

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

(Second Edition)



one vision
one identity
one community



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SUBSTANTIVE EXAMINATION
OF TRADEMARKS**

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**The ASEAN Secretariat
Jakarta**

The Association of Southeast Asian Nations (ASEAN) was established on 8 August 1967. The Member States are Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Myanmar, Philippines, Singapore, Thailand and Viet Nam. The ASEAN Secretariat is based in Jakarta, Indonesia.

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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 in the Common Guidelines until such time it became compatible with the relevant national law.

These Common Guidelines do not determine the outcome of the substantive examination of trademark applications. The ASEAN IP Offices retain any powers and responsibilities that are conferred upon them under the applicable national law. The Common Guidelines are not intended to be used as legal basis by any party in challenging the operative part of any decision of the national IP Offices or judicial bodies or authorities.

“NOTE: In these Guidelines the ellipsis notation “[...]” is used to indicate that a part of a quoted text or legal provision has been omitted for reasons of relevance or conciseness.”



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 ASEAN Member States (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). This project was approved by European Union and ASEAN in 2009 to support the implementation 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 ECAP III project seeks to further integrate ASEAN Member States into the global economy and world trading system with a view to further promoting economic growth and reducing 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 ASEAN Intellectual Property Rights Action Plan 2011-2015.

The European Union Intellectual Property Office (EUIPO) 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 ASEAN Member States, relevant to the substantive examination of trademark applications, as well as the practices followed by ASEAN IP offices. The internal guidelines and manuals currently used by some of the offices to examine trademark applications have also been taken into account. The Common Guidelines also 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 EUIPO 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 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 Member States 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 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, Lao PDR, 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 ASEAN Member States 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)

Lao PDR : Trademarks Manual, September 2003

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

Philippines : Guidelines for Trademark Examination (Manual for Trademark Examination), December 2012

Singapore : Trade Marks Work Manual

Viet Nam : Circular No. 01/2007/TT-BKHCN of February 14, 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006 with amendments and supplements in 2010, 2011, 2013 and 2016; and Regulations on Examination of Applications for Registration of Trademarks, 2010 – attached to Decision N° 709/QD-SHTT of April 29, 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 harmonization of the trademark examination standards and criteria applied by trademark examiners in the region.

The process to prepare the first edition of 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 IP offices of ASEAN Member States. The missions compiled information on relevant provisions in the laws, regulations and administrative guidelines, manuals and directives applied by 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 competent officials on possible content of the Common Guidelines, and manner in which the different absolute and relative grounds for 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 trademark laws, regulations and practices of

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 ASEAN Expert Group on Trademark Examination held in Bangkok from 21 to 25 July 2014. At the meeting, the draft Common Guidelines were discussed in detail.

- (iii) Review of the draft Common Guidelines by the project consultant taking into account the comments, suggestions and inputs received from ASEAN 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.

Revision of the Common Guidelines

The process to revise these Common Guidelines was started in 2018 and concluded in 2019, in the framework of the “Arise Plus – Intellectual Property Rights” project developed by the European Union for the ASEAN region (hereinafter “Arise+IPR”).

Arise+IPR is a beneficiary-driven project designed by the EUIPO to support trade development and the integration of the ASEAN member nations. It envisages upgrading and improving the ASEAN countries’ intellectual property systems in line with international best practices and standards.

The Common Guidelines were revised by a project consultant taking into account intervening developments in the ASEAN intellectual property laws and regulations, as well as the suggestions, examples and inputs obtained mainly from the ASEAN IP authorities and the EUIPO.

The draft was reviewed by the ASEAN Member States in May 2019, and the final revised Common Guidelines were delivered in August 2019.

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Abbreviations Used in the Common Guidelines

ASEAN Member States (Country Codes)

BN	: Brunei Darussalam
ID	: Indonesia
KH	: Cambodia
LA	: Lao PDR
MM	: Myanmar
MY	: Malaysia
PH	: Philippines
SG	: Singapore
TH	: Thailand
VN	: Viet Nam

Other Abbreviations

ECJ	: Court of Justice of the European Union (European Court of Justice)
EU	: European Union
GI	: Geographical Indications
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)
Nice Classification	: The International Classification of Goods and Services for the Purposes of the Registration of Marks, established under the Nice Agreement of 1957
EUIPO	: European Union Intellectual Property Office

- EUIPO Guidelines : Guidelines for Examination of European Union Trade Marks – European Union Intellectual Property Office (EUIPO), version 1.1, 1 October 2017
- EUTMIR : Commission Implementing Regulation No. 2018/626, of 5 March 2018, implementing Regulation 2017/1001 on the European Union Trade Mark
- EUTMR : Regulation No. 2017/1001, of 14 June 2017, on the European Union Trade Mark (European Union Trade Mark Regulation)
- 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 31 July 2019.

ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

1 Signs Admissible as ‘Trademarks’¹

Registration of a sign as a trademark should be refused if nature of the sign that is subject of 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 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 signs comply with the requirement of being sufficiently and adequately *represented* by means that are acceptable to the trademark authorities for the purposes of the official recording. The means of representation of trademarks for the purposes of registration may vary depending on the type of sign in question.²

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 definitions of ‘sign’, ‘mark’ and ‘trade mark’ in BN TMA s. 4(1); ID TML art. 1.1; KH TML art. 2(a); LA IPL art. 3.9 and 16.1, Decision 753, art. 32; MM TML s. 2.j); MY TMA s. 3(1) “mark”; PH IP Code s. 121.1, Rules, r. 101(j); SG TMA s. 2(1) and 7(1)(a), TM Manual chapter 1 ‘What is a Trade Mark?’; TH TMA s. 4 “mark”; and VN IPL, art. 4.16. Also, the EUIPO Guidelines Part B, Section 2, item 9, and Section 4, Chapter 2, item 1.

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.³

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

Where a law requires that a mark be visually perceptible as an absolute condition for registration, any application to register a mark consisting of a non-visually-perceptible sign could be refused. In particular, a sign perceptible, for instance, by the sense of hearing or the sense of smell could not be registered as such signs are not visually perceptible. This would rule out the registration of 'sound' and 'olfactory' marks. It would also rule out the registration of signs perceptible by the senses of touch or taste.

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

³ TRIPS, Article 15.1, in fine.

1.1.1 Two-dimensional Signs

Visually-perceptible two-dimensional signs are signs that are generally applied to, and visible on, the surface of a product or its labelling or conditioning, or visible on documents, conditioning and other supporting materials relating to goods or services offered on the market.

Two-dimensional signs admissible for registration as marks may belong to any of the following categories.

*1.1.1.1 Words, Letters, Digits, Numerals, Ideograms, Slogans*⁴

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 ASEAN Member States, 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 colors. They will not contain any figurative element, frame or background.

⁴ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 2; ID TML Art. 1.1; LA IPL art.16.1, Decision 753, art. 32, TM Manual p. 4; MY TMA, s. 3 and 10(1), TM Manual paragraph 4.11; MM TML s. 2.j); PH IP Code, s. 121.1, Rules, r. 101(j), 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 – ‘mark’ and 7(2), (3), (4); and VN IPL art. 72.1. Also the EUIPO Guidelines, Part B, Section 2, item 9.1.

The following examples illustrate this type of sign:

KLAROSEPT

MONT BLANC

AIR INDIA

ΜΟΛΚΥΒΟΝ

αλφάβητο

GML

1886

N° 5

H2NO

Giorgio@Play

Your flexible friend



[Examples provided by the IP authorities of Thailand]

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

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



[Example provided by the Malaysia IP authorities]

1.1.1.2 *Figurative Signs*⁵

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.

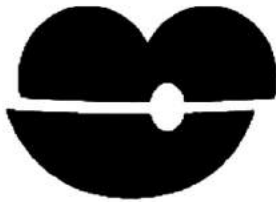
Figurative signs may have one or more colors but will not contain any words, letters, digits, numerals or ideograms. For example:



⁵ 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, Decision 753, art. 32, TM Manual, p. 4; MY TMA, s. 3 and 10(1); MM TML s. 2.j); PH IP Code, s. 121.1, Rules, r. 101(j), 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 ‘mark’ and 7; and VN IPL art. 72.1. Also the EUIPO Guidelines, Part B, Section 2, item 9.2.



[Examples provided by the IP authorities of Thailand]





[Examples 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*⁶

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 colors. For example:

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, Decision 753, art. 32, TM Manual, p. 4; MY TMA, s. 3 and 10(1); MM TML s. 2.j); PH IP Code, s. 121.1, Rules, r. 101(j), 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 7(6); and VN IPL art. 72.1. Also the EUIPO Guidelines, Part B, Section 2, item 9.2.





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



[Example provided by the Malaysia IP authorities]



[Examples provided by the IP authorities of Thailand]



Example from: <https://x1rcorp.com/x1r-home/>



Example from: <https://www.wd40.com/about-us>

1.1.2 Colors⁷

A single color as such ('color *per se*') or a combination of two or more colors 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 color in the abstract or consisting of two or more colors claimed in any conceivable combination or form, cannot be regarded as a mark for purposes of its registration. In this connection, see also item 2.1.3, below.

To be regarded as a mark, a color would need to be defined by a particular shape or have clear, defined contours. A *combination* of two or more colors 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 colors 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 from the Guidelines for Trademark Examination of the Philippines, p. 124]

⁷ See the provisions in KH TM Manual p. 18 and 21; ID TML Art. 1.1; LA IPL art. 16.1, Decision 753 art. 17.4 and 32, TM Manual p. 4; MY TMA, s.13; MM TML s. 2.); PH IP Code, s. 123.1(L), Rules, r. 101(j) and r. 102(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', s. 7(5) and s. 45; and VN IPL art. 72.1, Circular 001/2007, s. 39.2.b(i). Also the EUIPO Guidelines, Part B, Section 2, item 9.6, and Section 4, Chapter 2, item 2.4.

1.1.3 Three-dimensional Signs⁸

A three-dimensional shape is a ‘visually perceptible’ sign and is capable of being ‘represented’. To that extent, a three-dimensional shape should, in principle, be admitted for registration as a mark if it complies with the other prescribed requirements.

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

- the shape of a device *adjoined* or attached 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 attached or 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, attached to beer dispensers or placed in front of shops that offer such products, could function as a valid trademarks for beer products and for services related to those products.

⁸ See the provisions in KH TM Manual p. 18 and 19; LA Decision 753 art. 17.5 and 32, TM Manual, p. 19; MM; PH IP Code, s. 123.1(k), Rules, r. 101(j) and r. 102(k), TM Guidelines p. 18, chap. XII; SG TMA s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter 3 ‘Shape Marks’; TH TMA s.4 – ‘mark’ and s. 7(10); and VN IPL art. 72.1 and 74.2(a). Also the EUIPO Guidelines, Part B, Section 2, item 9.3, and Section 4, Chapter 2, item 2.1.

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



[Example from: <https://www.theliquorbarn.com/white-horse-blended-scotch-750ml/>]

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).⁹

⁹ In this connection see the judgment of the High Court of Malaya (Malaysia), Kuala Lumpur [Commercial Division], Originating Summons No. 24IP-49-12/2015, in the case between Kraft Foods Schweiz Holding GmbH and Pendaftar Cap Dagangan, on 15 August 2016, at § 33, that ruled, inter alia, that a 3—D shape can be a “mark” for the purposes of the trademark law. See: <http://foongchingleong.com/wordpress/wp-content/uploads/2018/09/Kraft-Foods-Schweiz-Holdings-GmbH-v-Pendaftar-Cap-Dagangan-3d.pdf>

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 particular shape of a chocolate bar could function as a trademark for chocolates if it is recognized as an indication of commercial origin, it is sufficiently distinctive and it is not functional.



[Example 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:



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



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

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



Example from International registration 931631 filed under the Madrid Protocol
[provided by the IP Office of Singapore]

1.1.4 Movement (Motion) Signs and Holograms¹⁰

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* or *motion* 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 public. They cannot be physically attached to the goods themselves but may be used to distinguish digital products

¹⁰ See the provisions in ID TML art. 1.1; KH TML art. 2(a); LA IPL art. 3.9, 16.1; MY TMA s. 10(1)(e); 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 EUIPO Guidelines, Part B, Section 2, items 9.8 and 9.10.1 and Section 4, Chapter 2, items 2.6 and 2.8.

and services on portable devices such as mobile telephones, internet-based services, etc.

The following are examples of movement marks that have been registered in Singapore, with their corresponding descriptions:



Trademark Nos. T0501368G, T0501369E and T051370I

Mark description:

The trade mark is a movement mark consisting of an animation of a man's hand and a child's hand which appear in a sequence of four images as shown in the representation on the form of application, whereby the man's hand and the child's hand converge in the positions illustrated in the top left and right figures, and the man's hand and the child's hand touch and clasp in the positions illustrated in the bottom left and right figures respectively.



Trademark No. T1111928I

Mark description:

The trade mark is a movement mark consisting of an animated sequence of a spray bottle with a light blue nozzle, featuring a front-loading washing machine-like door on the body of the spray bottle, where the washing machine-like door automatically opens, ejecting water and a series of fabric-related items through the door, namely a grey mattress, pillows, a blue towel, a black jacket, a white work shirt, a striped tie, a brown sofa, a brown teddy bear, and a white pair of shoes, which is produced sequentially by displaying the attached images in the order given, starting from the top left corner moving across the row to the far right, returning to the bottom left row and moving across again to the far right, ending with the bottom right corner.

[Examples provided by the IP Office of Singapore]

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 Marks¹¹

A 'position' mark is a figurative, mixed, color 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.

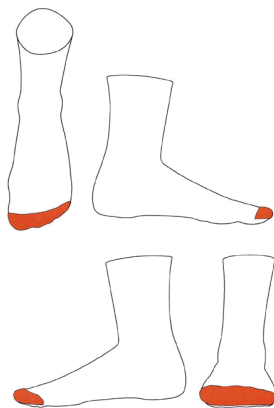
However, a figurative, mixed, color or three-dimensional sign may be registered with a *limitation* as to its position or location on the goods specified in the application. If the applicant limits the position of the sign to a particular location on the product, this limitation should not be a ground 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 color* applied to a particular part (position) of a product was found to lack distinctiveness in the case of the orange coloring of the toe of a sock (reproduced below). EUIPO refused registration of that device as a mark arguing, in particular, that the sign would be perceived by the

¹¹ See the EUIPO Guidelines, Part B, Section 2, item 9.4 and Section 4, Chapter 2, item 2.2.

relevant public as a presentation of the product dictated by aesthetic or functional considerations. The coloring 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 color of the toe of a sock as an indication of commercial origin. Consequently, the device was devoid of distinctive character. The European Court of Justice upheld that decision.¹²



The question of distinctiveness was also raised in the case of *Margarete Steiff GmbH vs EUIPO* (“STEIFF” case). The EUIPO 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 EUIPO’s decision.¹³

¹² Decision of the European Court of Justice, 15 June 2010, case T-547/08 (“Orange coloring 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>.

¹³ 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>.



[Examples 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 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 EUIPO CTM registration N° 3799574]



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

1.2 *Non-visually Perceptible Signs – 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 appropriately by using a generally available format or technology.

The **representation** of a mark cannot be replaced by a written description. However, a description of the mark may be supplied by the applicant. In this case, the description must be consistent with the representation of the mark.

Although a reproduction or a 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 representation of the sign is critical. Therefore, the decision to grant or refuse registration of a mark consisting of a sign that is not visually perceptible will effectively pivot on the representation of the sign.¹⁴

If the sign cannot be represented in a satisfactory manner, the sign must be refused registration. The applicant’s compliance with the rules that define the conditions for a ‘representation’ is imperative.

¹⁴ See the provisions in BN TMA s. 4(1); SG TMA s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter1 “What is a Trade Mark”, p. 11. Also the EUIPO Guidelines, Part B, Section 2, item 9, and Section 4, Chapter 2, item 1.3.

The representation of a sign applied for registration as a mark should be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*.¹⁵ The means used for the 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.

To be accepted, a graphic or other 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 representation must enable the examiner, as well as any competent authorities and the public, to determine with clarity and precision the subject matter covered by the registration.¹⁶

The function of the 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.

Where a graphic representation is submitted, it 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.

¹⁵ In this respect, EUTMIR Article 3(1) provides:

1. The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.

¹⁶ See the EUIPO Guidelines, Part B, Section 2, item 9, and Section 4, Chapter 2, item 1.3.

The actual 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 the 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 adequate representation.¹⁷

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 sonogram¹⁸, sonograph¹⁹ or oscillogram²⁰ accompanied by a corresponding electronic *sound file* (sound record, MP3 file) submitted by electronic filing or in a standard electronic format.²¹

¹⁷ See the provisions in ID IPL art. 1.1; SG TMA s. 2(1), TM Manual chapter 1 'What is a trade mark', p. 11; TH TMA, s. 4 'mark' and s. 7(11). Also the EUIPO Guidelines, Part B, Section 2, item 9.7, and Section 4, Chapter 2, item 2.5.

¹⁸ 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>

¹⁹ 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

²⁰ 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>

²¹ For example, see the EUIPO Guidelines, Part B, Section 2, item 9.7, and Section 4, item 2.5.

Other representations of a sound mark should 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. A written description could be interpreted in different ways and with different scope by different persons, and therefore it cannot clearly and accurately represent the sound or noise.²²

1.2.2 Signs Perceptible by the Sense of Smell

Signs perceptible only by the sense of smell (olfactory marks or smell marks) cannot be represented graphically or otherwise 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 odor or scent would not allow that odor or scent to be identified by the examiner or by a third party. 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 odor 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 a scent should not be regarded as objective since the description would allow different personal, subjective interpretations, and therefore it could not clearly and accurately represent a smell or odor.

There is at present no internationally recognized objective classification for smells, odors or scents that could be applied for the purposes of trademark registration.²³

²² See the SG TMA s. 2(1), TM Manual chapter1 “What is a trade mark”, p. 11. Also the EUIPO Guidelines, Part B, Section 2, item 9.5. and Section 4, item 2.5.

²³ In this regard see the SG TM Manual chap. 1 “What is a trade mark”, p.12; and the EUIPO Guidelines, Part B, Section 2, item 9.11, and Section 4, Chapter 2, item 2.9.2.

For the abovementioned reasons, the trademark examiner should refuse to admit or process any application for the registration of a sign that is perceptible by the sense of smell.

1.2.3 Signs Perceptible by the Sense of Taste

Signs perceptible only by the sense of taste (taste marks) 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 should be raised against signs perceptible by the sense of taste.²⁴

The trademark examiner should refuse to admit or process any application for the registration of a sign that is perceptible by the sense of taste.

1.2.4 Signs Perceptible by the Sense of Touch

Signs perceptible by the sense of touch (tactile marks) 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.

Tactile' marks may 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.

In this case the criteria and provisions regarding 'three-dimensional' marks would apply also to these tactile marks, *mutatis mutandis*. The usual conditions regarding distinctiveness and functionality would also need to be verified.

²⁴ See, for example, the EUIPO Guidelines, Part B, Section 2, item 9.11.2, and Section 4, Chapter 2, item 2.9.3.

However, to the extent that a tactile sign cannot be represented graphically in a manner that is clear, precise, self-contained, easily accessible, intelligible, durable and objective, the trademark examiner should refuse to admit or process any application for the registration of such a sign.²⁵

²⁵ See in this regard the EUIPO Guidelines, Part B, Section 2, item 9.11.3, and Section 4, Chapter 2, item 2.9.4.

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.²⁶

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.²⁷

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.

²⁶ See the provisions in BN TMA, s. 6(1)(b); KH TML art. 4(a); ID TML art. 20.e; LA IPL art. 23.1, Decision 753 art. 39; MY TMA s. 10(2A); MM TML s.2.k, 13.a); PH IP Code s. 121.1; SG TMA s. 2(1) – 'sign' and 'trade mark', 7(1)(a); TH TMA s. 6(1) and 7; VN IPL art. 72.2 and 74. Also the EUIPO Guidelines, Part B, Section 4, Chapter 3.

²⁷ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 1.

2.1 ***Signs Not Understood or Not Perceived as Trademarks***

A sign that is not perceived or recognized 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.

The following categories of signs could be regarded as *prima facie* incapable of being recognized by consumers as marks that indicate a commercial origin, and therefore should be presumed to lack distinctiveness:

- simple figures
- complex or unintelligible signs
- single colors in the abstract
- single letters and digits
- three-dimensional shapes
- patterns and surface designs
- common labels
- simple advertising phrases

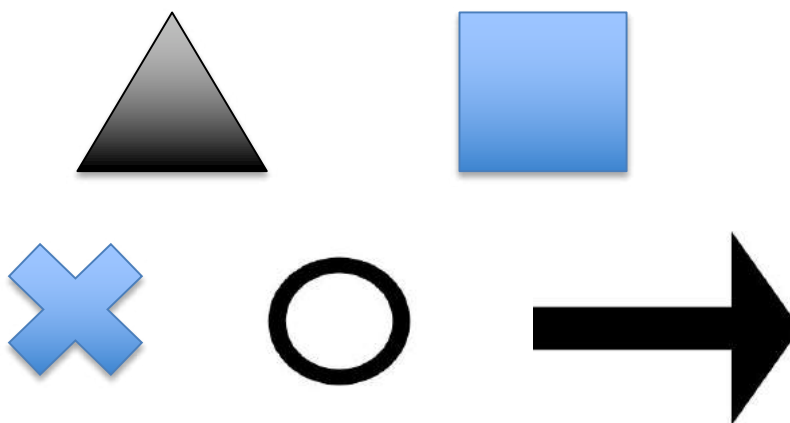
Nevertheless, signs should be assessed on a case-by-case basis. In some instances, the *combination* of non-distinctive elements with other specific and distinctive elements can render the sign distinctive as a whole.

2.1.1 Basic Shapes and Simple Figures

A sign consisting of a simple or basic 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 perceived or retained by consumers as an indication of commercial origin. Such signs are unable to function as trademarks to distinguish goods or services in trade and are, therefore, devoid of distinctiveness.²⁸

Basic geometrical shapes include simple lines, crosses, circles, triangles, squares, rectangles, rhombuses, trapezoids, diamonds, pentagons and hexagons.

For example, the following signs will normally not be sufficiently distinctive to be perceived, or to function, 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 punctuation marks and other symbols that are commonplace and non-distinct.

²⁸ For instance, see the provisions in LA TM Manual p. 26; VN IPL art. 74.2.a, Regulations, r. 17.8.2, Circular 01/2007 s. 39.4.a. Also, the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 6.

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 signs that are difficult for consumers to recognize or to remember. Such signs lack the ability to distinguish goods and services in trade and therefore cannot be registered as marks.²⁹

For example:



[Examples from the Regulations on the Examination of Applications for Registration of Marks of Viet Nam, item 17.8.2.b]



Application No.: 4-2009-24600

²⁹ See the provisions in LA TM Manual p. 26; VN Circular 01/2007 s. 39.4.b.



International Application No.: 1101043
[Examples provided by the Viet Nam IP authorities]

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



[Examples provided by the Viet Nam 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 Colors³⁰

2.1.3.1 Single Color

A *single color* in the abstract (*i. e.* a color as such) 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 color in the abstract would amount to claiming the idea of that color. 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 color in the abstract could unduly restrict the freedom of other traders to use colors 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 color could be presented and used in trade in a great variety of forms. The public will not normally recognize the color as being a mark. Consumers will normally not identify the commercial provenance of goods only on the basis of their color or the color of their packaging or conditioning. Consumers will usually look for a word or other graphic sign to distinguish particular goods or services.

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

³⁰ 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 IPL s. 16.1, Decision 753, art. 17.4 and 32, TM Manual p. 26; MM TML s. 2(j); MY TM Manual chapter 4 paragraph 4.8; PH IP Code, s. 123.1(L), Rules, r. 102(L), TM Guidelines chapter XIII; SG TMA s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter 2 ‘Colour marks’ p. 4 and 6; TH TMA s. 4 – ‘mark’, 7(5) and 45; and VN Circular 01/2007 s. 39.2.b(i). Also the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 14.

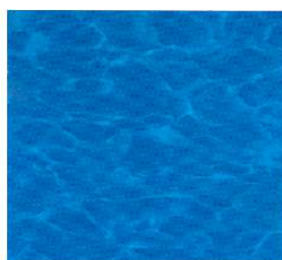
Accordingly, a mark consisting of a single color *per se* should be presumed not to be capable of functioning as a mark and the examiner should raise an objection to its registration on that ground. To be registered, the color would need to be defined by a concrete shape or have defined contours.³¹

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



International Application No. 801739
[Example provided by the Viet Nam IP authorities]

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



01015661 – SOCIÉTÉ DES PRODUITS NESTLÉ S. A.
[Example provided by the Malaysia IP authorities]

As regards colors 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).

³¹ See in this connection the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 14.1.

The foregoing grounds for refusal could be overcome in the exceptional case that the color is *very unusual* or *striking* when used in connection with particular goods or services. For example, the color '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 color 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 color 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 color.

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

Functionality of a color may also result from its technical or physical nature. For example, the color 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 color should be regarded as functional if it is common in the trade of particular goods or services, or if it results from the natural color of the goods. Any competitive need by third parties to use a color will make that color functional and would be a bar to the color's registration as a mark.

2.1.3.2 *Abstract Combinations of Colors*

In the case of an application to register a sign consisting of *two or more* colors claimed in any conceivable combination or form, the colors could effectively be used in practice in many different, unpredictable combinations and forms. This would not allow the average consumer to perceive and recall any particular combination of those colors. Such potential variation could give the mark an undefined scope of protection.

Moreover, 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 incurring in conflicting uses of the colors. Such unpredictability would make it impossible for a national authority to establish a clear scope of protection for the mark, thus causing unacceptable legal uncertainty.³²

Accordingly, a sign consisting of an abstract, undefined combination of two or more colors cannot be registered as a mark. To be registered, the colors 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 colors 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 colors (see item 2.1.3.1, above), if a combination of colors is *functional* in any way, acquired distinctiveness will not operate and registration should not be allowed.

For example, the use of colors 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 colors in particular contexts makes the color combination *functional* and it may not be claimed in exclusivity as a mark for the relevant goods or services.

Other circumstances in which a combination of colors should be objected include:

- the case where a combination of colors would be perceived by the average consumer as a decorative feature, and not as an indication of commercial provenance;
- the case where a particular combination of colors is functional in connection with particular goods or services, for example yellow and black for postal services, or codified colors for electrical wiring;
- the case where a particular combination of colors is usual in a particular industry in connection with certain goods or services, for

³² See in this connection the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 14.2.

example the use of colors pink or orange to indicate a flavours of strawberry or orange in drinks or ice—cream, or a color combination with predominant green that would indicate that the products are environmentally friendly or ecologically produced.

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.³³

If the letter or digit is presented in a *particular shape, style or color or combination of colors* 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 consisting of single letters or digits could be regarded as being distinctive:



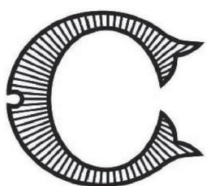
[Examples, respectively, from: <https://gsuite.google.com/setup/resources/logos/> and <https://www.google.com/gmail/about/>]

³³ See the provisions in BN TMA s. 4(1); KH TM Manual p. 28; ID TML Art. 1.1; LA IPL art. 3.9 and 16.1, Decision 753 art. 17.2, TM Manual p. 4 and 26; MY TMA s. 3(1); MM TML s. 2.j); PH IP Code, s. 121.1 and 123.1; SG TMA s. 2(1) – ‘sign’ and ‘trade mark’; TH TMA s. 4 ‘mark’ and s. 7(4); and VN IPL, art. 74.2.a), Circular 01/2007 s. 39.3.b). Also, the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 4.



[Example from: http://www.vmastoryboard.com/case-stories/2648/turner_duckworth_amazon_smile_logo/#sthash.m0Cszz6a.dpbs]

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]



[Example provided by the IP authorities of Thailand]



Applications No.: 4-2011-19180 and 4-2011-21087



Application No.: 4-200511949

[Examples provided by the IP authorities of Viet Nam]

In case of a single letter or digit presented in *standard characters*, i.e. devoid of any particular shape, style or color or combination of colors, 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 Viet Nam for lack of sufficient distinctiveness:



Applications No. 4-2009-06807, 4-2009-27613 and 4-2010-17584
[Examples provided by the Viet Nam 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 apply where the law allows or does not preclude the registration of three-dimensional marks.³⁴

³⁴ See the provisions in BN TMA, s. 4(1) and 6(2); ID TML s. 1.1; KH TM Manual p.18; LA IPL, art. 16.1, Decision 753 art. 17.5, TM Manual p. 4; MM TML s. 2.j); PH IP Code, s. 121.1, Rules r. 102.k), TM Guidelines chapter XII; SG TMA s. 2(1), 7(1) and 7(3), TM Manual chapter 3 “Shape Marks”, p. 7; TH TMA s. 4 – ‘mark’ and s. 7(10); and VN IPL, art. 74.2.b. Also, the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 11.

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 Viet Nam 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 Viet Nam IP authorities]

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 recognize 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.

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.³⁵

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

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’:



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

³⁵ 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), Rules r. 102.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 s. 7(10); and VN IPL, art. 74.2.a and b. Also the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 11.3, and Chapter 6, item 2.

The following shape was refused registration in Viet Nam 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 IP authorities of Viet Nam]

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 bottle shape could not be registered as a trademark to distinguish ‘wines’ insofar as the shape is usual or standard in the wine industry:



[Example from: <https://www.ebay.com/itm/Glass-Wine-Bottle-Antique-Green-750ml-x-12-premium-claret-Cork-mouth-home-brew/281347354774?epid=1391495348&hash=item41819bf096:g:3LcAAOSwi5dcpSOz>]

The following container 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 IP authorities of Malaysia]

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 Viet Nam IP authorities]

In Thailand, the following container shape was refused registration for fish sauce:



[Example provided by the IP authorities of Thailand]

Likewise, in Thailand the following shape was refused registration for chocolate beverages, cocoa beverages, coffee beverages, tea beverages, etc.



[Example provided by the IP authorities of Thailand]

However, an unusual, non-standard shape for a container should be regarded as sufficiently distinctive and accepted for registration for the product offered inside the container.

For example, in Viet Nam the following container shape was found to be distinctive and registered:



Application 4-2012-18308

[Example provided by the Viet Nam 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:³⁶



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 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

³⁶ 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&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=540089>.

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.

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]

However, if a distinctive sign, for example a distinctive label, tag or other distinctive element, is attached to a non-distinctive shape, the combination could be regarded as distinctive as a whole.

An application to register the shape or getup of a building or a store may also give rise to an objection if the shape is commonplace or usual for the outlets and stores at which the relevant goods or services are offered or commercialized.

For instance, the IP authorities of the Philippines found that the following shop façade was unregistrable as a mark for *amusement and recreational services*:



The façade design consisting of varying shapes and colors, while enhancing aesthetic appeal, did not make the mark distinctive as it was common to recreational and amusement establishments; registration of the mark would give the applicant a monopoly over features that are essential in amusement and recreational places.

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.³⁷

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 functional or otherwise 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.

³⁷ In this regard see the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 11.3 and 11.4, and Chapter 6, item 2.

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

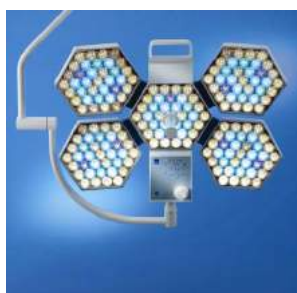
registered, should be regarded as functional since matter claimed in a patent document should be presumed to be a technical solution.

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 should not be registered as a mark.

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



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

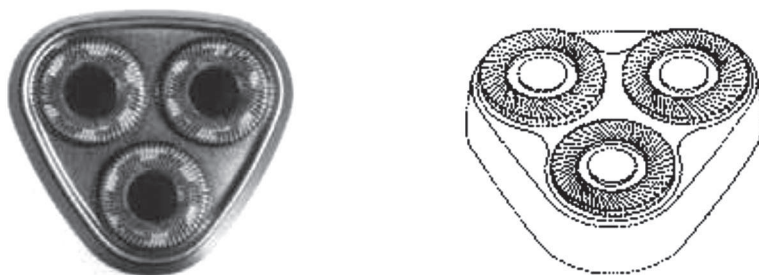


for “lights for medical purposes, namely operating lights”

[Example 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, respectively, from:
http://www.ippt.eu/files/2002/IPPT20020618_ECJ_Philips_v_Remington.pdf and
from the EUIPO 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.³⁸

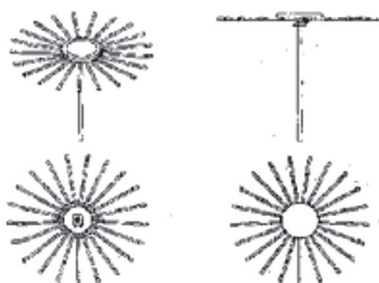


³⁸ See the decision of the European Court of Justice, case C-48/09, 'Red Lego Brick', of 14 September 2010. Also, the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 11.3, and Chapter 6, item 3.

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



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

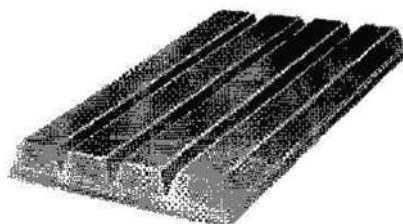


for “antenna” – Application No. 4-2004-09042

In Singapore, the case of *Société des Produits Nestlé SA v Petra Foods Ltd* [2017] 1 SLR 35, considered the following two shape marks:



The Two-Finger Mark



The Four-Finger Mark

The essential characteristics of the shape marks were identified and it was determined that each and every one of the essential characteristics performed a technical function.

The essential features of these shape marks were (1) the rectangular “slab” shape, including the relative proportions of width, length and depth; (2) the presence, position and depth of the breaking grooves along the length of each bar; and (3) the number of breaking grooves in each bar, which, together with the width of that bar, determined the number of fingers in that bar.

Each of the essential features of the shape marks were found to be necessary for a specific though different technical result. The first feature (i.e. rectangular “slab” shapes) was the most effective way to cut the bars using parallel cuts, in order to prevent wastage. The second feature (i.e. presence, position and depth of the breaking grooves) effectively divided the bar into detachable fingers. The third feature (i.e. number of breaking grooves), provides the technical function of being breakable into suitably-sized portions for satisfactory and convenient consumption.

In light of the above, the two shape marks fell under the prohibition to register a sign that consists exclusively of the shape of goods that is necessary to obtain a technical result.

A category of functional shapes that may be 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 overcome 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, to the extent that the patterns are functional:



[Examples, respectively, from: <https://www.tyresizecalculator.com/plus-sizing/tyre-patterns> 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.³⁹

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:



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

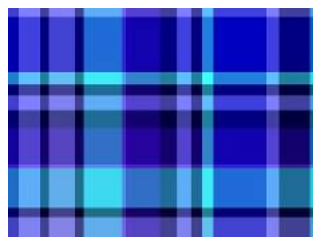
³⁹ In this regard, see the EUIPO Guidelines, Part B, Section 4, Chapter 6, item 4.

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.⁴⁰ Such patterns will normally not be perceived by the public as trademarks indicating commercial origin, but merely as ornamental elements or 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 on a product would not be perceived as marks:



[Examples, respectively, from: <https://scrappychicksonvinyl.com/products/copy-of-sweet-baby-plaid-pattern-vinyl-and-heat-transfer-vinyl> and <http://nattosoup.blogspot.com/2013/03/creating-plaid-patterns-with-copics-and.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:

⁴⁰ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 13.



