

The standards in the Common Guidelines serve as a reference to guide and focus the practices of the ASEAN IP Offices, with a view to achieving common criteria and standards in the short term. At the time these Common Guidelines were adopted by the ASEAN IP authorities, a few of its principles and standards were not applicable in some of the ASEAN IP Offices, or differed from the practices followed in those Offices.

Some of the principles and standards contained in the Common Guidelines might not be applicable in a country if that country's trademark law pre-empted them from operating, for instance, if a particular trademark law disallowed the registration of certain types of signs as marks. Where such incompatibility arose, the Office concerned would not apply the relevant principle or standard until such time as it became compatible with the relevant law.

These Common Guidelines do not determine the outcome of the substantive examination of trademark applications. The IP Offices retain any powers and responsibilities that are conferred upon them under the applicable national law. It is understood that these Common Guidelines contain principles and standards that can be applied regardless of the manner in which the individual Offices carry out their examination process. The Common Guidelines are not intended to be used as legal basis by any party in challenging the operative part of any decision of national IP Offices or judicial bodies or authorities.

ASEAN

**COMMON GUIDELINES FOR THE SUBSTANTIVE
EXAMINATION OF TRADEMARKS**

PART 1

**ABSOLUTE GROUNDS FOR THE REFUSAL
OF REGISTRATION OF TRADEMARKS**

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INTRODUCTION

Background

These Common Guidelines for the Substantive Examination of Trademarks in the ASEAN Countries (hereinafter called “the Common Guidelines”) have been prepared in the context of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III). That project was approved by the European Union and ASEAN in 2009 to support the objectives of the ASEAN Economic Community Blueprint. The project is aimed at supporting the strategic goals identified in the ASEAN IPR Action Plan 2011-2015.

Phase II of the ECAP III project seeks to further integrate ASEAN countries into the global economy and world trading system to promote economic growth and reduce poverty in the region. The project’s specific objective is to enhance ASEAN regional integration and further upgrade and harmonize the systems for the creation, protection, administration and enforcement of intellectual property rights in the ASEAN region, in line with international intellectual property standards and best practices, and with the ASEAN Intellectual Property Rights Action Plan 2011-2015.

The EU Office for Harmonization in the Internal Market (OHIM) was entrusted with the implementation of Phase II of ECAP III over the period 2013-2015.

The Common Guidelines have been drafted taking into account the laws, regulations and judicial and administrative decisions of the ASEAN countries, relevant to the substantive examination of trademark applications, as well as the practices followed by the ASEAN IP offices. The internal guidelines and manuals currently used by some of the offices to examine trademark applications have also been considered. The Common Guidelines take into account international standards and best practices, in particular the European Community Guidelines for Examination in the Office for Harmonization in the Internal Market on Community Trade Marks – 2014 (hereinafter called “the OHIM Guidelines”).

The ASEAN Common Guidelines are intended to supplement the abovementioned internal guidelines and manuals and to support the approximation and convergence of the trademark examination standards and criteria applied by the ASEAN IP offices. The Common Guidelines may also serve as a practical training tool for trademark examiners and as a reference document for professional advisors and industrial property agents.

Activities leading up to the Common Guidelines

The ten ASEAN countries have undertaken a number of regional commitments in the context of building a more closely integrated market in the medium and long term. That underlying regional project comprises specific projects and activities in punctual areas, including intellectual property.

The project to implement Common Guidelines for the examination of trademarks in the ASEAN region is partly challenged by the fact that differences subsist among the individual countries particularly as regards the size of their economies and populations, their cultures and languages, and their economic development (Cambodia, Laos and Myanmar are least-developed countries). The countries' history has strongly determined their legal traditions and, consequently, the structure and content of their intellectual property legislation including their trademark systems.

All the ASEAN countries have enacted or are in the process of adopting trademark legislation (either in the form of dedicated laws or as specific chapters or provisions within a broader law) as well as a variety of implementing norms of lower hierarchy, including implementing regulations and other subsidiary administrative decisions.

The following countries have also published or otherwise adopted for internal use by their trademark examiners, manuals, guidelines or regulations for the examination of trademark applications:

Cambodia: Trademarks Manual, July 2013

Indonesia: Technical Guidelines for Trademark Examination (Rev. 2012)

Laos: Trademarks Manual, September 2003

Malaysia: Manual of Trade Marks Law & Practice, 2003 (2nd Edition)

Philippines: Guidelines for Trademark Examination, August 2012

Singapore: Trade Marks Work Manual, 2012

Vietnam: Circular No. 01/2007/TT-BKHCHN of February 14, 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006; and Regulations on Examination of Applications for Registration of Trademarks, 2010 – attached to Decision N^o 709/QD-SHTT of 29 April 2010 of the Director General of NOIP.

While much of the matter covered in those national texts is consistent in substance with these Common Guidelines, some divergence remains on certain points. The development of these Common Guidelines for the region can stimulate the harmonization of the trademark examination standards and criteria applied by the trademark examiners in the region.

The process to prepare these Common Guidelines included the following main stages:

(i) Fact-finding missions undertaken by a project consultant during the months of May and June 2014 to each of the IP offices of the ASEAN countries. The missions compiled information on the relevant provisions in the laws, regulations and administrative guidelines, manuals and directives applied by the ASEAN trademark offices, as well as relevant decisions from administrative and judicial authorities on trademark-related cases, that have a bearing on the substantive examination of trademark applications by those offices. The missions included consultations with the competent officials on the possible content of the Common Guidelines, and the manner in which the different absolute and relative grounds for the refusal of trademark registration were being interpreted and applied by the offices.

(ii) Preparation by the project consultant of a first draft of the Common Guidelines based on the trademark laws, regulations and practices of the ASEAN IP Offices as compiled by the fact-finding missions, as well as on best practices from IP trademark offices. This draft was submitted to a meeting of the ASEAN Expert Group on Trademark Examination held in Bangkok from 21 to 25 July 2014. At that meeting the draft Common Guidelines were discussed in detail.

(iii) Revision of the draft Common Guidelines by the project consultant taking into account the comments, suggestions and inputs received from the ESEAN IP offices during and after the above-mentioned Expert Group meeting.

(iv) Completion of the final draft Common Guidelines and submission on 30 September 2014.

Abbreviations used in the Common Guidelines

ASEAN countries (Country Codes)

BN: Brunei Darussalam

ID: Indonesia

KH: Cambodia

LA: Laos

MM: Myanmar

MY: Malaysia

PH: Philippines

SG: Singapore

TH: Thailand

VN: Vietnam

Other abbreviations

CTMR: Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark (European Community trademark regulation)

ECJ: Court of Justice of the European Union (European Court of Justice)

EU: European Union

GI: geographical indication

IPL: Intellectual Property Law

NCL: The International Classification of Goods and Services for the Purposes of the Registration of Marks, established under the Nice Agreement of 1957

Nice Classification: The International Classification of Goods and Services for the Purposes of the Registration of Marks, established under the Nice Agreement of 1957

OHIM: Office for the Harmonization of the Internal Market (European Community Office for industrial designs and marks)

PARIS CONVENTION: Paris Convention for the Protection of Industrial Property, concluded in 1883, last revised in Stockholm, 1967

SGT: Singapore Treaty on the Law of Trademark and the Regulations under that Treaty, concluded in 2006

TMA: Trade Mark(s) Act

TML: Trade Mark(s) Law

TMR: Trade Mark(s) Regulation(s) or Trade Mark Rules

TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights

WHO: World Health Organization

WIPO: World Intellectual Property Organization

WTO: World Trade Organization

References

All websites references are current as on 30 September 2014.

ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

1 Signs admissible as ‘trademarks’¹

Registration of a sign as a trademark should be refused if the nature of the sign that is the subject of the application does not comply with the definition of ‘mark’ or ‘trademark’ provided in the law, or if the sign does not comply with the conditions specified to be regarded as registrable.

When a sign does not comply with the established definition of ‘mark’ or ‘trademark’, or it is clear that the subject matter of the application is not a sign capable of being a trademark, its registration as a mark should be refused. In this case, it will not be necessary to examine the sign as to other absolute or relative grounds for refusal.

In order to function as a mark, a sign must be *perceptible*. In theory, a sign perceptible by any of the five basic human senses (sight, hearing, smell, touch and taste) could potentially function as a mark to distinguish goods or services in trade. However, trademark law and practice will expressly or effectively limit the registrability of signs as marks by requiring that the sign comply with one of two conditions, namely:

- a) that the sign be *visually perceptible*,² or
- b) if non visually-perceptible signs are admissible for registration, that the sign be capable of being *represented graphically*.³

¹ In these Guidelines the term ‘mark’ and ‘trademark’ are used interchangeably, and both terms include ‘service marks’, except where otherwise indicated.

² See the provisions on trademarks in BN TMA s. 4(1); KH TML art. 2(a), TM Manual p.2; ID TML Art. 1.1; LA IPL art. 16.1, Decision 753 art.32 and 34 paragraph 4, TM Manual p. 4; MY TMA, s. 3 and 10, TM Manual chapter 4; MM; PH IP Code, s. 121.1, TM Guidelines p. 18; TH TMA s. 4 - ‘mark’; VN IPL art. 72.1.

³ See the definitions of ‘sign’ and ‘trade mark’ in SG TMA s. 2(1) and 7(1)(a), TM Manual chapter 1 ‘What is a Trade Mark?’

1.1 Visually perceptible signs

The TRIPS Agreement allows WTO Members to require as a condition for registration that signs be ‘visually perceptible’, i.e. perceptible by the sense of sight.⁴

Where a law provides for this condition any application for the registration of a mark consisting of a non visually-perceptible sign would have to be refused outright. In particular, a sign perceptible by the sense of hearing or the sense of smell could not be registered as such signs are not visually perceptible. This rules out the registration of ‘sound’ and ‘olfactory’ marks. It also rules out the registration of signs perceptible by the senses of touch or taste.

If the law requires signs to be visually perceptible, the fact that a non-visual sign may be represented visually is irrelevant. Such visual representation would not change the inherent nature of that sign, which cannot be perceived by the sense of sight when used as a mark in the course of trade.

It is recalled that for the purposes of registration of a visually-perceptible sign as a mark, the application must nevertheless include a reproduction or representation of the mark in the prescribed manner. However, compliance with this requirement is a standard formality and does not change the issue of substance regarding the nature of the sign.

Visually perceptible signs will generally fall under one of the following categories:

- Two-dimensional signs
- Colours
- Three-dimensional signs

1.1.1 Two-dimensional signs

The vast majority of the signs submitted for registration as marks will be signs that are visually perceptible. Such marks will be perceived by the sense of sight when used in trade to distinguish goods or services.

Visually-perceptible signs admissible for registration as marks may belong to any of the categories discussed below.

⁴ TRIPS, Article 15.1, *in fine*.

1.1.1.1 *Words, letters, digits, numerals, ideograms, slogans*⁵

This type of sign contains only elements that can be read, including signs consisting of one or more words (with or without meaning), letters, digits, numerals or recognizable ideograms, or a combination thereof, including slogans and advertisement phrases.

Some of these categories of signs may be named differently in the national laws of the ASEAN countries, and some may not be expressly mentioned in the law. For instance, under some laws slogans and advertisement phrases will be treated as 'combinations of words' and may be registered as trademarks accordingly.

This type of sign may be presented in 'standard' characters or in special, fanciful, non-standard characters that may pertain to any alphabet, and may have one or more colours. They will not contain any figurative element, frame or background.

The following examples illustrate this type of sign:

KLAROSEPT

MONT BLANC

AIR INDIA

ΜΑΡΚΟΥΣΟΝ

αλφάβητο

GM

⁵ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 2; ID TML Art. 1.1; LA IPL art.16.1, TM Manual p. 4; MY TMA, s. 3 and 10(1), TM Manual paragraph 4.11; MM; PH IP Code, s. 121.1, TM Guidelines p. 18; SG TMA s. 2(1) – 'sign' and 'trade mark', TM Manual chap. 1 'What is a Trade Mark?'; TH TMA s. 4 – 'mark'; and VN IPL art. 72.1. Also the OHIM Guidelines, Part B, Section 2, item 9.1.

1886

N° 5

H2NO

Giorgio@Play

Your flexible friend

A stylized, handwritten signature logo consisting of a large, bold letter 'J' with a smaller 'S' attached to its bottom right.The word 'BONGO' in a bold, blocky, 3D-style font. The letters are white with black outlines and are arranged in a slightly staggered, stacked manner.The logo for 'MUSCLE STARS'. The word 'MUSCLE' is in a large, bold, red font with a white outline. Below it, the word 'STARS' is in a smaller, bold, white font with a black outline.

Word marks also include signs that consist of a personal *signature*, whether real or fanciful. Such signs will normally be inherently distinctive. For example:

A handwritten signature in black ink that reads 'Paul Smith' in a cursive, flowing script.

[Image taken from <http://www.paulsmith.co.uk/uk-en/shop/>]




[Examples provided by the Malaysia IP authorities]

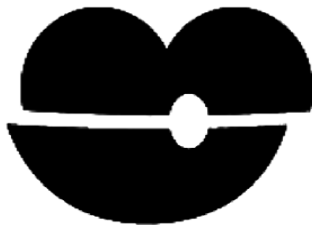
1.1.1.2 *Figurative signs*⁶

This type of sign will consist of one or more two-dimensional figurative elements. They may represent existing creatures (animals, flowers, etc.), real or fictitious persons or characters (portraits, cartoon characters, etc.), and real or imaginary objects or creatures (sun, stars, mountains, flying saucers, dragons, etc.). They may also consist of fanciful, abstract or geometrical shapes, devices, figures, logos or other purposely-created two-dimensional shapes.

Ideograms and characters that are not understood or have no meaning for the average consumer in the country where registration is sought may be regarded as figurative signs or figurative elements of signs.

Figurative signs may have one or more colours but will not contain any words, letters, digits, numerals or ideograms.

Examples:



⁶ See the provisions in BN TMA, s. 4(1); KH TML art.2(a), TM Manual p. 2 and 29; ID TML Art. 1.1; LA IPL art. 16.1, TM Manual, p. 4; MY TMA, s. 3 and 10(1); MM; PH IP Code, s. 121.1, TM Guidelines p. 18; SG TMA s.2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter 1 ‘What is a Trade Mark?’; TH TMA s. 4 and 7(6); and VN IPL art. 72.1. Also the OHIM Guidelines, Part B, Section 2, item 9.2.



[Examples taken from trademark applications under the Madrid Protocol. See http://www.wipo.int/edocs/madgdocs/en/2010/madrid_g_2010_52.pdf]

1.1.1.3 *Mixed signs*⁷

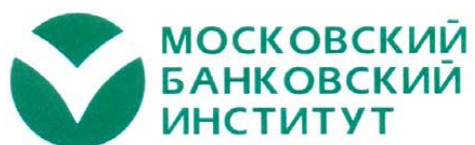
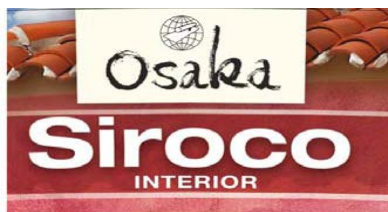
This type of sign will consist of a combination of one or more words, letters, digits, numerals or ideograms with one or more figurative sign or non-word element. The figurative element may be embodied within the word element (for example the figure of a sun in place of the letter “o”), be adjacent to or superposed on the word element, or be a background or a frame.

The non-figurative elements (words, numerals, etc.) may be presented in ‘standard’ characters or in special, fanciful characters, and the sign may have one or more colours.



⁷ See the provisions in BN TMA, s. 4(1); KH TML art.2(a), TM Manual p. 2 and 29; ID TML Art. 1.1; LA IPL art. 16.1, TM Manual, p. 4; MY TMA, s. 3 and 10(1); MM; PH IP Code, s. 121.1, TM Guidelines p. 18; SG TMA s. 2(1) ‘sign’ and ‘trade mark’, TM Manual chap. 1 ‘What is a Trade Mark?’; TH TMA s. 4 and 7(6); and VN IPL art. 72.1.

BORA



SWISS
INSO

Родные
Продукты!

VietTiger



[Examples taken from trademark applications under the Madrid Protocol.
See http://www.wipo.int/edocs/madgdocs/en/2010/madrid_g_2010_52.pdf]

1.1.2 Colours ¹

A single colour as such ('colour *per se*') or a combination of two or more colours in the abstract, claimed independently of any specific shape, contour or other defining element or feature -- i.e. claimed in any conceivable form -- would not comply with the conditions of clarity, precision and uniformity required for an unequivocal definition of the scope of the object of registration.

Accordingly, a sign consisting of a single colour in the abstract or consisting of two or more colours claimed in any conceivable combination or form, cannot be regarded as a mark.

To be regarded as a mark a colour would need to be defined by a particular shape or have clear, defined contours. A combination of two or more colours would need to be defined by a particular shape or contours, or be combined in a single, predetermined and uniform presentation.

For example, the following combination of colours silver, copper and black applied in particular positions and proportions on specific products (electrochemical cells and batteries) can be a valid mark for those goods:



[Example taken from the Guidelines for Trademark Examination of the Philippines, p. 124]

1.1.3 Three-dimensional signs ²

¹ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 18 and 21; ID TML Art. 1.1; LA Decision 753 art. 17.4 and 32, TM Manual p. 4; MY TMA, s.13; MM; PH IP Code, s. 123.1(L) , TM Guidelines chapter V item 5.3 p. 28, and chapter XIII p. 136; SG TMA s. 2(1) 'sign' and 'trade mark', TM Manual, chapter 2 'Colour Marks'; TH TMA s. 4 – 'mark'; and VN IPL art. 72.1, Circular 001/2007, s. 39.2.b(i). Also the OHIM Guidelines, Part B, Section 2, item 9.5.

A three-dimensional shape is a 'visually perceptible' sign and is capable of being 'represented graphically'. To that extent a three-dimensional shape should, in principle, be admitted for registration as a mark.

For the purposes of registration the following types of three-dimensional signs may be distinguished:

- the shape of a device *adjoined* to the goods or used in connection with the services that the mark will distinguish
- the shape that is *embodied* in the goods or in a part thereof, or in accessories used in connection with the services that the mark will distinguish,
- the shape of the container, wrapping, packaging, etc. of the goods or an accessory related to the service that the mark will distinguish.

1.1.3.1 Shapes of devices adjoined to the product

A three-dimensional device that is not embodied in a product (i.e. it is not the shape of the product itself or of a part of a product) or is not in immediate contact with a product (it is not a container, wrapping, packaging, etc.), but is used as an external device associated with particular goods or services, may be accepted as a trademark if it does not fail on other grounds for refusal.

For instance, a miniature reproduction of an hourglass or a bell appended to the neck of beer bottles, or attached to beer dispensers or placed in front of shops that offer such products, could function as a valid trademark for beer products and for services related to those products.

In the following example a miniature white horse appended to the bottle containing the product is used as a brand device to indicate commercial provenance:

² See the provisions in BN TMA, s. 4(1); KH TM Manual p. 18 and 19; LA Decision 753 art. 17.5, TM Manual, p. 19; MM; PH IP Code, s. 123.1(k), TM Guidelines p. 18, chap. XII; SG TMA s. 2(1) – 'sign' and 'trade mark', TM Manual chap. 3 'Shape Marks'; TH TMA s.4 – 'mark'; and VN IPL art. 72.1 and 74.1. Also the OHIM Guidelines, Part B, Section 2, item 9.3.



[Image taken from <http://www.scottishwhiskystore.com/shop/blended-whisky/white-horse/#tab-description>]

1.1.3.2 Shapes embodied in the product or in a part thereof

The shape of a product is a 'visually perceptible' sign and is capable of being 'represented graphically'. To that extent the shape of a product should, in principle, be admitted for registration as a mark. However, it would still be necessary for such sign to comply with the usual requirements for registration of a mark, in particular the requirement of distinctiveness (see chapter 2, below).

The shape that is to be registered as a trademark may be embodied in the product as a whole or in a specific part of a product. For example, the shape of a chocolate bar could be a trademark for chocolates if it is recognized as an indication of commercial origin, it is sufficiently distinctive and it is not functional.



[Image taken from <http://www.chocablog.com/reviews/toblerone/>]

Likewise, for example, the particular shape of the hook on the cap of a pen (or other writing instrument) could be a trademark of writing instruments.



[Image taken from <http://www.penhero.com/PenGallery/Parker/ParkerClassicSpacePen.htm>]

1.1.3.3 Shapes of containers, wrapping, packaging, etc.

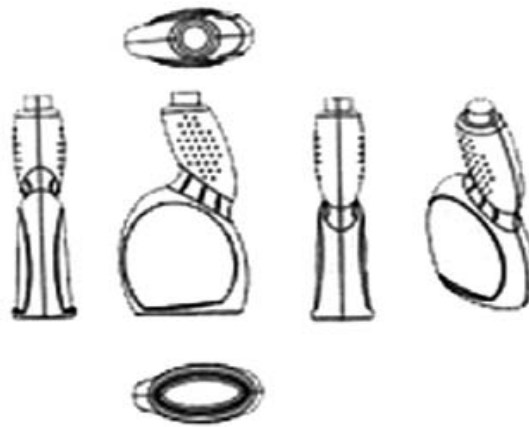
The shape or aspect of the container, wrapping, packaging or other conditioning of a product is a 'visually perceptible' sign and is capable of being 'represented graphically'. To that extent such shape, aspect or external conditioning of goods should, in principle, be admitted for registration as a mark.

However, it would still be necessary for such sign to comply with the usual requirements for registration. In particular, the shape must be distinctive and must not be functional (see chapter 2, below).

For example, the following shapes of containers and product conditioning can constitute valid trademarks for the goods that are inside the containers or under the conditioning:



[Example taken from the Guidelines for Trademark Examination of the Philippines, p. 118]



[Examples taken, respectively from trademark applications 1061542 and 1061835 filed under the Madrid Protocol.

See http://www.wipo.int/edocs/madgdocs/en/2010/madrid_g_2010_52.pdf]

1.1.4 Movement (animated) signs and holograms ³

Movement signs and holograms may be registered as marks to the extent that they are ‘visually perceptible’ and capable of being ‘represented graphically’.

A movement mark is perceived as a video clip or short film used to distinguish goods or services in the context of, for instance, visual or video communications to the

³ See the provisions in BN TMA, s. 4(1); KH TML art. 2(a); LA IPL art. 16.1; MY TMA s. 10(1)(e); MM; PH IP Code s. 121.1; SG Act s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter 1 “What is a trade mark” p. 13; VN IPL art. 72.1. Also the OHIM Guidelines, Part B, Section 2, item 9.8.1 and Section 4, item 2.1.2.4.

public. They cannot be physically attached to the goods themselves but may be used to distinguish digital products and services on portable devices such as mobile telephones, internet-based services, etc..

A hologram is a figurative sign that gives a seemingly three-dimensional view of the sign depending on the angle at which the sign is seen. In practice they function as two-dimensional figurative signs with a movement effect.

1.1.5 'Position' marks ⁴

A 'position' mark is a figurative, mixed, colour or three-dimensional sign that is applied to a specific part of, or in a specific position on, the goods that the mark distinguishes. Such marks are placed consistently in the same position on the goods of the trademark holder, in a regular size or proportion with respect to the size of the goods.

The examiner must object to an application for registration that broadly claims *per se* a position or location on a product and raise an objection of functionality. All the places on the surface of a product on which a trademark may be affixed are inherently functional and their exclusive appropriation as trademarks would interfere with the normal conduct of trade and industry. Unfettered availability of such surface positions by competitors is therefore necessary. They must remain free for all competitors to use.

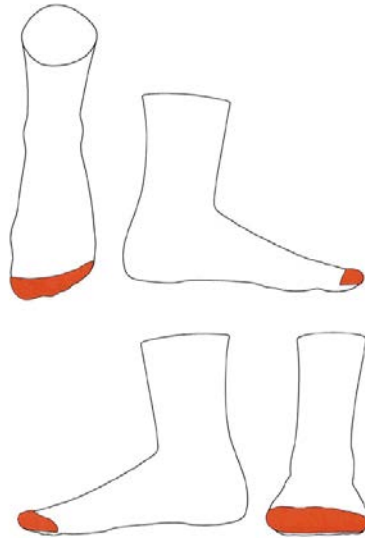
However, a figurative, mixed, colour or three-dimensional sign may be registered with a *limitation* as to its position or location on the goods specified in the application. If the applicant limits the position of the sign to a particular location on the product, this limitation should not be a ground for objection. The sign as intended to be applied on the specified position on the goods must nevertheless comply with the substantive requirements for registration.

In particular, a sign with a limitation regarding its position must be sufficiently *distinctive* with regard to the specified goods (or services). The sign must be recognizable by the relevant public as a mark indicating commercial origin, rather than just an element of the aspect, design or decoration of the product. Moreover, the features of the intended sign and the position limitation must be clear from the representation submitted (see item 2, below).

A *single colour* applied to a particular part (position) of a product was found to lack distinctiveness in the case of the orange colouring of the toe of a sock (reproduced below). OHIM refused registration of that device as a mark arguing, in particular, that the sign would be perceived by the relevant public as a presentation of the product dictated by aesthetic or functional considerations. The colouring of the toe might indicate the presence of a functional feature, namely a reinforcement. The relevant public was not in the habit of perceiving the colour of the toe of a sock as an

⁴ See the OHIM Guidelines, Part B, Section 2, item 9.8.2 and Section 4, item 2.2.14.

indication of commercial origin. Consequently, the device was devoid of distinctive character. The European Court of Justice upheld that decision.⁵



The question of distinctiveness was also raised in the case of *Margarete Steiff GmbH vs OHIM* (“STEIFF” case). The OHIM refused the registration of a ‘position’ mark consisting of a metal button placed in the center section of the ear of a soft toy animal (e.g. stuffed bear or dog). Such device (the metal button) positioned in the center of the toy’s ear was found not to be distinctive. The device would not be perceived by the relevant public as a sign of commercial origin but merely as part of the aspect of the product or a decorative feature thereof. A button fixed on a soft toy was a usual feature for this type of products and the consumers would not perceive it as a trademark. The European Court of Justice upheld OHIM’s decision.⁶

⁵ Decision of the European Court of Justice, 15 June 2010, case T-547/08 (“Orange colouring of toe of sock”). See <http://curia.europa.eu/juris/document/document.jsf?text=&docid=79459&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=332038>.

⁶ Decision of the European Court of Justice, 16 January 2014, case T-433/12 (“STEIFF” case). See <http://curia.europa.eu/juris/document/document.jsf?text=&docid=146427&pageIndex=0&doclang=FR&mode=lst&dir=&occ=first&part=1&cid=330342>.



[Images taken from http://www.steiffbaby.co.uk/wp-content/uploads//2011/08/My_First_Steiff_Teddy_Bear_664120.jpg and from <http://www.corfebears.co.uk/osp-3593.php>]

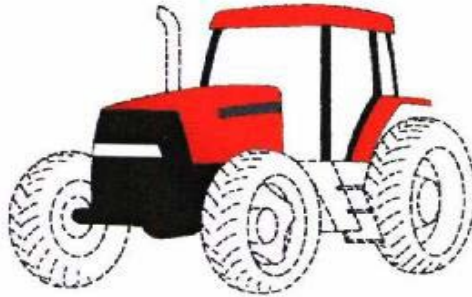
The following are examples of marks that have been accepted (registered) with a limitation as to the 'position' of certain distinctive elements:



for clothes and sportswear [examples provided by the Philippines IP authorities].



for electric lamp light bulbs [from OHIM CTM registration N° 3799574]



for agricultural machines and vehicles [from OHIM CTM registration N° 9045907]

1.2 Non-visually perceptible signs -- Graphic representation

If the law does not confine trademark registration to signs that are 'visually perceptible', any sign that is perceptible by any one of the five basic human senses (sight, hearing, smell, touch and taste) could, in principle, be registered as a mark. However, where non-visually perceptible signs are admitted, their registration will depend on whether the sign can be *represented graphically*. Therefore, the decision to grant or refuse registration of a mark consisting of a sign that is not visually perceptible will pivot on the graphic representation of the sign.⁷

Although a reproduction or a graphic representation will be a formal requirement to register any mark, including visually perceptible marks, in the case of signs that are not visually perceptible the graphic representation of the sign is critical. Under this approach if the sign cannot be represented graphically in a satisfactory manner, the sign must be refused registration. The applicant's compliance with the rules that define the conditions for a 'graphic representation' is imperative.

The graphic representation of a sign applied for registration as a mark should be *clear, precise, self-contained, easily accessible, intelligible, durable* and *objective*.⁸ The means used for the graphic representation should be stable, unambiguous and objective. A representation that may change in time or be subjectively interpreted in different ways would not allow the mark to be objectively defined. This ambiguity would cause legal uncertainty for the trademark owner and for competitors.

⁷ See the provisions in SG TMA s. 2(1) – 'sign' and 'trade mark', TM Manual chap.1 "What is a Trade Mark", p. 10. Also the OHIM Guidelines, Part B, Section 2, items 9.4 and 9.7.

⁸ See the OHIM Guidelines, Part B, Section 2, items 9.4 and 9.7, and Section 4, item 2.1.1, second paragraph. In the latter connection the OHIM Guidelines refer to the European Court of Justice judgment of 12/12/2002 , C-273/00, 'Sieckmann', paragraphs 46-55, and judgment of 06/05/2003, 'Libertel', C-104/01, paragraphs 28-29).

To be accepted, a graphic representation of the sign must be sufficiently clear to allow full understanding of the features of the mark and the scope of what will be claimed and protected by the registration of the mark.

The function of the graphic representation is to define the mark so as to determine the precise subject matter that will be covered by the registration. This information must be permanent and objective so that the scope of the registration may be established with certainty at any future time during the registration's term.

The graphic representation must be expressed and presented visually in *two-dimensional format*. This means that the representation must be made using printed or printable characters, images, lines, etc., on paper or in a form printable on paper.

The actual graphic representation will effectively depend on the nature of the sign and the sense through which the mark is to be perceived. The following rules apply to decide whether a graphic representation is adequate and should be admitted for signs that are *not* visually perceptible, i.e., signs that are perceptible by the senses of hearing, smell, taste and touch.

1.2.1 Signs perceptible by the sense of hearing

If the sign consists of a melody, jingle, tone, song or other musical sound that can be represented clearly and accurately by musical notation, such notation must be submitted with the application and will suffice to comply with the requirement of graphic representation.⁹

If the sign consists of a non-musical sound or noise that cannot clearly and accurately be represented by musical notation, and such signs are admissible for registration under the law, the examiner may require a graphic representation consisting of a sonogram¹⁰, sonograph¹¹ or oscillogram¹² accompanied by a corresponding electronic *sound file* (sound record) submitted by electronic filing or in a standard electronic format.¹³

⁹ See the provisions in SG TMA s. 2(1), TM Manual chap. 1 "What is a trade mark", p. 10. Also the OHIM Guidelines, Part B, Section 2, item 9.4.

¹⁰ A 'sonogram' is a graph representing a sound, showing the distribution of energy at different frequencies. See <http://www.oxforddictionaries.com/definition/english/sonogram?q=sonogram>

¹¹ A 'sonograph' is a graphic representation of the component frequencies of a sound. See http://www.oxforddictionaries.com/definition/english/sonography?q=sonograph#sonography_6

¹² An 'oscillogram' is a record produced by an oscillograph, a device for recording oscillations, especially those of an electric current. See <http://www.oxforddictionaries.com/definition/english/oscillograph?q=oscillograph>

¹³ For example, see the OHIM Guidelines, Part B, Section 2, item 9.4 and Section 4, item 2.1.2.3.

Other representations of a sound mark would not be regarded as a sufficiently clear graphic representation. For example, a written description of the sound or noise, or an explanation using onomatopoeic words would not be acceptable.¹⁴

1.2.2 Signs perceptible by the sense of smell

Signs perceptible only by the sense of smell cannot be represented graphically in a manner that is sufficiently clear, precise, easily accessible, intelligible, durable and objective.

A written chemical formula representing a substance that would produce the particular odour or scent would not allow that odour or scent to be identified by the examiner. It would lack 'easy accessibility' as such substance would need to be produced every time a comparison is to be performed.

A physical sample of material generating the scent or odour is not a 'graphic' representation and would generally not be stable and durable. Trademark offices are not equipped to receive and store such samples or material, so lack of accessibility to the mark would also be an obstacle.

A written description of the smell could not be regarded as objective since the description would allow different personal, subjective interpretations.

There is at present no internationally recognised objective classification for smells, odours or scents that could be applied for the purposes of trademark registration.¹⁵

1.2.3 Signs perceptible by the sense of taste

Signs perceptible only by the sense of taste cannot be represented graphically in a manner that is clear, precise, easily accessible, intelligible, durable and objective.

The same objections mentioned under item 1.2.2, above, regarding signs perceptible by the sense of smell will be raised against signs perceptible by the sense of taste.¹⁶

¹⁴ See the SG TMA s. 2(1), TM Manual chap.1 "What is a trade mark", p. 11. Also the OHIM Guidelines, Part B, Section 2, item 9.4.

¹⁵ In this regard see the SG TM Manual chap. 1 "What is a trade mark", p.12; and the OHIM Guidelines, Part B, Section 2, item 9.7 and Section 4, item 2.1.2.1.

¹⁶ See, for example, the OHIM Guidelines, Part B, Section 4, item 2.1.2.2.

