious". Where research shows that the combination of these word /abbreviation describing the goods or services (or some characteristic of the goods or services) is a commonly used and understood expression, a distinctiveness objection should be raised for example, ORISHOES, FRUITILICIOUS.

New terminology & fashionable words	
ECO	GO
ORI	NU, NEO, NEU

BIZ	LITE
BIO	VIRAL
EZ, EZI, EZY	HI
- LICIOUS	RITE
2U, 4U	X-
MASTER	K-
JOM	I-
- KU	

Examples:

Trademark	Goods and/or services	Decision
ECO-COOL	<i>Class 1: Fluids made with oil or lubricants, which may be mixed with water for treatment of metals</i>	Object. The trademark as a whole indicates the quality and characteristic of the goods.
	<i>Class 9: Application software for smartphones; Artificial intelligence software</i>	Object. The trademark as a whole indicates the intended purpose of the goods.
	<i>Class 31: vegetarian plants, mushroom, seaweed</i>	Object. The trademark as a whole indicates the quality and characteristic of the goods.
	<i>44: Dentistry services.</i>	Object. The trademark as a whole indicates the quality of the services being provided.
Eziclean	<i>Class 3: Cleaning, polishing, scouring and abrasive preparations</i>	Object. The trademark as a whole indicates the function and characteristic of the goods.
	<i>Class 36: Online and electronic banking services</i>	Object. The trademark as a whole indicates the kind of the services being provided.

	<i>Class 44: Medical consultations</i>	Object. The trademark as a whole indicates the services being provided.
	<i>Class 43: Restaurants services</i>	Object. The trademark as a whole indicates the kind of the services being provided.

i) E trademarks

With the increasing use and importance of electronic forms of communication, in particular the Internet, to conduct business and advertise goods and services, it has become increasingly commonplace for traders to adopt trademarks featuring the prefix "e". The prefix is commonly understood to mean electronic and it is often used, in combination with a word or phrase, to indicate goods which incorporate electronics or electronic technology or services provided by electronic means, that is, online or via the Internet. As such, a trademark consisting only of the prefix "e" and a word or phrase which has a direct reference to the goods or services claimed will be considered to have little or no capability of distinguishing.

Examiners will need to consider if the element in the trademark, apart from the prefix "e", has capability of distinguishing the goods or services. The presence of the prefix "e" in a trademark is unlikely to add to the trademark's capacity to distinguish unless it is rendered in a very distinctive way.

For example, a ground for objection would be raised against e-TOYS in respect of a broad claim for class 28 goods as it would be considered to

have a reference to electronic toys. Similarly, it would have direct reference if the specified services were the *retailing* of toys.

Trademarks such as e-COMMERCE for business services and e-PRINT for printing services are not prima facie capable of distinguishing.

However, if a trademark consists of the prefix "e", and a word having no direct reference to the specified goods or services (such as e-magic for non-magic related goods/services), or if the reference is illusory (such as e-wonder), then the trademark will be prima facie capable of distinguishing.

Examples:

Trademark	Goods and/or services	Decision
e-SMART	<i>Class 12: Automobiles; Motors and engines for automobiles</i>	Object. The trademark as a whole indicates the quality and characteristic of the goods.
	<i>Class 9: Computer programs [downloadable software]; Terminals [electricity]</i>	Object. The trademark as a whole indicates the type and characteristic of the goods.
	<i>Class 39: Transport</i>	Object. The trademark as a whole indicates the type and characteristic of the goods.

j) Domain names

A domain name is the address which is entered into a web browser's address field to locate resources on the Internet. It is typically a combination of standard address code material and an identifier.

Standard address code material points to directories, sub-directories and servers and is common to many domain names. Examples of standard address code material are: "http://", "www.", "net", "org", "com", "shop" or "au" and punctuation symbols "~", "." or "/". (search for domain name through MYNIC)

An identifier may be an individual's name, an existing trademark, a company name, a product name, a topic or any other combination of letters and numerals and is unique within any given domain name registration system.