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

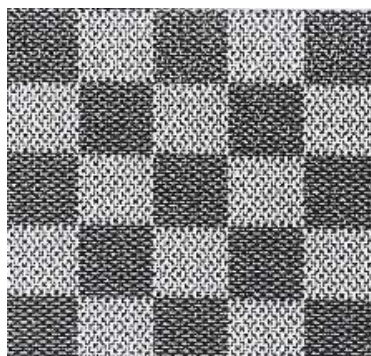
For instance, the following surface design was refused registration in Viet Nam on grounds of lack of distinctiveness in respect of the goods indicated:



For “building materials, not of metal” – Application No. 4-2009-23542
[Example provided by the Viet Nam IP authorities]

However, this *prima facie* 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



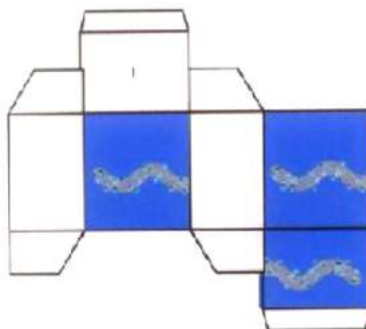
00004038 – BURBERRY Ltd.
[Examples provided by the Malaysia IP authorities]

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.⁴¹

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

⁴¹ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 10.



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



For goods in class 30 – Application No. 4-2002-07244
[Examples provided by the Viet Nam IP authorities]

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



[Examples, respectively, from: http://www.4shared.com/all-images/IIUk98vo/Simple_Label_Frames_Set_2.html and from <https://www.etsy.com/hk-en/listing/608819788/label-frame-svg-label-frame-clipart>]

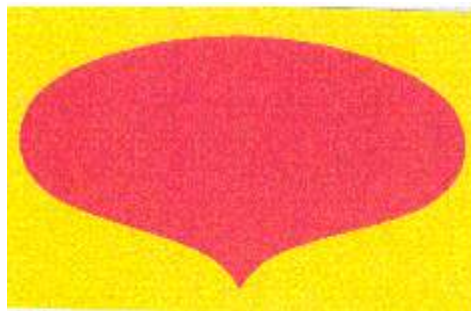
In the examples above, if a distinctive sign (word or figurative) was inserted or juxtaposed on the basic label or frame, the resulting composite sign could become distinctive and be registered as a whole.

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.⁴²

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:⁴³

- 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 rhyme 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:

⁴² See the provisions in BN TMA s. 6(1); KH TM Manual p. 28; ID TML, art. 1(1) and 2(3); LA IPL art. 16.1 and 23.1 and 2, TM Manual p. 26; MY TMA, s. 10(1)(d) and (e); MM TML s.2(j) and 13(a) and (b); PH IP Code s. 123.1 (g), (h), (i), (j), Rules, r. 102 (g), (h), (i), (j), IP Guidelines chapter IX, p.72; SG TM Manual chapter 14 ‘Slogans’; TH TMA s. 4 ‘mark’ and 7(2); and VN IPL, art. 74.2.c, Circular 01/2007 s. 39.3.g.

⁴³ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 5, and Chapter 4, item 2.5.

‘The brand you can trust’

‘You're in good hands with us’

‘We do things better’

“Not just water..... the health water!”⁴⁴

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.⁴⁵

- “WE DELIVER BEST!” (for pizza, pasta, spaghetti, noodles, bread);
- “YOUR HEALTHY CHOICE, YOUR FAMILY’S CHOICE, YOUR BEST CHOICE” (for natural sweetener);
- “SOLUTION TO MAN’S POLLUTION” (for environmental services).

Likewise, in Viet Nam the following advertising phrases were refused registration for lack of distinctiveness:⁴⁶

- “WE GIVE YOU MORE” (for “marketing” services – Application No. 4-2012-01305);

⁴⁴ Example provided by the Malaysia IP authorities.

⁴⁵ Examples provided by the Philippines IP authorities.

⁴⁶ Examples provided by the Viet Nam IP authorities.

- “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 Thailand, the following phrases were refused registration:⁴⁷

MORE THAN JUST A CLOUD

for advertising, business management, data management, database management, database marketing

I CAN READ

for pens, pencils, erasers, books, flyers, business cards, etc.

In contrast, the following advertising phrases were regarded as distinctive in the Philippines and registered as marks for the specified goods:⁴⁸

- “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.

⁴⁷ Examples provided by the IP authorities of Thailand.

⁴⁸ Examples provided by the Philippines IP authorities.

2.2 *Generic, Customary and Necessary Signs*⁴⁹

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 Viet Nam on grounds of being generic, customary or necessary for the goods and services indicated:⁵⁰

- “COTTON” for cloth, clothing, knitting services;
- “VASELINE” for skin care products.⁵¹

⁴⁹ See the provisions in BN TMA, s. 6(1)(c) and (d); KH TML art. 4(a), TM Manual p. 30; ID TML, art. 20.b) and f), and Elucidation, art. 20, point f); LA IPL art. 23.2, Decision 753, art. 40; MY TMA, s. 10(1)(d); MM; PH IP Code, s. 123.1(h) and (i), Rules, r. 102.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 EUIPO Guidelines, Part B, Section 4, Chapter 5.

⁵⁰ Examples provided by the Viet Nam IP authorities.

⁵¹ The word “VASELINE” has been recognized and protected as a proprietary trademark in other jurisdictions.

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.

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 as 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 and trade in connection with the variety, even after the expiration of the breeder's right.⁵²

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 laws usually contain similar provisions regarding variety denominations.⁵³ 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 that variety.

2.2.1.2 *International Non-proprietary Names – INN*

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 INN).

⁵² 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.

⁵³ For example, in Indonesia see TML art. 20.c), and Regulation N° 13 of 2004 under Law N° 23 of 2000 on Plant Variety Protection, article 4(g); in Lao PDR see Law on Intellectual Property, article 74.1; in Malaysia see the Protection of New Plant Varieties Act 2004, s. 16; in Singapore see Plant Variety Protection Act (Chapter 232A), s. 37; in Viet Nam see Intellectual Property Law No. 50/2005/QH11 of 29 November 2005, article 163. Also see the EUIPO Guidelines, Part B, Section 4, Chapter 13.

“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.”⁵⁴

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.⁵⁵

In case of doubt, the examiner should consult the latest list of INN published by the WHO.⁵⁶

2.2.2 Generic, Customary or Necessary Figurative Signs

Certain figurative or mixed 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 or mixed signs cannot function as trademarks in respect of the goods or services that they identify.⁵⁷

⁵⁴ See WHO at <http://www.who.int/medicines/services/inn/innguidance/en/>.

⁵⁵ In this regard, see the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.13.

⁵⁶ See <http://www.who.int/entity/medicines/publications/druginformation/innlists/en/index.html>.

⁵⁷ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 7, and Chapter 5, item 1.

For instance, the IP authorities of the Philippines decided that the following sign was unregistrable for electronic apparatus and equipment (class 9) and for retail store services (class 35):



The positioning of the letter “R” touching the leftmost part the circle was found to be insignificant and unable to avoid confusing similarity or almost identity with the usual standard “Registered Mark” symbol.

As regards purely figurative signs, for example, the following signs are customarily used in the leather industry to indicate that a product is totally or partly made of leather material. 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:



[Examples, respectively, from: <https://github.com/FortAwesome/Font-Awesome/issues/11478> and <http://www.vse-seniorum.cz/www-vse-seniorum-cz/eshop/4-1-Pece-o-kozeny-nabytek/0/5/20-LM-Strong-silne-znecistení-kuže>]

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



[Example provided by the Philippines IP authorities]

In Viet Nam 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

The Viet Nam Regulations on the Examination of Applications for the Registration of Marks, 2010, item 17.8.2.c), also provide the following examples of signs to be considered generic or customary:



For mechanical engineering services and pharmacy services, respectively

2.3 *Descriptive Signs*

2.3.1 Generally Descriptive Signs

A sign 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 as a mark for those goods or services.⁵⁸

Signs that describe goods or services cannot function as trademarks for those goods or services because they will not be recognized as a distinct element indicating a commercial origin different from competing goods or services of the same description. Such descriptive terms 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 in the public domain, freely accessible to all persons operating in the marketplace.

A sign should be 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

⁵⁸ See the provisions in BN TMA, s. 6(1)(c); KH TML art.4(a) TM Manual p. 30 and 31; ID TML art. 20.e) and f), Elucidation art. 20 point f); LA IPL art. 23.1 and 2, Decision 753 art. 40; MY TMA, s. 10(1)(d); MM TML s. 13.b); PH IP Code, s. 123.1(J) and (L), Rules, r. 102.j); SG TMA s. 7(1)(c); TH TMA s. 7(2) and 17; and VN IPL, art. 74.2.c), Circular 01/2007 s. 39.3.g), s. 39.4.d). Also, the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 1.

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.

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.

2.3.1.1 *Combination of descriptive and non-descriptive elements*⁵⁹

When a mark is composed of one or more descriptive words or other descriptive elements but also contains at least one sufficiently distinctive element, the combination as a whole should be regarded as distinctive for the purposes of registration. The fact that a mark is registered that contains descriptive or non—distinctive elements does not mean that these elements may be separately claimed as proprietary.⁶⁰

⁵⁹ In this connection see also item 2.5, below.

⁶⁰ See the EUIPO Guidelines, Part B, Section 4, Chapter 4, items 4.1 and 4.2.

For example, the following *combination* of the fanciful, distinctive word “JERRYJO” with the descriptive words “health foods” could be registered, as a whole, for food products:

JERRYJO HEALTHFOODS

Likewise, if a figurative element that is distinctive on its own is added to a descriptive or otherwise non-distinctive word element, the sign as a whole may be considered distinctive, provided that said figurative element is, due to its size and position, clearly recognizable in the sign.

For example, the following mark, as a whole, could be regarded as distinctive for “restaurant services”, in spite of the fact that the words “best chef” would be descriptive for those services:



2.3.1.2 *Position of elements in a mark*

If a mark consists of a word that is inherently descriptive with respect of particular goods or services, the fact that non-distinctive elements of the word are arranged vertically, upside-down or in one or more lines will not normally confer the sign with the distinctive character necessary for registration.

However, the particular way in which the word elements are arranged can add distinctive character to a sign when the arrangement is of such a nature that the average consumer will focus on the *arrangement* of the elements rather than immediately perceiving the descriptive message.⁶¹

⁶¹ In this regard, see the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 4.2.1.

For example, the following sign consisting of the words “BEST CHEF” would be regarded as descriptive (laudatory) for “food catering and restaurant services”.

However, those words could become distinctive if their elements are presented in an *unusual arrangement or shape* that will attract consumer attention and be retained as a particular indication of commercial provenance:

C
B H
 E
F S
 T

2.3.1.3 Inclusion of simple geometric shapes

If a sign consists of words or other verbal elements that are descriptive or otherwise non—distinctive, the combination of those elements with basic geometric shapes such as dots, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses will normally not provide distinctiveness to the sign as a whole, in particular when those shapes are used as a *frame or border*.

For example:



However, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a *global impression* that is sufficiently distinctive.⁶²

⁶² In this regard, see the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 4.2.2.

For example, the words “flavour and aroma” would be descriptive and therefore not registrable as a mark for ‘seasonings, spices and sauces’. However, its combination with a particular presentation or arrangement of geometrical shapes (squares) could, as a whole, be regarded as fanciful and sufficiently distinctive in respect of those products.⁶³



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 *wearing apparel*, or for *cosmetics*.

Moreover, the descriptiveness of a word must necessarily be assessed on the basis of the language or languages that are spoken or understood by the average consumers of the goods or services for which the mark will be used in the country concerned.

⁶³ Example provided by the EUIPO.

The descriptiveness of a word or word element may not be removed or dismissed by altering the character typeface, size or font of the letters in those words. For example, the word ‘LAGER’ would be considered descriptive with respect to ‘beers’ regardless of its presentation in any of the following typefaces.⁶⁴

LAGER LAGER LAGER LAGER

The following are examples of descriptive terms:

- as regards the kind or nature of goods or services: ‘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*;⁶⁵
- 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);⁶⁶
- as regards the size of goods or services: ‘FAMILY’, ‘GIANT’, ‘JUNIOR’, for any goods or services;

⁶⁴ As regards the distinctiveness of words when combined with other features, see item 2.5, below. In this connection see also the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.7 and 4.2.1.

⁶⁵ Examples provided by the Philippine IP authorities.

⁶⁶ Examples provided by the Philippine IP authorities.

- 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’⁶⁷ 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*;⁶⁸ ‘SMART’ for *electronic devices* that have processors, are programmable, have automated functions or are capable of processing information.⁶⁹

In Indonesia the following signs were refused registration as trademarks on grounds of descriptiveness:⁷⁰

Best Mart

for mini-market services

⁶⁷ Example suggested by the Singapore IP authorities.

⁶⁸ Examples provided by the Philippine IP authorities.

⁶⁹ See the Trademarks Manual of Cambodia, p. 36.

⁷⁰ Examples provided by the Indonesia IP authorities.

International Standard Academy

for educational 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:⁷¹

Extra SMS

(07022197 – Malaysian Mobile Services Sdn. Bhd.)

SLIMFIT

SLIM FIT

Slim Fit

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

⁷¹ Examples provided by the Malaysia IP authorities.

In Viet Nam the following terms were found to be descriptive:⁷²

Perfect

Application No. 4-2011-10424

COOL FRESH

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

NHENDO

for pesticides, insecticides. The application was refused because the word “NHENDO” is a variation of the word “Nhện Đỏ” (in English: red spider). The red spider is harmful insect species that destroys plants.

Application 4-2013-16086

In Cambodia the following sign was initially refused on grounds of descriptiveness:⁷³

Plus⁺soft

for clothing – Application No. 42186/11

⁷² Examples provided by the Viet Nam IP authorities.

⁷³ Example provided by the Cambodia IP authorities.

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.⁷⁴

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.

In Thailand, the following misspelt descriptive (laudatory) expression "extra" was refused registration as a mark:⁷⁵

EKTRA

for smartphones, photographic lenses.

The following misspelt words were found to be descriptive in Malaysia for the specified goods:⁷⁶

Careklean

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

'KLEAN `N' RINSE'

for cleaning and soaking solutions for contact lenses (93007872 – EXCEL PHARMACEUTICAL SDN.BHD.)

⁷⁴ See the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.3.

⁷⁵ Example provided by the IP authorities of Thailand.

⁷⁶ Examples provided by the Malaysia IP authorities.

The logo for 'SURE-LOC' is written in a bold, outlined, sans-serif font. The letters are white with a thick black outline. A small circular trademark symbol is located at the end of the word '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.*⁷⁷

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:

The logo for 'Xtra Delixious' is written in a stylized, bubbly, cursive font. The letters are white with a thick black outline. The word 'Xtra' is positioned above 'Delixious'.

for various foods and food products – Application N° 05001995
[Example provided by the Malaysia IP authorities]

⁷⁷ European Community registration N° 002091262. The registration can be seen on the EUIPO trademark database at <https://euipo.europa.eu/eSearch/#advanced/trademarks/1/100/n1=ApplicationNumber&v1=002091262&o1=AND&c1=CONTAINS&sf=ApplicationNumber&so=asc>

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



for goods in class 5 of the Nice Classification – Application No. 4-2004-03598
[Example provided by the Viet Nam 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.⁷⁸

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*);

⁷⁸ See the EUIPO Guidelines, Part B, Section 4, Chapter 3, item 2.

- ‘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 partial⁷⁹ (e.g. for *milk and milk products with partial or skimmed fat content*).

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.

⁷⁹ Example provided by the Philippine IP authorities.

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.⁸⁰

For instance, in Viet Nam the following combinations of descriptive words were found unregistrable:⁸¹

- ‘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.

In Indonesia, the following word combination was refused registration on grounds of descriptiveness:⁸²

BESTCHEF

for restaurant services

In Malaysia the following word combinations were found to be descriptive:⁸³

‘EXTRASAFE’

(01002067 – Takaso Rubber Products SDN. BHD.)

⁸⁰ See the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.2.

⁸¹ Examples provided by the Viet Nam IP authorities.

⁸² Example provided by the Indonesia IP authorities.

⁸³ Examples provided by the Malaysia IP authorities.

‘SUPERGUARD’

(02001109 – Kao Kabushiki Kaisha (Kao Corporation))

In Thailand, the following word combinations were found descriptive and not admitted for registration as marks:

HALF BAKED

for ice cream, bakery, desserts

BODYBALANCE

for proteins, vitamins and antioxidants for use in the manufacture of food supplements

YOUTH FACTOR

for medicated facial lotions, medicated skin moisturizers, etc.

Likewise, in cases decided by European Union authorities the following word combinations were found to be descriptive and hence unregistrable:⁸⁴

- ‘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);

⁸⁴ Examples cited in the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 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*

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*

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.⁸⁵

For instance, the following combinations of descriptive elements could be regarded as distinctive:⁸⁶

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

⁸⁵ See the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.2.

⁸⁶ Examples provided by the Singapore IP authorities.

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 countries, regions and other political demarcations but also the names of geographic or topographic phenomena including rivers, mountains, deserts, forests, oceans, lakes, etc.⁸⁷

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:⁸⁸

BOHEMIA

for *beer products* (NCL class 32)

Application N° 92008724 – Cerveceria Cuauhtemoc S.A. de C.V.

⁸⁷ See the provisions in BN TMA, s. 6(1)(c); KH TM Manual p. 37 and 38; ID TML art. 20.c); LA IPL art. 23.2 and 13; MY TMA s. 14(1)(f); MM TML s. 13.b); PH IP Code, s. 123.1(j), Rules, r. 102.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 d). Also, the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.6.

⁸⁸ Example provided by the Malaysia IP authorities

Bohemian-Art

for household or kitchen utensils and containers, semi-worked glass, glassware,
porcelain and earthenware

Application N° 07005436 — SOUTHERN POTTERY (M) SDN. BHD

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.

If the geographical sign is not known to the public, or is known but is not recognized as, or associated with, 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:⁸⁹

‘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.

⁸⁹ Examples provided by the Singapore IP authorities.

In Viet Nam the following sign was refused registration for any goods or services because “Ha Noi” is the name of the capital city of Viet Nam:⁹⁰



Đản phẩm của Người Hà Nội

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 Names*

A geographical name that does not refer to a likely or plausible place of origin of the particular products or services to which it applies, 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* or *allusive* of a particular location or place of origin.

For example, geographical names such as ‘MONT BLANC’, ‘ANNAPURNA’ or ‘EVEREST’ (names of mountain peaks), ‘SERENGETI’ (name of a desert), and ‘NIAGARA’ (name of a waterfall) are distinctive

⁹⁰ Examples provided by the Viet Nam IP authorities.

and may be registered as trademarks for, respectively, *writing instruments, apparatus for lighting and heating, eye glasses and lenses, and sanitary appliances and fittings.*

The following are further 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’,⁹¹ ‘TORINO’ and ‘PLYMOUTH’ for *automobiles*.

Similarly, ‘ALASKA’ for *milk and other dairy products*, and ‘MANHATTAN’ for *clothes and footwear* could be admitted for registration.⁹²

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**. Since the link between the goods or services and the geographical place is *unlikely*, those names can 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 the geographical name is known or usual in the practice in the relevant trade or business circles.

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 were used as a brand for scientific, nautical, surveying, photographic, cinematographic, optical, weighing and measuring instruments. In respect of these products, the name ‘CANTA’

⁹¹ Example provided by the Philippine IP authorities.

⁹² Examples provided by the Philippine IP authorities.

would be perceived by the public as a *fanciful* name, unrelated to the actual or likely geographical origin of those goods.

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.

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.

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:





[Examples, 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 <https://matadornetwork.com/read/epic-views-mount-fuji/>]

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



Application No. 4-2010-17717
[Example provided by the Viet Nam IP authorities]

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



[Examples provided by the Philippine IP authorities]

In Thailand, the authorities refused registration to the following signs:⁹³



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:

⁹³ Examples provided by the IP authorities of Thailand.



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

In connection with geographically *descriptive* signs see item 2.3.6.1, above. As regards signs that are geographically *deceptive* or misleading, see also 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 of the manufacturer or the place of its 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 *molded 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 geographically descriptive or geographically misdescriptive 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’.

In this regard, the following sign was refused registration in Thailand:



For clothing
[Example provided by the IP authorities of Thailand]

Words that convey a general, positive connotation but that do 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 in respect of any goods or services.

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 Viet Nam 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, usefulness, commercial value, cost or other characteristics of the goods or services or of their supply to the public.⁹⁴

For example, the following phrase was refused registration in Thailand on grounds of descriptiveness:⁹⁵



for advertising, business management, marketing management, marketing consultancy, Promotional marketing, digital marketing

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:⁹⁶

“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”

⁹⁴ For instance, see the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 2.5.

⁹⁵ Example provided by the IP authorities of Thailand.

⁹⁶ Examples provided by the Viet Nam IP authorities.

“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)

“YOUR WORLD. MORE PRIVATE” (for computer software and temporary use of non—downloadable computer software)

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



01008384 - US POINT VISION CARE GROUP SDN. BHD.
[Example provided by the Malaysia IP authorities]

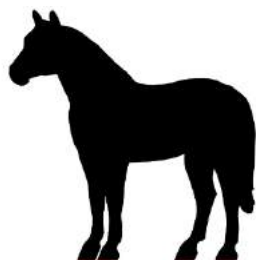
2.3.9 Descriptive Figurative Signs

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.⁹⁷

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

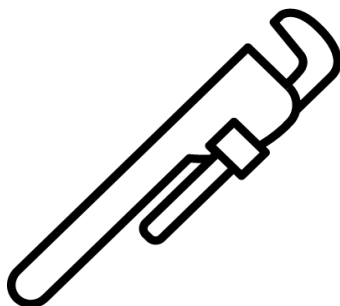


for horse-riding equipment, or horse transportation vehicles
[Example from: <http://clipart-library.com/clipart/8TE6Raedc.htm>]



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

⁹⁷ See examples in the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 3.



for hand tools and power-tools

[Example from: <http://freevector.co/vector-icons/other/pipe-wrench.html>]



for noodles and vermicelli

00009185 – CHEAH PAK FOO T/A FOO WON MEE MANUFACTURER

[Example provided by the Malaysia IP authorities]



for hotels services

[Example provided by the Viet Nam IP authorities]

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

In Thailand, the following figurative signs were found to be descriptive of the relevant goods and were refused registration as trademarks:⁹⁸



for perfume, soap.

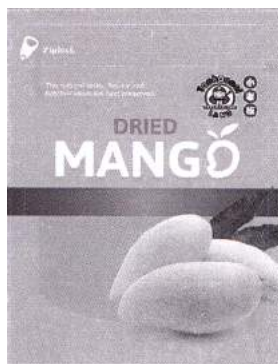
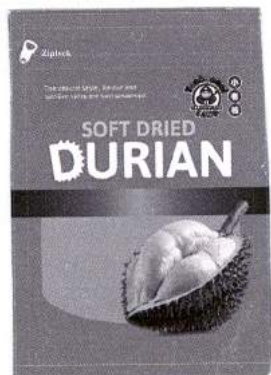


for live mussels.



for milk products.

⁹⁸ Examples provided by the IP authorities of Thailand.



for dried fruit and fruit products.

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 sufficiently departs from the standard, identical representation of the goods or services, should not be regarded as 'descriptive' and could 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 do not reproduce the usual appearance or shape of the specified goods or services and should not be regarded as descriptive:



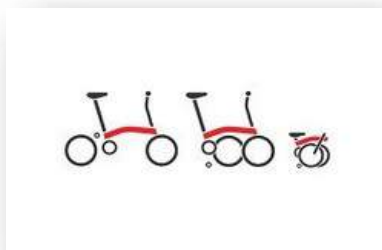
for *animal accessories and veterinary services*.

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



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

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



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

[Examples provided by the Philippines IP authorities]



*for pickles; processed vegetables and fruit, canned fruits and vegetables;
edible oils and fats; poultry and games; meat and meat extracts*
02001898 - STC CATERERS SDN. BHD.
[Example provided by the Malaysia IP authorities]

In Viet Nam 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:



for ‘coffee’ or ‘coffee products’ – Application No. 4-2008-01941
[Example provided by the Viet Nam IP authorities]

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.⁹⁹

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 will 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. The name may be cast in standard characters, with a special font, as a figurative device or as a combination thereof.

Where the sign consists of or includes 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, chapter 8, of these Guidelines regarding third-party rights in personal names).

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

Jim Thompson

 **pierre cardin**

YVES SAINT LAURENT

⁹⁹ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 31; ID TML art. 1.1, 2.3 and 21.2.a); LA IPL art. 16.1 and 23.7; MY TMA, s. 10(1)(a) and (b); MM TML s. 14.b); PH IP Code, s. 123.1(c), Rules r. 102.c); SG TMA s. 2(1) – 'sign' and 'trade mark', TMR r. 14; TH TMA s. 4 – 'mark' and 7.1; and VN IPL, art. 73.3, Circular 01/2007 s. 39.4.f).



04019735 – Registered – RAMLY FOOD PROCESSING SDN. BHD.
[Example provided by the Malaysia IP authorities]

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.

For example, in certain countries names such as SUKARNO, LADY DIANA, CHÉ GUEVARA or EINSTEIN may not be allowed registration as trademarks.¹⁰⁰ 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.

¹⁰⁰ 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 and Yang Di-Pertuan or any member of the Royal family, or any colorable imitation thereof".

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:



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

2.5 Distinctiveness Resulting from a Combination of Elements

A sign that is inherently not distinctive, 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.¹⁰¹

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 or with additional distinctive elements:

¹⁰¹ See the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 4.1.

‘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 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

[Example provided by the Philippines IP authorities]

**ECO
MIND**

for goods in NCL classes 3 and 5

[Example provided by the Viet Nam IP authorities]



for wine products

[Images from: <http://wineconcepts.co.za/wp-content/uploads/2016/04/Square-Red-Wine-Bottle-.jpg> and <https://drizly.com/wine/red-wine/cabernet-sauvignon/josh-cellar-cabernet-sauvignon/p20877>]



for *cat and pet food*

[Images from: https://www.123rf.com/photo_21878351_blue-eyed-cat-head.html
and <https://petsmartnigeria.com/product/whiskas-pouch-cat-food-fish-selection-jelly-12-x-100g/>]

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.¹⁰²

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:

- The use of colors and typefaces is common in trade and their use will not be perceived as an indication of commercial origin. Therefore, a simple change or addition of letter style, font or a single color to a non—distinctive word will not be enough to make that word distinctive. For example:

¹⁰² See the EUIPO Guidelines, Part B, Section 4, Chapter 4, item 4.2.

PRIME

PRIME

PRIME

However, a particular graphic design or an *unusual arrangement* of style, font and colors that can create a lasting impression and be easily remembered by the relevant consumers, could render the mark distinctive *as a whole*. For example:

PRIME



[Image from: <https://www.logolynx.com/topic/diy+business#&gid=1&pid=2>]

- 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 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 from: <http://www.winelabels.org/artmake.htm>]

‘BIOMEDICAL’

‘BIOMEDICAL’



for medicinal and health products and services

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

‘FRESHLY FRUIT’



‘FRESHLY FRUIT’

for fruit juices, jams and fruit products

[Image 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 claimed, appropriated or controlled exclusively by any particular trader.

However, that 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.¹⁰³

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

¹⁰³ 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]

come to be recognized 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.¹⁰⁴

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 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:

¹⁰⁴ See the provisions in BN TMA, s. 6(1) proviso; KH TM Manual p. 29; MY TMA s. 10(2B)(b); MM TML s.13(b)(i); PH IP Code, s. 123.2, Rules, r. 102, second paragraph; 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 EUIPO Guidelines, Part B, Section 4, Chapter 14.



[Image 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:

Secret Recipe
Fine Quality Cakes

for cakes and bread

Application N° 97009666

[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 the evidence submitted by the applicant “enables the Office to find that at least *a significant proportion of the relevant section of the public* identifies the products or services concerned as originating from a particular undertaking because of the trade mark”.¹⁰⁵ A significant portion of the relevant consumers in the country must see the trademark as identifying the relevant goods or services of a specific undertaking. It must be shown that, because of the use of the mark in that country’s market, the relevant public associate that mark with those goods or services.

All legal means of *evidence* will should be acceptable as indications that the sign is recognized as a mark and that the mark is effectively associated with a particular commercial origin in the country concerned. Usual types of evidence for this purpose may include, among others:¹⁰⁶

- figures of turnover and sales of the product with the mark in the country;
- figures of investment in advertising the mark in the country;

¹⁰⁵ See the EUIPO Guidelines, Part B, Section 4, Chapter 14. item 7.

¹⁰⁶ In this connection, see the EUIPO Guidelines, Part B, Section 4, Chapter 14. Item 8.

- consumer and market surveys about the products or services bearing the mark;
- reports from business associations and consumer organizations about the goods or services offered with the mark;
- reports on the type, scope and extent of advertising campaigns regarding those goods or services;
- documents evidencing the advertisements and promotional campaigns in the media that refer to the mark;
- catalogues, price lists and invoices that refer to the goods or services with the mark;
- management reports relating to the goods or services covered by the mark.

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 recognize 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.¹⁰⁷

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*:

¹⁰⁷ See the provisions in BN TMA, s. 6(3)(b); KH TML art. 4(c); ID TML art. 20. c); LA IPL art. 23.3 and 4; MY TMA, s.14(1)(a) and TMR, r. 13A(c) and (d); MM TML s. 13.e); PH IP Code, s. 123.1(g), Rules, r. 102.g); SG TMA s. 7(4)(b), TM Manual chapter 12 “Deceptive Marks”; TH TMA s. 8(9); and VN IPL, art. 73.5. Also the EUIPO Guidelines, Part B, Section 4, Chapter 8.

- (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 should 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 *reasonable and 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.¹⁰⁸

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.¹⁰⁹ However, the same mark should not be accepted for a specification of goods that is *confined* to ‘*fanciful and non-precious jewellery*’ because the meaning of the word ‘gold’ in the mark would be in direct contradiction with the nature of the only goods on which the mark would 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

¹⁰⁸ In this respect see, for instance, the EUIPO Guidelines, Part B, Section 4, Chapter 8, item 1.

¹⁰⁹ Such registration would not prevent bona fide third parties from freely using the word “gold” in the ordinary, descriptive sense in connection with their goods or services.

relevant public.¹¹⁰ The relation between fresh fruit juices and coffee beans or tea leaves is arbitrary and fanciful, and therefore incapable of deceiving consumers as to the nature or composition of fruit juices.

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 and habits of the average consumers of beers and ales and the manner in which those goods are usually offered or

¹¹⁰ Example provided by the Indonesian IP authorities.

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 specific goods.¹¹¹

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.¹¹²

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 those words were understood by the average consumer to mean “coffee from Brazil” and the mark was filed for use on coffee that does *not* originate in Brazil. This would be the case, for instance, 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 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

¹¹¹ Example provided by the Singapore IP authorities.

¹¹² In this connection see the EUIPO Guidelines, Part B, Section 4, Chapter 8, item 2.

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.¹¹³ That mark would be inevitably deceptive if used for goods that do not 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.¹¹⁴ 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.¹¹⁵

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

¹¹³ Example provided by the Philippines IP authorities.

¹¹⁴ Example provided by the Philippines IP authorities.

¹¹⁵ In this connection see the EUIPO Guidelines, Part B, Section 4, Chapter 8, item 3.

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). 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).



[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). If the specification of goods for that mark were to cover specifically only “*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.



[Example provided by the Philippines IP authorities]

In Viet Nam the following devices were regarded as geographically deceptive when applied to goods not originating from the countries indicated in the signs:¹¹⁶



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



Application No. 4-2008-20839

¹¹⁶ Examples provided by the Viet Nam IP authorities.

In Indonesia the following signs were refused registration because they reproduced the names of foreign countries without the required authorization:¹¹⁷

CYPRUS

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 a public body, official authority or statutory organization.¹¹⁸

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’¹¹⁹ or ‘INTERNATIONAL STANDARD’ does not refer

¹¹⁷ Examples provided by the Indonesia IP authorities.

¹¹⁸ For instance, see ID TML art. 21(2).c); LA IPL art. 23.3, 4 and 5, Decision 753 art. 41; SG TMR r. 12 and 13; TH TMA s. 8(6); VN IPL art. 73.4. Also, the EUIPO Guidelines, Part B, Section 4, Chapter 8, item 4.

¹¹⁹ Example provided by the Philippines IP authorities.

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.

In Malaysia similar cases for refusal include marks containing the words 'HALAL' and 'BUATAN MALAYSIA'.¹²⁰

In Viet Nam the following signs were not accepted on grounds that they are deceptively allusive to compliance with standards:¹²¹

- "JAPAN TECHNOLOGY"
- "STANDARD GERMANY"



In Thailand, the following sign was refused registration on grounds that it contained a deceptive reference to an official endorsement:¹²²

¹²⁰ Example provided by the Malaysia IP authorities.

¹²¹ Examples provided by the Viet Nam IP authorities.

¹²² Example provided by the IP authorities of Thailand.



for business advice, management advice; communication services; training, training of personnel in the areas of recruitment, human resources and business management

Likewise, a mark consisting of or including, for example, the expression 'ORGANIC CERTIFIED'¹²³ 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 signs 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.

¹²³ Example provided by the Philippines IP authorities.

4 State and Official Signs, Emblems and Other Symbols

4.1 *Signs under Article 6ter of the Paris Convention*

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:¹²⁴

- armorial bearings of States,
- flags of States,
- other State emblems,
- 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 6ter** 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

¹²⁴ 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. 21(2).b); LA IPL art. 23.5 and 6; MY TMA s. 15(b), TMR, r. 13, 14 and 15, TM Manual item 5.37; MM TML s. 13.f) and g); PH IP Code, s. 123.1(b), Rules, r. 102.b); SG TMA s. 7(11), (12) and (13), 56 and 57, TMR r. 11, 12 and 13, and TM Manual chapter 11 on “Other grounds for refusal of registration”, p. 9, 10 and 11; TH TMA, s. 8(1), (2), (6) and (7); and VN IPL, art. 73.1, 2 and 4. Also the EUIPO Guidelines, Part B, Section 4, Chapter 9.

emblems communicated through the Article 6*ter* procedure can be found on the 6*ter* database accessible online on the WIPO website.¹²⁵

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

- Armorial bearings of States



¹²⁵ See the WIPO website at: <http://www.wipo.int/ipdl/en/6ter/>.

- Flags of States



- Other State emblems ¹²⁶



Argentina



MOZAMBIQUE

¹²⁶ State emblems include 'country brands' and 'nation brands' adopted by Member States of the Paris Union as national identity signs.

- Official signs and hallmarks indicating control and warranty adopted a State¹²⁷



¹²⁷ Official signs and hallmarks indicating control or warranty include 'country brands' and 'nation brands' that States or national State agencies have adopted as official signs of control or warranty for specific goods or services.

- Names and abbreviations of names of international intergovernmental organizations

UNITED NATIONS ORGANIZATION

FOOD AND AGRICULTURE ORGANIZATION

WORLD HEALTH ORGANIZATION

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



- 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. The objection may be dropped if the

applicant submits evidence that the State or organization concerned has given authorization for registration of such mark.¹²⁸

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



[Example provided by the Philippines IP authorities]



[Examples, 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>]

¹²⁸ In this connection see the EUIPO Guidelines, Part B, Section 4, Chapter 9, item 2.3.

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



Application No. 4-2008-26144
[Example provided by the Viet Nam IP authorities]

Likewise, the authorities of Viet Nam refused registration to the following sign on grounds that it contained the flag of Australia:



Application No. 4-2014-15126
[Example provided by the Viet Nam 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.¹²⁹

¹²⁹ See http://www.gevers.eu/sites/default/files/gevers_belgium_feb13-mip.pdf.



[Image 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 colors of a flag should not be regarded as an imitation except, if the flag contains features (emblems, armorial bearings, etc.) that can be recognized regardless of the color.

For example, the following devices contain features (Swiss cross) that can be recognized notwithstanding the variations in the presentation or the color of a State emblem of Switzerland:



[Images, respectively, from:

https://www.google.com/search?q=fake+swiss+logos&client=safari&rls=en&source=lnms&tbn=isch&sa=X&ved=0ahUKEwj1iPSKxerhAhUStIkKHZV4B9sQ_AU-IDigB&biw=1364&bih=589#imgsrc=RismK4Z6Y3eEDM: 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 Marks¹³⁰

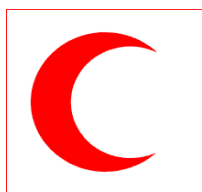
In addition to the emblems and other official signs covered by Article 6*ter* of the Paris Convention, signs protected by specific international treaties or by provisions in national laws, cannot, without proper authorization, be registered as a mark or as part of a mark. Signs that contain such emblems 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:

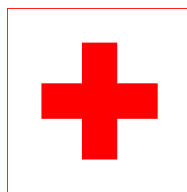


[Olympic symbol]

¹³⁰ See the EUIPO Guidelines, Part B, Section 4, Chapter 9, item 3.



