



Shape Trade Marks – An International Perspective

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IPO International Trademark Law and Anti-Counterfeiting Committee

This paper was created by the authors for the Intellectual Property Owners Association International Trademark Law and Anti-Counterfeiting Committee to provide background to IPO members. It should not be construed as providing legal advice or as representing the views of IPO.

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INTRODUCTION

The purpose of this White Paper is to review possible criteria guiding both OHIM and IP Offices from countries around the world regarding Shape Trade Marks.

Article 6(1) of the Paris Convention states in respect of Trade Marks that: *“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation”*.

Article 15.1 of the TRIPS Agreement states that a Trade Mark should be defined as: *“any sign capable of distinguishing the goods or services of one person from those of other persons”*. The basic test for registrability should be defined in a way that provides guidance on its application.

The developments in marketing and technology throughout the world had already been recognised in the General Agreement on Tariffs and Trade (GATT) discussions and by the European Communities (EC) by 1992 and it had been decided that Trade Mark legislation should cater for a wider range of “signs” than had previously been considered capable of functioning as Trade Marks. These developments were soon introduced into the draft legislation of a number of member countries.

It was considered, in relation to the shape and packaging of goods, that there was support for the proposition that if the sign constituted some element of the shape or the packaging of the product, and if the Applicant could demonstrate that that element was not necessary for the proper functioning, or did not result from the nature of the product or its packaging, then it should be capable of registration.

Accordingly, the existing definition of “*sign*” in the old legislation was amended to comply with TRIPS Agreement principles. For example, in Australia, the word “sign” was redefined as follows:

“‘Sign’ includes a word, name, signature, letter, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, or any combination thereof.”

The inclusion of “shape” in the definition of “sign” stands against the suggestion that it can never be an attribute separate from the Goods to which it relates. The inclusion mandates consideration of shape as a distinctive attribute, although not a necessary feature of the particular Goods. Where shape serves function, then it may not bear that character of a distinctive attribute. It is clear that the context in which Shape Trade Marks are used will affect the scope of protection that they offer.

We need to ask what the legislation requires of shapes that would be Trade Marks. In order to be a Trade Mark, a shape must be used to distinguish 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. That definition is entirely consistent with the idea of “shape” as an attribute of Goods, which distinguishes them from others. It should therefore not be read down to cover only some aspect of the physical configuration of Goods and indeed, the shape which distinguishes the Goods may in

fact be their shape taken as a whole.

Australian Federal Court Judge, Burchett J, observed in relation to Shape Trade Marks as follows:

“It does not follow that a shape can never be registered as a trade mark if it is the shape of the whole or a part of the relevant goods, so long as the goods remain distinct from the mark. Some special shape of a container for a liquid may, ..., be used as a trade mark, just as the shape of a medallion attached to goods might be so used. A shape may be applied ... in relation to goods, perhaps by moulding or impressing, so that it becomes a feature of their shape, though it may be irrelevant to their function. Just as a special word may be coined, a special shape may be created as a badge of origin. The special cases where a shape of the goods may be a mark are cases where the shape that is a mark is ‘extra’, added to the inherent form of the particular goods as something distinct which can denote origin. The goods can still be seen as having ‘an existence independently of the mark’ which is imposed upon them.

It is not that the addition of the word ‘shape’ to the statutory definition calls for some new principle, or that a ‘shape’ mark is somehow different in nature from other marks, but that a mark remains something ‘extra’ added to distinguish the products of one trader from those of another, a function which plainly cannot be performed by a mark consisting of either a word or a shape other traders may legitimately wish to use. That proposition has commonly been stated in connection with marks that seek to appropriate the actual name of the product or an apt description of it; but the principle equally applies in the case of a shape or picture representing the very form and appearance in which another trader might legitimately wish to make the product.”

This differs from the position in the United States where, for example, in *Wal-Mart Stores Inc v Samara Bros Inc* 529 US 205 (2000) (“Wal-Mart”), Justice Scalia delivered the opinion of the United States Supreme Court, stating (at 213):

“In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.”

Accordingly, in the United States, where a mark induces consumers to buy for a reason other than designation of a particular trade source, it will be seen by them as part of “the Goods”, rather than as a Trade Mark “in relation” to the Goods. In such a case, consumers will perceive that the Mark has value for a reason other than as a badge of origin. In *Wal-Mart*, the United States Supreme Court stated in the present context (at 215):

“a classic glass Coca-Cola bottle, ... may constitute packaging for those consumers who drink the Coke and then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those

consumers who buy Coke in the classic glass bottle, rather a can, because they think it more stylish to drink from the former.”

While the United States does not yet allow for the registration of Shape Trade Marks, its near neighbor, Canada, has recently passed amendments to the *Canadian Trade-marks Act*, which have been passed, but not yet implemented. These amendments introduce significant changes to the requirements and practice with respect to the registration of “distinguishing guises” in Canada. It will be interesting to watch developments in the United States on this aspect of Trade Mark Law.

The following paper has been prepared following a survey of laws concerning Shape Trade Marks in developed and developing legal markets and provides an overview of the current legal framework in each of those countries for the purposes of bringing the position on this topic to the attention of the IPO Membership.

The various Reports from around the world have been gathered by Members of the International Trade Marks and Anti-Counterfeiting Committee of the IPO and have been compiled by its Chair, Matthew Owen, Corporate Counsel, Intellectual Property of Caterpillar, Inc and by its Vice-Chair, Dr. Elizabeth Houlihan, Principal of **Houlihan²** Patent & Trade Mark Attorneys.

ARGENTINA

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1. How would you best protect the shape of the Coke bottle or the shape of the Hershey’s Kiss in your country? Is it possible to protect “SHAPE TRADE MARKS” in your country? **Yes.**
 - a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

Generally, the requirements for filing for a shape trade mark do not differ from those required for regular trademarks (*i.e.* word/device/combined). However, at least three views of the mark must be submitted (top view, front view and side view).

Likewise, another important requirement is the distinctiveness of the mark, this means that a shape, container, or wrapping considered to be of common use, cannot be registered.

What may be registered:

Any word or sign having distinctive capacity, including containers, labels and slogans, in connection with products or services, may be registered.

Who may register:

Anyone having a legitimate interest may register a shape trade mark.

Duration:

Ten years, renewable indefinitely for similar terms.

Use requirements:

Use is necessary within the 5 years preceding the expiration date, in order to be able to renew the registration.

Anyone may bring action in the Courts to have a registration declared lapsed if the trademark has not been used in Argentina within the 5 years preceding the commencement of the lapsing action.

Classification of Goods and Services:

Argentina has adopted the International Classification of Goods and Services for purposes of registration of trademarks. A separate Application is required for each class.

There is no multi-class system. Thus, a separate Application is required to protect each class of Goods and/or Services.

Information and material required for trademark applications:

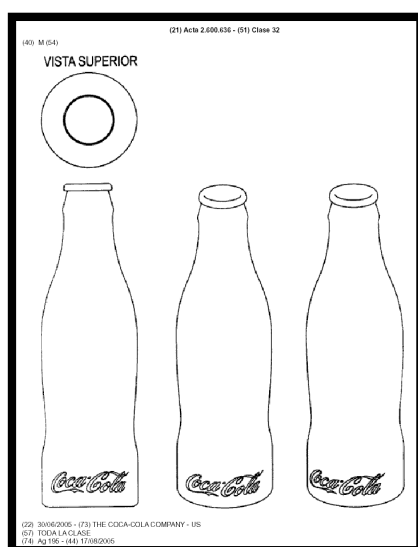
- Full name and address of the Applicant.
- Specimens of prints of the trademark, unless it is a plain word.
- Identification of the Goods or Services to be covered. The full Class can be covered.
- A Power of Attorney ("POA"), including Notarial attestation, and Consular legalization or Apostille.
- The "POA" must be received not later than 40 (forty) working days after the filing of the Application.
- If priority is to be claimed under the Paris Convention, the date and number of the basic foreign Application is required followed, within not more than three months, by a certified (unlegalized) copy thereof.

b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

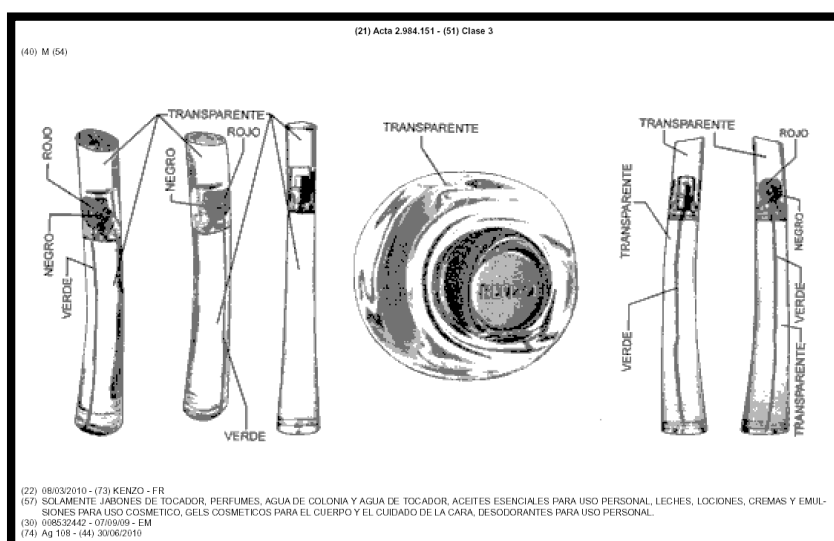
No.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

a) Coca-Cola Bottle



b) Kenzo Perfume bottles



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Art. 2, paragraph of Argentine Trademark Law No. 22. 362 provides the following:

*“The following shall not be considered trademarks, nor shall they be capable of registration:
c) the shape given to the Goods;”*

However, the above principle has been interpreted by jurisprudence through the years, indicating that the shapes that are not allowed to be registered as trademarks are the ones which are in common use and are the necessary shape of the products.

The Shape of trademarks can be protected both by Industrial Designs and as Trademarks.

The relevant statute of the Industrial Designs is Decree No. 6673/63, ratified by Law No. 16.478.

Significant Cases

- Case No 4855/053, "Kraft Foods Holding Company Inc. vs Alimentos Fargo SA" Sala III, 19/04/2011, which dealt with the shape of a Cookie.

- Case No 200, "N.V. Philips Gloeilampenfabrieken v. DNPI "Chamber II of 30/12/1992, which dealt with the shape of shaver blades.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

In Argentina, a formal Opposition cannot be dealt with by filing arguments at the Trademarks Office.

