IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1992] SGHC 77

OM 35/1991

Between

Cheng Kang Pte Ltd

… *Applicant*

And

Sze Jishian

… *Respondent*

GROUNDS OF DECISION

Trade Marks and Trade Names — Rectification of register; Words and Phrases

Version No 1: 11 Sep 2026 (01:05 hrs)

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Cheng Kang Pte Ltd and Others v Sze Jishian

[1992] SGHC 77

OM 35/1991
MPH Rubin JC
31 March 1992

1 Cur Adv Vult

2 ***Background***

3 This case is all about trade mark rights on joss paper. Joss paper is singularly associated with Chinese custom, more especially a Buddhist and Taoist phenomenon. Literature produced to the court (see `Chinese Customs and Festivals` by the Singapore Federation of Chinese Clan Association) shows that Taoists believe that the portals of hell open each year on the first day of the seventh month (usually around August) allowing the dead and unborn souls to wander the world for food and other necessities. Throughout that month and especially on the 15th day, joss paper (in silver and gold) and food are offered to these hungry ghosts. The festival of the hungry ghosts is popularly known as `Zhong Yuan Jie`. Chinese observe `Zhong Yuan Jie` by offering prayers, food and paper money to the dead. It is therefore not uncommon to see Singaporeans, particularly those who subscribe to Taoist traditions and beliefs, burning joss paper at temples, street corners and road sides during that festival. Joss paper is burnt in many forms and shapes, and sometimes in stacks or bundles.

4 **Parties and facts**

5 Sze Jishian (`SJ`), the respondents in this action, had been in the business of selling joss paper since about December 1983. They claim that sometime in 1986, one of the partners, Ng Kim Bok, wanted to have a trade mark for the joss paper they were selling in Singapore. As a result, the services of one Everbeauty Art Studio was commissioned to design the mark and the mark so designed with a Chinese `Yuan Bao` (silver or gold ingot) surrounded by a typical Chinese border characterized by a decorative, geometric motif was eventually registered. The respondents are currently the proprietors of trade marks bearing registration Nos 5730/87 and 4264/89. The trade marks are reproduced hereunder for reference.

6 **Trade mark registration No 5730/87**

7 5730/87. Joss-paper. Ng Kim Bok and Toh Poh Chu (both Singapore citizens) trading as Sze Jishian, Block 416, Pandan Garden #01-121, Singapore 2260; importers and exporters - 24 November 1987.

8 Trade mark registration No 4264/89

9 ***The transliteration of the Chinese characters appearing in the mark is `Cai` meaning `wealth` and `Bao` meaning `treasure`.***

10 4264/89. Joss paper. Ng Kim Bok and Toh Poh Chu (both Singapore citizens) trading as Sze Jishian, Block 416, Pandan Garden #01-121, Singapore 2260; importers and exporters - 6 July 1989. To be associated with No 5730/87.

11 It can be observed that the trade marks` main feature is the pictorial likeness of a Chinese `Yuan Bao` representing a hoof-shaped silver or gold

ingot used as currency in China in the early days. One account presented to the court shows that the gold ingot is normally meant for safe-keeping and the other, the silver ingot, is for circulation. The trade mark registration bearing No 4264/89 is identical in all respects to that of the one registered as 5730/87 except for the addition of the Chinese characters `Cai Bao` which means `wealth` and `treasure` placed near the ingot.

12 After the registration of the said marks, the respondents claimed that sometime in 1989, they appointed one Young Heng Paper Pte Ltd to engage a manufacturer in China to produce joss paper with the said marks on them. The first batch of joss paper thus manufactured was delivered to the respondents in June 1989 and according to the respondents, between 26 June 1989 and 21 June 1991, there had been a steady increase in the demand for their brand of joss paper. All in all, during that period they claimed to have ordered 376 crates of joss paper, each crate containing 360 stacks or bundles of joss paper of about half an inch thick. They also claimed to have sold off everything they had just ordered and it was due to the success of their design and the trade mark thereon that rival traders dealing in joss paper were eager to partake of its popularity and prestige.

13 The respondents came to know sometime before 31 July 1990 that one Cheng Kang Pte Ltd (`CK`), the principal applicants in this motion, had been selling or distributing joss paper bearing the mark similar to that of the respondents. SJ`s solicitors therefore wrote to CK on 31 July 1990, demanding CK not to pass off CK`s products as that of the respondents, and threatened to institute legal proceedings for passing-off against them.

14 CK and 11 other joss paper traders claiming to be persons aggrieved within s 39(1) of the Trade Marks Act (Cap 332) (`the Act`) responded by

Version No 1: 11 Sep 2026 (01:05 hrs)

applying to the court for the register of trade marks to be rectified by expunging therefrom the whole of the entry relating to trade mark Nos 5730/87 and 4264/89. The applicants` main point of contention was that the said pictorial representation being such a descriptive device in the joss paper trade cannot and should not be monopolized by the respondents.

15 Affidavits filed in support and in opposition were legion. Evidence presented in those affidavits had an inclination to repeat itself. The affidavits contained allegations and counter-allegations, points and counter-points replete with legal arguments, some of which could well have been left for submissions. All the same, the salient parts of the applicants` averments and the respondents` rebuttal could be conveniently summarized in the following few paragraphs.

16 The applicants, after alleging that they were aggrieved parties, averred that they, too, had been importing joss paper bearing the gold ingot symbol from manufacturers in China, and in that country, the representation of the gold ingot is regarded as descriptive and hence a number of manufacturers use that symbol on joss paper. These manufacturers who used representations of gold ingot on joss paper would then use different trade marks to differentiate their products from that of other manufacturers. They further averred that joss paper importers in Singapore should be at liberty to buy joss paper bearing the representation of the gold ingot from any one of those Chinese manufacturers. They argued that a Singapore importer in the position of the respondents could not validly claim to be the proprietors of such a mark within the meaning of s 11 of the Act. I must add at this juncture that the applicants` arguments based on `prior use` were abandoned in the course of the hearing.

