

Word Mark: Working Around the Trademark Distinctiveness Test

Following 27 December 2019, Trademark registration in Malaysia is governed by the Trade Marks Act ('TMA') 2019 which lays down *absolute grounds of refusal* under section 23(1). These grounds of refusal may pose difficulties for brand owners in the registration process as it allows the Registry to refuse registration of a mark which: -

- ✗ is lacking distinctive character;
- ✗ exclusively refers to the quality and characteristics of the goods filed; or/and
- ✗ is a customary sign in relation to the nature of the business.

This article focuses on ways to increase the distinctiveness of a word mark to avoid registrations falling under the hurdle of section 23(1) TMA 2019. An essential function of trademarks is to act as a batch of origin so consumers could clearly identify the source of goods and not fall into the schemes of buying counterfeit goods. To do that, it is sensible for the mark to be sufficiently distinctive so as to allow consumers to associate the goods to the novel mark in question.

✓ **Invented words / Unusual spelling**

One method of achieving such aim is to propose an invented word such as the brands "Kodak", "Kleenex" and "Samsung". For a word to be classified as an invented word, it must be 'clearly and substantially different from any word in ordinary and common use'¹ or 'has no obvious meaning until one has been assigned to it.'²

✓ **Neologism**

Alternatively, you may combine words to create a unique combination so as to render the mark distinctive. An interesting example can be drawn from a UK case regarding the registration of the mark "Baby-Dry" for diapers.³ Although "Baby" and "Dry" denotes a descriptive connotation on its own and would thereby fall under the absolute grounds of refusal, the UK Courts nevertheless deemed the mark "Baby-Dry" to be sufficiently distinctive and allowed its registration on the basis that consumers would be required to exercise some "further thought" before coming to associate the mark to diapers. The test laid down was whether the word combination in question was representing the essential characteristics of the goods and services in 'common parlance'.

¹ Eastman Photographic Materials Co Ltd's Application (1898) 15 RPC 476 at 486 (per Lord Macnaughten).

² Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338.

³ C-383/99 Procter & Gamble v. Office for Harmonization in the Internal Market

However, there is a fine line between a distinctive neologism and a non-distinctive neologism. Therefore, while a combination of descriptive words may help in increasing the distinctiveness of a descriptive word, a degree of risk for the Registry to see it as a descriptive mark exists nonetheless. It might be best to seek professional advice before registering such a word mark.

✓ **Add a logo to your word mark**

Furthermore, marks must be considered as a whole by the courts when assessing its distinctiveness. A combination of individual elements common to the trade may still be qualified as a distinctive mark⁴. Therefore, it may be helpful to add a logo to your word mark, making it a composite mark and hence increase the distinctiveness of your mark such as Nike's "Swoosh" and Adidas' "triangle" logo which accompanies their brand name.

✓ **Exceptions to Section 23(1) TMA 2019 - Acquired distinctiveness through use**

Notwithstanding the four absolute grounds of refusal laid down above, section 23(2) TMA 2019 lays down that: -

“... the Registrar shall not refuse to register an application of a trademark if, before the date of application for registration, the trademark has in fact acquired a distinctive character as a result of its use.”

The basis for this ground lies within the idea that it is the essence of trade mark law “to protect the public against tortious acts of competing traders in a particular state”⁵. This gives Applicants who have long been using its mark the protection they deserve. It protects the Applicant’s well-known mark against tortious acts of competing traders. Therefore, if your proposed mark is lacking inherent distinctiveness, you may still register the mark if you could provide evidence of substantive use of the mark prior to the registration. These may include evidence of your brand establishment, use of your mark on social media platforms, on product packaging, or any other usage.

Interested to learn more? Feel free to click [here](#) or send an email to ip@gvcolegal.com to speak to one of our IP experts who will assist you.

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⁴ Tint Shop (M) Sdn Bhd v Infinity Audio Sdn Bhd [2017] MLJU 597

⁵ Hamid Sultan JCA in Al Baik Fast Food Distribution Co SAE v El Baik Food Systems Co SA (2016) 9 CLJ 310