

SHOULD A DESCRIPTIVE WORD BE ALLOWED TO BE REGISTERED AS A TRADEMARK IN MALAYSIA?

FOR

Introduction

Descriptive words are common words found in any ordinary dictionary[1]. In the context of trademark, they refer to a term, phrase or expression that directly describes the goods or services the trademark represents. In other words, such descriptive words may convey information about the good or service itself, including its features, qualities or intended use. Descriptive word may be depicted on its own as a word trademark or depicted in combination with other components as a composite trademark.

For example, the words '**SURE LOC**' describes the character of the goods viz 'a lock that will surely lock, hence safeguarding the things that have been locked'[2]. The words '**PC FAIR**' describes 'PC' related fairs[3]. The words '**MALAYSIAN INTERNATIONAL FURNITURE FAIR**' describes the organisation and the conduct of furniture exhibition[4].

General Rule

As a general rule, descriptive word should not be allowed to be registered as a trademark in Malaysia. Prohibition of registering a descriptive word as a trademark in Malaysia is provided under the Trademarks Act 2019 ("**TMA 2019**") on the ground of lack of distinctiveness. The Intellectual Property Corporation of Malaysia ("**MyIPO**") often raises provisional refusals against such descriptive words during the trademark registration process based on the following grounds:

(a) Lack of Distinctive Character - MyIPO may refuse the registration of a descriptive word as a trademark under **Section 23(1)(b) of the TMA 2019** if the applied trademark is deemed devoid of any distinctive character. Essentially, this means that the word is too common or directly describes the goods or services it represents, making it unable to differentiate the applicant's products or services from others in the market.

(b) Exclusively Consists of Signs or Indications: MyIPO may refuse the registration of a descriptive word as a trademark under Section 23(1)(c) of the TMA 2019 if the applied trademark consists exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services. In simpler terms, if the word directly conveys information about the nature or attributes of the products or services, it may not be registrable.

A descriptive word should not be allowed to be registered as a trademark, primarily because it is the property of all mankind[5]. No one ought to be granted the exclusive use of a descriptive word of the quality or character of any goods or services. Such words of description are the property of all mankind and it would not be right to allow any individual to monopolise them and exclude others from their use[6].

Furthermore, on grounds of public policy, a trademark cannot be granted where it concerned descriptive word which other traders may legitimately desire to use[7].

For example in the case of ***MIFF Sdn Bhd v Kuala Lumpur & Selangor Furniture Entrepreneur Association & Ors [2010] MLJU 1216***, the Court is of the view that the plaintiff cannot be allowed to deprive others from using descriptive terms such as '**MALAYSIA**', '**FURNITURE**', '**FAIR**'. It is the natural tendency of furniture based or furniture related business entities in our country to use descriptive factual wordings such as 'MALAYSIA' and 'FURNITURE'. Therefore, there is nothing wrong for others to use 'MALAYSIA', 'FURNITURE', 'FAIR' or its abbreviation MFF to denote their services or business activities[8].

In addition to the above, a descriptive word, typically does not indicate the source of the goods or services, but instead the nature of the goods or services. This can be seen in the case of ***McCain International Ltd v Country Fair Foods Ltd [1981] RPC 69***, whereby the Court of Appeal held that the term '**OVEN CHIPS**' could not be seen to identify a manufacturer but only to describe the product[9].

Furthermore, when a name, truly descriptive of an article, has always been associated with the particular name of the manufacturer, then a monopoly of the name of the article, apart from the name of the manufacturer, is almost impossible to acquire.

This is illustrated in the case of ***Horlick's Malted Milk Co v Summerskill (1916) 34 RPC 63***. In this case, the plaintiff had always sold its food preparation as 'HORLICK'S MALTED MILK' for over 25 years. It was held that as the plaintiff had been in the habit of selling under the name 'Horlick's Malted Milk', they could not now eliminate the word 'Horlick' to enforce the word '**MALTED MILK**'[10].

Exception to the General Rule

Based on the above, it can be observed that registering a descriptive word as a trademark

in Malaysia can indeed be challenging, primarily because descriptive words are considered weak trademarks due to their inherent lack of distinctiveness. However, the registration of a descriptive word as a trademark in Malaysia is not entirely impossible.