17 The applicants went on to contend that the representation of the gold ingot for joss paper is not a mark which qualified for registration under s 10 of

Version No 1: 11 Sep 2026 (01:05 hrs)

the Act as it lacked any one of the essential particulars required therein. The applicants also took objection to the Chinese characters `Cai Bao` appearing in trade mark No 4264/89.

18 Tan Han Teo, in his affidavit filed on 27 April 1991 on behalf of the applicants, alleged that the representation of the gold ingot had been regarded as descriptive in the joss paper trade and by devotees who burn such joss paper. According to him, when burning joss paper, the devotees desire to signify certain qualities and the gold ingot signified good luck, prosperity, wealth and progress. He also averred that it had been an age old practice to fold coloured joss paper into the shape of gold ingots for burning. He invited the court`s attention to the definition of the word `joss paper` set out in the compact edition of the ***Oxford English Dictionary*** which defined joss paper as `gold and silver paper cut into the shape of coins and ingots and sometimes inscribed with prayers and burnt by Chinese at funerals and other religious ceremonies`.

19 The thrust of the applicants` contention, shorn of tautology and all linguistic embellishments, was that the mark is more or less the actual representation of a Chinese `Yuan Bao` and the representation has a direct reference to the character and quality of the goods.

20 The respondents denied that the marks they registered had ever been marks in China or in Singapore. Before they designed the same, they did not find any mark, design or representation which closely resembled the subject mark prior to the respondents registering them.

21 The principal affirmant for the respondents, Ng Kim Bok, in his affidavit filed on 4 November 1991, asserted that one could have any design printed on the joss paper as it symbolized what one may wish to burn and transport to the

Version No 1: 11 Sep 2026 (01:05 hrs)

next world. The design which they came up with, ie the design of a stylized `Yuan Bao` was not descriptive of joss paper but a unique design.

22 Some paragraphs, particularly paras 5, 6, 7 and 8 of Ng Kim Bok`s affidavit filed on 23 July 1991 on behalf of the respondents, are indeed relevant and they are set out below:

> *Paragraph 5:*
>
> *I started the respondent company in 1983 and before that date I was working in a temple. Joss paper-burning is an act by various groups of the Chinese community in Singapore as a symbol of offering to the deities or gods or their ancestors. It is the act of burning joss paper as similar to the burning of joss stick that is revered. It is meant as an offering. In the case of offerings to the deities or gods, earthy luxury like wealth is never represented as it will be totally offensive.*
>
> *Paragraph 6:*
>
> *There is no denying that there is a practice by the Chinese community to burn joss paper which may be folded into different shapes before burning. This is partly to facilitate the process of burning and partly for decorative purposes to appease the deities or gods. It is folded into various shapes and sizes. However, often, the joss paper is burnt together in a stack without any folding.*
>
> *Paragraph 7:*
>
> *The defendants are selling their joss papers not in a folded fashion which is a completely different product from those that are folded. The two-dimensional piece of paper does not in any way represent the gold or silver ingot. The characters `Yuan Bao` may refer to coins or silver ingots in ancient China. However, this use of the words as a form of currency is only one meaning of the characters. In Singapore today, the characters `Yuan Bao` is commonly used to refer to joss paper and sometimes it may mean a particular type of joss paper, namely, paper which has a rough texture like jotter-book paper. A copy of the latter type of paper has been exhibited as `NKB-1` in my affidavit filed on 17 June 1991.*

Version No 1: 11 Sep 2026 (01:05 hrs)

> *Paragraph 8:*
>
> *The joss paper trade involves many varieties of joss paper. These have varying textures, qualities, sizes and of course different prices. There are some with a rougher feel, and others have a smoother texture. Some are yellowish in color, whilst the other types which have gold or silver colours on them. The respondent company deals mainly in a type of smooth paper with the subject mark imprinted on it. The joss paper is of a better texture and made of a grade of higher quality paper. The respondent company specially orders the joss paper from particular Chinese manufacturers. The joss paper does not in any way represent wealth or portray qualities of wealth, as alleged by the applicants. The respondent company sells joss paper mainly to be used as offering to deities. The reason for registration of the subject marks is to enable customers to identify the quality joss paper as that sold by the respondent company.*

23 Further affidavits filed in support of the respondents, one by Kua Kok Eng and another by Low Ah Chai, both on 4 November 1991, stated that prior to 1989, they had never come across any joss paper bearing a similar trade mark to that of the respondents, and that the respondents` joss paper was of a superior quality and increasingly popular.

24 The respondents` contention, as could be gathered from their several affidavits and counsel`s submission, was that the joss paper was the vehicle upon which devotees used to transport all kinds of material things to the other world and the burning of joss paper did not signify wealth; the folding of joss paper was not confined only to gold ingots for a lot of devotees folded joss paper and plain gold paper into assorted shapes so that the joss paper could be stacked up and burnt more easily; the traditional `Yuan Bao` bore only a slight resemblance to the respondents` trade mark; the original or traditional `Yuan Bao` was hoof-shaped whereas the respondents` trade mark resembled a little hat with a raised mound in the middle; the respondents` creation of the device was novel and that the stylized `Yuan Bao` was in no way descriptive of joss paper, and that the respondents` trade mark was unique in design as it did not

Version No 1: 11 Sep 2026 (01:05 hrs)

accurately depict a classic `Yuan Bao` as there had been artistic input to modify and distinguish the design.

25 The remainder of the respondents` submission was that the average Chinese devotee, on seeing the respondents` trade mark which resembled a very stylized Chinese coin or ingot would in no way automatically associate such a mark with joss paper since joss paper could have any device put upon it. It was further submitted that the devices on the joss paper cover a host of things including pictures of deities and sages and selected Chinese characters. Even the intangibles such as prosperity and longevity are depicted on joss paper. They further said that unless the applicants could prove that the device signified or described the joss paper itself, the application could not be sustained.