1.2.4 Signs perceptible by the sense of touch

Signs perceptible by the sense of touch could be used to distinguish products and services offered, in particular, to persons that are visually impaired, although they could also be addressed to consumers in general.

These 'tactile' marks could be represented graphically to the extent that they consist of physical features of the particular products or of their packaging, or of objects used in connection with the services for which the marks are to be used.

The criteria and provisions regarding 'three-dimensional' marks would apply also to these marks, *mutatis mutandis*. The usual conditions regarding distinctiveness and functionality would also need to be met.

2 Distinctiveness

The fundamental requirement for a sign to be registered as a trademark is that it be distinctive in respect of the goods or services for which it will be used in trade. This means that the sign must be *capable of distinguishing* goods and services in the course of trade.¹

The distinctiveness of a sign for purposes of its registration as a mark must be established on a case-by-case basis with regard to the particular goods and services for which the mark will be used and for which registration is sought. Also, distinctiveness must be determined taking into account the perception of the sign by the public to whom the mark will be addressed, that is, the relevant sector of the public. This assessment must be done for each trademark application, on a case-by-case basis.²

For the purposes of registration as a mark, lack of distinctiveness of a sign may result from:

- (i) the fact that the sign's constituent features make it unintelligible or imperceptible by the average consumer when used as a trademark, or the fact that the average consumer will not understand or recognize that the sign is intended as a mark; or
- (ii) the relationship between the mark and the particular goods or services to which it is applied in the course of trade, or the legal, social or economic context in which the mark would be used.

2.1 Signs not understood or not perceived as trademarks

A sign that is not perceived or recognised by the relevant public, or that is not understood by consumers to be a mark indicating commercial origin, may not be registered as a trademark.

To be seen as a mark, the sign in question must be identified as a feature that is separate from the product or service it is to be used for. A sign cannot distinguish a product (or service) if it is not seen as something different and independent from the product it will identify. That would be the case, for instance, if the sign were seen as part of the normal appearance of the product itself or of the product's design.

¹ See the provisions in BN TMA, s. 6(1)(b); KH TML art. 4(a); ID TML art. 5(b); LA IPL art. 23.1, Decision 753 art. 39; MY TMA s. 10(2A); MM; PH IP Code s. 121.1; SG Act s. 7(1)(b); TH TMA s. 6(1); VN IPL art. 72.2. Also the OHIM Guidelines, Part B, Section 4, item 2.2.

² See the OHIM Guidelines, Part B, Section 4, item 2.2.1.

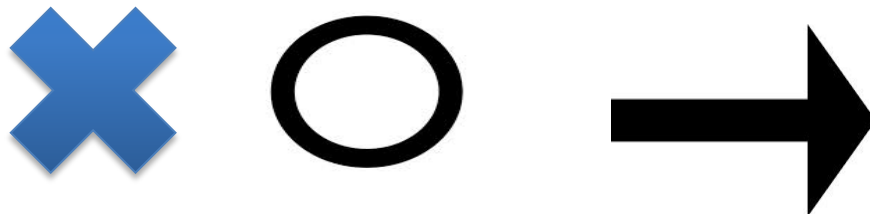
The following categories of signs could be regarded as *prima facie* incapable of being recognised by consumers as marks that indicate a commercial origin:

- simple figures
- complex or unintelligible signs
- colours
- single letters and digits
- three-dimensional shapes
- patterns and surface designs
- common labels
- simple advertising phrases.

2.1.1 Simple figures

A sign consisting of a simple geometrical shape devoid of any feature that will give it a special appearance, or attract the attention of consumers when the sign is used in trade, will generally not be distinctive and cannot function as a trademark.³

For example, the following signs will normally not be sufficiently distinctive to be perceived as marks, and therefore cannot be registered as such:



The same will apply to signs such as typographical symbols, exclamation marks (!), question marks (?), percentage (%) or 'and' (&) signs, and similar common symbols that are commonplace and non-distinct.

2.1.2 Complex or unintelligible signs

Signs that are composed of elements that are unintelligible or unduly complex will likewise not be perceived as trademarks by the average consumer if used in trade, or are difficult for consumers to recognize or to remember. Such signs lack the

³ For instance, see the provisions in LA TM Manual p. 26; VN IPL art. 74.2.a, Circular 01/2007 s. 39.4.a. Also the OHIM Guidelines, Part B, Section 4, item 2.2.7.

ability to distinguish goods and services in trade and therefore cannot be registered as marks.⁴

For example:⁵



Application No.: 4-2009-24600:



International Application No.: 1101043

Signs expressed in characters that are *prima facie* unintelligible to the general public in a particular country may be accepted subject to submission of a *transliteration* of the words or text, as required by the examiner under the applicable law. This may include cases of signs containing text written in alphabets or characters such as Arabic, Cyrillic, Sanskrit, Chinese, Japanese, Korean or others.

For example:

维尔迪

ほんだし

⁴ See the provisions in LA TM Manual p. 26; VN Circular 01/2007 s. 39.4.b.

⁵ Examples provided by the Vietnam IP authorities.



[Examples provided by the Vietnam IP authorities]

Where unintelligible words or text are combined with a figurative element, the combination may be found to be distinctive. However, the examiner may require a transliteration or a translation of the unintelligible words or text.

2.1.3 Colours ⁶

2.1.3.1 Single colour

A *single colour* in the abstract (a colour *per se*) claimed independently of any specific shape, contour or other defining element or feature -- i.e. claimed in any conceivable form -- cannot be registered as a mark. Claiming a colour in the abstract would amount to claiming the idea of that colour. Such sign would not comply with the conditions of clarity, precision and uniformity required for a precise definition of the scope of the registration. To that extent the sign would not be capable of distinguishing goods or services in trade.

Moreover, claiming a single colour in the abstract could unduly restrict the freedom of other traders to use colours to offer goods or services of the same type as those in respect of which registration is sought. This would interfere with legitimate trade and hence be contrary to public policy.

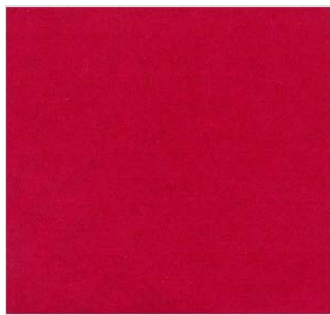
A single colour could be presented and used in trade in a great variety of forms. The public will not normally recognise the colour as being a mark. Consumers will normally not identify the commercial provenance of goods only on the basis of their colour or the colour of their conditioning. Consumers will look for a word or other graphic sign to distinguish particular goods or services.

⁶ See the provisions in BN TMA s. 6(1)(b); KH TM Manual p. 21; ID TML art. 1.1, TM Guidelines chapter II.A.1; LA TM Manual p. 26; MY TM Manual chapter 4 paragraph 4.8; PH IP Code, s. 123.1(L), TM Guidelines chapter XIII; SG TMA s. 2(1) – ‘mark’ and ‘trade mark’, TM Manual, ‘Colour marks’ p. 4 and 6; TH TMA s. 4 – ‘mark’; and VN Circular 01/2007 s. 39.2.b(i). Also the OHIM Guidelines, Part B, Section 4, items 2.1.2.5 and 2.2.4.

To the extent that single colours in the abstract are not generally used as a means of brand identification, it should be presumed that single colours are functional. This means that in practice a colour will function merely as a decoration or attractive presentation of goods and services, and will not be perceived as an indication of commercial provenance.

Accordingly, a mark consisting of a single colour *per se* should be presumed not to be capable of functioning as a mark and the examiner should raise an objection to its registration on that ground. To be registered, the colour would need to be defined by a concrete shape or have defined contours.

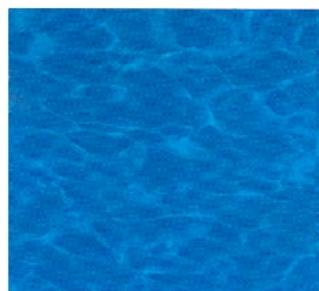
For example, the following sign consisting of the colour red *per se* was refused registration in Vietnam, as it was found incapable of functioning as a mark:



International Application No. 801739

[Example provided by the Vietnam IP authorities]

Likewise, the following colour *per se* was refused registration in Malaysia:



01015661 – SOCIÉTÉ DES PRODUITS NESTLÉ S. A.

[Example provided by the Malaysia IP authorities]

As regards colours applied to *parts* of products or to a specific position or location on a product, and their acceptability as trademarks, see item 1.1.5, above ('position' marks).

The foregoing grounds for refusal could be overcome in the exceptional case that the colour is *very unusual* or *striking* when used in connection with particular goods or services. For example, the colour 'fluorescent pink' applied as a brand on vehicle tyres (which are normally black) could be found to be distinctive.

This ground for refusal could also be overcome if the colour has *acquired distinctiveness* through use in trade. This special circumstance would have to be proven and the burden of proof would lie with the applicant for registration. See item 2.6, below).

However, acquired distinctiveness will not operate where a colour is *functional* on account of a convention, or of its inherent technical nature or the nature of the products on which it is applied. In such case the examiner should raise an objection against the registration of the colour.

The functional nature of a particular colour may result from a convention or from a technical standard in a particular sector of products. For example the use of the colour red for fire-extinguishing devices and equipment, or colour codes for specific components of an electric wiring circuit.

Functionality of a colour may also result from its technical or physical nature. For example, the colour black when used on certain products, such as internal combustion engines or motors, may provide thermic features that are necessary to enhance heat radiation performance.

Additionally, a colour should be regarded as functional if it is common in the trade of particular goods or services, or if it results from the natural colour of the goods. Any competitive need by third parties to use a colour will make that colour functional and would be a bar to the colour's registration as a mark.

2.1.3.2 Abstract combinations of colours

In the case of an application to register a sign consisting of *two or more* colours claimed in any conceivable combination or form, the colours could effectively be used in practice in many different combinations and forms. This would not allow the average consumer to perceive and recall any particular combination of those colours. Such potential variation could give the mark an undefined scope of protection. Competitors would be unable to predict the manner in which the owner of the mark might use it in trade and they could not avoid conflicting uses of the colours. Such unpredictability would make it impossible for competent national authorities to establish *a priori* a clear scope of protection for the mark, causing unacceptable legal uncertainty.

Accordingly, a sign consisting of an abstract, undefined combination of two or more colours cannot be registered as a mark. To be registered, the colours would need to be defined by a particular shape or contours, or be combined in a single, predetermined and uniform presentation.

Where the law so allows, the foregoing grounds of refusal could be overcome if the combination of colours has acquired distinctiveness through use in trade. This special circumstance would have to be proven in each case, and the burden of proof would lie with the applicant for registration. However, as with single colours (see item 2.1.3.1, above), if a combination of colours is functional in any way, acquired distinctiveness will not operate and registration should not be allowed.

For example, the use of colours for different layers in dishwasher tablets or detergent soaps are common in that industry to indicate that the product contains different active ingredients. This informative meaning of the different colours in particular contexts makes the colour combination functional and it may not be claimed in exclusivity as a mark for the relevant goods or services.

2.1.4 Single letters and digits

A single letter or a single digit may comply with the requirement of distinctiveness to be registered as a mark.⁷

If the letter or digit is presented in a *particular shape, style or colour or combination of colours* it may be *inherently distinctive* and therefore be registrable, without prejudice to other applicable grounds for refusal (for example, genericness or descriptiveness when used in respect of certain goods or services).

For example, the following signs could be regarded as being inherently distinctive:



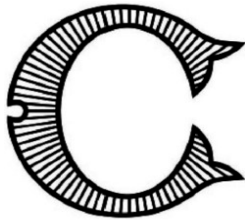
[Image taken from <https://www.etsy.com/listing/177338132/mosaic-number-house-number-number-6?ref=market>]

⁷ See the provisions in BN TMA s. 4(1); KH TM Manual p. 28; ID TML Art. 1.1; LA Decision 753 art. 17.2, TM Manual p. 4 and 26; MY TMA s. 3(1); MM; PH IP Code, s. 123.2; SG TMA s. 2(1) – ‘sign’ and ‘trade mark’; TH; and VN IPL, art. 74.2. Also the OHIM Guidelines, Part B, Section 4, item 2.2.5.



[Logos of Google and Amazon, respectively]

The following single-letter signs were found to be sufficiently distinctive:



[Examples provided by the Philippines IP authorities]



06007262 - RADIANCE HOSPITALITY GROUP PTE. LTD.



08025300 - REPSOL S.A.

[Examples provided by the Malaysia IP authorities]



Application No.: 4-2011-19180



Application No.: 4-2011-21087



Application No.: 4-200511949

[Examples provided by the Vietnam IP authorities]

In case of a single letter or digit presented in *standard characters*, i.e. devoid of any particular shape, style or colour or combination of colours, the examination should be more careful. Such signs carry a heavy presumption of lack of distinctiveness. Registration could be accorded if the sign is sufficiently distinctive and does not fail on other grounds, for example if the letter or digit is generic or descriptive in respect of particular goods or services.

For example, the following sign could be found *prima facie* not to be distinctive:



[Example provided by the Philippines IP authorities]

The following signs were refused registration in Vietnam for lack of sufficient distinctiveness:



Application No.: 4-2009-06807



Application No.: 4-2009-27613



Application No. 4-2010-17584

[Examples provided by the Vietnam IP authorities]

2.1.5 Three-dimensional shapes

Three-dimensional shapes are signs that can be registered as marks if they are distinctive. This will not apply where the law precludes the registration of three-dimensional marks.⁸

If the shape of a product, or of a part of a product, or of the product's packaging or container, is not distinctive but is presented in combination with a sign that is distinctive, the combination as a whole should be regarded as distinctive. The distinctive elements of the combination will render the ensemble distinctive, even if some of the elements of the combination are not distinctive. Such is the case, for example, of a three-dimensional mark consisting of a standard bottle with a distinctive label applied on it.

Where the distinctiveness is to be found in the shape of a product, or of a part of a product, or of the product's packaging or container that is not combined with another sign that is distinctive, the examination should proceed more carefully to determine that the shape is *in itself* sufficiently distinctive.

A sign consisting of a *two-dimensional reproduction* or representation of a three-dimensional shape should be treated and examined as the three-dimensional shape it reproduces. This means that a two-dimensional representation of an unregistrable three-dimensional shape must also give rise to an objection by the examiner if it relates to goods in respect of which the three-dimensional shape would not be registrable.

For instance, the following two-dimensional device was refused registration in Vietnam as it was found to *represent* the usual three-dimensional shape resulting from the nature of the product:



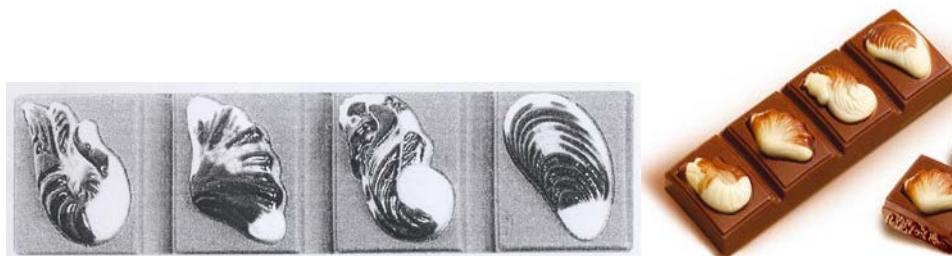
For fruits, preserves - Application No. 4-2009-17819

[Example provided by the Vietnam IP authorities]

⁸ See the provisions in BN TMA, s. 4(1) and 6(2); KH TM Manual p.18; LA Decision 753 art. 17.5, TM Manual p. 4; MM; PH IP Code, s. 121.1, TM Guidelines chapter XII; SG Act s. 2(1) and 7, TM Manual chapter 3 "Shape Marks", p. 7; TH TMA s. 4 – 'mark'; and VN IPL, art. 74.2.b. Also the OHIM Guidelines, Part B, Section 4, items 2.2.12 and 2.5.

The three-dimensional shape of a product, or of a part of a product, or of the product's packaging or container, will fulfil its distinctive function as a trademark if the consumers recognise that shape and rely on that sign as an indication of commercial origin. Conversely, a three-dimensional shape cannot be registered as a mark if it is incapable of distinguishing goods or services because the sign is not perceived as an indication of commercial provenance or commercial origin of the goods or services in connection with which that sign is used.

For example, the following shape of a chocolate bar was refused registration in Malaysia for 'pastry and confectionery, chocolate and chocolate products, pralines' on grounds, in particular, that the mark is not distinctive, not inherently capable of distinguishing and is common in the trade for chocolate:



TM application N° 05015047 - 'SEASHELL CHOCOLATE BAR

[Example provided by the Malaysia IP authorities]

The examination of this type of signs should proceed from the basis that the shape of a product or of the product's packaging or container will not normally be perceived by the public as a sign that conveys information about the product's commercial origin. Rather, the shape of a product will usually be perceived as the design of the product, or as a decorative or aesthetic presentation used in order to make the goods more attractive to potential consumers. On this ground the examiner should raise an objection for lack of distinctiveness. The burden of proof that the shape of a product is perceived as a mark and not just as a product design lies with the applicant.

It is recalled that the design of a product may be protected independently under the law of *industrial designs*, and in certain cases may also be protected under the law of *copyright* as a work of *applied art*. An industrial design refers to the *visual aspect* or *appearance* of a useful object and does not convey information on the commercial origin or provenance of the object. Under the law of industrial designs, a registered or unregistered design may give its holder exclusive rights to exploit the design commercially, but those rights will subsist only for a limited period of time after which the design will normally fall in the public domain.

Unlike industrial designs, rights in registered trademarks, including three-dimensional marks, may remain in force indefinitely (if renewed at regular intervals). It is

therefore a matter of public policy that exclusive private rights in the shape of a product be protected through the industrial design system, and only benefit from trademark protection when the shape of the product is clearly distinctive as an indicator of commercial origin.

In connection with the required distinctiveness, three-dimensional marks should be refused registration on the following particular grounds, which *cannot be overcome* by acquired distinctiveness as these grounds are based on the underlying policy considerations mentioned above:⁹

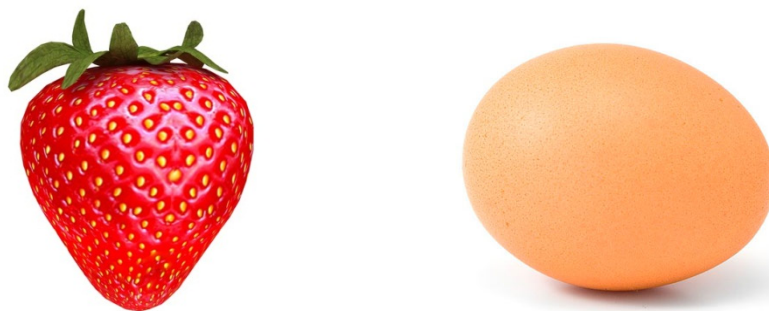
- the shape is *usual, common* or derives from the *nature* of the product
- the shape has a *functional* nature or a *technical* effect.

⁹ See the provisions in BN TMA, s. 6(2); KH TM Manual p. 19; LA Decision 753 art. 17.5, TM Manual p. 4; PH IP Code, s. 123.1(k), TM Guidelines chapter XII p. 122, 133, 134; SG TMA s. 7(3), TM Manual, chapter 3 'Shape marks' p. 7 and 9; TH TMA s. 4 'mark'; and VN IPL, art. 74.2.a and b. Also the OHIM Guidelines, Part B, Section 4, item 2.5.

2.1.5.1 Shape is usual, common or derives from the nature of the product

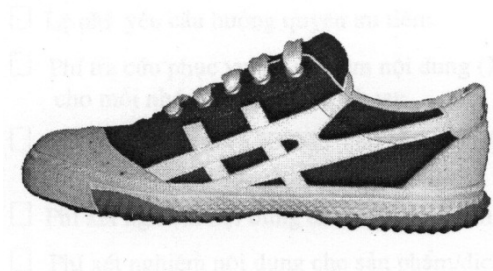
The shape of a product or of its packaging or container cannot be registered as a mark if it consists of a shape which derives from the nature of the product (or service) that the mark is to distinguish. Likewise, a shape cannot be registered as a mark if it consists of the usual shape for the product or of the packaging or container of that product, or if it is a shape that is common in the industry to which the product relates.

For example, the following three-dimensional devices could not be registered as trademarks for, respectively, 'fruit' or 'fresh eggs':



[Images taken, respectively, from <http://www.turbosquid.com/3d-models/3ds-max-strawberry-fruit-fresh/691309> and from <http://kottke.org/14/04/egg>]

The following shape was refused registration in Vietnam as it was found to be usual or derived from the nature of the product itself:



For sports shoes Application No. 4-2005-13334

[Example provided by the Vietnam IP authorities]

As regards *packaging and containers*, usual presentations of products and standard shapes of containers cannot -- in the absence of any distinctive sign or distinctive feature applied to it -- be registered as marks. However, if a non-distinctive wrapping or container includes a sufficiently distinctive sign such that the combination is made distinctive, the combination could be registered as a mark.

For example, the following shape could not be registered to distinguish 'wines' insofar as the shape is usual or standard for containers in the wine industry:



[Example taken from <http://www.alcoholstore.co.uk/store/products/shiny-bottle-wine-2/>]

The following shape was not allowed for registration by the Malaysian authorities on grounds of lack of distinctiveness and commonality of the container's shape:



Application N° 03002023 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

[Example provided by the Malaysia IP authorities]

Likewise, following containers were refused registration by the Vietnamese authorities on grounds of lack of distinctiveness and commonality of the containers' shapes:



For goods in class 3 -- Application No. 4-2003-10944



For goods in class 21 -- Application No. 4-2011-16952

[Examples provided by the Vietnam IP authorities]

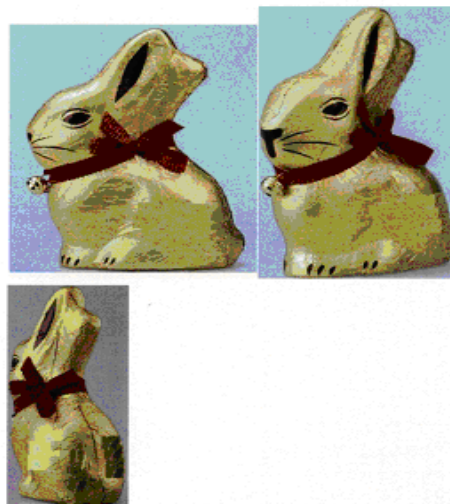
An unusual, non-standard container shape should be regarded as sufficiently distinctive and accepted for registration. For example, in Vietnam the following container shape was found to be distinctive and registered:



Application 4-2012-18308

[Example provided by the Vietnam IP authorities]

The *wrapping* and product *shape* in the following example were found to be commonplace for chocolate products and devoid of the required distinctiveness: ¹



In the case illustrated above the shapes derived directly from the products themselves or were undistinguishable from the natural or usual shapes of the relevant products. Such shapes must be left free from private appropriation because all competitors operating in the market in trade relating to those products need to be able to use the same or similar shapes freely in connection with their products, unencumbered by claims from any individual competitor. Granting exclusive trademark rights on shapes that are common or necessary in trade would unfairly

¹ Judgement of the European Court of Justice, 24 May 2012, case C-98/11 P 'Shape of a bunny made of chocolate with a red ribbon', taken from <http://curia.europa.eu/juris/document/document.jsf?jsessionid=9ea7d0f130de8db454cc04a44f3dabf88c90f1347635.e34KaxiLc3eQc40LaxqMbN4OaNuOe0?text=&docid=123102&pageIn dex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=540089> .

limit competition in respect of the goods in question, with undesired consequences for the economy and the public.

Moreover, a shape that is usual or commonplace in respect of a product will not be recognized by the consumers in their decision to purchase the product. To be distinctive as a mark, the shape of a product or the shape of a product's packaging or container must be substantially different from the shapes that are common, usual or necessary in the relevant trade. The shape must depart significantly from the shapes usually expected or used for the goods in question, and be capable of producing an impression on the consumer in the sense that the shape is an indication of commercial origin.

However, if a distinctive sign is attached to a non-distinctive shape, the combination could be regarded as distinctive.

2.1.5.2 *Shape with a functional nature or a technical effect*

The shape of a product or its packaging or container that results from functional considerations or produces a technical effect, including any sort of economic or practical advantage for the production or manufacturing processes, is not capable of distinguishing the relevant goods or services in the course of trade and cannot function a trademark. The examiner must raise an objection against the registration of such three-dimensional shapes, regardless of the type of goods or services to which they apply.

Features of shape that respond to functional considerations or give a technical effect or advantage amount to 'technical solutions' or inventions. As a matter of public policy, a technically determined shape should only be granted exclusive intellectual property rights through the patent system (including utility model protection), which has the proper set of legal conditions and requirements to assess whether the grant of exclusive rights would be warranted for such shape.

The patent system will require specific conditions for the protection of technical solutions and will bar the grant of exclusive rights for technology that does not meet those conditions. Moreover, where exclusive rights are granted under a patent, their duration will normally not exceed the standard term of 20 years, after which the technology disclosed in the patent falls into the public domain. If technically determined shapes of products were granted exclusive rights through the trademark system, technical solutions (inventions and utility models) could remain under private control indefinitely by renewing the trademark registration. Such permanent appropriation of functional shapes would run contrary to public policy that aims at facilitating the dissemination and access to new technology by bringing technical solutions into the public domain as soon as possible.

The examiner should raise this objection if the main features of the shape are functional, even if the shape includes other features that do not have a functional or technical nature. A shape should be regarded as functional -- and therefore

objectionable -- in any case where the essential elements of the shape have a technical, economic, commercial or practical effect in relation to the product.

A shape should be regarded as functional in the following cases, in particular:

- the shape is necessary to allow the product to be used for its intended purpose, or is an ergonomic shape for the product,
- the shape allows for a more efficient or more economical manufacture or assembly of the goods (e.g. by saving material or energy),
- the shape facilitates the transportation or storage of the goods,
- the shape gives the product more strength or better performance or durability,
- the shape allows the product to fit or be connected with another product.

A shape that is disclosed and claimed in a patent document or in technical literature in connection with the type of product for which the mark is to be registered, should be regarded as functional since matter claimed in a patent document should be presumed to be a technical solution.

Absolute grounds for refusal based on the functionality of a shape cannot be overcome by showing acquired distinctiveness. Even if a functional shape was in fact recognized by consumers as an indication of commercial origin of the goods, or found to be distinctive, such shape could not be registered as a mark.

For example, the following shapes of products should be refused registration as trademarks for the respective products, on the basis of functionality:





[Examples taken from trademark filings under the Madrid Protocol. See <http://www.wipo.int/romarin/>]

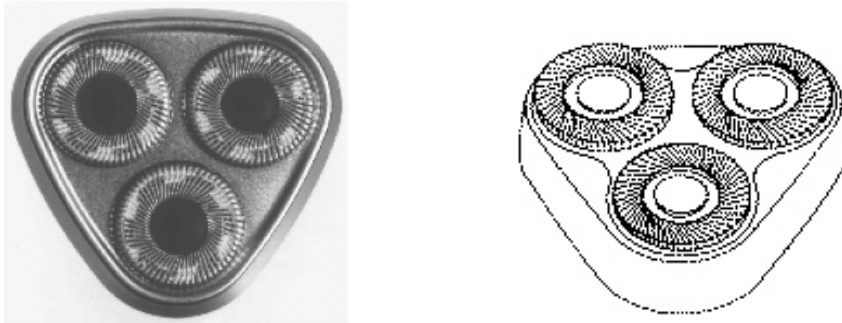


for “lights for medical purposes, namely operating lights”

[Example taken from trademark application 1061514 under the Madrid Protocol. See http://www.wipo.int/edocs/madgdocs/en/2010/madrid_g_2010_52.pdf]

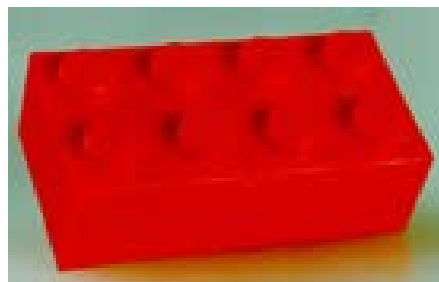
If a shape is functional because it provides a technical effect or functional advantage (including at the stages of manufacture, assembly, transportation or use of the product for its intended purpose) the objection cannot be overcome even if other shapes are available that would afford equivalent functionality or provide the same effect or advantage.

For example, the following shape of a part of a product (electric razor head) was found to be functional and therefore unregistrable notwithstanding the fact that other functional shapes existed for the same type of products:



[Examples taken, respectively, from http://www.ippt.eu/files/2002/IPPT20020618_ECJ_Philips_v_Remington.pdf and from the OHIM Guidelines Part B, Section 4, item 2.5.3]

Another example of a functional shape that was excluded from registration as a mark on grounds of functionality is the LEGO toy building brick.²

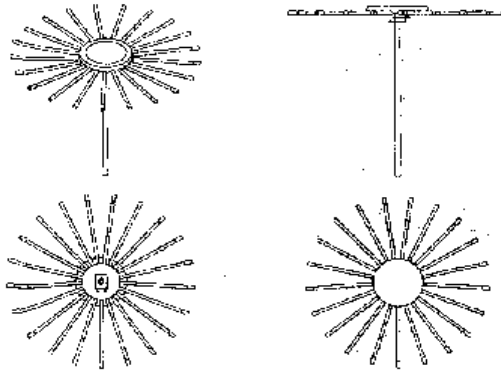


In Vietnam the following three-dimensional shapes were found to be functional or to provide a technical effect, and were refused registration as a trademarks for the goods indicated:

² See the decision of the European Court of Justice, case C-48/09, 'Red Lego Brick', of 14 September 2010. Also, the OHIM Guidelines, Part B, Section 4, item 2.5.3.



For “box for jewellery, cases for clock- and watchmaking”
Application No.:4-2012-26667



for “antenna” - Application No. 4-2004-09042

A category of functional shapes that are improper for registration as trademarks are surface patterns that have a function in providing grip, traction or other physical or technical effect. The fact that such surface patterns may also be aesthetically pleasing or decorative cannot remove an objection raised on grounds of functionality, where applicable.

For example, the following surface patterns could not be claimed as trademarks for, respectively, tyres or running shoes:

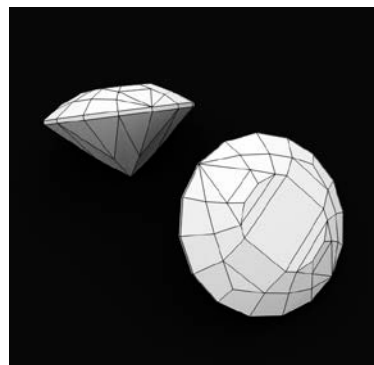


[Images taken, respectively, from <http://www.cdxetextbook.com/steersusp/wheelsTires/construct/treaddesign.html> and from <http://thumbs.dreamstime.com/x/running-shoe-yellow-black-tread-pattern-11961527.jpg>]

Shapes that give products an *added intrinsic value* are also functional and should be available for all competitors to use. This is consistent with public policy to enhance competition and prevent monopolization of economically valuable shapes, as competition will tend to enhance a larger supply of goods to the public at cheaper prices.

For example, the shapes used to cut gems and precious stones so they can reflect light better or be seen brighter add intrinsic value to gems and jewellery. In fact, the particular cut of a gem is one of the essential factors determining the commercial value of those goods. A gemstone that is not given the right shape will lose its commercial value. Such shape is therefore functional to the extent that, if a different shape is given to that product, the product will not function as desired.

For example, the three-dimensional shapes illustrated below could not be registered as marks for gems, gemstones or jewellery:



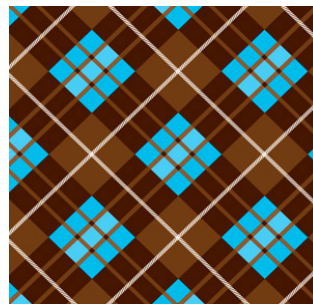
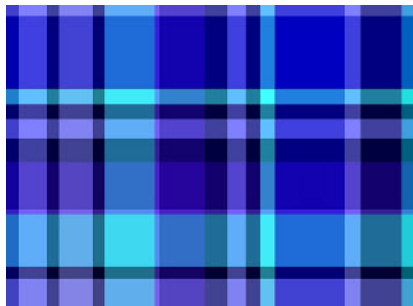
[Image taken from <http://www.turbosquid.com/3d-models/maya-gem-cuts/720214>]

2.1.6 Patterns and surface designs

Patterns are often applied to the surface of certain products or used in flat products such as textile materials and fabrics (plaids), clothes, wallpaper, tiles, tableware, leather goods and other similar products.³ Such patterns will normally not be perceived by the public as trademarks indicating commercial origin, but merely as decorative designs that make the product more attractive.

A pattern on a product's surface will normally function as a product design and be seen by consumers as part of the product itself. It will not be perceived as a sign distinct and separate from the product added to indicate commercial origin. Such patterns do not function as marks and the examiner should raise an objection against their registration.