It can only be overcome by friendly settlement (resulting from preliminary negotiations, or from mandatory pretrial mediation proceedings), or by instituting Court Action to have the Opposition. Otherwise, the Application becomes abandoned.

The one year term in which to obtain the amicable withdrawal of the opposition or to file Court Action is not extendable.

When the usual preliminary negotiations to settle Oppositions on the basis of a limitation or undertaking, *etc.* are not successful, or do not seem to be progressing favourably, it is advisable to start the mediation phase.

If the mediation process is unsuccessful, Court Action will be necessary and this involves a full lawsuit before the Federal Courts, usually lasting about two years until a decision is reached by the Federal Court of Appeals.

Please bear in mind that if the Applicant is not domiciled in a country member of The Hague Convention or has no real estate in Argentina, it may be subject to a request for security for costs.

The ownership of a trademark and the exclusive right to use it shall be acquired through registration.

In order to become the registered owner of a trademark, or exercise the right to oppose the registration or use thereof, it shall be essential that the Applicant or Opponent have a legitimate interest.

Decisions refusing registration shall be subject to appeal to the Federal Court of Civil and Commercial Matters. The appeal shall be tried in accordance with the rules for ordinary proceedings and must be lodged within 30 working days from notification of the adverse decision, before the National Board of Industrial Property, which shall proceed as established in Section 17.

Should action not be brought within the prescribed period, the Application shall be declared abandoned.

The property right in a trademark shall become extinguished:

- (a) By renunciation on the part of the registered owner;
- (b) By expiry of the period of validity, without the registration having been renewed; or
- (c) By court decision invalidating the registration or declaring its lapse.

Trademarks are null and void which were registered:

- (a) In contravention of the provisions of the law;
- (b) By those who, when applying for registration, knew or should have known that they belonged to a third party;
- (c) For the sale thereof, by those regularly engaged in the registration of trademarks for the said purpose.

The right of action to seek invalidation shall become statute-barred after ten years.

Imprisonment from three months to two years shall be imposed, in addition to which a fine from one million to 150 million pesos may be levied upon those who:

- (a) Counterfeit or fraudulently imitate a registered trademark or designation;
- (b) Use a counterfeit or fraudulently imitate a registered trademark or designation, or one belonging to a third party, without his consent;
- (c) Offer for sale or sell a counterfeit or fraudulently imitated registered trademark or designation, or one belonging to a third party, without his consent; or
- (d) Offer for sale, sell or otherwise market goods or services with a counterfeit or fraudulently imitated registered trademark.

The National Executive Power shall update the amount of the fine annually on the basis of the variation recorded in the index for general level wholesale prices, officially published by the National Institute of Statistics and Census.

Penal action shall be public and the general provisions of Book 1 of the Penal Code are applicable insofar as they are compatible with law.

The Federal Courts in Criminal and Correctional Matters shall be competent to try penal actions, which shall be dealt with in accordance with the procedure for correctional cases; and the Federal Courts in Civil and Commercial Matters shall be competent to try civil actions, for which the procedure for ordinary actions shall be applicable.

The aggrieved party may, regardless of the kind of action elected, apply for:

- (a) Seizure and sale of goods and other objects bearing an infringing trademark; and
- (b) Destruction of the infringing trademarks and designations and of all objects bearing the same, unless they can be separated therefrom.

Upon request, the court shall order the publication of the judgment at the cost of the offender, where that latter was condemned or defeated in the proceedings.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

From a protection perspective, it is highly advisable to register a shape both as a Trade Mark as well as an Industrial Design.

As mentioned before, it must be clearly understood that the required shape must not be a necessary one; thus, before proceeding, the matter should be checked with local counsel.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

In *Pfizer Inc. vs Microsules Bernabò SA* (Case 5862/01, August 15 2006), the Federal Court of Appeals ordered the defendant to cease the use of a rhomboid-shaped pill and the colour blue on the famous “Viagra” drug to treat erectile dysfunction.

Upon discovering that the competitor Microsules Bernabò SA was producing a pill to treat erectile dysfunction using a rhomboid shape and the colour blue, Pfizer Inc. brought a suit requesting the Court to order Microsules to:

- Cease using a rhomboid shape and the colour blue for its pill on the grounds that it infringed Pfizer’s shape and colour trademark registered in Class 5 of the Nice Classification and used for Viagra – a product to treat erectile dysfunction and
- Pay the relevant compensation for damages.

AUSTRALIA

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

This would best be done by filing two-dimensional and three-dimensional Shape Trade Mark Applications for the shape of the bottle Coke bottle or Hershey's Kiss, respectively.

Is it possible to protect "SHAPE TRADE MARKS" in your country?

Yes.

It is possible to protect Shape Trade Marks in Australia since the *Australian Trade Marks Act 1995* ("the Act") was amended as outlined below. However, the application of these amendments has not been without difficulty for various reasons, which will be explored further.

When deciding upon whether a shape is registrable as a Trade Mark, the central issue to be decided by the Registrar in respect of each Application is:

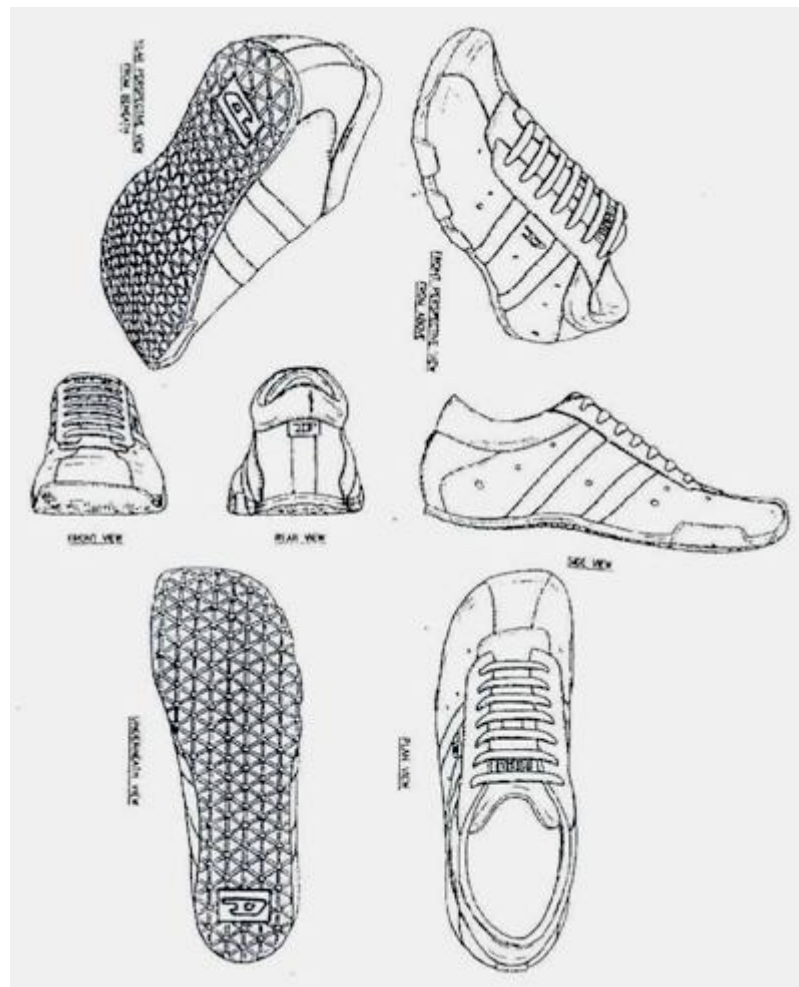
- (a) whether the goods themselves can constitute a Trade Mark;
 - (b) whether the mark has a separate identity from that of the goods;
 - (c) whether the shape has functional characteristics, *i.e.*, do the features of shape bear any relation to the function to be performed by the nature of the goods;
 - (d) whether the shape has been used as a trade mark; and
 - (e) whether the shape of the goods in question is inherently adapted to distinguish them from the goods of other traders.
- a. What do you need to provide to accompany an application for registration of a three-dimensional shape trade mark?

The Applicant needs to provide an endorsement specifying or describing the Shape Mark, if requested by the Examiner. The endorsement may state the words "*three-dimensional shape*", or it may simply refer to an object, which is known to be three-dimensional.

An example of the latter is:

“The trade mark consists of the shape of a SHOE including its features as depicted in the representations accompanying the application form and the stylised letter D. The stylised letter D appears on the rear and the outside of the shoe, the sole comprises a rubber cross-hatched pattern with a square containing the stylised letter D; and two oblique stripes on either side of the shoe and one vertical stripe on the rear,”

which was filed during the prosecution of the Shape Mark in *Global Brand Marketing Inc v YD Pty Ltd* [2008] FCA 605. A representation of the Mark is shown below:



- b. Is it necessary to provide evidence of distinctiveness of shape trade mark? For example: Do you need to provide Evidence-of-Use?

There is no statutory filing or registration requirement for evidence of use when prosecuting an Application for a Shape Trade Mark in Australia. However, in practice, meeting the inherent distinctiveness criterion for registration under Section 41(1) of the Act has proven difficult for many Applicants. Numerous applications are rejected on the basis that the shape of the goods is functional and

therefore lacks distinctiveness as a Trade Mark. In circumstances where a shape is considered by the Registrar to be functional and therefore devoid of inherent adaptation to distinguish, Section 41(6) provides for the registration of a Mark not inherently adapted to distinguish, where the Applicant can establish that the Trade Mark does in fact distinguish the designated Goods or Services because of the extent to which it has been used before the Application was filed.

In practice, Sub-sections 41(3) to 41(6) of the Act are designed to control the process by which the Registrar is to reach a conclusion as to whether the Trade Mark for which registration is sought is capable of distinguishing the Applicant's Goods or Services ("*the designated goods or services*"). If the Trade Mark is not so capable, the Application for must be rejected (Section 41(2)). Subsection (3) requires the Registrar first to "*take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons*".

Having taken such matter into account, it is theoretically open to the Registrar to conclude:

- (a) that the Trade Mark is inherently adapted to distinguish the designated Goods or Services from the Goods or Services of other persons and capable, on that basis alone, of so distinguishing the designated Goods or Services; or
- (b) that the Trade Mark is not to any extent inherently adapted to distinguish the designated Goods or Services from those of other persons; or
- (c) that the Trade Mark is to some extent inherently adapted to distinguish the designated Goods or Services from those of other persons, but there is uncertainty, on that basis alone, that the Trade Mark is actually capable of so distinguishing the designated Goods or Services.

If the shape is considered by the Examiner to be "*devoid of inherent adaptation to distinguish*", the Application must proceed under the provisions of sub-section 41(6), which requires the Applicant to provide evidence of acquired distinctiveness through use of the mark.