[Red Crescent]



[Red Cross]

In this regard, the following sign was refused registration in Thailand: ¹³¹



for hospital services, health clinic services.

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 Viet Nam because of its unauthorized inclusion of the Euro sign:



Application No. 4-2012-20098
[Example provided by the Viet Nam IP authorities]

¹³¹ Example provided by the IP authorities of Thailand.

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 Darussalam:¹³²

- a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colorable 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;
- 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);

¹³² TMA s. 7(1)(c) and (d), and Chapter 94 - Emblems and Names (Prevention of Improper Use) Act, 1967.

- 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:¹³³

- the words "Bunga Raya" and the representations of the hibiscus or any colorable imitation thereof;
- representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colorable 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 colorable 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.

¹³³ TMR r. 13(1)(b), (c) and (d), and 14.

Singapore:¹³⁴

- a representation of the President or any colorable 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:¹³⁵

- State arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces;
- national flags of Thailand, royal standard flags or official flags;
- royal names, royal monograms, abbreviations of royal names or royal monograms;

¹³⁴ TMR r. 11 and 12.

¹³⁵ TMA s. 8(1), (2), (3), (4) and (5).

- 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 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.¹³⁶

‘*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 recognized 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 legal, 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

¹³⁶ See the provisions in BN TMA, s. 6(3)(a); KH TML art.4(b); ID TML, art. 20.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 TML s. 13.c); PH IP Code, s. 123.1(a) and (m), Rules, r. 102.m), TM Guidelines p. 87; SG TMA 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 EUIPO Guidelines, Part B, Section 4, Chapter 7.

section of the identified community potentially affected by the sign are factors to be considered in each case.

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.

5.2 Particular Issues

5.2.1 Nature of the Sign Itself

To the extent that national law so provides, an application for registration of a sign as trademark could be objected by the examining authority if the sign is deemed to be contrary to public policy or public order, or contrary to accepted principles of morality, in the country concerned.

This assessment must be undertaken by the competent national authority on the basis of the standards and criteria prevailing 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 the sign 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 on the market could 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.¹³⁷

Likewise, registration of the following marks were refused, respectively, in Indonesia and in Malaysia on grounds of their contradiction with the prevailing rules of religious morality, causing offense to the sensitivity of Muslim people and misrepresenting Islamic precepts.¹³⁸

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

¹³⁷ Information provided, respectively, by the IP authorities of Indonesia and the Philippines.

¹³⁸ Examples provided, respectively, by the IP authorities of Indonesia and of Malaysia.

In Thailand, the following sign representing the goddess Guanyin was refused registration on grounds of public order. In Chinese culture, and in other countries in East Asia, Guanyin is worshiped as a goddess. Registration of the image of Guanyin as a trademark was deemed contrary to public policy:¹³⁹



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

KANTOR POS

for restaurant services

[Example provided by the Indonesia IP authorities]

The grounds of morality include *ethical* and socially acceptable standards, as recognized or practiced under a country's culture and based on the perception of the people in that country. Therefore, the assessment of these grounds of refusal may be more subjective, but the trademark examiner should strive to apply them as objectively as possible.

For example, in Viet Nam the following sign was refused on grounds of public ethics:

¹³⁹ Information provided by the IP authorities of Thailand.

NUDE

Application No.4-2012-04183
[Example provided by the Viet Nam IP authorities]

Likewise, in Thailand the registration of the following figurative sign was refused. The sign represented the obscene hand gesture of the middle finger pointing up. The sign was deemed contrary to morality:¹⁴⁰



for *shirts* (clothing)

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:

¹⁴⁰ Information provided by the IP authorities of Thailand.

“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.¹⁴¹

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 commercialized 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 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 should be deemed registrable 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

¹⁴¹ For instance, see provisions in LA IPL s. 23 last paragraph, and Decision 753 art. 45 last paragraph; PH IP Code s. 123.3. In this connection, see also the EUIPO Guidelines, Part B, Section 4, Chapter 7, item 1:

“The question whether the goods or services for which protection is sought can or cannot be legally offered in a particular Member State’s market is irrelevant [...]”

or services to which the mark applies is subject to prior regulatory authorization or is 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.

It must be recalled in this respect that the registration of a mark will only confer a right to exclude third parties from the use of the mark. The registration of a mark does not grant on the registered holder a right to use that mark in trade.

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)¹⁴²

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.¹⁴³

A ‘collective’ organization that registers for 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 endeavor. The collective mark would be intended primarily for use by the

¹⁴² 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. [...]

¹⁴³ 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, and 46; LA IPL art. 3.11, Decision 753 art. 20, TM Manual p. 21 and 22; MY; MM TML s. 2.m); PH IP Code, s. 121.2 and 167, Rules r. 101.b); SG TMA s. 60 and First Schedule, TM Manual chapter 15 ‘Collective Marks’; TH TMA s. 4 – ‘collective mark’ and 94; and VN IPL, art. 4.17, 87.3 and 105.4. See also the EUIPO Guidelines, Part B, Section 4, Chapter 15.

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.

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 recognized and can be registered under many national trademark laws.¹⁴⁴

¹⁴⁴ 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 TML s. 2.n); SG TMA s. 61 and Second Schedule, TM Manual chapter 16 ‘Certification Marks’; TH TMA s. 4 – ‘certification mark’, 82 and 84; and VN IPL, art. 4.18, 87.4 and 105.5, Circular 01/2007 s. 37.6.

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.¹⁴⁵

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,
- 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.

¹⁴⁵ In this connection, see also the EUIPO Guidelines, Part B, Section 4, Chapter 16.

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 in 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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PART 2

RELATIVE GROUNDS FOR THE REFUSAL OF REGISTRATION OF TRADEMARKS

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Abbreviations Used in the Common Guidelines

ASEAN Member States (Country Codes)

BN	: Brunei Darussalam
ID	: Indonesia
KH	: Cambodia
LA	: Lao PDR
MM	: Myanmar
MY	: Malaysia
PH	: Philippines
SG	: Singapore
TH	: Thailand
VN	: Viet Nam

Other Abbreviations

ECJ	: Court of Justice of the European Union (European Court of Justice)
EU	: European Union
GI	: Geographical Indications
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)
Nice Classification	: The International Classification of Goods and Services for the Purposes of the Registration of Marks, established under the Nice Agreement of 1957
EUIPO	: European Union Intellectual Property Office

- EUIPO Guidelines : Guidelines for Examination of European Union Trade Marks – European Union Intellectual Property Office (EUIPO), version 1.1, 1 October 2017
- EUTMIR : Commission Implementing Regulation No. 2018/626, of 5 March 2018, implementing Regulation 2017/1001 on the European Union Trade Mark,
- EUTMR : Regulation No. 2017/1001 of 14 June 2017 on the European Union Trademark (European Union Trademark Regulation)
- 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 31 July 2019.

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 rights. 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 types of earlier rights that may be held by third parties that could conflict with an 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, other intellectual property statutes, civil law or common law.

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 was 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 some degree of economic detriment for another undertaking to the extent that the public may prefer certain goods or services on offer and shun others. However, any prejudice resulting from customer preference would be a normal consequence of competition in the market and cannot be regarded as ‘unfair’, provided that 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.¹

¹ In this connection see also the EUIPO Guidelines, Part C.

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.²

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.³

Double identity is less frequent than partial identity and similarity. However, when double identity is established there is no need to assess

² See the provisions in BN TMA s. 8(1) and (2), and s. 9; KH TML art. 4(g); ID TML art. 21(1) (a); LA IPL art. 16.2 and 3, and 23.9; MY TMA s. 19(1) and (2); MM TML s. 14; PH IP Code s. 123.1(d), Rules r. 102.d); SG TMA s. 8(1) and (2); TH TMA s. 13; and VN IPL art.74(2)(e).

³ See the provisions in BN TMA s. 8(1); KH TML art. 4(g); ID TML art. 21(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 TML s. 14.a); PH IP Code, s. 123.1(d)(i), Rules r. 102.d); SG TMA s. 8(1); TH TMA s. 13(1); and VN IPL art.74(2)(f). See also the EUIPO Guidelines, Part C, Section 2.

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.⁴

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.⁵

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.

⁴ 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."

⁵ See the provisions in BN TMA s. 8(2); KH TML art. 4(g); ID TML art. 21(1)(a); LA IPL art. 16, first paragraph, 3 and 23.9, and Decision 753 art. 34(1).2, 35 and 36; MY TMA s. 19(1)(b) and (2)(b); MM TML s.14.a); PH IP Code s. 123.1(d)(iii), Rules r. 102.d)(iii); SG TMA s. 8(2); TH TMA s. 13(2); and VN IPL art.74(2)(e). See also the EUIPO Guidelines, Part C, Section 2, Chapter 1, item 3.

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 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.

To decide if there is a likelihood of confusion, both the earlier mark and the later mark should be assessed. To this effect:

- The examiner should assess the distinctiveness of the earlier mark as a whole, on the understanding that an earlier registered mark is presumed to have a certain degree of distinctiveness.
- All the components of the earlier mark and of the later mark must be assessed, prioritising the coinciding components.

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. One single factor will not suffice to establish a likelihood of confusion in a particular case.

A global assessment of all the relevant factors and circumstances does not exclude — but rather follows — a step-by-step analysis of those factors and circumstances as they apply to the signs under consideration.

The factors that are relevant to determine a likelihood of confusion are linked and interdependent, and include:

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

These factors are discussed in the following sections.⁶

2.2.2 Comparison of Signs

In case of conflict between two marks, it will be necessary to look at the marks to decide if they are identical, similar, or dissimilar.⁷

The initial comparison of the signs should include all the perceptible elements in the signs, regardless of their distinctive value. At this initial stage, the comparison of the signs should focus on the objectively perceptible elements of the signs. Other factors such as the

⁶ 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 Member States: 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 39.9. See also the EUIPO Guidelines, Part C, Section 2, Chapter 1, item 4.2.

⁷ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 4.

distinctiveness of the sign or the *dominant* or *weak* elements will be decisive but should only be brought to weigh in at a later stage of analysis, for the final global assessment of likelihood of confusion.

When assessing the distinctiveness of two opposing signs for purposes of relative grounds of refusal, the same criteria apply as are used to determine distinctiveness for absolute grounds of refusal. However, those criteria are used to establish if the minimum threshold of distinctiveness is attained as well as to assess the varying degrees of distinctiveness of the marks involved.

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’.

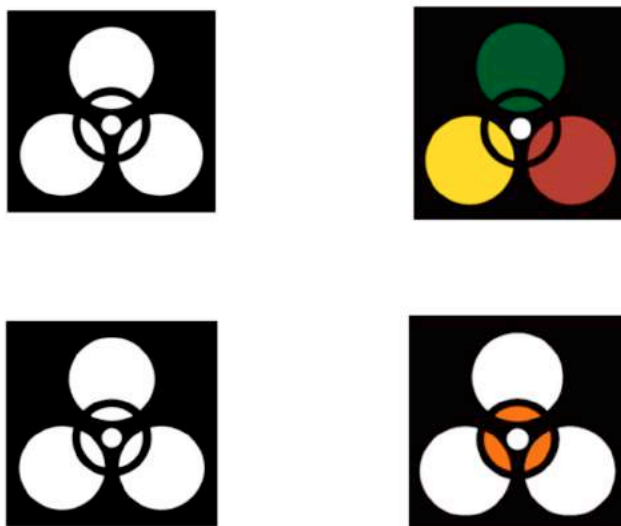
Two signs that are identical *in all aspects*, or that present differences that are *insignificant* because they cannot be perceived or noticed by the relevant consumers, should therefore be regarded as ‘identical’.

A difference in **colour** will normally preclude a finding of identity. This means, in particular, that an earlier mark in black and white or in greyscale should not be regarded as “identical” to the same mark in colour, unless the differences in colour or in the contrast of shades are insignificant. The following examples illustrate cases where differences in colour or shade should be regarded as *significant* or *insignificant*.⁸

(i) Insignificant differences:



(ii) Significant differences:



⁸ Examples provided by the EUIPO.



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 simple variation of upper or lower case should 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.⁹

⁹ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 4, item 3.

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.¹⁰

¹⁰ 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. [...] The *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 details. [...]

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 is purely factual and objective. It will determine how much the later mark *looks* like the earlier mark.¹¹

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), or two mixed marks.

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

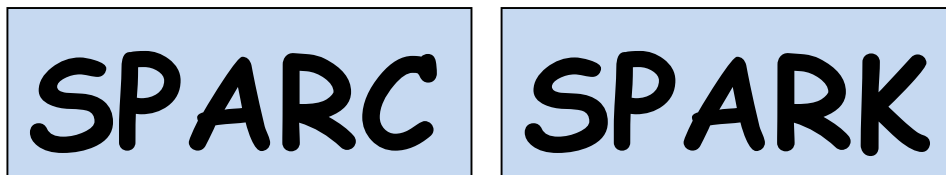
(1) As regards a conflict between *two purely word marks* the visual comparison will be based on the number and sequence of the letters, digits and characters contained in the marks. The analysis will necessarily be made in the language (and alphabet) of the national office, as well as in other languages 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

¹¹ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 4, item 3.4.1.

make the marks visually more dissimilar than a variation in one of the middle letters.

Typically, the alteration of one middle letter (not initial letter) would avoid identity of the word but would sustain a finding of similarity. For example, the following signs should be regarded as visually similar:¹²



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.

¹² Example provided by the IP authorities of Thailand.

For instance, the Philippines IP authorities found that the following signs were confusingly similar:



Subject mark
For tropical dried fruits (class 29)

SWEET VALLEY

Cited (earlier) mark
For tinned fruit and vegetables
(class 29); fresh fruit and
vegetables (class 31)

It was noted that the presence of a *frame is insignificant* and did not prevent the subject mark from being confusingly similar with the cited mark.

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 (the signs applied for registration appear on the left and the registered or cited marks appear on the right):

Ma

Mo
Momo Denim

Me
Meme Denim

Mc

[Example provided by the IP authorities of Thailand]



[Example provided by the Indonesia IP authorities]



(Japan Airlines' service mark)

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



[Example provided by the IP authorities of Thailand]

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 strikingly 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.

For example, the following devices are not identical, but their figurative elements are close enough for the signs to be regarded as visually similar:¹³



¹³ Example provided by the IP authorities of Thailand.

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 Comparison¹⁴

(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

¹⁴ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 4, item 3.4.2.

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 have 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. The stress of the pronunciation of the words’ syllables, as customary among the relevant consumers, is also to be taken into account.

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.



(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 (for example, ‘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

In Singapore, the case of *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941, considered the following marks:¹⁵

The Composite Mark	The Sign
	

The fact that the syllables are articulated in an inverted order does not prevent the two marks from being found to be aurally similar.

(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.

¹⁵ Example provided by the IP authorities of Singapore.

(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, the following mixed signs were found to be phonetically similar notwithstanding of their different visual appearance:



[Example provided by the IP authorities of Indonesia]



[Example provided by the IP authorities of Thailand]

2.2.2.2.3 Conceptual Comparison¹⁶

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.

¹⁶ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 4, items 3.4.3 and 3.4.4.

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:

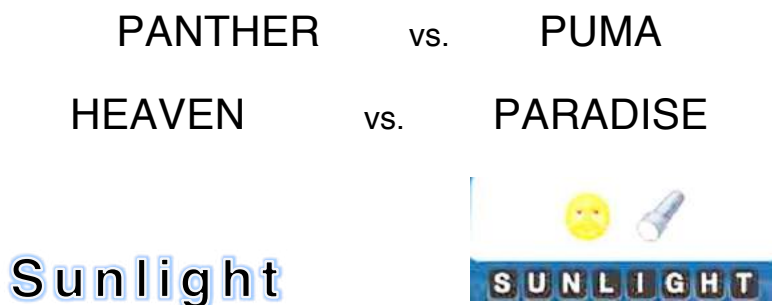
- signs that contain a *word* element that has a meaning in the language, or one of the languages, of the country concerned, or
- signs that have a *figurative* element that represents something that has a meaning, i.e. something that can be recognised and described or named in words.

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 there is no conceptual similarity between them, i.e. they are not conceptually similar.

Factors Relevant for Conceptual Comparison

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

For example:



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



[Images, respectively, from <https://www.kissspng.com/png-hummingbird-drawing-blue-clip-art-crowned-clipart-1439446/> 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 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.

For instance, the IP authorities of the Philippines found that the following mixed marks were confusingly similar:

Subject mark

Cited (earlier) mark

Both for *restaurant services*

In this case it was noted that the likelihood of confusion was not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark [the figurative element]. If the *dominant* (word) portion of both marks is the same the marks may be confusingly similar notwithstanding ancillary differences.

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 that case, the assessment of the likelihood of confusion should focus on the *impact* of the *non-coinciding components* on the *overall impression* of the signs. The examiner should take into account the distinctiveness of the non-coinciding components.

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.

When marks share an element that has a low degree of distinctiveness there may still be a likelihood of confusion if:

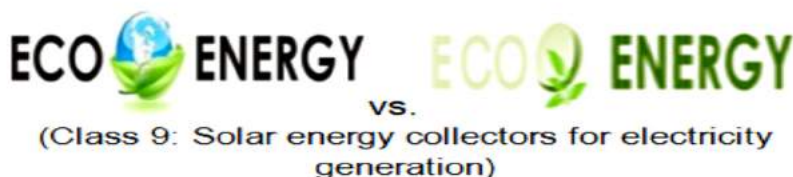
- the other components have an equally low or a lower degree of distinctiveness, or are of insignificant visual impact, but the *overall impression* of the marks is similar; or
- the *overall impression* of the marks is highly similar or identical.

For example, in a conflict between two word marks used for 'cosmetic products' that share the *common prefix element* "COSME", the remaining

elements are sufficiently close to produce an overall impression of similarity. This would warrant finding a likelihood of confusion:

COSMEGLOW vs. COSMESHOW

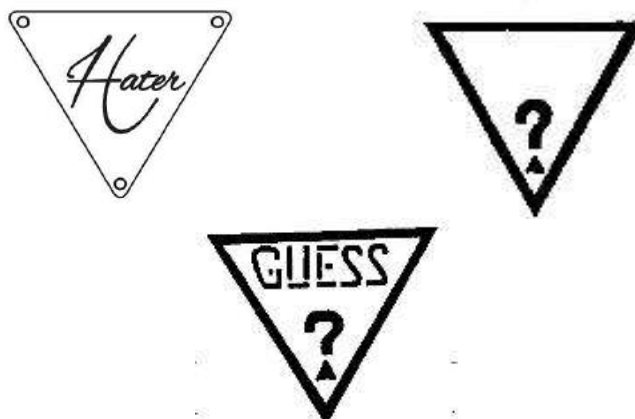
The following example illustrates the case of figurative or mixed marks containing elements that are commonplace or descriptive for the goods or services in question, but the particular arrangement of those elements gives them an *overall impression* of identity or similarity that causes a likelihood of confusion. In these cases the later marks should be refused registration:¹⁷



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, and the other elements contained in the marks are different, no likelihood of confusion can be found with respect to those marks. They may be allowed to coexist on the market.

¹⁷ Examples provided by the EUIPO.

For instance, the IP authorities of Singapore dismissed an opposition based on alleged similarity between the following mixed (composite) signs:¹⁸



Subject mark

Cited marks

For goods in NCL class 25 (*wearing apparel*)

The IPOS concluded that the inverted triangle devices that were common to the subject mark and to the cited marks was not prominent enough compared with the prominence of the elements inside the respective triangles. Those elements were dissimilar and in the overall assessment the Office concluded that the marks were dissimilar.

In the following case involving two mixed (composite) signs, only the word element “flexi” is common to both signs; the other elements differ significantly. However, the common word element “flexi” is descriptive with respect to the specified ‘*credit card services*’ and ‘*financial services*’, and could not be claimed in exclusivity by either party. These marks do not

¹⁸ Source: IPOS. See: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/guess-v-jen-chi-2019-sqipos-3.pdf>

present a likelihood of confusion and may therefore be registered and coexist in the marketplace.¹⁹



(Class 9: Credit cards)

The following is an example of mixed signs that contain shared elements that are *generic* or commonplace, but which give a different overall impression and would not cause a likelihood of confusion. These marks may therefore coexist as marks for 'pasta and noodles':



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

The following is an example of word marks that include common words that are *descriptive*: the words 'protection screen' and 'protective screen' as parts of marks applied to that type of goods merely describe the products and may be used freely for those goods. These marks may therefore coexist on the market.

¹⁹ Example provided by the EUIPO.

Nivea protection screen
vs.
Coral protective screen

Likewise, in the following word marks used for ‘beauty treatment products’, the only common element is the suffix “LUX” which is commonplace in the cosmetics industry to allude to “luxury” or to “light”. These marks do not present a likelihood of confusion and may therefore coexist on the market.

MORELUX vs. **INLUX**

Similarly, the following word marks may coexist for film—related products and services. They contain the common generic element “MOVIE”, that refers generally to the film industry and may not be claimed in exclusivity for that use:

MOVIE FAN vs. **MOVIEPLEX**

Similarly, the following marks used for ‘building materials’ and ‘construction services’ share the prefix element “BUILD”, which is commonplace in the building industry. The remaining elements “GRO” and “FLUX” are dissimilar. In the overall assessment there would be no likelihood of confusion between these marks:

BUILDGRO vs. **BUILDFLUX**

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 or likelihood of confusion.



VS.



[Images, 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. 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.”²⁰

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. 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.

²⁰ Decision of 29 September 1998, case C-39/97, ‘Canon’, paragraphs 18 and 24.

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 to establish whether the goods and services in respect of which the conflicting marks will be used are identical or just similar.²¹

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 registration 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. Protection of a mark is, in principle, coterminous with the specification of goods and services. However, in practice protection may be broader where necessary, in particular when the earlier mark is **well-known** or enjoys a **reputation** that warrants an extended scope of protection (see item 3, below).

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 a 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.

²¹ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 2.

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.

In the following case from the Philippines IP authority, two otherwise similar marks were allowed to coexist in view of the limited, non—conflicting scope of the specifications of goods, which were included in the same NCL class (class 12):

D-TRACKER

Subject mark

Class 12: Apparatus for locomotion by air or water, motors and engines for land vehicles, couplings and transmission components for land vehicles, unloading tippers for tilting railway freight cars, pusher cars for mining, puller cars for mining, traction engine, ropeways for cargo or freight handling, non-electric prime movers for land vehicles [not including their parts], internal combustion engines [for land vehicles], jet engines [for land vehicles], turbines [for land vehicles], machine elements for land vehicles, shafts, axles or spindles [for land vehicles], bearings [for land vehicles], shaft couplings or connectors [for land vehicles], power transmissions and gearing for [for land vehicles], shock absorbers [for land vehicles], springs [for land vehicles], brakes [for land vehicles], parachutes, anti-theft alarms for vehicles, wheelchairs, AC motors or DC motors for land vehicles [not including their parts], vessels, personal water crafts, small water crafts, ship, boats, vehicles for use on water, aircraft, railway rolling stock, two-wheeled motor vehicles, bicycles and their parts and fittings, motorcycles, scooters [vehicles], mopeds, two-wheeled vehicles, handle bars for two-wheeled vehicles, handle pads for two-wheeled vehicles, front forks for two-wheeled vehicles, wheel rims for two-wheeled vehicles, wheel hubs for two-wheeled vehicles, spokes for two-wheeled vehicles, tires for two-wheeled vehicles, frames for two-wheeled vehicles, saddle for two-wheeled vehicles, stands for two-wheeled vehicles, drive chains for two-wheeled vehicles, drive belts for two-wheeled vehicles, fairings for two-wheeled vehicles, mudguards for two-wheeled vehicles, side covers for two-wheeled vehicles, tail covers for two-wheeled vehicles, pedals for

TRACKER

Cited mark

Class 12: Motor land vehicles, **namely**, automobiles, sport utility vehicles, trucks and vans.

two-wheeled vehicles, brake pads for two-wheeled vehicles, luggage racks for two-wheeled vehicles, warning horns for two-wheeled vehicles, steering damper for two-wheeled vehicles, engines for land vehicles, rickshaws, sleighs and sleds [vehicles], wheelbarrows, carts, horse drawn carriages, bicycle trailers, adhesive rubber patches for repairing tubes or tires, baby carriages.

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 or a third-party objection 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.²² The purpose of the NCL is primarily administrative, for use in structuring trademark databases and schedules of fees for the registration and renewal of trademarks, in particular.

The scope and structure of each of the classes under the NCL is different because they have been defined using different technical criteria. Although the individual classes of goods and services will generally indicate that the goods and services covered under them are similar or related as regards their nature, purpose or use, manner of distribution or material and ingredients, the NCL classes will not automatically determine the similarity or dissimilarity of the goods and services for the purposes of establishing a likelihood of confusion between two marks.

²² The International Classification of Goods and Services for the Purposes of the Registration of Marks, a.k.a. the Nice Classification (NCL), was established in 1957. The latest version of the 11th edition of the NCL came into force on January 1, 2019.

In this connection, 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.”

Along the same lines, the Nice Agreement itself provides the following:

*Article 2
Legal Effect and Use of the Classification*

[...]

(4) The fact that a term is included in the alphabetical list in no way affects any rights which might subsist in such a term.

Although the classification of goods and services in accordance with the NCL should not 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.

For example, in the following case the IP authorities of the Philippines decided that two otherwise similar marks could coexist considering the different non-competing nature of the goods specified for each of them, regardless of the fact that all the goods fell under the same NCL class (class 9):



SYNERGY

Subject Mark

Cited Mark

Class 9 - Telephone wires, soldering iron, electrical plugs, socket plugs, cable connectors, coaxial cable, computer cable, electrical cords, adapter plugs, door bells, outlets, switches, utility box, junction box, extension cords, electronic accessories, video cables, audio cables.

Class 9 - Optical glasses, sunglasses, and parts and fittings therefor.

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.²³

- nature of the goods and services,
- intended purpose and method of use,

²³ In this regard see the EUIPO Guidelines, Part C, Section 2, Chapter 2, item 3.2.

- 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 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:

- ‘toothpaste’ and ‘toothbrushes’,
- ‘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 standard or common containers used to transport or dispense the goods, for example products in liquid, powder or loose form, are not to be regarded as complementary products for this purpose.

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 or surrogates 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 effectively 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 that goods or services could have a common origin 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 '*orthopaedic 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.²⁴

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.

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.

²⁴ In this regard see, for example, the EUIPO Guidelines, Part C, Section 2, Chapter 3.

- 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*²⁵

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 a component used to manufacture other products, and will not normally be sold directly to end-users. Similarly, the profile of customers that buy building materials is different to that of buyers of finished 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.

²⁵ In this connection, see the EUIPO Guidelines, Part C, Section 2, Chapter 3, item 1.

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.²⁶

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

²⁶ See the EUIPO Guidelines, Part C, Section 2, Chapter 3, item 3.

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

Other factors that are relevant to decide on the likelihood of confusion in a particular case include the following:²⁷

- 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 Marks²⁸

- ❖ 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

²⁷ In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 6.

²⁸ See the provisions in BN TMA s. 42(1)(c) and (2), TMR r. 17; MY TMA s. 24; SG TMA s. 17, TM Manual chapter 7 'Relative Grounds for Refusal of Registration' p. 39 (*this only relates to families of marks*); and VN IPL art. 4.19 and Circular 01/2007 s. 37.4.b. ("association marks")

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’.²⁹

- ❖ 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 the

²⁹ See for instance the provisions in Viet Nam IPL art. 4.19 and Circular 01/2007 s. 37.4.b.

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.³⁰

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.

³⁰ See <http://www.bayer.com/en/products-from-a-to-z.aspx>.

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 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.³¹

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,

³¹ See the provisions in BN TMA, s. 10; MY TMA s. 20; SG TMA s. 9.

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.

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**.³²

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.

³² In this connection see the EUIPO Guidelines, Part C, Section 2, Chapter 7.

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. As discussed above, those factors include:

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

It is recalled that the global analysis approach does not exclude a step-by-step analysis of each of those factors. Under a global assessment approach, a later mark should not be refused registration only because it is factually similar to an earlier sign, or only because the relevant goods or services are identical or similar. Rather, the ground for refusal should be that, if the later, contested mark were to be used in trade 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 bearing that mark. The registration should therefore be refused to prevent a situation that would make it likely that confusion would occur 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.*³³

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.

³³ 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. That protection is regarded as a minimum. National laws may and often do protect well-known signs above that minimum level. While no express reference is made to other sorts of well-known signs, such as trade names or geographical indications, the same principles can apply to the latter.

The international minimum protection refers to both unauthorised use and unauthorised *registration* of a well-known mark. The relevant provisions of the **Paris Convention** read as the follows:

Article 6bis

(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 provisions of the **TRIPS Agreement** that supplement Article 6ter of the Paris Convention are the following:

*Article 16
Rights Conferred*

1. [...]

2. *Article 6bis 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 6bis 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 Member States and are reflected in their trademark laws and administrative provisions.³⁴

³⁴ 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. 21(1).b) and c), 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)

3.2 Obligation to Refuse Registration of a Conflicting Mark

The implementation of the international provisions quoted above requires the examiner to refuse an unauthorized application to register a mark that contains, or is confusingly similar to, a mark or other sign that is well-known in the country to 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:

- (i) the conflicting mark contains, or is confusingly similar to, the well-known sign;
- (ii) the essential part of the conflicting mark constitutes a reproduction of the well-known sign; or
- (iii) the conflicting mark constitutes an imitation liable to create confusion with the well-known sign;

and

- (a) the conflicting mark is to be used on, or in connection with 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 sign is registered or used, 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 sign, and provided that the interests of the owner of the registered well-known sign are likely to be *damaged* by such use.

and 14(2), 70B, TMR r. 13A and 13B; MM TML s. 2.p), 14.f); PH IP Code s. 123.1.e and f, Rules r. 102.e) and f), TM Guidelines chapter XI, p. 119 to 121; SG TMA s. 2(1) – ‘well-known trade mark’, 8(4), (5) and (6), TM Manual chapter 7 ‘Relative Grounds for Refusal of Registration’ p. 13 and 37; TH TMA s.8(10); and VN IPL art. 4.20, 74.2.i) and 75, Decree 103/2006 art. 6.2, Circular 01/2007 s. 42.

A substantial part of the examination to refuse a registration on the basis of a prior well-known sign 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 sign that refers to 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 *sign 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 sign, and
- the extent to which such connection would *damage the interests* of the owner of the well-known sign.

The *connection* between the use of the conflicting mark on dissimilar goods or services and the owner of the earlier well-known sign will depend, among other factors, on the degree of similarity between the earlier sign and the conflicting mark, the similarity between the relevant goods or services, the distinctiveness of the earlier sign and the strength and scope of the reputation of the earlier sign. 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 or other sign is *well-known*, and the extent to which the interests of the owner of the well-known sign could be *damaged* by a connection with the opposed mark.

3.3 Determining Whether a Mark is Well-known

3.3.1 Relevant facts

An opponent that claims extended protection for a sign 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 of public knowledge.

The opponent must prove that may show that his mark is well-known or has an 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 sign is known to the public:³⁵

- the degree of knowledge or recognition of the sign 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 sign in trade, in the country or in other countries;
- the duration, extent and geographical area of any promotion of the well-known sign, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the sign applies;
- the duration and geographical area of any registrations and applications for registration of the well-known sign;
- the record of successful enforcement of rights in the well-known sign, in particular, the extent to which the sign has been recognized as well-known by competent authorities;
- the value associated with the well-known sign.

These factors should not be regarded as cumulative or exclusive conditions to determine whether a sign is well-known. The determination in each case will depend upon the particular circumstances. In some

³⁵ 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 Rules r. 103, 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”); see <https://www.wipo.int/publications/en/details.jsp?id=346> .

cases, all of the factors may be relevant, and a decision may be based on additional factors that are relevant to the case.³⁶

3.3.2 Bad Faith

Bad faith may be a factor to take into account when examining the validity of an application for registration of a mark, to the extent that the law expressly establishes bad faith as a ground for refusal of registration, or where bad faith can be included under the broader grounds of infringement of public order.

In establishing whether a sign is well-known, an opponent may also submit evidence that the application for registration of a mark that is identical or confusingly similar to his 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.³⁷

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):

³⁶ See the WIPO Joint Recommendation, Article 2(1)(c). In this regard, see also the EUIPO Guidelines Part C, Section 5, item 3.1.3 – Assessment of reputation – relevant factors.

³⁷ 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. 21(3); LA Decision 753, art 36, paragraph. 6, item 7; MM TMA s. 14.d); 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

3.3.3 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 sign is well-known as claimed and could suffer prejudice if the opposed mark were used in trade.

The type of evidence that could be submitted by the opponent to prove that his mark is well-known 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.³⁸

However, to determine that a mark or other sign is well-known, the examiner should *not* require or request evidence relating to the following facts:

- that the opponent's well-known sign has been used in the country where protection is sought (the sign's reputation in the country may have been obtained without any actual use therein);
- that the well-known sign has been registered or that an application for registration of the sign has been filed in or for any country;
- that the sign is well-known in another country;
- that the sign is well-known by the public *at large* in the country where protection is sought.³⁹

Those facts go beyond the standard requirements for the purposes of giving legal recognition to a well-known sign, and would not determine the issue of whether a sign 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 the sign is in fact well-known or enjoys a reputation in the country where protection is sought. Registration should, therefore, not be required. A different approach would defeat the purpose of providing protection for well-known marks on the basis of its notoriety. It is also noteworthy in this respect that Article 6*bis* of the Paris Convention does not mention registration of a well-known mark as a condition to enjoy protection under that provision.

³⁸ See the EUIPO Guidelines, Part C, Section 5, item 3.1.4.4.

³⁹ See the WIPO Joint Recommendation, Article 2(3)(a), at <https://www.wipo.int/publications/en/details.jsp?id=346>.

3.4 Determining the ‘Relevant Sector of the Public’

3.4.1 Scope of ‘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.

Relevant sectors of the public include, but are not necessarily 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.⁴⁰

Knowledge of the mark by one of the abovementioned relevant sectors of the public, in the country concerned, will be enough to consider the mark as well-known in that country. 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. Information supplied in this regard by local associations of producers and local chambers of commerce would be highly relevant to identify and define the relevant business circles that deal with the type of goods or services to which the well-known sign refers.

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 sectors of the public in the country is not necessary and should not be required. 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 relatively few famous marks would be able to meet such high standard.

⁴⁰ See the WIPO Joint Recommendation, Article 2(2), at <https://www.wipo.int/publications/en/details.jsp?id=346>.

3.4.2 Looking beyond the specified goods or services

No two signs have an identical reputation, notoriety or goodwill. The degree to which a particular mark is well-known will differ from country to country and may vary over time within the same country. This will depend, in particular, on the advertising and promotion efforts of the holder of the sign.

A well-known sign's goodwill should be preserved from unfair dilution (by blurring or tarnishing) and from unfair free-riding (see item 3.5, below). When a conflict arises between a filed trademark and an earlier well-known sign, the potential damage to the earlier well-known sign must be assessed by the examiner. Protection of a well-known sign should be commensurate with its goodwill, which may not be limited to the goods or services for which the sign is used, or which have been specified on the register (if the sign is registered). The examiner should look beyond the specific goods or services for which the well-known sign is directly used or registered.