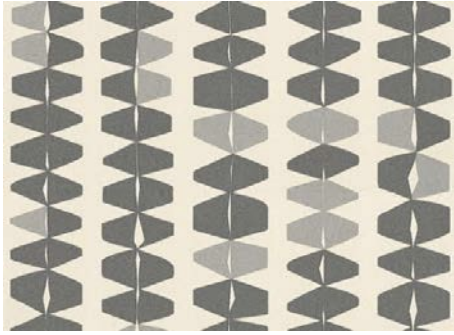
For example, the following surface patterns would not be perceived as marks:



[Images taken, respectively, from <http://nattosoup.blogspot.com/2013/03/creating-plaid-patterns-with-copics-and.html> and from <http://blog.thinkplaid.com/2007/03/plaid-pattern.html>]

Likewise, the patterns of wallpaper, tableware, tablecloths and similar products will normally not be seen by consumers as trademarks but rather as ornamental or decorative product designs. For example:

³ See the OHIM Guidelines, Part B, Section 4, item 2.2.13.



[Images taken from <http://printpattern.blogspot.com/2011/02/wallpaper-elle-decoration.html>]

For instance, the following surface design was refused registration in Vietnam on grounds of lack of distinctiveness in respect of the goods indicated:

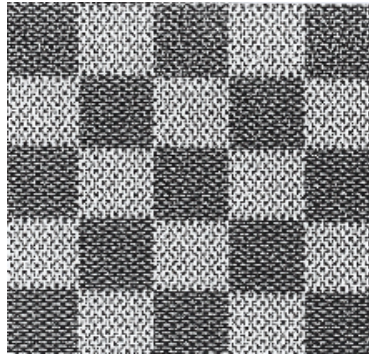


For “building materials, not of metal” - Application No. 4-2009-23542

[Example provided by the Vietnam IP authorities]

However, this *a priori* ground for refusal may be overcome in respect of a particular pattern where the applicant proves that the pattern has acquired distinctiveness and effectively functions as a trademark when used in trade for specific goods or services.

For instance, the following patterns were found to be distinctive in Malaysia:



07015465 -- Louis Vuitton Malletier



00004038 - BURBERRY Ltd.

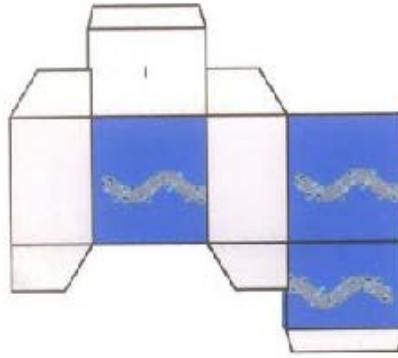
[Examples provided by the Malaysia IP authorities]

2.1.7 Common labels and frames

Certain labels and frames are commonplace or usual in trade in general, or in respect of a particular industry, and therefore cannot be recognized by the public as specific marks indicating commercial origin.⁴

For example, in Vietnam the following labels were refused registration on grounds of commonality and lack of distinctiveness:

⁴ See the OHIM Guidelines, Part B, Section 4, item 2.2.11.



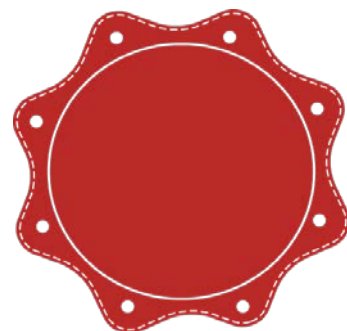
For “medicines” - Application No. 4-2008-18928



For goods in class 30 - Application No. 4-2002-07244:

[Examples provided by the Vietnam IP authorities]

The following are examples of labels or frames that would not normally on their own be recognised as trademarks, regardless of the type of goods or services in connection with which they are used:



[Images taken, respectively, from http://www.4shared.com/all-images/IIUk98vo/Simple_Label_Frames_Set_2.html and from <http://www.fotor.com/features/cliparts/frame-label-b9cc3bb3bb7d42a2955bceba571530bf>]

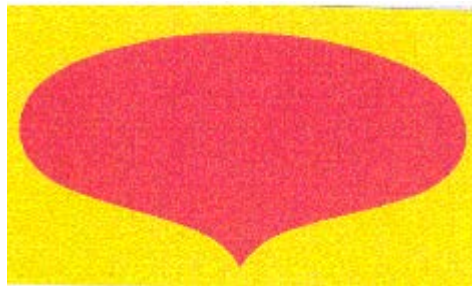
In the examples above, if a distinctive sign (word or figurative) were inserted or juxtaposed on the basic label or frame, the resulting composite sign could become distinctive and be registered as a whole.

However, a label or frame may be found to be distinctive if it is not commonplace or usual in trade, or if it includes elements or features that are themselves sufficiently distinctive.

For example, the following label devices were found to be fanciful and sufficiently distinctive in Malaysia:



02006414 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.



03003257 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

[Examples provided by the IP authorities of Malaysia]

2.1.8 Simple advertising phrases

Simple advertising or promotional phrases and slogans that contain a standard sales message or information about a product, service or trader will not be perceived as signs that indicate commercial origin. Such phrases and slogans are not distinctive and cannot function as marks. The examiner should raise an objection on these grounds.⁵

⁵ See the provisions in BN TMA s. 6(1); KH TM Manual p. 28; ID TML, art. 5.b; LA TM Manual p. 26; MY TMA, s. 10(1)(d) and (e); MM; PH IP Guidelines chapter IX, p.72; SG

A phrase or slogan can be regarded as sufficiently distinctive if it is unusual or striking by reason of its meaning, choice of words or structure, for instance in the following cases: ⁶

- the phrase has more than one meaning and the second meaning is covert, un-conspicuous or unusual in the context of the advertised product or service;
- the slogan presents a pun or plays with words in an unusual manner;
- the phrase contains elements of surprise or an unexpected twist in meaning;
- the slogan presents a paradox or requires an interpretative effort;
- the phrase has a particular rime or rhythm that make it easy to memorize;
- the phrase has an unusual syntax.

For example, the following phrases are usual or common and would not be distinctive enough to be registered as trademarks for any goods or services:

‘The brand you can trust’

‘You're in good hands with us’

‘We do things better’.

“Not just water..... the health water! “ ⁷

These phrases contain general or laudatory statements that refer to alleged positive qualities or advantages of the goods or services in connection with which the phrases are used. They will not be understood as trademarks but as common sales pitch and would therefore not be sufficiently distinctive for registration as marks.

The following advertising phrases were regarded as *not* being distinctive enough for registration as marks in the Philippines, for the goods or services specified: ⁸

- “WE DELIVER BEST!” (for pizza, pasta, spaghetti, noodles, bread)

TM Manual chapter 14 ‘Slogans’; TH TMA s. 4 ‘mark’ and 6(1); and VN IPL, art. 74.2.c, Circular 01/2007 s. 39.3.f and g.

⁶ See the OHIM Guidelines, Part B, Section 4, item 2.2.6.

⁷ Example provided by the Malaysia IP authorities.

⁸ Examples provided by the Philippines IP authorities.

- “YOUR HEALTHY CHOICE, YOUR FAMILY’S CHOICE, YOUR BEST CHOICE” (for natural sweetener)
- “SOLUTION TO MAN’S POLLUTION” (for environmental services).

Likewise, in Vietnam the following advertising phrases were refused registration for lack of distinctiveness:⁹

- “WE GIVE YOU MORE” (for “marketing” services - Application No. 4-2012-01305)
- “YOUR PARTNER FOR SUCCESS” (for goods and services in classes 9, 12, 14, 16, 20, 21, 25, 28, 35, 36, 37, 38, 39, 41, 42, 45. -- Application No. 4-2008-9718)
- “THE FINANCIAL BASIS FOR YOUR SUCCESS” (for services in class 36 -- Application No. 4-2008-09484)

In contrast, the following advertising phrases were regarded as distinctive in the Philippines and registered as marks for the specified goods:¹⁰

- “WORLD’S PLEASURE AUTHORITY” (for ice cream, water ices, frozen confections, preparations for making the aforesaid goods, confectionery, chocolate, chocolate confectionery)
- “YOUR FIRST LINE OF DEFENSE” (for fire arms, ammunition, spare parts of firearms)
- “KEEP AGE AS A SECRET” (for soap, hair lotions, essential oils).

As regards descriptive, misleading and laudatory phrases and slogans, see item 2.3 and chapter 3, below.

⁹ Examples provided by the Vietnam IP authorities.

¹⁰ Examples provided by the Philippines IP authorities.

2.2 Generic, customary and necessary signs ¹

2.2.1 Generic, customary or necessary words

A sign that consists exclusively or essentially of a word that is a generic, customary, common, scientific or technical name or designation of a particular product or service, or of a category of goods or services, cannot be appropriated in exclusivity by any individual trader as a mark to distinguish such goods or services. Such names and designations need to remain free for use by all competitors in order that they may exercise their trade normally and unfettered by exclusive third-party rights.

Such terms are understood among the interested business circles, consumers and the public at large to identify goods and services *generically*. In practice those designations allow traders to address an offer to consumers in terms that the consumers will understand. The assessment of this ground for refusal necessarily requires consideration of the specific goods or services, or type of goods or services, to which the sign would apply. A term that is common or generic for a particular type of goods or services may be highly distinctive for a different type of goods or services.

For instance, the following words were refused registration in Vietnam on grounds of being generic, customary or necessary for the goods and services indicated: ²

- “COTTON” for cloth, clothing, knitting services
- “VASELINE” for skin care products

This ground for refusal of registration applies not only to the common or standard names of goods and services but also names that have *become* the usual or customary designation, or have linguistically acquired a new meaning for a product or service within a given country, among a significant portion of the relevant population. It is common, for instance, that the younger public in a community will be inclined to invent or coin innovative expressions to designate certain goods or services. Refusal therefore needs to be assessed locally in the context of each particular country or community, and in the language or languages spoken therein.

For example, if the word ‘CHOPP’ has been taken up by a significant number of consumers in a country to designate ‘draught beer’, that term could not be claimed for registration as a mark for beer products or beer-related services in that country.

¹ See the provisions in BN TMA, s. 6(1)(c) and (d); KH TML art. 4(a), TM Manual p. 30; ID TML, art. 5.d); LA IPL art. 23.2; MY TMA, s. 10(1)(d); MM; PH IP Code, s. 123.1(h) and (i); SG TMA s. 7(1)(c) and (d); TH TMA s. 7(2); and VN IPL, art. 74.2.b), Circular 01/2007 s. 39.3.e). Also the OHIM Guidelines, Part B, Section 4, item 2.4.

² Examples provided by the Vietnam IP authorities.

In addition to common or standard terms, *scientific* and *technical* designations of goods or services cannot be registered as marks for the relevant goods or services. Although the general public may not be familiar with such terms, the informed business circles and specialized consumers (e.g. medical doctors, software developers, electronic engineers, etc.) and their suppliers need unrestricted access to the scientific and technical designations used in the trade.

For example, the word 'RESISTOR' might not be known to most ordinary consumers, but has a precise meaning (in English and other languages) for persons that operate in the electronics industry. That term could therefore not be registered as a mark for electronic products and devices, or parts thereof. However, that word could be validly accepted as a mark for other goods, such as clothing and wearing apparel, because the word is not commonly used to designate these goods.

2.2.1.1 Plant variety denominations

A special case of generic designations refers to the designation of *plant varieties* protected under the plant breeder protection system. Protected plant varieties are assigned a specific variety denomination that is reserved to designate plants and material of that variety. In this connection the UPOV Convention provides that a protected variety must be designated by a '*denomination*' that will be its generic designation. Each Contracting Party must ensure that no rights are acquired in the denomination of the variety that could hamper the free use of that denomination in connection with the variety, even after the expiration of the breeder's right.³

A plant variety that is submitted for registration in several countries must be given the same denomination in all those countries. Any person who offers for sale or markets propagating material of a variety protected in a country must use the variety denomination for that material, even after the expiration of the breeder's right in that variety. This means that the denomination of a protected plant variety cannot be registered by any person as a mark for *products of that variety*, not even by the holder of the plant breeder certificate for such variety. If a trademark is used in respect of products (seed, grain, fruit) of the plant variety, it must be clearly recognizable and distinct from the variety denomination.

National plant variety protection laws usually contain similar provisions regarding variety denominations.⁴ Where such provisions apply in the country concerned, the examiner should raise an objection to the registration of a mark consisting of a variety denomination, if the goods specified in the application relate to products of

³ UPOV Convention for the Protection of New Varieties of Plants (1991), Article 20 at http://www.upov.int/upovlex/en/conventions/1991/w_up912.html#_20.

⁴ For example, in **Indonesia** see Regulation N^o 13 of 2004 under Law N^o 23 of 2000 on Plant Variety Protection, article 4(g); in **Laos** see Law on Intellectual Property, article 73; in **Malaysia** see the Protection of New Plant Varieties Act 2004, s. 16; in **Singapore** see Plant Variety Protection Act N^o 22 of 2004, s. 37; in **Vietnam** see Intellectual Property Law No. 50/2005/QH11 of 29 November 2005, article 163.

that variety.

2.2.1.2 International Non-proprietary Names - INNs

A particular case of generic technical terms concerns the names of certain chemical substances that have actual or potential activity for pharmacological purposes listed by the World Health Organization (WHO) as 'international non-proprietary names (known as INNs).

“International Non-proprietary Names (INN) identify pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized and is public property. A non-proprietary name is also known as a generic name. [...] To make INN universally available they are formally placed by WHO in the public domain, hence their designation as "non-proprietary". They can be used without any restriction whatsoever to identify pharmaceutical substances.”⁵

If a sign filed for registration as a trademark consists of, or contains, a term that is entirely or substantially the same as a recommended or proposed INN, and is intended for use in respect of pharmaceutical or medicinal products, the examiner should raise an objection. In case of doubt, the examiner should consult the latest list of INNs published by the WHO.⁶

2.2.2 Generic, customary or necessary figurative signs

Certain figurative signs have, by convention or by custom, a particular meaning that is widely understood in the relevant business circles and by the consumers, or by a significant portion of consumers, in respect of all or specific goods or services. As with common or generic names of goods and services, such figurative signs cannot function as trademarks in respect of the goods or services that they identify.

For example, the following signs are customarily used in the leather industry to indicate that a product is made totally or partly of leather. These devices could not be registered as marks for that type of products or for goods or services related thereto. The registration of such signs for use on other types of goods could be allowed if no other grounds for refusal apply, in particular that the sign must not be deceptive or misleading when used in connection with such other goods:

⁵ See WHO at <http://www.who.int/medicines/services/inn/innguidance/en/> .

⁶ <http://www.who.int/entity/medicines/publications/druginformation/innlists/en/index.html>



[Images taken from <http://www.tandyleatherfactory.com/en-usd/product/kodiak-oil-tanned-cowhide-side-tan-9075-03.aspx> and from <http://www.vse-seniorum.cz/www-vse-seniorum-cz/eshop/4-1-Pece-o-kozy-nabytek/05/20-LM-Strong-silne-znecistení-kuze>]

Likewise, the following sign is customary for barber shop services:



[Example provided by the Philippines IP authorities.]

In Vietnam the following signs were not accepted for registration on grounds that they are generic, customary or necessary for the services specified:



For “Electric building” - Application No. 4-2009-14218



For “communications” - Application No. 4-2010-26087

2.3 Descriptive signs

2.3.1 Generally descriptive signs

A mark that consists exclusively or essentially of a sign that is *descriptive* or presumptively descriptive of the goods or services in respect of which the mark is to be used, should be refused registration for those goods or services.⁷

Signs that describe goods or services cannot function as trademarks for those goods or services because they will not be recognized as a distinct elements indicating commercial origin different from other goods or services of the same description. Such descriptive terms are common elements that need to be available for use by all traders to address consumers with their goods and services and promote the same without obstacles from individual competitors. It is therefore a matter of public policy that descriptive terms remain freely accessible to all persons operating in the marketplace.

A sign is regarded as descriptive for this purpose if it is perceived by the relevant sector of the public or the relevant consumers as providing information about the goods or services for which the mark is to be registered. Such information may refer to, in particular, the nature, kind, subject matter, quality, geographical origin or provenance, quantity, size, purpose, use, value or any other relevant characteristic of the goods or services.

A sign that contains a merely *allusive* reference to some feature of the product or service, or an *indirect* reference to some characteristic of the relevant goods or services, should not be regarded as ‘descriptive’ for purposes of registration.

⁷ See the provisions in BN TMA, s. 6(1)(c); KH TML art.4(a) TM Manual p. 30 and 31; ID TML art. 5.d); LA IPL art. 23.2 Decision 753 art. 40; MY TMA, s. 10(1)(d); MM; PH IP Code, s. 123.1(J) and (L); SG TMA s. 7(1)(c); TH TMA s. 7(2); and VN IPL, art. 74.2.c), Circular 01/2007 s. 39.3.f) and g), s. 39.4.d). Also the OHIM Guidelines, Part B, Section 4, item 2.3.

The reference basis to ascertain whether a sign (word or figurative element) is descriptive should be the common meaning and understanding of the sign by the relevant consumers in the country. As with generic and common designations, this ground for refusal must be assessed in the context of the local language and perception by consumers in the country concerned.

Descriptive terms in foreign languages should be assessed on the basis of the level of knowledge and understanding of those terms by the relevant consumers in the country concerned. If a foreign language or certain terms or expressions in a foreign language are well understood in the country, this ground for refusal should apply in the same way as for terms in the national language.

2.3.2 Descriptive words

Signs consisting of one or more words that describe, in particular, the nature, subject matter, quality, quantity, size, purpose, use or any other characteristic of the specified goods or services should be objected by the examiner.

To be regarded as 'descriptive', a word must always be considered in conjunction with the goods or services for which the mark will be used. Certain words will be descriptive regardless of the goods or services, such as those that relate to value or size (see examples above). In other cases, a word may be descriptive with respect to certain goods or services but distinctive (and therefore registrable) with respect to other goods and services. For example, the word 'COMEDY' would be descriptive as a mark for television programs and broadcasting services. However, the same word would be distinctive as a mark for clothes and wearing apparel, or for cosmetics.

The following are examples of descriptive terms:

- as regards the kind or nature of goods or services: 'RAPILATHER' for soaps and shaving creams that produce foam, '24-SEVEN' for internet banking services, 'SOFTER' for pillows and mattresses;
- as regards the subject matter of goods or services: 'GEOGRAPHY' for books and publications, 'MAGNETIK' for digital data carriers, software, digital publications, etc., 'DRAMA' for television entertainment programs, etc., 'CAR' for vehicle and mechanical repair services;
- as regards the quality of goods or services: 'EXTRA', 'PRIME', 'PREMIUM', 'DELUXE', "GOOD", and 'BEST', for any goods or services; 'LITE', 'FRESH' or 'SKIM' for food products; '14k', '18k' or '24k' for jewellery;⁸

⁸ Examples provided by the Philippine IP authorities.

- as regards the quantity of goods or services: ‘KILOVALUE’ for rice and other cereal grains; “500”, “1000” for pharmaceutical drugs/medicines (describes the milligram dosage content);⁹
- as regards the size of goods or services: ‘FAMILY’, ‘GIANT’, ‘JUNIOR’, for any goods or services;
- as regards the purpose or use of goods or services: ‘UPCUTTER’ for cutting instruments, ‘STRIKE’ for matches and fire-lighting products; ‘SANITARY’ in connection with cleaning and sanitation services, ‘THE FIDUCIARY’ for finance and banking services;
- as regards the value of goods or services: ‘2-for-ONE’¹⁰ in connection with sales and distribution services offering price discounts, ‘50/OFF’ for any goods or services;
- as regards other characteristics of goods or services: ‘FRESH’ for household cleaning products; ‘BRIGHT-N-CLEAR’ for synthetic wall paints; ‘STOUT’ for beers and ales; ‘RUSTOFF’ for metal polishing and care products; ‘TWO LITER’ or ‘TURBO’ for motor engines or motor vehicles; ‘4-GB’ or ‘2-TERA’ for computers and related hardware or software; also ‘3-N-1’, ‘3-in-1’ or ‘3-N-One’ for coffee products (describe that the goods comprise coffee, sugar and cream); ‘125’, ‘250’ for vehicles, particularly, motorcycles (describes the engine size in cubic centimeters); ‘LOW CALORIE’, ‘TASTY’, ‘NUTRITIOUS’ for food; ‘ENERGY SAVER’ for bulbs, fluorescent lamps;¹¹ ‘SMART’ for electronic devices that have processors, are programmable, have automated functions or are capable of processing information.¹²

In Indonesia the following signs were refused on grounds of descriptiveness:¹³

Best Mart for mini-market services

International Standard Academy for educational services

⁹ Examples provided by the Philippine IP authorities.

¹⁰ Example suggested by the Singapore IP authorities.

¹¹ Examples provided by the Philippine IP authorities.

¹² See the Trademarks Manual of Cambodia, p. 36.

¹³ Examples provided by the Indonesia IP authorities.

BESTCHEF for restaurant services

organic water for mineral water

**A
PROPERTY**

for real estate agency and management services.

In Malaysia the following terms were found to be descriptive: ¹⁴

'EXTRASAFE' (01002067 - TAKASO RUBBER PRODUCTS SDN. BHD).

Extra SMS (07022197 -- MALAYSIAN MOBILE SERVICES SDN. BHD.)

'SUPERGUARD' (02001109 -- KAO KABUSHIKI KAISHA (a.k.a. KAO CORPORATION)).

SLIMFIT

SLIM FIT

Slim Fit

for services relating to hygiene and beauty care, beauty therapy, slimming treatment, healthcare, personal rooming, spa services, etc.
- Application N° 03015603

In Vietnam the following terms were found to be descriptive: ¹⁵

¹⁴ Examples provided by the Malaysia IP authorities.

¹⁵ Examples provided by the Vietnam IP authorities.

Perfect

Application No. 4-2011-10424

COOL FRESH

for goods in class 3 - Application No. 4-2011-01628

In Cambodia the following sign was initially refused on grounds of descriptiveness: ¹⁶

Plus⁺soft

for clothing (class 25) - Application No. 42186/11

2.3.3 Spelling variations in descriptive words

The descriptiveness of a word cannot be overcome by a simple variation of the word's standard spelling, by misspelling the word or by using a phonetic equivalent. A phonetic equivalent of a descriptive word will also be treated as descriptive.

For example, to the extent that the word 'bright' would be descriptive for wall paints, the word BRITE would also be descriptive in respect of the same goods. This also applies to spelling variations such as, for example, 'RESIST'NT' (for resistant), 'X-RA-FRESH' (for extra fresh), 'KWIK-GRIPP' (for quick grip), 'EE-ZEE-HOLD' (easy hold), etc.

The following misspelt words were found to be descriptive in Malaysia for the specified goods: ¹⁷

Careklean

for bleaching, cleaning, polishing and scouring preparations, soaps (class 3) (92005280 -- ANTARA ABDI (M) SDN BHD.)

'KLEAN `N' RINSE' for cleaning and soaking solutions for contact lenses (class 5) (93007872 - EXCEL PHARMACEUTICAL SDN.BHD.)

¹⁶ Example provided by the Cambodia IP authorities.

¹⁷ Examples provided by the Malaysia IP authorities.

SURE-LOC

for ironmongery, door locks, cylindrical locks, rim locks, latches, padlocks, floor springs of metal, hinges, door handles, pull and push bars and plates of metal, etc. -- Application 00006118

However, the spelling variation or misspelling of a word may create the required distinctiveness if the word becomes striking, surprising or memorable for the relevant consumers. This may be the case, for instance, where the variation effectively changes the meaning of the word, introduces an alternative meaning or a pun, or otherwise requires the consumer to make some intellectual effort to understand the connection with the basic sense of the word.

For example, the combination 'MINUTE MAID' (which alludes to 'minute made') was found acceptable for a European trademark registration to cover, among other products, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.¹⁸

Likewise, the mark 'XTRA DELIXIOUS' (i.e. 'Extra Delicious') was found to be distinctive in Malaysia due to its spelling variation combined with an unusual visual format:



For various foods and food products - Application N° 05001995 --

[Example provided by the Malaysia IP authorities]

In Vietnam the following sign with a spelling variation was found to be distinctive:



¹⁸ European Community registration N° 002091262, cited in OHIM Guidelines, Part B, Section 4, item 2.3.2.3. The registration can be seen on the OHIM trademark database at <https://oami.europa.eu/eSearch/#details/trademarks/002091262>

For goods in class 5 of the Nice Classification - Application No. 4-2004-03598

[Example provided by the Vietnam IP authorities]

2.3.4 Descriptive word elements

Certain verbal elements that are commonly used as components, prefixes or suffixes to form other words and have a common descriptive or informative meaning, or are commonly used in the language of a particular country, cannot be registered *per se* as marks for goods or services in general, or in respect of which such common use is relevant. Such word elements must remain free from individual appropriation. Due to their descriptive nature, they are not distinctive and would not be able to function as trademarks, either in general or in respect of certain goods or services.¹⁹

For example, the following word elements in the English language generally cannot be registered separately as marks for any type of goods or services, or for certain goods or services in respect of which their meaning is of common use and should not be privatized by an individual trader:

- ‘mini’ : meaning small, reduced size (e.g. for electronic components);
- ‘micro’ : meaning very small (smaller than ‘mini’, e.g. for electronic components; microwave ovens);
- ‘nano’ : meaning very small, minute or related to nanotechnology (e.g. for electronic components or electronic devices);
- ‘mid’, ‘midi’ : meaning at the middle of a qualitative or quantitative range (e.g. for wearing apparel; for products usually offered in distinct sizes or size ranges);
- ‘multi’, ‘poly’, ‘pluri’ : meaning multiplicity, or that the goods (or services) have or contain several or multiple characteristics or possible uses;
- ‘plus’, ‘extra’ : meaning additional or beyond the usual or standard performance or features of a product or service;
- ‘eco’, ‘bio’ : meaning ecologically or organically produced or following certain environmentally friendly standards;
- ‘semi’ : meaning incompleteness of the quality or somewhat partial²⁰ (e.g. for milk and milk products with partial or skimmed fat content).

¹⁹ See the OHIM Guidelines, Part B, Section 4, item 2.2.2.

²⁰ Example provided by the Philippine IP authorities.

The same objection should be raised in respect of other word elements that have a common descriptive meaning in the national language of the country. This ground for refusal will require consideration of the particular perception of the consumers in the country concerned in the languages used locally. It would also require an assessment of the level of knowledge and use of foreign languages (for example, English, Chinese, etc.) by the relevant consumers in the country.

Where a word element is not descriptive in respect of particular goods or services, this ground for refusal will not apply. Moreover, as with descriptive words, this ground for refusal may be overcome in respect of a particular verbal element if the applicant can prove that such element has *acquired* distinctiveness through use in the market and effectively functions as a trademark when used in connection with specific goods or services.

2.3.5 Combinations of descriptive words

The mere combination of descriptive or generic terms will not overcome a finding of descriptiveness. Two words each of which separately taken is descriptive or generic in respect of the relevant goods or services will often be found to be descriptive when combined. The combination of two or more descriptive (or generic) words would therefore remain objectionable if used in connection with the goods or services described.

For instance, in Vietnam the following combinations of descriptive words were found unregistrable:²¹

- ‘GOODCHECK’ for goods in class 5 of the Nice Classification - Application No. 4-2009-16064
- ‘HEAR MUSIC’ for goods in class 9 of the Nice Classification - Application No. 4-2009-18861

Likewise, in cases decided by European Community authorities the following word combinations were found to be descriptive and hence unregistrable:²²

- ‘TRUSTEDLINK’ for software for e-commerce, business consulting services, software integration services and education services for e-commerce technologies and services (judgment of 26/10/2000, T-345/99)
- ‘CINE COMEDY’ for the broadcast of radio and television programmes, production, showing and rental of films, and allocation, transfer, rental and other exploitation of rights to films (judgment of 31/01/2001, T-136/99)

²¹ Examples provided by the Vietnam IP authorities.

²² Examples cited in the OHIM Guidelines, Part B, Section 4, item 2.3.2.2.

- 'COMPANYLINE' for insurance and financial affairs (judgment of 19/09/2002, C-104/00 P)
- 'TELEAID' for electronic devices for transferring speech and data, repair services for automobiles and vehicle repair, operation of a communications network, towing and rescue services and computing services for determining vehicle location (judgment of 20/03/2002, T-355/00)
- 'BIOMILD' for yoghurt being mild and organic (judgment of 12/02/2004, C-265/00)
- 'QUICKGRIPP' for hand tools, clamps and parts for tools and clamps (order of 27/05/2004, T-61/03)
- 'TWIST AND POUR' for hand held plastic containers sold as an integral part of a liquid paint containing, storage and pouring device (judgment of 12/06/2007, T-190/05)
- 'CLEARWIFI' for telecommunications services, namely high-speed access to computer and communication networks (judgment of 19/11/2009, T-399/08)
- 'STEAM GLIDE' for electric irons, electric flat irons, electric irons for ironing clothes, parts and fittings for the aforementioned goods (judgment of 16/01/2013, T-544/11).

However, the combination of a descriptive word with a word or *word* element that is distinctive can render the combination as a whole sufficiently distinctive. In particular, the combination of a descriptive word with an earlier registered mark of the same person will normally avoid a finding of descriptiveness in connection with the same goods or services.

Likewise, a combination of one or more descriptive words with *figurative* elements that are distinctive can render the combination (mixed sign) sufficiently distinctive.

For example, the following mixed signs containing descriptive words or elements in combination with a distinctive visual presentation were considered distinctive in Malaysia:



for mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruits juices, syrups and other beverages (class 32)

04005494 -- CHEONG KIM CHUAN TRADING SDN. BHD.



for beers; mineral and aerated waters, non-alcoholic drinks; fruit drinks and fruit juices; syrups and preparations for making beverages (class 32)
07022647 – TH TONG FOOD INDUSTRIES SDN. BHD.

[Examples provided by the Malaysia IP authorities]

Also, a combination of words that is unusual or fanciful enough to create an impression sufficiently removed from the plain meaning of the basic words could be regarded as sufficiently distinctive. If the combination of two or more descriptive words or elements is itself fanciful, the combination may become sufficiently distinctive.²³

For instance, the following combinations of descriptive elements could be regarded as distinctive:²⁴

- 'YOUTH CODE' for cosmetics;
- 'MR SUSHI' for Japanese food including sushi condiments, spices and all related sushi ingredients.

2.3.6 Geographically descriptive signs

2.3.6.1 General considerations

Geographical signs are names, terms, figurative or mixed signs that indicate or convey a sense of geographical origin. Geographical terms include the names of any geographical location, not only political demarcations but also the names of

²³ See the OHIM Guidelines, Part B, Section 4, item 2.3.2.2.

²⁴ Examples provided by the Singapore IP authorities.

geographic or topographic phenomena including rivers, mountains, deserts, forests, oceans, lakes, etc.²⁵

A sign consisting of or containing a geographical term, or a figurative element that has a geographical meaning or connotation, may be sufficiently distinctive to be recognized and function as a trademark in commerce. However, a geographical sign may be descriptive when used in connection with specific goods or services. In this case, the sign must be refused registration.

For example, 'BOHEMIA' would be geographically descriptive for beer, considering that the region of Bohemia (Czech Republic) is in fact a region where beer is produced. Bohemia is also a region that is known for its traditional crystal products. Therefore the geographical link is *plausible* as regards 'beer' and 'crystal' products. On the basis of that geographical connection, the following marks were refused in Malaysia:²⁶

'BOHEMIA'

for beer products (class 32)
Application N° 92008724 - CERVECERIA CUAUHTEMOC S.A. DE C.V.

Bohemian-Art

for household or kitchen utensils and containers, semi-worked glass, glassware, porcelain and earthenware (class 21)
SOUTHERN POTTERY (M) SDN. BHD -- Application N° 07005436

The descriptiveness of a geographical sign should be assessed in the light of the following main factors:

- (a) the extent to which the relevant sector of the public in the country know or recognize the sign as a geographical term or a sign that indicates a geographical location;
- (b) the extent to which that sector of the public associate the place designated or indicated by the geographical sign with the goods or services specified in the application.

²⁵ See the provisions in BN TMA, s. 6(1)(c); KH TM Manual p. 37 and 38; ID TML art. 5.d); LA IPL art. 23.2; MY TMA s. 14(1)(f); MM; PH IP Code, s. 123.1(j); SG TMA s. 7(1)(c); TH TMA s. 7(2), Notification of Ministry of Commerce 20 September 2004, s. 2; and VN IPL, art. 74.2.c) and e). Also the OHIM Guidelines, Part B, Section 4, item 2.3.2.6.

²⁶ Example provided by the Malaysia IP authorities

If the geographical sign is not known to the public, or is known but is not recognized as an actual or plausible place of origin of the specified goods or services, the sign should not be regarded as geographically descriptive.

The following are examples of geographical names that may be regarded as descriptive in respect of the goods specified:²⁷

‘PARIS’ for clothing and cosmetics;

‘NETHERLANDS’ for alcoholic drinks;

‘ATLANTIC’ for prawn and salmon.

Adjectival forms of geographical names must be assimilated to geographical names and be accepted or rejected on the same grounds of descriptiveness. For example, ‘PARIS’ and ‘PARISIAN’ should both be regarded as geographical terms. Even if the word ‘parisian’ is not the geographical name of any particular place, it will still be regarded as geographically descriptive as it refers directly to the city of Paris in France.

In Vietnam the following sign was refused registration for any goods or services because “Ha Noi” is the name of the capital city of Vietnam:²⁸



Application No. 4-2008-16905

However, the following sign that includes the name ‘Hanoi’ in combination with the distinctive element “TCIC” was accepted. In this context the geographical element “Hanoi” was understood as a geographical information supplement:



Application No. 4-2011-01766

2.3.6.2 Fanciful, arbitrary or suggestive geographical signs

²⁷ Examples provided by the Singapore IP authorities.