2. Please give some examples of actual shape trade marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

At the time of writing there are 879 registered Shape Trade Marks on the Register of IP Australia.

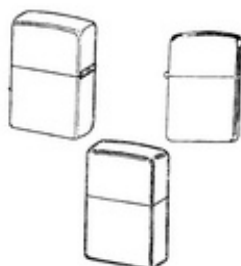
Registered two-dimensional shape Trade marks

Two-dimensional Shape Trade Mark Applications do not have a specific "*type*" designation and are simply categorized as "*Shape*" Marks. However, a written statement or endorsement describing the Mark as applying to a shape is usually included.

The Zippo lighter

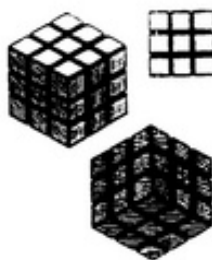
Trade Mark Registration No. 904846 was filed as a Shape Mark on 28 February 2002 by Zippo Manufacturing Company in Class 34 for cigarette, cigar and

tobacco pipe lighters with the endorsement “[t]he trade mark consists of the shape of a cigarette lighter as depicted in the representations attached to the application form.* Provisions of subsection 41(6) applied.*” and the following representation:



The Rubik's cube

Trade Mark Registration No. 707483 was filed as a Shape Mark on 29 April 1996 by Rubik's Brand Limited in Class 35 for licensing services for the advertising and promoting of the goods and services of others in the print, billboard and television media, with the endorsement “[t]he mark consists of a black cube as depicted in the attached representations having nine colour patches on each of its six faces with the colour patches on each face being the same and consisting of the colours red, white, blue, green, yellow and orange” and the following representation:



Registered three-dimensional shape trade marks

Three-dimensional Shape Trade Mark Applications do not have a specific “type” designation and are simply categorized as a “Shape” Mark. However, a written statement or endorsement describing the Mark as applying to a three-dimensional shape is usually included.

The Weber Barbeque

Trade Mark Registration No. 703633 was filed as a Shape Mark on 4 March 1996 by Weber-Stephen Products LLC in Class 11 for barbecues and portable grilling apparatus, with the endorsement “[t]he trade mark is the configuration of the three dimensional shape of the kettle portion of the cooking apparatus, as illustrated in the representation attached to the application form. The kettle portion includes a bottom portion of generally semi-spherical shape and a top of generally semi-ellipsoid shape. The components shown in broken lines in the illustration do not form part of the trade mark.* Provisions of subsection 41(6) applied.*” and the following representation:



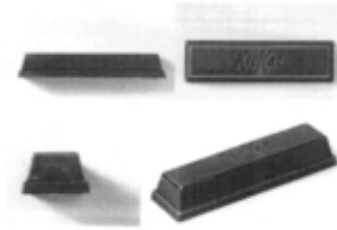
The Tiffany box

Trade Mark Registration No. 718720 was filed as both a Shape and Colour Mark on 1 October 1996 by Tiffany and Company in Class 8 for hand tools and implements and cutlery; in Class 14 for precious metals and their alloys and goods in precious metals or coated therewith including tableware and dinnerware; jewellery, precious stones; horological and chronometric instruments; and in Class 21 for household or kitchen utensils and containers including tableware and dinnerware; combs and sponges; brushes; glassware, porcelain and earthenware. The Application was filed with the endorsement “[t]he trade mark consists of both the words *TIFFANY & CO* and a robin's egg blue box as depicted in the representation attached to the application form. The applicant claims the colour as an essential feature of the trade mark.* Convention priority is claimed based on an application made in the United Kingdom by reason of Community Trade Mark Application no 151985 dated 1 April 1996.*” and the following representation:



Kit Kat chocolate

Trade Mark Registration No. 849096 was filed as a Shape Mark on 6 September 2000 by Société des Produits Nestlé S.A. in Class 30 for cocoa and preparations having a base of cocoa, chocolate, chocolate products, confectionery, sweets, candies; sugar; chewing gum; bakery products, pastry, biscuits; cakes, cookies, wafers, food preparations included in Class 30 for making desserts and puddings; cereal and cereal products; ice cream, water ices, sherbets, frozen confections, frozen cakes, preparations for making ice cream and/or water ices and/or sherbets and/or frozen confections and/or frozen cakes with the endorsement “[t]he trade mark consists of a combination of the three dimensional shape of a bar and the words *KIT KAT* which are imprinted upon it, as shown in the representation attached to the application form.” and the following representation:



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with shape trade marks.

Legislation

The law relating to the registration of Shape Trade Marks in Australia was made possible through amendments introduced in the *Trade Marks Act 1995* (Cth) (“the Act”) and the *Trade Marks Regulations 1995* (Cth) (“the Regulations”).

Section 17 defines the term “trade mark” as follows:

*“A **trade mark** is a **sign** used, or intended to be used, to distinguish 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.”*

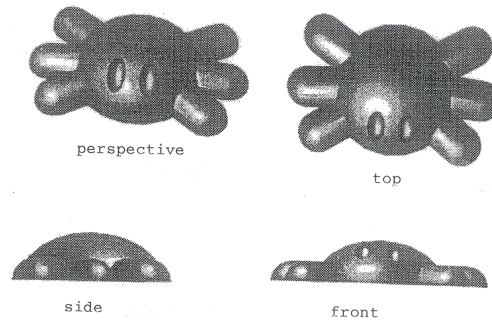
Section 6 defines what is meant by a “sign” as follows:

*“**sign** includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, **shape**, colour, sound or scent.”*

Case Law

- *Kenman Kandy (Aust) Pty Ltd v Registrar of Trade Marks* (2002) 122 FCA 494; [2002] FCAFC 273

Kenman Kandy Australia Pty Ltd (“Kenman Kandy”) applied to its “*millennium bug*” sweet as a Trade Mark on 15 January 1999. The “*millennium bug*” was a fruit flavoured gelatinous confectionary comprising a central body, which resembled a section of a sphere with a curved upper surface and a flat lower surface. There were two oval “eyes” on the body and three short stylised “legs” on either side of the body which were symmetrically disposed about the eyes. Kenman Kandy had filed the Application with the statement “[t]he trade mark consists of the three-dimensional shape of the goods as shown in the representations attached to the application form” with the following representation:



The Shape Mark was refused registration because it had “*little or no inherent adaptation to distinguish the applicant’s goods in the market place.*”

On appeal to the Federal Court, the decision of the Registrar was upheld. It was concluded that the Shape Mark was not inherently adapted to distinguish Kenman's confectionery from that of others, even though the Mark was concocted and no real insect had that shape. The shape was nonetheless considered to be reminiscent of a variety of insects and it was concluded that other traders would wish to use the shape in the ordinary course of business.

An appeal to the Full Court was allowed and the decision of the primary judge was set aside. The Court held that although the bug shape was suggestive of insect life, it was an imaginary shape and was not the shape of any specific insect or bug. Registration of the bug shape as a Trade Mark was not considered to give the appellant a monopoly over all bug or insect shapes. The decision of the Registrar rejecting Application No. 783465 was reversed and it was ordered that the Application be registered.

- Re Chocolaterie Guylian NV's Application (1999) 46 IPR 201;
Chocolaterie Guylian NV v Registrar of Trade Marks (2009) 180 FCR 60
 Chocolaterie Guylian NV (“Guylian”), a Belgian chocolate manufacturer well-known world-wide for its sea shell range of chocolates (“Perles d’ Océan”), sought to register its chocolate seahorse shape in Australia as a three-dimensional Shape Trade Mark, represented as follows:



The Registrar refused the registration of the Application. Guylian appealed to the Federal Court, arguing that the Shape Mark was a “*fanciful stylised*” representation of a seahorse which “*departs radically from the shape of seahorses found in nature.*” As the tail wraps up behind the spine of the creature rather than forwards (giving it an overall “S” like configuration), and the appearance was solid and “*chunky*” as opposed to the more slender and elongate shape of a real

seahorse.

The Federal Court dismissed the Application on the basis that, although the seahorse was to some degree inherently adapted to distinguish, and the seahorse in question was recognisable as such, it was not sufficiently inherently adapted to distinguish in terms of the Act. Furthermore, the evidence failed to establish that Guylian's seahorse shape was used as a Mark, sufficient for the purposes of the Act, because it was rarely used alone as a badge of origin, and was combined with other aspects of packaging. Guylian appealed to the Full Federal Court.

The Full Federal Court distinguished the case from that of *Kenman Kandy* (which related to an entirely imaginary creature) in that the shape was clearly that of a seahorse. It was found that other traders, acting with proper motives, would want in the future to use the same seahorse shape. The shape was held to be inherently adapted to distinguish to some extent, but not to the degree required by the Act. Furthermore, the Court upheld the Federal Court's finding that the seahorse shape was not used as a Trade Mark as it was simply one of the chocolate shapes out of a number of seashell/marine shapes that Guylian sold and marketed as one collection. It was concluded that the shape was not given such a prominence, either in use as the shape of the goods, or displayed in packaging and promotional material, as to educate the public that it was being used as a Trade Mark. The appeal was dismissed with costs.

- *Cadbury Schweppes Proprietary Limited, Effem foods Pty Ltd v Société des Produits Nestlé S.A.* [2003] ATMO 74

Société des Produits Nestlé S.A. ("Nestlé") sought registration for the Shape Trade Mark in Class 30 for hard candy confectionery as shown in the following representation:



Nestlé had used the Shape Trade Mark since 1923 on candy made in the annular shape, which was prominently embossed with the Trade Mark LIFE SAVERS. These words covered the whole of one side of the candy. Since the representation filed with the Application did not bear the embossed words LIFE SAVERS, which was considered to form a part of the shape in use, all of the use claimed by Nestlé was considered to be insufficient to show acquired distinctiveness. The Delegate also concluded that any Trade Mark significance that the shape may have had was swamped by the Trade Mark LIFE SAVERS embossed on the candy. The Shape Mark of the Application was therefore assessed as "unused". The Delegate concluded that the Shape Trade Mark lacked any inherent capacity to distinguish. Furthermore, not only was the shape of the Mark considered to be dictated by function, but it was concluded that traders would wish to use the annular shape on similar goods in the ordinary course of business without improper motive.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding registered shape trade marks.

The Act has a number of provisions enabling the opposition of a Trade Mark Application and the cancellation or revocation of a Trade Mark Registration.