26 They went on to submit that the respondents` said mark was not common to the trade and that no statistics had been provided by the applicants in terms of the number of sales there had been in respect of the allegedly similar brands of joss paper in Singapore. The respondents complained that the applicants had not provided to the court any data as to when these brands came into the market. Counsel submitted that four similar brands of joss paper exhibited in Tan Han Teo`s affidavit filed in support of the application on 27 April 1991 were infringing copies.

27 **Issues and law**

28 On the threshold issue whether the applicants were aggrieved parties within s 39(1) of the Act, the respondents` former counsel had, at the outset, conceded that inasmuch as the applicants were in the same trade as the proprietors of the trade marks, the applicants could be regarded, for the purposes of these proceedings, as `aggrieved persons` within the meaning of that section.

Version No 1: 11 Sep 2026 (01:05 hrs)

But there was a clear reference in the submission of the respondents` present counsel, that the application before the court smacked of ill motives and the applicants were not bona fide aggrieved parties; rather, they were intense business rivals who wanted to partake of the respondents` success. Counsel also submitted that the evidence presented by the applicants did not go to support the contention that the applicants were indeed aggrieved parties.

29 Section 39(1) of the Act reads as follows:

> *Subject to the provisions of this Act -*
>
> (a) the court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongfully remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging or varying the entry as it thinks fit;
>
> (b) the court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register;
>
> (c) in case of fraud in the registration, assignment or transmission of a registered trade mark the Registrar may himself apply to the court under this section;
>
> (d) any order of the court rectifying the register shall direct that notice of the rectification be served on the Registrar in the prescribed manner, and the Registrar shall, upon receipt of the notice, rectify the register accordingly.

30 The words `persons aggrieved` appearing in similar legislative enactments had been a subject matter of discussion in many cases and the words generally received a broad interpretation. In the leading case of **Powell`s Trade Mark,** [1893] 10 RPC 195[1894] 11 RPC 4 (HL) Bowen LJ observed at p 201:

> *Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if*

Version No 1: 11 Sep 2026 (01:05 hrs)

> *the mark remained. It is very difficult to frame a nearer definition than that.*

31 When the case went up to the House of Lords on appeal Lord Herschell observed at pp 7-8:

> *My Lords, I should be very unwilling unduly to limit the construction to be placed upon these words; because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the register a mark which ought not to be there, and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation.*

32 Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved.

33 Lord Watson observed at p 8:

> *In my opinion, any trader is, in the sense of the statute, `aggrieved` whenever the registration of a particular trade mark operates in restraint of what would otherwise have been his legal rights. Whatever benefit is gained by registration must entail a corresponding disadvantage upon a trader who might possibly have had occasion to use the mark in the course of his business. It is implied, of course, that the person aggrieved must manufacture or deal in the same class of goods to which the registered mark applies, and that there shall be a reasonable possibility of his finding occasion to use it. But the fact that the trader deals in the same class of goods, and could use it, is prima facie, sufficient evidence of his being aggrieved, which can only be displaced by the person who registered the mark, upon whom the onus lies, showing that there is no reasonable probability*

Version No 1: 11 Sep 2026 (01:05 hrs)

> *that the objector would have used it, although he were free to do so. That reading of the statute appears, to me, to be in substantial conformity with the construction adopted by the Court of Appeal in* ***Re Riviere`s Trade Mark****, and also in* ***Re Apollinaris Co`s Trade Marks****.*

34 In **Re Wright Crossley & Co`s Trade Mark,** [1898] 15 RPC 131 Romer J, after approving the statement in **Re Apollinaris Co`s Trade Marks** [1891] 2 Ch D 186 said at p 133:

> *... that an applicant, in order to show that he is a person aggrieved, must show that in some possible way he may be damaged or injured if the trade mark is allowed to stand; and by `possible` I mean possible in a practical sense, and not merely in a fantastic view.*

35 Lord Pearce in **Daiquiri Rum Trade Mark** [1969] RPC 600 at p 615 said:

> *In my opinion, the words were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled. At common law a trader could ask the courts to protect him from the improper use of his mark by others who would pass off their goods as his. But to do this, he had to establish by cogent evidence from the purchasing public and the trade that the mark had come to denote his goods and his alone. To avoid the paraphernalia of proof and to help traders by enabling them to see more clearly where they stood in respect of particular marks the Trade Marks Acts were passed. It is, and was intended to be, a great advantage to a trader to have his mark registered under the Acts. That advantage to him is to some extent a corresponding disadvantage to his rivals. He was only intended to have it if the necessary qualifications are fulfilled. If they are not, the mark is not to be entered on the register. If it subsequently appears that it is wrongly on the register, it is to be removed. For to permit it to remain would give him, at the expense of his rivals, an advantage to which he is not entitled. Thus, the general intention and policy of the Act show, I think, that Parliament intended the words to have a wide meaning. If an erroneous entry gives to his rival a statutory trade advantage which he was not intended to have, any trader whose business is, or will probably be, affected thereby is `aggrieved` and entitled to ask that the error should be corrected.*

Version No 1: 11 Sep 2026 (01:05 hrs)

36 In Singapore, too, courts have favoured a wide definition. (See **Karrimor International Ltd v Ho Choong Fun t/a Ah Hwa Trading Co** [1989] 3 MLJ 467 and **RH Macy & Co Inc v Trade Accents.** [1992] 1 SLR 581)

37 In the case before me, the applicants and the respondents are trade rivals. Moreover, the applicants, a group of joss paper traders, it appears to me, wish to use the mark as a description of their joss paper. In the circumstances, if the trade marks which now stand registered in the name of the respondents are erroneous, they would give the respondents a statutory advantage to which they would not be entitled. Given those facts, the applicants` contention that they are aggrieved persons within the meaning of s 39(1) of the Act is not without justification, and I hold that for the purposes of this application and in a very practical sense, the applicants are indeed persons aggrieved. In the result, the applicants are entitled to make this application.