²⁸ Examples provided by the Vietnam IP authorities.

A geographical name that does not normally refer to a likely or plausible place of origin of particular products, and cannot be regarded as descriptive of any characteristic of the goods or services by reason of their geographic origin, should not be regarded as geographically 'descriptive' and should not give rise to an objection. The same applies to names that are merely *suggestive* of a particular location or place of origin.

For example, 'MONT BLANC', 'ANNAPURNA' or 'EVEREST' (names of mountain peaks), 'SERENGETI' (name of a desert), and 'NIAGARA' (name of a waterfall) may be registered as marks to distinguish, respectively, writing instruments, apparatus for lighting and heating, eye glasses and lenses, and sanitary appliances and fittings.

The following are other examples of geographical names that are distinctive trademarks for the products specified:

'TICINO' for electric accessories and fittings;

'DUNLOP' for batteries, optical instruments, glasses and lenses.

'TUCSON',²⁹ 'TORINO' and 'PLYMOUTH' for automobiles,

Similarly, 'ALASKA' for milk and other dairy products, and 'MANHATTAN' for clothes and footwear could be admitted for registration.³⁰

Those names do not describe the geographic place of manufacture or production of those products since the link between the goods and the geographical name is arbitrary, fanciful or merely suggestive. They will therefore function properly as marks in trade.

Geographical names of cities, regions, provinces or other locations that are unknown to the relevant consumers and business circles in the country, or that are not known to be, or are unlikely to be, the places of origin or production of the goods (or services) for which the mark will be used, should not be regarded as geographically descriptive, and may be registered as marks. This can be ascertained by establishing whether reference to the geographical name is known or usual in the practice in the relevant trade or business.

For example, the name 'CANTA' that designates a small province in Peru should not be regarded as geographically descriptive (i.e. indicating geographical origin or provenance) if it was used as a brand for scientific, nautical, surveying, photographic, cinematographic, optical, weighing and measuring instruments. In respect of these products, the name 'CANTA' will be perceived by the public as a *fanciful* name, unrelated to the actual or likely geographical origin of those goods.

²⁹ Example provided by the Philippine IP authorities.

³⁰ Examples provided by the Philippine IP authorities.

2.3.6.3 Likely future geographical association

An objection could be raised on grounds of descriptiveness if a geographical sign that is not currently used in the country could, on the basis of an objective analysis, be presumed to be used or to become known in the country as its trade relations develop. This foreseeable association of certain goods with a particular geographical provenance can be assessed by reference to the perception among local business community members, local trade circles and objective data and information available, for instance, on the internet. Such information is current and can be established at the time of the application so it may not be regarded as merely theoretical or speculative.

An objection on these grounds could be raised on the basis of an opposition from interested third parties or foreign government authorities. An objection need not be raised *ex officio* to the extent that the examiner does not have access to the relevant information regarding the geographical name.

However, the merely theoretical or speculative possibility that certain goods or services might, in an uncertain future, originate or proceed from a specific geographical location should not be used as grounds to refuse the registration of a geographical name for reason of geographical descriptiveness.

For example, if Ethiopia is known in the coffee trading circles as a place of origin of quality coffee beans and related products, the name of a particular region or location in Ethiopia could reasonably be presumed to be the place of origin of those products, even if the particular name of that location is not yet known to the relevant sector of the public in the country where registration of that name as a trademark is being sought.

This approach to geographical signs would help prevent the bad faith registration of geographically significant signs, in particular those of foreign countries.

2.3.6.4 Figurative geographical signs

Figurative and mixed signs that are or contain representations of well-known buildings, structures, topographical landmarks and other images may function as indications of geographical origin if they contain a clear reference to a particular geographical provenance. Such figurative signs should be treated in the same way as geographical names and terms, having regard to the relevant goods or services.

Certain images refer clearly to specific countries, regions, cities, or other locations that may be well known to the relevant sector of consumers in a country. For instance, the following figurative signs will establish a *prima facie* presumption that the goods or services proceed or have a connection to the geographical origin associated to the image, namely, France, United States of America, and Japan, respectively:



[Images taken, respectively, from <http://www.clker.com/clipart-la-tour-eiffel-eiffel-tower--4.html>; <http://lossuperinfantes.blogspot.com/2014/02/tipos-de-recursos-ejemplos.html>; and http://homepage2.nifty.com/hsuzuki/wallpaper/e_04_fuji_01.htm

The following figurative sign was not allowed in Vietnam for any goods or services because it represents a famous landmark pagoda in Hanoi that consumers would perceive as indicating geographical origin:



Application No. 4-2010-17717

[Example provided by the Vietnam IP authorities]

The following are examples of *mixed* marks containing figurative elements that may be recognized as direct reference to a geographical location:³¹

³¹ Examples provided by the Philippine IP authorities.



The outline, shape or map of a country, when clearly recognizable, should also be regarded as a geographically descriptive sign. For example, the flag-map of Thailand below is a geographically descriptive sign:



[Image taken from: http://commons.wikimedia.org/wiki/File:Flag-map_of_Thailand.png]

To decide whether a figurative or a mixed sign would be geographically descriptive or geographically deceptive, the examiner must have regard to the goods or services specified in the application and consider the perception and knowledge of that geographical sign by the relevant consumers.

In connection with geographically *descriptive* signs see item 2.3.6.1, above. As regards signs that are geographically *deceptive* or misleading, see item 3.2, below.

2.3.6.5 Geographical signs that indicate true geographical origin or link

Certain geographical signs indicate a true geographical origin or geographical connection. This may result from reasons relating to the original place of

establishment or the place of current commercial activity. If those signs have acquired distinctiveness or secondary meaning through use they may be accepted for registration as marks.

Where the law so provides in respect of signs consisting of or containing the name of a country, the examiner may request the applicant to submit evidence that the competent authority of that country has given consent to the registration of the mark.

The following are examples of signs that contain geographical terms but should not raise an objection on grounds of being 'geographically descriptive'; these signs are distinctive and may be allowed for the goods and services indicated:

'SINGAPORE AIRLINES', 'BANGKOK AIRWAYS' and 'SWISS' for air transportation services;

'MINNESOTA RUBBER' for moulded products made of rubber or plastic for industrial use;

'MYANMAR' and 'MANILA' for beer products;

'YOKOHAMA' for tyres and related rubber products;

'OERLIKON' for hand tools and electric welding tools;

'ZURICH' for insurance and financial services;

'VAUXHALL' for motor vehicles;

Where the applicant has no connection with a geographical location contained in the mark filed for registration the examiner may, if the sign would be descriptive or deceptive, raise an objection and request evidence of acquired distinctiveness to overcome the objection.

A sign consisting of or containing the *map* or *outline* of a country will also indicate true geographical origin. In this connection, see also item 2.3.6.4, above.

As regards signs that are geographically *deceptive* or misleading, see item 3.2, below.

2.3.7 Laudatory expressions and other signs

Laudatory terms express desirable or superior characteristics of the relevant goods or services. They apply or refer directly to the goods or services, which are thus qualified or described by the term.

Laudatory expressions should be treated as descriptive terms, regardless of whether they are true, verifiable, speculative, exaggerated, implausible or outright false. As descriptive signs, they should be refused registration as trademarks.

Examples of laudatory expressions that should be objected as descriptive include: 'SUPER', 'SUPREME', 'BEST', 'EXTRA FINE', 'FIRST', 'PRIME', 'MODERN', 'ULTIMATE', 'PREMIUM'.

A term that is merely of a general, positive connotation but that does not directly 'describe' the goods or services should not be regarded as descriptive for these purposes. For instance, words such as 'HEAVENLY', 'KUDOS', or 'GLORY' should not be regarded as laudatory or descriptive.

With respect to laudatory phrases and slogans, see also item 2.3.8, below.

A *figurative* sign may also be regarded as laudatory and descriptive. For example, the following figurative sign was found to be descriptive as it is generally understood by the public as meaning "good", "optimal", "number one":



for "paper" - Application No. 4-2004-01831

[Example provided by the Vietnam IP authorities]

2.3.8 Descriptive advertising phrases and slogans

An advertising phrase or slogan should be refused registration as a trademark if the phrase is descriptive. Such is the case where the phrase directly conveys information about the relevant goods or services, in particular with reference to their nature, kind, quality, intended purpose, commercial value, cost or other characteristics of the goods or services or of their supply to the public.³²

The same ground for refusal will apply if the phrase or slogan is *laudatory* or otherwise describes or extolls real or alleged quality, advantages or other characteristics of the goods or services.

Examples of descriptive or laudatory slogans include:

³² For instance, see the OHIM Guidelines, Part B, Section 4, item 2.2.6.

“Melts in your mouth, not in your hands” (for chocolate products)

“We put safety first” (for motor vehicles and parts)

“First of the class”

“Number one – now and always”

“Buy the Number One in the market”

“Coffee/chocolate/fruit product ... at its best!” (for coffee, chocolate or fruit)

“Only the best for you!”

“We do fashion like no others” for clothing, glass, jewellery [Example provided by the Vietnam IP authorities]

A descriptive or laudatory slogan or phrase may be rendered distinctive by the inclusion of sufficiently distinctive word or figurative elements. For example:



01008384 - US POINT VISION CARE GROUP SDN. BHD.

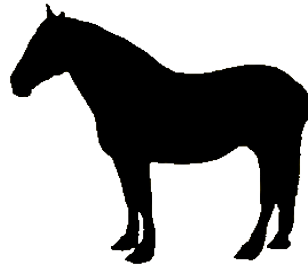
[Example provided by the Malaysia IP authorities]

2.3.9 Descriptive figurative signs

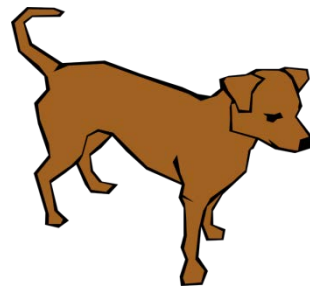
Figurative signs that are descriptive in respect of specific goods or services should be objected as trademarks for those goods or services. In this connection, the same rationale applies as for descriptive word signs.

A figurative sign should be regarded as descriptive where it consists of an identical representation of the relevant goods (or services), or it does not depart sufficiently from such identical rendering. A figurative should give rise to an objection on grounds of descriptiveness if it clearly depicts the nature, kind, use, purpose or other characteristic of the goods or services.

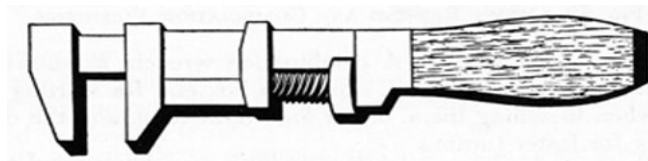
The following are examples of figurative signs that should be regarded as descriptive in connection with the goods or services indicated:



for horse-riding equipment, or horse transportation vehicles [image taken from http://funny-pictures.picphotos.net/animal-silhouette-silhouette-clip-art/funny-clip-art-cool-drawings.com*image-files*animal-silhouette-horse.gif/]



for dog food products [image taken from <http://www.clipartbest.com/dog-drawing-pictures>]



for hand tools and power-tools [image taken from <http://hnsa.org/doc/tools/>]



for noodles and vermicelli (class 30)
00009185 - CHEAH PAK FOO T/A FOO WON MEE MANUFACTURER

[Example provided by the Malaysia IP authorities]



for hotels services

This sign would be understood as “five stars”, which is a standard device used to describe quality in the hotel industry.

[Example provided by the Vietnam IP authorities]

A figurative sign that is markedly different from the usual aspect or shape of the relevant goods or of good related to the specified services, or is *stylized* in a manner that significantly departs from the standard, identical representation of the goods or services, should not be regarded as ‘descriptive’ and should be allowed. The same applies to figurative devices that are merely allusive or *evocative* of certain characteristics of goods or services.

For example, the following figurative signs would not be regarded as descriptive of the specified goods or related services:



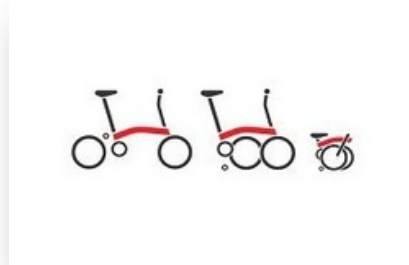
for animal accessories and veterinary services.

[Image taken from <http://www.clipartbest.com/quarter-horse-face-silhouette>]



for hand tools and power-tools, or mechanical repair shops.

[Images taken from <http://www.pd4pic.com/wrench/>]



for locks and security locks, and for bicycles, folding bicycles and bicycle parts, respectively.³³



for pickles; processed vegetables and fruit, canned fruits and vegetables; edible oils and fats; poultry and games; meat and meat extracts (class 29).
02001898 - STC CATERERS SDN. BHD.³⁴

In Vietnam the following sign was accepted because of its unusual distinctive presentation, in spite of the fact that the figure of a weasel is regarded as descriptive for certain types of 'coffee' and 'coffee products' in that country:³⁵

³³ Examples provided by the Philippines IP authorities.

³⁴ Example provided by the Malaysia IP authorities.

³⁵ Example provided by the Vietnam IP authorities.



for 'coffee' or 'coffee products' - Application No. 4-2008-01941

2.4 Names and likenesses of persons

2.4.1 Names of persons and companies

A mark may consist, in whole or in part, of the name of an individual person or of a legal entity such as a corporation, limited liability company, foundation or a not-for-profit organization (foundation, club, cooperative, etc.). It may also consist of a portrait or likeness of a particular person.¹

The name (first name, surname or full name) of an individual person should be regarded as inherently distinctive, regardless of the commonality of its occurrence in the country concerned. In this case, a first-come-first-served approach would apply, taking into account the rule of speciality as regards the goods or services covered by the mark. For example, the name 'MILLER' may be registered as a mark for certain goods or services by one person and the same name registered for different goods or services by a different person.

To the extent that a name is distinctive for the specified goods or services, it may be registered as a mark regardless of its presentation or style. This may be in standard characters, a special font or a figurative device.

Where the sign consists of a name that does not correspond to that of the applicant, the examiner may require that the applicant submit proof of consent from the person named or from that person's legal representative (see Part 2 of these Guidelines regarding third-party rights in a name).

For example, the following personal names are distinctive and may be registered as trademarks:

Jim Thompson

 **pierre cardin**

YVES SAINT LAURENT

¹ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 31; ID TML art. 1.1; LA IPL art. 23.7; MY TMA, s. 10(1)(a) and (b); MM; PH IP Code, s. 123.1(c); SG TMA s. 2(1) – 'sign' and 'mark', TMR r. 14; TH TMA s. 4 – 'mark'; and VN IPL, art. 73.3, Circular 01/2007 s. 39.4.f).



04019735 – Registered - RAMLY FOOD PROCESSING SDN. BHD. ²

The same applies to the *portrait, likeness* or semblance of an individual person. A sign consisting of a person's likeness should be regarded as inherently distinctive and may be registered as a mark.

Issues regarding possible conflicts of rights over the use of personal names, titles or likenesses as marks, in particular as regards those of famous living persons, pertain to the area of *relative* grounds for the refusal or cancellation of trademark registrations. (See Part 2, chapter 8, of these Guidelines.)

The name of a famous or well-known deceased person may also be taken up as a trademark. For example, the following names could be registered as trademarks for the goods mentioned, if the law does not restrict or prohibit their use as marks:

- 'BOLIVAR' (from Simon Bolivar, a South American 19th century freedom fighter) for surgical, medical, dental and veterinary apparatus and instruments,
- 'DARWIN' (from Charles Darwin, an English 19th century scientist) for processed fruit and vegetable products,
- 'BACH' (from Johann Sebastian Bach, a 17th century German composer) for chocolate and confectionery products.

The law may restrict or prohibit the registration of the names of certain deceased persons, for reasons of public order, morality or respect to such persons' memory. This will depend on the tradition, history and policy of the country concerned, the time elapsed since the passing of the personality in question and the perception and sensitivity of the public in that country. An objection may also be raised on behalf of a minority population within the country or for respect towards personalities that are revered or otherwise have a special status in another country.

² Example provided by the Malaysia IP authorities.

For example, in certain countries names such as SUKARNO, LADY DIANA, CHÉ GUEVARA or EINSTEIN may not be allowed registration as trademarks.³ Where such names are included in a trademark application the examiner should evaluate the case and, if required, raise an objection against the registration.

The *trade name* of a legal entity such as a corporation, limited liability company, foundation or the name of a not-for-profit organization (foundation, sports club, cooperative, etc.) can be registered as a trademark if the name is distinctive when used in connection with the relevant goods or services. Distinctiveness may be inherent or acquired.

It is often the case that the distinctive portion of the trade name of a company is also used as its 'house mark' or basic trademark used in connection with the company's goods and services. For example, the marks 'BAYER' (from Bayer A.G.), 'TOYOTA' (from Toyota Motor Corporation) and MANCHESTER UNITED (from Manchester United Football Club) are distinctive.

The same applies in respect of the names of organizations and *institutions* that will normally be inherently distinctive and registrable as trademarks. For instance, ESA (European Space Agency) or MIT (Massachusetts Institute of Technology) could be registered as marks.

2.4.2 Fanciful names and characters

A mark may consist of a *fanciful* name or the image of a *fictitious character*. Such signs will normally be inherently distinctive as they would have been coined *ad hoc* to serve as brands.

If the sign consists of a name or a character in respect of which the examiner has a doubt as to whether the sign is fanciful or fictitious, the examiner may require that this fact be clarified or stated in the application.

The following is an example of a brand consisting of a fanciful name and a fictitious character:

³ For example, the Brunei TMA, s. 7(c) prohibits the registration of any trademark that consists of or contains a "representation of His Majesty the Sultan or any member of the Royal family, or any colourable imitation thereof".



[Image taken from <http://juanvaldez3.blogspot.com/2012/06/quienes-somos.html>]

2.5 Distinctiveness resulting from a combination of elements

A sign that on its own is not distinctive, or is generic or descriptive, can avoid these grounds for refusal if it is combined with a sign or element that is inherently distinctive, and both are used in combination as *a whole*. In this case, the registration would be accorded for the combination and not for its individual non-distinctive elements.

The following are examples of signs that would be unregistrable on their own for lack of distinctiveness, but could be allowed when combined with a distinctive sign:

‘RAPILATHER’

‘*GILLETTE RAPILATHER*’

for soaps and shaving creams that produce foam

‘SOFTER’

GUNILLA - Softer Bed Gear

for pillows and mattresses;

‘EXTRA’

‘*ARIEL Extra*’

for laundry soaps and detergent products;

‘GIANT’

‘**KELLOG’S Giant Servings**’

for cereal food products;

'COLLAGEN'



for bone and joint reinforcing food supplements and medicinal products [Image taken from <http://www.naturallife.com.uy>];

'EXPERT IN BONE NUTRITION'

'ANLENE'
EXPERT IN BONE
NUTRITION'

for milk and milk products;

'SUPER'

'SAN MIG COFFEE SUPER'

for coffee products;

'HEALTHY WHITENING'

'LISTERINE'
HEALTHY WHITENING'

for cosmetic tooth whitening mouthwash;

'TERIYAKI'



for restaurant services; ⁴

ECO
MIND

for goods in classes 3 and 5 of the Nice Classification

[Application No. 4-2012-01957] ⁵



for wine products [Images taken from http://www.oempromo.com/Homecare-and-Houseware/Wine/index_7.htm and <http://www.liberty-laser.com/html/gallery.html>]



⁴ Example provided by the Philippines IP authorities.

⁵ Example provided by the Vietnam IP authorities.

for cat and pet food [Images taken from <http://www.jeremynoeljohnson.com/my-thoughts/dem-cats/> and <http://pubpages.unh.edu/~mpx52/catsupplies.html>]

In order that a non-distinctive, generic or descriptive sign may become registrable if presented in a distinctive form or combined with a distinctive element, such form or element should *itself* be *sufficiently distinctive*. A combination or presentation that is not on the whole sufficiently distinctive will not overcome an objection on grounds of non-distinctiveness or descriptiveness.

Consumers confronted with a sign consisting of a combination of a word element and a figurative element will tend to focus mainly on the word element rather than the figurative element. If the word element is not distinctive, the figurative element will need to be highly distinctive in order to raise the combination as a whole to the required level of distinctiveness. A figurative element that does not convey any 'trademark message' to the consumers will not function as a distinctive sign and its combination with a non-distinctive word element would not be registrable.

The following rules should be applied in assessing whether a combination of a non-distinctive word sign with a figurative element will make the combination sufficiently distinctive:

- A simple change of letter style, font or colour will not be enough to make a sign distinctive. For example:

‘PRIME’

PRIME

- The figurative element combined with a non-distinctive word element should not consist of any of the following, in particular, as these elements will not introduce the required distinctiveness:
 - a simple, basic shape,
 - a decorative accessory or discrete detail,
 - a background pattern,
 - a device that is descriptive with regard to the relevant goods, their container or packaging, or their point-of-sale,
 - a frame, box, label or shape that is commonly used in trade and will not be noticed or recognized as a trademark by the average consumers.

For example, the following combinations would not be sufficiently distinctive:

‘100% NATURAL’



for cosmetic or health care products

[Image taken from <http://www.foodnavigator-usa.com/Markets/Natural-Clean-Label-Trends-2013-Who-s-driving-the-agenda-From-Simple-Truth-to-Open-Nature>]

‘RIESLING’



for wine products

[Image taken from <http://www.winelabels.org/artmake.htm>]

‘BIOMEDICAL’

‘BIOMEDICAL’



for medicinal and health products and services

[Image taken from <http://www.clker.com/clipart-swoosh-red.html>]



'FRESHLY FRUIT'

'FRESHLY FRUIT'

for fruit juices, jams and fruit products

[Image taken from <http://www.realsimple.com/food-recipes/shopping-storing/food/guide-to-organic-labels-10000000696097/>]

2.6 Acquired distinctiveness

2.6.1 Acquired distinctiveness and 'secondary meaning'

Signs that are not inherently distinctive, or are generic, commonplace or descriptive with regard to the specified goods or services, should in principle be refused registration. Those signs cannot function as marks as all competitors need to be able to use them freely in the course of trade. They cannot not be appropriated or controlled exclusively by any particular trader.

However, this *a priori* ground for refusal may be overcome in respect of certain signs if it can be proven that the sign has *acquired distinctiveness through use* in the market and effectively functions as a trademark when used in connection with the particular goods or services.¹

This special case is an exception to the rule that non-distinctive, generic and descriptive signs cannot be accepted as marks because they do not function as badges of commercial origin. If evidence shows that -- notwithstanding its initial absence of inherent distinctiveness -- a sign has come to be recognised as a trademark by the consumers and effectively functions to indicate commercial provenance in respect of particular goods or services, that sign could be registered as a mark for those goods or services.²

Acquired distinctiveness may also be characterized as a case of '*secondary meaning*' acquired by such signs. This means that -- for specific goods or services -- the primary, common meaning of the sign has been superseded by a new, 'secondary' meaning of the sign as an indication of commercial origin in the minds of the consumers. This secondary meaning allows the sign to function effectively as a mark in the marketplace.

A sign may acquire distinctiveness as a result of continuous use of the sign as a trademark in connection with the particular goods or services. This may be supported by consistent advertising and awareness activity by the trademark holder aimed at educating the public and the consumers that the sign is a badge of commercial origin of specific goods or services.

As with any other sign, acquired distinctiveness must be assessed taking into account the meaning of the sign in the languages that the relevant consumers

¹ For instance, the TRIPS Agreement, Article 15.1 provides that "Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on *distinctiveness acquired through use*." [emphasis added]

² See the provisions in BN TMA, s. 6(1) proviso; KH TM Manual p. 29; MY TMA s. 10(2B)(b); MM; PH IP Code, s. 123.2; SG TMA s. 7(2), TM Manual chapter 6 'Evidence of distinctiveness acquired through use'; TH TMA s. 7 third paragraph and Notification of Ministry of Commerce of 11 October 2012, clause 2; and VN Circular 01/2007 s. 39.5. Also the OHIM Guidelines, Part B, Section 4, item 2.12.

understand. This may vary within a country depending on the sector of consumers involved and the type of goods or services for which the mark is used.

For example, the following mark used consistently in a distinct shade of orange has become distinctive for the goods and services of the Migros company operating in Switzerland and neighbouring countries:



[Image taken from <http://www.migros.ch/fr/medias/logos.html?currentPage=2>]

Likewise, the following mark was allowed for registration in Malaysia on evidence that the mark had acquired distinctiveness (secondary meaning) through use:

A logo for 'Secret Recipe' featuring the words 'Secret Recipe' in a cursive script and 'Fine Quality Cakes' in a serif font below it. The text is centered and appears to be part of a larger graphic design.

Application N° 97009666 – For *cakes and bread*.

[Example provided by the Malaysia IP authorities]

Acquisition of distinctiveness through use will, however, not apply to signs that are functional or defined by a technical effect or advantage. Such signs must, as a matter of policy, remain free from exclusive appropriation by any individual trader. An exclusive right in a device that provides a functional effect or a technical advantage can only be obtained through a patent of invention (petty patent or utility model patent, where applicable) (see item 2.1.5.2, above).

2.6.2 Proving acquired distinctiveness

An applicant may invoke acquired distinctiveness to overcome an objection raised by the examiner on grounds that the sign is non-distinctive, generic or descriptive. The applicant would bear the burden of proof, but the examiner can supplement the evidence submitted by the applicant with any relevant information obtained from other sources.

Acquired distinctiveness must be proven as of the date of filing of the application for registration of the mark. The evidence must show that, on the filing date, the sign was already distinctive in the country in respect of the relevant goods or services. This cut-off date results from the fact that the filing date of an application determines its priority in case of conflict with prior or intervening rights.

As with inherent distinctiveness, acquired distinctiveness must be assessed in the light of the actual or presumed perception of the relevant average consumer. This refers to the sector of consumers to whom the goods or services bearing the sign are addressed, including both actual and potential customers in the country concerned.

To succeed with a claim of acquired distinctiveness, the examiner must be persuaded “that a *significant proportion* of the relevant public for the claimed goods and services in the relevant territory see the trade mark as identifying the relevant goods or services of a specific undertaking, in other words, that the use made of the mark has created a link in the mind of the relevant public with a specific company’s goods or services, regardless of the fact that the wording at issue would lack the distinctiveness to make this link had such use not taken place.”³

All means of *evidence* will be acceptable as indications that the sign is recognized as a mark and is associated with a particular commercial origin in the country concerned. Usual types of evidence for this purpose include, among others:

- figures of turnover and sales in the country,
- figures of investment in advertising in the country,
- consumer and market surveys,
- reports from business associations and consumer organizations,
- reports on the type, scope and extent of advertising campaigns,
- documents evidencing the advertisements and promotional campaigns in the media,
- catalogues, price lists and invoices,
- management reports.

³ See the OHIM Guidelines, item 2.12.7.

Evidence should include samples of the mark as it is actually used in trade in the country in connection with the goods or services. Evidence of use of the sign together with other marks would be acceptable provided it is clear that the consumers attribute an indication of commercial origin to the sign for which registration is sought. It should be demonstrated that the sign has been used continuously or only with interruptions that can be explained and justified. Sporadic use would be unlikely to make a sign distinctive or to acquire secondary meaning.

The examiner must assess the evidence as a *whole* since it is unlikely that a single piece of evidence will unambiguously prove acquired distinctiveness or secondary meaning. However, the examiner can extrapolate the evidence available to arrive at a conclusion that a significant portion of the relevant public effectively recognise the sign as a trademark.

3 Deceptive signs

3.1 General considerations on deceptive signs

A sign that is deceptive or misleading when used in respect of specific goods or services cannot be registered as a trademark for those goods and services.⁴

A sign will be regarded as deceptive when its use in trade in respect of the relevant goods or services would convey false or misleading information about such goods and services. The deceptive or misleading character of the sign must be clear and direct if the mark were applied to the relevant goods or services. In this regard, the deceptive or misleading information conveyed by the sign can refer, in particular, to the nature, subject matter, quality, geographical origin or provenance, quantity, size, purpose, use, value or other relevant characteristics of the goods or services.

Signs that are merely evocative or allusive of a possible or speculative characteristic of the goods should not give rise to an objection of deceptiveness. For example, a sign that includes the word 'DELICATE' should not be regarded as deceptive for foods products that are not fat-free or cholesterol-free on the argument that such foods cannot be regarded as 'delicate'. The mark 'DELICATE' would be regarded as a fanciful sign or a sign merely allusive to other characteristics of the specified goods.

An objection to registration should be decided not only when the sign has actually caused consumers to be deceived or misled but also when it is found that there is a *reasonable risk* or a *likelihood* that the consumer will be deceived or misled if the mark is used in trade.

When assessing the deceptiveness of a sign the examiner should proceed on the following assumptions:

- (a) The owner of the mark will not deliberately seek to deceive the consumers when using his mark; rather, if the sign can be used in a way that does not cause consumer deception, it may be presumed that the sign will be used in that way.
- (b) The average consumer is reasonably attentive and circumspect, and not easily liable to deception. A sign should be objected on grounds of deceptiveness only when it is clearly in contradiction with the characteristics of the specified goods or services and this would frustrate a *legitimate expectation* from the consumer based on the *prima facie* meaning of the mark as used in connection with the relevant goods or services, and considering the usual market practices and consumer perception within that market.⁵

⁴ See the provisions in BN TMA, s. 6(3)(b); KH TML art. 4(c); ID TML art. 5.a); LA IPL art. 23.3 and 4; MY TMA, s.14(1)(a) and TMR, r. 13A(c) and (d); MM; PH IP Code, s. 123.1(g); SG Act s. 7(4)(b), TM Manual chapter 12 - "Deceptive Marks"; TH TMA s. 8(9); and VN IPL, art. 73.4 and 5. Also the OHIM Guidelines, Part B, Section 4, item 2.7.

⁵ In this respect see, for instance, the OHIM Guidelines, Part B, Section 4, item 2.7.1.

In applying the *first assumption* under item (a) above, an objection should not be raised if the specification of goods or services is broad enough to allow the mark to be used for goods and services in respect of which the sign would not be deceptive or misleading. Conversely, if the list of goods and services is confined to a short number of specific goods or services and the sign would be deceptive or misleading in respect of all the specified goods and services, an objection must be raised.

For example, a mark containing the word 'GOLD' could be registered for 'watches and chronometric instruments', since such products may or may not be made of gold. However, the same mark should not be accepted for a specification of goods that is confined to 'fanciful and non-precious jewellery' because the sense of the word 'gold' in the mark would be in direct contradiction with the nature of the only goods on which the mark will be used.

Similarly, the mark "The Coffee Bean & Tea Leaf" may be registered for use in connection with goods and services different from just coffee or tea, for example fresh fruit juices. Such use will not be deceptive for the relevant public.⁶

In applying the *second assumption* under item (b) above, a mark containing a word should not be objected in respect of goods for which use of the mark would not give rise to any expectation about the goods because the word is conceptually unrelated to those goods. Where the specification in the application includes a variety of different goods and services, the examiner should only raise an objection in respect of those specific goods and services for which the use of the mark would clearly be deceptive or misleading. The rest of the goods or services could be maintained and the mark could be registered with an amended specification.

For example, the mark 'BLUE MOUNTAIN BEER' applied for the following goods:

beers, ales;

beer substitutes;

mineral waters,

other non-alcoholic beverages;

fruit beverages and fruit juices;

syrops and preparations for making beverages'.

This mark could be regarded as deceptive or misleading in respect of 'beer substitutes' to the extent that consumers would expect the mark to identify 'beers' and not products that seem to be, but are not, beers.

An objection could also be raised in respect of 'ales' if the mark 'BLUE MOUNTAIN BEER' used on ales would, in the country concerned and considering the perception

⁶ Example provided by the Indonesian IP authorities.

and habits of the average consumers of beers and ales and the manner in which those goods are usually offered or presented in shops, be likely to give rise to erroneous purchase decisions among those consumers (i.e. buying ale mistakenly believing it is beer).

Similarly, the mark “ABC Banana Chips” would be acceptable for registration in respect of ‘chips’ generally. However, if the list of goods included ‘mango chips’ specifically, an objection of deceptiveness should be raised in respect of these goods.⁷

3.2 Geographically deceptive signs

A sign that contains an element that is a geographic term or has a geographic connotation should only be refused if that element makes it likely that the relevant consumers will be misled as to the true geographical origin or provenance of the goods or services.

The ‘true’ geographical origin of the goods could be given by an explicit reference in the list of goods and services submitted by the applicant, or could be based on the common knowledge and reasonable perception of the relevant sector of consumers.

For example, a sign containing the words ‘PEPITA – CAFÉ DO BRASIL’ would be objectionable to the extent that the mark was used on coffee that does not originate in Brazil. This would be the case if the specification of goods for the mark expressly mentioned coffee of an origin different from Brazil, for example, ‘coffee blends from African coffee beans’. Conversely, if the specification of goods refers broadly to, for example, ‘coffee and coffee products’, the mark would not *a priori* convey any deceptive or misleading message. In this case the examiner should presume that the mark will in fact be used on coffee and coffee products originating from Brazil.