Trade Mark Opposition Proceedings

There are two mandatory elements of the process relating to Trade Mark Oppositions in Australia:

- (1) A “Notice of Intention to Oppose” must be filed with IP Australia within 2 months of advertisement of acceptance of the relevant Trade Mark Application in the Australian Official Journal of Trade Marks; and
- (2) A “Statement of Grounds and Particulars” setting out the Grounds of Opposition and the material facts which particularise each of those grounds must be filed with IP Australia within 1 month of filing a Notice of Intention to Oppose.

An Application is treated as opposed only when both the Notice of Intention to Oppose AND the Statement of Grounds have been filed.

Defending an Opposed Trade Mark Application

In order for an Application to be maintained and the opposition to be defended, an Applicant must defend their Trade Mark Application through filing a “Notice of Intention to Defend” within 1 month from the day the applicant is given a copy of the Statement of Grounds. This Notice can only be filed after both the Notice of Intention to Oppose and the Statement of Grounds have been filed by the Opponent and accepted by the Registrar.

If the Applicant fails to do this, the Trade Mark Application will lapse. This deadline may be extended under certain circumstances.

The Notice of Intention to Defend must include an Australian Address for Service. This may be relevant for overseas applicants who have not provided an Australian Address for Service when filing the Trade Mark.

Evidence

Once both the Notice of Intention to Oppose and Notice of Intention to Defend have been filed, the following procedure applies:

- (a) the Opponent has three months to file its Evidence in Support;
- (b) the Applicant then has three months to file its Evidence in Answer; and
- (c) the Opponent then has two months to file its Evidence in Reply.

Extensions of Time

It is at the Registrar’s discretion whether an Extension of Time, typically for a period of less than one month, will be granted to either party in Opposition Proceedings. Extensions will only be allowed where the Registrar is satisfied that:

- (a) The relevant party has made **all reasonable efforts to meet the deadline** and

- the failure to meet the deadline occurs despite the relevant party acting diligently and promptly in respect to filing the relevant document/evidence;
or
(b) there are “exceptional circumstances”.

Cooling-off Period

With the consent of both parties, a “*cooling-off period*” can be requested, by application to the Registrar, at any time after Opposition Proceedings have commenced. Proceedings can be suspended for an initial period of 6 months up to a maximum of 12 months, and all parties involved in the Opposition must consent. The Registrar will only grant one cooling-off period.

Hearing

Either party may request a Hearing after the evidence is filed. The Registrar must convene a Hearing, if requested. The Registrar may also call for a Hearing. The Registrar has a discretion regarding whether or not to hold an oral hearing, or to hear the matter based on written submissions.

If the Registrar decides to hear the matter in person, the Opponent must file a summary of submissions 10 business days before the Hearing and the Applicant must file its summary of submissions no later than 5 business days before the Hearing. Failure to comply with these deadlines can have adverse cost consequences.

Trade Mark Removal for Non-Use

In terms of Section 92, any person may apply to the Registrar for the removal a Trade Mark from the Register only on the two grounds set out in Section 92(4):

(1) The Applicant for registration had no intention to use the Trade Mark

The first ground on which an Application for Removal for Non-Use may be based is that, on the day on which the Application for the Registration of the Trade Mark was filed, the Applicant for registration had no intention in good faith to use the Trade Mark in Australia; or to authorise the use of the Trade Mark in Australia; or to assign the Trade Mark to a body corporate for use in Australia; in relation to the Goods and/or Services to which the Non-Use Application relates and that the registered owner has not used the Trade Mark in Australia; or has not used the Trade Mark in good faith in Australia; in relation to those Goods and/or Services at any time before the period of one month ending on the day on which the Non-Use Application is filed.

(2) The owner of the registration has not used the Trade Mark

Alternatively, an Application for Removal for Non-Use can be based on the claim that the Trade Mark has remained registered for a continuous period of three (3) years ending one month before the day on which the Non-Use Application is filed, and, at no time during that period, the person who was then the registered owner used the Trade Mark in Australia; or used the Trade Mark in good faith in Australia; in relation to the Goods and/or Services to which the Application relates.

An Application for Removal for Non-Use may not be made if an action concerning the Trade Mark is pending. The onus and evidentiary burden is on the Applicant for removal. The Application will be advertised in the Official Journal.

A person who wishes to defend a registration from removal for non-use must file a Notice of Opposition to the Removal Application within three months of the date of advertisement in the Official Journal, or obtain an extension of time to do so. The onus is on the Opponent to rebut any allegation of lack of intention to use, or of non-use.

The procedure to be followed in such Opposition Proceedings is the same as that set out in the section above relating to “*Trade Mark Opposition Proceedings*.”

Trade Mark Revocation

(1) By the Registrar

Sections 84A to 84D of the Act give the Registrar the non-mandatory power to revoke registration in appropriate circumstances, such as to correct administration errors.

According to these provisions, the Registrar may revoke the registration of a Trade Mark if satisfied that the Trade Mark should not have been registered, taking account of all the circumstances that existed when it became registered (whether or not the Registrar knew then of their existence); and it is reasonable to revoke the registration, taking account of all the circumstances.

These circumstances include, *inter alia*, any errors (including errors of judgment) or omissions that led directly or indirectly to the registration; any relevant obligations of Australia under an international agreement; any special circumstances making it appropriate not to register the Trade Mark; or to register the Trade Mark only if the registration were subject to conditions or limitations to which the registration was not actually subject; any use that has been made of the Trade Mark; any past, current or proposed legal proceedings relating to the Trade Mark as a Registered Trade Mark or to the registration of the Trade Mark; other action taken in relation to the Trade Mark as a Registered Trade Mark; and any special circumstances making it appropriate to revoke the registration; or not to revoke the registration. The decision of the Registrar may be taken on appeal to the Australian Federal Court.

(2) By the Court

An “*aggrieved person*” may apply to the Australian Courts for the amendment of the Register and/or cancellation of the registration in terms of Sections 85 to 88, 181 and 182 of the Act.

There is considerable case law on the meaning of “*an aggrieved person*,” and the nature of the aggrievement, with the term being given a broad interpretation and including trade rivalry and a person who has been threatened with Trade Mark Infringement Proceedings.

In proceedings for cancellation of a Trade Mark Registration, the onus and evidentiary burden is on the Applicant.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against shape trade mark applications.

Ensure consistency in description and representation of the mark

It is important to ensure that the Specification of Goods is consistent with the written description in the statement or endorsement and the representation of the Mark. If these aspects of an Application are inconsistent with one another, the written description in the statement or endorsement will be considered decisive in delineating the Trade Mark (*Levi Strauss & Co v Kimbyr Investments Ltd* (1993) 28 IPR 249).

In *Cadbury Schweppes Proprietary Limited, Effem foods Pty Ltd v Société des Produits Nestlé S.A.* [2003] ATMO 74, the Delegate noted the difference in scope between the Specification of Goods cited as “hard candy confectionery” and the description of the Trade Mark on the application form which stated that: “[t]he trade mark consists of the shape of a circular piece of confectionery with a hole in the middle, as depicted in the representation attached to the application form.” The description was held to be considerably wider than the Goods to which it applies, which it difficult to interpret the scope claimed.

File good quality representations of the Shape Mark from the start

It is important to file accurate representations showing the distinguishing features of the Shape Mark as the Application will be examined on the basis of the representations provided at filing. In practice, this is usually achieved by providing multiple aspect views of the shape. Clear representations of the shape are particularly important where one or more aspects of proportionality are an essential feature of the Mark (*Cadbury Schweppes Proprietary Limited, Effem foods Pty Ltd v Société des Produits Nestlé S.A.* [2003] ATMO 74).

Use of the Shape Trade Mark

In order to demonstrate that the Shape Trade Mark has been used and/or has acquired distinctiveness through use, it must be capable of acting as a badge of origin on its own. That is, the shape *solus* must be seen by consumers as a Trade Mark and not just as the functional shape of the Goods, or always in combination with a dominant word or logo Mark.

It is difficult to discern general guidelines on how to go about achieving such use, as the case law in this area has been decided on the merits. However, it is clear that the Registrar will regard a Shape Trade Mark as unused where dominant shape features of the Shape Mark are present in use, but are not included in the representation as filed (*Cadbury Schweppes Proprietary Limited, Effem foods Pty Ltd v Société des Produits Nestlé S.A.* [2003] ATMO 74). Furthermore, ordinary everyday well-known shapes, with features considered to be necessary to achieve a technical result, are unlikely to be regarded as having acquired distinctiveness, even if they have been used for a long period (*Multix Pty Ltd* [2004] ATMO 51).

6. Please give some examples of registered shape trade marks that were enforced (successfully or not) against third party uses.

Provision for the enforcement of Shape Trade Marks

As with a Trade Mark Registration for a word or logo, a Trade Mark owner can enforce a registration for a Shape Trade Mark against third party users in terms of Section 120 of the Act which provides that:

- (1) *A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered.*
- (2) *A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:*
 - (a) goods of the same description as that of goods (registered goods) in respect of which the trade mark is registered; or*
 - (b) services that are closely related to registered goods; or*
 - (c) services of the same description as that of services (registered services) in respect of which the trade mark is registered; or*
 - (d) goods that are closely related to registered services."*

Shape Trade Marks in Australia can also be protected under a common law action of passing-off, even where the Mark is not registered or the use is not in respect of the same or similar goods or services. The elements are confined to:

- (1) a business reputation associated exclusively with the Mark in question (*Cadbury Schweppes v Pub Squash*);
- (2) a misrepresentation by the Defendant that would suggest an association between itself and the owner of the Shape Trade Mark (*SA Brewing Company v 20th Century Fox*); and
- (3) as a consequence of the misrepresentation, damage or the possibility of damage to the owner of the Shape Trade Mark's reputation having occurred.

Examples of successful enforcement

- *Zippo Manufacturing Co v Jaxlawn Pty Ltd* [2011] FCA 1125

In this case (discussed in Item 2 above), a shipment of Goods was seized by the Chief Executive Officer of Australian Customs ("Customs") and Proceedings were filed in the Federal Court of Australia shortly thereafter.

In the Deed of Settlement, Jaxlawn agreed that it would cease from importing, retailing, distributing, promoting for sale, offering, displaying, advertising, selling and supplying any lighters having the shape the subject of Australian Trade Mark No. 904846 or any shape that was substantially identical or deceptively similar to that shape.

The Court ordered, by consent, that the first shipment of seized Goods be forfeited, that the Proceeding be discontinued with a right of reinstatement and that there be no order as to Costs.