As a rule of thumb, an Internet Domain name will probably only be acceptable as a trademark under Malaysian law if the main component meets the standard requirements for a registrable trademark and if the component is not overwhelmed by the additional "address" material in the trademark.

In a domain name, it is the identifier which enables one domain name to be differentiated from another and may lend a domain name some trademark significance. In other words, it is the identifier which is the distinguishing element of a domain name, and this is the element which should be considered when assessing the capability of distinguishing.

Where a trademark consists only of standard address code material and an identifier it will not be prima facie capable of distinguishing if the identifier is a word, phrase, or combination of letters and/or numbers which other traders would wish to use in the normal course of their trade. An example of when a ground for objection should be raised is the domain

name such as ALI.COM or BESTPRICE.COM as ALI is a common name and best price is a laudatory expression.

Another example “terrific.org” would not be acceptable, because it consists of a laudatory term and the non-distinctive address component “.org”. However, “mangoseed.org” would be acceptable for bicycles. The goods or services relevant to the trademark will also have the usual bearing on whether objections to registration should be raised.

The ability of the trademark to distinguish must be assessed on consideration of the mark as a whole and where a distinguishing element is overwhelmed by distinctive matter an objection should be raised. For example, “padini.com” or “https://www.padini.com” would be acceptable as it consists of distinctive element of the word “Padini”.

The normal criteria for determining similarity apply when comparing trademarks that include an Internet address. For example, https://www.padeeny.com would be considered deceptively similar to https://www.padini.com. The inclusion of a full Internet address will probably result in a broader range of objections based on similarity.

If a domain name is part of a composite trademark, the trademark may be prima facie capable of distinguishing due to the overall presentation, depending on the relative proportions, arrangement etc. of the material within the trademark, as a whole.

Where a distinctiveness objection has been raised, the fact that the applicant is the registrant or authorised user of the domain name is not sufficient on its own to overcome the ground for objection. However, if the

applicant has been using the domain name for a sufficient period and it has developed the secondary meaning of indicating trade origin, this may support applying the evidence provisions of section 23. When assessing evidence in relation to domain names examiners should be mindful that use does not always equal distinctiveness.

Examples:

Trademark	Goods and/or services	Decision
	<i>Class 35: Advertising of goods or services</i>	Object. The trademark as a whole indicates the characteristic of the services being provided.
LAMPU.COM.MY	<i>Class 11: Led floodlights; Led lamp lights</i>	Object. The trademark merely descriptive of the goods claimed.
	<i>Class 35: online retailing of various goods</i>	Accept

k) Smart and intelligent trademarks

The ordinary dictionary meanings of the words "smart" or "intelligent" should be taken into account when examining trademarks incorporating them, as should the surname significance of Smart. However, the words are now ones which many traders wish to use, particularly in relation to goods which utilise, or are a product of, modern technology. In relation to these goods the words are understood to mean that the goods have one or more of the following features in some form or degree:

- incorporate artificial intelligence

- are computerised or utilise processors or other mechanisms of control
- are programmable
- have automated functions
- are capable of processing information.

If the designated goods incorporate any of the features mentioned above, and the trademark consists only of the word SMART or INTELLIGENT, then a ground for objection should be raised.

If a trademark consists of the word SMART or INTELLIGENT combined with a word having some reference to the goods or services, then it is unlikely to be sufficiently capable of distinguishing. For example, SMART LIGHTS would not be prima facie capable of distinguishing on lighting apparatus or the installation of lighting apparatus and therefore a distinctiveness objection would be appropriate.

If a trademark consists of the word “PRO” combined with a word having some reference to the goods or services, then it is unlikely to be sufficiently capable of distinguishing. For example, “PRO CLEAN” would not be prima facie capable of distinguishing on cleaning goods or services and therefore a distinctiveness objection would be appropriate.