However, if in a particular case the examiner finds that -- for the relevant public in the country concerned -- the geographical reference contained in the sign is strong enough to convey an erroneous perception regarding the origin of the goods, the examiner may raise an objection or request for a qualifier to be endorsed with the application. The examiner may, for instance, require that the specification of goods clearly state that the “coffee and coffee products” originate from Brazil.

(If after its registration the mark is used in trade in a manner that is deceptive or misleading for consumers, other action may be taken under the applicable law, including the invalidation or cancellation of the registration or a prohibition to use the mark).

A case of deceptiveness would arise if, for example, an application to register the mark “KALINGA GOLD” was filed for coffee products made with coffee that does not originate from the organic coffee-producing region of Kalinga, in the north of the Philippines.⁸ That mark would be inevitably deceptive if used for goods that do not

⁷ Example provided by the Singapore IP authorities.

⁸ Example provided by the Philippines IP authorities.

correspond to those that the relevant public in the Philippines would normally expect if presented with coffee products bearing that mark.

For example, the mark “SWISSTIME” should be regarded as deceptive if applied to watches or timepieces having no connection with Switzerland.⁹ The relevant public will assume that the geographical element ‘Swiss’ indicates a true connection to that country and would be deceived if such connection did not exist.

Signs that are *merely evocative* or allusive of a possible or speculative geographical origin of the goods should not give rise to an objection of deceptiveness. For example, a mark for wearing apparel or for specialty foods consisting of a foreign name -- such as ‘TOSHIRO’, ‘ANNUNZIATA’ or ‘BORIS -- should not be regarded as misleading merely because those names may evoke a link to, respectively, Japan, Italy or Russia.

As regards *figurative* or *mixed* signs representing recognizable well-known monuments, structures, buildings or topographical landmarks, such signs could be totally or partly deceptive depending on the impression and perception of the average consumer of the goods or services to which the mark applies. If the mark contains an image that refers to a particular country, region or location that is a plausible geographical origin for the specified goods, and the specification *expressly* indicates that the goods have a different provenance, the mark should be regarded as deceptive.

For example, the following mark contains clear references to a geographical location, namely the city of Paris, in France (Europe).¹⁰ If the specification of goods for that mark is limited to cover only “perfumery, essential oils and cosmetic products of Asian origin”, the mark could be objected on grounds of deceptiveness. The public would be deceived because there would be a contradiction between the information conveyed by the sign (i.e. that the plausible origin of the goods is the city of Paris) and the actual place of origin of the goods (i.e. Asia as specified in the application).



⁹ Example provided by the Philippines IP authorities.

¹⁰ Example provided by the Philippines IP authorities.

Likewise, the following mark contains a clear indication of a geographical location, namely the city of Rome, in Italy (Europe).¹¹ If the specification of goods for that mark were to cover specifically “coffee and coffee products produced in Colombia”, an objection should be raised on grounds of deceptiveness to the extent that Italy is well known as a place of coffee roasting shops and coffee products, and the reference to Rome is a plausible true origin in the mind of an average coffee consumer.



In Vietnam the following devices were regarded as geographically deceptive when applied to goods not originating from the countries indicated in the signs: ¹²



for micro, television, mobile phones - Application No. 4-2012-28009



Application No. 4-2008-20839

¹¹ Example provided by the Philippines IP authorities.

¹² Examples provided by the Vietnam IP authorities.

In Indonesia the following signs were refused registration because they reproduced the names of foreign countries without the required authorisation: ¹³



for goods in class 25 of the Nice Classification

TURKEY

for goods in class 29 of the Nice Classification

3.3 Signs with a deceptive reference to official endorsement

A sign should be refused registration as a mark if it contains an express indication or a clear, unambiguous implication that the goods or services have received official authorization or endorsement from an identifiable public body, official authority or statutory organization. ¹⁴

A sign that refers to a fictitious institution or has the appearance of official endorsement by a general reference a status or a State, would not be sufficient reason to regard the sign as deceptive.

For example, a sign containing the words 'AUTHORITY CHECK', 'EXPORT QUALITY' ¹⁵ or 'INTERNATIONAL STANDARD' does not refer specifically to any particular authority or institution and should not be regarded as deceptive.

On the other hand, a sign containing, for example, the words 'HALAL APPROVED', 'ISO CERTIFIED' or 'BSI - CHECK' should not be admitted for registration if the organizations named in those marks or competent to issue marketing clearance have not given their express consent. Where the law provides for statutory restrictions regarding third-party registration of signs containing such names or abbreviations, the examiner may disallow registration even if the applicant managed to obtain consent from the organizations concerned.

¹³ Examples provided by the Indonesia IP authorities.

¹⁴ For instance, see ID TML art. 6(3).c); LA IPL art. 23.3, Decision 753 art. 41; SG TMR r. 13; TH TMA s. 8(8); VN IPL art. 73.4.

¹⁵ Example provided by the Philippines IP authorities.

In Malaysia similar cases for refusal include marks containing the words ‘HALAL’ and ‘BUATAN MALAYSIA’.¹⁶

In Vietnam the following signs were not accepted on grounds that they are deceptively allusive to compliance with standards:¹⁷

- “JAPAN TECHNOLOGY”
- “STANDARD GERMANY”



Likewise, a mark consisting of or including, for example, the expression ‘ORGANIC CERTIFIED’¹⁸ could be understood to indicate that the product has been checked for conformity with organic production standards by some competent official authority. Where such is not the case, the examiner should object to the registration of that mark for any goods or services.

If a sign filed for trademark registration consists of or includes an earlier sign that is protected by a third party as a (publicly or privately-owned) certification mark, quality control sign or other standard compliance indicator, the examiner should raise an objection *ex officio* or upon opposition. In this connection, see in Part 2 of these Guidelines, chapter 2 regarding earlier registered marks and chapter 4 regarding earlier unregistered marks.

4 State and official signs, emblems and other symbols

4.1 Signs under Article 6ter of the Paris Convention

¹⁶ Example provided by the Malaysia IP authorities.

¹⁷ Examples provided by the Vietnam IP authorities.

¹⁸ Example provided by the Philippines IP authorities.

Signs containing official signs, emblems and other symbols of States or intergovernmental organizations cannot be registered as trademarks unless the applicant submits evidence that the State or organization concerned has given authorization for such registration. In particular, the following official signs are concerned:¹⁹

- armorial bearings of States,
- flags of States,
- other emblems of States,
- official signs and hallmarks of control and warranty adopted by States,
- names and abbreviations of international intergovernmental organizations,
- armorial bearings of international intergovernmental organizations,
- flags of international intergovernmental organizations,
- other emblems of international intergovernmental organizations,
- any heraldic imitation of the foregoing.

This ground for refusal is based on the provisions of Article 6*ter* of the Paris Convention that establishes a procedure for the reciprocal communication of the emblems and official signs of States, and of the names and emblems of intergovernmental organizations. The signs and emblems communicated through the Article 6*ter* procedure can be found on the 6*ter* database accessible online on the WIPO website.²⁰

National IP authorities are required to protect *ex officio* the communicated signs and emblems against their unauthorized registration as marks or as parts of marks (except if they have communicated their refusal in the prescribed manner). State flags do not need to be communicated to benefit from this protection.

Where this ground for refusal applies, registration must be refused in respect of all the goods and services covered in the application. However, as regards *official signs of control or warranty*, the refusal by the examiner could be limited to the goods and services in respect of which the official sign of control or warranty is used, as indicated in the list of goods and services communicated with the sign.

The following are examples of signs communicated under Article 6*ter* of the Paris Convention, that are not registrable as marks or as parts of marks, unless the

¹⁹ See the provisions in BN TMA, s. 7(1)(a) and (b), 55 and 56, Emblems and Names (Cap. 94) s. 3(c), Schedule Part I; KH TML, art. 4(d); ID TML, art. 6(3).b) and c); LA IPL art. 23.5 and 6; MY TMA s. 15(b), TMR, r. 13, 14 and 15, TM Manual item 5.37; MM; PH IP Code, s. 123.1(b); SG Act s. 7(11), (12) and (13), 56 and 57, TMR r. 11, 12 and 13, and Work Manual on “Other grounds for refusal of registration”, p. 9 and 10; TH TMA, s. 8(1), (2), (6) and (7); and VN IPL, art. 73.1 and 2. Also the OHIM Guidelines, Part B, Section 4, item 2.8.

²⁰ See the WIPO website at: <http://www.wipo.int/ipdl/en/6ter/>.

applicant submits evidence that the competent national or intergovernmental authority has given authorization for such registration:

- Armorial bearings of States



- Flags of States



- Other emblems of States



- Official signs and hallmarks indicating control and warranty adopted a State ²¹



- Names and abbreviations of names of international intergovernmental organizations

UNITED NATIONS ORGANIZATION

FOOD AND AGRICULTURE ORGANIZATION

WORLD HEALTH ORGANIZATION

²¹ Some official signs and hallmarks indicating control or warranty may consist of 'country brands' that a State or a national State agency has adopted as an official sign of control for specific goods or services.

Asia-Pacific Economic Cooperation

UNO

FAO

WHO

- Armorial bearings of international intergovernmental organizations



- Flags of international intergovernmental organizations



[Organisation for the Prohibition of Chemical Weapons]

[Association of South-East Asian Nations]

- Other emblems of international intergovernmental organizations



F C T C

WHO FRAMEWORK CONVENTION
ON TOBACCO CONTROL



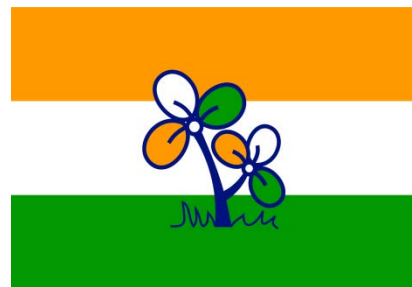
- **Heraldic imitations**

The examiner should raise an objection against any mark that contains an imitation of a protected emblem, flag or other official sign if that sign can be clearly recognized in the imitation.

For example, the following signs containing national emblems or imitations thereof should be refused registration as marks:



[Example provided by the Philippines IP authorities]



[Images taken, respectively, from <http://www.tinydeal.com/2014-world-cup-sale-si-1674.html> and <http://flagstamps.blogspot.com/2014/02/misuse-of-indian-national-flag-by.html>]

The following sign was refused registration as a trademark in Vietnam because of its similarity with the flag of the Republic of Guinea



Application No. 4-2008-26144

[Example provided by the Vietnam IP authorities]

Similarly, the registrations of the following marks were declared invalid by a court in the Netherlands because they included, without authorization, the Swiss national emblem.²²



[Image taken from http://www.gevers.eu/sites/default/files/gevers_belgium_feb13-mip.pdf]

A sign containing an imitation in black and white of a protected emblem, flag or official sign should be refused registration if the specific features of the imitated emblem, flag or sign can be recognized. However, a total variation in the colours of a flag would not be regarded as an imitation except if the flag contains features (emblems, armorial bearings, etc.) that can be recognized regardless of the colour.

For example, the following devices contain features (Swiss cross) that can be recognized notwithstanding the variations in the presentation or the colour.



²² See http://www.gevers.eu/sites/default/files/gevers_belgium_feb13-mip.pdf

[Images taken, respectively, from <http://forums.watchuseek.com/f2/my-swiss-army-watch-fake-roo-960583.html> and <http://www.crwflags.com/fotw/flags/ch.html>]

A sign consisting of a stylized reproduction of certain elements borrowed from or inspired by a State emblem should not be considered an imitation from the heraldic point of view for these purposes.

For example, the following sign was found *not* to imitate, from a heraldic point of view, the flag of the United States of America, although the device was inspired by that flag:

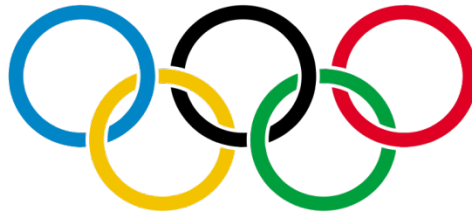


[Example provided by the Philippines IP authorities]

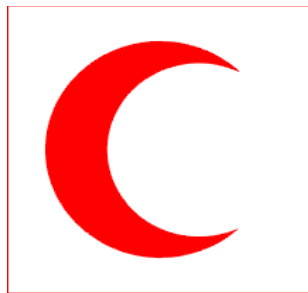
4.2 Other signs and emblems excluded as marks ¹

In addition to the emblems and other official signs covered by Article 6*ter* of the Paris Convention, signs protected by specific international treaties or by provisions in national laws, cannot, without proper authorization, be registered as a mark or as part of a mark. Signs that contain such emblems must give rise to an objection by the examiner if such authorization is not filed by or on behalf of the applicant.

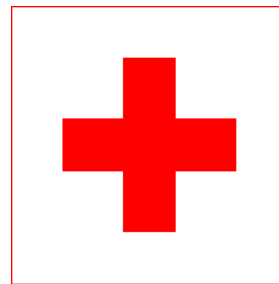
For instance, a mark should not be allowed if it contains any of the following signs protected, respectively, under the Nairobi Treaty on the Protection of the Olympic Symbol, and the Convention for the Amelioration of the Condition of the Wounded in Armies in the Field, Geneva, 22 August 1864:



[Olympic symbol]



[Red Crescent]



[Red Cross]

Where national trademark laws or treaties subscribed by the country prohibit the registration of marks that contain specified national, regional or international emblems and symbols, such marks should also be refused registration.

The following sign was refused in Vietnam because of its unauthorized inclusion of the Euro sign: ²

¹ See the OHIM Guidelines, Part B, Section 4, item 2.8.3.

² Example provided by the Vietnam IP authorities.



Application No. 4-2012-20098

4.3 Signs excluded by statutory provision

Where the law provides for a statutory restriction or a prohibition regarding the registration of signs containing particular names or other elements, the examiner should disallow registration accordingly. Such restrictions are specific to individual countries and must be assessed by the local IP authorities on the basis of their own standards.

For example, the following statutory restrictions to the registration of marks that contain certain specified elements are provided in the laws of the countries indicated below:

Brunei: ³

- a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colourable imitation thereof
- any word, letter or device likely to lead persons to believe that the applicant either has or recently has had Royal patronage or authorisation
- the standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri
- the State Seal of Brunei Darussalam
- the Brunei Coat-of-Arms
- the emblem or official seal of the United Nations Organisation

³ TMA s. 7(1)(c) and (d), and Chapter 94 - Emblems and Names (Prevention of Improper Use) Act, 1967.

- the Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty
- the Emblem or official seal of the International Criminal Police Organisation (Interpol)
- the emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam
- the name of His Majesty the Sultan and Yang Di-Pertuan
- the name of Her Majesty the Raja Isteri

the name ICPO - Interpol or International Criminal Police Organisation (Interpol).

Malaysia: ⁴

- the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation thereof;
- representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation thereof;
- the representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;
- representations of, or mottoes of or words referring to, the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;
- representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- representations of, or mottoes of or words referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling any of the foregoing as to be likely to be mistaken for them.

⁴ TMR r. 13(1)(b), (c) and (d), and 14.

Singapore: ⁵

- a representation of the President or any colourable imitation thereof;
- any representation of the Crest of the Republic of Singapore, the Presidential Coat of Arms, the Royal or Imperial Arms, or of any crest, armorial bearing, insignia, or device so nearly resembling any of the foregoing as to be likely to be mistaken for them;
- any representation of the Royal or Imperial crown, or of the Singapore flag, or of the Royal or Imperial flag;
- the word “Royal”, “Imperial”, “Presidential”, or “Singapore Government”, or any word, letter or device if used in such a manner as to be likely to lead persons to think that the applicant either has or has had Royal, Imperial, Presidential or the Singapore Government’s patronage or authorisation;
- the words “Red Cross” or “Geneva Cross”, any representation of the Geneva Cross or the Red Cross, any representation of the Swiss Federal cross in white on a red background or silver on a red background, or any representation similar to any of the foregoing;
- the word “ANZAC”.

Thailand: ⁶

- royal names, royal monograms, abbreviations of royal names or royal monograms;
- representations of the King, Queen or Heir to the Throne;
- names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family.

⁵ TMR r. 11 and 12.

⁶ TMA s. 8(3), (4) and (5).

5 Public order, public policy, morality

5.1 General considerations

A distinction should be made between the concepts of ‘public policy’ and ‘public order’, on the one hand, and ‘morality’ on the other.

‘*Public policy*’ and ‘*public order*’ refer to the general legal framework of a particular State, and to the rationale and purpose underlying that legal framework. The legal framework includes, in addition to positive legislation and executive provisions in force in a country, international treaties and other international commitments adopted by a State, as well as established case law. These legal sources reflect and express the policy, basic principles and values of the State.

‘*Morality*’ is a set of socially recognised principles that determine practices and rules of conduct within a particular society or community. These principles and rules are not cast in positive legislation or executive norms, and may vary over time. They may be quite different in different countries or within different regions and communities inside the same country. Moral principles and rules reflect values that a national society or community wants to uphold. They are applied alongside positive legal norms that generally will not deal with the type of issues or details that are the subject matter of ‘morality’.

Since the definition of ‘public policy’, ‘public order’ and ‘morality’ is a strictly domestic matter, it can only be judged and decided by the competent national authorities in each country. The determination of what is contrary to public order or to prevailing standards of morality will necessarily depend on the political, cultural and religious context prevailing in the country concerned. In addition, factors such as the degree of outrage calculated to be caused by the use of the offensive sign and the size and section of the identified community potentially affected by the sign are factors to be considered in each case .⁷

The examiner should raise an objection to the registration of a mark when those standards are offended, as determined in the local context of the country where the application is examined.

⁷ See the provisions in BN TMA, s. 6(3)(a); KH TML art.4(b); ID TML, art. 5.a); LA IPL art. 23.18, Decision 753 art. 45 and 46; MY TMA s. 14(b) and (c), TM Manual chapter 5 items 5.5 to 5.8; MM; PH IP Code, s. 123.1(a) and (m), TM Guidelines p. 87; SG Act s. 7(4)(a), TM Manual chapter 9 - “Marks Contrary to Public Policy or to Morality”; TH TMA s. 8(9); and VN IPL, art. 8.1 and Circular 01/2007 item 39.2.b.iii. Also the OHIM Guidelines, Part B, Section 4, item 2.6.

5.2 Particular issues

5.2.1 Nature of the sign itself

To the extent that national law so provides, registration of a sign as trademark should raise an objection from the examiner if the sign is contrary to public policy or public order, or contrary to accepted principles of morality, in the country concerned.

When this ground for refusal is invoked, it should refer to the sign itself. Refusal should be based on the fact that the sign chosen to be registered as a mark is, in itself, contrary to public policy, public order or accepted principles of morality.

In these cases, the nature of the goods or services and the profile of the consumers to whom the goods or services would be addressed are of lesser relevance. What is objectionable is the choice of the sign as such because it is regarded by the examining authority as contrary to public policy, public order or morality. The fact that the goods or services are of limited distribution, or that the relevant sector of consumers is limited would not guarantee that other members of the public -- even those not addressed by the offer -- will not be affected by the presence and use of such sign in the course of trade.

An objection on grounds of public policy, public order or morality may also be raised in cases where the problem does not lie with the sign itself but with the use to which it would be put. This is the case of certain names, symbols or images that are *highly respected* or of *restricted use* in a particular country. The use of such names (for example, the name of a national hero), symbols (for example, a symbol of royalty) or images (for example, an image of religious significance) as trademarks for goods or services traded the market would be regarded as offensive and contrary to public policy, public order or accepted morality.

For instance, the registration of the mark 'BUDDAH BAR' was invalidated in Indonesia and was refused in the Philippines for reasons of public order based on respect for the Buddhist religious feelings among the interested communities in those countries.⁸

Likewise, registration of the following marks were refused, respectively, in Indonesia and in Malaysia on grounds of their contradiction with the prevailing

⁸ Information provided, respectively, by the IP authorities of Indonesia and the Philippines.

rules of religious morality, causing offense to the sensitivity of Muslim people and misrepresenting Islamic precepts:⁹

MAŞAALLAH41

for goods in class 25 of the Nice Classification



For beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages - Application N° 03013458

In Vietnam the following sign was refused on grounds of public ethics:¹⁰

Application No.4-2012-04183

In Indonesia the following sign was refused registration because the sign could be associated with the official postal service in that country (in Indonesia 'Kantor Pos' means 'Post Office'):¹¹

⁹ Examples provided, respectively, by the IP authorities of Indonesia and of Malaysia.

¹⁰ Examples provided by the Vietnam IP authorities.

¹¹ Example provided by the Indonesia IP authorities.

KANTOR POS

for restaurant services.

With regard to the refusal of registration on grounds of public policy, public order or morality a country may adopt a more nuanced standard. Where the law so allows, the examiner will raise an objection against the mark only if it is established that *the commercial use* of that mark for the specified goods or services would be contrary to public policy, public order or morality. This may have the advantage of reducing the scope for subjective assessment and avoiding the need to decide about policy or morality of a sign in the abstract.

5.2.2 Nature of the goods and services

In connection with the possible refusal of registration on grounds of public policy, public order or morality it should be noted that both the Paris Convention (Article 7) and the TRIPS Agreement (Article 15.4) provide the following:

“The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.”

In connection with the trademark examination procedure, this provision has been understood in the sense that the registration of a mark should not be refused only for reasons related to the nature of the goods or services that are included in the specification of goods and services.¹²

In practice, this would prevent the refusal of a registration for the reason, in particular, that some or all the goods or services listed in the application cannot be produced, imported, distributed or otherwise commercialised in the country where the application is filed if such impediment is due to some legal or administrative constraint applicable for the time being in that country.

For instance, it is usual that national laws will require -- in particular for reasons of safety, health and environmental security -- that certain products (or services) be subjected to regulatory approval or prior marketing authorization before they can be manufactured, imported, distributed or otherwise commercialized in the country. It may also happen that, in a particular country, the importation and distribution of

¹² For instance, see provisions in LA IPL s. 23 last paragraph, and Decision 753 art. 45 last paragraph.

particular goods, or the offering of certain services, is totally restricted or banned by law.

In such cases, the registration of a mark should be regarded as a matter separate and distinct from the manufacture, importation, distribution or commercialization of the goods or services to which the mark will apply. The former may be allowed even where the latter is not allowed.

This means that a mark could be registered if it does not fall afoul of any absolute or relative grounds for refusal, even if the manufacture, importation, distribution or commercialization of the goods or services to which the mark applies is subject to prior authorization or is outright banned by law, and even if at the time of registration, the mark cannot be used in trade in the country where registration is granted.

6 Collective and certification marks

6.1 General considerations

6.1.1 Collective marks

The recognition and protection of collective marks is an international obligation under the Paris Convention (Article *7bis*) and the TRIPS Agreement (by reference to the Paris Convention in Article 2.1).¹³

A *collective mark* is a mark that is owned by a ‘collective’ organization with the purpose of being used by all the members of that organization or by a specified category of those members. The collective organization that owns a registered collective mark could, for example, be an association of manufacturers, a cooperative of producers, a corporate union of retail distributors, a chamber of traders or a federation of industries.¹⁴

A ‘collective’ organization that registers of collective mark must be composed of two or more members that share some common commercial purpose or interest and intend to use a common collective mark to distinguish their goods or services in the context of that common endeavour. The collective mark would be intended primarily for use by the *members* of the collective organization, not by the holding organization itself. The arrangement is similar to that of a ‘club’ of producers, manufacturers or traders whose members are allowed to use the ‘club’s’ collective mark under specified conditions agreed by them.

¹³ Article *7bis* of the Paris Convention provides that:

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest. [...]

¹⁴ See the provisions in BN TMA, s. 50 and First Schedule – ‘Collective Marks’; KH TML art. 2(b) and 17, Sub-Decree 46 of 2009, art. 23, TM Manual p. 22 to 25; ID TML art. 1.4, 50 and 51; LA IPL art. 3.11, Decision 753 art. 20, TM Manual p. 21 and 22; MY; MM; PH IP Code, s. 121.2 and 167; SG Act, s. 60 and First Schedule, TM Manual on ‘Collective Marks’; TH TMA s. 4 – ‘collective mark’ and 94; and VN IPL, art. 4.17, 87.3 and 105.4. Also the OHIM Guidelines, Part B, Section 4, item 2.11.

6.1.2 Certification marks

A *certification mark* is a mark that is owned by a ‘certifying’ entity, usually a company, an organization or a public body. A certification mark is used in connection with goods and services to indicate to consumers that the holder of the mark has ‘certified’ that those goods and services comply with certain standards of quality, safety, environmental friendliness, or other characteristics valued by the public or required by law.

Like collective marks, certification marks are registered to be used by persons other than the registered holder. However, the user of a certification mark will normally have an arm’s length contractual relationship with the registered holder of the mark, and his status is akin to that of a licensee.

Unlike collective marks, the registration of certification marks is not mandated under any international treaty. Nevertheless, certification marks are recognised and can be registered under many national trademark laws.¹⁵

6.2 Particular conditions for substantive examination

Collective and certification marks will be treated and examined like ordinary standard marks in respect of most of the applicable absolute grounds for refusal of registration.¹⁶

This includes the case where a sign proposed to be registered as a collective or certification mark is *misleading* as to character or significance of the mark, as may be perceived by the relevant sector of the public. In particular, if a collective or certification mark consists of a sign that may be perceived when used as being different in character from a collective or certification mark, this should give rise to an objection from the examiner.

In addition to the usual grounds for refusal, the following particular aspects require specific consideration by the examiner for purposes of the substantive examination of collective and certification marks:

- geographical descriptiveness,

¹⁵ For instance, see the provisions in BN TMA, s. 52, Second Schedule – ‘Certification Marks’; LA IPL art. 3.12, Decision 753 art. 21; MY TMA s. 56; MM; SG Act s. 61 and Second Schedule, TM Manual on ‘Certification Marks’; TH TMA s. 4 – ‘certification mark’, 82, 83 and 84; and VN IPL, art. 4.18, 87.4 and 105.5, Circular 01/2007 s. 37.6.

¹⁶ In this connection, see also the OHIM Guidelines, Part B, Section 4, item 2.11.3.

- regulations of use of the mark, and
- use of a certification mark by its registered holder.

6.2.1 Geographical descriptiveness

A sign that is descriptive of the geographical origin or provenance of the goods or services for which it will be used cannot normally be registered as a mark for those goods or services (see item 2.3.6, above).

However, many associations and cooperatives of producers that operate in particular geographical regions or other locations use a common sign to indicate that their goods have certain common characteristics, in particular their geographical origin. Those signs could be registered by those producers as *collective* marks used to indicate geographical provenance.

In order to allow this type of collective marks to be registered, an *exception* must be made to the standard grounds of refusal based on the *geographical descriptiveness* of the mark. Therefore, collective marks that consist of, or include, geographical terms or other geographical elements should not be objected on the basis of their geographical descriptiveness. To this effect, the application should indicate that the registration is requested for a collective mark and that the applicant is a collective organization.

If the sign is descriptive of characteristics of the relevant products or services different from their geographical origin, an objection should be raised on the usual grounds for refusal.

As regards *certification* marks, organizations of producers and individual certifying companies, as well as certifying public bodies, use special signs to indicate that certain goods or services have been checked for compliance with specific characteristics, in particular their geographical origin. Those signs may be registered as certification marks. To that effect, when a registration application concerns a certification mark an exception must be made to the grounds of refusal based on geographical descriptiveness.

A certification mark that consists of, or includes, a geographical term or other geographical elements should not be objected on the basis of its geographical descriptiveness. To this effect, the application should indicate that the registration is requested for a certification mark.

6.2.2 Regulations of use of the mark

Applications for the registration of collective and certification marks must submit the relevant regulations of use of the mark, which may include or refer to certain specifications about the goods or services and the manner in which the mark may be used.

The examiner should verify that the regulations of use have been submitted and review the regulations to be satisfied that they are plausible in the light of the purpose of the mark. The regulations of use of a collective mark would be expected to provide some structure or system for the registered holder to control the use of the mark by the members of the proprietor organization.

As regards *collective* marks that are used to indicate the geographical origin of the products bearing the mark, the regulations of use of the mark should indicate the condition that the users and the goods must comply with, in particular, the 'quality link' between the goods and their geographical place of origin.

Where the law so requires, the regulations of use of a collective mark should provide that other persons, whose goods are produced in the same geographical location and comply with the product specifications, may become members of the collective body or use the collective mark under a particular arrangement. This condition is aimed at avoiding a situation where some local producers from the specified area of production would be excluded from using the geographical name of their place of production, which they would be entitled to do under normal, honest trade practices.

As regards a geographical *certification* mark, the examiner should, if the law so requires, check the rules of use of the mark by to ascertain that they do not contain any provisions that would be discriminatory against certain producers. In particular, local producers that operate in the specified geographical area and comply with the other conditions specified for certification under the mark, should be allowed to use the mark.

6.2.3 Use of a certification mark by its registered holder

Where the law so provides, the examiner should raise an objection to the registration of a certification mark if the application indicates that the person in whose name the registration is to issue carries on an activity that involves the manufacture or supply of goods or services of the kind to be certified under that mark.

It is generally understood that a certification mark is to be used to indicate that the holder of the mark has performed an independent assessment of the goods or services of a third party. Such arm's length relationship would be presumed not to exist if the holder of the mark uses the mark on its own goods and services.

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ASEAN

**COMMON GUIDELINES FOR THE SUBSTANTIVE
EXAMINATION OF TRADEMARKS**

PART 2

**RELATIVE GROUNDS FOR THE REFUSAL
OF REGISTRATION OF TRADEMARKS**

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10 APPLYING FOR REGISTRATION IN BAD FAITH

Abbreviations used in the Common Guidelines

ASEAN countries (Country Codes)

BN: Brunei Darussalam

ID: Indonesia

KH: Cambodia

LA: Laos

MM: Myanmar

MY: Malaysia

PH: Philippines

SG: Singapore

TH: Thailand

VN: Vietnam

Other abbreviations

CTMR: Council Regulation (EC) No. 207/2009 of 26 February 2009 on the
Community trade mark (European Community trademark regulation)

ECJ: Court of Justice of the European Union (European Court of Justice)

EU: European Union

GI: geographical indication

IPL: Intellectual Property Law

NCL: The International Classification of Goods and Services for the Purposes of
the Registration of Marks, established under the Nice Agreement of 1957

Nice Classification: The International Classification of Goods and Services for the Purposes of the Registration of Marks, established under the Nice Agreement of 1957

OHIM: Office for the Harmonization of the Internal Market (European Community Office for industrial designs and marks)

PARIS CONVENTION: Paris Convention for the Protection of Industrial Property, concluded in 1883, last revised in Stockholm, 1967

SGT: Singapore Treaty on the Law of Trademark and the Regulations under that Treaty, concluded in 2006

TMA: Trade Mark(s) Act

TML: Trade Mark(s) Law

TMR: Trade Mark(s) Regulation(s) or Trade Mark Rules

TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights

WHO: World Health Organization

WIPO: World Intellectual Property Organization

WTO: World Trade Organization

References

All websites references are current as on 30 September 2014.

RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION

1 General considerations

A mark may not be registered if *the use* of the mark *in trade* would conflict with another person's earlier right. The fact that a sign is not objectionable on absolute grounds for refusal of registration will not overcome an objection based on the existence of third-party rights that would conflict with the use of that sign as a mark in commerce.

There are a number of different sorts of earlier rights held by persons unrelated to a trademark applicant that could conflict with the applicant's mark and prevent its registration. The types of earlier rights that may justify an objection on relative grounds for refusal are usually prescribed in trademark laws but are also found in other laws, for example, copyright laws and other intellectual property statutes.

Conflicting third-party rights may also be based on civil law, common law or other legislation dealing, for example, with personal rights, company names, unfair competition or passing off.

Grounds for refusal based on pre-existing rights of other persons are called 'relative grounds' because they do not refer to absolute objective grounds relating to the trademark sign itself, but are rather contingent on the existence of intervening third-party rights.

Relative grounds for refusal may be raised by the examiner *ex officio*, i.e. on the examiner's own initiative, or as a result of a third-party opposition or objection filed against the registration of a mark. Relative grounds may also be raised in requests for rectification, revocation, cancellation or invalidation of a registration after grant.

A refusal of a trademark registration on relative grounds will require the examiner to take into account all the circumstances that are relevant in each particular case. The examiner is required to prospectively imagine the likely situation if the mark were actually used in trade to distinguish the specified goods or services within the country. The analysis of all relevant factors should ultimately lead the examiner to answer the following question in order to decide whether to allow or object to the registration of a mark:

'If this mark (filed for registration) were used in trade in this country, in connection with the specified goods and services, would such use *unfairly* prejudice a third party?'

If the answer to that question is 'yes', registration of the mark should not be allowed.

It should however be recalled that in competition among suppliers operating in a market economy the success of one undertaking may entail economic detriment for another undertaking to the extent that the public may prefer certain goods or services and shun others among those on offer. However, any prejudice resulting from customer preference would be a normal consequence of competition in the market and cannot be regarded as 'unfair' if the rules of competition are respected. Those rules include honest trade practices and respect for intellectual property, in particular the laws that regulate the various business identifiers used in trade.

The following sections examine the main relative grounds for refusal that can sustain an objection against the registration of a mark, based on various categories of third-party rights.

2 Earlier registered marks

The most usual relative ground raised to refuse the registration of a mark is the existence of one or more earlier marks registered for the same or a similar specification of goods or services.¹

Trademark rights are always established for a particular sign in conjunction with a set of specified goods or services. Therefore, to assess the relevance of an earlier trademark right as a ground for refusal the examiner must necessarily consider the marks in conflict as well as the specifications of goods and services covered by those marks.