However, shortly thereafter, Zippo's solicitors received an email from Customs enclosing photographs of a second shipment of products allegedly imported by Jaxlawn that Customs believed may have infringed Zippo's rights. Customs requested Zippo's solicitors to advise whether or not the products were infringing. After receiving additional photographs of the seized Goods, Zippo's solicitors formed the view that the Goods were within the scope of the Registered Zippo Shape Trade Mark and were not licensed or authorised by Zippo. Zippo's solicitors communicated with Customs and subsequently Jaxlawn agreed to forfeit the Goods.

Zippo sought Court Orders that the Proceeding be reinstated and sought a declaration that Jaxlawn had engaged in, or alternatively threatened to engage in, conduct that infringed each of the Registered Zippo word Trade Marks, Registered Zippo logo Trade Mark and registered Zippo Shape Trade Mark; threatened to engage in misleading and deceptive conduct; and threatened to wrongfully pass off the imported Goods as products made or otherwise originating or associated with Zippo.

Zippo sought an injunction restraining Jaxlawn, whether by itself, its servants, agents or howsoever otherwise from importing, selling, offering for sale, supplying, displaying, advertising, promoting any lighters or accessories (or goods of the same description):

- (a) under and by reference to the Registered Zippo word Trade Marks or any substantially identical or deceptively similar Trade Mark;
- (b) under and by reference to the Registered Zippo logo Trade Mark or any substantially identical or deceptively similar Trade Mark; or
- (c) having the shape the subject of the Registered Zippo Shape Trade Mark or any substantially identical or deceptively similar shape.

Jaxlawn was ordered to pay Zippo's indemnity costs of the Proceeding and of the Interlocutory Application.

- *Coca-Cola Company v All-Fect Distributors Ltd (t/as Millers Distributing Co)* (1998) 43 IPR 47

Merkel J. considered a claim by Coca-Cola that the sale by the respondent of a cola confectionery with a shape similar to the distinctive Coke contour bottle was an infringement of a registered trade mark held by Coca-Cola, which comprised a two-dimensional drawing of the contour bottle in Class 32 in respect of "*beverages and syrups for the manufacture of such beverages*." All-Fect Distributors had been importing and selling a cola-flavoured confectionary with a shape similar to the contour bottle device Mark of the Coca-Cola Company. The confectionary also featured the word "*cola*" inscribed on it in capitals, and was supplied to retailers in a tub labelled as containing "*Efruti*" cola bottles and

displaying a picture of two cola bottles reclining in the sun on an island, sipping cola.

At first instance in the Federal Court, Merkel J. dismissed the Coca-Cola Company's infringement claim, concluding that:

- the Respondent had not used the contour bottle Trade Mark in respect of Goods for which the Mark was registered, and so there could be no infringement under Section 120(1);
- the Respondent's confectionery were not Goods of the same description as, or closely related to, beverages, and so there could no infringement under Section 120(2);
- there was no infringement under Section 120(3) because the Respondent had not used the contour bottle mark "as a Trade Mark", because:

"the cola bottle confectionery is merely recognisable as having the well-known shape of the contour bottle but would not be likely to be believed or expected to have a trade or commercial connection of some kind with the applicant by reason of having that shape. Likewise, consumers would be unlikely to be led to wonder whether it might the case that the confectionery comes from the same source as Coca-Cola."

Merkel J. did not expressly make a finding regarding whether there was the requisite connection for the purposes of Section 120(3), because he based his decision on whether the Shape Mark had been "*used as a trade mark*" by All-Fect. It is fair to say that Merkel J. seems to have assumed that the requisite "*connection*" under Section 120(3) was a "*commercial connection*" of "*association*" or "*endorsement*", or the like. However, no argument appears to have been presented that Section 120(3) could be satisfied by any other form of connection - Coca-Cola appeared content to argue that such a connection could be established in this case.

On appeal, the Full Court of the Federal Court overturned Merkel J.'s finding that All-Fect had not used the contour bottle Shape Mark as a Trade Mark, because the test was not whether the use of the contour bottle shape indicated a connection between the confectionery and Coca-Cola, but whether the use indicated a connection between the confectionery and All-Fect. The Full Court held that on the facts there was such a connection, and that All-Fect's use of the silhouette, the fluting and the label brand constituted use of those features as a Trade Mark. Merkel J.'s finding that the Goods were not of the same description as Goods in respect of which the Mark was registered was also overturned, on the basis that at trial, this had been conceded by the Respondents. The result was that the matter was remitted to Merkel J. to determine whether there had been infringement under Section 120(2), and Section 120(3) dropped out of the picture. There is no report of the remitted Proceedings.

Unsuccessful enforcement

- *Koninklijke Philips Electronics NV v Remington Products Australia Pty Limited* [1999] FCA 816; [2000] FCA 876

Koninklijke Philips Electronics NV manufactured a well known and long established line of electric shavers distributed by Philips Electronics Australia Pty Ltd in Australia (collectively “Philips”). The rotary shavers were, and still are, well-known world-wide, having three rotary shaving “heads” arranged in the configuration of an equilateral triangle. Until June 1997, all competing electric shavers sold in Australia were “foil” shavers, a different type which are not constructed on the rotary principle. Rotary shavers, particularly those with three shaving heads forming an equilateral triangle, had therefore been exclusively associated with the name of Philips.

Philips was the owner of two Shape Trade Mark Registrations in Australia, initially registered under the *Trade Marks Act 1955*, in Class 8 for, *inter alia*, “shaving apparatus”. The first registration for a two-dimensional device Trade Mark was represented as follows:



The second Mark (which was also in fact two-dimensional) was filed with the endorsement “[r]egistration of this trade mark shall neither confer nor recognise any right to the use of its features as a design applied to an article of manufacture” and was referred to in argument as “the three-dimensional mark” because it was depicted so as to represent a three-dimensional appearance, as follows:



In June 1997, Remington Products Australia Pty Limited (“Remington”), a well known vendor of foil electric shavers, began to sell in Australia a rotary electric shaver with three shaving “heads” equally spaced in a triangular formation, as a bulkier “wet/dry” model:



After obtaining an interlocutory injunction against Remington, Philips commenced proceedings alleging *inter alia* infringement of its Shape Trade Marks. Remington cross-claimed that Philips' Trade Mark was inherently unregistrable, as it depicted functional features of an article, and was furthermore not a "*sign*" according to the statutory definition of a Trade Mark.

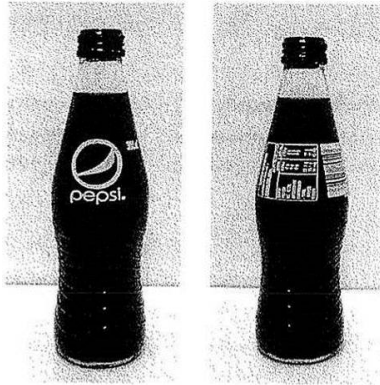
The Federal Court held that in light of the emphasis by Remington of other features of its shaver, including that the shaver was a "*dual track shaver*" and a "*wet/dry shaver*" with "*three independently floating heads*," the use of the triangular shape and the way in which the Remington shaver was advertised, was not a use of either of Philips' Marks as a Trade Mark. Both Philips' claims and Remington's cross-claims were dismissed, with costs, and the interlocutory injunction ordered to be dissolved.

On appeal, the Full Federal Court upheld the trial Court's finding that Remington did not use the Mark as a Trade Mark. It was concluded that where the shape consists of the shape of the Goods and nothing more, it cannot function as a Trade Mark to distinguish the commercial origin of the Goods.

- *The Coca-Cola Company v PepsiCo Inc. (No. 2)* [2014] FCA 1287

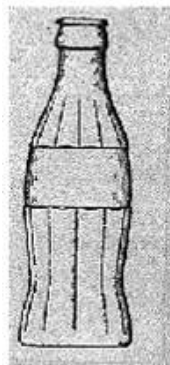
In this case, the Coca-Cola Company sued PepsiCo Inc. for *inter alia* infringement of four Registered Trade Marks covering the two-dimensional and the three-dimensional shape of the iconic Coca-Cola contour bottle. It was argued that the shape of PepsiCo Inc.'s newly released "Carolina" bottle was used as a Trade Mark within the meaning of Sections 17 and 120(1) of the Act.

The “Carolina” bottle:

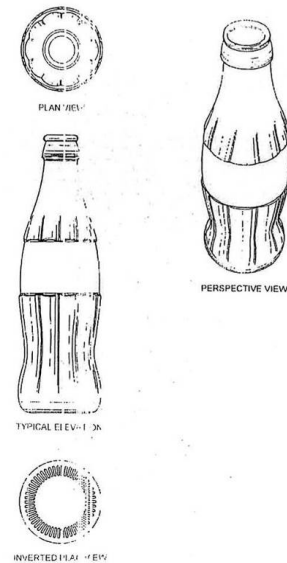


The shape of the Carolina bottle, or in the alternative, the outline or silhouette of the bottle, was claimed to be deceptively similar to one or more of the Coca-Cola Company’s four Registered Trade Marks:

Trade Mark No. 63697:



Trade Mark No. 767355:



Trade Mark No. 1160893:



Trade Mark No. 1160894:



PepsiCo Inc. responded that the shape of the Carolina bottle was not being used as a Trade Mark, and even if it was, it was being done in conjunction with the more traditional word and logo Marks used by PepsiCo Inc. In the alternative, PepsiCo Inc. submitted that the whole shape of the Carolina bottle is not deceptively similar to any of the Coca-Cola Company's four Registrations.

The Court reviewed the extensive evidence and held that the shape of the Carolina bottle was not being used as a Trade Mark, as consumers would not consider the outline or silhouette of the Carolina bottle alone as a feature being used to indicate a connection between the Pepsi beverages and PepsiCo Inc.

The Court carried out a side-by-side comparison of the representations of each of the Coca-Cola Company's four Registrations and the Carolina bottle, and found that there were significant differences in shape. It was also concluded that there was no deceptive similarity as the outline or silhouette of the contour bottle was not considered to be an essential feature of any of the Registered Trade Marks at issue. The Coca-Cola Company's claim of Trade Mark infringement was dismissed. There is no report of any appeal Proceedings.

BRAZIL

Contributor: Luiz Edgard Montauray Pimenta and Ana Paula Affonso Brito

Montauray Pimenta, Machado e Vieira de Mello
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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

It is possible to protect "SHAPE TRADE MARKS" in our country, and the best way to protect them is by filing a trademark application before the Brazilian Trademark Office ("BTO") for the goods covered thereby.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

Besides the Power of Attorney, which is mandatory for all trademark applications in Brazil, we also need to submit a brief description of the mark to the BTO, as well as different perspectives (drawings from different angles) of the mark.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

No. However, we take this opportunity to clarify that in accordance with Article 124, item XXI of the Brazilian Trademark Law, "*the necessary, common, or ordinary form of the product or packing, or also that one which cannot be dissociated from a technical effect*" is unable to be registered as a mark.