Section 23(2) of the TMA 2019 provides an opportunity for applicants to seek for the registration (as trademarks) of descriptive words that have acquired distinctiveness through use in Malaysia. This section states that even if a trademark lacks inherent distinctiveness and does not pass the registrability threshold under **Sections 23(1)(b) and 23(1)(c) of the TMA 2019**, the Registrar may still allow its registration, if the applied mark has acquired distinctiveness as a result of its use in Malaysia before the date of application for registration of such trademark is made with the MyIPO.

To clarify further, 'acquired distinctiveness' refers to the situation where a descriptive word has become associated with a particular source of goods or services in the minds of consumers, amongst others, due to extensive and continuous use of such descriptive word by the trademark owner in Malaysia.

This association creates a unique identity for the word, transforming it from a descriptive term into a distinctive identifier of a specific brand.

It is important to note that whether a particular descriptive word has acquired distinctiveness would depend upon its own peculiar facts.

For instance, even a purely descriptive term consisting of perfectly ordinary English words may, by a course of dealing over many years, become so associated with a particular trader that it acquires a secondary meaning such that it may properly be said to be descriptive of that trader's goods and of his goods alone[11].

Cases have shown that it is possible for a descriptive word to become distinctive. In *Legal and General Assurance Society Limited v Daniel [1968] RPC 253*, Lord Denning MR held, inter alia, that although the words 'Legal and General' are descriptive words, nevertheless they have acquired such a connotation, such a significance in business and elsewhere, that they have become especially associated with the plaintiff being less common, less descriptive, more specialised and rarely used in combination except by the plaintiff[12].

In the case of *Amanresorts Ltd and Another v Novelty Pte Ltd [2008] 2 SLR 32 at p 49*, the court held that the brand name 'Aman', although a descriptive word (meaning 'peace' or 'peaceful') standing by itself, is also a fancy trademark when used in relation to hotels and resorts as it is not merely describing the plaintiffs' goods and services. Aman hotel and Aman resort can be and are distinctive as the Hotel de la Paix ('paix' being the French word 'peace') and the Peach Hotel in Shanghai, China[13].

Essentially, in a trademark registration process, the burden of proof lies on the applicant of the trademark. The applicant must provide sufficient evidence via a statutory declaration to

demonstrate that the descriptive word has indeed acquired factual distinctiveness through use before the date of the application for registration is made with the MyIPO.

This evidence may include details of the marketing efforts, sales figures, consumer surveys and any other relevant documentation that showcases the trademark's recognition and association with the applicant's goods or services. The Registrar of Trademark will assess the evidence presented and determine whether the trademark has indeed acquired the required distinctiveness to merit registration.

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1. Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd [2009] 5 MLJ 703.
 2. found in the case of Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338.
 3. found in the case of Shaifubahrim bin Mohd v EM Exhibitions (M) Sdn Bhd & Anor [2012] 9 MLJ 84.
 4. found in the case of MIFF Sdn Bhd v Kuala Lumpur & Selangor Furniture Entrepreneur Association & Ors [2010] MLJU 1216.
 5. Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338.
 6. Eastman Photographs Materials Co Ltd's Application [1895-9] All ER 1633, as referred to in the case of Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338.
 7. Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338.
 8. In any event, the plaintiff has not established that it had already acquired secondary distinctiveness over the usage of those terms.
 9. As referred to in the case of Shaifubahrim bin Mohd v EM Exhibitions (M) Sdn Bhd & Anor [2012] 9 MLJ 84.
 10. Ibid.
 11. Reckitt & Colman Products Ltd v Borden Inc [1990] 1 All ER 873, as referred to in the case of Ken Holdings Bhd & Ors v Sri Seltra Sdn Bhd & Ors [2014] 9 MLJ 858.
 12. As referred to in the case of Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kotra Pharma (M) Sdn Bhd [2009] 5 MLJ 703.
 13. As referred to in the case of Ken Holdings Bhd & Ors v Sri Seltra Sdn Bhd & Ors [2014] 9 MLJ 858.

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