An example of this approach can be found in the case between **Y-Teq Auto Parts** and **X1R Global Holding** et al, decided in Malaysia.⁴¹

The following mark was registered by Y-Teq Auto Parts for a variety of specified goods and services, including motorcycle spare parts (NCL 7), audio apparatus; batteries and scientific apparatus (NCL 9); vehicles and parts for vehicles (NCL 12); and advertising, business management and office functions services (NCL 35), and accepted for clothing, footwear and headgear (NCL 25):

⁴¹ Judgement of the Court of Appeal of Malaysia (Appellate Jurisdiction) Civil Appeal No. W-02(IPCV)(A)-511 -03/201 6, between Y-Teq Auto Parts and X1R Global Holding et al., dated 11 January 2017. Originating Summons No. 24IP-40-09/2015. [Information provided by the IP authorities of Malaysia]



Those registrations and acceptance were granted in spite of the prior registration by X1R Global Holding of the following well—known mark:



registered for industrial oils, greases, lubricants, air filters for motorcycle, grease for belts, industrial oils and greases, fuel, fuel oil, lubricants, lubricating grease, lubricating oil, lubricants for engine treatment, motor fuel, motor oil, additives for motor oil, additives for motor fuel, motor lubricants, oil for engine treatment, automatic transmission treatment, manual transmission treatment, petrol system treatment (all in NCL class 4).

X1R Global Holding requested the expungement of the registrations obtained by Y-Teq Auto Parts. The Court of Appeal found the later registration incompatible with the earlier well—known mark, notwithstanding their different specification of goods. The provision protecting well—known marks was not confined to the specified goods if the use of the other mark in relation to different goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark were likely to be damaged by such use.

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*,
- ❖ taking *unfair advantage* from the unauthorised use of the well-known mark, also referred to as *free-riding* or commercial *parasitism*.⁴²

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”

⁴² In this connection, see the EUIPO Guidelines Part C, Section 5, items 3.4.2 and 3.4.3.



[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 questionable 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 consumer association 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 unauthorized use could be an actionable act of unfair competition.⁴³

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

⁴³ See the decision of the Supreme Court of the Philippines on 18 August 2004, in the case of *McDONALD'S CORPORATION et al. vs. L.C. BIG MAK BURGER, INC. et al.* ("Big Mac" case), G.R. No. 143993, at <http://sc.judiciary.gov.ph/jurisprudence/2004/aug2004/143993.htm>.

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.

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. The law may require that the earlier sign must have acquired a certain degree of reputation or that it be recognised by the relevant sector of the public.

Recognition of rights in earlier unregistered marks may be implied in provisions that proscribe registrations applied for '*in bad faith*' (see chapter 10, below), or in provisions relating to the protection of well-known marks. In this context bad faith refers to the knowledge by the applicant of the existence of an earlier unregistered sign 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, and the dishonest attempt to take advantage of that earlier sign.

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.⁴⁴

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

⁴⁴ In this connection see the provisions in BN TMA s. 5(2), 8(4)(a) and 10; KH TML art. 26; ID TML art.21(1).b) and c); 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 TML s. 14.b); SG TMA s. 8(7)(a) and 9, TM Manual chapter 7 'Relative Grounds for Refusal of Registration' p. 13 item (h) and p. 37 item (d); TH TMA s. 46 second paragraph; and VN IPL art. 74.2.g.

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 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:

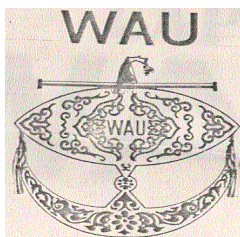
Application N° 90000355

Mark:



Goods: *Edible oil (NCL class 29)*

Earlier registered mark: M/083601



Goods: *Edible oil (NCL class 29)*

[Information provided by the Malaysia IP authorities]

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.

5 Earlier Geographical Indications

Geographical indications are recognised and protected in ASEAN Member States. In most of them geographical indications may be registered as such and exclusive rights to their commercial use may be established.⁴⁵

Where geographical indications (GIs) is 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.

If the law provides that a prior GI is an absolute ground for refusal to register a trademark, this ground should be applied *ex officio* by the trademark examiner. The existence of a prior GI could also be the basis of an *ex officio* objection raised under the prohibition to register signs that would be deceptive with respect to the geographic provenance of the goods.⁴⁶

Unlike trademarks, geographical indications are extremely focused 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

⁴⁵ See the provisions in KH Law on Geographical Indications Art. 31 first and second paragraphs; ID TML art. 21(1).d); LA IPL art. 3.17, 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 TML s. 2.o), 14.c), and 53 to 62; PH IP Code s. 123.1(g) and (j); SG TMA s. 2(1) – ‘geographical indication’, s. 7(7), (8), (9), (10), (10A), (10B) and (10C), Geographical Indications Act 2014 s. 2 – ‘geographical indication’ and s. 4(2) and (4); TH TMA s. 8(12); and VN IPL art. 4.22 and 74.2. L, m), Circular 01/2007 s, 39.12.a) ii).

⁴⁶ On this topic see the EUIPO Guidelines, Part B, Section 4, Chapter 10.

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 signs, 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 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. It may also consist of a 'traditional' designation for a particular product known to originate traditionally from a particular geographical region or location. Commercial companies and other business undertakings, by contrast, have unlimited freedom to create or choose the signs that will constitute their trademarks.

Under these circumstances, 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 chooses 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.⁴⁷

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.

⁴⁷ 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, 19 and 23.11, Decision 753, art. 37; MY TMA s. 14(1)(a); MM TML s. 2.q); PH IP Code s.165.2, Rules r. 104; SG TMA s. 8(7)(a) and (b), and 8(8); and VN IPL art. 4.21, 6.3.b) and 74.2.k), Circular 01/2007 s. 1.6, 39.3.h) and 39.12.a) iii).

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.⁴⁸

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.

⁴⁸ 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 TML s. 63; PH IP Code s.165.2, Rules, r. 104; SG TMA s. 8(7)(a) and (b), and 8(8); and VN IPL art. 4.21, 6.3.b) and 74.2.k), Circular 01/2007 s. 1.6, 39.3.h) and 39.12.a) iii).

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.

6.3 Domain Names

A domain name 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”.⁴⁹ 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 a specific object of intellectual property. Registration of a domain name with a competent national internet registration authority does not generate exclusive rights like intellectual property does.

However, it is often the case that domain names are formed by inserting, among their constitutive elements, a trade name or a trademark belonging to the registered user of the domain name. In this case, any unauthorised registration or use of a domain name that contains another person’s

⁴⁹ See <http://www.thefreedictionary.com/domain+name>.

trademark or trade name could be regarded as an infringement of that trademark or trade name.⁵⁰

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 prior 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 prior 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 registered domain name as used by its proprietor in trade.

⁵⁰ This practice, often referred to as ‘cybersquatting’, is the subject of a growing number of dispute settlement proceedings. Many of these are dealt with in the framework of the WIPO Arbitration and Mediation Center applying the internationally—agreed Uniform Dispute Settlement Policy (UDRP). See: <https://www.wipo.int/amc/en/domains/>.

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.⁵¹

7.1 *Industrial Designs*

If the three-dimensional shape of a product or a two-dimensional pattern of a product is registered as an industrial design, or otherwise protected as an unregistered design under the applicable law, that shape or pattern may not be commercially used without authorisation from the design right holder. Consequently, that shape or pattern may not be registered, in particular, as a three-dimensional mark or a two-dimensional figurative mark without due authorisation or consent of the holder of the exclusive right in the design. If the registration of three-dimensional mark or the two-dimensional figurative mark were allowed to proceed in spite of the existence of the prior industrial design, that registration would interfere with the normal exploitation of the exclusive right in the industrial design.

Depending on the scope of the exclusive rights provided under the design law, those rights may extend to any type of products for which a trademark is registered, or could be confined only 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.

⁵¹ 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 TML s. 14.c); PH IP Code s. 4.1.d; SG TMA s. 8(7)(b); TH TMA s. 8(9); and VN IPL art. 74.2.n), Circular 01/2007 s. 39.4.e) and 39.12.a) (v).

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 be, and often are, used as trademarks or as parts of trademarks.

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.⁵²

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 of 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).

⁵² On this topic, see also the EUIPO Guidelines Part B, Section 4, Chapter 3, item 3.

007⁵

[Information provided by the Philippines IP authorities]

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.

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 status 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.⁵³

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.

⁵³ See the provisions in BN TMR, r. 12(1); KH TMA art. 14(e); ID TML art. 21(2).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 TML s. 14.b); PH IP Code s. 123.1(c), Rules r. 102.c), TM Guidelines chapter IX item 6; SG TMR r. 11 and 14, TM Manual chapter 10 'Names and representations of famous people, buildings, etc.'; TH TMA s.7(1), (6) and (7); and VN IPL art. 73.3 Circular 01/2007 s. 39.4.g) and 39.12.a) (iv). On this topic, see also the EUIPO Guidelines Part C, Section 4, item 4.3.1.

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 *fictional*, or is insufficient to identify a particular person, or if the mark represents a character or portrait that is *fictional* 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 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.⁵⁴ 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:⁵⁵

“[...] any [false or misleading] uses of 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 protection

⁵⁴ 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/ found at <https://www.wipo.int/tk/en/igc/>.

⁵⁵ See WIPO document WIPO/GRTFK/IC/40/5, April 9, 2019, Article 5 [Alt. 3 Option 1] 5.3(c), at https://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_40/wipo_grtkf_ic_40_5.pdf.

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 protection can also be implemented as a relative ground for refusal to the extent that controlling such access, use and dissemination is a subjective collective right that can be claimed by particular communities, groups or peoples.⁵⁶

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.⁵⁷

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.

⁵⁶ See the provisions in KH TML art. 4(b); ID TML art. 20.a); LA IPL art. 23.8 and 18, Decision 753 art. 37 and 46; MY TMA s. 14(1)(b); MM TML s. 13.c); PH IP Code s. 123.1.a; SG TMA s. 7(4)(a); TH TMA s. 8(9); and VN IPL art. 73.2.

⁵⁷ See <http://www.theguardian.com/world/2012/mar/01/navajo-nation-sues-urban-outfitters> and <https://www.theguardian.com/us-news/2016/nov/18/urban-outfitters-navajo-nation-settlement>.

10 Applying for Registration in Bad Faith

10.1 Notion of ‘bad faith’

Several ASEAN Member States 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.⁵⁸

‘Bad faith’ is not defined as such in any of the IP laws of the ASEAN Member States, but it may be defined in other laws or jurisprudence in those countries. Bad faith has been described as ‘*conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices*’.⁵⁹ Bad faith has also been characterized as intentional dishonesty by action or omission that knowingly infringes the law or honest practices.⁶⁰

In this respect, ‘bad faith’ may be understood as the situation where an applicant knows that the mark that is submitted for registration in his name already belongs to another person who has a better 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.

⁵⁸ 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. 21(3) and Elucidation of art. 21(3); LA Decision 753, art 36, paragraph. 6, item 7; MY TMA s. 25(1), 37(a) and 45(1)(c); MM TML s. 14.d); SG TMA s. 7(6) and 8(5) and (6).

⁵⁹ Opinion of Advocate General Sharpston of 11 June 2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 60, and similarly, 01 April 2009, R 529/2008-4, FS (fig.), § 14). See EUIPO Guidelines, Part D, Section 2, item 3.3.2.

⁶⁰ “Bad faith” has been defined as:

1) n. intentional dishonest act by not fulfilling legal or contractual obligations, misleading another, entering into an agreement without the intention or means to fulfill it, or violating basic standards of honesty in dealing with others. [...]

See: <https://dictionary.law.com/Default.aspx?selected=2>.

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.

10.2 Factors that evidence bad faith

Where the law provides that applying for registration of a mark in bad faith is an *absolute* ground for refusal of registration, such registration should be refused to the extent that bad faith by the applicant is evidenced or duly proven.

Bad faith may be evidenced by any valid means of proof. The examiner will have to take into account at least three basic concurring *factors* that will point to bad faith in an application or an opposing registration. Those factors include the following, and define the essence of bad faith in this respect:⁶¹

1. Identity or high similarity of the signs;
2. Knowledge of the earlier mark by the applicant or registrant;
3. Dishonest intention in applying for registration or filing an opposition.

1. Identity or confusing similarity of the signs

For a finding of bad faith, it is necessary that the mark that is filed for registration and the mark that is cited against it, or that is the basis of an opposition, be *identical* or quasi—identical. Although this sole factor is not

⁶¹ In this connection see, for example, the EUIPO Guidelines, Part D, Section 2, item 3.3.2.1.

dispositive and good faith coincidences may occur, depending on the distinctiveness of the sign in question and the circumstances of the case, the identity (or almost identity) of the signs would be a *prima facie* indication that one of the parties had access to — and is attempting to encroach on — the other party's sign. Such identity or quasi-identity of the signs is unlikely to be a fortuitous or accidental coincidence.

Conversely, if the signs in question are clearly dissimilar or are not confusingly similar, this fact could not support a finding of bad faith.

2. Knowledge of the earlier mark by the applicant or registrant

The applicant or opposer must know or have known about the existence or prior use of the identical or confusingly similar sign by the other party for identical or similar products or services.

A typical case of prior knowledge of the existence of a mark is where the parties involved had some sort of earlier commercial or business connection. For example, where one party was formerly a distributor, dealer or commercial representative for the other. In this case, that party could not ignore or be 'unaware' of the existence and activity of the genuine, earlier holder of the mark, and that such activity predated the bad—faith party's application or use of the mark.

A presumption of knowledge ('must have known' or 'could not have been unaware') could also be predicated on the parties' involvement in the business circles of the trade to which the goods or services belong, or on the basis of the length of time during which the earlier (legitimate) user had used the sign. The longer the time of use, the likelier it is that such use was known in the relevant market. Prior use of the mark in foreign markets, in electronic commerce or on the internet would also be relevant to demonstrate an earlier genuine use of the mark.

The mere knowledge that another party is using a particular mark would not automatically establish bad faith. A person may by using in good faith a mark that is similar to a competitor's sign, and this may be undertaken in pursuit of legitimate objectives. However, this should normally not be assumed where the marks are identical or materially identical.

Moreover, the examiner should be aware of cases where the prior relationship between the parties is supported by contractual agreements

which may be totally or partially in force, or breached but under litigation. This would make the case more complex and prevent a straightforward conclusion about bad faith by either party.

The following case, decided by the IP authorities of Singapore (IPOS), illustrates the invalidation of two trademark registrations obtained in bad faith. In its decision of 19 November, 2018, the IPOS declared invalid the following trademark registrations.⁶²



40201606062U



40201606064Y

For *food products* in NCL classes 29 and 30

The IPOS found that the holder of the registrations had a prior work and business relationship with his foreign supplier, whose marks he registered in bad faith, and had misrepresented relevant facts in this connection. The registrant had taken undue advantage of that relationship to obtain the trademark registrations without authorization.

3. Dishonest intention in applying for registration or filing an opposition

The intention behind an applicant or an opposing party is subjective and can only be ascertained by reference to objective facts and circumstances. The following facts and circumstances may be considered, for example:

- Bad faith may be presumed if a registration is filed or obtained without any *bona fide* intention to use the mark in trade. If the mark is filed or registered only with a view to subsequently transferring its ownership for speculative gain or financial compensation, that could be regarded

⁶² Source: IPOS: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/mahendra-naidu-v-navin-trading-2019-sqipos-2.pdf>.

as a bad faith operation if it cannot be justified by any legitimate motive that is consistent with the purpose of trademark law.

- Bad faith may be presumed if the mark that is filed or registered is a well-known mark or a sign enjoying reputation among the trade circles or the relevant sector of consumers in the country, and which belongs to a different, unrelated person operating in the same or in another country. This would indicate an unfair attempt to take advantage of the legitimate owner's reputation ('free-riding' or 'parasitic competition').

10.3 Effect of bad faith on a trademark application

Where, in opposition proceedings, the evidence submitted demonstrates that the application was filed in bad faith, this fact should be considered by the examiner to deciding on the total or partial refusal of registration of the mark. Conversely, if the proceedings demonstrate that the earlier mark was filed or registered in bad faith, the opposition should be refused in whole or in part. Where the law so allows, the earlier bad faith application should be refused, and the earlier registration cancelled to the extent it is tainted by bad faith.

The effect of bad faith (or the absence of good faith) on the registration of a mark may be illustrated by the case of *Birkenstock Orthopaedie GMBH and Co. KG (formerly Birkenstock Orthopaedie GMBH vs. Philippine Shoe Expo Marketing Corporation)*⁶³ decided by the Supreme Court of the Philippines in 2013.

The court decided, among other points, that the registrant of the mark was in bad faith in having it registered in its name since another entity is the true and lawful owner thereof. Citing the decision of the IPOPHL Director General⁶⁴, the court held that BIRKENSTOCK, obviously of German origin, is a highly distinct and arbitrary mark. It is very remote that two persons did coin the same or identical marks. To come up with a highly distinct and uncommon mark previously appropriated by another, for use

⁶³ G.R. No. 194307, November 20, 2013.

⁶⁴ Promulgated on 22 December 2009, on the appeal from the Decision of the Bureau of Legal Affairs dated 28 May 2008 in the consolidated *Inter Partes* Case Nos. 14-2007-00108, 14-2007-00115, and 14-2007-00116.

in the same line of business, and without any plausible explanation, is incredible.

The marks are reproduced below for comparison:

Registrant's mark



True and Lawful Owner's Marks

Birkenstock



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ANNEX I

**EXCERPTS OF LEGAL PROVISIONS OF
THE ASEAN COUNTRIES RELEVANT TO THE
SUBSTANTIVE EXAMINATION OF MARKS**

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BRUNEI DARUSSALAM

Trade Marks Act (Cap.98) 2000

Trade Marks (Amendment) Rules 2017

4. (1) In this Act, “trade mark” means any perceptible sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.¹

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark and a certification mark.

Registered trade marks

5. [...]

(2) No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act affects any law relating to passing off.

Absolute grounds for refusal of registration

6. (1) The following shall not be registered —

- (a) signs which do not satisfy the requirements of subsection (1) of section 4;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of

¹ As amended by the Trade Marks Act (Amendment) Order, 2017.

goods or of rendering of services, or other characteristics of goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of —

(a) the shape which results from the nature of the goods themselves;

(b) the shape of goods which is necessary to obtain a technical result;
or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is —

(a) contrary to public policy or to accepted principles of morality; or

(b) of such a nature as to deceive the public.

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in Brunei Darussalam by any law.

(5) A trade mark shall not be registered in the cases specified or referred to in section 7.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Specially protected emblems etc.

7. (1) A trade mark which consists of or contains —

- (a) a representation of the Emblem, Arms and Regalia of Brunei Darussalam, including the Royal Arms, State Crest, the Insignia of Royalty, armorial bearings and other insignia and emblems of Brunei Darussalam; or any device so closely resembling any of them as to be likely to be mistaken for them;
- (b) a representation of the Royal crowns, and His Majesty the Sultan and Yang Di-Pertuan's Standard or any other Royal flag, or any colourable imitation thereof;
- (c) a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colourable imitation thereof;
- (d) any word, letter or device likely to lead persons to believe that the applicant either has or recently has had Royal patronage or authorisation; or
- (e) any name or thing which is a specified name or specified emblem as defined in section 2 of the Emblems and Names (Prevention of Improper Use) Act (Chapter 94), or any colourable imitation thereof,

shall not be registered, unless it appears to the Registrar that consent has been given by or on behalf of His Majesty the Sultan and Yang Di-Pertuan or, as the case may be, that member of the Royal family.

(2) A trade mark which consists of or contains a representation of the national flag of Brunei Darussalam shall not be registered if it appears to the Registrar that the use of that trade mark would be misleading or grossly offensive.

(3) A trade mark shall not be registered in the cases specified in section 55 or 56.

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains

- (a) arms which a person is authorised to use by virtue of a grant of arms by His Majesty the Sultan and Yang Di-Pertuan; or
- (b) insignia so closely resembling such arms as to be likely to be mistaken for them,

unless it appears to the Registrar that consent has been given by or on behalf of that person. Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to any law relating to arms.

Relative grounds for refusal of registration

8. (1) A trade mark shall not be registered if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

- (a) it is identical with an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected; or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which —

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Brunei Darussalam and the use of the later mark without

due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Brunei Darussalam is liable to be prevented —

(a) by virtue of any law protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right, other than those referred to in subsections (1), (2) and (3) or in paragraph (a), or by any law relating to the infringement of copyright or registered designs.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Meaning of “earlier trade mark”

9. (1) In this Act, “earlier trade mark” means —

(a) a registered trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) of subsection (1), subject to its being so registered.

(3) A trade mark within paragraph (a) of subsection (1) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no *bona fide* use of the mark during the 2 years immediately preceding the expiry.

Raising of relative grounds in case of honest concurrent use

10. (1) This section applies where, on an application for the registration of a trade mark, it appears to the Registrar —

(a) that there is an earlier trade mark in relation to which the conditions set out in subsection (1), (2) or (3) of section 8 apply; or

(b) that there is an earlier right in relation to which the condition set out in subsection (4) of section 8 is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purpose of this section, “honest concurrent use” means such use in Brunei Darussalam, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purpose of section 33 of the repealed Act.

(4) Nothing in this section affects —

(a) the refusal of registration on the grounds mentioned in section 6;
or

(b) the making of an application for a declaration of invalidity under subsection (2) of section 48.

(5) This section does not apply when there is an order in force under section 11.

Registration subject to disclaimer or limitation

15. (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

and where the registration of a trade mark is subject to such a disclaimer or limitation, the rights conferred by section 12 are restricted accordingly.

- (2) Provision shall be made by rules as to the publication and entry in the register of such a disclaimer or limitation.

Registration: supplementary provisions

42. (1) Provision may be made by rules as to —
[...]

- (c) the registration of a series of trade marks.

- (2) In paragraph (c) of subsection (1), a series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.
[...]

Collective marks

50. A collective mark is a mark distinguishing the goods or services of members of an association which is the proprietor of that mark from those of other undertakings.

Application of Act to collective marks

51. This Act applies to collective marks, subject to the First Schedule.

Certification marks

52. A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of that mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

Application of Act to certification marks

53. This Act applies to certification marks, subject to the Second Schedule.

Protection of well-known trade marks

54. (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, including such a trade mark entitled to the benefits of the Paris Convention by virtue of the World Trade Organisation Agreement are to the trade mark of a person who —

(a) is a citizen of, is domiciled, ordinarily resident or has a right of abode in, a Paris Convention country or a World Trade Organisation country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, any such country,

whether or not that person carries on business, or has any goodwill, in Brunei Darussalam. References to the proprietor of such a trade mark shall be construed accordingly.

(2) Subject to section 49, the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction the use in Brunei Darussalam of a trade mark which, or the essential part of which, is identical or similar to his trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

National emblems etc. of Paris Convention and World Trade Organisation countries

55. (1) A trade mark which consists of or contains the flag of a Paris Convention country or a World Trade Organisation country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Paris Convention country or a World Trade Organisation country which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Paris Convention country or a World Trade Organisation country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of that country.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a citizen of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Paris Convention country or a World Trade Organisation country is or would be required for the registration of a trade mark, those

authorities are entitled to restrain by injunction any use of the mark in Brunei Darussalam without their authorisation.

Emblems etc. of certain international organisations

56. (1) This section applies to —

- (a) the armorial bearings, flags and other emblems; and
- (b) the abbreviations and names,

of organisations of which the government or governments of one or more Paris Convention countries or World Trade Organisation countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

- (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use of the mark in Brunei Darussalam which was not authorised by it.

(5) Nothing in this section affects the rights of a person whose *bona fide* use of a trade mark began before the making of this Act.

FIRST SCHEDULE -- COLLECTIVE MARKS

General

1. This Act applies to collective marks, subject to the following provisions.

Signs of which a collective mark may consist

2. In relation to a collective mark, the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a collective mark may be registered which consists of signs or indications which may serve, in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

Mark not to be misleading as to character or significance

4. A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a collective mark. Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

Regulations governing use of collective mark

5. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse. Further requirements with which the regulations have to comply may be imposed by rules.

Approval of regulations etc.

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark –

(a) comply with sub-paragraph (2) of paragraph 5 of this Schedule and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

[...]

SECOND SCHEDULE -- CERTIFICATION MARKS

General

1. This Act applies to certification marks subject to the following provisions.

Signs of which a certification mark may consist

2. In relation to a certification mark the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a certification mark may be registered which consists of signs or indications which may serve in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

Name of proprietor's business

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5. A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a certification mark.

Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate the person authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes. Further requirements with which the regulations have to comply may be imposed by rules.

Approval of regulations etc.

7. (1) A certification mark shall not be registered unless —
- (a) the regulations governing the use of the mark —
 - (i) comply with sub-paragraph (2) of paragraph 6 of this Schedule and any further requirements imposed by rules; and
 - (ii) are not contrary to public policy or to accepted principles of morality; and
 - (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

[...]

Trade Marks Rules 2000

Prohibition on registration of mark consisting of arms

11. Where a representation of any arms or insignia as is referred to in subsection (4) of section 7 appears on a mark, the Registrar shall refuse to accept an application for the registration of the mark unless satisfied that the consent of the person entitled to the arm has been obtained.

Persons living or recently dead

12. (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar, before proceeding to register the mark, may require the applicant to furnish the Registrar with consent of the person or, in the case of a person recently dead, of his legal representatives.

[...]

Series of trade marks

17. (1) The proprietor of a series of trade marks may apply to the Registrar on Form TM 1 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series; and the Registrar shall, if satisfied that the marks constitute a series, accept the application.

[...]

(3) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the Registrar shall delete the mark accordingly.

[...]

Emblems and Names (Prevention of Improper Use) Act (94)

2. In this Act unless the context otherwise requires —

[...]

“specified emblem” means any emblems, seal, flag, pennant, insignia, formation sign, ensign or coat of arms specified in Part I of the Schedule;

“specified name” means any name specified in Part II of the Schedule and includes any abbreviation of any such name.

3. (1) Notwithstanding anything contained in any law for the time being in force, no person shall, except with the written permission of His Majesty the Sultan and Yang Di-Pertuan —

[...]

(c) use or continue to use any specified name or specified emblem, or any colourable imitation thereof, in the title of any patent, or in any trade mark of design;

[...]

4. Notwithstanding anything contained in any law for the time being in force, no competent authority shall —

- (a) register any company, firm or other body or persons under any name; or
- (b) register a trade mark or design which bears any emblem, name, photograph, drawing or other pictorial representation;

[...]

if the use of such name, emblem, photograph, drawing or pictorial representation would be in contravention of section 3.

SCHEDULE

Part I – Emblems

1. The standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri.
2. The State Seal of Brunei Darussalam.
3. The Brunei Coat-of-Arms.
4. The emblem or official seal of the United Nations Organisation.
5. The Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty.
6. The Emblem or official seal of the International Criminal Police Organisation (Interpol).
7. The emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam [...]

Part II – Names

1. The name of His Majesty the Sultan and Yang Di-Pertuan.
2. The name of Her Majesty the Raja Isteri.
3. The name ICPO - Interpol or International Criminal Police Organisation (Interpol).

CAMBODIA

Law concerning Marks, Trade Names and Acts of Unfair Competition, Royal Decree of 7 February 2002 – NS/RKM/0202/006

Article 2

(a) "mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise;

(b) "collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

(c) "trade name" means the name or/and designation identifying and distinguishing an enterprise.

Article 4

A mark cannot be validly registered:

(a) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;

(b) if it is contrary to public order or morality or good custom;

(c) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;

(d) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorized by the competent authority of that State or organization;

- (e) if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well-known in the Kingdom of Cambodia for identical or similar goods or services of another enterprise;
- (f) if it is identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well-known and registered in the Kingdom of Cambodia for goods or services which are not identical or similar to those in respect of which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark that the interests of the owner of the well-known mark are likely to be damaged by such use; or
- (g) if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Article 14

The Ministry of Commerce has the right to order the cancellation to the registered mark where:

[...]

- (e) It is convinced upon evidence that the owner of the registered mark is not the legitimate owner.
- (f) It is convinced that the registered mark is similar or identical to a well-known mark owned by third party.

Article 17

- (a) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.

- (b) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in paragraph (a).

Article 21

- (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.
- (b) Any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

Article 25

An infringement of a registered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used:

- (a) in relation to goods and services identical with or similar to the goods and services for which the well-known mark has been registered, or
- (b) in relation to goods and services which are not identical with or similar to those in respect of which the well-known mark has been registered and the use of the sign in relation to these goods or services would indicate a connection between those goods and services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use.

Article 26

An infringement of an unregistered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that

the sign is used in relation to goods or services identical with or similar to the goods or services for which the mark is well-known.

Law on Geographical Indication, 20 January 2014

Article 23: Protection of Cambodian and Foreign Geographical Indication

The Cambodian and foreign geographical indications registered in the Kingdom of Cambodia shall be protected against any:

- a. direct or indirect commercial misuse of a registered geographical indication in respect of identical or comparable goods to those of the registered geographical indication where the misuse benefited or would benefit from the reputation of the geographical indication;
- b. unauthorized use, imitation, evocation or translation of the geographical indication even if the true origin of the goods is accompanied by the expression such as “style”, “type”, “method”, “manner”, “imitation”, or translations of such expressions, or of similar expressions likely to mislead the public;
- c. false or misleading indication as to origin, nature, or specific quality of the goods appearing on packaging, or in advertising materials or on other documents concerning the goods that are likely to mislead its origin;
- d. other practices likely to mislead the public as to the true origin of the goods.

Article 31: Geographical Indication and Mark

The Ministry of Commerce shall refuse any application for registration of a mark which is identical with or confusingly similar to a geographical indication which applied before the filing date of application for mark registration as defined in the Article 23 of this law.

Where a geographical indication is definitely registered in accordance with this law, the application for registration of a mark corresponding to one of

the situations defined in Article 23 and relating to the same type of goods shall be refused.

The Ministry of Commerce shall refuse any application for renewal of a mark if it contradicts the provision under Article 23 of this law. The decision of refusal shall be initially taken by the Ministry of Commerce or at the request of any interested person.

The use of a mark corresponding to one of the situations defined in Article 23, and which has been registered, in good faith, before either the date of protection of the geographical indication or the filing date of the application for geographical indication registration in the Kingdom of Cambodia, the mark may continue to be used if there are no grounds for invalidation.

Sub-Decree No. 64 of July 12, 2006, on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition

Article 12: Transliteration and Translation of the Mark

Upon the Registrar's requirement, where a mark consists of a word or words in characters other than Khmer or Roman, filling in application form, and the additional reproductions of the mark shall be accompanied by a sufficient word by word written scripts, transliteration and translation of such words, stating the language to which each word belongs.

Article 23: Collective Mark

Articles 9 to 22 of this Sub-Decree shall apply, mutatis mutandis, to collective mark subject to the following conditions:

1. The acceptance of an application for registration of a collective mark shall be made, unless in the application for registration, the mark has been designated as a collective mark, and unless the application is accompanied by a copy of the regulation governing the use of the mark, duly certified by the applicant. The certification made by the applicant shall not require any legalization;

2. The regulation governing the use of the collective mark shall define the common characteristics or quality of goods or services which the collective mark shall be designated and the conditions under which the persons using that collective mark shall follow. The regulation shall provide for the exercise of effective control on the use of collective mark in compliance with the provisions of that regulation and shall determine adequate sanctions for any use contrary to the said regulation;
3. A copy of the regulation governing the use of collective mark shall be appended to the registration of a collective mark;
4. Publication of the registration of a collective mark, in accordance with Article 19(1) of this Sub-Decree, shall include a summary of the regulation appended to the registration;
5. Every notification of changes effected in the regulation governing the use of the mark shall be made in writing;
6. All notifications of such changes shall be recorded in the Register. Changes in the regulations governing the use of collective mark shall have no effect until such recording has been made. A summary record of changes shall be publicly published;
7. For the purposes of use of the collective mark in connection with Articles 15 and 16 of the law, the registered owner of a collective mark may use the mark himself/herself providing that it is also used by other authorized persons in accordance with the regulation governing such use. Use by such persons shall be deemed as using by the registered owner.

TRADEMARK MANUAL – Intellectual Property Department – July 2013

Available from the IP authorities of Cambodia.

INDONESIA

Law No. 20 of 2016 on Marks and Geographical Indications

CHAPTER I

GENERAL PROVISIONS

Article 1

In this law:

1. Mark means any sign capable of being represented graphically in the form of drawings, logos, names, words, letters, numerals, color arrangements, in 2 (two) and/or 3 (three) dimensional shape, sounds, holograms, or combination of 2 (two) or more of those elements to distinguish goods and/or services produced by a person or legal entity in trading goods and/or services.
2. Trademark means any mark used for goods traded collectively by a person or several persons or a legal entity to distinguish other similar goods.
3. Service mark means any mark used for services traded by a person or several persons collectively or legal entity to distinguish other similar services.
4. Collective mark means any mark used for goods and/or services entailing similar characteristics concerning nature, general characteristic, quality of goods or services as well as supervision that will be traded by several persons or entities to distinguish with other similar goods and/or services.
5. Right on mark means the exclusive right granted by the State to a registered mark owner for a definite period to use his/her mark or authorize others to do otherwise.

[...]

CHAPTER II

SCOPE OF MARKS

Article 2

[...]

(3) Protected marks consist of signs in the form of drawings, logos, names, words, numerals, color arrangement, in 2 (two) and/or 3 (three) dimensional shape, sounds, holograms, or combination of 2 (two) or more of those elements to distinguish goods and/or services produced by a person or legal entity in trading of goods and/or services.

CHAPTER III

APPLICATION FOR REGISTRATION OF MARK

Part One

Requirements of and Procedures for Application

Article 4

[...]

(2) The application as referred to in section (1) must contain:

[...]

d. color(s) if the mark being applied for registration uses color elements;

[...]

f. class of goods and/or services as well as description of types of goods and/or services.

[...]

(4) The application as referred to in section (1) is supplemented by mark representation and receipt of payment of prescribed fee.

[...]

(6) In the event that the mark as referred to in section (4) is in 3 (three) dimensional shape, its mark representation is supplemented in the form of characteristics of that mark.

(7) In the event that the mark as referred to in section (4) is in the form of sounds, its mark representation is supplemented in musical notes and sound recording.

[...]

CHAPTER IV

MARK REGISTRATION

Part One

Non-Registrable and Refused Trademark

Article 20

A mark cannot be registered if it:

- a. Is in contradiction to the State ideology, laws and regulations, morality, religion, decency or public order;
- b. Is similar to, related to, or merely mention the goods and/or services being applied for registration;
- c. contains any elements which may mislead the public in respect to its origin, quality, type, size, variety, intended use of goods and/or services being applied for registration or constitute a name of a protected plant variety for similar goods and/or services;
- d. contains a description that does not correspond to the quality, or efficacy of produced goods and/or services;
- e. is devoid any distinctive character; and/or
- f. constitutes a generic name and/or a public sign.

Article 21

- (1) An application shall be refused if the trademark is substantively similar to or identical with:
 - a. a prior registered trademark of other parties or an earlier trademark application in respect of similar goods and/or services;
 - b. a well-known mark of other parties for similar goods and/or services;
 - c. a well-known mark of other parties for different goods and/or services complying with certain requirements; or
 - d. a registered geographical indication.

- (2) An application is refused if the mark:
 - a. constitutes or is similar to the name or initial of a well-known individual, photograph, or name of legal entity owned by another person, unless under a written consent from its proprietor;
 - b. constitute as duplication or similar to name or initial, flag, symbol or State emblem, or both national and international agency, unless under a written consent from the authorities; or
 - c. constitute a duplication or is similar to official signs or seal or stamp used by a country or Government agency, unless under a written consent from the authorities.

- (3) An application shall be refused if it is submitted in bad faith.
[...]

CHAPTER VI

COLLECTIVE MARK

Article 46

(1) A mark application as collective mark may only be accepted if the application clearly states that the mark will be used as a collective mark.

(2) In addition to the declaration on the use of collective mark as referred to in section (1) the application must be supplemented with a copy of regulations on using the mark as collective mark.

(3) The regulation on using collective mark as referred to in section (2) at least contains provisions on:

a. characteristics, common traits, or quality of goods and/or services to be produced and traded;

b. controlling over the use of collective mark; and

c. sanctions provided for the violation against the regulation on use of collective mark.

[...]

Elucidation of Law Number 20 of 2016 on Marks and Geographical Indications

Article 4

[...]

Section (4)

The term “mark representation” means a sample of mark or label attached on the application for registration of mark.