In this regard, the marks and the corresponding goods and services must be compared to determine whether they are close enough to cause prejudice to the holder of the earlier right. Two cases may be distinguished as a first step:

- *identity* of the signs and of the specified goods and services (i.e. *double identity*),
- *similarity* of the signs and of the specified goods and services.

2.1 Double identity

'Double identity' occurs when a mark contained in an application for registration is identical with an earlier mark, and the goods or services specified in that application are also identical to the goods or services covered by the earlier mark.²

Double identity is less frequent than partial identity and similarity. However when double identity is established there is no need to assess likelihood of confusion. The examiner can raise an *ex officio* objection and a third-party opposition to the registration of the later mark should be upheld.³

¹ See the provisions in BN TMA s. 8(1) and (2); KH TML art. 4(g); ID TML art. 6(1).a); LA IPL art. 16.2 and 3, and 23.9; MY TMA s. 19(1) and (2); MM; PH IP Code s. 123.1(d); SG TMA s. 8(1) and (2); TH TMA s. 6(3); and VN IPL art.74(2).f).

² See the provisions in BN TMA s. 8(1); KH TML art. 4(g); ID TML art. 6(1).a); LA IPL art. 16.2 and 23.9 and Decision 753 art. 34(1).1; MY TMA s. 19(1)(a) and (2)(a); MM; PH IP Code, s. 123.1(d)(i); SG TMA s. 8(1); TH TMA s. 6(3); and VN IPL art.74(2).f).

³ In connection with the exclusive rights conferred by registration, the TRIPS Agreement (Article 16.1) deals with 'double identity' providing that: "In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed."

The examiner will establish whether a case of double identity exists by applying the same analysis and criteria used to determine the degree of similarity between the signs in conflict and their respective lists of goods and services. That analysis must precede any finding of likelihood of confusion.

2.2 Likelihood of confusion

2.2.1 General considerations

Most cases of conflict between marks will not present a double identity of signs and goods or services but rather a situation of similarity that will require closer analysis. In these cases an objection to the registration of the mark will be based on the broader standard of likelihood of confusion. This means that registration should only be refused where the circumstances indicate that, if the mark filed for registration were used in trade in the country, in connection with the specified goods or services, such use would be likely to cause confusion among the relevant sector of consumers.⁴

In this respect, confusion should be understood to include any assumption or perception by an average consumer that there is a connection between the marks in conflict, the holders of those marks or the commercial origin of the goods and services covered by the respective marks, where such connection in fact does not exist.

In the assessment of a likelihood of confusion both direct confusion and confusion by association must be covered, namely the cases where:

- a consumer would directly confuse the marks as used in trade (which could entail an erroneous purchasing decision), or
- a consumer would not confuse the marks but would assume that there is some connection or association between the commercial origin of the goods or services for which those marks are used, because they originate from the same undertaking or from two undertakings that are economically linked.

For trademark purposes, two undertakings must be regarded as '*economically linked*' if they are connected by virtue of any arrangement resulting in a single control of the marks in question or a common control of the marks through a third

⁴ See the provisions in BN TMA s. 8(2); KH TML art. 4(g); ID TML art. 6(1).a); LA IPL art. 16.3 and 23.9, and Decision 753 art. 34(1).2, 35 and 36; MY TMA s. 19(1)(b) and (2)(b); MM; PH IP Code s. 123.1(d)(iii); SG TMA s. 8(2); TH TMA s. 6(3); and VN IPL art.74(2).f).

person. This would include, in particular, a parent-subsidiary relationship, a licence, a sponsorship arrangement, an exclusive distribution contract or other contractual arrangement, or undertakings belonging to a single economic group.

The examiner must therefore object the registration of a mark if -- having considered all the relevant factors -- he concludes that the use of that mark within the country is likely to cause any of the above-mentioned assumptions in the mind of the relevant consumers.

Unlike the case of 'double identity', which may be determined objectively, a determination of 'likelihood of confusion' will often require the examiner's analysis and appreciation of the circumstances involved in the case. Although this will involve a degree of subjectivity, the use of standard examination criteria will make the conclusions more predictable.

A likelihood of confusion should only be found after a global assessment of all the factors and circumstances that are relevant in each particular case. Those factors are linked and interdependent, and include:

- the similarity of the *goods* or *services* involved,
- the similarity of the *signs* in conflict,
- the *relevant public* and consumers
- *other* relevant factors.

These factors are discussed in the following sections.⁵

2.2.2 Comparison of signs

In case of conflict between two marks, once it has been determined that the goods or services are identical or similar, it will be necessary to look at the marks to decide if they are identical, similar or dissimilar.

The initial objective comparison should include all the perceptible elements in the signs, regardless of their distinctive value. At this stage, the comparison of the

⁵ Regarding the factors that need to be analysed to determine if there is a likelihood of confusion, some examples of analysis criteria are found in the following texts of some of the ASEAN countries: KH TM Manual p. 54 to 67; ID TM Guidelines chapter IV.B.2.1)a); LA Decision 753 art. 34, 35, 36 and 37; MY TM Manual chapter 11 paragraphs 11.5 to 11.45; PH TM Guidelines chapter X p. 89 to 118; SG TM Manual chapter 7 - 'Relative Grounds for Refusal of Registration'; and VN Circular 01/2007 s. 39.8 and 9.

signs should remain objective. Other factors such as the distinctiveness of the sign or the dominant or weak elements should only weigh in at a later stage for the final global assessment of likelihood of confusion.

The conflicting signs should be compared as they appear, respectively, in the application and on the register of marks. The examiner should presume that the marks are, or will be, used in trade as they appear on the file and on the register.

If the signs are clearly dissimilar, the examiner should finish the examination of the likelihood of confusion.

On the other hand, a finding of similarity should not, on its own, lead to a conclusion that the registration of the mark being examined would be likely to cause confusion. This conclusion should only come after the final, global assessment once all the relevant factors have been considered.

2.2.2.1 *Identity of signs*

If the examiner finds that the sign for which registration is sought is *identical* with an earlier mark, the registration should be refused in respect of the goods and services that are covered by both marks.

Although in principle a finding of 'identity' would require that the signs be identical in all respects, examination should proceed on the basis that *insignificant* differences that would be imperceptible to the average consumer for the relevant goods or services, should not be taken into account. Any difference that is *not perceptible* without careful, close, side-by-side examination of the marks, should be considered 'insignificant'.

Two signs that are identical *in all aspects*, or that present *differences that are insignificant* because they cannot be perceived or noticed by the relevant consumers, should therefore be regarded as 'identical'.

Identity in respect of only some elements (partial identity) is not to be regarded as identity but as similarity. For example, in the following cases the marks should not be considered identical:

- two marks consisting of words that sound the same but have different spelling,
- two marks consisting of words that are identical except for one letter or digit,
- one mark is included entirely in the other, but the other has an additional figurative element or is presented in different characters, style or colours.

However, as regards word marks, a variation of upper or lower case will not be taken into consideration: such variation should be treated as an insignificant difference.

2.2.2.2 *Similarity of signs*

In most cases of conflict between marks the opposition or objection will be based on the fact that the signs are similar and that such similarity (in conjunction with other relevant factors) is likely to cause confusion.

For these purposes 'similarity' means a situation where the two signs are less than totally identical; they are identical in respect of certain aspects but dissimilar as regards other aspects.

In comparing the signs, the examiner should disregard any negligible elements and features and focus on the elements that are clearly perceptible. An element or feature is to be regarded as 'negligible' if at first sight it is not noticeable on the sign. This may result from the feature's size or position in the mark. If a feature is only perceivable upon close and careful inspection, it is *prima facie* irrelevant for purposes of determining similarity.

Signs that consist of ideograms, characters or text written in a *foreign language* or in *foreign characters* that are unintelligible to the average consumer in a country should be treated as figurative signs as they cannot be compared phonetically or conceptually in the language of the country concerned. A translation would only serve for information purposes since the mark would be used in the marketplace in its original form (i.e. in its foreign language or foreign characters). In this connection, see item 1.1.1.2 in Part 1 of these Guidelines.

The aspects that need to be compared to determine similarity between the signs are their *visual* features, their *phonetic* features and their *conceptual* dimension. The examiner should consider the *overall impression* of the signs in conflict on the basis of their visual, phonetic and conceptual characteristics, and must also take into account the level of inherent or acquired distinctiveness of the earlier (cited or opposing) sign.⁶

⁶ In this regard see the judgement of the ECJ of 22 September 1999, case C-342/97, 'Lloyd Schuhfabrik Meyer', paragraph 26, in which the ECJ stated:

"[...] the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the *overall impression* created by them, bearing in mind, in particular, their distinctive and dominant components. [...] {T}he *perception* of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various

2.2.2.2.1 Visual comparison

The visual aspect or impression of a sign is relevant for the comparison of any visually-perceptible signs, whether word, figurative, mixed, three-dimensional or colour signs. Visual comparison will determine how much the later mark *looks* like the earlier mark.

Visual similarity should be assessed taking into account different factors depending on the type of visual signs that are in conflict. Comparison between two purely word marks or two purely figurative marks will be more straight forward than comparisons between, for instance, a purely word mark and a mixed mark (a word plus figurative elements).

Visual similarity will depend on the elements that are common to both marks. However, visual similarity may also occur if, despite some differences in the individual elements contained in the marks, the overall layout, proportions and choice of colours make the marks, as a whole, look similar.

Word signs

(1) As regards a conflict between *two purely word marks* the visual comparison will be based on the number and sequence of the letters, digits and characters contained in the marks. The analysis will necessarily be made in the language (and alphabet) of the national office, as well as in other languages that are commonly used or understood in the country. However, a word transliterated from one alphabet to another may cease to be visually similar. (The signs may nevertheless remain phonetically similar – see below).

The average consumer will see a mark as a whole and will not notice a small difference in the number of letters or their position. However, the letters at the beginning of a word will tend to be noticed more than the other letters in the word. In this respect, a difference in the initial letter may make the marks visually more dissimilar than a variation in one of the middle letters.

The length of the word and the splitting of a word are also factors that can affect the visual perception of word signs.

However, it is not possible to establish beforehand a fail-safe rule on the number of different letters in a word that will avoid a finding of visual similarity, or the number of identical letters that will determine visual similarity between two words.

(2) In case of a conflict between a *pure word mark* and a *mixed word sign* (i.e. a word presented in special characters, typeface, font or colour, or combined with a figurative element), the word element will normally be noticed and memorized more easily because consumers will tend to first read the words in the mark whenever possible.

Visual similarity will depend on whether the letters in the respective words of the marks are in the same position, and also on the strength of any special visual features, style of the letters or figurative elements of the mark. If the figurative elements or special characters are not strong enough to impress a difference between the two signs, the identity or similarity of the words would prevail.

If the figurative elements of a mark are strong or its letters highly stylised, that mark may be found to be visually dissimilar from a pure word mark with no figurative elements.

(3) In case of conflict between *two mixed signs* (i.e. both marks have words with or without special characters, typeface, font or colour, and are combined with figurative elements) visual similarity may be found where the letters or words are the same, in the same position, and the figurative elements (typeface, font, colours) are not strong enough to impress a substantial difference.

For instance, the following mixed signs can be regarded as visually similar:



vs.



[Example provided by the Indonesia IP authorities]



(Japan Airlines' service mark)

[Example taken from the Trademarks Manual of Cambodia, p. 59]

However, if only some letters or only a part of the word or words are the same in the two marks and the style or the figurative elements are markedly different in each mark, they may be found to be visually dissimilar.

(4) In case of a *mixed sign in conflict with a purely figurative sign*, visual similarity will depend solely on the figurative elements since only one of the marks has a word element and the other mark has none. In this case, visual similarity may be found if the figurative elements in both marks are prominently visible and are the same or almost identical. However, if the word element in the mixed mark is more prominent than its figurative element, the visual similarity with the purely figurative mark may disappear.

Figurative signs and colour signs

(1) In case of conflict between *two purely figurative signs* (i.e. neither mark contains any word element) the figures may be regarded as visually similar if they conform to one another in shape, contours and proportions. A variation of the colours used, or a shift from black and white to colour, might not make the marks dissimilar.

(2) In case of marks consisting of a *combination of colours*, visual similarity will be found if the colours of the later mark are the same, or its colours are within a range of shades that cannot be distinguished from the earlier colours by an average consumer.

Three-dimensional signs

If both conflicting marks are *three-dimensional*, visual similarity will depend on correspondence of the shapes, proportions and choice of colours, if any.

The *first visual impression* of the marks should be decisive to find similarity. Any differences that are perceivable only after close examination, measurement or other verification will not cause dissimilarity.

In case of an earlier *three-dimensional mark opposed to a two-dimensional figurative mark*, visual similarity may be found if the two-dimensional mark effectively reproduces the shape of the earlier mark so it can be easily identified as a reproduction. Insignificant or irrelevant differences in the marks will not cause visual dissimilarity.

2.2.2.2.2 Phonetic comparison ⁷

(1) A phonetic comparison of visually-perceptible signs may only be performed between signs that *contain* one or more *word elements* that can be read and *pronounced*. Such comparison is possible even if the word elements also contain a figurative element or use special characters, typeface, font or colour.

A phonetic comparison is not possible if one or both of the signs in conflict has no word element that can be read and pronounced. However, such signs may still be compared visually and conceptually.

(2) Phonetic comparison must be based on the pronunciation codes of the average consumers in the country concerned. Foreign words may be pronounced differently in different countries and the way in which a word is pronounced in the foreign country of origin is not always relevant.

For example: the words “LOVING KARE” may be *phonetically* similar or identical to “LAVIN-KER” when pronounced by consumers whose language is not English.

If required, a phonetic comparison should include a *transliteration* of the word elements and an assessment of the resulting sounds.

(3) The overall phonetic impression of a mark that contains a word element will depend on the number and sequence of the word’s *syllables*, and the manner in which the word is *pronounced* in a particular country. Phonetic similarity will be found if the sound of the pronunciation of the word elements of the conflicting marks is the same, or close enough to be phonetically indistinguishable.

Common syllables found in both marks, their sequence and the total number of syllables that give rhythm of the words will influence phonetic similarity or dissimilarity.

⁷ In this connection see the OHIM Guidelines, Part C, Section 2, Chapter 3, item 3.5.

(4) Graphic signs that can be read as part of a word or phrase must also be taken into account for a phonetic comparison. For example, signs such as '@', '&', '%', '+' and '#' have names ('at', 'and', 'per cent', 'plus', 'hash') and will normally be read by a consumer if they are part of a word mark. The same applies to loose letters ('Quali-T' may sound the same as 'quality'). The sound of those signs and letters must be taken into account for a full phonetic comparison. The actual sound of those graphic signs will depend on name given to the sign in the local language.

(5) Where the marks in opposition contain identical syllables or words but their sequence is inverted, that difference may not eliminate a finding of phonetic similarity.

For example: **BLUE GINGER** vs. *GINGER BLUES*

(6) The phonetic value of a foreign word or of a fanciful word will be that of its pronunciation by the general public in the country concerned. However, where a significant portion of the relevant sector of consumers in a country also understand the foreign word and would pronounce it in the corresponding foreign language, this pronunciation must also be taken into consideration for the phonetic comparison.

(7) Account should be taken of different letters that produce identical or similar sounds when pronounced. For example, the sound of the letters "b" and "p", or "x" and "s" may be identical or confusingly similar when pronounced in a particular context. This difference of letters may not suffice to avoid a finding of phonetic similarity.

(8) When comparing two mixed signs for phonetic similarity, the word elements will normally prevail over the figurative elements because the consumers will tend to read and retain the words rather than the accompanying visual elements. For example, in Indonesia the following mixed signs were found to be phonetically similar notwithstanding of their different visual appearance:



vs.



2.2.2.2.3 Conceptual comparison

Signs with semantic content

Similarity between two marks may be caused by a similarity in the concept or meaning of the signs, as understood by the average consumers in the country concerned.

A conceptual assessment may only be performed in respect of signs that have a semantic content, namely signs that have at least one *meaning* generally understood by consumers in a particular country. Such signs with a meaning will be:

- signs that contain a *word* element that has a meaning in the language, or one of the languages, of the country concerned, or
- signs that have a *figurative* element that represents something that has a meaning, i.e. something that can be recognised and described or named in words.

If only one of the signs in conflict has a meaning, a comparison cannot be performed. The conclusion of the comparison between such signs will be that they are not conceptually similar.

Factors relevant for conceptual comparison

(1) A conceptual similarity between *two word marks* may be found if both words have the same meaning, are synonyms, or refer to concepts or ideas that are close enough to be associated.

For example: PANTHER vs. PUMA

HEAVEN vs. PARADISE

Sunlight



[Image taken from <http://www.oneclueanswer.com/tag/emoji-pop-sunlight/>]

(2) In case of a *compound word mark comprising two or more words* that are used together and have a specific meaning that is different from the meaning of its individual component words, only that specific meaning should be taken into account. There is no conceptual similarity between two word marks if the similarity is based only on one of the component words considered separately.

For example: FIREWORKS vs. SKUNK WORKS

DARKROOM vs. DARK SAND

However, if the mark consists of a composite word or expression in a foreign language, and the average consumers in the country are only able to understand the part of the word that is common to both marks but do not understand the complete expression, conceptual similarity can only be assessed with respect to the parts that have a meaning for those consumers. Conceptual similarity may be found to the extent that only the meaning of the common part will be considered.

For example: GAME BUDDY vs. GAMEWAY

In this example, if only the word 'game' is understood by the relevant sector of consumers, that element would introduce a degree of conceptual similarity. However, depending on the other parts of the marks involved and their overall perception, that similarity may not lead to a finding of likelihood of confusion if there is no visual or phonetic similarity between the signs.

(3) As regards marks that consist of *names of persons*, conceptual similarity may be found where one name is the root or a derivative of the other name, or where different spelling is given to the same name.

For example: TERRY vs. TERRI

CAROLE vs. KAROLE

KLAMBERT vs. KLAMBERTON

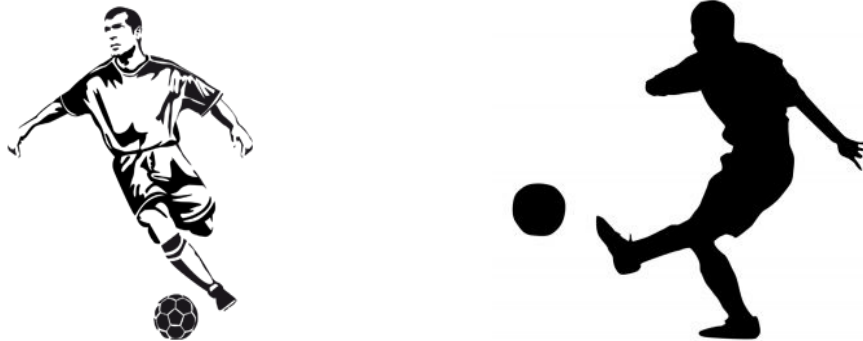
(4) Conceptual similarity may be found between two signs composed of *numbers* or *letters*. In this case, the conceptual similarity will result from the fact that the numbers' meaning is the same or easily related, or that the letter is the same. A variation of style, typeface, font or colour may not dispel similarity because the meaning of the number or letter would prevail.

For example: JIM-1000 vs. JIM THOUSAND

 MK-200 vs. MK2000

(5) Conceptual similarity can be found between signs that contain *figurative elements* where the *meaning or concept represented* by the figurative elements is the same in both marks, or their meanings can be directly associated, even if the images are not visually similar.

For example:



[Images taken, respectively, from <http://www.dezignwithaz.com/soccer-player-wall-stickers-p-1210.html> and <http://www.clipartpanda.com/categories/soccer-player-silhouette>]



[Images taken, respectively,
from <http://yamisnuffles.deviantart.com/art/Hummingbird-Tattoo-388443390>
and <http://www.thisiscolossal.com/2012/09/gorgeous-painted-birds-by-adam-s-doyle/>]

(6) Conceptual similarity between a *word mark* and a mark that contains a *figurative element* with or without words, can be found if the word mark corresponds to the *meaning or concept represented* by the figurative element, or if the meaning of the figurative elements can be directly associated with the word mark.

For example:

RED
SAMURAI



[Image taken from <http://www.dreamstime.com/royalty-free-stock-photo-samurai-warrior-cute-image12292605>]



[Examples provided by the Philippines IP authorities]

(7) Conceptual similarity between two *mixed marks* may be found if the word elements in both marks are conceptually synonymous. If the word elements are conceptually dissimilar, the *figurative elements* could lead to a finding of similarity in the signs if those elements are prominent enough to be perceived over and above the dissimilar but less perceptible word elements. If the *meaning or concept represented* by the figures is identical or similar, and the figurative elements are prominent in both signs, there could be a finding of conceptual similarity.

For example:



vs.



[Examples provided by the Indonesia IP authorities]

2.2.2.3 *Distinctive and weak elements of signs*

When two marks are compared in order to determine likelihood of confusion, the distinctive strength of the elements contained in the marks must be taken into account.

If the identity or similarity in the signs resides in an inherently strong, distinctive element contained in the earlier mark that is reproduced entirely or substantially in

the later mark, this would make the marks substantially identical or similar. The identity or similarity in respect of that strong, distinctive element would be likely to cause confusion if both signs were used in the market.

Conversely, if the words or figurative elements that are identical or similar in both marks are not themselves distinctive, or have only weak distinctiveness, then the identity or similarity of the marks would be based on elements that cannot be claimed in exclusivity by either party. Such similarity cannot normally sustain a finding of likelihood of confusion.

In particular, any elements in a mark that are generic, descriptive, laudatory or allusive with respect of the specified goods or services, have a low level of distinctiveness and will not support a finding of likelihood of confusion.

For example, if two marks contain the same figurative element so that they may be considered visually similar, but such common element is inherently non-distinctive in relation to the relevant goods or services, no likelihood of confusion can be found between those marks. They may be allowed to coexist in the market.

The following is an example of signs that contain shared elements that are *generic* or commonplace:

MOVIE FAN

vs.

MOVIEPLEX



vs.

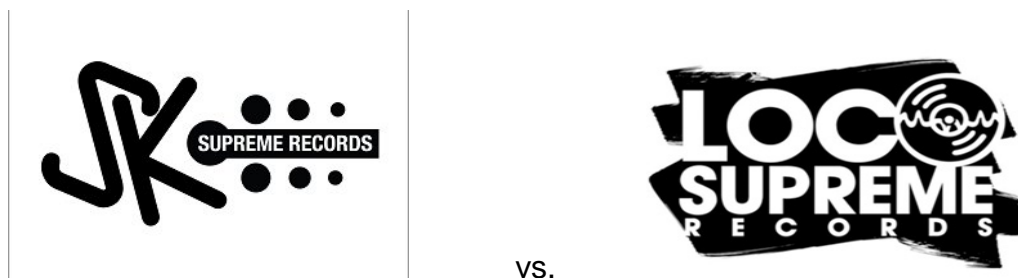


[Images taken, respectively from <http://www.dreamstime.com/royalty-free-stock-images-spaghetti-pasta-bakery-labels-pack-spaghetti-windmill-field-bread-image35508609> and <http://www.dreamstime.com/stock-images-spaghetti-pasta-bakery-labels-pack-spaghetti-windmill-field-bread-image35507744>]

The following is an example of word marks that have common elements that are *descriptive*: the words 'protection screen' and 'protective screen' as parts of marks applied to that type of goods merely describe the products. Those marks may coexist in the market.

Nivea protection screen vs. **Coral** protective screen

The following is an example of signs that contain shared elements that are *laudatory*: in this case, the expression 'supreme' used in both marks is not distinctive and cannot be used to base a finding of similarity between the signs.



[Images taken, respectively from <http://www.residentadvisor.net/record-label.aspx?id=1896> and <http://www.residentadvisor.net/record-label.aspx?id=6082>]

2.2.2.4 *Relevance of enhanced distinctiveness of a sign*

Distinctiveness of a mark is its ability to link or associate, in the mind of consumers, the relevant goods or services to a particular commercial origin and, consequently, to distinguish those goods and services from the goods and services of other persons offered in the same market.

Signs have varying degrees of distinctiveness:

- ❖ Signs that are merely generic, descriptive or functional have *no distinctiveness*.
- ❖ Signs that are *allusive* of the nature, use, kind, quality or other characteristics of the relevant goods or services, but are not entirely generic,

descriptive or functional, have a *low* level of distinctiveness. They may be registered as marks but will remain '*weak*' because they will not be able to oppose later marks that are not very closely similar or identical.

- ❖ Signs that are *fanciful* or '*arbitrary*' are *inherently* distinctive and have a 'standard' level of distinctiveness in connection with the specified or similar goods and. Their existence is a ground for refusal of later marks that relate to the same goods or services.

A sign that is not inherently distinctive may nevertheless *acquire distinctiveness* through use in trade. Acquired distinctiveness should be recognised by the examiner to the extent that it is invoked and proven by the interested party. If the evidence demonstrates acquired distinctiveness, the sign may be cited against the registration of a later conflicting mark.

A registered mark should be *presumed* to have at least a minimum degree of inherent (or acquired) distinctiveness. This is the baseline on which the examiner will assess a likelihood of confusion in case of conflict with a later mark.

- ❖ A mark that, through use and market promotion, has become *well known* to the relevant consumers enjoys '*enhanced distinctiveness*' or '*reputation*'. Enhanced distinctiveness or reputation may warrant a finding of likelihood of confusion with respect to a later mark even in respect of dissimilar goods or services (see item 3, below).

With respect to marks that have enhanced distinctiveness (inherent or acquired) the ECJ has held that:

“... marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

... the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.”⁸

In case of conflict between two marks, the reputation or enhanced distinctiveness of the earlier mark will be relevant to determine likelihood of confusion. The reputation of the contested mark is irrelevant for the purposes of this assessment.

⁸ Decision of 29 September 1998, case C-39/97, 'Canon', paragraphs 18 and 24:

It is the scope of protection of the earlier, cited mark that will determine whether the use of the contested mark would cause a likelihood of confusion, because the earlier mark enjoys an exclusive right that prevails over the later applicant's right.

2.2.3 Comparison of goods and services

2.2.3.1 Definition of the relevant goods and services

To assess the likelihood that a mark will cause confusion if used in competition with an earlier mark, it is necessary first to establish whether the goods and services in respect of which the conflicting marks will be used are identical or just similar.

If an opposition is filed against a registration on the basis of a prior mark that covers goods and services that are not identical, similar or otherwise materially related, the opposition should be dismissed. The *principle of 'speciality'* of trademarks postulates that the scope of protection of a mark is limited to the goods and services specifically covered by its registration or to those in respect of which the mark is used. This rule has an exception when the earlier mark is well known or enjoys a reputation that warrants an extended scope of protection.

The principle of speciality also requires that the goods or services be clearly specified in an application. The examiner should not accept an application with broad or vague specification of goods or services, or blanket references to the classes of the International classification of goods and services (Nice Classification – NCL) such as “all other goods in class 1”.

The determination of whether the goods or services are identical or similar should also include the goods or services for which the sign is used in trade, if the earlier sign claims rights on the basis of use in addition to, or instead of, registration, for instance where an enhanced distinctiveness or reputation of the mark is claimed.

The comparison of goods and services must be objective, disregarding the similarity or degree of distinctiveness of the signs in conflict.

The comparison must be based on the specification of goods and services contained in the earlier registration (or application) and in the later application. If the examination of the relative grounds of refusal is prompted by an opposition, the comparison should be confined to the goods or services to which the opposition refers (partial opposition). The goods and services that have not been included in the opposition need not be examined for identity or similarity, unless the law requires the examiner to do otherwise.

The scope of the lists of goods and services contained the earlier registration and the opposed application should be analysed carefully taking into consideration the use of certain terms. The expressions ‘in particular’, ‘such as’, ‘including, and ‘for example’ do not affect or limit the scope of the list; they just add illustration or clarification. The examiner may disregard these expressions when determining the scope of the specification of goods or services, or may require those terms to be deleted if they make the specification unclear.

On the other hand, if the specification of goods and services includes the expressions ‘*namely*’ or ‘*exclusively*’, these should be interpreted in the sense that the coverage and scope of the specification is limited to the goods and services following those words.

For example, if the specification of goods and services covers “Scientific apparatuses and instruments, *namely* microscopes and optical instruments”, the examination should be confined to comparing only the goods “microscopes and optical instruments”. Likewise, the specification “Pharmaceutical products *exclusively* for dermatological use” should limit the comparison to the specifically indicated goods for dermatological use.

If the registration or the application contains a *disclaimer* that limits the scope of the goods or services covered by the registration or by the challenged application, this must also be taken into account. A disclaimer is binding on the trademark holder and on the Office. This means, in particular, that an opposition cannot be based on the identity or similarity of goods or services that have been expressly disclaimed in the cited trademark registration.

2.2.3.2 *Classification of goods and services*

The Nice Classification (NCL) establishes 45 classes under which, in principle, all goods and services may be classified. However, the scope and structure of each of the classes is different because they were defined using different technical criteria.

The purpose of the NCL is primarily administrative, for use in structuring trademark databases and schedules of fees for the registration and renewal of marks, among other things. Although the NCL classes of goods and services will in many cases give an accurate indication of goods and services that are similar or related, those classes do not automatically determine the similarity or dissimilarity of the goods and services for purposes of establishing a likelihood of confusion between two marks.

In this connection it is noteworthy that the Singapore Treaty (SGT) Article 9(2) provides the following:

“(2) (a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.

(b) Goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in different classes of the Nice Classification.”

Although the classification of goods and services in accordance with the NCL should not to be taken as the main criterion to decide whether goods or services are similar for purposes of finding a likelihood of confusion, the classification does provide a useful reference for this purpose. The classification of particular goods or services in a given class would still need to be weighed in with other relevant factors to conclude whether there is similarity or dissimilarity of goods and services in a particular case.

2.2.3.3 *Identity of goods and services*

In order to decide if there is identity with respect to goods and services, the examiner must interpret and understand the meaning and breadth of each term included in the specification. This should be done on the basis of references such as dictionaries and thesauruses, the Nice Classification, and the examiner’s knowledge of the use of words in the local language taking into account local trade practices.

The goods and services specified for two marks in conflict are to be considered ‘identical’ when they coincide entirely because the same terms -- or synonymous terms -- are used in the specifications of both marks. The following cases of total or partial identity of goods and services may occur:

- all the goods and services mentioned in both lists are the *same* (same terms or synonyms),
- a broad category of goods or services of the earlier, cited mark *fully includes* the goods or services of the later, contested mark,
- all the goods or services of the earlier, cited mark *fall entirely within* a broader category of goods or services covered by the later, contested mark,
- the goods or services of one mark *partly overlap* with goods or services of the other mark, in which case there is identity in respect of the overlapping goods or services.

Case 1: All the goods and services mentioned in both lists are the same (same terms or synonyms)

For example, the designation of 'automobiles' is identical to 'automobiles' and to its synonym 'cars'. 'Baby food' is synonym with 'infant food'. 'Gum solvents' is synonym with 'degumming preparations'. 'Sports shoes' and 'athletics shoes' are synonyms. 'Therefore, these goods can, respectively, be regarded as identical.

A coincidence in the terms or names used to designate the goods or services does not necessarily mean that the goods or services are identical. Identity will depend on the nature, purpose, use, composition or material and other characteristics of the goods or services.

For example, "solvents (for paints and varnishes)" are not identical with "solvents (for removing adhesive medical plasters)". "Blades" (for machine saws) and "blades" (for hand tools) are not identical.

Case 2: A broad category of goods or services of the earlier, cited mark *fully includes* the goods or services of the later, contested mark

For example, the earlier mark is registered for "pharmaceutical preparations" and the contested mark is requested for "antibiotic preparations". The category "pharmaceutical preparations" is broader than the category "antibiotic preparations", which is only one type of pharmaceutical product. "Footwear" is broader than, and includes, "sports shoes".

In this case, the goods contained in the narrower category of the contested mark are identical with the goods covered by the cited mark.

Case 3: All the goods or services of the earlier, cited mark *fall entirely within* a broader category of goods or services covered by the later, contested mark

For example, the earlier mark is registered for "biological herbicides and fertilizers", and the contested mark is applied for "chemicals used in industry, science, photography, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry".

As a first step, the goods mentioned in the broader claim that are inherently different from those in the earlier registration should be set aside because they are irrelevant for purposes of determining the *identity* of the goods (although those different goods may later be relevant to assess the similarity of the goods, and for the global assessment of likelihood of confusion). In this example, the following goods may therefore be disregarded: 'chemicals used in industry, science and photography; unprocessed artificial resins, unprocessed plastics; fire extinguishing

compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry’.

As regards “chemicals used in agriculture, horticulture and forestry” and “manures”, these goods may be regarded as identical to “biological herbicides and fertilizers”.

Case 4: The goods or services of one mark *partly overlap* with goods or services of the other mark

In the case of overlap, the specified goods or services will be regarded as identical if they are expressed in broad categories and it is not possible to separate conceptually the goods or services.

For example, if one of the marks in conflict is registered for “clothing” and the other mark is applied for “sportswear”, the overlap would occur to the extent that both broad concepts can apply *simultaneously* to certain goods. Those goods will therefore fall under the coverage scope of *both* marks. For example, the goods “unprocessed artificial resins used in industry” would fall under both specifications because such goods would concurrently be “unprocessed artificial resins” and “chemicals used in industry”.