Examples:

Trademark	Goods and/or services	Decision
	<i>Class 36: investment advisory services</i>	Object. The trademark as a whole indicates the type and characteristic of the service being provided.

iDryer	<i>Class 11: Hair dryers for beauty salon use</i>	Object. The trademark as a whole indicates the kind and characteristic of the goods.
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I) Surnames

When deciding whether a trademark consisting of a surname is capable of distinguishing the designated goods and / or services of an applicant from those of other traders, it is necessary to first consider the extent to which the trademark is capable of distinguishing those goods and / or services. The commonness of a surname is an indicator of the extent to which the trademark is capable of distinguishing the applicant's goods and / or services.

The consideration as to whether a trademark containing or consisting of a surname is capable of distinguishing is multifaceted however some **factors in determining the degree of adaptation** include:

- i. If your research indicates that a **surname is common or shared** by a significant portion of Malaysians it is more likely that other traders may wish to use the same name in trade, and as such that name is less likely to be capable of distinguishing any one trader's goods or services.

Examples of common Chinese surnames in Malaysia are Lee, Tan, Wong, Yeoh, Wang, Li, Chen, Chan, Chong, Huang, Ng, Goh, Zhang, etc.

- ii. If the surname in the trademark also has **other meanings and associations**, these should be considered, taking into account their

relevance to the application at hand and the level of understanding that consumers and general public may have.

Surnames	Secondary Meaning
LEE	Lee is a surname shared by a significant number of Malaysians and has secondary meaning which is shelter and protection.
WANG	Wang is a surname shared by a significant number of Malaysians and has well-known relevance to and associations with money and wealth.
ONG	Ong is a common surname which often spelled Wang, and it can also refer to prosperity in Chinese.

- iii. Is it common practice in Malaysia for traders of the particular goods and / or services claimed to **use their surname as a trademark**?

For example, it is common for legal practices to adopt and utilise surnames as part of business names and trademarks, such as, 'Wong & Partners', 'Tee, Low & Associates', 'Lee & Partners', etc.

m) Combination of a surname and other words/additional matter

If a trademark consists of a surname combined with words that are considered descriptive in relation to the particular goods and / or services, it is unlikely that it will be sufficiently capable of distinguishing. For example: LOKE CAR REPAIRS in relation to *motor vehicle repair and maintenance*. The surname LOKE is common and when considering the relevant factors there is nothing to suggest that this word would be considered and understood as anything else other than a common surname. The reference to CAR REPAIRS is directly descriptive of the services claimed. The mark as-a-whole would not be prima facie capable of distinguishing the applicant's services from those of other traders.

When assessing the registrability of a sign which consists of a common surname, consideration must also be given to the way in which the surname is represented. An unusual representation may serve to render it capable of distinguishing where plain type would not.

n) Trademarks consisting of two or more surnames

Two or more surnames which are not, individually, are capable of distinguishing an applicant's designated goods or services, are prima facie capable of distinguishing when they are combined. The reason for this is that the need for other traders to use the combination in relation to the same or similar goods or services is relatively low.

If a trademark consists of two surnames, where the first of them is also a common given name, for example:

Trademark	Good and/or Services	Decision
CHEONG CHAN	<i>Class 30: Coffee, tea, cocoa and artificial coffee</i>	Accept. The combination should be treated as the name of a person rather than as two surnames as this would be its ordinary significance.
TAN CHONG	<i>Class 12: Automobiles, cars, including parts and fittings thereof</i>	

o) Corporate names

Corporate names can function as trademarks. Whether they will qualify for registration will depend upon whether other traders, in the ordinary course of trade and without improper motive, are likely to want to use the same trademark, or a trademark closely resembling it, on or in connection with their own goods or services.

For example, THE BEST BAKING COMPANY would have no inherent adaptation to distinguish *bakery services* in class 43. Similarly, SELAMAT CABLE SDN BHD has no capable of distinguishing *electric cables* in class 9.

p) Titles of well-known books, novels, stories, plays, films, stage shows, songs and musical works

A trademark that consists of well-known and famous cultural products should be objected under Section 23(5)(a), regardless of the class applied. The copyright of the mark applied might belong to a particular person or company, hence if the mark is applied by another person, it might create confusion among the public as to the ownership of the mark.