[...]

Section (6)

The term “characteristics of mark” means drawings/paintings perceptible from front, sides, up and down.

Article 20

Point a

The term “is in contradiction to public order” means noncompliance with the existing rules in the public generally such as offending the public or group of people, courtesy or common ethics of the public, and public or group of people tranquility.

Point b

The mark is related to or only State goods and/or services being applied for registration.

Point c

The term “contains misleading elements” such as mark “No.1 Soy sauce”, “*Kecap No. 1,*” is not registrable because it is misleading the public in relation to the quality of the goods; mark “netto 100 gram” is not registrable because it is misleading in relation to the weight/size of the goods.

Point d

The term “contains description that does not correspond to quality, or efficacy of produced goods and/or services” means mentioning a description which does not correspond to the quality, benefit, efficacy, and/or risks of pertinent product. For example: medicine that can heal all diseases, a cigarette that is safe for health.

Point e

A sign is considered non-distinctive if that sign is too simple such as line or full stop, or even too complicated that it is not clear.

Point f

The term “generic name” such as the mark “diner” for restaurant, mark “coffee shop” for café. Whereas “generic symbol” such as “symbol of skull” for dangerous goods, symbol “poison” for chemical substances, “symbol of spoon and fork” for restaurant services.

Article 21

Section (1)

The term “substantially similar” means similarity which is generated from dominant element between mark that creates impression of similarity, whether in shapes, composition, writing, or combinations of those elements, or similarity in phonetics, in the mark.

[...]

Point b

Refusal of application having substantially similarity or identical to a well-known mark of another party for similar goods and/or services is carried out by considering general public knowledge in respect of the mark in the relevant business sector.

In addition, it is also considered that mark’s reputation is acquired because of strong and massive promotion, investments in several countries worldwide by the owner, and equipped with evidence of mark registration in several countries.

If those are not enough, the Commercial Court may order an independent agency to conduct a survey to conclude whether the mark is or is not well-known to serve as the ground for refusal.

[...]

Section (2)

Point a

The term “name of legal entity” means name of legal entity which is used as mark and registered.

Point b

The term “national agency” includes public organization or social political organization.

[...]

Section (3)

The term “applicant in bad faith” means the applicant who is allegedly having his/her mark registered with intention to forge, imitate, or duplicate mark of another party for the interest of his/her business which has created unfair business competition, deceived, or misled consumers.

For example, mark application in writing, painting, logo, or color arrangement which is similar to the mark of other parties or a publicly well-known mark for years, is duplicated in whatsoever that is substantially similar to the well-known mark. From the above example there has been a bad faith from the applicant for at least it is assumed that there is a deliberate action to duplicate the well-known mark.

[...]

Government Regulation No. 23, 1993, regarding the Procedure of Application for Registration of Mark

Article 2

An application for registration of mark as referred to in Article 1 shall be furnished with:

- a) A written statement that the mark being applied for registration is the property of the applicant; [...]

Article 3

1. The statement as referred to in article 2 letter a) shall clearly state:

- a) that the mark applied for registration is his property,
- b) that the mark applied for registration does not imitate any other's trademark in its entirety or in its essential part; [...]

Ministry of Law & Human Rights Regulation No. 67/2016 regarding Trademark Registration

[...]

Article 2

Scope of this Regulation consists of:

- a. Requirements and Procedures for Applications;
- b. Classification of Goods and Services;
- c. Refusal of the Application;
- d. Correction of a Mistake in Respect of the Registration of Mark Certificate;
- e. Requirements and Procedures for Renewal;
- f. Requirements and Procedures for Change of Name and/or Address;
- g. Requirements and Procedures for Change in Ownership or Transfer of Right;
- h. Collective Trademarks Application and Official Excerpt of the certificate.

Article 14

[...]

- (4) Provisions concerning classification of goods and/or services as referred to in Para (1) is guided to the Nice Classification regarding International Classification of Goods and Services for the Purposes of the Registration of Marks

Part Two

Criteria of Well-Known Marks

Article 18

- (1) Criteria in determining whether a mark is well known as referred to in Article 16 Para (2) letter b) and c), is carried out by considering the public knowledge in respect to the mark in the relevant business sector.

- (2) The public as mentioned in Para (1) is consumer public or public in general that have relation in the production level, promotion, distribution or marketing of the goods or services which is protected by the well-known marks.
- (3) In determining that the mark is well known as referred to in Para (1) is carried out by considering:
 - a. the degree of knowledge or recognition of the mark in the relevant sector of the public as well-known marks;
 - b. the sales volume of the goods and/or services and the size of the profit gained from the use of the marks.
 - c. the market share of the marks related to the distribution of goods and/or services.
 - d. the range area of the using of the marks.
 - e. the time period of the using of the marks.
 - f. intensity and the promotion of the marks, included value of the investment which is used in promoting the marks.
 - g. the registration or application of the marks in other countries.
 - h. the level of success in law enforcement of the marks, especially recognition as well-known marks by the authorities.
 - i. value of the marks which is obtained from the reputation and the guarantee of the quality of goods and/or services from the marks.

Part Three

Refusal Based on Well-known Marks

Article 19

- (1) An application is refused if it has similarity in essential or identical with a well-known mark as referred to in Article 16 Para (2) letter b) and c), is carried out by considering the criteria as referred to in Article 18.
- (2) Refusal to an application based on well-known marks for non-similar goods and services as referred to in Article 16 Para (2) letter c) must comply with certain requirements.

- (3) Certain requirements as referred to in Para (2) c), namely:
- a. any opposition filed by the owner of the well-known marks; and
 - b. the well-known marks must be registered.
- (4) The opposition as referred to in Para (3) letter a) must contain any reasons and accompanied by sufficient evidence that the marks is being applied substantially similar to or identical with the well-known marks for non-similar goods and services, owned by the opponent.

LAO PDR

Law on Intellectual Property (Amended) No. 38/NA, 15 November 2017

Article 3 (revised). Definitions

The terms as used in this law have the following meanings: [...]

9. *Mark* means any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings;
10. *Trademark* means the mark provided for in Item 9 of this Article to use with goods or services as well as to distinguish between these goods or services and other goods or services;
11. *Collective trademark* means the trademark used by affiliated enterprises or members of an association, cooperative, state or private organization or a group of individuals;
12. *Certification mark* means the trademark, which the owner has permitted the use of by individuals, legal entities or organizations for use with their goods or services in order to certify the characteristic, which relates to the origin, raw materials and production methods of the goods or methods of services supply, type, quality, safety or other characteristics of the goods or services;
13. *Well-known mark* means a trademark, which is widely recognized by the relevant sector within the territory of the Lao PDR, including where such knowledge is a result of promotion of the trade mark;
14. *Trade name* means the name of an enterprise used in business to identify the enterprise; [...]
17. *Geographical indication* means a sign used to indicate a good as originating in the territory of a country or region or locality in that territory, where a given quality and reputation or other characteristic of the good is essentially attributable to its geographical origin; [...]

Article 16 (revised). Eligibility Requirements for Trademark Certificate

A mark eligible for trademark certificate shall meet all the following requirements:

1. the mark may be any sign, or any combination of signs, capable of distinguishing the goods or services of individual, legal entity or organization from those of other individuals, legal entities or organizations. Such signs may include words, personal names, letters, numerals, figurative elements, shape, three—dimension picture, motion picture or package of products and combinations of colors as well as any combination of such signs;
2. the mark is not identical to a previously registered mark, well-known mark, or geographical indication for the same goods or services;
3. the mark is not similar to a previously registered mark or well-known mark for the same, similar, or related goods and services, where the use of the later mark would tend to cause confusion as to the source of the goods or services or create a false impression that they are connected or associated with another party;
4. the mark does not contain characteristics prohibited under Article 23 of this law.

Any trademark shall be deemed well-known when it meets all the following requirements:

1. the trademark is a mark, as defined in the above paragraph, which is widely recognized by the relevant sector within the territory of the Lao PDR, as indicating the goods or services of the proprietor of the mark that is claimed to be a well-known mark;
2. the trademark is not contrary to the requirements for registrability in the Lao PDR;
3. In considering whether a mark is a well-known mark, shall have evidence of such facts as are mentioned below:

- 3.1 the relevant sectors of the public recognize the mark by way of trade, use of the trademark on or in connection with goods or services or through advertising;
- 3.2 the products, goods, services are widely circulated bearing the trademark within the territory;
- 3.3 the volume of goods sold or services provided;
- 3.4 regular and continuous period of use of the trademark;
- 3.5 goodwill associated with use of the trademark with the goods or services based on such factors as good quality, service, or their popularity;
- 3.6 domestic consumers certify and widely recognize the reputation of the trademark;
- 3.7 high value of investment in the trademark such as investment in advertisement or creation of image of such trademark.

A well-known trademark whether registered or otherwise shall be protected in accordance with laws.

Article 19. Trade name

A trade name is a name of an enterprise which is used for business operations. The trade name shall be protected without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 23 (revised). Marks Ineligible for Trademark Registration

Marks ineligible for trademark registration shall be as follows:

1. the mark that does not distinguish the goods or services of the applicant from those of another individual, legal entity or organization;

2. the mark that consists exclusively of signs or indications which is served, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or of signs that have become customary in the current language or in the good faith and established practices of the trade in the Lao PDR;
3. the mark that is of such a nature as to deceive or mislead the public or trade circles in which the mark is used or is of a fake or fraudulent nature;
4. the mark that consists of or comprises sign that mislead the public as to the origin, nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods or services;
5. the mark that consists of or contains, without authorization from the relevant governmental entity, armorial bearings, flags, or other national emblems, and official signs, hallmarks, abbreviations or full names of towns, municipalities, provinces or capital of the Lao PDR or foreign countries;
6. the mark that consists of or contains, without authorization from the relevant state or international organization, an emblem of an international organization or symbols created by international conventions, official seals or symbols of state or international organizations;
7. the mark that consists of or contains, without authorization, the name, image, or likeness of a living person;
8. the mark that consists of or contains, without authorization images of cultural symbols or historical monuments, or the name, image, or likeness of a national hero or a leader, or the mark would be offensive or contrary to the fine traditions of the nation;
9. the mark that is identical or similar to trademarks already registered for the same, similar, or related goods or services;
10. the mark that is identical, or similar to a well-known mark for the same, similar or related goods or services;
11. the mark that is identical, or similar to a trade name for a business that provides the same, similar, or related goods and services;
12. the above-mentioned mark that would lead to a likelihood of confusion as to the source of the goods or services or falsely suggest

an association with the registered mark or well-known mark or trade name, as appropriate;

13. the mark that consists of or bears a geographical indication which identifies a place other than the true origin of the products;
14. the mark that consists of or bears a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory;
15. the mark consists of or contains matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or contempt, or disrepute;
16. the mark is of such a nature as to create confusion with the establishment, the goods, or the industrial or commercial activities, of a competitor;
17. the mark is of such a nature that its use in the course of trade would discredit production place of goods, or the industrial or commercial activities, of a competitor;
18. the mark is contrary to national security, social order, culture and the fine traditions of the nation.

The nature of the goods or services is not the case for denying of the registration of the mark.

Article 33 (revised). Application for Registration of Trademark

An application for registration of trademark shall include the following documents:

[...]

3. a clear drawing or other image or specimen of the mark;
 4. description of the goods to which the trademark shall be applied or the services in connection with which it will be used; if the application relates to a collective trademark or certification mark, the application shall so indicate and shall include a description of the way the mark is to be used;
- [...]

One registration application is valid for only one trademark but may apply to more than one class of goods or services as per the international classifications, subject to the payment of a fee for each class of goods or services.

[...]

Article 74 (revised). Variety Denomination

Variety denomination shall be conducted as follows:

1. Each variety shall be designated by a denomination which will be its generic designation. No rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right;

[...]

Decision No. 753 /MOST on the Implementation of Law on Intellectual Property concerning Trademarks and Trade Names, 20 September, 2012

Article 15. Application Requirements

The application shall include [...]

3. If required, a brief description of the mark as described in Article 17 of this Decision. [...]

Article 17. Brief Description of the Mark

Unless the mark is in standard characters, the application shall include a brief description of the mark with the following information:

1. If the mark includes figurative elements, a brief statement describing such elements.
2. Where the mark includes words, letters, numbers, or symbols with a special appearance, a brief statement identifying that appearance.

3. If the mark is in a foreign language or contains foreign characters or words, a statement to that effect and a statement of the meaning of such foreign terms or characters, if any, and a transliteration of words or characters into the Lao language or other rendering from which the pronunciation can be ascertained.
4. If color is a feature of the mark, a statement to that effect and the colors of the mark and portions of the mark associated with each color.
5. If the mark is three-dimensional, a statement to that effect.

No description is required where the mark is limited to words, letters, numbers, or symbols, or a combination thereof, that are presented in standard characters and for which none of the above features is a feature of the mark.

Articles 20. Collective Marks

A collective mark is a mark that is adopted by a collective organization, such as an association, union, cooperative, fraternal organization, chamber of commerce, or other organized collective membership organization, to indicate an affiliation with the collective organization. A collective mark is used by members of the collective organization but is not used by the collective organization itself. A collective mark may be:

1. a collective trademark that is used by members of the collective organization to identify their goods or services and distinguish them from those of non-members of the collective organization.
2. a collective membership mark that is used to indicate membership in the collective organization.

A collective mark is distinguished from a trademark in that the collective organization does not itself sell goods or perform services under a collective trademark, although the collective organization may advertise or otherwise promote the goods produced or sold or services provided by its members under the mark. Since a collective mark is used by many persons, it does not perform the essential function of a trademark, which is to indicate the source of goods and services, that is, which produced or sold the goods or provided the services. Instead, the sole function of a collective mark is to indicate that the person displaying the mark is a

member of the organized collective group. An application to register a collective mark should be reviewed to determine whether it is, in fact, a collective mark or whether it is more properly a trademark or certification mark. [...]

Article 21. Certification Marks

A certification mark is a mark that is adopted for use by a person other than its owner to certify that the user of the mark, or goods or services of the user of the mark, meet the standards or possess the characteristics that are the subject of the certification. A certification mark may be used to indicate, for example, that goods meet certain standards of safety or cleanliness, or that they were produced by persons with certain characteristics or qualifications.

A certification mark is distinguished from a trademark in that the owner of the mark does not itself sell the goods or perform the services to which the certification mark applies. Since a certification mark is used by many persons, it does not indicate the source of goods and services, that is, who produced or sold the goods or services. Instead, the sole function of a certification mark is to indicate that the goods or services in connection with which the mark is used, or the person providing such goods or services, have certain characteristics or have satisfied standards established by another person, that is, the party that provides the certification. [...]

An application to register a certification mark should be reviewed to determine whether it is, in fact, a certification mark or whether it is more properly a trademark or collective mark. [...]

Article 32. Trademark Subject Matter

As provided in Article 16 of the Intellectual Property Law, a trademark may be any sign or combination of signs capable of distinguishing the goods or services of one undertaking from goods or services of another. In particular, in addition to the signs mentioned in Article 16 of the Intellectual Property Law, a trademark may be a word or combination of words including a brief slogan; one or more letters, numbers or symbols

alone or in combination; colors or combinations of colors; figurative elements including pictures or drawings; or a three-dimensional sign; provided that all such signs must satisfy other requirements of the Intellectual Property Law and this Decision. Unless an application claims color as a feature of the mark, or restricts words or symbols to their presentation in a specific form, it will be presumed that such restrictions do not apply to the mark. [...]

Article 34. Identical and Similar Marks

For purposes of Articles 16 and 23 of the Intellectual Property Law, a mark that is the subject of an application shall be considered to be

- 1. Identical** where it cannot be distinguished in its essential aspects from a registered trademark, well-known mark, or trade name.
- 2. Similar** where it resembles a registered trademark, well-known mark, or trade name as described below in such a way as to give the same overall commercial impression.

In determining whether a mark is identical or similar to a registered trademark, well-known mark, or trade name, the Department shall evaluate the marks, or the mark and trade name, with regard to the overall commercial impression of each, taken as a whole, based on the appearance of the mark, and taking into account its pronunciation and its meaning, if any. In conducting this evaluation, the Department may give more weight to prominent features of a mark and less weight to minor features. For purposes of this article, a well-known mark must have been well-known by the relevant sector of the public in the Lao PDR as of the effective filing date of the application.

The similarity or dissimilarity of two marks, or of a mark and trade name, or of a mark and a geographical indication, is determined on the basis of the commercial impression of each in its entirety. The addition or deletion of minor features or of merely descriptive terms normally is not sufficient to change the commercial impression of a mark, nor is the use of color in a mark, where color is not a feature of the mark that is used for comparison.

Even though a mark must be visually perceptible, marks that include words or symbols are likely to be used in situations in which they are **pronounced**, for example, in television advertising or by placing an order. For purposes of Articles 16 and 23 of the Intellectual Property Law, homonymous marks (marks with the same pronunciation) will be considered to be identical or similar. The fact that a mark could be pronounced in some other manner will not be sufficient to avoid a refusal where an ordinary person reading the mark would reasonably expect to pronounce the mark in a way that is identical or similar to the pronunciation of a registered mark, well-known mark, or trade name.

Where a mark includes words or symbols that are equivalent in **meaning** to another mark, the Department may also judge such mark to be similar to another mark or trade name with the same meaning. Where such marks are presented in different languages, the marks will be considered similar or identical if likely purchasers of the goods would be expected to recognize the marks as having the same meaning.

For purposes of this Decision, images and words are considered to be interchangeable when both refer to the same object. Likewise, letters, numbers, and symbols, or combinations thereof, will be treated as interchangeable whether presented in such form or rendered phonetically this Decision.

Article 35. Same, Similar, or Related Goods or Services

For purposes of Articles 16 and 23 of the Intellectual Property Law, goods and services are the same, similar, or related to each other where such goods are of the same type or same general type, or where such goods would commonly be used together, or used for the same purpose, or sold together in the same types of stores.

Article 36. Likelihood of Confusion; Permissible Exceptions

A mark will be refused registration pursuant to Articles 16 and 23 of the Intellectual Property Law where the Department finds that:

1. the mark is of such a nature as to create confusion with the establishment, the goods, or the industrial or commercial activities, of a competitor, or
2. the use of the mark, on or in connection with the goods or services stated in the application would tend to cause confusion as to the source of the goods or services.

Refusal under this paragraph shall be based on a preponderance of the evidence, that is, a mark will be refused registration where the Department finds it more likely than not that such confusion would occur.

In evaluating the likelihood of confusion, the Department shall consider the following factors with regard to the mark that is the subject of the application and a registered mark, well-known mark, or trade name:

1. Their similarity or dissimilarity, taking into account the criteria of Article 34 of this Decision. If the marks are not identical or similar for purposes of Article 34 of this Decision, no further inquiry is needed.
2. The similarity, dissimilarity, or relatedness of the goods or services to which each applies, taking into account the criteria of Article 35 of this Decision. Even where similarity of the marks has been found under the criteria of Article 34 of this Decision, no further inquiry is normally required for purposes of this article if the goods or services are not similar and not related in accordance with Article 35 of this Decision.

In general, there is a greater likelihood of confusion when there is greater similarity between the marks, or between the mark and trade name, and when there is greater similarity between the goods or services of each. However, a greater similarity of one may require less similarity in the other to sustain a finding of likelihood of confusion.

Where the mark that is the subject of the application is identical or essentially identical to a registered mark, well-known mark, or trade name, and the goods and services are the same or essentially the same as those associated with the registered mark, well-known mark, or trade name, a likelihood of confusion shall be presumed and registration shall be refused.

Where the marks, or mark and trade name are found to have some similarity but are not identical or essentially identical, and the goods or services are found to be identical, similar, or related, the Department shall additionally take into account the following **factors**, as such factors are appropriate to the application, to determine whether there exists a likelihood of confusion:

1. Similarity or dissimilarity of the trade channels of the goods or services, including whether such goods are normally sold together or purchased in the same places, or otherwise encountered by the same persons. The use of similar channels of distribution increases the likelihood of confusion with similar or related goods sold under a similar mark.
2. Conditions under which the goods are encountered and the degree of care normally exercised in making a purchase. Less similarity is required to find a likelihood of confusion where it is likely that consumers will exercise a lower degree of care in making a purchase, while a likelihood of confusion may not exist for similar marks and similar goods that require special knowledge to purchase.
3. Fame of the earlier mark as determined by its length of use, advertising and promotion, revenues from sales, large number of different types of goods or services in connection with which the mark is used, or the like. The greater the fame of a mark, the likelier that purchasers will assume a relationship between the same or a similar mark with the more famous mark.
4. Number and nature of similar marks for the same or similar goods or services. Where a large number of unrelated persons use the same or essentially the same mark for the same or closely related goods or services, it indicates that the mark itself is weak, and a likelihood of confusion will exist only when the Department finds that both the mark and goods and services associated with it are identical, or nearly identical, to those of the registered trademark, well-known mark or trade name. This situation most often arises in connection with marks that incorporate descriptive or geographical terms.
5. Nature and extent of any actual confusion. The criterion established by Articles 16 and 23 of the Intellectual Property Law is whether the later mark would tend to cause confusion, not whether such confusion

has actually occurred. However, evidence of actual confusion may suggest a tendency to cause confusion if the number of instances is large relative to the number of opportunities for confusion, while a small number of such instances relative to the number of opportunities may suggest that no such tendency exists.

6. Length of time during and conditions under which the marks have been concurrently used without evidence of actual confusion. Co-existence of the marks or of the mark and trade name, in the same market for a reasonable time period without any known confusion may be evidence that there is no likelihood of confusion.
7. Intent of the later user. Generally, the intent of the applicant is not an element to be considered in evaluating the likelihood of confusion except where there is evidence that the applicant has adopted or is attempting to register a mark in order to create confusion or an association with the registered or well-known mark or trade name. Evidence of such intent can be inferred from facts showing the applicant's knowledge of the earlier mark or trade name, or where the applicant acknowledged an intent to use a similar mark, or advertises or promotes his or her goods or services in a way that strongly shows an intent to mislead consumers, for example, by copying other trade dress of the registered or well-known mark.

Where the Department finds a likelihood of confusion between the mark that is the subject of an application and another mark that is also owned by the applicant, the applicant may avoid a refusal under this article by amending the application and, if the cited mark is the subject of a registration or pending application, the registration or application of the cited mark to indicate that the two marks are commonly owned. Where the Department finds a likelihood of confusion between the mark that is the subject of an application and a trade name or well-known mark that is not the subject of an application or registration, the applicant may avoid such refusal by amending the pending application as stated herein and providing satisfactory evidence that the applicant is the owner of such mark or trade name. In such cases, ownership must be identical for the two applications, or for the application and registration, or for the application and well-known marks, or for the application and the trade name, as appropriate.

A refusal pursuant to this article may be avoided where the applicant submits a verified statement by the owner of an earlier registered mark, or of a mark that was well-known at the time of application, or of an earlier trade name, consenting to such registration concurrently with the earlier rights, together with a statement explaining how the two marks can exist concurrently without creating a likelihood of confusion, and further provided that the Department finds that approval of registration is unlikely to lead to confusion as set forth in paragraph 1 of this article. Such situations may exist, for example, where the goods and services of the parties are sold in different channels of commerce or in different geographical areas in a manner that is unlikely to result in sales or advertising to the same customers.

Article 37. False Impression of Association

The Department shall refuse registration where the mark would tend to create false impression that the goods or services to which an application pertains are connected or associated with the goods or services of a registered or well-known mark or with a trade name. A false impression of connection or association may be created for purposes of Articles 16 and 23 of the Intellectual Property Law where a registered mark with an earlier filing date than the application, or a mark that is well-known in the Lao PDR before the effective filing date of the application, or a trade name that is used or known in the Lao PDR before the effective filing date of the application, meets one or more of the following criteria:

1. The marks are identical or similar and the goods or services identified in the application, **even if not similar or related** to those in connection with which the earlier mark or trade name is used, represent a likely area for **expansion** of the goods or services.
2. The marks are identical or similar and the earlier mark or trade name has such a degree of fame that the relevant sector of the public would be likely to assume a **connection** between the goods or services of the applicant and those of the owner of the earlier mark or trade name.
3. The mark of the applicant appears to be **derived** from a more famous mark or trade name.

The Department shall also refuse registration pursuant to Article 23 of the Intellectual Property Law where a mark consists of or contains material that falsely suggests a connection with persons, living or dead, or with institutions, beliefs, or national symbols. Such connection or association may be created by the use of a person's name or image; by the use of the name or symbol or mark of an institution; by the use of terms or symbols commonly used in reference to beliefs; and by the use of national symbols or of the names therefor.

The Department may find a tendency to create a false impression of connection or association in other circumstances where the evidence suggests that such a false association or connection is more likely than not to be created among the relevant sector of the public.

Article 38. Well-Known Marks

For purposes of Articles 16 and 23 of the Intellectual Property Law, the relevant sector means that part of the public that would be expected to have knowledge of a mark and includes persons who have knowledge of a mark as a result of advertising or marketing. Such persons shall include, but are not necessarily limited to:

1. Actual and/or potential consumers of the type of goods and/or services to which the mark applies;
2. Persons involved in channels of distribution of the type of goods and/or services to which the mark applies; and
3. Business circles dealing with the type of goods and/or services to which the mark applies.

Recognition of a well-known mark in the Lao PDR does not require that the goods or services associated with the mark be sold or distributed in the Lao PDR.

Article 39. Lack of Distinctiveness

A mark shall be refused registration where it is not of such a nature as to distinguish the goods or services of one undertaking from those of another. In particular, a mark that consists entirely of terms that are descriptive of the goods and services, or of the common names for such goods, shall be refused registration.

Article 40. Descriptive or Customary Terms

Where a mark is capable of distinguishing the goods or services of one entity from those of another, but the mark includes terms that are descriptive or customary terms for the goods or services, the Department shall require the applicant to **disclaim** the descriptive or customary terms apart from the mark as shown in the application. A term is considered to be **descriptive** for purposes of this article if it describes the goods or services or some characteristic of the goods or services. Such terms must be disclaimed to preserve the right of other producers or providers to use the same terms in connection with their goods. Examples of descriptive terms include laudatory terms (best, tastiest, quality, and the like); terms that merely describe the location of the applicant; and terms that indicate some quality or characteristic of the goods or services (pain-free, home-cooked, prompt service, and the like). While a descriptive term must be disclaimed, a term that is merely suggestive may function as a mark or may be incorporated in a mark and need not be disclaimed.

Refusal is also appropriate where a mark consists exclusively of signs or indications designating the kind, quality, quantity, intended purpose, value, or place of origin of the goods, their time of production, or signs that have become customary in the current language or in the good faith and established practices of the trade in the Lao PDR.

Where a mark incorporates such terms but does not consist exclusively of them, the Department will require such terms to be disclaimed. If such terms appear on a drawing, the Department will inquire whether they are intended to be part of the mark, and if not, will require the drawing to be amended to delete the terms.

Article 41. Deceptive or Misleading Marks

Registration shall be refused under Article 23 of the Intellectual Property Law where a mark falsely indicates that the goods or services identified in the application have a certain nature, quality, or characteristics, or that they are suitable for a particular purpose or originate from a particular place or are made by a certain process or to certain standards.

Registration shall also be refused under Article 23 of the Intellectual Property Law where the mark as a whole, when used on or in connection with the goods or services identified in the application, would tend to deceive or mislead the public as to the nature, quality, characteristics, or suitability of the goods or services, or their geographic origin. A refusal under this paragraph is appropriate, for example, where the mark incorporates geographical terms that falsely suggest that the goods and services originate in a region from which they do not in fact originate. A refusal under this paragraph may also be appropriate where the mark contains elements that would tend to indicate the suitability of goods or services for a particular purpose or group if goods are not suitable for such purpose or group, for example, by incorporating a picture of a baby on goods not suitable for use with a baby.

The fact that a mark can be understood in a non-deceptive way is not a bar to refusal of registration. Where a mark is susceptible of more than one understanding, the Department should refuse the registration if it would be reasonable for a purchaser to understand the mark in its deceptive or misleading sense.

In case of doubt, or where a mark is susceptible of more than one understanding, the Department shall make an inquiry regarding the nature of the goods and services, their qualities, characteristics, or origin, as appropriate, to determine whether a mark may be descriptive or whether it may be deceptive or misleading.

Article 42. Marks Containing Elements Not Permitted or Authorized

Pursuant to Article 23 of the Intellectual Property Law, the Department will refuse to register a mark that consists of, or contains, any of the following elements:

1. Flag, armorial bearing, or other emblems of a country or intergovernmental organization, official seals or symbols of state or international organizations, or symbols created by international conventions, except where such elements are authorized by the relevant governmental or intergovernmental entity. For purposes of this paragraph, such elements shall be determined as provided in the Paris Convention.
2. Abbreviations or full names of towns, municipalities, provinces or capital of the Lao PDR or foreign countries except as authorized by the relevant governmental entity, unless such abbreviations or names are disclaimed.
3. Official signs and hallmarks indicating control and warranty adopted by them, and any imitation thereof, where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind, except where such elements are authorized by the relevant governmental entity.
4. The name, image, or likeness of a living person without such person's authorization.

Where the applicant claims authorized use, such authorization must be presented in writing.

Authorization is required for purposes of this article unless the applicant is the governmental or intergovernmental authority entitled to give such authorization or, for purposes of subparagraph 4 of paragraph 1 of this article, the person whose name, image, or likeness is used, or a person such as a parent or legal guardian who is authorized to act on such person's behalf.

Article 43. Trade Names

Trade names shall be protected whether or not they are registered.

The same principles shall apply in evaluating whether a trademark application is identical with or similar to a trade name as apply in regard to a registered mark.

A trade name shall be entitled to protection against infringement in accordance with the same principles that apply to trademarks.

Article 44. Marks that Consist of or Incorporate a Geographical Indication

Pursuant to Article 23 of the Intellectual Property Law, the Department shall refuse to register a mark that consists of or incorporates a geographical indication where the goods identified in the application, or any portion of such goods, do not in fact originate in the place associated with the geographical indication, unless the applicant amends the application so as to apply the mark solely to goods that originate in the place associated with the geographical indication.

Pursuant to Article 23 of the Intellectual Property Law, the Department shall also refuse registration of a mark that consists of or incorporates a geographical indication where the use of such geographical indication in connection with the goods identified in the application, or any portion of such goods, may be literally true as to the territory, region or locality in which the goods originate, but nevertheless falsely represent to the public that the goods originate in another territory. Such situation may occur, for example, where the name of the location where the goods actually originate is identical or similar to the name of a territory, region, or locality to which the geographical indication pertains.

The Department will refuse registration in accordance with this article where a mark, or element of a mark, is **homonymous** with a geographical indication.

For purposes of this article, a geographical indication is as defined in paragraph 18 of Article 3 of the Intellectual Property Law.

The Department will apply the provisions of this article to any geographical indication that is registered in the Lao PDR, or that may be entitled to protection in the Lao PDR even if not yet registered in this country. Where such conditions are not satisfied, for example, because a geographical indication is not yet protected in its country of origin, the Department may refuse registration to a mark that consists of or includes such geographical indication pursuant to Article 36 of this Decision if it finds that the use of the geographical indication would tend to deceive or mislead purchasers as to the true origin or characteristics, quality, or reputation of the goods.

Article 45. Marks that Disparage or Discredit Another

The Department shall refuse registration of a mark pursuant to Article 23 of the Intellectual Property Law that consists of or contains elements that may disparage persons, living or dead, or institutions, beliefs, or national symbols.

Such disparagement may be created by the use of a person's name or image; by the use of the name or symbol or mark of an institution; by the use of terms or symbols commonly used in reference to beliefs; and by the use of national symbols or of the names therefor, under circumstances, or in such manner as to ridicule, discredit, show contempt for, or bring into disrepute such person, institution, belief, or symbol.

The standard to be applied in evaluating whether a refusal is appropriate under this article is whether the mark, or element of the mark, as used in connection with the goods or services to which it applies, would be viewed by an ordinary Lao person as disparaging, discrediting, or showing contempt for such persons, beliefs, institutions, or symbols, or bringing them into disrepute.

In particular, the Department may refuse registration under this article when the mark is applied to goods relating to bodily functions, or where the use of the goods in connection with the mark would bring the mark into proximity with intimate parts of the body, or in any other manner where the use of the mark in connection with the goods or services would indicate contempt for the person, institution, belief, or symbol.

Note that a refusal may not be based on the nature of the goods for which a mark is applied. Goods or services relating to bodily functions or to goods the use of which may be objectionable on some ground may still be the subject of an application to register a mark. Such situation should be distinguished from a refusal based on the manner of use of the mark pursuant to paragraph 15 of Article 23 of the Intellectual Property Law. Note that in the general case, there is no objection to registration of a mark based on the nature of the goods or services, except as provided herein where it is the connection between the mark and its use with such goods or services that would disparage persons, institutions, beliefs, or national symbols that would disparage them or bring them into contempt or disrepute.

Article 46. Marks Contrary to Social Order and Fine Traditions of the Nation

In accordance with Article 23 of the Intellectual Property Law, registration may be refused where a mark or its intended use is contrary to **social order** and the fine traditions of the nation. A mark will be considered to be contrary to social order and the fine traditions of the nation where it consists of, comprises, or includes material that is scandalous or obscene or otherwise offensive, where it includes disparaging material, or where publication of the mark would constitute a violation of national law. For purposes of interpreting Article 23 of the Intellectual Property Law, this provision shall be interpreted as being consistent with the terms *ordre public* or **public order** and **morality** as used in international agreements to which the Lao PDR is a party.

TRADEMARKS MANUAL - September 2003

Available from the IP authorities of Lao PDR.

MALAYSIA

Trade Marks Act 1976 - Act No. 175 (amendments up to 1 January 2006)

Section 3. Interpretation

(1) In this Act, unless the context otherwise requires—
[...]

“geographical indication” means an indication which identifies any goods as originating in a country or territory or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;

“in the course of trade”, in relation to the provision of services, means in the course of business;
[...]

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;
[...]

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;
[...]

“specification” means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered;

“trade mark” means, except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the mark whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI; [...]

“word” includes an abbreviation of a word.

(2) In this Act—

- (a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;
- (b) references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods; and
- (c) references to the use of a mark in relation to services shall be construed as references to the use thereof as a statement or as part of a statement about the availability or performance of services.

Section 10. Registrable trade marks

- (1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:
 - (a) the name of an individual, company or firm represented in a special or particular manner;
 - (b) the signature of the applicant for registration or of some predecessor in his business;
 - (c) an invented word or words;
 - (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
 - (e) any other distinctive mark.
- (2) A name, signature or word which is not described in paragraph (1)(a), (b), (c) or (d) is not registrable unless it is by evidence shown to be distinctive.

- (2A) For the purposes of this section, “distinctive”, in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.
- (2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—
- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in the Register in respect of any goods or services.

Section 12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.

- (1) Where an application for registration of a trade mark has been made by a person, and before the date of the application the trade mark had been used by a person other than the applicant under the control of and with the consent and authority of the applicant, and where an application is made by the applicant and that other person for the registration of that other person as a registered user of the trade mark immediately after the registration of the trade mark and the Registrar is satisfied that the other person is entitled to be registered as a registered user of the trade mark, the Registrar may, for the purpose of determining whether the trade mark is distinctive of or capable of distinguishing the goods or services of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant and may make an order that the trade mark is so distinctive or capable of distinguishing.

(2) An order of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Where an order is made under subsection (1), the registration of the trade mark shall cease to have effect if at the expiration of the prescribed period, or such further period not exceeding six months as the Registrar may allow, that other person has not become registered as the registered user of the trade mark.

Section 13. Colour of trade mark

(1) A trade mark may be limited in whole or in part to one or more specified colours and, in any such case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2) Where a trade mark is registered without limitations as to colour, it shall be deemed to be registered for all colours.

Section 14. Prohibition on registration

- (1) A mark or part of a mark shall not be registered as a trade mark—
- (a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;
 - (b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;
 - (c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;
 - (d) if it is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;
 - (e) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for:
Provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or

services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

- (f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or
- (g) if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

(2) Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.