Therefore, unless the 3D mark to be protected is distinctive enough to be registered as a trademark in Brazil, such three-dimensional mark will be rejected by the BTO.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Registration no. 820963712
Mark: TOBLER TOBLERONE



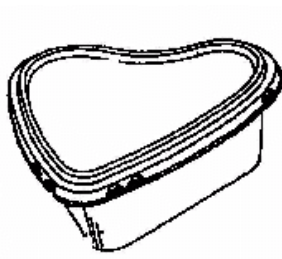
Class: 30
 Filing Date: August 6, 1998
 Owner: Kraft Foods Schweiz Holding
 Status: registration in force until April 9, 2022.

Registration no. 200037056
 Mark:



Class: 32
 Filing Date: June 24, 1998
 Owner: The Coca-Cola Company
 Status: registration in force until August 5, 2013.

Registration no. 820641618
 Mark:



Old Local Class: 29, item 40
 Filing Date: March 26, 1998
 Owner: Arla Foods AMBA
 Status: registration in force until September 2, 2018.

Registration no. 820671584
 Mark:



Class: 3
Filing Date: May 19, 1998
Owner: CONOPCO, INC. TB. NEG. COMO CALVIN KLEIN COSMETICS
Status: registration in force until December 18, 2021.

Registration no. 821047370
Mark:



Class: 9
Filing Date: September 10, 1998
Owner: Oakley Inc.
Status: registration in force until April 23, 2012.

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The Brazilian Industrial Property Law does not foresee any specific provision for three-dimensional marks, but generically determines the following:

Section I

Signs Registrable as Marks

122. Any distinctive visually perceivable signs that are not included in legal prohibitions shall be eligible for registration as a mark.

123. For the purposes of this Law, the following definitions apply:

I. product or service mark: one which is used to distinguish a product or service from another that is identical, similar, or alike, but of different origin.

Also, as informed above:

124. The following are not registrable as marks:

(...)

XXI. the necessary, common, or ordinary form of the product or packing, or also that one which cannot be dissociated from a technical effect;

Moreover, in accordance with the Trademark's Guidance recently issued by the BTO, the three-dimensional mark is a sign constituted by a plastic distinctive form, which is able to individualize the products and services protected thereby.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

The procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding registered Shape Trade Marks is the same as that followed by word, composite and design marks in Brazil.

For prompt reference, (1) oppositions may be filed before the BTO within 60 days of the application's publication in the Industrial Property Journal; (2) Administrative Nullity Actions may be filed before the BTO within 180 days from the registration's granting date; (3) Non-Use Cancellation Actions may be filed before the BTO after 5 (five) years from the registration's granting decision; and (4) Nullity Actions may be filed before the Brazilian Federal Courts within 5 (five) years from the decision to grant registration.

The deadline for the other party to file a response expires in 60 days from the date of publication of the proceedings.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

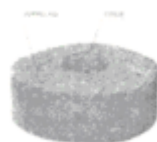
A strategy that could be used against a three-dimensional trademark registration could be disqualifying the same as a mark, by arguing that it does not attend to the use requirements (as a trademark), but has ornamental/decorative purposes only.

In addition, if the shape is of common use, it is also possible to obtain the rejection of the three-dimensional trademark application based on this argument.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Registration no. 824314891

Mark:



Class: 31

Owner: MASTERFOODS BRASIL ALIMENTOS LTDA.

Status: This mark was the subject of an opposition filed by SOCIETE DES PRODUITS NESTLE SA (CH) thereagainst, but Masterfoods successfully

overcame the opposition and the mark matured into registration. It is in force until December 9, 2018.

Registration no. 825086825

Mark:



Class: 06

Owner: MOTTURA SERRATURE DI SICUREZZA SPA

Status: This mark was the subject of an opposition filed by ATELIER MECÂNICO MORCEGO LTDA thereagainst, but Mottura has successfully overcome the opposition and the mark has matured into registration. It is in force until August 12, 2018.

Registration no. 828611637

Mark:



Class: 25

Owner: BOYNER HOLDING ANONIM SIRKETI

Status: This mark was the subject of an opposition filed by MONTBLANC-SIMPLO GmbH thereagainst, based on its prior mark but Boyner Holding has



successfully overcome the opposition and the mark has matured into registration. It is in force until November 3, 2019.

CANADA

Contributor: Ms. Kellie Moffatt

OSLER

Ottawa

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? YES/No

Yes. The shaping of the goods themselves or their packaging may in appropriate circumstances be protected in Canada as a "distinguishing guise".

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

An application for registration of a distinguishing guise must be accompanied by:

- a clear drawing or drawings showing different profiles of the shape of the wares;
- a description of the mark that makes clear that the trade-mark sought to be registered is three-dimensional.

Evidence of distinctiveness must also be filed (see 1(b) below), although it does not need to be filed concurrently with the application.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?

For example: Do you need to provide Evidence-of-Use?

Under current law¹, an application for registration of a distinguishing guise must assert actual use and a distinguishing guise will be registrable only if it has been used in Canada as to have become distinctive at the date of filing. Practically

¹ IMPORTANT NOTE: It should be noted that amendments to the Canadian *Trade-marks Act* which have been passed, but not yet implemented, introduce significant changes to the requirements and practice with respect to the registration of distinguishing guises in Canada. It is unclear when the changes will be implemented by the Canadian Intellectual Property Office. The amendments repeal the definition and category of "distinguishing guise". The definition of "trademark" in section 2 is expanded to include "a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others". "Sign" is defined so as to include "a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign". Applications to register "the three-dimensional shape of any the goods specified in the application, or of an integral part or the packaging of any of those goods" will be subject to the requirement that the applicant furnish evidence establishing that the trademark is distinctive as of the filing date of the application.

speaking, and absent exceptional circumstances, the Trade-marks Office will look for clear evidence in the form of one or more affidavits demonstrating that the mark has been used and promoted for at least five years prior to filing.

The evidentiary burden is a heavy one and the extent and nature of the requisite evidence will vary depending on the circumstances. If the applied for mark has a low degree of inherent distinctiveness, the threshold will be higher.

By way of general guidance, the evidence filed should include:



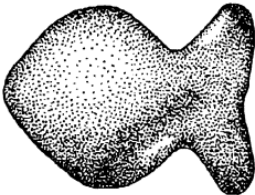
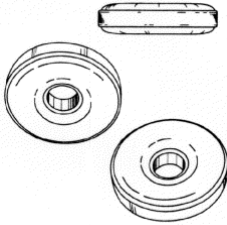
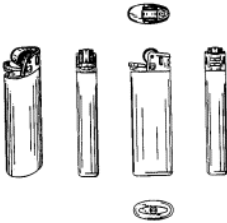
- a statement explaining the nature of the mark and how it is used in association with the wares;
- a description of the manner of association of the mark at the time of transfer of property or transfer in possession of the wares. Specimens or photos of specimens of the mark should be included;
- details of the origins of the distinguishing guise and the length of time that it has been used; and
- details of sales revenues and advertising/promotion expenditures in Canada, an explanation of channels of trade, indication of representative customers and sample advertisements. Extent of use of the mark across Canada may be expressed in terms of units, dollar volume of sales or percentage of the market for the wares sold. The evidence may also refer to the mode of distribution, the number of distributors and the number of outlets in which the product associated with the mark is offered for sale. The evidence must be broken down by province or region of Canada.

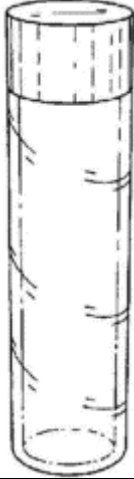

In some cases, additional affidavits or survey evidence may be required to demonstrate the requisite degree of distinctiveness among the public. Such additional affidavits could, depending on the relevant circumstances, be secured from advertising agencies, distributors, wholesalers, retailers and users who can attest to the recognition of guise as distinguishing the goods of the applicant.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

A distinguishing guise will, by definition, be a three dimensional mark (as distinguished from a two dimensional mark applied to a three dimensional object – such as a fanciful label or marking applied to a bottle).

Set out below are some examples of three dimensional shape trade-marks that have been successfully registered in Canada as distinguishing guises:

Distinguishing Guise	Reg. No.	Wares	Owner
	TMA631,583	Chocolate	Chocoladefabriken Lindt & Sprüngli AG
	TMA824,732	Electronic appliances, namely, kitchen food processors and blenders	Homeland Housewares, LLC
	TMA532,558	Edible crackers; cookies and biscuits; snack mix consisting primarily of crackers and pretzels	Pepperidge Farm Incorporated
	TMA562,616	Candy and candy confections	WM. Wrigley JR. Company
	TMA495,518	Lighters	Bic Inc.

	TMA751,978	Mineral and aerated water	Voss of Norway ASA
	TMA590,634	Ice milk, reduced fat ice cream and frozen yogurt confections in cone, cup and molded form, with and without flavorings and toppings such as hot fudge, chocolate, strawberry and pineapple	American Dairy Queen Corporation

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Section 2 of the Canadian *Trade-marks Act* defines “trade-mark” to include a distinguishing guise. Section 2 defines a “distinguishing guise” as meaning:

- (a) the shaping of the wares or their containers, or
 - (b) a mode of wrapping or packaging the wares or their containers
- the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others.

Section 13 of the Act outlines when a distinguishing guise will be registrable and provides as follows:

- (1) A distinguishing guise is registrable only if:
 - (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration; and

- (b) the exclusive use by the applicant of the distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry.
- (2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.
- (3) The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

Section 32(1) provides that an applicant who claims that a mark is registrable under Section 13 [as distinguishing guise] shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

There is no special forum or procedure for opposing, invalidating or cancelling a registered distinguishing guise. The same procedures as apply for “regular” trade-marks will be followed for shape trade marks².

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

Filing: Ensure that the mark to be applied for as a distinguishing guise is not purely functional. If it is functional, consider whether some level of protection could be secured by seeking to register a two dimensional mark or a particular colour/combination of colours applied to the three dimensional mark, as such marks do not face the same restrictions as distinguishing guises.