38 As regards the applicants` original claim based on prior use and the argument that the respondents were not proprietors of the said mark within the meaning of s 11 of the Act, Mr Dedar Singh, for the applicants, conceded that the applicants would abandon the ground based on proprietorship and prior use. The issues for resolution therefore encompassed only the provisions of s 10 of the Act, viz: (a) whether the subject marks are or are not distinctive; (b) whether they are descriptive of the character and quality of joss paper; and (c) whether the marks are common to the trade.

39 Section 10 of the Act provides:

Version No 1: 11 Sep 2026 (01:05 hrs)

> (1) A trade mark (other than a certification trade mark) registrable in Part A of the register shall contain or consist of at least one of the following essential particulars:
>
> (a) the name of a company, individual or firm represented in a special or particular manner;
>
> (b) the signature of the applicant for the registration or some predecessor in his business;
>
> (c) an invented word or invented words;
>
> (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname;
>
> (e) any other distinctive mark; provided that a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.
>
> (2) For the purposes of this section, `distinctive` means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
>
> (3) In determining whether a trade mark is adapted to distinguish as aforesaid the Registrar or the court may have regard to the extent to which -
>
> (a) the trade mark is inherently adapted to distinguish as aforesaid; and
>
> (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid:
>
> …

40 Before embarking on an analysis of s 10 of the Act and its implications to the facts and issues at hand, it would, perhaps, be useful to restate a few well-settled principles of law. It must be remembered that the onus of proving that the said mark was not distinctive rests squarely on the applicants for it is provided under s 47 of the Act that the fact that a person is registered as

Version No 1: 11 Sep 2026 (01:05 hrs)

proprietor of a trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and all subsequent assignments and translations thereof. Secondly, it is almost axiomatic that the court should scrutinize with care, applications to register inherently non-distinctive marks and that the court should be careful not to interfere with other persons` rights further than is necessary for the protection of the claimant and not to allow a claimant to obtain a monopoly further than is consistent with reason and fair dealing: per Lord Cohen in **Re Yorkshire Copper Works` Application** [1954] 71 RPC 150 at p 157, quoting from **Re Joseph Crosfield & Sons Ltd.** [1910] 1 Ch 130

41 Lord Diplock in **Smith Kline and French Laboratories Ltd v Sterling-Winthrop Group Ltd** [1976] RPC 511[1975] 2 All ER 578 at pp 538 and 539, adopted the following approach:

> *However, long before the reference to inherent adaptability had been incorporated in the current statutes dealing with trade marks, it had been held upon grounds of public policy that a trader ought not to be allowed to obtain by registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use. The classic statement of this doctrine is to be found in the speech of Lord Parker in the* ***W & G*** *case (1913) 30 RPC 660 at p 672 where he said that the right to registration should `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 with their own goods`. The reference to `inherently adapted` in s 9(3) of the Consolidation Act of 1938, which was first enacted in 1937, has always been treated as giving statutory expression to the doctrine as previously stated by Lord Parker.*

42 The underlying principle is that the Act (s 15(1)) requires that the mark should not be likely to deceive or cause confusion, or that it should not otherwise be disentitled to protection in the court of justice. It also requires that the mark be distinctive and lays down certain guidelines as set out under s 10(1) of the

Act. In dealing with the issue of registrability, Kitto J made the following observations in the Australian case of **Clark Equipment Co v Registrar of Trade Marks** [1964] 111 CLR 511 at p 514:

> *The interests of strangers and of the public are thus bound up with the whole question [of registrability] ... but to say this is not to treat the question as depending upon some vague notion of public policy: it is to insist that the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives - in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess - will think of the word and want to use it in connection with similar goods in any manner which would infringe a registered trade mark granted in respect of it.*

43 Now touching upon the issue whether a mark resembling a `Yuan Bao` registered by the respondents for joss paper could be distinctive, particularly when it is conceded by the respondents that joss papers are sometimes folded in the form of a `Yuan Bao` and burnt during religious occasions, my attention was invited to a number of decisions and I propose to deal with a few of them.

44 In **Unilever PLC`s Trade Mark,** [1984] RPC 155 Unilever applied to register a device mark in Part A of the register which consisted of a slug of red and white toothpaste being extruded from the mouth of a toothpaste tube onto a toothbrush. The application was in respect of toothpaste, and by the time of the appeal by opponents to the application, the application for registration had been made subject to certain conditions.

45 The principal objections to registration raised by the opponents were that the mark represented on the form of application was not a trade mark within the meaning of s 68 of the Act (equivalent to our s 2), and that even if it was, it was not distinctive within the meaning of s 9 (equivalent to our s 10). The applicants

Version No 1: 11 Sep 2026 (01:05 hrs)

for registration filed evidence showing that the device mark had been extensively used in relation to the advertisement and sale of their red and white striped `SIGNAL` toothpaste, and invariably in association with the `SIGNAL` mark. The applicant`s evidence was given by statutory declaration; several of their witnesses were cross-examined on their declarations. There was no evidence from the public. The assistant registrar dismissed the opposition and allowed the registration to proceed. From this decision, the opponents appealed to the court.

46 In allowing the appeal, the court held that (1) on the evidence, it was the common practice of toothpaste manufacturers to illustrate a product by putting on cartons and advertisements representations of toothpaste being extruded onto a toothbrush; (2) the advertising material relied upon by Unilever emphasized `SIGNAL` as the trade mark of the product and stressed the functional nature of the red stripes; and (3) the mark was not a trade mark within the meaning of the Act; it was a pictorial representation of the product.