In these cases the examiner should not *ex officio* separate, dissect or limit the goods or services specified in the lists of goods and services of the conflicting marks.

To the extent that certain goods will fall under both categories, the examiner should regard both (broad) categories of goods as identical because the goods that could result from the overlap of those categories would fall within the scope of both lists of goods.

2.2.3.4 *Similarity of goods and services*

Goods and services will be regarded as ‘similar’ if they are not identical but have some connection by reason of their inherent characteristics or of other peripheral factors regarding their use or commercialization that link them.

The examination of similarity aims at establishing possible relevant links between the goods and services that will qualify them as ‘similar’. This in turn will be a factor to decide, at the global assessment stage, whether there is a likelihood of confusion between the conflicting marks.

The examination of similarity requires the examiner to identify the characteristics or factors that connect the goods or services. In practice this means that the relevance of one or more factors will depend on the particular goods and services

covered by the marks in conflict. Rarely will all the similarity factors be present in a single case.

Factors that should be taken into account to establish *similarity of goods and services* include the following, among others:⁹

- nature of the goods and services,
- intended purpose and method of use,
- complementarity,
- competition,
- distribution channels,
- relevant public and consumers,
- the origin, producer or provider of the goods or services.

2.2.3.4.1 Nature of the goods and services

The inherent nature of goods and services is given by their specific characteristics, properties and qualities. These include a product's composition and material, and the way it functions (e.g. electric vs. manually operated).

The nature of a particular product or service is defined by reference to a broader category of goods or services to which it belongs. For instance the nature of a screwdriver is that of being a type of hand tool; the nature of a hat is that of a type of headgear.

However, to determine similarity of goods and services for the purposes of trademark registration, the mere nature of the goods or services will not always indicate that the goods are similar.

For instance, 'floor polishers', 'welding machines', 'hair clippers' and 'electric cars' are all in the nature of 'electric devices' as they operate using electricity. 'Paint brushes' and 'tooth brushes' are both in the nature of 'brushes'. Nevertheless, in spite of their common nature, those products would not be similar because other factors such as their purpose and method of use, usual consumers, producers and distribution channels, etc. will weigh in to make them dissimilar in the final analysis.

2.2.3.4.2 Intended purpose and method of use of the goods and services

The '*purpose*' of a product is the reason for which it was invented or manufactured, and also its intended function or use in practice. For example, the intended

⁹ In this regard see the OHIM Guidelines, Part C, Section 2, Chapter 2, item 3.1.1.

purpose of engine oils is to lubricate the interior of engines; the purpose of sunflower oil or olive oil is not to lubricate engines but to complement human foods.

However, the use to which a particular product may be put will not change the fundamental purpose or function of the product. For example, the purpose or function of a knife is to cut things, regardless of the fact that it could be used as a decorative device.

The '*method of use*' of a product refers to the manner in which the goods are used to realize their purpose. This in turn results from the intended purpose of the product or its inherent nature. However, method of use alone will not determine similarity of goods.

For instance, medicinal and cosmetic products for personal use in liquid, cream or solid presentation may be used and applied on a person's body by the same method, and nicotine patches are applied in the same way as adhesive bandages. However, those products cannot be regarded as similar because their purpose and manner of commercialization are quite different.

2.2.3.4.3 Complementarity of the goods and services

Goods and services may be similar if they are used together or in correlation so as to allow them to achieve their purpose, to function properly or to complement one another.

However, the fact that two products may be used at the same time or in combination, for convenience of the user, does not mean that the products are complementary if their combined use is not necessary for them to function properly. For example, 'rubber boots' and 'umbrellas' are not complementary or similar goods just because they may be used together on a rainy day. 'Soft drinks' and 'bottle openers' are complementary (the bottle must be opened to consume the drink). However, they are not similar because the manufacturers and the inherent nature of those products are different.

Products that are complementary may be regarded as 'similar' to determine likelihood of confusion, even if their inherent nature may be quite different. For example:

- 'tooth paste' and 'tooth brushes',
- 'spectacles (eye-glasses)' and 'spectacle cases'
- 'tennis racquets' and 'tennis balls'
- 'teaching material' and 'educational services'

- 'laundry services' and 'washing powder'.

The goods and services in each tandem above have a different inherent nature (and may have different providers) but can be regarded as similar because they are conceived to work together, are complementary, are addressed to the same consumers or are commercialized through the same channels.

However, bottles, cans and other containers used together with of the goods they contain are not to be regarded as complementary products.

2.2.3.4.4 Competition between the goods and services

Goods or services are in competition when, notwithstanding their different inherent nature, they serve the same or a similar purpose and are addressed to the same sector of consumers. Such goods or services are effectively substitutes of each other and may be interchangeable.

Goods and services that are in direct competition because they are substitutes or surrogates of one another are in fact commercial equivalents and should be regarded as similar for trademark purposes.

For example:

- soya milk and dairy milk
- electric heaters and gas heaters
- hand razors and electric razors

2.2.3.4.5 Channels of distribution of the goods and services

Similarity between goods or services will often result from the fact that they are commercialized or distributed through the same channels or in the same type of shops and points of sale. Channels of distribution, outlets and shops will bring together consumers who will be exposed to the goods (or services) offered at those points of sale. The public will tend to associate the goods by assuming that they have a common production or quality control.

For example: soaps, perfumery, cosmetics, hair lotions, dentifrices, vitamins, food supplements and over-the-counter medicinal products may be found together in the same types of outlet, for instance pharmacies and super market stores. Those

goods may be regarded to be similar to the extent that they share common points of sale.

2.2.3.4.6 Relevant public and consumers of the goods and services

If goods or services are addressed to the same type of public or the same category of consumers, it may be argued that such fact makes those goods or services similar for purposes of finding a likelihood of confusion. The consumers addressed with particular goods or services may be the public at large or specialised consumers and business clients.

Conversely, the fact that two products or services are addressed to customers of very different nature would militate against a finding that the goods or services are 'similar'. For example, 'chemicals used in industry' and 'photographic film' are offered to very different types of consumers and are unlikely to be considered 'similar' goods.

2.2.3.4.7 Origin, producer or supplier of the goods or services

The usual origin of the type of goods or services can be a factor to determine their similarity. If goods or services are usually produced, manufactured or supplied by undertakings of the same type there is a strong indication that such goods or services should be regarded as similar or related.

The type of origin that is relevant for these purposes refers to the general arrangements that allow goods and services to come on the market. This includes the fact that goods are generated by undertakings of a certain type or that economically linked undertakings control the production of the goods and related services.

The geographic origin of the goods or the geographic location of the producers is irrelevant in this connection.

The factors that indicate a usual common origin for goods and services include:

- Type of producer. If different sorts of goods are produced by the same type of industry, those goods will be connected by that fact. For example, industries that provide health care goods are likely to produce not only 'pharmaceutical products', but also 'personal hygiene products', 'soaps', 'cosmetics', 'bandages', 'surgical instruments' and 'dental instruments' and 'orthopedic articles'. Agricultural cooperatives and agro-industries are the usual origin for food products. Products may be regarded as 'similar' to the extent that they are related by the type of industry that generated them.

- Method and technology used in manufacture. For example, textile factories and workshops may produce clothes and wearing items, as well as curtains and boat sails. Companies that have the technology to produce electric and electronic goods may produce a variety of related goods that would be 'similar' because of the technology used.
- Usual trade or marketing practices. It is predictable that certain industries will tend to expand to adjacent or related industries as they develop. Where such is the case, goods and services in these typically adjacent trade sectors would indicate that the goods or services are 'similar'. For example, the clothing industry and the leather accessory industries may connect as they expand. Producers of perfumes and cosmetics may launch a line of accessories including sunglasses.
- Same provider for services and related goods. It is usual that the provider of a service will also provide the goods that need to be used in connection with the purchase of the service. For example, undertakings offering 'spa and gym services' will also offer food supplements, cosmetic products or gym accessories. Those services and the related goods may be regarded as 'similar'.

2.2.4 Relevant public and consumers

Goods and services in the marketplace are offered to the public and to consumers that have different characteristics. The question of likelihood of confusion focuses on the possibility that goods or services put on the market in a particular country may be perceived by the relevant public or consumers as originating from a particular commercial undertaking. In this regard, the characteristics of the relevant sector of consumers to which the goods and services are addressed will be an important factor in deciding whether there is a likelihood of confusion if a later mark were to coexist with an earlier mark.¹⁰

2.2.4.1 *Relevant sector of consumers*

In case of conflict between two marks, the 'likelihood of confusion' to be established refers to the possible confusion affecting the consumers and the public of the country where the examination takes place.

The relevant public is the sector of consumers of the identical or similar goods or services specified for the marks in conflict. The likelihood of confusion should be determined on the basis of the *average* consumer. This includes both *actual* and *potential* consumers.

¹⁰ In this regard see, for example, the OHIM Guidelines, Part C, Section 2, Chapter 6.

A likelihood of confusion should be recognised only if a *significant* part of the relevant consumers in the country would be confused. It is not necessary that all or most of the actual or potential consumers would be confused.

When defining the ‘relevant sector of the public’ or ‘relevant consumers’, it is necessary to distinguish between the *general* public and consumers that belong to *professional* or *specialised* sectors, depending on who the goods or services are addressed to.

- If the similar goods or services covered by *both* marks are addressed to consumers of the *general public*, then the likelihood of confusion should be assessed from the perspective of that type of consumers. Likewise, if the goods or services covered by *both* marks are directed only to professional or specialised consumers, for example, the medical profession, engineers, computer experts, etc. this profile should be considered.
- If the goods or services covered by both marks in conflict are directed equally to the *general public as well as professional or specialised consumers*, then the standard to be applied should be the perception of the goods or services by the general public, which is presumed to have a lower degree of attentiveness.
- If the goods or services covered by one of the marks in conflict are directed to the *general public* and the other mark is used for goods or services that target the *professional or specialised consumers*, then the standard to be used is the perception by the professional or specialised consumers. In this case it is understood that, although the goods or services intended for the general public could also reach the professional sectors, the converse would be quite unlikely because the goods or services for a sector of specialised consumers will normally not be offered to the general public. Therefore, the perception of consumers of the general public is not relevant as they would not be exposed to offers of those goods or services addressed to a professional or specialised sector.

For example, if the earlier mark covers ‘adhesives for industrial and surgical use’ and the later mark covers ‘adhesives and glues for stationery and household purposes’, the relevant consumers of reference will be those that could be exposed to offers of both types of goods, in this case the professional consumers. The general public is unlikely to be exposed to offers of products for industrial use.

Likewise, if the earlier mark covers ‘machines and machine tools; motors and engines; agricultural motorized implements’, and the later mark covers ‘household appliances, namely blenders, cutters and mixers’, the reference group for perception analysis purposes will be the consumers that could be interested in both

types of products, namely the professional consumers. The general public would not normally be exposed to offers of industrial or agricultural machinery.

2.2.4.2 *Relevance of consumers in determining likelihood of confusion*

2.2.4.2.1 Similarity of goods and services

In deciding whether goods or services are similar the relevant consumers of the goods and services will be a factor to consider. In particular, depending on whether the consumer is an intermediate or a final consumer, the goods or services will be more or less likely to be related. Goods that are raw materials or starting inputs to manufacture other products are addressed to industrial, professional or manufacturing customers. Finished products will be addressed and offered to final consumers.

For example, producers of plate glass will normally have as their clients, manufacturers of windows, window panes, mirrors, etc. Plate glass is not sold to end-users. Similarly, the profile of customers that buy building materials is different to that of buyers of houses or of building services.

Where the relevant consumers of the specified goods or services are materially different, the likelihood that confusion may occur will be commensurately lower.

2.2.4.2.2 Similarity of signs

The characteristics of the consumers in a particular sector will also determine the perception of similarity of the signs in conflict. For instance, the meaning and the phonetic features of a sign will be understood and perceived differently depending on the culture and language of the consumers (see item 2.2.3, above).

Signs that are clearly distinct to the average consumer in one country may be confusingly similar to consumers in another country. The examiner must consider the profile of the consumers in the country of filing.

2.2.4.2.3 Distinctiveness of signs

The characteristics of the consumers in the relevant sector of the public in a particular country will determine their perception of the signs in conflict. This perception will determine the level of inherent distinctiveness of a sign in respect of those consumers in that country.

For example, the word mark 'GOURMET – Moderna' for 'food products' may be perceived as generic, descriptive, weakly distinctive or inherently distinctive by consumers in different countries, depending on their knowledge or perception of the words involved.

2.2.4.3 Degree of attention of consumers

When analysing the likelihood of confusion of (identical or similar) marks that are used on goods or services that are similar, it is necessary to consider the degree of attention that is usually exercised by the relevant consumers.

The consumer of reference in each case should be the *average consumer* of the type or category of goods or services in question. The consumer should be presumed to be reasonably 'well informed', reasonably 'observant' and 'circumspect'. The level of attention of the consumer should be expected to vary depending on the type of goods or services to be purchased.¹¹

While the degree of attention of a purchaser may depend on the type of goods and services and on whether the consumers are professional or specialised, other factors can come into play. The degree of attention of an individual purchaser will depend on factors that are independent of the business specialisation of the person. However, it may be assumed that consumers that are active in a professional or specialised field will be less likely to be confused when they purchase goods or services that are familiar to them or that they are used to purchase.

One factor determining the consumer's degree of attention is his *level of involvement* in the purchase of the goods or services. This depends on the degree to which a purchase is important to a particular consumer. The greater the importance of the purchase of a product or service, the greater the purchaser's attention is likely to be. This in turn will reduce the likelihood that the purchaser will be deceived or confused if exposed to similar marks.

A high degree of attention can be expected from consumers that purchase goods or services that are expensive, infrequent or potentially dangerous or hazardous. For instance, purchases of goods such as a house or an automobile, or services such as medical or financial advice, will be looked at more carefully. The same applies to goods such as pharmaceutical products as regards the medical professional that prescribes the product or the consumers that buy those products 'over the counter'.

Conversely, a lower level of attention can be expected in respect of routine purchases of inexpensive goods.

2.2.5 Other factors relevant for a likelihood of confusion

¹¹ See the comments in the OHIM Guidelines, Part C, Section 2, Chapter 6, item 3.

Other factors that are relevant to a decision of likelihood of confusion include the following:

- Families and series of marks
- Coexistence of the marks in conflict in the same country
- Prior decisions involving the same or similar marks

2.2.5.1 Families and series of marks¹²

- ❖ A ‘family’ of marks is a group of marks that share one or more common distinctive elements and are owned by the same person. Those common elements may be inherently distinctive or may have acquired distinctiveness through use or by advertising in the country. The specific distinctive elements shared by all the marks belonging to the same family reinforce the information conveyed by those marks regarding the commercial origin of the goods or services. The marks that form a family of marks will generally be registered (and may be associated to each other for purposes of their assignment), but it is not excluded that some of the marks in a family may be unregistered. Marks that form a ‘family’ of marks may also be characterized as ‘integrated marks’ or ‘association marks’.¹³
- ❖ A ‘series’ of marks is a group of marks that have either been registered simultaneously or have been registered successively and subsequently been associated as a series by a decision of the Office. The marks that constitute a series must all have the same distinctive elements in common. Their variations or differences must relate only to matters that are not distinctive. One practical consequence of having registrations in a series is that the various registrations of the marks that compose the series are ‘associated’ on the trademark register and cannot be assigned or transferred separately. The marks in a series will always be registered, since the series is a formal link established only among registered marks.

The existence of a family or a series of marks could reinforce a finding of likelihood of confusion. If the contested mark contains the same distinctive element that characterises all the marks that belong to the family or series, consumers could believe that the contested mark also belongs to that family or series. Consumers could assume that the goods or services bearing the contested mark have the same commercial origin of the other goods or services. Such erroneous association should be avoided.

Where an objection or opposition to the registration of a later mark is raised on the basis of an earlier mark that belongs to a family of marks, this fact must be invoked and substantiated by the opponent. If the existence of a family or series of marks is established, the examiner should compare the contested mark with the family of marks *as a whole*. The analysis should determine whether the later mark contains

¹² See the provisions in BN TMA s. 42(1)(c) and (2), TMR r. 17; MY TMA s. 24; MM; SG TMA s. 17, TM Manual Relative Grounds for Refusal of Registration p. 39; TH TMA s. 14 and 50; and VN IPL art. 4.19 and Circular 01/2007 s. 37.4.b..

¹³ See for instance the provisions in Vietnam IPL art. 4.19 and Circular 01/2007 s. 37.4.b.

the features that are specific of the marks that belong to the family, such that it is likely that consumers would mistakenly believe that the contested mark is a new addition to the family.

The element that is common to the marks that belong to a family or a series of marks must be *distinctive*. A family or series of marks cannot successfully challenge a later mark on the basis of elements that are generic, descriptive or weakly distinctive.

A family of word marks that is based on a *prefix* or a *suffix* that is fanciful or arbitrary in connection with the type of goods will create a strong case for a finding of likelihood of confusion. For example, the following family/series of marks is based on the fanciful suffix 'KAST':

PanaKast, MyroKast, FramaKast, SaniKast

The following family of marks is based on the main element 'BAY' taken from the name of the BAYER company:¹⁴

Baydur, Bayfil, Baycoll, Baygon, Baysol, Baypran, Baytril, Bayga, Bayfol, Bayflex, etc.

A likelihood of confusion based on a prior series of marks will require that the later mark include the distinctive element of the series in identical form or in a form that is very closely similar. This may include the position of prefixes and suffixes, since the position of the distinctive element is one of the factors that characterises the marks in the family or series. This may have an exception where the affixed element is so strongly distinctive that it can stand on its own. In this case, a shift in its position will not remove the likeliness of association.

2.2.5.2 *Prior coexistence of the marks in conflict in the same country*

The fact that the marks in conflict have coexisted in the same market for a substantial period of time is a factor that should be taken into account.

For coexistence to be relevant as a factor that militates against a finding of likelihood of confusion, it must be based on simultaneous use in the marketplace within the national territory. The applicant must prove that the mark had already

¹⁴ See <http://www.bayer.com/en/products-from-a-to-z.aspx> .

been used in the country and that no confusion or likelihood of confusion has been noticed.

The period of coexistence should be sufficiently long to allow for an assessment of the effects of such situation. Moreover, that coexistence must be peaceful, in the sense that it is accepted or tolerated by the parties involved. Coexistence in the midst of *inter partes* proceedings would not be a valid coexistence for purposes of dispelling a likelihood of confusion.

This will also bring into play the provisions of national law relating to the rights that derive from the use of *unregistered* marks. Where the law provides that rights accrue from use in the market, or that '*honest concurrent use*' generates common law rights, these factors may be dispositive in the opposition.¹⁵

2.2.5.3 *Prior decisions involving the same or similar marks*

If the mark filed for registration and the earlier, cited mark have already been confronted on an earlier occasion in the country, and a decision has already been issued in that connection, this fact should be taken into account by the examiner. The examiner should consider with special care whether a similar decision should be taken in the case on hand.

A decision taken by the trademark office or by another authority in an earlier case will normally *not* be binding on the examiner or the office in deciding a later case. However, for reasons of legal security and predictability, the office's decisions should be coherent and consistent, and the same facts should result in the same solution, where applicable. In taking its decisions the office should adhere to the principles of equal treatment and sound administration.

The examiner should therefore assess the relevance of the facts of the earlier case and the analysis and legal reasoning sustaining the earlier decision. If the facts and the reasoning of the earlier case are also applicable to the case under consideration, the earlier decision should be taken into account and the examiner's decision should, where relevant, be consistent with the earlier decision on the similar case.

However, the examiner should distinguish a prior case from the one on hand where the facts and circumstances cannot be assimilated. The examiner's conclusions should be based on the facts and circumstances of the case under examination, even if this leads to a decision that is different from the prior decision on the similar earlier case. The examiner should exercise caution because an identity of marks and goods or services in two cases coming up at different times may hide factual and legal circumstances that are materially different in each case.

¹⁵ See the provisions in BN TMA, s. 10; MY TMA s. 20; SG TMA s. 9.

2.2.6 Global assessment of likelihood of confusion

2.2.6.1 Need for a global assessment

The ultimate purpose of the substantive examination of the various factors relating to conflicting signs is to determine whether there is a likelihood that confusion may occur in trade if both signs were allowed to coexist in the marketplace in a particular country. This requires that all the relevant circumstances be taken into consideration in a single global assessment.

In this connection, the fact that two signs may be visually, phonetically or conceptually similar, or that the relevant goods or services are identical or similar, will not necessarily determine a likelihood of confusion. Other factors, in particular the distinctiveness and reputation of the earlier sign will play a major role.

A likelihood of confusion may only be established after a global assessment is made considering all the factors and circumstances that are relevant in each particular case. Those factors include:

- the similarity of the goods or services involved,
- the similarity of the signs in conflict,
- the relevant public and consumers
- other relevant factors.

It is recalled that the global analysis approach means that a later mark should not be refused registration just because it is similar to an earlier mark, or because the goods or services covered are identical or similar. Rather, the ground for refusal should be that -- if the later, contested mark were to be used in the market in the country concerned -- there is a likelihood that the relevant consumers would be confused as to the commercial origin of the goods or services. The registration should be refused to prevent a likelihood of confusion in the marketplace.

2.2.6.2 The principle of interdependence of factors

The abovementioned factors that may indicate the existence of a likelihood of confusion are *linked* and *interdependent*. The principle of interdependence means that all factors need to be weighed and that some of them have a greater influence in finding a likelihood of confusion, in particular the similarity of the relevant goods and the similarity between the signs in conflict.

Interdependence also means that, in preparing the global analysis, the lower impact of one of the factors may be balanced by the higher impact of one or more of the other factors. In this regard the European Court of Justice has held as follows:

“19 That **global assessment** implies some **interdependence** between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital in the preamble to the Directive [First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1)], which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”¹⁶

For the final global assessment of likelihood of confusion, the examiner should combine the conclusions arrived at with respect to the individual factors that were analysed. The examiner should, in particular:

- evaluate the degree of similarity between the goods and services and factor in the level of attention of the relevant consumers in respect of those goods or services;
- consider whether the signs in conflict have elements that are identical or only similar, and weigh the degree of similarity between the signs and the elements of each sign that sustain such similarity (are those elements distinctive, or merely descriptive or laudatory?); and
- consider the degree of distinctiveness of the earlier, cited mark as a whole (is that mark weak, inherently distinctive, or well-known?).

The examiner must arrive at a conclusion based on his personal assessment of all the above-mentioned factors. Each case will be different and seldom will a case be so clear-cut that it can be dismissed without a full analysis of all the factors.

¹⁶ See paragraph 19 of the judgment of 22 June 1999 in the case C-342/97, Lloyd Schuhfabrik Meyer vs. Klijsen Handel, regarding their marks LLOYD and LOINT'S to distinguish shoes.

3 Well-known signs

3.1 *General considerations*

The existence of a sign that has enhanced distinctiveness or reputation may be a ground for refusal of the registration of a later mark if the use of the later mark is likely to cause confusion in the marketplace as to the commercial provenance of the goods or services in question.

Signs that have enhanced distinctiveness or reputation are also referred to in these Guidelines as 'well-known signs'. Such signs will usually be trademarks, but they may also consist of trade names, geographical indications or other business identifiers.

The Paris Convention and the TRIPS Agreement establish an international obligation to give protection to well-known marks (no express reference is made to other well-known signs). That protection is regarded as a minimum. National laws may and often do protect well-known signs above that minimum level.

The international minimum protection refers to both unauthorised use and to unauthorised *registration* of a well-known mark. The relevant provisions of the Paris Convention read as the follows:

Article 6*bis*

(1) The countries of the Union undertake, *ex officio* if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

The supplementary provisions of the TRIPS Agreement are the following:

*Article 16
Rights Conferred*

1. [...]
2. Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.
3. Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

These international standards have been taken up by the ASEAN countries and are reflected in their trademark laws and administrative provisions.¹⁷

3.2 Obligation to refuse registration of a conflicting mark

The implementation of the international provisions quoted above require that an unauthorized application to register a mark that contains, or is confusingly similar to, a mark that is well-known in the country be refused.

Under those provisions and the corresponding provisions in the national law, a decision to refuse the registration of a conflicting mark should be taken at least where the following conditions occur:

¹⁷ See the provisions in the laws of BN TMA s. 8(3), 9(1)(b) and 54; KH TML art. 4(e) and (f), 25 and 26, TM Manual p. 48 to 53; ID TML art.4, 6(1).b), 6(2), and TM Guidelines chapter IV.B.2.1).b); LA IPL art. 3.13, 16 first paragraph items 2 and 3, and second paragraph, 23.10 and 23.12, Decision 753 art. 38; MY TMA s.14(1)(d) and (e) and 14(2), 70B, TMR r. 13A and 13B; MM; PH IP Code s. 123.1.e and f, TMR r. 102, TM Guidelines chapter XI, p. 119 to 121; SG Act s. 2(1) – ‘well-known trade mark’, 8(4), (5) and (6), TM Manual ‘Relative Grounds for Refusal of Registration’ p. 13 and 37; TH; and VN IPL art. 4.20, 74.2.i) and 75, Decree 103/2006 art. 6.2, Circular 01/2007 s. 42.

- (i) the conflicting mark contains, or is confusingly similar to, the well-known mark,
- (ii) the essential part of the conflicting mark constitutes a reproduction of the well-known mark, or
- (iii) the conflicting mark constitutes an imitation liable to create confusion with the well-known mark;

and

- (a) the conflicting mark is to be used on identical or similar goods or services, or
- (b) the conflicting mark is to be used on goods or services which are not similar to those in respect of which the well-known mark is registered, if that use of the conflicting mark in relation to those goods or services would indicate a *connection* between those goods or services and the owner of the registered well-known mark, and provided that the interests of the owner of the registered well-known mark are likely to be *damaged* by such use.

A substantial part of the examination to refuse a registration on the basis of a prior well-known mark will be performed using the same criteria that have been discussed above as regards the identity or similarity of goods and services and the identity or similarity of marks.

Where an opposition is based on a well-known mark that covers goods or services that are not identical or similar to those of the challenged mark, the examination must also deal with the following matters and the corresponding evidence:

- the extent to which the *mark is well known*,
- the extent to which the use of the conflicting mark on dissimilar goods or services would *indicate a connection* with the owner of the well-known mark, and
- the extent to which such connection would *damage the interests* of the owner of the well-known mark.

The *connection* between the use of the conflicting mark on dissimilar goods or services and the owner of the earlier well-known mark will depend, among other factors, on the degree of similarity between the conflicting marks, the similarity between the respective goods or services, the distinctiveness of the earlier mark

and the strength and scope of the reputation of the earlier mark. These questions relating to the required connection are dealt with under item 2.2, above.

The following sections deal with the questions of the extent to which the earlier mark is *well known*, and the extent to which the interests of the owner of the well-known mark could be *damaged* by a connection with the opposed mark.

3.3 Determining whether a mark is well known

An opponent that claims extended protection for a mark on grounds that it is well known or has a reputation must submit evidence to support the allegation. The examiner must examine the evidence submitted, which should be clear and convincing. The examiner is not required to perform research *ex officio* on the facts of the case, but may use any relevant information that is public knowledge.

All evidence may be useful in establishing the status of a mark as being well known. The opponent may submit evidence of any nature that may show that his mark is well known or has enhanced distinctiveness or a reputation. The evidence must be examined as a whole, weighing the probative value of different elements. The evidence may focus on one or more of the following facts that relate to the extent to which the mark is known to the public:¹⁸

- the degree of knowledge or recognition of the mark in the relevant sector of the public in the country, as a result of use in trade or promotion and advertising;
- the duration, extent and geographical area of any use of the well-known mark in trade, in the country or in other countries;
- the duration, extent and geographical area of any promotion of the well-known mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- the duration and geographical area of any registrations and applications for registration of the well-known mark;

¹⁸ See the provisions of KH TM Manual p. 48 to 53; ID TM Guidelines chapter IV.B.2.1).b; LA IPL art. 16 second paragraph, Decision 753 art. 38; MY TMR r. 13B; MM; PH TMR r. 102, TM Guidelines chapter XI, p. 119 to 121; and VN IPL art. 75, Circular 01/2007 s. 42.3. Also the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO, 1999 (hereinafter called “the WIPO Joint Recommendation”).

- the record of successful enforcement of rights in the well-known mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
- the value associated with the well-known mark.

These factors should not be regarded as cumulative or exclusive conditions to determine whether a mark is well-known. The determination in each case will depend upon the particular circumstances. In some cases all of the factors may be relevant, and a decision may be based on additional factors that are relevant to the case.¹⁹

Bad faith

In establishing whether a mark is well known, an opponent may also submit evidence that the application for registration of a mark that is identical or confusingly similar to a well-known sign was filed in *bad faith*. Possible bad faith by the applicant is a factor that the examiner should consider when analysing the conflicting interests in an opposition based on a prior well-known sign. In this connection see also item 3.5.4 and chapter 10, below.²⁰

For example, in Indonesia the following mark (on the left) was refused on grounds that the applicant had filed for registration in bad faith, considering his knowledge of the existence of the earlier well-known sign (on the right):

¹⁹ See the WIPO Joint Recommendation, Article 2(1)(c).

²⁰ Regarding bad faith the WIPO Joint Recommendation, Article 3(2), provides:

“(2) [*Consideration of Bad Faith*] Bad faith may be considered as one factor among others in assessing competing interests in applying Part II of these Provisions.”

Also see the provisions in BN TMA s. 6(6); KH TML, art. 14.e; ID TML art.4; LA Decision 753, art 36, paragraph. 6, item 7; SG TMA, s. 7(6) and 8(5) and (6).



for restaurant services

vs.



Well-known sign belonging to Major League Baseball Properties, Inc., USA

Means of evidence

The opponent is free to submit means of evidence that tend to demonstrate that the opposing sign is well known in the country. The evidence will aim at persuading the examiner that the opposition should be upheld because the opponent's mark is well known as claimed and could suffer prejudice if the opposed mark were used.

The type of evidence that could be submitted by the opponent may include:

- affidavits and sworn statements from competent bodies, e.g. chambers of commerce or associations of producers
- earlier decisions of courts or administrative authorities, including the Office that is hearing the case
- opinion polls and market surveys
- audits and inspections
- experts' certifications and awards
- articles in the press or in specialised publications
- advertising and promotional material
- reports on expenditure in promotion and advertising of the mark
- reports on economic results, sales figures

- company profiles
- invoices and other commercial documents.²¹

However, to determine that a mark is well known, the examiner may not request or expect evidence relating to the following facts:

- that the opponent's mark has been used in the country (the mark's reputation in the country may have been obtained without any actual use therein);
- that the mark has been registered or that an application for registration of the mark has been filed in or for the country;
- that the mark is well known in another country,
- or that the mark has been registered or that an application for registration of the mark has been filed in or for a foreign country
- that the mark is well known by the public at large in the country.²²

Those facts go beyond the standard requirements for the purposes of receiving legal recognition of a well-known mark and would not be relevant to the issue of whether a mark is well known to a particular sector of consumers in the examiner's country.

In particular, it should be noted that the protection that is due to a well-known sign is based on the fact that it is well known or enjoys a reputation in the country where protection is sought. Registration should not be required.

3.4 Determining the 'relevant sector of the public'

The relevant sector of the public in cases of opposition based on an earlier well-known mark are the average consumers of the goods and services for which the well-known mark is used or registered. This is the sector of *actual* or *potential* consumers to which the goods or services are normally directed, or who are familiar with the goods or services for professional or commercial reasons.

²¹ See the OHIM Guidelines, Part C, Section 5, Chapter 6, item 3.1.4.4.

²² See the WIPO Joint Recommendation, Article 2(3)(a).

Relevant sectors of the public include, but are not necessarily be limited to:

- actual and potential consumers of the type of goods or services to which the well-known mark applies;
- persons involved in channels of distribution of the type of goods or services to which the mark applies;
- business circles dealing with the type of goods or services to which the mark applies.²³

Knowledge of the mark by one relevant sector of the public in the country will be enough to consider the mark as well-known. For example, if a mark is well known by the members of the business community that deal or trade in the country with the type of goods or services in question, that knowledge should be regarded as sufficient.

The standard for a mark to be regarded as ‘well known’ is set at the level of ‘knowledge by the *relevant sector* of the public’. Knowledge by all relevant sectors of the public in the country is not necessary. Therefore, the ‘relevant sector’ of the public will never mean that the general public at large must be familiar with the mark. Such widespread knowledge is unlikely to occur in most cases, and only a few famous marks would be able to meet that standard.

3.5 Damage to the interests of the owner of a well-known mark

3.5.1 Types of possible damage to owner of a well-known mark

An opposition based on an earlier mark that has reputation or is well known should submit at least *prima facie* evidence that use of the contested mark would cause damage or prejudice to the holder of the earlier well-known mark.

Damage or prejudice to the holder of an earlier well-known mark may result from one or more of the following undesired effects that are likely to derive from an unauthorised use of that mark:

- ❖ a detriment to the *distinctiveness* of the well-known mark, or dilution by *blurring*,
- ❖ a detriment to the *reputation* of the well-known mark, or dilution by *tarnishing*,

²³ See the WIPO Joint Recommendation, Article 2(2).

- ❖ taking *unfair advantage* from the unauthorised use of the well-known mark, also referred to as *free-riding* or commercial *parasitism*.