Section 14A. Where registration shall not be refused

(1) A trade mark shall not be refused registration by virtue of paragraphs 14(f) and (g) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either—

- (a) before the commencement of the Geographical Indications Act 2000 [Act 602]; or
- (b) before the geographical indication in question is protected in its country of origin.

(2) A trade mark shall not be refused registration by virtue of paragraphs 14(f) and (g) if the geographical indication in question—

- (a) has ceased to be protected; or
- (b) has fallen into disuse,

in its country of origin.

Section 15. Where registration may be refused

The Registrar shall refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as is likely to be taken for that mark:

- (a) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design” and “Copyright” or a word or words to the like effect in any language whatsoever; or
- (b) any mark which is specifically declared by the Minister in any regulations made under this Act to be a prohibited mark.

Section 16. Use of name of another person

Where a person makes an application to register a trade mark which consists of or includes the name or representation of another person whether living or dead the Registrar may require the applicant to furnish him with the consent of that person if living or of the legal representative of that person if deceased before permitting the name or representation to be used as a trade mark.

Section 17. Registration for particular goods or services

(1) A trade mark may be registered in respect of any or all of the goods comprised in a prescribed class of goods or in respect of any or all of the services comprised in a prescribed class of services.

(2) If any question arises as to the class in which goods or services are comprised that question shall be decided by the registrar whose decision shall be final.

Section 18. Disclaimer

(1) If a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains matter which is common to the trade or business or is not distinctive,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain in the Register, may require as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any such part or matter, to the exclusive use of which the Registrar or the Court holds him not to be entitled or that the proprietor shall make such other disclaimer as the Registrar or the Court may consider necessary for the purpose of defining his rights under the registration.

(2) No disclaimer on the Register shall affect any right of the proprietor of a trade mark except a right arising out of the registration of the trade mark in respect of which the disclaimer is made.

Section 19. Identical trade marks

(1) No trade mark shall be registered in respect of any goods or description of goods—

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services—

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

(a) such applications are in respect of the same goods or description of goods; or

(b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

(a) such applications are in respect of the same services or description of services; or

(b) at least one of such applications is in respect of services and the other or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

Section 20. Concurrent use

(1) Notwithstanding subsection 19(1), in the case of honest concurrent use or of the circumstances described in paragraph 6(4)(c) or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same goods or description of goods; or
- (b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods, subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(1A) Notwithstanding subsection 19(2), in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same services or description of services; or
- (b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(2) The Registrar shall not refuse to register a trade mark which is identical to or so nearly resembling another trade mark in the Register if the applicant of the first mentioned trade mark or his predecessor in business has continuously used that trade mark from a date before—

- (a) the use of that other trade mark by the registered proprietor or his predecessor in business or by a registered user; or
- (b) the registration of that other trade mark by the registered proprietor or his predecessor in business,

whichever is the earlier.

Section 24. Series of trade marks

(1) Where several trade marks in respect of the same goods or description of goods in a single class or in respect of the same services or description of services in a single class resemble each other in material particulars but differ in respect of—

- (a) statements or representation as to the goods or services in respect of which the trade marks are used or proposed to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
- (d) colour, and a person who claims to be the proprietor thereof seeks to register the trade marks, the trade marks may be registered as a series in one registration.

[...]

Section 25. Registration

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner.

[...]

Section 37. Registration conclusive

In all legal proceedings relating to a trade mark registered in the Register (including applications under section 45) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date thereof, be taken to be valid in all respects unless it is shown—

(a) that the original registration was obtained by fraud;
[...]

Section 45. Rectification of the Register

(1) Subject to the provisions of this Act—
[...]

(c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;
[...]

Section 56. Certification trade marks

(1) A mark which must be capable, in relation to any goods or services, of distinguishing in the course of trade goods or services certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods or services not so certified shall be registrable as a certification trade mark in the Register in respect of those goods or services in the name of that person as proprietor thereof except that a mark shall not be so registrable in the name of a person who carries on a trade in goods or services of the kind certified.

(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which—

(a) the mark is inherently capable of distinguishing in relation to the goods or services in question; and

- (b) by reason of the use of the mark or any other circumstances, the mark is in fact capable of distinguishing in relation to the goods or services in question.

[...]

(9) In dealing with an application under this section the Registrar shall have regard to the like considerations, as far as relevant, as if the application were an application under section 25 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(10) An applicant for the registration of a trade mark under this section shall transmit to the Registrar draft rules for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorize the use of the trade mark and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorize the use of the trade mark in accordance with the rules) and such rules, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the Register.

(11) The Registrar shall consider the application with regard to the following matters, that is to say—

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
- (b) whether the draft rules are satisfactory; and
- (c) whether in all the circumstances the registrations applied for would be to the public advantage,

and may either—

- (i) refuse to accept the application; or
- (ii) accept the application and approve the rules, either without modification and unconditionally or subject to any conditions, amendments, modifications or limitations of the application or of the rules, which he may think requisite,

[...]

Section 57. Defensive registration of well-known trade marks

(1) Where a trade mark consisting of an invented word or words has become so well-known as regards any goods or services in respect of which it is registered and, in relation to which it has been used, that the use thereof in relation to other goods or services would likely to be taken as indicating a connection in the course of trade between the other goods or services and a person entitled to use the trade mark in relation to the first mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first mentioned goods or services does not use or propose to use the trade mark in relation to the other goods or services and notwithstanding anything in section 46 the trade mark may, on the application in a prescribed manner of the proprietor registered in respect of the first mentioned goods or services, be registered in his name in respect of the other goods or services as a defensive trade mark and while so registered, shall not be liable to be taken off the Register in respect of other goods or services under section 46.

[...]

Section 70B. Protection of well-known trade marks

- (1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a well-known trade mark is entitled to restrain by injunction the use in Malaysia in the course of trade and without the proprietor's consent of the trade mark which, or the essential part of which, is identical with or nearly resembles the proprietor's mark, in respect of the same goods or services, where the use is likely to deceive or cause confusion.
- (2) Nothing in subsection (1) shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this Act.
- (3) In this section, references to a trade mark which is entitled to protection under Article 6bis of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark are to a mark which is well-known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia, and references to the proprietor of such a mark shall be construed accordingly.

Trade Marks Regulations 1997 (to February 2011)

Regulation 13. Marks subject to statutory restriction.

- (1) The Registrar shall refuse to accept any application for the registration of a mark upon which any of the following appears:
 - (a) the words "To counterfeit this is a forgery", "Registered Trade Mark", "Registered Service Mark", or any words to the like effect in any language;
 - (b) the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation thereof;
 - (c) representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation thereof;
 - (d) 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;
 - (e) the word "ASEAN" and the representation of the ASEAN logotype or any colourable imitation thereof;
 - (f) the words "Red Crescent" or "Geneva Cross" and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such representations in a similar colour or colours.
- (2) Where there appears in a trade mark, the registration of which is applied for, a representation of a crescent or a cross in any colour, not being one of those mentioned in paragraph (1)(f), the Registrar may require the applicant, as a condition of acceptance, to undertake not to use the crescent or cross device in red, or in white or silver on a red ground, or in any similar colour or colours.

Regulation 13A. Where registration of mark is not allowed.

The Registrar shall not register a mark or part of a mark where—

- (a) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of Malaysia to be well-known in Malaysia, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;
- (b) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known under regulation 13B, which is registered in Malaysia with respect to goods or services whether or not similar to those with respect to which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the proprietor of the registered mark, provided further, that the interests of the proprietor of the registered mark are likely to be damaged by such use;
- (c) the mark or part of the mark is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;
- (d) the mark or part of the mark is likely to mislead the public if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

Regulation 13B. Criteria of well-known mark.

In determining whether a mark is well-known or not, the following criteria may be taken into account:

- (a) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- (b) the duration, extent and geographical area of any use of the mark;

- (c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;
- (e) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities;
- (f) the value associated with the mark.

Regulation 14. Royal arms, etc.

The following devices shall not appear on a trade mark the registration of which is applied for:

- (a) 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;
- (b) representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- (c) 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.

Regulation 15. Arms of city, etc.

Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or

person appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of such official or other person as appears to the Registrar to be entitled to give consent is filed.

Regulation 16. Goods or services described on a mark.

- (1) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services, the Registrar may refuse to register such mark in respect of any goods or services, as the case may be, other than the goods or services so named or described.
- (2) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services and in either case the name or description in use varies, the Registrar shall consider whether to refuse to permit the registration of the mark for those and other goods or services, as the case may be, unless the applicant states in his application that the name or description will be varied when the mark is used upon goods or services covered by the specification other than the named or described goods or services.

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

Available from the IP authorities of Malaysia.

MYANMAR

Trademark Law, No. 3, 2019 – 30 January 2019

CHAPTER I

Title, Commencement and Definition

[...]

2. The following expressions contained in this Law shall have the meanings given hereunder:

[...]

e) Agency means Agency for Intellectual Property Rights organized under this law.

f) Department means Department to perform the Intellectual Property Rights matters was assigned by the Ministry.

g) Registrar means Assistant Director General who carries out the functions of the registration of Intellectual Property.

[...]

i) Intellectual property rights mean rights that are legally protected for the creations made by self-knowledge. In this expression, copyright, creative right, industrial design right, trademark right and other kinds of intellectual property rights are also included.

j) Mark means any visually perceptible sign in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs capable of distinguishing the goods or services of one undertaking from those of other undertakings. In the said expression, trademark, service mark, collective mark and certification mark are also included;

k) Trademark means any mark capable of distinguishing the goods of one undertaking from those of other undertakings in trade;

l) Service mark means any mark capable of distinguishing services of one undertaking from those of other undertakings in trade;

- m) Collective mark means any mark that belongs to a collective, socio-economic society, an association or a federation of industries, producers or traders, and that distinguishes the goods or services of the members of the collective entity from the goods or services of other undertakings;
 - n) Certification mark means a mark used in connection with goods or services certified by the owner of the mark as to their origin, quality, standard or other characteristics and which are used under the control of the owner of the marks;
 - o) Geographical indication means any indication which identifies goods as originating in the territory of a country, or a region or a locality in that territory, where a given quality, reputation or other characteristics of the goods is essentially attributable to its geographical origin;
 - p) Well-known mark means any mark that is well-known in the relevant sector of the public in the Republic of the Union of Myanmar according to the prescribed criteria;
 - q) Trade name means the name or designation identifying and distinguishing an enterprise.
 - r) Owner of the registered mark means the person or entity recorded as the owner of the registered mark in the register of the intellectual property office.
- [...]

CHAPTER VII

Non-Registrable Marks

13. A mark that falls under any of the following absolute grounds for refusal shall not be registrable if it:
- a) lacks distinctive character;
 - b) consists exclusively of signs or indications which may serve, in trade, to designate the kind, subject matter, quality, quantity, intended purpose, value, place of origin, time of production of the goods or rendering of services, or other characteristics of the goods or services;

Exception:

A mark shall not be refused registration in accordance with subsections a) and b) if it falls under any of the following-

- (i) it has in fact acquired distinctive character as a result of use in commerce before the date of application for registration.
 - (ii) the mark has been used continuously and exclusively in good faith in the course of trade in the Republic of the Union of Myanmar by the applicant before the date of application for registration.
- c) adversely affects public order, morality, faith and conscience, integrity of State, or venerated, and cherished culture of the ethnic group of the Republic of the Union of Myanmar;
- d) has become generic or customary in the current language or in the bona fide and established practices of the trade;
- e) is likely to mislead the public or trade circles, in respect of subsection b);
- f) consists of total or partial reproduction or imitation of a flag, armorial bearings, or other emblems adopted by a State or an international intergovernmental organization; an official sign or hallmark indicating control and warranty adopted by a State; abbreviations and names of an international intergovernmental organization, unless authorized by the competent authorities of the State or of the international intergovernmental organization concerned;
- g) uses emblems protected under international treaties to which the Republic of the Union of Myanmar is a contracting party.

14. A mark that falls under any of the following relative grounds for refusal shall not be registrable:

- a) if it is identical with or similar to a registered mark or earlier applied mark in the name of a different person, the goods or services in respect of which registration has been requested are identical with or similar to the goods or services for which the earlier mark has been registered or applied for and the use of the sign would cause a likelihood of confusion with that mark by the users.

- b) if, without the permission of the relevant person or legal entity, it uses the mark affecting personality rights of that person or the reputation of the legal entity;
- c) if the mark infringes the copyright or industrial property right of a third person;
- d) if the registration of the mark is filed in bad faith;
- e) if it is identical with or similar to a well-known mark, the goods or services in respect of which registration of sign is applied for are identical with or similar to the goods or services for which the well-known mark is used and the use of the sign would cause a likelihood of confusion with that mark;
- f) if it is identical with or similar to a registered well-known mark, the goods or services in respect of which registration of the sign is applied for are dissimilar to the goods or services for which the well-known mark is registered, the use of the sign would indicate a connection between the goods or services for which it is used and the owner of the registered well-known mark, and the interests of the owner of the registered well-known mark are likely to be damaged by such use.

CHAPTER VIII

Application

[...]

17. (A) The applicant for the registration of a mark shall state the following elements:

[...]

- 4. The full exposition of the mark.
- 5. The names of the goods and/or services for which the registration is sought according to the classes of the international classification.

[...]

CHAPTER XVI

Geographical Indications

[...]

57. a) Only producers carrying on their activity in the geographical area specified in the Register shall have the right to use a registered geographical indication, in the course of trade, with respect to the products specified in the Register, provided that such products possess the quality, reputation or other characteristic specified in the Register.

b) In the case of homonymous geographical indications, protection shall be accorded to each indication, provided that there is a sufficient distinction in practice between the homonym registered subsequently and the name already on the Register, taking into account the need to treat the producers concerned in an equitable manner and that consumers are not misled.

c) The right holder of the registered geographical indication shall have the rights to prevent the following matters:

- (i) the use of any means in the presentation of the goods to be originated in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical indication of the goods;
- (ii) any use of registered geographical indication which constitutes an act of unfair competition;
- (iii) any use of a geographical indication identifying goods not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

d) The rights under subsection a) and c) do not apply to another geographical indication which, although literally true as to the territory, region or locality in which the good originates, falsely represents to the public that the good originates in another territory.

60. a) Where a geographical indication is registered under this law, the registration of a mark the use of which would contravene section 57 and which relates to a product of the same type shall be refused if the application for registration of the mark is submitted after the date of submission of the registration application in respect of the geographical indication.

b) Marks registered in breach of subsection a) shall be invalidated.

c) A mark the use of which contravenes section 57, which has been applied for or registered in good faith before the date on which the application for protection of the geographical indication is submitted to the Registrar, may continue to be used and renewed for that product notwithstanding the registration of a geographical indication, provided that no grounds exist under Chapter XV (*Invalidation and Cancellation of Registration of Mark*). In such cases, the use of the protected geographical indication shall be permitted as well as use of the relevant marks.

CHAPTER XVII

Trade Name

63. a) A trade name shall be protected without the obligation of filing or registration, whether or not it forms part of a mark.

b) A name or designation may not be used as a trade name if by its nature or use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

c) A trade name shall be protected against any unauthorized use of an identical or similar sign whether used as a trade name or a mark if that use is likely to mislead the public.

PHILIPPINES

REPUBLIC ACT No. 8293 – An Act Prescribing the Intellectual Property Code and Establishing the Intellectual Property Office, Providing for its Powers and Functions, and for Other Purposes, as amended by Republic Act No. 9150 (2001), Republic Act No. 9502 (2008), and Republic Act No. 10372 (2013)

SECTION 121. Definitions –

As used in Part III, the following terms have the following meanings:

121.1. "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

121.2. "Collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark; (Sec. 40, R.A. No. 166a)

121.3. "Trade name" means the name or designation identifying or distinguishing an enterprise; (Sec. 38, R.A. No. 166a)
[...]

SECTION 123. Registrability –

123.1. A mark cannot be registered if it:

- a. Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
- b. Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;

- c. Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow;
- d. Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - (i) The same goods or services, or
 - (ii) Closely related goods or services, or
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- e. Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- f. Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided* further, that the interests of the owner of the registered mark are likely to be damaged by such use;
- g. Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;
- h. Consists exclusively of signs that are generic for the goods or services that they seek to identify;

- i. Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in *bona fide* and established trade practice;
- j. Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;
- k. Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- l. Consists of color alone, unless defined by a given form; or
- m. Is contrary to public order or morality.

123.2. As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods for which registration is requested as a result of the use that have been made of it in commerce in the Philippines. The Office may accept as *prima facie* evidence that the mark has become distinctive, as used in connection with the applicant's goods or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

123.3. The nature of the goods to which the mark is applied will not constitute an obstacle to registration. (Sec. 4, R.A. No. 166a)

SECTION 165. Trade Names or Business Names —

165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2.

a. Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

b. In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

165.3. The remedies provided for in Sections 153 to 156 and Sections 166 and 167 shall apply mutatis mutandis.

[...]

SECTION 167. Collective Marks —

167.1. Subject to Subsections 167.2 and 167.3, Sections 122 to 164 and 166 shall apply to collective marks, except that references therein to "mark" shall be read as "collective mark".

167.2.

a. An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the agreement, if any, governing the use of the collective mark.

[...]

167.3. In addition to the grounds provided in Section 149, the Court shall cancel the registration of a collective mark if the person requesting the cancellation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the agreements referred to in Subsection 166.2 or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

[...]

Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers of 2017 **— IPOP HL Memorandum Circular No. 17-010, 7 July 2017**

RULE 101. *Definitions.* –

Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

(a) "*Bureau*" or "*Office*" means the Bureau of Trademarks of the Intellectual Property Office of the Philippines;

(b) "*Collective mark*" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristics, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

[...]

(j) "*Mark*" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods;

[...]

(m) "*Trade name*" means the name or designation identifying or distinguishing an enterprise, also known or referred to as business identifier;

[...]

RULE 102. *Registrability.* –

A mark cannot be registered if it:

- (a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

- (b) Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;
- (c) Consists of a name, portrait or signature identifying a particular living individual except by the person's written consent; or the name, signature, or portrait of a deceased President of the Philippines, during the life of the surviving spouse, if any, except by the latter's written consent;
- (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - (i) The same goods or services, or
 - (ii) Closely related goods or services, or
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided* further, That the interests of the owner of the registered mark are likely to be damaged by such use;

- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of the services, or other characteristics of the goods or services;
- (k) Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- (l) Consists of color alone, unless defined by a given form; or
- (m) Is contrary to public order or morality.

As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods and/or services for which registration is requested as a result of the use that has been made of it in commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods and/or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

The nature of the goods or services to which the mark is applied will not constitute an obstacle to registration.

RULE 103. *Criteria for Determining Whether a Mark is Well-known.* –

In determining whether a mark is well-known, the following criteria or any combination thereof may be considered:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that the mark is a well-known mark.

RULE 104. *Trade Names or Business Names.* –

A name or designation may not be used as a trade name if its nature or its use is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

[...]

RULE 400. *Application Requirements.* –

All applications must be addressed to the Director and shall be in Filipino or English and shall contain the following:

[...]

(g) where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;

(h) where the mark is a three-dimensional mark, a statement to that effect;

(i) reproduction of the mark as provided in these Regulations or subsequent issuances;

[...]

(k) the names of the goods or services for which the registration is sought, grouped according to the classes of the Nice Classification, together with the number of the class of the said classification to which each group of goods or services belongs;

- (l) where the application is for a collective mark, a designation to that effect;
[...]

RULE 402. *Reproduction of the Mark.* –

One (1) reproduction of the mark shall be submitted upon filing of the application which shall substantially represent the mark as actually used or intended to be used on or in connection with the goods and/or services of the applicant. The reproduction may be added or pasted on the space provided for in the application form or printed on an ordinary bond paper. The reproduction must be clear and legible, printed in black ink or in color, if colors are claimed, and must be capable of being clearly reproduced when published in the IPO eGazette. An electronic copy of the reproduction may likewise be submitted in lieu of the printed reproduction. The electronic reproduction should be in .jpg format and must not exceed one (1) megabyte.

In the case of word marks or if no special characteristics have to be shown, such as design, style of lettering, color, diacritical marks, or unusual forms of punctuation, the mark must be represented in standard characters. The specification of the mark to be reproduced will be indicated in the application form and/or published on the website.

The provisions of this Rule shall, however, be construed liberally in determining whether the application shall be considered complete for purposes of granting a filing date.

RULE 403. *Submission of Label.* –

The applicant may submit the label as actually used or intended to be used on the goods or a computer printout of the label.

RULE 604. *Disclaimers.* –

The basic purpose of disclaimers is to make of record, that a significant element of a composite mark is not being exclusively appropriated apart

from the composite. The following portions of a mark, when forming part of the composite mark, must be disclaimed to permit registration, namely:

- (a) a generic term;
- (b) a descriptive matter in the composite mark;
- (c) a customary term, sign or indication; or
- (d) a matter which does not function as a trademark, or service mark or a trade name.

Such disclaimer shall not prejudice or affect the applicant's rights then existing under some other law or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's rights to registration on another application of later date, where the disclaimed matter has become distinctive of the applicant's goods, business or services.

Where the Examiner has determined that any portion of a mark contains unregistrable matter which must be disclaimed, the Examiner shall communicate the findings to the applicant in the office action. If the applicant fails to comply with the Examiner's requirement for a disclaimer, the Examiner must make the requirement final if the application is in condition for a final action.

Partial disclaimer may be allowed with respect to some classes or some goods and/or services.

Guidelines for Trademark Examination – (Manual for Trademark Examination) First Edition, December 2012

Available from the IP authorities of the Philippines.

See: <https://www.ipophil.gov.ph>

SINGAPORE

Trade Marks Act [Cap. 332, 2005 Rev Ed.]

Interpretation

2. (1) In this Act, unless the context otherwise requires — [...]

“business identifier” means any sign capable of being represented graphically which is used to identify any business;

“certification mark” has the meaning assigned to it in section 61;

“collective mark” has the meaning assigned to it in section 60; [...]

“dilution”, in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is —

- (a) any competition between the proprietor of the trade mark and any other party; or
- (b) any likelihood of confusion on the part of the public;

“earlier trade mark” means —

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well-known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“geographical indication” has the same meaning as in section 2 of the Geographical Indications Act 2014; [...]

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof; [...]

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person; [...]

"well-known trade mark" means —

- (a) any registered trade mark that is well-known in Singapore; or
- (b) any unregistered trade mark that is well-known in Singapore and that belongs to a person who —
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore; [...]

Application for registration

5. (2) The application shall — [...]

- (c) contain a clear representation of the trade mark; [...]

Absolute grounds for refusal of registration

7. (1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.
- (2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.
- (3) A sign shall not be registered as a trade mark if it consists exclusively of —
- (a) the shape which results from the nature of the goods themselves;
 - (b) the shape of goods which is necessary to obtain a technical result;
or
 - (c) the shape which gives substantial value to the goods.
- (4) A trade mark shall not be registered if it is —
- (a) contrary to public policy or to morality; or
 - (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).
- (5) A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law.
- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.
- (7) Notwithstanding subsection (2), a trade mark shall not be registered if it contains or consists of a geographical indication in respect of a wine or spirit and the trade mark is used or intended to be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.

(8) Subsection (7) shall apply whether or not the trade mark has, or is accompanied by, an indication of the true geographical origin of the wine or spirit, as the case may be, or an expression such as “kind”, “type”, “style”, “imitation” or the like, and irrespective of the language the geographical indication is expressed in that trade mark.

(9) A trade mark shall not be refused registration by virtue of subsection (7) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either —

(a) before 15th January 1999; or

(b) before the geographical indication in question is protected in its country of origin.

(10) A trade mark shall not be refused registration by virtue of subsection (7) if the geographical indication in question —

(a) has ceased to be protected; or

(b) has fallen into disuse,

in its country of origin.

(10A) Notwithstanding subsection (2), a trade mark shall not be registered if —

(a) it contains or consists of a geographical indication which is registered, or in respect of which an application for registration has been made, under the Geographical Indications Act 2014 before the date of the application for registration of the trade mark; and

(b) the goods for which the trade mark is sought to be registered —

(i) are identical or similar to the goods for which the geographical indication is registered or for which registration of the geographical indication is sought; and

(ii) do not originate in the place indicated by the geographical indication.

(10B) Subsection (10A) shall apply whether or not the trade mark has, or is accompanied by, an indication of the true geographical origin of the goods, or an expression such as “kind”, “type”, “style”, “imitation” or the like, and irrespective of the language the geographical indication is expressed in that trade mark.

(10C) A trade mark shall not be refused registration by virtue of subsection (10A) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either

-
- (a) before the date of the application for registration of the geographical indication in question in Singapore; or
- (b) before the geographical indication in question became protected in its country of origin.

(11) A trade mark shall not be registered in the cases specified in sections 56 and 57.

(12) The Minister may make rules to provide that a sign specified in the rules shall not be registered as a trade mark, or shall not be so registered unless such conditions as may be prescribed are met.

(13) A trade mark shall not be registered if or to the extent that the registration contravenes any rule made under subsection (12).

Relative grounds for refusal of registration

8. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

- (2) A trade mark shall not be registered if because —
- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public. [...]

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well-known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
 - (ii) if the earlier trade mark is well-known to the public at large in Singapore —
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

(5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well-known in Singapore, unless it is shown that the application was made in bad faith.

(6) In deciding whether any such application was made in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier trade mark.

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

- (b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.
- (8) A person entitled under subsection (7) to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.
- (9) The Registrar may, in his discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.
- (10) The Registrar may, in his discretion, register any trade mark referred to in subsection (3), (4) or (7) where the proprietor of the earlier trade mark or other earlier right fails to give notice to the Registrar of opposition to the registration in accordance with section 13.
- (11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no *bona fide* use of the mark during the 2 years immediately preceding the expiry.

Raising of relative grounds in case of honest concurrent use

9. (1) Where, on an application for the registration of a trade mark, it appears to the Registrar —

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 8(1), (2) or (3) apply; or
- (b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use in the course of trade in Singapore of the trade mark for which registration is sought, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect —

- (a) the refusal of registration on the grounds mentioned in section 7; or
- (b) the making of an application for a declaration of invalidity under section 23(3).

Registration of series of trade marks

17. (1) A person may make a single application under section 5 for the registration of a series of trade marks.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act and the Registrar is required under section 15 to register the trade marks, he shall register them as a series in one registration.

Registration subject to disclaimer or limitation

30. (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.

(3) The Minister may make rules as to the publication and entry in the register of a disclaimer or limitation.

National emblems, etc., of Convention countries: Article 6ter of Paris Convention, etc.

56. (1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without their authorisation.

Emblems, etc., of certain international organisations: Article 6ter of Paris Convention, etc.

57. (1) This section shall apply to —

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

- (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without its authorisation.

(5) Nothing in this section shall affect the rights of a person whose *bona fide* use of the trade mark in question began before 23rd February 1995 (when the relevant provisions of the Paris Convention entered into force in relation to Singapore).

Notification under Article 6ter of Paris Convention, etc.

58. (1) For the purposes of section 56, state emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

- (a) the country in question has notified Singapore in accordance with Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) Singapore has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of section 57, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

- (a) the organisation in question has notified Singapore in accordance with Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) Singapore has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification. [...]

Collective marks

60. (1) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by

members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

(2) The provisions of this Act shall apply to collective marks subject to the provisions of the First Schedule.

Certification marks

61. (1) A certification mark is a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified.

(2) The provision of this Act shall apply to certification marks subject to the provisions of the Second Schedule.

FIRST SCHEDULE – COLLECTIVE MARKS

[...]

Signs of which a collective mark may consist

2. In relation to a collective mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association.

Indication of geographical origin

3. (1) Notwithstanding section 7(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Mark not to be misleading as to character or significance

4. (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

Regulations governing use of collective mark

5. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

(3) Further requirements with which the regulations have to comply may be imposed by rules made under this Act.

Approval of regulations by Registrar

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark —

(a) comply with paragraph 5(2) and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.
[...]

SECOND SCHEDULE – CERTIFICATION MARKS

[...]

Signs of which a certification mark may consist

2. In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1)(b) from those which are not so certified.

Indication of geographical origin

3. (1) Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor’s business

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5. (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

[...]

Approval of regulations, etc.

7. (1) A certification mark shall not be registered unless —

(a) the regulations governing the use of the mark —

(i) comply with paragraph 6(2) and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

[...]

Trade Marks Rules

Representation of President

11. The Registrar shall refuse to register a trade mark which consists of or contains any representation of the President or any colourable imitation thereof.

Singapore Crest, Presidential Coat of Arms, Royal Arms, etc.

12. The Registrar shall refuse to register a trade mark which consists of or contains —

- (a) 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;
- (b) any representation of the Royal or Imperial crown, or of the Singapore flag, or of the Royal or Imperial flag;
- (c) 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 recently has had Royal, Imperial, Presidential or the Singapore Government’s patronage or authorisation, whether or not such be the case;
- (d) 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; or
- (e) the word “ANZAC”,

unless it appears to the Registrar that consent to its registration and use of the person or authority entitled to give consent has been obtained.

Registration of mark consisting of arms, etc.

13. (1) Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate,

government body, statutory board, institution or person appears on a trade mark which is the subject of an application for registration, the Registrar, before proceeding to register the mark, may require the applicant to furnish the Registrar with the consent to the registration and use of the matter in question of such official or other person as appears to the Registrar to be entitled to give consent.

(2) The Registrar shall refuse to register the mark if no such consent is furnished within the time specified by the Registrar.

Persons living or recently dead

14. (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

Geographical Indications Act 2014

Interpretation

2. In this Act, unless the context otherwise requires —
[...]

“geographical indication” means any indication used in trade to identify goods as originating from a place, provided that —

- (a) the place is a qualifying country or a region or locality in a qualifying country; and
- (b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place;

“goods” means any natural or agricultural product or any product of handicraft or industry;

“interested party”, in relation to goods identified by a geographical indication, means a producer of the goods, a trader of the goods, or an association of such producers or traders or of such producers and traders;
[...]

Interested party may bring action for certain uses of geographical indication

4. (1) Subject to the provisions of this Act, an interested party of goods identified by a geographical indication may bring an action against a person for carrying out an act to which this section applies in relation to the geographical indication.

[...]

(2) This section shall apply to the following acts:

- (a) the use of a geographical indication in relation to any goods which did not originate in the place indicated by the geographical indication, in a manner which misleads the public as to the geographical origin of the goods;
- (b) any use of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10 *bis* of the Paris Convention;

[...]

(3) Any use of a geographical indication within the meaning of subsection (2) shall be deemed to be an act to which this section applies even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another place.

(4) For the purposes of subsection (2), “use of a geographical indication” includes the use of a trade mark which contains or consists of the geographical indication in question.

Trade Marks Work Manual

Available from the IP authorities of Singapore at:

<https://www.ipos.gov.sg>

<https://www.ipos.gov.sg/resources/trade-mark>

THAILAND

Trademark Act B.E. 2534 (1991), as amended by Trademark Act (No. 2) B.E. 2543 (2000) and Trademark Act (No. 3) B.E. 2559 (2016)

Section 4. In this Act:—

“mark” means a photograph, drawing, invented device, logo, name, word, phrase, letter, numeral, signature, combination of colors, figurative element, sound or combination thereof.

“trademark” means a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trademark of the owner of such trademark is used from goods under another person’s trademark;

“service mark” means a mark used or proposed to be used on or in connection with services to distinguish the services using the service mark of the owner of such service mark from services under another person’s service mark;

“certification mark” means a mark used or proposed to be used by the owner thereof on or in connection with goods or services of another person to certify the origin, composition, method of production, quality or other characteristics of such goods or to certify as to the nature, quality, type or other characteristics of such services;

“collective mark” means a trademark or service mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group of persons or any other state or private organization;
[...]

Section 6. To be registrable, a trademark must:

- (1) be distinctive;
- (2) not be prohibited under this Act;

- (3) not be the same as or similar to a trademark registered by another person.

Section 7. A distinctive trademark is a trademark which enables the public or users to distinguish the goods with which the trademark is used from other goods.

A trademark having or comprising any of the following essential characteristics shall be deemed distinctive:

- (1) a personal name, a surname of a natural person not being such by its ordinary signification, a full name of a juristic person in accordance with the law on such matter or a tradename represented in a special manner and having no direct reference to the character or quality of the goods;
- (2) a word or phrase having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister;
- (3) an invented word;
- (4) a stylized letter or numeral;
- (5) a combination of colors represented in a special manner;
- (6) the signature of the applicant or the predecessor in his or her business or the signature of another person with his or her permission;
- (7) the representation of the applicant or of another person with his or her permission or of a deceased person with the permission of his or her ascendants, descendants and spouse, if any;
- (8) an invented device;
- (9) a picture having no direct reference to the character or quality of the goods and not being a picture of a map or a geographical site prescribed by the Minister;

- (10) a shape which is not the natural form of the goods or a shape which is not necessary to obtain a technical result of the goods or a shape which does not give value to the goods;
- (11) a sound having no direct reference to the character or quality of the goods or a sound which is not the natural sound of the goods or a sound which does not result from the functioning of the goods.

A trademark having no characteristics under paragraph two (1) to (11), if used on goods which have been widely sold or advertised in accordance with the rules prescribed in a notification by the Minister and if it is proved that the rules have been duly met, shall be deemed distinctive.

Section 8. Trademarks having or consisting of any of the following characteristics shall not be registrable: —

- (1) State arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces;
- (2) national flags of Thailand, royal standard flags or official flags;
- (3) royal names, royal monograms, abbreviations of royal names or royal monograms, or
- (4) representations of the King, Queen or Heir to the Throne;
- (5) names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family;
- (6) national emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or international organizations, names and monograms of foreign states or international organizations, unless permission is given by the competent officer of the foreign state or international organization;
- (7) official emblems and emblems of the Red Cross or appellations “Red Cross” or “Geneva Cross”;

- (8) a mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise or any other government organ of Thailand, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark;
- (9) any mark which is contrary to public order, morality or public policy;
- (10) a mark registered or not, which is identical with a well-known mark as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods;
- (11) trademarks similar to those under (1) (2) (3) (5) (6) or (7);
- (12) geographical indications protected under the law on geographical indications;
- (13) other trademarks prescribed by the Ministerial Notifications.

Section 13. Subject to Section 27, the Registrar shall not grant registration to a trademark applied for if he finds that:

- (1) it is identical with a trademark registered by another person for use with goods in the same class or in different classes found to be of the same character
- (2) it is so similar to a trademark registered by another person that the public might be confused or misled as to the ownership or origin of the goods for use with goods in the same class or in different classes found to be of the same character.

Section 17. If, in the opinion of the Registrar, a trademark considered as a whole is registrable under Section 6 but contains one or more parts which are common to the trade for some types or classes of goods such that no applicant should have exclusive right thereto or which are not distinctive, the Registrar shall make either of the following:

- (1) order the applicant to disclaim exclusive right to such part or parts of the trademark within sixty days from the date of receipt of the order;
 - (2) order the applicant to enter such other disclaimers as the Registrar finds it necessary to define the rights of the owner of such trademark within sixty days from the date of receipt of the order.
- [...]

Section 27. Where there are applications under Section 13 or Section 20 paragraph one, as the case may be, if the Registrar finds there has been honest concurrent users or special circumstances making it proper to do so, he or she may grant registration of such identical or similar trademarks of several owners subject to such conditions and limitations as to the mode or place of use or such other conditions and limitations as he or she may think fit to impose. The Registrar shall, without delay, notify the applicant and the registered owner of the order in writing with reasons.

[...]

Section 45. A trademark registered without limitation of color shall be deemed to be registered for all colors.

Section 82. The applicant for registration of a certification mark, in addition to complying with the provisions on registration of trademarks, shall:—

- (1) submit the regulations on use of the certification mark together with the application for registration
and
- (2) demonstrate an ability to certify the characteristics of the goods or services as provided in the regulations under (1).

The regulations under (1) shall indicate the origin, composition, method of production, quality or other characteristics which are to be certified including the rule, procedures and conditions for authorizing use of the certification mark.