47 Falconer J observed, at p 188:

> *... that it is common practice of toothpaste manufacturers to illustrate a product by putting on their cartons and in their advertising literature representations of the toothpaste being extruded onto a toothbrush; but it is really nothing more than a descriptive picture telling the potential purchaser of the nature of the toothpaste he is going to get; it is going to be the toothpaste with the red stripes; and the textual matter which usually goes with it tells him that the red stripes contain either the breath-sweetening material in the early stages and later on the fluoride component. ... where you have a pictorial device, the pictorial device being one which in itself is purely descriptive, in the sense that it is a picture of the product and is intended to illustrate the product, following the custom of the particular trade.*

48 The next case referred to was **Re Maschinenfabrik Gustav Eirich`s Application** [1958] RPC 493 where there was an application to register a

diagrammatic device in respect of certain machines. The application was opposed by the opponents, Liner Concrete Machinery Co Ltd, on the grounds that the mark applied for was an ordinary diagrammatical feature and was not therefore adapted to distinguish the goods of the applicant company, and that its registration would embarrass the opponents in the conduct of their business. It was held that the device sought to be registered was of so descriptive a character as to be inherently unadapted to distinguish the goods of the applicants irrespective of any amount of use prior to the filing of the application. The decision of the assistant comptroller was based on his appreciation that he took into account the admitted practice in the industry of including diagrams of a closely similar nature in sales brochures, and he fully adopted the observations of Lord Parker in the case of **The Registrar of Trade Marks v W & G Du Cros Ltd** [1913] 30 RPC 660 at p 672, namely:

> *The applicants` chance of success in this respect (ie of establishing that their mark is distinctive) must, I think, depend largely upon whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.*

49 My attention was next invited to the case of **Pantino Inc`s Application** [1966] RPC 527 where an application was made to register, as a trade mark for clothing, an outline sketch of a woman in a blouse and slacks. It was rejected by the registrar on the ground that the proposed mark was not `adapted to distinguish` or `capable of distinguishing` the applicants` goods, such sketches or photographs of women in similar poses being commonly used as illustrations or advertisements in the clothing trade. On appeal, the registrar`s decision to reject the mark was upheld by Tookey QC. He held that the mark was no more than a sketch of the kind which commonly appeared in advertising literature, newspapers and periodicals in connection with women`s clothes, including clothes of the type which the girl was wearing and he agreed with the registrar

Version No 1: 11 Sep 2026 (01:05 hrs)

that there was nothing inherent in the sketch which even suggested that it was intended to be a distinctive mark indicative of a particular manufacturer or trader. He held that it was an ordinary kind of fashion sketch to be found associated with women`s clothing, and inherently carried no other significance.

50 In the ***Pantino*** case,14 the appeal tribunal had to deal with a decision of the English Court of Appeal in **Re James`s Trade Mark; James v Soulby** [1886] 33 Ch D 392 which was decided under s 10 of the Trade Marks Registration Act of 1875.

51 In the ***James`s Trade Mark*** case,15 the plaintiffs registered in 1861 a design for the shape of blocks of black lead, being a cylinder terminated by a dome at one end. From that time they sold black lead in boxes upon which a black dome was impressed, and they imprinted a dome upon each block of black lead. This they did without regard to the shape of the blocks they sold, and there was evidence that the term `dome black lead` had become known in the trade as denoting black lead of the plaintiffs` manufacture. In 1877 they registered a black dome as their trade mark for `black lead`. The plaintiffs having brought an action to restrain infringement of their trade mark, the defendants applied to have it expunged from the register, and Mr Pearson J ordered it to be expunged on the ground that it was only a representation of the thing sold, which thing everybody was at liberty to make, and therefore was not a good trade mark.

52 On appeal, the Court of Appeal, in allowing the appeal, held that there was no reason why a dome should not be a distinctive mark for black lead, that the evidence showed it to be in fact distinctive, that it was therefore capable of registration as a trade mark, and that the decision of Mr Pearson J must be reversed.

Version No 1: 11 Sep 2026 (01:05 hrs)

53 Lindley LJ at pp 395-396 observed:

> *A mark must be something distinct from the thing marked. The thing itself cannot be a mark of itself, but here we have got the thing and we have got a mark on the thing, and the question is, whether that mark on the thing is or is not a distinctive mark within the meaning of the Act. Of course the plaintiffs in this case have no monopoly in black lead of this shape. Anybody may make black lead of this shape provided he does not mark it as the plaintiffs mark theirs, and provided he does not pass it off as the plaintiffs` black lead. There is no monopoly in the shape, and I cannot help thinking that that has not been sufficiently kept in mind. What the plaintiffs have registered is a brand, a mark like a dome intended to represent a dome. Is that a distinctive mark? There may be marks not sufficiently distinctive to come within the statute, but I cannot conceive why a mark such as we have here should not be a distinctive mark, and as a matter of fact the evidence shews that it is a distinctive mark. Why, then, should not the plaintiffs put it on their labels, and why should not they put in on the things they make? Supposing they chose, as for aught I know they may choose, to sell black lead of this description in cubes or spheres, or in octagonal or other shapes, there is no reason why they should not mark them with this mark of a dome. If they do I cannot see that there is anything contrary to the Act in their claiming the benefit of that registered dome-mark. It appears to me that Mr Pearson J`s decision in this case cannot be supported.*

54 As regards the American decisions, I quite concur in the observations made by Cotton LJ. I cannot see why, according to English law, a fish should not be a distinctive mark of a fishing line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned pigskin into leather, I do not know why a pig should not be a good trade mark for tanned pig`s hide. I am not inclined to apply to English Acts of Parliament the American cases which have been cited. I am not acquainted with the American Acts under which they were decided, and I have not found the American definition, if there be one, of a trade mark.