If the mark applied has a meaning and the meaning has a direct reference to the specification of goods / services, further objection on Section 23(1)(b)-(c) may be imposed.

However, once a cultural product is in public domain, objection on Section 23(5)(a) may not be raised but an examiner should continue to examine the mark with regards to the distinctiveness and whether the mark applied has a direct reference to the goods/services.

Determining which trademarks are contrary to law which might include copyright law or unprotectable in a court presents more of a problem. If a trademark consists of a device, it may be assumed that the applicant owns the copyright in it. However, if there is evidence to the contrary, a ground of refusal would be that to register it, and so to confer exclusive rights in

it on the applicant would be contrary to law which might include copyright law.

Trademark	Decision	Reasons
Little Red Riding Hood	Object	The title of a classic folk tale which is clearly in the public domain. When used in relation to books, films, stage shows, etc, the words are likely to be seen merely as the title of the work, which traders would wish to use for that purpose (for example, in publishing new versions, or producing a stage show with that title).
Beethoven's 5th Symphony	Object	This popular and well-known musical work is clearly in the public domain. The words signify only the composer and title of the musical work, and it is the subject of a number of critiques and study aids, as well as being a work that others would wish to use in relation to performances and recordings.

q) Titles of books or media

Examiners should raise an objection when the mark applied is a title of a famous book, regardless of which class the mark is applied for. The following table provides some illustrative examples:

Trademark	Decision	Reason
DIY RENOVATIONS	Object	Indicates that the subject matter of the goods or services is 'do it yourself' renovations.
GARLIC DIET	Object	Indicates that the subject matter relates to diets incorporating garlic as an important element.
SPORT & LEISURE	Object	Indicates that the subject matter is sporting or leisure activities

r) Numerals

Numerals fall within the definition of a sign. Numerals and combinations of numerals are commonly used in many fields to indicate size, quantity, quality, address number, telephone number, date, date of production (e.g., 2000), model or batch number.

Where the numerals have a meaning within the market for the relevant goods/services, or are likely to be seen as indicating any of the aforementioned characteristics, it is likely that other traders, without any improper motive, will desire to use them and therefore they will not be capable of distinguishing one trader's goods or services from those of others. In such cases a distinctiveness objection will apply.

A word spelling out the number or numerals will normally be treated in the same manner as the numeral representation of the number. This was confirmed in the case of *2000 Two Thousand Trade Mark, Trade Marks Registry, [1992] RPC 65*, which refused registration of the trademark 2000 TWO THOUSAND. In the latter decision it was observed at 67 that 'the number 2000 is particularly non-distinctive and laudatory because it is increasingly seen as indicating the approaching new millennium'.

The following trademarks are not registrable:

915

SEVEN



s) Combinations of letters and numerals

Trademarks consisting of combinations of letters and numerals will generally be considered prima facie capable of distinguishing goods if there is no common need for their use.

Each combination should be viewed in the context of the goods claimed and on the basis of appropriate research. If the combination has a specific meaning in relation to the goods claimed, then a ground for objection is appropriate.

Care should be taken in relation to technological products, clothing, automobiles and whitegoods, where letter/numeral combinations are likely to be in common use to indicate **size, date, quantity, time, power, speed or strength**. For example: size (41R clothing, 4x4 vehicles), date of production (Jun 07), quantity (100 ml), quality (A1), time of production (2 pm), power (120 hp for engines, 40 w for lighting), speed (80 k or 4 MHz) or strength (% vol alcohol, psi 63800 wire).

Combinations of letters and numerals will generally be considered as capable of distinguishing good or services as it is not likely that traders would need such combinations to identify their services. However, if the combination has a specific meaning in relation to the services claimed, then an objection is appropriate.

Three or more letters, which are in themselves registrable, when combined with a numeral would generally result in a trademark which is not likely to be required for use by other traders.