Section 84. If the Registrar is of the opinion that the applicant for registration of a certification mark does not have sufficient ability to certify the characteristics of the goods or services as provided in the regulations on use of the certification mark or that registration of the certification mark would not be in the public interest, the Registrar shall refuse registration and shall in writing promptly notify the applicant of the order with the grounds of the refuse. [...]

Section 94. Except for the provisions of Chapter I, Part 5, the provisions concerning trademarks shall apply to collective marks *mutatis mutandis*.

Notification of the Ministry of Commerce, 20 September, 2004, Prescribing Geographical Names under Section 7(2) of the Trademark Act

[...]

2. The following geographical names shall be held to be geographical names under Section 7(2) of the Trademark Act of 1991:

1. Names of countries, including those of independent zones which have the same characteristics as those of countries, names of country groups that are widely known or regional names.
2. Names of states, regions or counties.
3. Names of capitals, ports or local administrative zones.
4. Names of continents or sub-continents.
5. Names of oceans, seas, gulfs, peninsulas, capes, islands, archipelagos or lakes.
6. Other geographical names, such as names of ports, provinces, districts, sub-districts, countries, islands, hills and mountains, rivers, seas or lakes which are known by public in general.

The above geographical names shall also mean their abbreviations and the words by which they are generally called, without being restricted to only the governmental names. [...]

Notification of Ministry of Commerce of 11 October 2012 prescribing regulations for demonstration of distinctive character according to Section 7(3) of the Trademark Act

[...]

Clause 2. Demonstration of distinctive character by distribution, dissemination, or advertisement of the goods or services using a trademark, service mark, certification mark, and collective trademark until widely recognized according to Section 7, paragraph 3 of the Trademark Act B.E. 2534, amended in the Trademark Act (No.2) B.E. 2543, will comprise of the following criteria:

- (1) The goods or services using the trademark has been distributed, disseminated, or advertised continuously for an appropriate length of time to the point that the general public or public in a specific sector in Thailand has widely recognized or understood that such good or service is different from other goods or services.
- (2) The distribution, dissemination, or advertisement of such product or service to the point that the trademark has been widely recognized in Thailand, such trademark shall be deemed having distinctive characters only with such product or services.
- (3) A trademark to be demonstrated for distinctive characters according to this Declaration shall be the same trademark as the one submitted for registration.

Clause 3. For demonstration according to Clause 2, the applicant for registration shall submit evidence of distribution, dissemination, or advertisement of such product or service using such trademark being applied for registration such as copies of product purchase receipts, copies of advertisement receipts, copies of invoices, copies of purchase orders, copies of licenses, plant establishment, copies of evidence of advertisements in various media, product samples, or other evidence, including witnesses (if any), etc.

[...]

VIET NAM

Law on Intellectual Property, No. 50/2005/QH11, amended and supplemented by Law No. 36/2009/QH12 of 2009

Article 4. Interpretation of terms. In this Law, the following terms shall be construed as follows:

[...]

16. *Mark* means any sign used to distinguish goods and/or services of different organizations or individuals.

17. *Collective mark* means a mark used to distinguish goods or services of members from those of non-members of an organization which is the owner of such mark.

18. *Certification mark* means a mark which is authorized by its owner to be used by another organization or individual on the latter's goods and/or services, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods or services bearing the mark.

19. *Integrated mark* means identical or similar marks registered by the same entity and intended for use on products or services which are of the same type or similar types or interrelated.

20. *Well-known mark* means a mark widely known by consumers throughout the Vietnamese territory.

21. *Trade name* means a designation of an organization or individual in business activities, capable of distinguishing the business entity bearing it from another entity in the same business domain and area.

A business area mentioned in this clause means a geographical area where a business entity has its partners, customers or earns its reputation.

22. *Geographical indication* means a sign which identifies a product as originating from a specific region, locality, territory or country.

[...]

Article 6. Bases for the emergence and establishment of intellectual property rights

[...]

4. Industrial property rights are established as follows:
 - a. Industrial property rights to an invention, industrial design, layout-design, mark or geographical indication shall be established on the basis of a decision of the competent state agency on the grant of a protection title according to the registration procedures stipulated in this Law or the recognition of international registration under treaties to which the Socialist Republic of Viet Nam is a contracting party; for a well-known mark, industrial property rights shall be established on the basis of use process, not subject to any registration procedures.
 - b. Industrial property rights to a trade name shall be established on the basis of lawful use thereof;
[...]

Article 8. The State's intellectual property policies

1. To recognize and protect intellectual property rights of organizations and individuals on the basis of harmonizing benefits of intellectual property rights holders and public interests; not to protect intellectual property objects which are contrary to social ethics and public order and prejudicial to defence and security.
[...]

Article 72. General conditions for marks eligible for protection

A mark shall be protected when it satisfies the following conditions:

1. Being a visible sign in the form of letters, words, drawings or images, including holograms, or a combination thereof, represented in one or more colors;
2. Being capable of distinguishing goods or services of the mark owner from those of other subjects.

Article 73. Signs not protected as marks

The following signs shall not be protected as marks:

1. Signs identical with or confusingly similar to national flags or national emblems;
2. Signs identical with or confusingly similar to emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese state agencies, political organizations, socio-political organizations, socio-political-professional organizations, social organizations or socio-professional organizations or international organizations, unless permitted by such agencies or organizations;
3. Signs identical with or confusingly similar to real names, alias, pseudonyms or images of leaders, national heroes or famous personalities of Viet Nam or foreign countries;
4. Signs identical with or confusingly similar to certification seals, check seals or warranty seals of international organizations which require that their signs must not be used, unless such seals are registered as certification marks by those organizations;
5. Signs which cause misleading or confusion or deceive consumers as to the origin, properties, intended utilities, quality, value or other characteristics of goods or services.

Article 74. Distinctiveness of marks

1. A mark shall be considered distinctive if it consists of one or several easily noticeable and memorable elements, or of many elements forming an easily noticeable and memorable combination, and does not fall into the cases specified in Clause 2 of this Article.
2. A mark shall be considered as indistinctive if it is a sign or signs falling into one of the following cases:
 - a. Simple shapes and geometric figures, numerals, letters or scripts of uncommon languages, except where such signs have been widely used and recognized as a mark;

- b. Conventional signs or symbols, pictures or common names in any language of goods or services that have been widely and regularly used and known to many people;
- c. Signs indicating time, place and method of production, category, quantity, quality, properties, ingredients, intended utility, value or other characteristics, which is descriptive of goods or services, except where such signs have acquired distinctiveness through use before the filing of mark registration applications;
- d. Signs describing the legal status and business field of business entities;
- e. Signs indicating the geographical origin of goods or services, except where such signs have been widely used and recognized as a mark or registered as collective marks or certification marks as provided for in this Law;
- f. Signs other than integrated marks which are identical with or confusingly similar to registered marks of identical or similar goods or services on the basis of registration applications with earlier filing dates or priority dates, as applicable, including mark registration applications filed under treaties to which the Socialist Republic of Viet Nam is a contracting party;
- g. Signs identical with or confusingly similar to another person's mark which has been widely used and recognized for similar or identical goods or services before the filing date or the priority date, as applicable;
- h. Signs identical with or confusingly similar to another person's mark which has been registered for identical or similar goods or services, the registration certificate of which has been invalidated for no more than 5 years, except where the ground for such invalidation is non-use of the mark according to Point d, Clause 1, Article 95 of this Law;
- i. Signs identical with or confusingly similar to another person's mark recognized as a well-known mark which has been registered for goods or services which are identical with or similar to those bearing such well-known mark, or for dissimilar goods or services

- if the use of such mark may affect the distinctiveness of the well-known mark or the mark registration is aimed at taking advantage of the reputation of the well-known mark;
- j. Signs identical with or similar to another person's trade name currently in use if the use of such signs may cause confusion to consumers as to the origin of goods or services;
 - k. Signs identical with or similar to a geographical indication being protected if the use of such signs may mislead consumers as to the geographical origin of goods;
 - l. Signs identical with, containing or being translated or transcribed from geographical indications being protected for wines or spirits if such signs have been registered for use with respect to wines and spirits not originating from the geographical areas bearing such geographical indications;
 - m. Signs identical with or insignificantly different from another person's industrial design which has been protected on the basis of an industrial design registration application with the filing date or priority date earlier than that of the mark registration application.

Article 75. Criteria for evaluation of well-known marks

The following criteria shall be taken into account when a mark is considered well-known:

1. The number of involved consumers who have been aware of the mark through purchase or use of goods or services bearing the mark or through advertising;
2. Territorial area in which goods or services bearing the mark are circulated;
3. Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
5. Duration of continuous use of the mark;

6. Wide reputation of goods or services bearing the mark;
7. Number of countries protecting the mark;
8. Number of countries recognizing the mark as a well-known mark;
9. Assignment price, licensing price, or investment capital contribution value of the mark.

Article 76. General conditions for trade names eligible for protection

A trade name shall be protected when it is capable of distinguishing the business entity bearing it from other business entities operating in the same business field and locality.

Article 77. Subject matters not protected as trade names

Names of state agencies, political organizations, socio-political organizations, socio-political- professional organizations, social organizations, socio-professional organizations or other entities that are not involved in business activities shall not be protected as trade names.

Article 78. Distinctiveness of trade names

A trade name shall be considered distinctive when it satisfies the following conditions:

1. Consisting of a proper name, except where it has been widely known through use;
2. Being not identical with or confusingly similar to a trade name having been used earlier by another person in the same business field and locality;
3. Being not identical with or confusingly similar to another person's mark or a geographical indication having been protected before the date it is used.

Article 80. Subject matters not protected as geographical indications

The following subject matters shall not be protected as geographical indications:

[...]

3. Geographical indications identical with or similar to a protected mark, where the use of such geographical indications is likely to cause a confusion as to the origin of products;

[...]

Article 87. Right to register marks

[...]

3. Lawfully established collective organizations may register collective marks to be used by their members under regulations on use of collective marks. For signs indicating geographical origins of goods or services, organizations that may register them are collective organizations of organizations or individuals engaged in production or trading in relevant localities. For other geographical names or signs indicating geographical origins of local specialties of Viet Nam, the registration must be permitted by competent state agencies.

4. Organizations with the function of controlling and certifying the quality, properties, origin or other relevant criteria of goods or services may register certification marks, provided that they are not engaged in the production or trading of these goods or services. For other geographical names or signs indicating geographical origins of local specialties of Viet Nam, the registration thereof must be permitted by a competent state agency.

[...]

Article 105. Requirements on mark registration applications

1. Documents, samples, information identifying a mark registered for protection in a mark registration application include:

- a. A sample of the mark and a list of goods or services bearing the mark;
 - b. Regulation on use of collective marks or regulation on use of certification marks.
2. The sample of the mark must be described in order to clarify elements of the mark and the comprehensive meaning of the mark, if any; where the mark consists of words or phrases of hieroglyphic languages, such words or phrases must be transcribed; where the mark consists of words or phrases in foreign languages, such words or phrases must be translated into Vietnamese.
[...]
4. The regulation on use of collective marks consists of the following principal contents:
- a. Name, address, grounds of establishment and operations of the collective organization being the owner of the mark;
 - b. Criteria for becoming a member of the collective organization;
 - c. List of organizations and individuals permitted to use the mark;
 - d. Conditions for use of the mark;
 - e. Measures for handling acts violating the regulation on use of marks.
5. The regulation on use of certification marks consists of the following principal contents:
- a. The organization or individual being the mark owner;
 - b. Conditions for using the mark;
 - c. Characteristics of goods or services certified by the mark;
 - d. Methods of evaluating characteristics of goods or services and methods of controlling the use of the mark;
 - e. Expenses to be paid by the mark user for the certification and protection of the mark, if any.

Article 163. Denominations of plant varieties

[...]

3. Denominations of plant varieties shall be deemed improper in the following cases:

[...]

- e. They are identical or confusingly similar to marks, trade names or geographical indications protected before the date of publication of protection registration applications of such plant varieties;

[...]

5. When denominations of plant varieties are combined with trademarks, trade names or indications similar to denominations of plant varieties already registered for sale offer or marketed, such denominations must still be distinguishable.

Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property, as amended and supplemented by Decree No. 122/2010/ND/CP of December 31, 2010

Article 6. Bases and procedures for the establishment of industrial property rights

1. Industrial property rights to inventions, layout designs, industrial designs, marks and geographical indications are established on the basis of decisions of the state management agency in charge of industrial property which grants protection titles to applicants for registration of those objects according to the provisions of Chapters VII, VIII and IX of the Law on Intellectual Property. Industrial property rights to marks internationally registered under the Madrid Agreement and the Madrid Protocol are established on the basis of recognition of such international registration by the state management agency.
2. Industrial property rights to well-known marks are established on the basis of widespread use of those marks according to the provisions of Article 75 of the Law on Intellectual Property, not requiring the completion of registration procedures.

3. Industrial property rights to trade names are established on the basis of lawful use of those names according to geographical areas (territories) and business domains, not requiring the completion of registration procedures.

[...]

Circular No. 01/2007/TT-BKHCN of February 14, 2007, guiding the implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, as amended and supplemented in 2010, 2011, 2013 and 2016

1. Grounds for establishment of industrial property rights

[...]

- 1.2 Industrial property rights to inventions, layout designs of semiconductor integrated circuits (hereinafter referred to as layout designs), industrial designs and marks shall be established under decisions of the National Office of Intellectual Property (NOIP) on the grant of protection titles to persons that register those objects. [...]

- 1.3 Industrial property rights to geographical indications shall be established under decisions of the NOIP on the grant of certificates of registered geographical indications to organizations managing those geographical indications

[...]

- 1.5 Industrial property rights to well-known marks shall be established on the basis of their actual public use that has made them well-known, and for those marks the registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over a well-known mark, its proprietor shall evidence his/her/its rights with appropriate proofs specified in Article 75 of the Intellectual Property Law.

- 1.6 Industrial property rights to trade names shall be established on the basis of the lawful use of those trade names, and for those trade names the procedures for registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over, a trade name, the entity owning that trade name shall evidence his/her/its rights with proofs indicating the period of time, territory and field in which the trade name has been used by that entity.

[...]

15. Substantive examination of applications

[...]

15.6. Examination contents

[...]

- b. The assessment of the object based on the protection conditions shall be conducted for objects one after another (if the application contains many and still ensures the uniformity). For each object, the assessment shall be conducted based on each specific protection condition:

[...]

- (iii) For a mark registration application, the assessment shall be conducted with regard to each component of the mark for each goods or service on the list of goods and services.

[...]

37. Requirements for mark registration applications

[...]

37.3 If there is a ground (information, evidence) to doubt about the truthfulness of information supplied in the application, NOIP may request the applicant to submit within one month documents to certify such information, probably as follows:

[...]

- c. Documents evidencing the right to use/register a mark containing special symbols, for:
- (i) Names, emblems, flags or armorial bearings of domestic or international agencies and organizations or certification, control or warranty hallmarks of international organizations as defined in Clauses 2 and 4, Article 73 of the Intellectual Property Law;
- (ii) Names of characters or figures in publicly known works under copyright protection or trade names, trade indications, origin indications, prizes, medals or particular signs of a type of product, which may cause confusion, as defined in Clause 5, Article 73 of the Intellectual Property Law;

- (iii) Signs covered by the protection of industrial property rights of other persons as defined at Point m, Clause 2, Article 74 of the Intellectual Property Law;

[...]

37.4. Requirements for written declarations

An applicant shall submit two written declarations, made according to a set form (not printed herein), with the following attentions:

- a. The section of mark description in the application must clearly indicate the type of mark sought to be registered (common mark, collective mark, association mark, certification mark);
- b. If the mark sought to be registered is an association mark, the applicant shall clearly indicate associated elements being marks or goods or services according to the following provisions:
 - (i) If associated elements are marks (similar to another mark of the very applicant used for the same goods or service or used for similar goods or services), the applicant shall clearly indicate a mark considered substantial among those association marks (if any). If one or several of those marks have been registered or stated in the previously filed applications, the applicant shall clearly indicate the serial numbers of the protection titles and the previously filed applications.
 - (ii) If associated elements are goods or services (a mark used for similar or interrelated goods or services), the applicant shall clearly indicate a goods or service considered substantial among those goods or services (if any). If one of those goods or services has been previously registered or stated in a previously filed application, the applicant shall clearly indicate the serial numbers of the protection title and previously filed application.
 - (iii) If the applicant fails to clearly indicate a substantial mark or a substantial goods or service, all marks and all goods or services related to the mark stated in his/her application shall be considered independent from one another. The assessment of distinctiveness of the mark stated in the application shall comply with general provisions on assessment of distinctiveness as specified at Point 39 of this Circular.

- c. For a certification mark, the applicant shall briefly describe in the written declaration characteristics of goods or services certified by the mark (characteristics of origin, raw materials, materials, method of production, method of providing service, quality, accuracy, safety or other characteristics of goods or services bearing the mark).

[...]

37.6. Requirements for regulations on use of collective marks and certification marks

A regulation on use of a collective mark and a regulation on use of a certification mark must have relevant contents specified in Clauses 4 and 5, Article 105 of the Intellectual Property Law and clarify the following matters:

- a. Brief information on the mark, the mark proprietor and goods and services bearing the mark;
- b. Conditions for the mark registrant to license the mark and conditions for termination of the right to use the mark;
- c. Obligations of the mark user (assuring the particular quality and characteristics of a goods or service bearing the mark, submitting to the control of the mark registrant, paying the mark management charge, etc.);
- d. Rights of the mark registrant (controlling compliance with the regulation on use of the mark, collecting the mark management charge, suspending the mark use right of a person who fails to satisfy the conditions specified in the mark use regulation, etc.);
- e. Mechanism of licensing, control and inspection of use of the mark and assurance of the quality and reputation of goods and services bearing the mark);
- f. Dispute settlement mechanism.

[...]

37.7. Requirements on documents certifying the permission for registration and use of marks certifying geographical origins

- a. For a mark certifying a geographical origin, in addition to the mark use regulation and necessary documents evidencing the right of mark registration, the application must also be enclosed with the local administration's permission for the applicant to register a certification mark containing signs indicating a geographical origin (geographical name, symbol or map of the area or locality) for goods and services bearing the mark.

[...]

39. Substantive examination of mark registration applications

[...]

39.2 Assessment of conformity of objects stated in mark registration applications with requests for grant of certificates of registered marks

- a. According to the provisions of Clause 1, Article 72 of the Intellectual Property Law, signs eligible for being registered as marks must be visible ones in the form of letters, numerals, words, pictures, images, including three-dimensional images or their combinations, presented in one or several given colors.
- b. The following types of sign shall not be protected as marks:
 - (i) Signs that are merely colors and neither combined with character signs or figure signs nor presented in the form of character signs or figure signs;
 - (ii) Signs pertaining to objects not protectable as marks according to the provisions of Article 73 of the Intellectual Property Law;
 - (iii) Signs that are contrary to the public order or prejudicial to national security.

39.3. Assessment of distinctiveness of signs in the form of letters or numerals (hereinafter referred to as character signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law.

Except for the exceptions specified at Point 39.5 of this Circular, the following character signs shall be considered indistinctive:

- a. Characters of languages that are imperceptible and unmemorable to the common knowledge of Vietnamese consumers (unreadable, incomprehensible and unmemorable), such as characters not of Latin origin: Arabic, Slavonic, Sanskrit, Chinese, Japanese, Korean or Thai characters, etc.; except when characters of these languages combine with other components to formulate a distinctive whole or are presented in a graphic form or other special forms;
- b. A Latin-origin character that consists of only one letter or consists of numerals only, or consists of two letters which cannot be pronounced as a word, even if it is accompanied with numerals, except when it is presented in a graphic form or other special forms;
- c. A combination of too many letters or words that is imperceptible and unmemorable, such as a sequence of too many characters not arranged according to a given order or rule, or a text or a paragraph;
- d. A Latin-origin character that is a meaningful word, the meaning of which has been so frequently and widely used in a relevant field in Viet Nam that it loses its distinctiveness;
- e. A word or phrase that is used in Viet Nam as the common name of the very related goods or service;
- f. A word or phrase that describes the very goods or service bearing the mark, such as a sign indicating time, location, geographical origin (except when the registered mark is a mark certifying the geographical origin of a goods or a collective mark), method of manufacture, type, quantity, quality and characteristics (except when the registered mark is a mark certifying the quality of a goods or service), composition, utility and value of a goods or service;
- g. A word or phrase that is liable to describe the legal status or business lines of the mark proprietor;
- h. A character sign that is identical or similar to any of objects covered by the protection of industrial property rights of other persons according to the provisions of Points e, f, g, h, i, j and k, Clause 2, Article 74 of the Intellectual Property Law;
- i. Character signs that cause misunderstanding or confusion or mislead consumers as to the origin, utility, quality, value or other characteristics such as ingredients, process of manufacture, materials or superiority of a goods or service according to the provisions of Clause 5, Article 73 of the Intellectual Property Law;

- j. Character signs that are identical or confusingly similar to real names, alias or pseudonyms of leaders, national heroes or personalities of Viet Nam or foreign countries; identical or confusingly similar to names of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.4. Assessment of distinctiveness of signs in the form of pictures or images (hereinafter referred to as figure signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law

Except for the exceptions specified at Point 39.5 of this Circular, a figure sign shall be considered indistinctive if:

- a. It is a common figure or geometric figure, such as round, ellipse, triangle, quadrangle, etc., or a simple drawing; a picture or image used merely as a background or ornamental pattern of a product or a product package;
- b. It is a picture or image that is too tangled or complicated for consumers to easily perceive and memorize its details, i.e. a sign that consists of too many combined or overlapped images or lines;
- c. It is a widely used picture, image, emblem or symbol;
- d. It is a picture or image liable to describe the very goods or service bearing the mark; location and method of manufacture, geographical origin, type, quantity, quality, properties, composition, utility, value or other characteristics of the goods or service bearing the mark;
- e. It is identical to or not substantially distinguishable from protected industrial designs of other persons;
- f. It is identical or confusingly similar to images of leaders, national heroes or personalities of Viet Nam or foreign countries; identical or confusingly similar to images of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.5. The following exceptions shall apply upon assessment of distinctiveness of character signs or figure signs:

- a. A sign that falls into the cases specified at Points 39.3.a, b, c, f and g and Points 39.4.a, b, c, d and e of this Circular has been used as a mark and widely known to consumers and that mark therefore become distinguishable from relevant goods and services.
- b. To be subject to the application of this exception, the applicant shall furnish evidence of the wide use of that mark (the time of beginning of the use, present scope and level of use, etc., in which, the mark shall be considered “in use” when the use is made in lawful production, business, commercial, advertising or marketing activities) and evidence of the mark’s distinctiveness from the mark proprietor’s relevant goods and services. In this case, that mark shall be recognized distinctive if it is presented in the form in which it has been uninterruptedly and widely used in the reality.

39.6. Assessment of distinctiveness of signs being combinations of character signs and figure signs (hereinafter referred to a combined signs)

A combined sign shall be considered distinctive when a character sign combines with a figure sign in a distinctive whole, specifically as follows:

- a. The character sign and the figure sign are all distinctive and combined into a distinctive whole;
- b. The strong component of the mark (the element that has a strong effect on the senses of consumers, attracts their attention to and gives an impression of the mark) is a distinctive character sign or figure sign, while other components are indistinctive or insignificantly distinctive.
- c. If the combined sign consists of indistinctive or insignificantly distinctive character signs and figure signs, but a unique combination of those signs gives a particular impression, that combined whole is still considered distinctive;
- d. The combined sign consists of indistinctive or insignificantly distinctive character and figure components but that combined whole has become distinctive through the use according to the provisions of Point 39.5 of this Circular.

39.7. Minimum information source

- a. To assess the ability of a sign stated in an application to cause confusion, the NOIP shall conduct the search in the following minimum information source:
- (i) Mark registration applications filed with the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination and mark registration international applications designating Viet Nam notified by the WIPO to the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination for identical or similar goods and services;
 - (ii) Marks already registered or recognized for protection still effective in Viet Nam (including well-known marks), for identical, similar or relevant goods and services;
 - (iii) Registered marks that have ceased to be valid for more than five years, except for those invalidated for non-use defined at Point d, Clause 1, Article 95 of the Intellectual Property Law, for identical or similar goods and services;
 - (iv) Geographical indications currently protected in Viet Nam;
 - (v) Indications to the geographical origin of goods and services; geographical names, quality or control hallmarks; national flags and emblems of nations; flags, names and emblems of Vietnamese and international agencies and organizations; names and images of leaders, national heroes, names and images of personalities of Viet Nam and foreign countries, etc., collected and stored by the NOIP.
- b. When necessary, the search may be conducted in reference information sources other than the minimum information source defined at Point 39.7.a above, such as industrial design registration applications, trade names, etc.

39.8. Assessment of confusing similarity of signs sought to be registered to other marks

- a. To assess whether or not a sign sought to be registered and stated in an application is identical or confusingly similar to another mark (hereinafter referred to as control mark), it is necessary to compare the disposition, content and pronunciation (for character signs), significance and form of expression of the sign (for character signs and figure signs), and concurrently compare the goods and services bearing the sign with those bearing the control mark defined at this Point.
- b. Signs identical to control marks: A sign shall be considered identical to a control mark if it resembles the control mark in terms of disposition, content, significance and form of expression.
- c. A sign considered confusingly similar to a control mark if:
 - (i) It is similar to the control mark in terms of disposition or/and content or/and pronunciation or/and significance or/and form of expression in such a way that makes consumers misjudge these two objects as one or an object as a variation of the other or these two objects of the same origin;
 - (ii) It is merely a transliteration or translation of the control mark in case the control mark is a well-known mark.

39.9. Assessment of similarity of goods and services

- a. Two goods or two services shall be considered identical (of the same type) if these two goods or services have the following characteristics:
 - (i) They have the same nature (composition, ingredients) and the same function and utility; or
 - (ii) They have similar natures and the same function and utility.
- b. Two goods or two services shall be considered similar if these two goods or services have the following characteristics:
 - (i) They are similar in nature; or
 - (ii) They are similar in function or utility; and

- (iii) They are marketed in the same commercial channel (they are distributed by the same mode, or sold together or compete with each other in the same type of shop);
- c. A goods and a service shall be considered similar if they fall into one or several of the following cases:
- (i) They have a correlation in nature (a goods or service or a material or component of a goods or service forms constitutes part of the other); or
 - (ii) They have a correlation in function (to accomplish the function of a goods or service, it is necessary to use the other, or they are usually used together); or
 - (iii) They have a close correlation in method of realization (a goods or service is the result of the use or exploitation of the other).

39.10. Inspection of the first-to-file rule

Before issuing decisions on the grant of certificates of registered marks, the NOIP shall inspect the observance of the first-to-file rule defined in Article 90 of the Intellectual Property Law.

39.11. Conclusion on the ability of signs to be confused with control marks

A sign shall be considered identical or confusingly similar to a control mark used for identical or similar or relevant goods in the following cases:

- (i) It is identical to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark;
- (ii) It is identical to the control mark and goods and services bearing it are identical to goods and services bearing the control mark of the same mark proprietor;
- (iii) It is confusingly similar to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark, except when the similarity of goods and services and the similarity of signs are unable to cause confusion when similar signs are used;

- (iv) It is identical or similar to the control mark being a well-known mark and goods and services bearing it are neither identical nor similar to goods and services bearing the mark, but its use as a mark may make consumers believe that there exists a relationship between goods and services bearing it and the proprietor of the well-known mark and make it possible to reduce the distinctiveness or damage the reputation of the well-known mark.

39.12. Assessment of the ability of signs to cause other confusions

The assessment of the ability of signs to cause other confusions shall comply with the provisions of Article 73 and Clause 2, Article 74 of the Intellectual Property Law and the following specific provisions.

- a. A sign shall be considered having caused confusion of origin of goods or services in the following cases:
 - (i) It is identical or similar to the name or emblem of a nation or territory (national flag, national emblem, name of the nation or a locality) or confusingly similar to the name or emblem of a nation or territory, causing a mislead that goods or services bearing the sign originate from that nation or territory;
 - (ii) It is identical or similar to a protected geographical indication, in case its use may mislead consumers as to the geographical origin of goods; it is identical to a geographical indication or contains a geographical indication or is translated or inscribed from a geographical indication protected for a wine or spirit, in case the sign sought to be registered as a mark for a wine or spirit does not originate in the geographical area subject to that geographical indication;
 - (iii) It is a word identical or similar to the trade name of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are manufactured or provided by the person having above trade name; it is an image identical or similar to the commercial logo of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are

manufactured or provided by the person having the above commercial logo;

- (iv) It is identical or similar to real names, alias, pseudonyms or images of leaders, national heroes or personalities of Viet Nam or foreign countries; it is identical or similar to names or images of typical human characters or figures in widely known works, in case its use can make consumers believe that goods or services bearing it are manufactured or provided by owners of those works;
 - (v) It is identical to or not substantially distinguishable from industrial designs of other persons protected on the basis of industrial design registration applications with filing dates or dates of priority earlier than the filing date or date of priority of the mark registration application.
- b. In the following cases, a sign shall be considered able to cause confusion or mislead to the nature and value of goods and services:
- (i) The sign is a word, picture, image or symbol that gives a misleading impression of properties or utilities of a goods or service, i.e., a sign identical or similar to a mark or another sign used so widely that it has been regarded as being associated with a function or utility of a given type of goods or service and thereby making consumers believe that goods and services bearing the sign also have such function or utility;
 - (ii) The sign is a word or image that gives a misleading impression of composition or ingredients of a goods or service, i.e., a description of another goods or service relevant to the goods or service bearing the sign gives a misleading impression that the goods or service bearing the sign is composed of or has the same nature as the described goods or service.

42. Recognition of well-known marks

42.1 Well-known marks are protected by Vietnamese law in accordance with the provisions of Article 75 of the Intellectual Property Law and Article 6*bis* of the Paris Convention for the Protection of Industrial Property.

42.2 Rights to well-known marks are protected and belong to proprietors of those marks without any registration procedures. Mark proprietors may use documents specified at Point 42.3 of this Circular to evidence their ownership of marks and prove that their marks satisfy the conditions for being considered well-known.

42.3 Documents evidencing the ownership and reputation of a mark may include information on the scope, scale, level and continuity of the use of the mark, including an explanation of origin, history and time of continuous use of the mark; number of nations in which the mark has been registered or recognized as a well-known mark; list of goods and services bearing the mark; the territorial area in which the mark is circulated, turnover from products sold or services provided; quantity of goods and services bearing the mark manufactured or sold; property value of the mark, price of assignment or licensing of the mark and value of investment capital contributed in the form of the mark; investment in and expenses for advertising and marketing of the mark, including those for participation in national and international exhibitions; infringements, disputes and decisions or rulings of the court or competent agencies; surveyed number of consumers knowing the mark through sale, purchase, use, advertisement and marketing; rating and evaluation of reputation of the mark by national or international organizations or the mass media; prizes and medals awarded to the mark; results of examinations held by intellectual property assessment competent organizations.”.

42.4 If the recognition of a well-known mark causes a decision on handling infringement of that well-known mark according to Point d) Clause 1 Article 129 of Intellectual Property Law or a decision on refusal of protection of other well-known mark according to Point i) Clause 2 Article 29 of Intellectual Property Law, that well-known mark shall be recorded in the list of well-known marks kept at the NOIP for purpose of reference in the intellectual property right establishment and protection.

REGULATIONS ON EXAMINATION OF APPLICATION FOR REGISTRATION OF MARKS – Attached to Decision No. 709/QĐ-SHTT of April 29, 2010, of the Director General of the National Office of Intellectual Property of Viet Nam)

2. Terminologies

Terminologies used in these Regulations shall be construed as follows:
[...]

- "Sign" refers to a combination of letters and / or figurative elements presented in the mark specimen in the request for trademark registration;

- "Mark" means a registered sign;
[...]

6. Checking quantity of required documents attached to the Request

6.2.5. An application for registration of a mark containing geographical elements (Article 74.2.d of the Intellectual Property Law).

6.2.5.1. A sign which can identify geographical origin of goods/services is a sign which includes geographical name or image indicating a geographic origin in its combination, such as national emblems, the symbol of a region, map of a region, etc.

6.2.5.2. Geographical name is a name of a continent, country, region, place, ocean, lake, river, mountain, planet, star, galaxy, etc.

6.2.5.3. A sign related to geographical origin may be accepted to register as a collective mark or a certification mark. Application shall include permission of the concerned local government (all *People's Committees* that administer the whole related geographical territory) to allow that applicant to register the element of geographical name, symbol, administrative map for goods and services indicated in the list.

6.2.5.4. It shall not be accepted to register a normal mark in some cases, such as a sign includes only geographical name/image indicating

geographical origin, or the element of geographical name/ image indicating geographical origin is standing out from other elements (taking into account cases in which other elements are none or are few distinctive), or at the stage of formality examination, the geographical name/image indicating geographical origin stands alone as an independent element of the mark specimen.

Above-mentioned geographical name/image indicating geographical origin is a name/image that is identical with respective geographical name/image indicating the geographical origin of Viet Nam and other countries. Administrative geographical name mentioned in this document normally refers to a administrative unit at district level and above, or at lower administrative level, such as a name of a commune, village or hamlet which has reputation with regard to the respective goods/services (for example, “BÀU ĐÁ” which is the name of a market in Binh Dinh province is unable to register as a normal mark for alcohol; “Bát Tràng” which is the name of a village in the suburbs of Ha Noi is not registrable as a normal mark for fine arts and consume pottery, etc.).

It is unable to register a letter sign identical with a foreign geographical name which is widely known or listed in popular dictionaries as a geographical name (for example, Larousse, Longman...) or is widely known via Internet.

6.2.5.5. The following may be registered as a normal marks:

- A sign containing geographical name/image indicating geographical origin does not lead to confusion or describe origin of the product/service, such as a name of a planet (Mars, Venus, the Earth, Sun, etc.), name of a star (Sirius, Northern Star, Morning Star, etc.), galaxy (Milky Way, etc), a name of a continent (Asia, Europe, etc.), a name of a mountain (Hymalaya, Everest, etc.).
- A sign that is both geographical name and a popular word in the normal life (Hòa Bình (peaceful), Thái Bình (peaceful and prosperous), Cộng Hòa (republic), etc.), except for the case that the geographical region bearing that name is famous for the products or services which are identical with products or services listed in the request for protection.
- A name of a geographical area which covers several localities, such as Hồng Hà, Cửu Long, Mê Kông, Trường Sơn, etc.

- A sign containing a geographical name/image indicating geographical origin which is used popularly as a trademark.

6.2.5.6. A sign containing a geographical name/image indicating geographical origin which is used together with other distinctive elements may be acceptable to be registered as a normal mark (certainly, these signs must be the real geographical origin of the products/services):

VIFOOD HA NOI

UNILEVER VIET NAM

CAFE CHIỀU TÀ DAKLAK

DUNHILL

Paris-London-New York

It is unacceptable to register as a normal mark in the following cases:

VIFOOD

HA NOI

It is unacceptable to register a sign that is a geographical name written without diacritics if it can be automatically understood as indication to a specific place:

HA NOI

HA NOI

BAN ME THUOT

A geographical name written without diacritics which is automatically understood as indication to a specific place but is presented as a supplement element just for purpose of indicating the place may be accepted to be an element of the mark but must be excluded from the protection scope:

MELIA

Ha Noi

Bưởi **PHÚC TRẠCH – HA TINH**

TIA SÁNG HAI PHONG

A geographical name written without diacritics which is not automatically understood as indication to a specific place may be accepted to register as a normal mark:

SONG HONG

(It can be understood as either “Sóng Hồng” or “Sông Hồng”)

7. Checking format and contents of documents

[...]

7.2. Requirements for description of mark:

- Composition, components of mark specimen must be identical with the description. If the mark consists of many elements, those elements and their combination must be clearly indicated in the description. If the mark contains figurative elements, contents and significance of those elements (if any) must be clearly specified in the description. If the mark contains letters, words or expressions in languages other than Latin, their pronunciations (transliterated into Vietnamese) must be clearly annotated and their meanings (if any) must be translated into Vietnamese. It is not required to explain elements which are words coined by the applicants, except the case they are not Latin letters.