Version No 1: 11 Sep 2026 (01:05 hrs)

55 However in the ***Pantino*** case,14 the appeal tribunal distinguished the decision of the Court of Appeal on the ground that the Lord Justices arrived at their decision on facts peculiar to the case, and in any event, it was decided under the Trade Marks Registration Act of 1883 (in fact 1875). I should add that the ***James`s Trade Mark*** case15 was also doubted by the High Court of Australia in **Eclipse Sleep Products Inc v The Registrar of Trade Marks** [1957] 99 CLR 300 at p 313 and by Kekewich J in **Re Sphincter Grip Armoured Hose Co`s Trade Mark** [1893] 10 RPC 84 at p 85 where he commented:

> *... I am perfectly aware, of course, that in that case of* ***James`s Trade Mark*** *it was not a mere representation of the thing sold, and the remarks which fell from the Lord Justices must, of course, be construed, as in every case, with reference to the particular facts before them; but still there is considerable difficulty in applying that judgment universally ... .*

56 The applicants` counsel also called my attention to three other cases: **Moneysworth Trade Mark,** [1976] RPC 317 **Network 90 Trade Mark** [1984] RPC 549 and **Yomeishu Seizo Co Ltd & Anor v Sinma Medical Products (S) Pte Ltd.** [1991] FSR 278 [1991] 3 MLJ 251 I will return to these cases later in this judgment.

57 Based on the principles emerging from the foregoing cases, and after inviting the court to treat the ***James`s Trade Mark*** case16 with some circumspection, Mr Dedar Singh submitted that the marks of the respondents were unregistrable as they lacked distinctiveness.

58 Miss Fam for the respondents, on the other hand, submitted that their clients` device, whilst descriptive of the Chinese ingot, was not descriptive of joss paper per se. In amplification, she added that the three-dimensional folding of joss paper by devotees would not in any manner or form offend the trade

Version No 1: 11 Sep 2026 (01:05 hrs)

mark and the right in the mark is limited to the joss paper only. She added that a stylized `Yuan Bao` was in no way descriptive of the character or quality of the joss paper.

59 Counsel for the respondents further submitted that the court was not dealing with the word mark and what was before the court was a device mark which resembled a gold or silver ingot. She said that the scope of the registration did not extend to the use of the Chinese characters `Yuan Bao`. She further contended that the secondary significance attached to `Yuan Bao` was irrelevant and the three-dimensional folded joss paper in the form of an ingot would not be regarded as an infringement of the respondents` trade marks within the meaning of s 45 of the Act which provides, inter alia, that `... right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark ... uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade ...`.

60 As regards the respondents` contention that the secondary significance attached to `Yuan Bao` was irrelevant and the three-dimensional folding of joss paper in the form of ingots would not attract the provisions of s 45 of the Act, it should be borne in mind that the test for registrability was not whether registration would impose an intolerable burden on traders who wished to use the mark, but whether they would merely be hindered or embarrassed in what they might legitimately want to do in the future. When considering registration, one is not concerned to look too closely at what would constitute infringement or a defence thereto; the privilege of a monopoly should not be conferred where it might require honest men to look for a defence. See **Colorcoat Trade Mark.** [1990] RPC 511

Version No 1: 11 Sep 2026 (01:05 hrs)

61 The respondents` counsel called my attention to the case of **Re An Application By The Diamond T Motor Car Co.** [1921] 38 RPC 373 Counsel submitted that the ***Diamond T*** case22 was on all fours with the application at hand. In that case, the mark sought to be registered in respect of motor cars and motor trucks was a combination of three elements: (i) a diamond-shaped border, (ii) the word `diamond` and (iii) a large letter T.

62 The facts of the case had been comprehensively set out in the headnotes of the report as follows:

> *A company organized under the laws of Illinois, USA had for many years carried on business as manufacturers of motor cars and motor lorries. Since 1905 the applicants or their predecessors had used in the USA, as their trade mark, a mark consisting of a combination of a diamond with the word `diamond` and the letter T. There was evidence of large sales of the applicants` vehicles under the said mark in the USA and that the mark was distinctive in the USA of the applicants` goods. The mark was registered as a trade mark in the USA and in many other countries abroad. The applicants` vehicles had been advertised in the United Kingdom under the said mark, and traders and others had inquired for the applicants` vehicles under the name `Diamond T` but there was no evidence of any sales in [the United Kingdom]. The applicants in 1918 applied to register the said mark in Class 22 for motor cars and motor trucks. The Registrar of Trade Marks refused the application on the ground that the mark was not a distinctive mark within the meaning of the Trade Marks Act 1905 s 9, para (5); that the device of a diamond was a common device for trade marks in the motor trade and that registration of the mark might create in the mind of the public the impression that the applicants had obtained a monopoly of a diamond-shaped border; that registration of the mark would prevent all persons who had the initial T from using that initial in a diamond-shaped border; that the mark bore such a resemblance to three marks already on the register as to be calculated to deceive; and in the exercise of his discretion.*

63 The applicants appealed to the court and filed evidence in support of their appeal to show that the trade mark was distinctive.

Version No 1: 11 Sep 2026 (01:05 hrs)

64 PO Lawrence J, on appeal, allowed the registration of the mark subject to a condition that the applicants should disclaim any right both to the exclusive use of a diamond-shaped border and also to the exclusive use of the word `diamond`. The court, in arriving at its decision, held that the combination was distinctive though the individual elements were common to the trade. The learned judged said, at p 382:

> *The circumstances to which I refer are that there are already six marks on the register in Class 22 containing a diamond-shaped border; that a diamond-shaped border must therefore be regarded as common to the trade; that the word `diamond` does not carry the matter any further, as it merely describes the border; and that the addition of the letter T, which is open to the trade, does not make the mark as a whole distinctive to the eye or to the ear. Now, admitting that the diamond-shaped border is common to the trade and that the word `diamond` carries the matter no further, the result is that there is now in existence a class of marks which I will call `diamond marks`. Further, admitting that certain traders with the initial letter T might hereafter use that initial upon or in connection with their goods, the result would be that a class of marks might spring up which I will call `T marks`, and for the purposes of this judgment I will assume that such a class is already in existence. Nevertheless, I am of opinion that the existence of diamond marks and of T marks does not prevent the applicants` mark, which for the first time combines the common feature of each class, from being a mark which is likely to be actually distinctive of the applicants` vehicles, apart altogether from the effects of registration. Both to the eye and to the ear, the applicants` mark is a `Diamond T` mark. There is no other `Diamond T` mark at present in use in the trade, and I do not consider that traders are likely hereafter, in the ordinary course of business and without any improper motive, to desire to use a `Diamond T` mark upon or in connection with motor cars and motor trucks.*

65 Miss Fam next relied on the case of **Re J & P Coats Ltd`s Application** [1936] 2 All ER 975 (`the Sheen case`). In that case, the applicants, J & P Coats, applied to register the word `sheen` in Class 23 in respect of machine twist being sewing cotton. The application was refused on the grounds that `sheen` was not an invented word but descriptive of the character, glossiness and was one of a

Version No 1: 11 Sep 2026 (01:05 hrs)

class of words which never could become distinctive of the goods of the applicants but should be left free for the whole trade to use.