The following trademarks are registrable:



8视界



The following trademarks are not registrable:

Trademark	Good and/or Services	Decision
4BY4	<i>Class 12: Shock absorber for automobiles</i>	Object. Typically refers to a four-wheel drive vehicle (automobile engines that powers all four wheels).
G69	<i>Class 1: Chemicals used in industry, in particular antifreeze, not including catalysts or catalysts carriers</i>	Object. The mark is not represented in a special manner.

t) Devices

A device trademark is a drawing, picture or other image that appears without text, letters or numerals. Device trademarks were among the first signs used to indicate trade origin and there are many famous and well-known trademarks that continue to take this form. However, pictorial signs that are common to the trade are not capable of distinguishing a trader's goods or services in the marketplace.

The starting point for assessing the capacity of a device mark to distinguish the applicant's goods or services is the general test of distinctiveness laid down by the High Court in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2014) 254 CLR 337. Although that case dealt specifically with the registrability of foreign words, it provides general guidance that can and must be applied to other types of trademarks. The first step of the enquiry is to determine the "ordinary signification" of the device. This is to be determined by reference to the "target audience" of the goods and services. Once that signification has been determined, the second step is to enquire as to the likelihood of other traders wanting to use that device or some deceptively similar variant for the sake of that signification.

u) Representations of the goods and other representations that signify the nature of the goods/services

A device which is an ordinary depiction of the goods upon which, or in connection with which, it will be used is generally not prima facie capable of distinguishing. For example, the **ordinary** signification of picture of a wheelbarrow is "this is a wheelbarrow". Hence an image of a wheelbarrow for *wheelbarrows* would not be prima facie capable of distinguishing any one trader's wheelbarrows in the marketplace.

A trademark which consists solely of a device which is common to the trade will not be considered to be inherently capable of distinguishing unless it is depicted in a special or fanciful manner. For example, an ordinary representation of grapes and vine leaves for *wine* would not be

considered capable of distinguishing one trader's wine from that of another.

Other examples of devices common to the trade are cats and dogs for *pet food*, orchard scenes for *fruit*, pictures of aeroplanes for *travel services*, pictures of dogs for *kennel services* and simple depictions of a knife and fork for *restaurant/catering services*. For the consumer such pictures ordinarily signify the kind or intended purpose of goods and services.

The following trademarks are not registrable:

Trademark	Goods and/or services	Decision
	<p><i>Class 31: Fresh fruit; Fresh vegetables (other than Arugula); Plant seeds; Plants.</i></p>	<p>Object. The mark contains an image of an apple which merely descriptive of the goods applied.</p>
	<p><i>Class 5: Injectable pharmaceuticals.</i></p>	<p>Object. The mark contains an image of a syringe that is common in the pharmaceutical industry.</p>

v) Representations that signify the qualities or characteristics of the goods/services

Some devices are commonly used and understood to convey information about the properties or characteristics of goods or services. Examples include an image of a skull and crossbones to indicate that a product or

substance is poisonous, an image of a lightning flash to indicate the presence of electrical apparatus or an electrical hazard, as well as symbols such as the recycling symbol and the trefoil radiation symbol, depicted below left and below right, respectively.

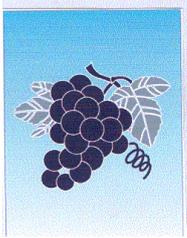


Devices of this kind, sometimes referred to as ‘universal symbols’, will generally not be prima facie capable of distinguishing, at least when they are represented in a normal fashion and used in their ordinary or expected context. The recycling symbol is likely to be problematic for most goods, since its ordinary signification is that goods are recyclable and hence this symbol is a device that other traders might want to use in relation to a very wide range of products. However, where the use of a universal symbol is obviously fanciful, such as the use of the radiation symbol in relation to beer, the mark is likely to be treated as prima facie capable of distinguishing. It should, however, be noted that the use of some universal symbols, including the radiation symbol, is regulated by statute and a mark will not be registrable where its use would be contrary to law.

A few of the more **common trade usages** are mentioned below. Where the trademark consists solely of the device concerned, it might not be accepted for registration unless the applicant had proven secondary meaning (distinctiveness) by submitting evidence of use during appeal or hearing.