- If the mark in question is a color mark, such color mark must be clearly stated and its colors must be named.

Example: *Blue, dark blue, light blue, red, orange, yellow brown, red, yellow, green.*

[...]

7.7. Requirements for mark specimens:

In addition to the mark specimens attached to the written Request, nine more identical mark specimens that satisfy the following requirements must be enclosed:

[...]

- For a three-dimensional mark, the mark specimens must be accompanied with a photo or drawing showing the trademark perspective and may be accompanied with a descriptive specimen in projection form (Point 37.5 b of Circular No. 01/2007/TT-BKHCHN of February 14, 2007 of the Ministry of Science and Technology).

- For a colored mark, the mark specimens must be presented with all the colors sought to be registered. In case of not claim to register a colored mark, the mark specimen must be in black and white (Point 37.5 c of Circular No. 01/2007/TT-BKHCHN of February 14, 2007 of the Ministry of Science and Technology).

17. Assessment on the eligibility for protection of a sign

The eligibility for protection of a sign is assessed according to the provisions of Articles 72, 73 of the Intellectual Property Law, Point 39.2 of Circular No. 01/2007/TT-BKHCHN of February 14, 2007 of the Ministry of Science and Technology and it is specified as follows:

The following elements shall be refused for protection even in case of integrating with other elements:

17.1. Non-visible signs: sound, smell, taste, etc.

17.2. Signs being contrary to social ethics and the public order or which do harm to national defense and security (Article 8.1 of the Intellectual Property Law and Point 39.2.b.iii of Circular No. 01/2007/TT-BKHCHN of February 14, 2007, of the Ministry of Science and Technology).

Example:

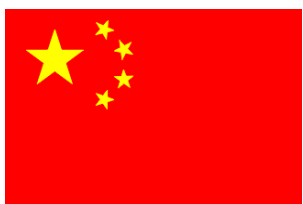
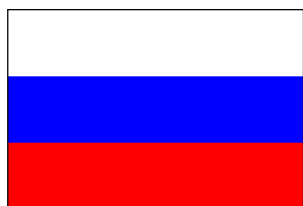
BIN LADEN



(With the sign of swastika)

17.3. Signs identical with or confusingly similar to national flags or national emblems.

Example:



17.4. Signs identical with or confusingly similar to emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese State bodies, political organizations, socio-political organizations, socio-politico-

professional organizations, social organizations or socio-professional organizations or with international organizations, unless permitted by such bodies or organizations.

Example:



MOST



MPI

17.5. Signs identical with or confusingly similar to real names, aliases, pseudonyms or images of leaders, national heroes or famous personalities of Viet Nam or foreign countries.

Example:

HỒ CHÍ MINH

ISAAC NEWTON

17.6. Signs identical with or confusingly similar to certification seals, check seals or warranty seals.

Example:



ISO

17.7. Signs which cause misunderstanding or confusion or which deceive consumer as to the origin, properties, use, quality, value or other characteristics of goods or services.

Example:

SẢN XUẤT TẠI CHÂU ÂU

(for those goods manufactured outside EU)

MADE IN U.S.A

(for those goods manufactured outside the US)

17.8. A mark shall be deemed to be distinctive if it consists of one or more easily noticeable and memorable elements, or of many elements forming an easily noticeable and memorable combination.

17.8.1. Assessing the distinctiveness of signs in the form of letters, numbers (sign in characters) shall follow provisions of Article 74.2 of the Intellectual Property Law and Point 39.3 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology.

The following elements of letters shall be deemed not to be distinctive:

a) Characters in a language that Vietnamese customers with ordinary knowledge cannot notice and remember (cannot read, understand, and remember) namely non-Latin originated characters: Arabic, Russian, Sanskrit, Chinese, Japanese, Korean, Thai and so on; except the case when the characters in the above-mentioned languages going with other elements to make up a general combination which can be distinctive or can be presented in form of graphics or other special forms.

Example:

荏原

ς Ω Σ

b) Though being Latin-originated characters, the sign is just a letter or a number, or the sign is a combination of two letters but it is impossible to read as one word – even going with a number; except when this combination is presented in form of graphics or in other special forms.

Example:

BT AA DC2

c) A combination of many letters (even figures) or words that is unable to notice and remember, for example a sequence including many orderless/ruleless characters or a document, a paragraph.

Example:

BGMHCK

d) Though being Latin-originated characters, it is a meaningful word and its meaning has been widely used and become so popular in relevant field in Viet Nam that gradually loses its distinctiveness.

Example:

NYLON (vải sợi)

e) A word or a combination of words used in Viet Nam as generic name of the related goods or services.

Example:

HOTEL INN RESORT
(hotel services, accommodation services)

PERFUME COSMETIC
(perfumes, cosmetics)

g) A word or a combination of words with the contents describes the goods/service, for example, signs leading to the time, place, geographical origin (except the case where a mark is registered as a collective mark or

a certification mark relating to the geographical origin of the product), production method, type, quantity, quality, characteristics (except the case where a mark is registered as a certification mark for certifying the quality of goods/services), ingredients, value of the goods/services.

Example:

CÔNG NGHỆ ĐỨC
CHẤT LƯỢNG NHẬT BẢN
(for the products corresponding with this contents)
EXCELLENT PERFECT
TỐT BỀN
DỊCH VỤ CHẤT LƯỢNG CAO

h) A meaningful word or a combination of words describes legal form, business areas of the trademark owner.

Example:

GROUP TẬP ĐOÀN
CO., LTD. CÔNG TY CỔ PHẦN

i) A word or a combination of words that is widely used;

Example:

INTERNATIONAL GLOBAL

k) Word signs cause confusion and misleading consumer about the origin, function, use, quality, value or other characteristics, such as composition, producing progress, materials, pre-eminence of products or services in accordance with Article 73.5 of the Intellectual Property Law.

Example:

CÔNG NGHỆ ĐỨC

CHẤT LƯỢNG NHẬT BẢN

(for products corresponding with this content)

17.8.2. Assessment of distinctiveness of figurative and image signs (hereinafter referred to as "figurative sign") shall follow Article 74.2 of the Intellectual Property Law and Point 39.4 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology.

Figurative elements are considered not able to distinguish, if:

a) Shapes or normal geometrics such as circles, ellipse, triangle, quadrangle, etc. or simple drawings; images/photos only used as background or decorative lines for products and product packages.

Example:



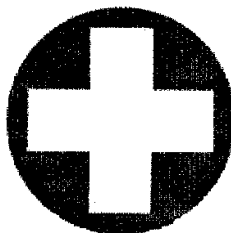
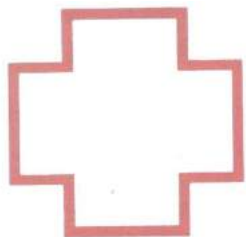
b) Too complicated drawings, images that are difficult for consumer to recognize and remember their characteristics, such as combination of many images, combined lines or overlapping lines.

Example:



c) Pictures, images, logos, symbols that are widely used:

- Traffic signs
- Symbol “Red Cross” of public health

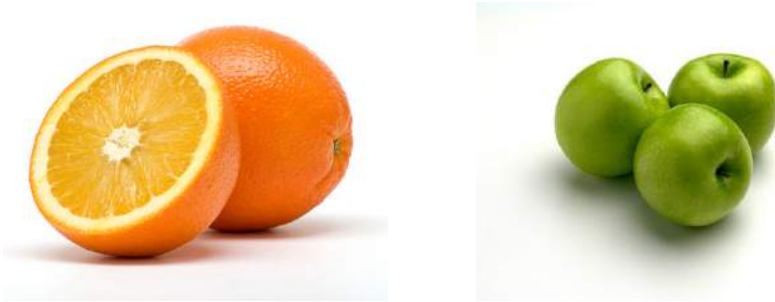


- A gear for mechanical engineering
- A snake wrapped around a bowl for pharmacy



d) Common pictures, images of the products

Example:



for fresh oranges, apples

e) Pictures, images mainly describing products, services bearing the trademarks

Example:



for orange-juice

g) Pictures, images that cause consumer confusion and mislead about the origin of products/services

Example:



Eiffel Tower for products/services originated outside France



Kremlin for products/services originated outside the Russian Federation

17.8.3. Assessment of distinctiveness of a combination of images and words (hereinafter referred to as "combined sign") shall follow Article 74.2 of the Intellectual Property Law and Point 39.4 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology.

A combined sign is considered distinctive when the combination of word and figure elements has distinctiveness. Details are as follows:

- a) Both word and image elements have distinctiveness and combined into a combination with distinctiveness as well.
- b) The main element of a sign (element that has strong impact on consumer's sense and impresses attention) is a word or image element with distinctiveness, although the rest has no or less distinctiveness.

Example:



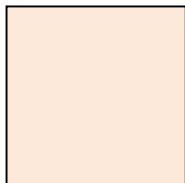
c) In case of a combination of word and image elements with no or less of distinctiveness but the combination is unique so it is still considered as distinctive.

Example:



d) A combination of word and image elements with no or less distinctiveness that obtains distinctiveness in progress of use in accordance with Point 39.5 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology.

Example:



17.8.4. Assessment of possibility to apply exceptions under Article 74.2 of the Intellectual Property Law and Point 39.5 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology:

a) Signs under the cases mentioned in Points 39.3.a, 39.3.b, 39.3.c, 39.3.g, 39.3.h, 39.4.a, 39.4.b, 39.4.c, 39.4.d, 39.4.e of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology that have been used with functions as trademarks and are widely known by consumer and by thus obtaining distinctiveness for related products/services.

Example:

BP (gasoline) **P/S** (toothpaste)

b) In applying these exceptions, the applicant must provide evidences of wide-spread use of his/her trademark (starting time of use, scope and level of current use, etc. in which the trademark is only considered as “used” through activities of manufacture, selling, trade, advertisement and marketing in accordance with the law) and evidence of trademark’s distinctiveness related products/services of the trademark owner. In this case, the trademark is only recognized to have distinctiveness when it is presented in the popular form that used for a continuous period of time, in practice.

20. Assessment of distinctiveness based on searched references under Point 39.8 of Circular No. 01/2007/TT-BKHCN of February 14, 2007 of the Ministry of Science and Technology

In order to assess the distinctiveness between the sign requested for registration and the searched references, the examiner shall undertake comparison of structures, pronunciation (for word signs), meaning (content) and form of expression (for both figure and word signs), and also undertake comparison of products/services bearing the sign requested for registration and products/services bearing the references.

20.1. A sign shall be considered as identical with the references if structures, meanings (contents) and forms of expression of the signs and references are exactly identical.

20.2. A sign shall be considered as similar with references if:

20.2.1. Structures and/or pronunciation and/or meanings (contents) and/or forms of expression of the sign and references are closely identical that easily leading consumer to confuse that they are one, or this version is the other's variant, or they have same origin.

20.2.2. A sign shall be considered as similar with its reference in terms of structure if structure of the sign contains the whole or main part of the reference and this containing is significant component of the sign (i.e, the sign formed by adding new secondary parts to the reference or to the main part of the reference; or by removing secondary parts out of the reference; or by changing secondary parts of the reference).

a) Normally, for polysyllabic signs or really long signs, different parts of signs have different values. The part with high-level distinctiveness shall be the main part, the rest with lower level distinctiveness shall be the secondary part. The main part usually is unique with special pronunciation (normally are invented words). The identicalness in main parts usually leads to signs' similarity. Secondary parts, more or less, have descriptive character (e.g.: New, Neo, Gold, Super, etc.) or have low-level distinctiveness or have consumer low-level distinctiveness because of often use (e.g.: System, Club, Fashion, etc.), or are popular suffix (e.g.: ol, in, ic, il, etc.). Secondary parts cannot cause similarity by themselves but they may increase level of similarity when stand together with similar parts.

Example:

and **NEO NESTLÉ**
SUPER NESTLÉ

and **KODAK GOLD**
KODAK TROPICAL

and **CHANELMODE**
CHANELFASHION

and **METRININ**
METRINOL

(identical in part of "METRIN-", differences are only -IN and -OL which are popular suffixes)

and **TÂN** **HÒA HẢI**
HÒA HẢI

(All underlined parts are main part (or original word))

b) The main part (or original word) may be used as ground to form a trademark series of the same owner.

A sign of one person has main part which is identical with main part of a trademark series owned by the other person and causes confusion of consumers about the trademark owner, this main part may be words and/or images.

Example:

a trademark series: **JASTOMIN, JASTOMINING, JASTOMINIC**

c) When a sign is contained in the other one, and if the early sign constitutes the main part of the latter (e.g. a unique invented word), the ability of similarity of two signs is very great, even if the latter containing another main part.

Example:

and **XEROX**
and **XEROXMATE** (together with a secondary part)
or **XEROX BELIS** (together with another main part)

If the early sign is the secondary part of the latter, the similarity is hard to cause.

Example:

The three following signs for tobacco are considered as distinctive:

CLUB
PACIFIC CLUB
AMERICAN CLUB

d) When the word signs are names of human beings:

- Names of European – American people: it is necessary to note that names of European - American people normally include names (first name) and surnames (family name) in which the number of names is very few while the number of surnames are more diversified. Therefore, in general, surnames are more unique than names, so in case of identical surnames may usually lead to the similarity.

Example:

and WINDERMAN
PETER WINDERMAN

If names are identical, the ability of similarity is low.

Example:

and PETER
PETER WINDERMAN

and ROBERT KENEDY
ROBERT FORD

* **Note:** Unique or rare names can bring distinctiveness to the signs.

- Vietnamese names: Names of Vietnamese people (and names of people in some other countries) have opposite features with the European-American people as the number of surnames is limited and number of names are diversified, so names (including middle names) have higher distinctiveness. Therefore, if surnames are identical, the ability of similarity is low.

Example:

and NGUYỄN
NGUYỄN THÁI BÌNH
NGUYỄN KIM

and NGUYỄN THÀNH

If names (including middle names) are identical normally lead to the confusion.

Example:

and PHAN THANH TÔNG
THANH TÔNG

However, if a full name consists of only two words of which one word is different, the distinctiveness is still capable:

Example:

and LÊ LAN
LÝ LAN

e) Signs which are in different writings but are the same when pronounced by one of the popular languages in Viet Nam, may cause similarity.

Example:

and SUNSEAT
SUNSIT

and SERCUIT
SERKIT

g) Some special cases of signs in Vietnamese language:

- Two signs in Vietnamese language that are identical in characters but different in accents shall be considered as similarity.

Example:

and SAO VÀNG
SÁO VÀNG

and KIM HƯNG
KIM HÙNG

(This rule is applied to avoid the use of signs that are closed to a registered trademark by identical characters together with change in accents caused similar optical effect).

- Two signs that are different in writing but have same pronunciation of people in large region of Viet Nam shall still be considered as similarity.

Example:

and **THÀNH LIÊM**
 THÀNH LIM

and **MINH NHẬT**
 MINH NHỰT

and **HẠNH PHÚC**
 HẠNH PHƯỚC

and **NGỌC CHINH**
 NGỌC TRINH

h) Two figure signs that are presented similarly, or have similar main elements (including both two-dimensional or cubic figures) shall be considered as similarity.

Examples:

The image of sunrise from the sea with sin-wave light rays may be considered as similarity with an image of sunrise from the land with straight light rays (different presentation s but the same sense of sunrise).

20.2.3. A sign is considered as similarity in meaning with the cited references if both of the main part of the sign and the cited reference have same content, refer to one subject (thing, phenomenon, concept), or if both sign and the cited reference focus on two similar objects.

a. If two signs shall be considered as similarity if they are written in different forms but have the same meaning in Vietnamese or in one popular foreign language in Viet Nam, such as English, French, Russian or Chinese (because in the past, four languages of English, French, Russian and Chinese were considered as popular foreign languages and required consideration during the examination in addition to the Vietnamese language; and trademarks purely in Russian and Chinese might be registered)

Examples:

WHITE FLOWERS - FLEURS BLANCHES

ORIENT - БОЦТОК - PHƯƠNG ĐÔNG

or having the same meaning in Vietnamese or Chinese-Vietnamese (popular meaning)

Examples:

CÁI HÒM	-	CÁI RỪNG
THUYỀN	-	GHE
KIM TINH	-	SAO VÀNG
BẠCH MÃ	-	NGỰA TRẮNG
TOÀN MỸ	-	HOÀN MỸ

Two signs might be considered as confusingly similar if they are written in different forms but have the same or contrary meanings (in some certain cases).

Examples:

MINI-SHIP and MINI BOAT

(con tàu nhỏ - a little ship and con thuyền nhỏ - a little boat)

LA VACHE QUI RIT and LAVACHE SERIEUSE

(bò cười - smiling cow and bò nghiêm nghị - grave-looking cow)

b. Two signs may still have distinctiveness if they have many identical characters but have two clearly different meanings.

Examples:

THREE (ba, số 3 - three, the number)
and **TREE** (cây, trồng cây - plant, planting trees)

SEE (thấy, nhìn thấy - see, visibility)
and **SEA** (biển - sea)

c. If two signs have difference in meaning (e.g. images of tiger and lion) but both of them are unique expressed with shoes on foot and hat on head, **the ability of similarity is very high.**

d. Two figure signs have similar meaning (e. g. both indicate the image of elephant, ship, the chef, etc.) but are expressed in different unique ways, might be considered as distinctiveness (e.g. image of a normal duck vs. image Donald Duck of Walt Disney, or image of an elephant's head vs. image of elephants; each image is are able to distinguish with other).

* **Note:** Such case shall not be applied to a well-known figurative reference as by that all figure signs shall make sense of cited reference's meaning and usually lead to confusion and make a decision on similarity.

e. A character sign may be similar to a figure sign (or vice versa) if they have the same concrete meaning (e.g. the cited reference is a well-known mark, or a good reputation mark in the market, or a unique mark, or a mark with small quantity, etc.)

Examples:

MẶT TRỜI or **SUN** with image of the sun

CON VOI or **ELEPHANT** with image of elephant

Condition: goods bearing the marks must be identical.

Examples:

word "Vịt **DONALD**" and image of the Donald Duck

g. However, two figure signs which have same general meaning and different in specific meanings, may have distinctiveness.

Examples:

CON CHIM and image of a pigeon
(Pigeon is a bird in general but it belongs to a specific kind of bird)

BÔNG HOA and image of a rose
(Rose is a flower in general but it belongs to a specific kind of flower).

h. Two figure signs which express a same meaning and have similar expression with different quantity, shall be considered as confusing similarity.

Examples:

Image of **an eagle** and image of **many eagles**

Image of **a rose** and image of **many roses**

20.2.4. A sign may be considered as confusingly similarity with the cited reference if the whole or the main part of the sign and the whole or the main part of the cited reference are expressed in the same way, in which color of the sign/cited reference is considered as an element of stylized expression.

- a. Common graphic sense that already took into account types of characters, unique expression layout of characters.
- b. Color of characters;
- c. If colors are the main parts of two signs, the color similarity and color arrangement can cause the similarity between those signs;
* **Note:** In some cases, graphic and color expressions do not play a key role, but those expressions can contribute to increase or reduce the similarity between two signs.
- d. Two signs that are ideographic characters of a unpopular language in Viet Nam, their similarity assessment shall be carried out just between two figure signs.

20.2.5. “The main part of sign/cited reference” means a factor or a combination of factors that create a part of the sign/cited reference and make the biggest effect to on the senses of consumer, attract their impression when facing to the goods/services. Such sign/reference may comprise two and several main parts.

20.2.6. A sign causes confusing similarity with the cited reference if it is merely a transliteration or translation of the reference;

20.2.7. The assessment of similarity of a sign shall be conducted in all aspects, such as: syllables, semantics, word structure, graphic expression as well as commercial impression (consumer's impression during the consumer trade progress); **This sign might cause enough confusion to the consumer even if both the sign and the cited reference are similar in only one aspect.**

a. Two signs shall be considered similar if their corresponding character and figurative parts are similar, or those parts create a similar in overall.

b. Two signs contain similarity, more or less, in character or figurative parts, while the rest of them having high distinctiveness, in overall, there is a distinctiveness between them.

c. However, it shall be noted that: In a combined sign, the character part plays more important role in distinctiveness than the figure part because in addition to the visibility, character part can be audible to the consumer through oral transmission or means of mass media.

d. Comparison of the sign under examination with another reference
During the examination of a sign, it is necessary to conduct the consideration of possibilities of its identicalness and similarity with all cited references, in details as follows:

* Between a character sign – with:

- other character signs (in relation to word structure, pronunciation, meaning, art expression);
- figure signs (in relation to art expression, meaning);
- combined signs (in relation to word structure, pronunciation, meaning/significance, art expression)

* Between a figure sign – with:

- other figure signs;
- character signs (in relation to art expression, meaning);
- combined signs (in relation to art expression, meaning/significance)

* Between a combined sign – with:

- character signs (in relation to word structure, pronunciation, meaning, art expression);
- figure signs (in relation to art expression, meaning);
- other combined signs (in relation to word structure, pronunciation, meaning/significance, art expression)

e. Case of which the sign is considered similar with a well-known trademark

A well-known trademark usually is significantly distinctive with wider range of impressive and powerful than a normal trademark, therefore, it should be noted that:

- The assessment of similarity between a sign and a well-known trademark should be carried out more strictly than the assessment with a normal reference, because the similarity to a well-known trademark usually causes confusions to the consumer.
- A sign that is similar to a well-known trademark might not be registered also for goods/services that are dissimilar to goods/products bearing the well-known trademark.

g. A sign which contains character or figure elements that are confusingly similar to a registered character or figure element with earlier filing date/priority date, shall be considered to have distinctiveness after moving out such confusingly similar elements.

20.2.8. If main parts of the sign and the cited reference are similar, the sign shall be considered as confusingly similar to the cited reference. With reference to the secondary part, the similarity shall be increased or reduced based on the specific representation of the color.

21. Similarity assessment of goods and services

Issue of goods/services is one another key element may cause the confusing similarity.

21.1. Two goods or two services shall be considered identical if those goods/services are under a category (motorbike, bicycle, hotel service, hotel service with parking area; restaurant service, beverage services,...)

21.2. Two goods or two services shall be considered as similar if those goods/services;

21.2.1. Having the same nature (composition, structure, etc.) **or** having the same function and utility purpose; (pants, shirts, shoes, sandals; cosmetics, make-up cream; etc.); **or**

21.2.2. Having almost the same nature **and** having the same function and utility purpose (noodles; beers, alcohols; shirts; bricks, tiles; etc.); **or**

21.2.3. Having similar nature (cocoa, chocolate, coffee; cakes, jams, candies; etc.); **or**

21.2.4. Having similar function, utility purpose (cosmetics sales service, beauty salon service; glue used for industries, household glue, etc.); **and**

21.2.5. Entering the market by one commercial channel (distribution by one method, sale together or side by side, sale in one type of shop, etc.); (fish sauce, soy sauce, salts; incense, votive papers; blankets, cushions, mattress; etc.); **or** are used together (toothpaste, toothbrushes)

21.3. A good or service is considered as similar if it falls into one of the following cases:

21.3.1. Having relation in nature (goods, service or raw materials, component of this goods/services is composed from the other goods/service); (motorbike, motorcycle assemble service, clothes, tailor service; etc.);

21.3.2. Having relation in function (in order to carry out function of this goods/service, it is necessary to use the other goods/service, or they are usually used together); (pharmaceuticals, sale drugs/medicine; gold and silver, sale gold and silver; etc.);

21.3.3. Having close relation in implementation methodology (this goods/service is the result of the use or exploitation of the other

goods/service); (computer software, computer software design; telephone, post and telecommunication service; etc.).

22. Assessment of possibilities of confusing similarity

The following cases shall be considered to cause confusing similarity to the consumer:

- Identical sign and identical goods/services;
- Identical sign and similar goods/services;
- Similar sign and identical goods/services;
- Similar sign and similar goods/services.

In case a well-known trademark is used as the reference, the ability of causing confusions to the consumer that the sign is from the same origin or is related to the well-known trademark, even for different and dissimilar goods/services.

Examples:

The consumer may believe that trademark HONDA used for confectionery and the well-known trademark HONDA used for cars and motorcycles belong to one trademark owner, or that two trademark owners have a relationship with each other.

23. A cited reference with less similar trademark specimen and more similar list of goods and services **may** cause confusion to the consumer. A cited reference with more similar trademark specimen together with a very less similar list of goods and services **may not** cause confusion to consumer.

24. A sign upon its protection as a trademark shall not infringe prior legitimate rights relating to other subjects. Among those subjects, rights relating to copyright, industrial designs and geographical indications are near and easy to cause conflict with the rights relating to trademarks. A sign requested for registration, if necessary or upon enough necessary information, must be compared with subject matters protected according to laws on copyright, industrial design, geographical indications with an earlier filing date/priority date.

25. Conclusion on possibility to protect the sign

A sign is considered to have possibility to be protected as a trademark if:

- the sign or its remains after removing out elements according to Point 17 (if any) has distinctiveness with references; or
- after removing out all identical or similar goods/services, the sign has distinctiveness with references.

Annex 2

[...]

3. A word trademark contains a geographical name and descriptive components but is written consecutively: in case of consecutive writing but the separation is created by using different colors and/or different types of characters; the consecutive writing with clear description should be refused (BESTCARE, SUPERQUALITY ...).
4. If a popular component is accepted for several applicants (e.g. CLARI) and the trademark requested for registration is confusingly similar with one/several registered trademark(s) (containing such popular component) and the supplement is also pronounced with similar sounding, the object should be considered to refuse (CLARITRA and CLARITHRO).
5. If the word structures are different by adding consonant/vowel like the adjacent consonant/vowel, the ability of similarity is high (CEMMA and CEMAAR; EVIT and ENVIT).
6. If the word structures are confusingly similar with dashes (-) between components that cause confusingly similar in word structure and should be refused (GIRL-OK is confusingly similar with GYRLOK and GINLOK).
7. A combination of a word has meaning and a component has no meaning can be refused by a cited reference is a word has meaning (FUSION BY STEPPER is refused by cited reference of FUSION and/or STEPPER that depends on the unique of that word has meaning, if the word has meaning is not strong enough or is generic, both words may be coexistence, such as CLUB and CUB OF BLACK SEA).

[...]

10. If the opposition based on a prior trade name: the examiner shall notice the applicant about the request for opposition against the grant of a certificate, concurrently, the examiner shall request the person who filed the opposition to prove his/her right over the trade name (grounds for the opposition) through the use (if this information has not yet to expressed fully in the letter for opposition against the grant of a certificate at the first filing).
11. If the trademark application requests for registration in several classes and the exclusion is only suitable for one/some class(es) and/or one/some goods, it may apply the exclusion for one/some class(es) of goods and/or one/some certain goods (this exclusion is presented in both Notification and Decision on granting the certificate for trademark registration).

[...]

13. The following cases should be paid attention:

- The drug is understood as for human use only.
- The drug and supplement food are similar products.
- The drug and pesticide – basically are dissimilar.

14. The following cases should be paid attention:

- Mark Hồng Đào of class 44 shall be referred for refusing the mark Hồng Đào of class 3, and shall be referred for considering as similar for mark of classes 30 and 43 or class 33 and 43.
- Mark Hồng Đào for cosmetics shall be referred for refusing the mark Hồng Đào for dish washing liquid;
- The mark requested for registration of one/some product(s) that is/are not refused by cited reference of sale service/supermarket (class 35) except for the sale of only that product(s).

The said cases are general examples, however, such cases still cause confusion if the cited reference is a famous trademark and/or a trademark that is used widely or has reputation in Viet Nam and/or a trademark containing a very unique component/sign. The examination result of each case shall depend on evidences or the proof of related party(ies).

15. Mark TULINA for plant protection drug shall not be refused by reference of mark TULINO for pharmaceuticals.
16. Mark TULINA for plant protection drug shall be refused by reference of mark TULINA for pharmaceuticals.
17. Mark VINABABY for soap, perfume, cosmetics (class 3) shall not be refused by reference of mark VINABABY for pharmaceuticals (class 5) and/or mark VINALADY for same products of class 3.
18. Mark TORAMIDE shall be refused by reference of TORMIDE; mark TORAMIDE shall be refused by reference of TONEMIDE (for pharmaceuticals also) as they are similar on structure and pronunciation.
19. Mark VITAFORLUX shall be refused by reference of VITALUX (for pharmaceuticals also).
20. Mark CUBICIN shall not be refused by reference of CULBICEF; it is also applied to the case of PICEROM and PICENROX.
21. Mark AMECINECAP shall be refused by reference of AMMELCIN.
22. Mark TNC BOOST shall not be refused by reference of BUD BOOSTER (for fertilizers also).
23. Mark BILAF shall be refused by references of DILAF, β -LAF (for pharmaceuticals).
24. Mark TNC – FENOCA shall be handled as mark TNC FENOCA.
25. If marks VINAGAME, VIỆTGAME are accepted for registration in class 9, excluding component of 'game'.
26. Mark VINAROMA may be accepted for registration, but the mark VinaRoma is refused in accordance with Point 73.5 if address of the applicant is outside Italy.
27. The whole of mark PROSOL YUCA shall be refused by reference of PROSON (not refuse only component of PROSOL).

28. A mark containing component of ORIGAMI requested for registration in Class 16: paper-folding-art of a Vietnamese applicant: the component of Origami shall not be refused by the reason of “name of paper-folding-art or paper-folding method of Japan that cause confusion for consumer about the origin of product” in accordance with Article 73.5 of the Intellectual Property Law.
29. If there are several references relating to the confusing similarity of one owner, the examiner can use only some references of that (if reasonable) for the intended refusal/refusal of registration.
30. If there are several references relating to the confusing similarity of different owners, the examiner should use these references (and apply Item 29 above if reasonable) for the intended refusal/refusal of registration.
31. Mark AIRPORT BUSINESS CENTER of Công ty TNHH kiến trúc thiết kế A cu ra ta in Class 42: consultant service in architecture; establishment of construction drawings, shall be refused in accordance with Article 73.5 of the Intellectual Property Law.
32. Mark MINSUPER H5000 for pharmaceuticals: use of pharmaceutical brands of different owners, the component MIN that is presented in relatively independent form could be used for refusing the trademark requested for registration.
33. Mark NAM GIANG that is identical with name of commune in the applicant’s address, in addition, Nam Giang also is the name of a district in Quang Nam Province: the mark shall not be refused on the ground of geographical name according to the Intellectual Property Law.

[...]



ANNEX II

**WEBSITES OF LEGAL PROVISIONS
RELEVANT TO THE SUBSTANTIVE
EXAMINATION OF MARKS**

BRUNEI DARUSSALAM

<http://www.bruipo.gov.bn/SitePages/legislation.aspx>

CAMBODIA

www.cambodiadip.gov.kh

www.moc.gov.kh

<http://www.cambodiaip.gov.kh/TemplateTwo.aspx?parentId=43&menuId=43&childMasterMenuId=43>

INDONESIA

<http://www.dgip.go.id/merek>

LAO PDR

<http://www.most.gov.la.wipo.net/law/index.html>

MALAYSIA

General Information on Trade Mark:

<http://www.myipo.gov.my/web/guest/cap-umum>

Trade Marks Act and Regulations:

<http://www.myipo.gov.my/web/guest/cap-akta>

Manual of Trade Marks Law and Practice in Malaysia:

<http://www.myipo.gov.my/cap-panduan>

MYANMAR

http://www.most.gov.mm/index.php?option=com_frontpage&Itemid=1

PHILIPPINES

Intellectual Property Code:

<https://drive.google.com/file/d/0B2or2OrWYpIfN3BnNVNILUFjUmM/view?ts=58057027>

Trademark Law:

<http://www.ipophil.gov.ph/images/IPResources/IPCodePartIII.pdf>

Trademark Regulations:

<https://ipophil.gov.ph/images/2017Uploads/IPOPHL-Memorandum-Circular-No.-17-010-Rules-and-Regulations-on-Trademarks-Service-Marks-Trade-Names-and-Marked-or-Stamped-Containers-of-2017.pdf>

Trademark Information:

<http://www.ipophil.gov.ph/index.php/trademark>

SINGAPORE

<https://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>

THAILAND

http://www.ipthailand.go.th/en/index.php?option=com_content&view=article&id=53&Itemid=169

http://www.ipthailand.go.th/en/index.php?option=com_docman&task=category_view&gid=114&Itemid=169

VIET NAM

<http://www.ipvietnam.gov.vn/en/web/english/home>

IP Laws:

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/\(a gntDisplayContent\)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(a gntDisplayContent)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB)

IP Governmental Decrees:

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/\(a gntDisplayContent\)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(a gntDisplayContent)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627)

IP Ministerial Circulars:

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/\(a gntDisplayContent\)?OpenAgent&UNID=D2945788E58A233F4725767200221575](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(a gntDisplayContent)?OpenAgent&UNID=D2945788E58A233F4725767200221575)

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ANNEX III

CONTACT DETAILS OF IP OFFICES OF ASEAN MEMBER STATES

BRUNEI DARUSSALAM

Brunei Intellectual Property Office (BruIPO)
Attorney General's Chambers

Address:

Level 2, Knowledge Hub,
Simpang 32-37
Anggerek Desa Technology Park, Jalan Berakas
Bandar Seri Begawan BB3713, Brunei Darussalam

Phone: (673) 238 0966

Email: tm.application@bruipo.gov.bn

Website: <http://www.bruipo.gov.bn>

CAMBODIA

Intellectual Property Department (IPD)
Ministry of Commerce

Address:

Russian Federation Blvd, Toeuk Thla Village
Sangkat Sen Sok, Khan Sen Sok
Phnom Penh, Cambodia

Phone: (855) 23 866 115 or (588) 11 888 969

Email: cambodiaip.dip@gmail.com

Website: <http://www.cambodiaip.gov.kh>

INDONESIA

Directorate General of Intellectual Property
Ministry of Law and Human Rights

Address:

Jalan H.R. Rasuna Said Kav. 8-9
Jakarta 12940, Indonesia

Phone: (62 21) 57905517

Website: <http://www.dgip.go.id/>; <http://laman.dgip.go.id/>

LAO PDR

Department of Intellectual Property
Ministry of Science and Technology

Address:

P.O. Box: 2279, Nahaidiew Road,
Vientiane Capital, Lao PDR

Phone: (856) 21 253111

Website: <http://www.most.gov.la/index.php?lang=en>

MALAYSIA

Intellectual Property Corporation of Malaysia (MyIPO)

Address:

Unit 1-7, Ground Floor Tower B, Menara UOA Bangsar
No. 5 Jalan Bangsar Utama 1
59200 Kuala Lumpur, Malaysia

Phone: (603) 2299 8400

Website: <http://www.myipo.gov.my/en/myipo/>

MYANMAR

Intellectual property Department
Department of Research and Innovation
Ministry of education

Address:

Building No. 21
Ministry of Education
Nay Pyi Taw, Myanmar

Phone: (95 67) 404507

Website: <http://www.moe-st.gov.mm>

PHILIPPINES

Intellectual Property Office of the Philippines (IPOP HL)

Address:

Intellectual Property Center, 28 Upper McKinley Road,
McKinley Hill Town Center, Fort Bonifacio
Taguig City 1634, Philippines

Phone: (63 2) 2386300

Website: <http://www.ipophil.gov.ph/>

SINGAPORE

Intellectual Property Office of Singapore (IPOS)

Address:

1 Paya Lebar Link #11-03
PLQ 1, Paya Lebar Quarter
Singapore 408533
Singapore

Phone: (65) 63398616

Website: <https://www.ipos.gov.sg/>

THAILAND

Department of Intellectual Property
Ministry of Commerce

Address:

563 Nonthaburi Rd., Bang Krasor,
Muang, Nonthaburi 11000, Thailand

Phone: (66 2) 547 4621 to 5

Website: <https://www.ipthailand.go.th/en/home-eng.html>

VIET NAM

Intellectual Property Office of Viet Nam (IP Viet Nam)
Ministry of Science and Technology

Address:

386 Nguyen Trai St., Thanh Xuan Dist.
Ha Noi, Viet Nam

Phone: (844) 3558 8217 or 3858 3069

Website: <http://www.noip.gov.vn/web/noip/home/en>

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