66 On appeal to the judge, it was found that the word `sheen` had in fact become distinctive of the goods of the applicants and the Registrar was directed to proceed with the application. The Registrar appealed. The Court of Appeal (Lord Wright MR, Slesser and Romer LJJ), in dismissing the appeal, held that there was sufficient evidence of the distinctiveness of the word `sheen` to justify the judge`s finding that it was distinctive and therefore registrable.

67 It appears from the reasoning of the Court of Appeal that the question before it was a practical one of fact and not of law. In the result, the Court of Appeal held that `sheen` was not the ordinary or natural word used in the trade nor a word incapable of losing its natural meaning and that its use would not embarrass a trader as to its legitimate meaning.

68 The ***Diamond T*** case22 relied on by counsel was distinguished in **Moneysworth Trade Mark.** [1976] RPC 317 In the ***Moneysworth*** case,18 the applicant sought to register as an unused trade mark, a device consisting of the word `Moneysworth` in outline capital letters superimposed upon a dollar symbol extending above and below the word. Registration was sought in respect of printed matter, periodical publications and books. The hearing officer held that the mark failed to qualify for registration either under ss 9 or 10 of the Act. The applicant appealed to the Board of Trade.

69 Falconer QC, in his decision, observed at p 165:

> *In the present case the hearing officer has held that the mark sought to be registered `has so direct a reference to goods which are concerned with obtaining money`s worth that it possesses no element of inherent capacity to distinguish the goods of any one*

> *trader in them`. He considered that the mark consists predominantly of the word `Moneysworth` which must be regarded as a combination of the two words `Money`s Worth` or as a variation of the hyphenated word `Money`s-Worth`. He further considered that the word `Moneysworth`, as the equivalent of `Money`s Worth`, has a direct reference to the character or quality of goods concerned in the application in that, having regard to the dictionary definitions of `Money`s Worth` and `Money`s-Worth` which are cited in the decision, it `is as apt for describing publications relating to, for example, consumer testing and advisory services designed to enable readers to purchase their money`s worth, as any two words of the language could possibly be`.*

70 Falconer QC, in dismissing the appeal, held that the word `Moneysworth` by itself was unregistrable since it had a direct reference to the character and quality of the goods (a periodical on consumer affairs telling its readers how to get their money`s worth), and that the addition of the dollar device was not sufficient to alter the predominant impression produced by the mark and the mark could not be allowed to proceed for registration in Part B even if the word per se was disclaimed.

71 There is yet another case which appears to possess analogous features to the dispute at hand. In the ***Network 90*** case,19 an application was made for registration of the mark `Network 90` in Part A of the register in respect of certain goods in Class 9, including computer modules and interfaces. It was conceded that each element of the mark was non-distinctive but the applicant was willing to disclaim each of them, seeking to protect only the combination of the two. The application was refused by the hearing officer on the ground that since the mark was neither distinctive nor capable of distinguishing, it was unregistrable in either part of the register. In arriving at this conclusion, the hearing officer relied upon his own knowledge of the use of the word `network` in relation to telephones, computers and computer apparatus. It was further held that the mark was objectionable under s 11 of the Act (equivalent to our s 15(1)).

Version No 1: 11 Sep 2026 (01:05 hrs)

72 In dismissing the appeal, Falconer J held that the only additional idea which could be ascribed to the word `network` when used in conjunction with the goods in respect of which registration was sought was that it was a network suitable for the 1990s. This, in the court`s view, created no new idea or image enabling the mark to be accepted as a distinctive mark in Part A or as a mark capable of being distinctive and so registrable in Part B.

73 The concept of `descriptive words and distinctiveness` received careful attention by Chan Sek Keong J in the ***Yomeishu*** case.20 Chan Sek Keong J observed, at p 254:

> *Under s 10 of the Act, a word or words which have a direct reference to the character or quality of the goods (ie descriptive words) is/are not registrable under Part A except upon evidence of distinctiveness. `There is no absolute incompatibility between what is descriptive and what is distinctive` (per Fletcher Moulton LJ in* ***Re Joseph Crosfield & Sons Lt d*** *at p 145, approved by the Privy Council in* ***De Cordova v Vick Chemical Co*** *[(1951) 68 RPC 103] at p 106. It is thus settled law that distinctiveness in relation to the use of descriptive words may be satisfied by adducing evidence that the words have acquired a secondary meaning in connection with the goods of the claimant. But, as the law does not permit any person to claim a proprietary right to the use of common words in a language, it is extremely difficult to establish that common words have acquired a secondary meaning in relation to the goods of the claimant. There are degrees of difficulty in proving a secondary meaning.*

74 Chan Sek Keong J`s observations relate specifically to descriptive words. But the principles enunciated by Chan Sek Keong J apply with equal force to pictures, for a description may be in words or by picture. (See the observations of Bowen LJ in **Re Anderson`s Trade Mark.** [1885] 54 LJ Ch 1084)

75 It is common ground that a device may lack distinctiveness if it is common to the trade or descriptive of the goods and services in question.