Device	Remarks
STARS	Common to accommodation services to indicate the quality of the accommodation services (e.g., a four-star hotel).
VINE LEAVES AND GRAPES	Common to the wine and alcoholic drinks trade
HOPS AND EARS OF CORN	Common to the trade in beer and similar beverages.
FLOWERS, SHRUBS, TREES AND HERBS	Common to the perfumery and cosmetics trades; they should be disclaimed and, where a particular flower or herb etc. can be identified in the mark, objection will need to be taken if the goods are not appropriately limited.
COWS AND RURAL SCENES	Common to the dairy trade; they will not usually need to be disclaimed but where appropriate, the goods should be suitably limited to avoid any likelihood of deception as to their nature.
ANIMALS	Common to the leather trades; they will need to be disclaimed and the goods suitably limited, unless the articles concerned could not be made from the particular animal's skin (e.g., if they are 'textile piece goods').
COMPRISING REPEATED, OR REPEATABLE PATTERNS	These types of devices are non-distinctive for goods sold in trades commonly employing such patterns, such as wallpaper, piece goods, clothing, pottery etc. This is so, even if the pattern is somewhat complicated, such as a tartan for woollen goods. Where the device is likely to be used as a pattern on the goods, the public are not likely to see, or to use, the devices as trademarks.
BEDS, AND EATING IMPLEMENTS	Common to the accommodation and restaurant or take away food trades. These should be disclaimed.

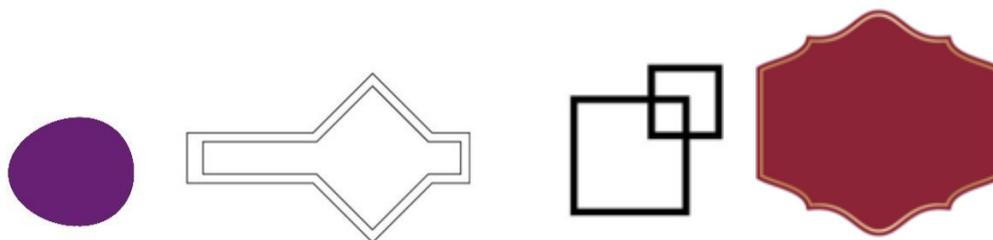
The following trademarks are not registrable:

Trademark	Goods and/or services	Decision
	<p><i>Class 9: Downloadable applications for use with mobile devices; Downloadable computer software for remote monitoring and analysis</i></p>	<p>Object. The image of a heart with a lifeline and fingerprint icon featured in the trademark is a generic representation commonly associated with heart rate monitoring services.</p>
	<p><i>Class 30: Glucose powder for food; non-medicated food supplements being glucose confectionery.</i></p>	<p>Object. The device of grapes gives an indication that the goods claimed contain a flavour from the grapes itself. Hence, it is considered as a non-distinctive trademark.</p>

w) Simple geometric shapes

Line drawings of simple geometric figures such as circles, rectangles, squares or triangles will generally not signify trade source to consumers and other traders should be free to use such devices in relation to their goods and services.

The following trademarks are not registrable:



Although they are capable of being used as trademarks, triangles, squares, rectangles, diamonds, circles, ovals etc., are more frequently used as borders or as outlines for containing other matter. Their inherent capacity to distinguish, therefore, is very low, particularly where they are hollow and not filled in.

The practice with regard to simple shapes is as follows:

- (a) circles, ovals, segments and shapes composed of three or four sides are not accepted;
- (b) irregular curvilinear shapes and regular rectilinear shapes composed of from five to nine sides are acceptable, if they are either:
 - (i) made solid, or
 - (ii) coloured, the colour named, and a condition accepted which limits use of the mark to the named colour,
- (c) regular figures having ten or more sides are regarded as too close to circles and are treated as (a) above.

A combination of simple geometrical shapes must be considered on its merits. Generally, a combination of two or more elements will possess sufficient capacity to distinguish. More elaborate devices may be acceptable are shown as example below.