In any case of unauthorised use of a well-known sign, one or more of those undesired effects may occur simultaneously.

The following example illustrates the case where the above-mentioned levels of prejudice may concur to the detriment of the holder of a well-known sign:

“STARBUCKS COFFEE” vs. “STAR BACK CAFÉ”



[Illustration provided by the Brunei Darussalam IP authorities]

3.5.2 Detriment to the *distinctiveness* of a well-known mark

The unauthorised use of a well-known mark is likely to affect negatively the distinctiveness of that mark. This adverse effect may also be described as a dilution of the distinctiveness of the mark by a blurring of the unique identity of the sign. The uniqueness and distinctive strength of the well-known mark are lessened, ‘whittled away’ as a consequence of the uncontrolled use of the well-known mark.

The dilution of the distinctiveness of the well-known mark has the effect that the unique distinctive strength and identity of the mark ceases to be capable of evoking in the mind of the consumers an immediate and unambiguous association with the goods or services that the mark covers. As the uniqueness of the well-known mark is blurred by the arrival and presence on the market of other identical or similar

signs for the same or similar goods or services, the earlier mark ceases to have a strong presence in the minds of the consumers, and the immediate connection of the mark to the goods and services of the holder will start to fade.

This effect is detrimental to the holder of the well-known mark because it effectively diminishes the distinctive and commercial value of the mark. The distinctiveness that allowed the owner of the mark to attach consumers to the goods and services covered by that mark is reduced. The distinctive value of a well-known sign is built through heavy investment in the quality of goods and services and in promotion and advertising sustained over time. If the status of distinctiveness of the mark is diluted, that investment is lost to a substantial extent.

When the opponent raises an issue of detriment or dilution of the distinctiveness of a well-known mark by blurring, he must prove the allegations. Ideally this would be done by submitting evidence to indicate that the relevant consumers have changed their behaviour and consumption pattern moving away or approaching less the goods or services identified by the well-known mark, as an effect of the mark's strength having diminished.

However, the opponent is not required to prove actual detriment or dilution of the distinctiveness of the mark. It is enough if evidence is submitted of the *likelihood* that such dilution would occur if the contested mark were used. The examiner must be persuaded that there is a *serious risk* that such damage could occur. The likelihood of detriment may be based on logical inferences from an analysis of the possible adverse effect on the distinctiveness of the mark. This should take into account the normal practice and operation of the market for the goods and services concerned, and the relevant consumers.

The so-called '*avalanche effect*' may also be considered as a justification for the opposition. The danger of allowing a first instance of dilution of the distinctive uniqueness of a well-known mark is that other cases may follow at an increasing rate. The ultimate effect could be that the distinctiveness of the well-known mark would disappear under an 'avalanche' of unauthorised, uncontrolled uses by other traders operating with identical or similar signs. Therefore, the first use of a sign identical or similar to the well-known mark can already give rise to a serious likelihood that dilution would in fact occur.

Detriment to, or dilution of, the distinctiveness of a well-known mark is all the more likely where that mark is highly distinctive, in particular where such distinctiveness is inherent. The stronger the distinctiveness and uniqueness of the mark, the likelier it is that an unauthorised use of the mark or of a similar sign would be detrimental to that distinctiveness.

Conversely, if the well-known mark is not inherently distinctive, or is composed of elements that are commonplace or descriptive, other traders may find themselves

in the need to use those expressions to operate normally in trade. In such cases, an argument of dilution by blurring may be harder to substantiate.

3.5.3 Detriment to the *reputation* of a well-known mark

Detriment to the *reputation* of a well-known mark means that the good image and positive associations evoked by that mark become *tarnished*, tainted or degraded by an unauthorised use of the mark or of a similar mark. Such use would cause the good image and positive associations of the mark to be replaced in the mind of the consumers by associations with negative values or connections that are injurious to the good name of the mark.

This dilution by *tarnishing* would occur, in particular, if the contested mark were to be used in connection with goods or services that are incompatible with the image that the well-known mark has in the eyes of the public, or used in a context that is degrading, obscene or otherwise inappropriate for that image. It is not necessary that the goods or services be of a kind that would be used in activities that are inherently of low moral value. It is enough that the nature and intended use of the goods or services be in contradiction or in contrast with the overall message conveyed by the well-known mark.

For instance, if a well-known mark is used for perfumes, fragrances and cosmetics that convey a message of glamour and exclusivity, the use of the same or a similar mark for household disinfectant products would, in the mind of the relevant consumers, associate the well-known mark to goods and services far removed from the image built by the holder of the well-known mark for its goods and services.

If the opposition is based on dilution by tarnishing, the opponent should submit arguments and evidence that will persuade the examiner that the use of the contested mark would be likely to conjure in the mind of the relevant consumers associations with values or images that could be destructive or conflictive with the image conveyed by the well-known mark. The opposition must argue and show that the goods or services of the contested mark have characteristics that are negative in relation to the goods or services of the well-known mark.

For example, the reputation of a mark applied to higher educational services and related academic activities would be degraded or tarnished if a third party were allowed to use that mark for bar and night-club entertainment services. Such association would predictably be detrimental to the reputation of the well-known mark.

It should be noted that damage to the reputation of a mark may also spill over to affect the reputation of the owner of that mark. Therefore, depending on the nature

of the unauthorised use of a well-known mark, the disrepute of that might not easily be contained and could effectively have an impact on the overall image and reputation of the undertaking to which that mark belongs.

3.5.4 Taking *unfair advantage* from a well-known mark

Taking *unfair advantage* of the distinctiveness or the reputation of a well-known mark is a particular case of encroachment on the rights in a well-known mark. This covers the cases where an unauthorised third party uses the well-known mark, or a sign that is very similar to it, in a way that is commercially beneficial to that party and to its goods or services, and such use *free-rides* on the distinctiveness and reputation of the well-known mark.

This unfair practice relies on sponging benefits from the image, attractiveness and reputation of another person's well-known mark. By using the well-known mark, the sponger *transfers* or takes over a part of the image and good name of the earlier mark for his own goods or services. There is a misappropriation or 'abduction' of the earlier mark's distinctiveness and reputation.

Such use by the third party is unfair because it will not require any major investment or effort in creating or maintaining the distinctive strength and reputation of the well-known mark, and because it is not authorised by the owner of that mark. This behaviour is characterised as *commercial parasitism* and, under the provisions of the relevant laws, such unauthorised use could be an actionable act of unfair competition.²⁴

²⁴ See the decision of the Supreme Court of the Philippines on 18 August 2004, in the case G.R. No. 143993, McDONALD'S CORPORATION et al. *vs.* L.C. BIG MAK BURGER, INC. et al. ("Big Mac" case), at http://www.lawphil.net/judjuris/juri2004/aug2004/gr_143993_2004.html .

In this case the first instance trial court stated that:

"The [...] provision of the law concerning unfair competition is broader and more inclusive than the law concerning the infringement of trademark, which is of more limited range, but within its narrower range recognizes a more exclusive right derived by the adoption and registration of the trademark by the person whose goods or services are first associated therewith. [...] Notwithstanding the distinction between an action for trademark infringement and an action for unfair competition, however, the law extends substantially the same relief to the injured party for both cases. [...]"

Any conduct may be said to constitute unfair competition if the effect is to pass off on the public the goods of one man as the goods of another. The choice of "B[ig] M[ak]" as trade name by defendant corporation is not merely for sentimental

Where the opponent argues that the use of the challenged mark would entail taking unfair advantage of the distinctiveness or reputation of the well-known mark, he should provide evidence that may allow the examiner to arrive at that conclusion.

The evidence should show that the association of the contested mark with the well-known mark would transfer the distinctive strength and reputation from one to the other. To this effect proof should be directed to the strong inherent or acquired distinctiveness of the mark that would be misappropriated, the similarity of the signs, and the connection or link between the goods and services of the two marks.

In this respect, if there were a likelihood of *crossover* between *neighbouring markets* or consumer habits or trends that connect the respective goods and services, this must be evidenced as the unfair image transfer would occur more easily in these cases. Actual or potential uses of the well-known mark in licensing and *merchandising* arrangements would also be indicative of this.

Unlike the cases of detriment to the distinctive character or the reputation of a well-known mark, the free-riding on that distinctive character or reputation would not, in itself, directly cause an economic damage to the mark or to its holder. Rather, it affords an economic benefit to a third party; such benefit is unfair because it does not derive from any significant effort or investment made by that party. Nevertheless, such 'parasitic' benefit does not cause a direct, coterminous economic prejudice to the well-known mark or to its holder (unless the distinctiveness or reputation of that mark is impaired).

Therefore, the rationale behind refusing a registration on grounds of free-riding on the distinctive character or reputation of a well-known mark is based mainly on public policy that aims at preserving a level playing field among competitors, and preventing acts that would constitute or support unfair commercial practices or unfair competition.

reasons but was clearly made to take advantage of the reputation, popularity and the established goodwill of plaintiff McDonald's." [...]

The Supreme Court added that:

"Absent proof that respondents' adoption of the "Big Mak" mark was due to honest mistake or was fortuitous, the inescapable conclusion is that respondents adopted the "Big Mak" mark to "ride on the coattails" of the more established "Big Mac" mark. This saves respondents much of the expense in advertising to create market recognition of their mark and hamburgers."

4 Earlier unregistered marks

An opposition and the refusal of a registration may be based on a prior right in an unregistered mark. This will depend on the extent to which, under the applicable law, the *use of a mark in trade* gives the user an exclusive right in that mark in connection with particular goods or services, or at least the right to oppose the unauthorized registration of the earlier used sign.

This includes cases where, as provided in the applicable law, the use of a mark in trade within the country confers on the user a *right to prevent* third parties from using the same or a similar mark in a way that would cause confusion in the marketplace or among the relevant consumers,

Recognition of rights in earlier unregistered marks may be implied in provisions that proscribe registrations applied for '*in bad faith*' (see chapter 10, below). In this context bad faith refers to the knowledge by the applicant of the existence of an earlier unregistered mark that is identical or confusingly similar to the mark that is filed, owned or used by another person who has a legitimate claim to that mark.

Rights in earlier unregistered marks are also indirectly recognised in laws that prohibit '*passing off*' goods or services as those of someone else, and in provisions that deal with '*honest concurrent use*' of the same or a similar mark by two different persons in the same country.²⁵

In these cases, the opposition to the registration will be based on the precise scope of the prior use, as there would be no registration to serve as a basis. The opponent would have to prove both that he is using the mark in the country and that such use relates to goods and services that are identical or similar to those specified in the application.

The opponent must submit the relevant evidence and the examiner would need to establish, as a first step, that the alleged use and the alleged scope of such use are actually taking place. Only the factual situation within the country at the time of the opposition would be relevant to this effect.

Once the facts that determine the contour and scope of the user-based rights have been established, the examination should proceed in the usual manner to decide

²⁵ In this connection see the provisions in BN TMA s. 5(2), 8(4)(a) and 10; KH TML art. 26; ID TML art.4; MY TMA s.14(1)(a), 19(4) and 20, TM Manual chapter 13 – items 13.65 to 13.76 on 'Honest concurrent use'; MM; SG TMA s. 8(7)(a) and 9, TM Manual chapter 7 p. 13 item (h) and p. 37 item (d); TH TMA s. 46 second paragraph; and VN IPL art. 74.2.g.

whether the mark presented for registration would create a likelihood of confusion with the earlier unregistered mark.

If the law recognises rights deriving from the 'honest concurrent use' of a mark, the examiner should apply the relevant provisions accordingly.

The following case from Malaysia provides an example of rights resulting from honest concurrent use of marks:²⁶

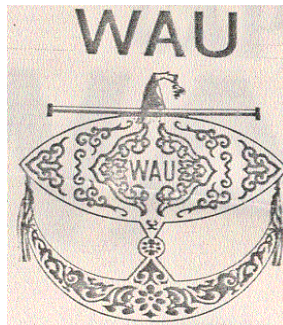
Case III: Application N° 90000355

Mark:



Goods/Services: *Edible oil (class 29).*

Earlier registered mark: - M/083601



Goods/Services: *Edible oil (class 29).*

These marks were allowed to coexist on the basis of consent from the holder of the earlier registered mark. The condition to allow the registration of the later mark was that the mark should be only in relation to goods manufactured and sold in the West Coast of Malaysia.

²⁶ Information provided by the Malaysia IP authorities.

5 Earlier geographical indications

Geographical indications are recognised and protected in the ASEAN countries. In most of them geographical indications may be registered as such and exclusive rights to their commercial use may be established.

Where geographical indications (GIs) can be registered as such, an opposition to the registration of a mark may be based on an earlier registered geographical indication, in the same way as an earlier registered mark. A well-known GI could be cited against the registration of a mark that would cause confusion or take unfair advantage of the reputation of the GI.²⁷

Unlike trademarks, geographical indications are extremely focussed in their coverage of goods (services are generally not covered in GI registrations). Because of their nature, GIs distinguish only a precise category of goods having very specific characteristics and originating from a precisely defined area of production.

A geographical indication cannot be used to distinguish goods or services different from those expressly specified in the registration of the GI. This will usually confine the issue of similarity of goods to those specified in the registration of the GI, and to goods closely related or derived from them, as well as ancillary and related services. The fact that a GI is registered for only one or a few specific goods does not mean that the GI cannot be protected against a trademark registration that would affect its exclusive commercial exploitation rights.

Where a GI is highly distinctive, has a reputation or is well known, the extended protection afforded to well-known marks would apply equally to GIs. In this case, the same issues of similarity or broader likelihood of connection or association with other goods or services would have to be considered. Like with well-known marks, a contested mark may have to be refused registration or limited where there is a risk of unfair transfer of distinctiveness and reputation from a well-known GI to an unauthorised third party's trademark.

When performing the global assessment to decide on the likelihood of confusion, the examiner should bear in mind a particular factor that is specific to GIs. Unlike trademarks, trade names and other business identifiers, the producers that use a

²⁷ See the provisions in KH Law on Geographical Indications Art. 31 first and second paragraphs; ID TML art. 6(1).c); LA IPL art. 3.18, 23.13 and 23.14, Decision 753 art. 44; MY TMA s. 3 – 'geographical indication', s. 10(1)(d), 14(1)(f) and (g); MM; PH IP Code s. 123.1(g) and (j); SG TMA s. 2(1) – 'geographical indication', s. 7(7) and (8), Geographical Indications Act of 1999 s. 2 – 'geographical indication' and s. 3(2) and (4); TH TMA s. 8(12); and VN IPL art. 4.22 and 74.2.e), k) and L), Circular 01/2007 s. 39.12.a.ii).

GI do not have flexibility to choose their sign. A GI will necessarily consist of, or include, a geographical name derived from the name of the region or location where the relevant goods are produced. Commercial companies and other undertakings, by contrast, have unlimited freedom to create or choose the signs that will constitute their trademarks.

Under these circumstances, the a successful defence of a GI can be especially critical for the commercial viability of the GI. A trademark that contains or is similar to a protected GI, applied to the same or similar products, could directly affect the distinctiveness and reputation of the GI.

A trader that adopts a mark is presumed to have a broad freedom to choose a sign or to create his trademark. If he purposely choses a sign that is identical with, or similar to, the protected GI (for the same, similar or related goods or services) that choice could be regarded as an attempt to free-ride on the GI's reputation. An opponent could make a case that the registration of a GI as a trademark is a registration in 'bad faith'.

6 Earlier trade names and names of other entities

Prior rights that may be invoked as relative grounds to refuse a trademark registration include rights acquired in business identifiers such as:

- trade names
- company names
- names of unincorporated entities
- domain names.

6.1 Trade names and company names

A *trade name* is the name that identifies a trader or a business that operates in the marketplace in a particular country. It is a flexible concept that does not have an agreed definition in any international agreement, but is recognized and defined in many IP laws.

An exclusive right in a trade name is acquired by the first use of the name in the territory of the country. Use of the trade name will usually need to be at a national level or at least more than just of local level.

A trade name must be protected even if the name is not registered, and regardless of whether the same name is used or registered as a mark. In this respect, the Paris Convention provides as follows:

Article 8
[Trade Names]

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

A *company name* is the official name of a company or similar organisation as it appears on its articles of incorporation. The company name is established under its statutes and is included among the particulars of the company when it is entered on the register of companies.

Unlike a trade name, a company name is not necessarily the name by which a company or trader is known by the public in a particular market. However, often the official name of incorporation or an abbreviated version thereof, becomes the trade name of the company. The trade name may in turn be adopted as a

company's 'house mark' and be registered as a mark or become the basis for a family of marks.

To the extent that a person has acquired an exclusive right in a trade name or in a company name, that person may invoke that right in opposition proceedings. The examiner should raise an objection against a mark that reproduces or includes a trade name or a company name where the use of such mark for the specified goods or services is likely to cause confusion or a false impression of association or of commercial connection with the owner of the trade name.²⁸

The examiner should consider the line of business and the actual commercial activity of the trader or company that owns the trade name, and compare them to the goods and services specified in the challenged application. If the nature of the goods and services is such that they would be identical, similar or substantially related to the business activity of the trade name holder, an objection should be raised.

As regards the similarity of signs, it is often the case that a trade name and, even more so, a company name will consist of elements that are generic, descriptive or otherwise devoid of any distinctive character. In these cases, the trade name or company name would only be protected if both signs were identical.

Where the trade name or company name includes one or more distinctive elements, these elements should be the basis for a comparison of the signs in conflict. However, it is usually the case that such distinctive elements of trade names are also registered as trademarks.

6.2 Names of unincorporated entities

The names of unincorporated and not-for-profit organisations such as sports associations, foundations, cooperatives, clubs, also attach exclusive rights that can justify an opposition to the registration of a mark that is identical or similar.

As with trade names, the question of the possible connection between the activities of the opposing entity and the goods or services contained in the trademark application would have to be examined by the Office.

²⁸ See the provisions in BN TMA s. 8(4)(a) and (b); KH TML art. 2(c), 4(e) and (f), and 2; ID TML art.6(3).a); LA Law art. 3.14 and 23.11, Decision 753, art. 37; MY TMA s. 14(1)(a); MM; PH IP Code s.165.2; SG Act s. 8(7)(a) and (b), and s. 8(8); TH TMA s.8(9); and VN IPL art. 4.21, 6.3.b) and 74.2.j), Circular 01/2007 s. 1.6, 39.2.h) and 39.12.a).iii).

6.3 Domain names

A domain names has been defined as “a series of alphanumeric strings separated by periods, [...] that is an address of a computer network connection and that identifies the owner of the address”.²⁹ A domain name will usually serve to identify an internet website or a series of pages in a website.

A domain name as such is not an object of intellectual property. Registration of a domain name with a registration authority does not generate exclusive rights.

However, it is often the case that domain names are formed by inserting, among its constitutive elements, a trade name or a trademark belonging to the user of the domain name. In this case, any unauthorised use of a domain name that contains another person’s trademark or trade name could be regarded as an unauthorised use of that trademark or trade name .

An attempt to register as a trademark a domain name that includes a mark or a trade name that belongs to another person could give rise to an opposition on the basis of the exclusive rights in the mark or trade name.

Moreover, if a distinctive domain name were used in trade or on the internet in such a way that it becomes well known within the territory of a country, such use may generate prior user rights akin to those of an unregistered mark. This would depend on the provisions in the laws of the countries concerned. Where such rights are established, they could be the basis for an opposition to challenge the registration of a mark that would be likely to cause confusion with the domain name as used by its proprietor.

²⁹ <http://www.thefreedictionary.com/domain+name>

7 Other earlier intellectual property rights

A mark may conflict with the exclusive rights conferred under other intellectual property rights, in particular rights acquired under the laws of industrial designs and of copyright that protect certain works that could be used as trademarks.³⁰

7.1 *Industrial designs*

If the shape of a product is registered as an industrial design, or otherwise protected as an unregistered design under the applicable law, that shape may not be commercially used without authorisation from the design right holder. That shape may not be registered, in particular, as a three-dimensional mark without due authorisation or consent of the holder of the exclusive right in the design.

Depending on the scope of the exclusive rights provided under the design law, the design right may apply regardless of the goods for which a trademark would be registered, or could be confined to the category of products in which the design is embodied.

Even if the trademark law does not expressly mention prior design rights as a basis to refuse the registration of a mark, such grounds for refusal would result directly from the provisions of the design law itself. An opposition to the registration of a mark could therefore be filed on the basis of an earlier design right, in particular where the shape of the trademark is identical or cannot be distinguished from the protected design.

7.2 *Works protected by copyright*

Copyright in works may be the basis for an opposition to the registration of a mark. This may be the case, in particular where works or the titles of works are used in trademarks without due authorisation.

7.2.1 Works included in trademarks

Figurative and three-dimensional works can, and often are, used as trademarks or as parts of trademarks.

³⁰ See the provisions in BN TMA, s. 8(4)(b); KH art. 14(e); ID TML art. 4; LA IPL art. 23.3; MY TMA s. 14(1)(a); MM; PH IP Code s. 4.1.d, ; SG TMA s. 8(7)(b); TH TMA s. 8(9); and VN IPL art. 74.2.m), Circular 01/2007 s. 39.4.e) and 39.12.a)(v).

Figurative and three-dimensional elements of marks may consist of artistic works that are commissioned or used to create a logo, label or other figurative or mixed trademark. Those artistic works are protected by copyright and their use requires the rights to be assigned or licensed.

Typically, the person that commissions the artwork used to create a new logo, figurative or mixed mark will own the economic rights in that artwork. However, where that is not the case, or a pre-existing work is picked up by a trader and used as a mark without authorization, the copyright holder may take action.

An opposition may be filed by the holder of copyright in a work, against the registration of a mark that contains the protected work without proper authorisation. Such opposition would proceed regardless of the goods or services on which the contested mark would be used, because the holder of copyright is entitled to control any economic exploitation or commercial use of the work that is not covered by the limitations and exceptions provided under copyright law.

Where the opponent proves his copyright in the work that is used in the mark that is filed for registration, the applicant is required to justify that use of the mark. If the applicant fails to submit sufficient justification, the examiner should raise an objection to the registration.

7.2.2 Titles of works

The titles of works such as books, films, music, video games and software are an important part of those works. They can be regarded as an essential element of a work to the extent that they identify and represent the work and will, in practice, facilitate its commercial exploitation. Moreover, under many copyright laws the titles of works are as such also protected as works if they meet the required standard of originality.

The titles of the works may become the basis of extended marketing strategies, including merchandising and licensing agreements. The titles of works can, and often do, become the trademarks under which the works are offered in the market as they become commercial products. Such products include, in particular, any physical support for the copyrighted works, for example: books, DVDs and other carriers (memory sticks, mini-disks, cartridges, etc.) that contain works such as digital books, music, audio-visual works, video games and software.

If registration is applied for a mark that contains the title of a work, and the mark is to be used for goods or services that could overlap or interfere with the normal or extended exploitation of, in particular, a literary, audio-visual or musical work, the holder of the copyright in that work could oppose the registration.

The examiner should examine the extent to which the title of the work is original and distinctive, and the nature of the goods or services covered by the mark. Where the title of a work consists of commonplace or unoriginal words or other elements, or does not evoke in the mind of consumers the work of the author, the mark would not interfere with the normal exploitation of the work. In these cases the opposition could be rejected and the mark registered.

An example of the operation of this ground for refusal is given by the case of the “007” titles of Ian Fleming’s spy novels. The 007 device below was filed for trademark registration in the Philippines by DANJAQ, LLC for scientific, nautical, surveying and electrical apparatus and instruments (Class 9) and for education and entertainment services (Class 41).³¹

The image shows the iconic '007' logo. The numbers '007' are rendered in a bold, italicized, serif font. The final '7' is stylized to resemble a gun barrel, with a small '5' or similar character integrated into its lower curve.

This application was initially objected to by the examiner on the ground that it falsely suggested a connection with Ian Fleming, the author of the James Bond 007 novels and movies protected by copyright.

DANJAQ provided evidence that it was the holding company responsible for the trademarks and copyright of all characters and materials relating to the James Bond 007 works of Ian Fleming. The registration was allowed to proceed. However, if DANJAQ had not been related to the James Bond works or to Ian Fleming, the objection to registration would have been maintained.

³¹ Information provided by the Philippines IP authorities.

8 Personal names, identity and likeness

Individual persons, in particular if they are well known by segments of the public for their activities in the world of sports, art, business or politics, have a personal right to prevent the appropriation and commercial use of their names, pseudonyms, artistic names, portraits, likeness or other representations of their persons or identity.

This right may derive from provisions in the trademark law, civil law, privacy laws or special laws that protect the image of national or foreign public authorities, dignitaries or other persons in high-ranking positions. However, the same ground may apply regardless of the statute of the person whose identity is used if such use is without authorization and the use would create the perception that there is an association, connection, affiliation, sponsorship or other relation between that person and the unauthorized user.³²

An application to register a mark that contains the name, pseudonym, portrait, likeness or other representation that is sufficient to *identify clearly* a particular person or dignitary may be opposed by the interested party and the examiner may raise an objection *ex officio*. If the applicant's entitlement is not cleared, the registration of the mark should be refused.

The examiner should examine, in particular, if the sign effectively identifies an individual person who has not given his consent to register for such registration.

If the sign that is filed for registration consists of a name that does not correspond to that of the applicant, the examiner may require that the applicant submit proof of *consent* from the person named or from that person's legal representative. In this case the examiner should verify compliance with that formal requirement.

This ground for objection or opposition will not apply if the mark refers to a name that is *fanciful* or *fictitious*, or is insufficient to identify a particular person, or if the mark represents a character or portrait that is *fictitious* or that will not be associated to a particular person. If the name is fanciful, the examiner may require that this be stated or clarified in the application. (See item 2.4 in Part 1 of these Guidelines).

If the sign consists of a personal name (first name, surname or full name) of an individual person, the sign should be regarded as inherently distinctive, regardless

³² See the provisions in BN TMR, r. 12(1); KH TMA art. 14(e); ID TML art. 6(3).a); LA IPL art. 23.7 and 8, Decision 753 art. 42.4; MY TMA s. 16, TM Manual items 5.40 to 5.43; MM; PH IP Code s. 123.1(c), TM Guidelines chapter IX item 6; SG TMR r. 11 and 14, TM Manual chapter 10 – 'Names and representations of famous people'; TH TMA s.7(1), (4) and (5); and VN IPL art. 73.3 Circular 01/2007 s. 39.4.f) and 39.12.a)(iv).

of the commonality of its occurrence in the country concerned. In this case, a first-come-first-served approach would prevail, in respect of the specified goods or services or beyond if the mark is well-known.

An opposition based on a prior right over a mark or trade name consisting of the same or a confusingly similar name should be decided applying the standard criteria on likelihood of confusion.

An opposition based on an opponent's personal name should not be upheld if there is no reason to assume that the relevant consumers will associate the mark with the opponent in the course of trade. For example, an application to register the mark "FORD" for motor vehicles could not be opposed successfully by a [hypothetical] Mr. Albert J. Ford merely because that person's name includes the word 'Ford', unless that person is active and widely known in the automobile business and there is a risk that the relevant sector of the public would associate the mark "FORD" with Mr. Albert J. Ford.

An attempt to register as a mark a *distorted* or *parodic* version of the name of a well-known personality could also give rise to an objection. For example, an application to register the mark "PARES HILTON" could be objected by Ms. Paris Hilton on the basis that such mark could be associated with Ms. Hilton's own marks or could cause disrepute or dilution of those marks.

9 Names and symbols of certain communities

Within most countries there are groups and communities of people that are culturally, linguistically or ethnically distinct from the rest of the population of that country. Those groups or communities, sometimes known as ‘local communities’ or ‘indigenous communities’, typically have their own identity and name, as well as symbols, codes, insignia, cultural expressions, ritual terms and other signs. Those communities have legitimate expectations to control the use of such signs -- including any commercial exploitation -- and to restrict unauthorised access to, or dissemination of, those signs by persons unrelated to the communities.

The right of local, indigenous and other communities to control the access, dissemination and use of their symbols, codes, cultural expressions, ritual terms and other signs is recognised in many countries and the issues related to such control are under discussion at the international level.³³ The identity of those communities and their symbols and signs -- whether sacred, secret or publicly used -- have been claimed to deserve respect and protection from misappropriation or unauthorised use.

At the WIPO Intergovernmental Committee on Intellectual Property, Genetic Resources, Traditional Knowledge and Folklore it is proposed that traditional cultural expressions, which include traditional and sacred signs and icons, be protected against the following, in particular:³⁴

“[...] any [false or misleading] uses of [protected] traditional cultural expressions, in relation to goods and services, that suggest endorsement by or linkage with the beneficiaries” [...]

One of the means to avoid or reduce the occurrence of unauthorised access, use or dissemination of such symbols and signs of indigenous communities is to disallow their appropriation as trademarks (or trade names) by persons unrelated to the communities. While such policy objective could be implemented in IP law as an absolute ground for refusal of registration of marks based on reasons of public order or public policy, that policy can also be implemented as a relative ground for refusal to the extent that controlling such access, use and dissemination is a

³³ See work of the Intergovernmental Committee on Intellectual Property, Genetic Resources, Traditional Knowledge and Folklore at WIPO. In particular, the documents in the series WIPO/GRTKF/28 found at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=276220

³⁴ See WIPO document WIPO/GRTKF/28/6, article 3.1(a)(iv) and 3.2(d).

subjective collective right that can be claimed by particular communities, groups or peoples.³⁵

On the basis of the rights of communities to control the use of their identity and their symbols and signs, the examiner should -- upon opposition or *ex officio* -- raise an objection to the registration of a mark if it consists of, or includes, a sign that is identical with, or confusingly similar to, the name of a local or indigenous community or one of its symbols, codes, insignia, cultural expressions, ritual terms or other signs. Use of a mark that includes one of those signs would falsely suggest a connection with a particular community or people, or be misleading as to possible sponsorship, patronage, affiliation or other connection.

For example, in the United States of America, in 2012, the Navajo nation sued the company Urban Outfitters for unauthorised use of the name "Navajo" and "Navaho" as trademarks for goods including clothes and wearing apparel. The plaintiffs claimed, *inter alia*, that "when the defendant used the 'Navajo' and 'Navaho' marks with its goods and services, a connection with the Navajo nation is falsely presumed." The court upheld the complaint.³⁶

The same rationale could be applied to object to the registration of marks that contain signs belonging to indigenous or other communities, in the country or abroad.

³⁵ See the provisions in KH TML art. 4(b); ID TML art. 5.a); LA IPL art. 23.8 and 18, Decision 753 art. 37 and 46; MY TMA s. 14(1)(b); MM; PH IP Code s. 123.1.a; SG Act s. 7(4)(a); TH TMA s. 8(9); and VN IPL art. 73.2.

³⁶ See <http://www.law360.com/articles/429688/urban-outfitters-loses-bid-to-toss-navajo-trademark-suit> and <http://www.theguardian.com/world/2012/mar/01/navajo-nation-sues-urban-outfitters> .

10 Applying for registration in bad faith

Several ASEAN countries have provisions or practice that take into account the possibility that an application be filed in bad faith. Some of those countries' trademark provisions contain an express or implied reference to an applicant's 'bad faith' or 'fraudulent intent' as a factor that can impede or vitiate a trademark registration.³⁷

In this respect, 'bad faith' is understood as the situation where an applicant knows that the mark that is applied for registration already belongs to another person who has a genuine claim to that mark and has not consented to such registration. 'Fraudulent intent' refers to an applicant's intention to obtain a registration where that would infringe legal provisions or prior rights.

Knowledge of the mark may result from the fact that the mark is well known in the country or abroad, or has reputation in the country. Knowledge may also result from the fact that the applicant has had some sort of connection or business relationship with the owner of the mark he is trying to register.

The WIPO Joint Recommendation, Article 3(2), provides as follows in connection with the protection of well-known marks:

(2) [*Consideration of Bad Faith*] Bad faith may be considered as one factor among others in assessing competing interests in applying Part II of these Provisions.

Where in opposition proceedings the evidence submitted demonstrates that the application was filed in bad faith, this factor should be considered by the examiner at the time of making a global assessment of the likelihood of confusion if the contested mark were registered.

The effect of bad faith (or the absence of good faith) on the registration of a mark may be illustrated by the case of Shangri-La International Hotel Management, Ltd., Shangri-La Properties, Inc., Makati Shangri-La Hotel & Resort, Inc., and Kuok Philippines Properties, Inc., vs. Developers Group of Companies, Inc., decided by the Supreme Court of the Philippines in 2006.³⁸ The court decided, among other

³⁷ For instance, see the relevant provisions in BN TMA s. 6(6); KH TML, art. 14.e and TM Manual p. 107; ID TML art.4; LA Decision 753, art 36, paragraph. 6, item 7; MY TMA s. 25(1), 37(a) and 45(1)(c); SG TMA, s. 7(6) and 8(5) and (6).

³⁸ Decision of the Supreme Court of the Philippines, on 31 March 2006, case G.R. No. 159938, SHANGRI-LA INTERNATIONAL HOTEL MANAGEMENT, LTD., et al. vs. DEVELOPERS GROUP OF COMPANIES, INC ("Shangri-La case"). See http://www.lawphil.net/judjuris/juri2006/mar2006/gr_159938_2006.html .

points, that the registrant of the mark (reproduced below) had acted in bad faith because it was aware of the prior existence of the earlier mark and proceeded to obtain registration in its name in spite of that knowledge.



[Information provided by the Philippines IP authorities]

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