Version No 1: 11 Sep 2026 (01:05 hrs)

Shanahan, in his ***Australian Law Of Trade Marks And Passing-Off*** (2nd Ed) at p 111, lists a number of devices as unregistrable:

> *... grapes and vine leaves for wine, flowers for perfumery, pine trees for deodorizers, cats and dogs for pet food, lightning flashes for electrical apparatus, stars for alcoholic drinks, orchard scenes for fruit, clothed models for clothing, women`s heads for beauty products, and chevrons for certain food products (labels in this shape being commonly applied to bottle necks).*

76 Further, according to the author, a device may also lack distinctiveness where it describes some specific attribute of the product, such as its suitability for a particular purpose or its manner of operation. A case in point is where the registrar refused to register a device in the form of a riding boot with the words `Boot Brand` in respect of leather on the ground that such goods could be ordered as `boot leather`. (See **William Gibson & Sons Pty Ltd`s Application** [1962] 32 AOJP 783 referred to by Shanahan at p 113.)

77 As observed by me earlier, the onus in this case is on the applicants to negative the validity of the registration of the marks under dispute. The respondents` contention is that there is insufficient evidence to support all the applicants` contentions, particularly the mark bearing the `Yuan Bao` as being descriptive of the character or quality of joss paper. Further, according to counsel, the applicants have not discharged the onus placed on them. Counsel further contended that the respondents` mark is inherently adapted to distinguish and is in fact distinctive.

78 On the submission that the applicants have not discharged their onus, it should be observed that Ng Kim Bok, the principal affirmant for the respondents, in para 6 of his affidavit filed on 23 July 1991, conceded that there was no denying that there was a practice by the Chinese community to fold joss paper into different shapes before burning. Ng Kim Bok further said in the same

Version No 1: 11 Sep 2026 (01:05 hrs)

affidavit that in Singapore, the characters `Yuan Bao` commonly referred to joss paper and sometimes, it may mean a particular type of joss paper. If what had been stated by the respondents does truly reflect the position in Singapore, it follows that the mark or marks now being used by the respondents are a feature common to joss paper and, in my view, are not inherently adapted to distinguish their product.

79 The claim by the respondents that theirs is a very stylized Chinese coin or ingot and the design did not accurately depict a classic `Yuan Bao` as there had been some artistic input to modify and distinguish the design, is a weak proposition. I should add at this juncture that the `Yuan Baos` I have seen, as featured in magazines, newspapers and also from the exhibits provided to the court, are almost similar to the design produced by the respondents. To my mind, the two marks are not sufficiently unusual or fanciful in appearance and are not inherently adapted to distinguish and the marks are simply too descriptive to be given full monopoly rights of a Part A register. The design of the mark is no more than a sketch of the typical `Yuan Bao` and is most certainly common to the trade.

80 In the light of all the evidence, the claim by Ng that the mark was an original creation and that he `personally came up with the mark` is devoid of merit. To come within s 10(1)(e) of the Act, a device must possess inherent distinctiveness or at least some inherent distinctiveness together with evidence of factual distinctiveness. Ricketson in ***The Law Of Intellectual Property*** (1984) at p 651 states that:

> *... there are a number of factors which may operate to deprive a device mark of any inherent distinctiveness. Thus, a device mark will be unregistrable if it is one commonly used in the particular trade; for instance, the use of a red and white pole has long been associated with barbers and the device of a mortar and pestle*

Version No 1: 11 Sep 2026 (01:05 hrs)

> *with pharmacists and druggists. Specific examples in the cases have included the use of a cat in relation to gin, a diamond in relation to motor cars, a star in relation to tobacco and the use of parallel red lines in hosing. In such cases, to be registrable, the device must possess some special feature or embellishment which provides the necessary distinctiveness and a disclaimer of the basic device may be required.*

81 There is undisputed evidence that one of the ways of folding joss paper is in the form of `Yuan Bao` when offering to deities. The fact that there are other ways of folding the paper does not, in my view, pale the significance of the form of Yuan Bao being one of the symbols of offering to the deities during religious rituals. In my view, there was no new idea or no new image created by the respondents. It all goes back to the famous ingot, the `Yuan Bao`.

82 Now, have the respondents` marks attained a secondary meaning or secondary significance? To my mind, the respondents` devices are nothing but a reproduction of a classic `Yuan Bao` without any great artistic input. The geometric motif surrounding the marks and the words `Cai Bao` in the second mark are mere peripheral appendages and do not, in any way, make the mark adapted to distinguish either in fact or in law. It is clear to me that the respondents did intend to make use of and monopolize a popular Chinese customary representation as part of their marks. Those who have come across the classic Chinese porcelain deities carrying the traditional `Yuan Bao` would immediately recognize that the marks in question are nothing but a reproduction of that traditional ingot. In my view, the respondents` explanation or purported explanation that their devices were original and had gained popularity since their introduction and impliedly attained some secondary significance has little merit.

83 **Order**

Version No 1: 11 Sep 2026 (01:05 hrs)

84 The application before me is to expunge the two trade marks registered as Nos 4264/89 and 5730/87. The difference between the first and the second mark is that the second mark has an additional feature of the Chinese words `Cai Bao` meaning wealth and treasure. The words themselves do not add anything to the main feature of the trade mark. In the premises, my order is that the register of trade marks be rectified by expunging therefrom the trade marks registered as Nos 4264/89 and 5730/87. I further direct that the notice of the rectification, as required by s 39(1)(d) of the Act be served on the Registrar of Trade Marks in the prescribed manner and that the registrar shall, upon receipt of the notice, rectify the register accordingly. As regards costs, since the applicants abandoned midway through the proceedings a substantial contention based on prior use, I award the applicants only two-thirds of the costs of this action.

85 **Outcome:**

86 Application allowed.

MPH Rubin JC

Dedar Singh Gill (Drew & Napier) for the applicants
Anita Fam and Jeanette Ling (Khattar Wong & Partners) for the respondents

Version No 1: 11 Sep 2026 (01:05 hrs)