The following trademarks are registrable:

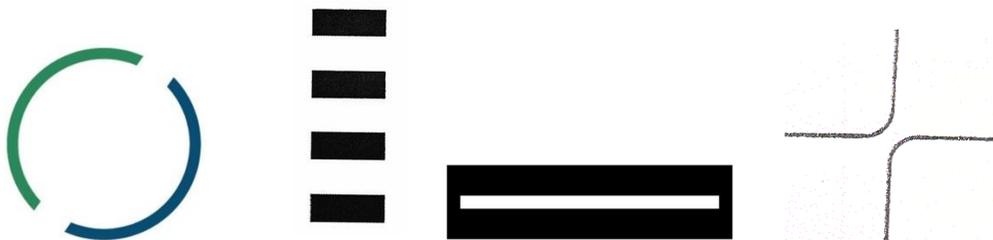




x) Markings, lines, threads etc.

Markings, lines, threads and stitching on goods can indicate trade origin. In general, however, markings, lines and the like will not ordinarily signify the trade origin of goods to consumers until they have been educated to understand that the device in question functions as a trademark. Instead, such signs are more likely to be understood as being decorative features.

The following trademarks are not registrable:



y) Images of persons

Portraits, pictures, and images of people are generally prima facie capable of distinguishing. However, if the portrait is a real-life person whether the person is living or dead, the applicant is required to get the consent of the person as laid down in Section 23(5)(f).

If, however the image represented in the trademark is of a well-known person (or group of people), and the well-known person (or group of people) is *not* the applicant, consideration should be given to section 23(5)(a) of the Act, which considers whether use of the trademark in relation to the goods or services is likely to deceive or cause confusion.

Examples:

Trademark	Decision
	<p>Accepted with portrait condition (letter of consent included).</p> <p><i>Condition:</i> The portrait appearing in the mark is that of Abby A/P Kuppusamy</p>
	<p>The mark contains the illustrated image of a women which can be accepted without letter of consent (the portrait is not a real-life person).</p>
	<p>This portrait was generated by the AI technology. It can be accepted with Statutory Declaration & condition imposed on the use of AI Portrait.</p> <p><i>Condition:</i> The portrait appearing in the mark is Artificial Intelligent (AI) created.</p>

z) Barcodes

Barcodes are machine-readable representations of data. They include linear (one-dimensional) barcodes as well as two-dimensional barcodes.

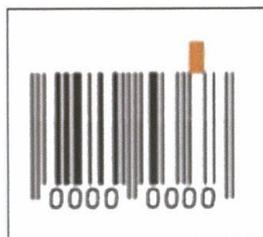


Two-dimensional barcodes are represented as geometric shapes and can be used to encode various types of information (such as text, URL, phone number). Quick Response (or QR) Codes are examples of two-dimensional barcodes:



Barcodes should be considered in relation to whether other traders are likely in the ordinary course of their business and without any improper motive, to desire to use them, or something so similar to them, upon or in connection with their goods or services. As such **a trademark which consists entirely of a simple barcode is unlikely to be prima facie capable of distinguishing.**

The following trademark is not registrable:



aa) Composite trademarks

Trademarks comprising any combination of words, devices, shapes, sounds, scents and/or colour elements must satisfy the requirement that, when taken as a whole, they are capable of distinguishing designated goods or services in the marketplace. It could be said, however, that

combinations are likely to have a higher capacity to distinguish and are more likely to be prima facie capable of distinguishing.

Examples:

Trademark	Goods and/or services	Decision
	<p><i>Class 31: Agricultural seeds.</i></p>	<p>Object. The words "Sawit Emas" refers to the nature and quality of the designated goods. Therefore, it is considered a non-distinctive trademark.</p>
	<p><i>Class 29: Milk and milk products.</i></p>	<p>Object. 'Orimilk' is a combination of two words that can give an idea of the quality of the product being traded, and the word 'Ori' is a short-form for the word original. Therefore, it is considered a non-distinctive trademark.</p>
	<p><i>Class 18: Leather; Imitation leather</i></p>	<p>Accepted with disclaimer the letters "MG"</p>