Opposing/Invalidating: As above, consider whether the mark at issue is functional. An application for registration of a three dimensional shape trade-mark may also opposed or a registration invalidated on grounds that the mark is not distinctive, so also consider whether the mark (or a confusingly similar mark)

² By way of overview, the steps in an opposition proceeding are as follows: (i) statement of opposition (filed by the opponent); (ii) counterstatement (filed by the applicant); (iii) evidence (the opponent must file its evidence within 4 months after the applicant’s counterstatement is filed; the applicant will then have 4 months to file its evidence); (iv) cross-examination (optional); (v) written arguments (optional); (vi) oral hearing (optional); and (vii) decision. With respect to nullity administrative proceedings (i.e., based on non-use), the steps are as follows: (i) request for issuance of notice (requesting party files a request with the Trademarks Registrar to issue a notice requiring the trademark registrant to file evidence of use of the mark at issue in the past 3 years); (ii) evidence (the registrant has 3 months after the Registrar’s notice is issued to file evidence of use of the mark or special circumstances excusing non-use); (iii) written representations (optional); (iv) oral hearing (optional); (v) decision. Finally, a cancellation proceeding before the Federal Court would involve: (i) exchange of pleadings; (ii) documentary and oral discovery; (iii) trial; and (iv) decision.

has been used by others or whether the mark has been licensed by the trade-mark owners on terms which do not impose the requisite degree of control over the character or quality of the goods produced/sold under license. Use by others or improperly licensed use by others can negatively impact the distinctiveness of a mark. Extensive third party use can lead to the mark becoming generic.


A registration for a distinguishing guise may also be invalidated on ground that the registration has become likely to unreasonably limit the development of any art or industry.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

There are a significant number of cases in Canada in which applications for registration of distinguishing guises have been opposed and several in which decisions of the Registrar of Trade-marks rejecting applications for registration of distinguishing guises have been appealed to the Federal Court.

The leading case on the subject of distinguishing guises, and functionality in particular, is the decision of Supreme Court of Canada in *Kirkbi AG v. Ritvik Holdings, Inc.* (2005), 43 C.P.R. (4th) 383 (see <https://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2246/index.do>). In this case, the defendant (which is now known as Mega Brands) began making and selling “brick” toy building blocks after Lego's (the plaintiff) patent expired. Lego was unsuccessful in restraining the sale of Mega Brands’ building blocks. In dismissing Lego’s appeal of the lower courts’ decision that the cylindrical studs on Lego’s blocks were “functional in all respects”, the Supreme Court noted that “trade-marks law is not intended to prevent the competitive use of utilitarian features of products”.

There are not a great many other reported decisions involving the enforcement of distinguishing guise registrations against third parties. The most relevant decision is *Kraft Jacobs Suchard (Schweiz) AG et al. v. Hagemeyer Canada Inc.* (1998), 78 C.P.R. (3d) 464. In this case, the defendant, Hagemeyer, was the former exclusive Canadian distributor of Toblerone chocolate bars. Following the termination of the agreement, the defendant commenced sales of an “Alpenhorn” chocolate bar which came in a triangular package with bite-sized sections called “treads” or “peaks”. While the shape of the products was similar, they were not identical as the Alpenhorn treads/peaks had a more rounded appearance and the product packaging used a different colour scheme. Kraft commenced an action for summary judgment, in part relying on its registered distinguishing guise (see particulars below). The Court held in favour of Kraft given the similarities in the products’ packaging and shape.

Distinguishing Guise	Reg. No.	Wares	Owner
	TMA337,785	Milk chocolate with almonds and honey	Mondelez Europe GmbH (assignment in ownership since the 1998 case)

CHINA

Contributor: Dr. Qiang Ma

JUN HE

Beijing

www.junhe.com

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

Yes. It is possible to protect "SHAPE TRADE MARKS" in China.

In order to best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in China, we could take the following measures:

- (1) Apply for recordal of copyright in the work of art under Copyright Law;
- (2) Claim packing, decoration of famous or noted commodities in an unfair competition infringement case under Anti-Unfair Competition Law;
- (3) Apply for a three-dimensional trademark under Trademark Law; and
- (4) Apply for a Design Patent under Patent Law.

Registration of the Coke bottle and the Hershey's Kiss chocolate have both been applied for as Shape Trademarks in China. Please refer to the chart under Item 2 below.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

In order to apply for registration of a 3-dimensional Shape Trademark in China, we need to submit an application form, a signed POA and a scanned copy of the Certificate of Incorporation or the Certificate of Good Standing of the Applicant. In the application, we need to state that the applied-for mark is a 3-D mark, explain the way in which the mark is used, and provide specimens displaying the three-dimensional shape, which at least should include three-dimensional drawings (no more than 6 images are permitted).



- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

It is not required to provide evidence of distinctiveness of Shape Trademarks at the time of filing. The China Trademark Office (CTMO) does not accept such evidence materials at the filing stage.

The CTMO is very cautious in examining 3-D trademark applications and is likely to reject the same on the ground of non-distinctiveness. Assuming the CTMO rejects the application, we may appeal the rejection with the Trademark Review and Adjudication Board (TRAB) and argue the inherent distinctiveness and provide evidence of distinctiveness of the Shape Trademark acquired or strengthened through actual use.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

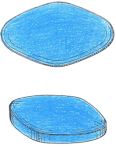

Two-dimensional Shape Trademarks:

2-D Mark	Application No.	Applicant	Class	Goods	Status
	806207	HERMES INTERNATIONAL	18, 14, 25	Bags; handbags; briefcases; jewelry; earrings; rings; shoes and slippers; scarf; <i>etc.</i>	Registered: Extended protection in China on 02/06/2013
	3031816	ZIPPO MANUFACTURING COMPANY	34	Lighters for smokers; <i>etc.</i>	Invalid Filed refusal review on 09/11/2002 Completed refusal review on 05/30/2008 Preliminarily approved for registration on 07/13/2008 Filed opposition on 07/13/2008 Completed opposition on 06/29/2011 Filed opposition appeal on

					08/12/2011 Unfavorable decision on opposition appeal issued on 04/13/2014
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Three-dimensional Shape Trademarks:

3-D Mark	Application No.	Registrant	Class	Claimed Goods/Services	Status
	IR No. 615994	MONDELEZ EUROPE GMBH	30	Chocolate products; coca; chocolate; pastry; candy, icy food.	Registered; Filed refusal review on 02/26/2003, Completed refusal review on 11/27/2006.
	3032478	THE COCA-COLA COMPANY	32	Beverages; fruit beverage (not containing alcohol; beverage, not containing alcohol; water (beverage); aerated water; etc.	Registered; Filed refusal review on 09/26/2002. Completed refusal review on 07/11/2005.
	IR. No. 783985	FERRERO S.P.A.	30	Coca products; Chocolate; candy; etc.	Registered; Filed refusal review on 05/07/2003; Completed refusal review on 10/30/2006.
	10831262	THE HERSHEY COMPANY	30	Coca; coca products; chocolate for baking; chocolate; etc.	Registered on 08/28/2013; Filed opposition on 08/27/2013; pending

					opposition.
	3110761	PFIZER PRODUCTS INC.	5	Pharmaceutical preparation; medicines for human purposes; antibiotics; pharmaceutical preparations for treating urinary system diseases and urinary incontinence	Registered on 6/19/2003 Filed invalidation on December 13, 2005, Pending invalidation
	IR. No. 798804	VOLKSWAGEN AKTIENGESELLSCHAFT	12, 16, 28	Automobile and the parts thereof; etc.	Registered; Extended protection in China on April 6, 2006.

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

3.1 China Trademark Law

[Scope of trademark]

Article 8:

Any sign capable of distinguishing the goods of a natural person, a legal person, or any other organization from those of others, including but not limited to word, design, letter, numeral, three-dimensional symbol, combination of colors, and sound, as well as a combination of the above, may serve as a trademark for registration application.

NOTE: The China Trademark Law added “*three-dimensional symbol*” to the scope of trademark in 2001.

[Non-distinctive mark]

Article 11:

The following signs may not be registered as trademarks:

- (1) A sign only bearing the generic name, design, or model of the goods.
- (2) A sign only directly indicating the quality, main raw materials, functions, uses, weight, quantity, or other features of goods.
- (3) Other signs lacking distinctiveness.

If a sign listed in the preceding paragraph has obtained distinctiveness through use and can be easily identified, it may be registered as a trademark.

[Non-functional requirement of 3D trademark]

Article 12:

Where the registration of a three-dimensional trademark is applied for, it shall not be registered if it is merely a shape resulting from the nature of the goods, a shape of the goods necessary for achieving a technical effect, or a shape to add a substantive value to the goods.

Anti-Unfair Competition Law

[Package, decoration of famous or noted commodities]

Article 5:

Any businesses should not use the following unfair methods in their business transactions which can damage another competitor:

to use the specific name, package, decoration of famous or noted commodities, or to use a similar name, package, decoration of famous or noted commodities, which may confuse consumers distinguishing the commodities from famous or noted commodities.

3.2 REGULATION

Regulation on the Implementation of the China Trademark Law (2014 Revision)

[Requisite procedure for applying a 3-D mark in China]

Article 13:

.....

Where an application is filed for registering a three-dimensional symbol as a trademark, it shall be stated as such in the application, the instructions for use of the trademark shall be provided, and a design including, at a minimum, the three-dimensional drawing, shall be submitted based upon which the three-dimensional shape can be determined.

Certain Regulations on Prohibiting Unfair Competition Activity concerning Imitating Specific Names, Packaging or Decoration of Famous Commodities (1995)

[Decoration of famous commodities]

Article 3(v):

“*Decoration*” refers to “*the writing, design, color and their combination attached to a commodity or its packaging so as to identify and beautify the commodity.*” According to the relevant court cases and practice, “*Decoration*” includes the shape of a commodity.

3.3 JUDICIAL INTERPRETATION

Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks (2002)

[Determining similar marks, including similar 3-D shape mark]

Article 9:

The term “*identical trademarks*” as provided in Article 52, Item 1 of the Trademark Law refers to there being basically no difference in visual perception between the trademark that is charged with infringement and the registered trademark of the plaintiff.

The term “*similar trademarks*” as provided in Article 52, Item 1 of the Trademark Law refers to the trademark charged of infringement and the registered trademark of the plaintiff being similar in the font style, pronunciation, meaning of the words, or in the composition and color of the pictures, or in the overall structure of all the elements combined, or in the three-dimensional shape or combination of colors so that the relevant general public may be confused about the origin of the commodity, or believe that there exist certain connections between the origin and the commodity, which is represented by the registered trademark of the plaintiff.

3.4 OTHER DOCUMENTS ISSUED BY THE CHINA SUPREME COURT AND THE CHINA TRADEMARK OFFICE

3.4.1 Annual Report of the Supreme People's Court on Intellectual Property Cases (2012) (Abstract) (Title Only)

[Examining and determining the distinctiveness of partial shape of a product]

25. Administrative dispute between HERMESITAUES.P.A. and the TRAB regarding trademark refusal review on (IR No. 798099)

When applying for a 3-D mark featuring partial shape of a product, considering the 3-D shape generally cannot be used separately without the products *per se*, the relevant public is likely to consider it as a constituent part of a product rather than a trademark, so the trademark application for the 3-D mark shall be rejected, except if the shape of the product is distinguishable from shapes of the other similar products, or if the applicant can demonstrate that the relevant public has been able to associate the shape with a certain product provider through trademark use.

3.4.2 Annual Report of the Supreme People's Court on Intellectual Property Rights Cases (2009)

[Definition of Trademark Use in terms of Trademark Infringement (concerning Shape Trademark)]

According to Article 52 of the China Trademark Law (Article 57 of new Trademark Law), without authorization of the trademark registrant, using a trademark identical/similar to a registered trademark on identical/similar goods shall be

considered trademark infringement. However, the requisite condition of trademark use in trademark infringement is that the use shall be designed to identify the origin and the producer.

In the trademark dispute between the retrial Applicants, Pfizer Products Co, Ltd., Pfizer Pharmaceuticals Ltd (collectively refers to “Pfizer”) and the Respondents, Jiangsu Lianhuan Pharmaceuticals Co., Ltd. (“Lianhuan”) and Guangzhou Weierman Pharmaceuticals Co., Ltd. (“Weierman”), the Supreme Court held that it is not trademark use if the use cannot be functioned to identify the origin or the producer. Accordingly, if one uses the mark in that way on identical/similar goods, it does not constitute trademark infringement. (Please refer to the enforcement case No. 6.4 in Question 6 below).

3.4.3 Trademark Examination Standard 2005

Part Four: Examination of Shape Trademarks

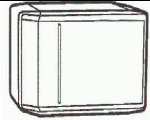
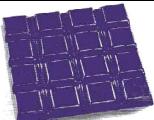
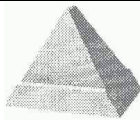
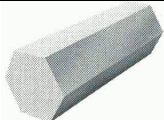


Section Two: Relevant Interpretation

A three-dimensional Trademark includes the shape of goods, the packaging of the goods or other 3-D symbols.



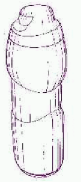

Section Four (iv): Examination of the distinctive feature of 3-D Trademark

If a 3-D trademark (1) merely contains the generic or frequently-used shape, packaging of the designated goods, or (2) if the mark as a whole cannot be used to identify the origin of the goods, or (3) if the specimen submitted by the applicant is too vague to identify the 3-D shape, the mark is considered to lack distinctiveness.




(1). “merely contains the generic or frequently-used shape, packaging of the designated goods”

Mark						
Claimed Goods	Loudspeaker	Chocolate	Chocolate, cake	Chocolate, candy	Spirit	Cosmetics


Exception: if the mark is not the generic or frequently-used shape, packaging of the designated Goods or contains another distinctive symbol.

Mark				
Claimed Goods	Nutrition	Vehicles and parts thereof	Fruit beverage and juice	Beers

(2) Other symbols lacking distinctiveness

Mark			
Claimed Goods	Glasses and glasses case	Vehicles	Perfume

Exception: a 3-D symbol that is distinctive

Mark	
Claimed Goods	Restaurant; hotels.

Section Five: Examination of similarity of 3-D mark

(1). Examination of similarity of 3-D marks

a) Assuming that two marks are composed of 3-D symbols and the structure, shape and overall visual effect of the symbols are identical or similar, so that consumers will be easily confused as to the origin of the goods/services, then the two marks are considered to be identical or similar marks.

b). Assuming that two marks are composed of distinctive 3-D symbols and another distinctive symbol, if the 3-D symbols or the other symbol are identical or similar, so that consumers will be easily confused as to the origin of the goods/services, the two marks are considered to be identical or similar marks.

c). Assuming that two marks are composed of non-distinctive 3-D symbols and another distinctive symbol, if the other symbols are identical or similar, so that consumers will be easily confused as to the origin of the goods/services, the two marks are considered to be identical or similar marks.



Exception: If the other distinctive symbols of the two marks are clearly distinguishable, so that consumers will not be confused as the origin of the goods/services, the two marks are not considered to be identical or similar marks.

Mark		
The other symbol	(Word: KRUG)	(Word: LA GRANDE DAME)

(2). Examination of similarity of 3-D mark and 2-D mark

a) If a 3-D mark is composed of a non-distinctive 3-D symbol and another distinctive symbol, and the distinctive symbol is identical/similar to the distinctive part of a 2-D mark, so that consumers will be confused, the two marks are considered to be identical or similar marks.

b) If the 3-D symbol of 3-D mark is distinctive, but it is visually identical/similar with the distinctive part of a 2-D mark, so that consumers will be confused, the two marks are considered to be identical or similar marks.


Mark		
Claimed Goods	Clothing; shoes; caps	Clothing; shoes; caps

3.5 CASES

China adopts the Civil Law system, so court cases are not precedential. However, in trademark practice, the court may refer to decisions of higher courts before making its

decision in a specific case. Through providing the following cases, we hope to illustrate court practice in dealing with Shape Trademarks.


3.5.1 Trademark refusal review decision dispute between FERRERO S.P.A. and the TRAB regarding –The Beijing First Intermediate People’s Court (2007)

FACT: FERRERO applied for designating the protection of its IR mark “” (IR.No.783985) in China in association with “coca products; chocolate; candy; *etc.*” in Class 25. The CTMO rejected the designation on the ground of non-distinctiveness. FERRERO appealed the rejection with the TRAB and provided 79 pieces of evidence showing that the mark had acquired distinctiveness through extensive use. The TRAB sustained the rejection on the ground that the mark was a common packaging of the claimed goods, which could not be used to identify the product provider. FERRERO filed a lawsuit before the court.

ISSUE: Whether a unique chocolate packaging is a distinctive mark?

FINDING: Yes, the court held that the IR mark is a distinctive mark. The TRAB argued that the IR mark was common packaging, but it did not provide evidence showing the same. To the contrary, the color and product packaging chosen by the IR mark did not fall within the range of choices for common product packaging in the industry and the claimed Goods. The unique design of the IR mark had become a symbolic design of the FERRERO’s products. When seeing the IR mark, consumers could clearly identify the origin of the product bearing the mark. The IR mark has obtained distinctiveness as a trademark, which shall be extended to protection in China.

3.5.2 Trademark refusal review decision dispute between ZIPPO MANUFACTURING COMPANY and the TRAB –The Beijing First Intermediate People’s Court (2008)

FACTS: ZIPPO applied for registration of the mark “” (Reg. No. 3031816) on the claimed Good: “lighters for smoking” in Class 34. The CTMO rejected the application on the ground of non-distinctiveness. ZIPPO appealed the rejection. The TRAB sustained the rejection on the ground that the 3-D mark merely displayed the common image of the claimed Goods. ZIPPO later filed a lawsuit before the court.

ISSUE: Whether an original shape of a lighter is a distinctive mark?


FINDING: The court held that it was a distinctive mark.

The mark was comprised of the following elements: 1.the overall appearance is a flat cuboid; 2. the main surface is planar; 3. the edges are slightly rounded; 4. the top surface appears slightly arched; 5. the bottom surface consists of a linear pattern; 6. the overall shape is divided into two parts in a 5:7 proportion; 7. There is a shaft structure on the right side of the product and placed in the joint place between the upper and lower portions. The shaft is shorter than the joint line and bulged outwardly displaying a cross-section as a semi-circle.

The court further held that the TRAB wrongfully omitted the above elements 6~7 in determining the distinctiveness of the mark. The 3D mark adopted a cuboid-like design, which contained several specific elements, especially element 7. The overall design of the 3-D mark was original and did not fall within the range of common design choices. Accordingly, the originality of the overall shape made the mark a symbolic design that could identify the origin of the lighters. The IR mark has obtained distinctiveness as a trademark, which shall be registered in China.

Though the -3D mark has been preliminarily approved for registration through judicial procedure, it was later opposed by a third party. It appears the CTMO made a decision in favor of ZIPPO, and the third party later filed an opposition appeal with the TRAB. However, the TRAB overturned the CTMO's decision on March 14, 2014. We do not yet know whether ZIPPO has appealed before the court.

3.5.3 Trademark refusal review decision dispute between Emerson Electric Co. and the TRAB – the Beijing High People's Court (2010)

FACTS: Emerson applied for registration of the mark “” (Reg. No. 3975565) for a sealing side button (machine part) in Class 7 on 24 March 2004. The CTMO rejected the same on the ground of non-distinctiveness. Emerson appealed the rejection with the TRAB, which sustained the CTMO's decision. A Lawsuit was filed before the first-instance court. The court upheld the decision. Emerson appealed to the Beijing High People's court. The court upheld again.


ISSUE: Is the unique shape of a machine part inherently distinctive?

FINDING: No. In determining whether a symbol is distinctive, the relation between the symbol and the claimed Goods/Services shall be considered. Assuming the symbol is less related to the Goods/Services, it is more distinctive. If the symbol is more closely related to the claimed Goods/Services, it is less distinctive. Emerson's 3-D mark is the product claimed by the mark. In the scenario that registering a 3-D mark featuring the shape of a product, since the trademark completely overlaps with the mark, the shape is not a distinctive trademark, except that there is evidence proving that the mark has been used to the extent that consumers are able to identify the product provider by it.

Emerson argued that the clover design on the 3-D mark is unique, which can distinguish itself from the same kind of products of the other traders in the marketplace. It merely proves that the 3-D symbol can be protected by copyright law and patent law, but it is not the ground of trademark distinctiveness. Distinctiveness requires distinguishing from different Goods/Service providers, rather than from different products. Beside, Emerson did not provide evidence of acquired distinctiveness by use in mainland China. Therefore, the court did not uphold Emerson's assertion through lack of merit.

3.5.4 Trademark refusal review decision dispute between Coca-cola Company and the TRAB – The Beijing High People's Court (2011)



FACTS: Coca-cola applied for registration of the mark “” (Reg. NO. 3330291) on “non-alcoholic beverage; water (beverage); aerated water; *etc.*” in Class 32 on 8 October 2002. The CTMO rejected the same on the ground that the applied-for mark is a common container of beverage, which lacks distinctiveness. Coca-cola appealed the rejection with the TRAB, which sustained the CTMO's rejection. A lawsuit was filed with the Beijing First Intermediate Court. The court upheld the TRAB's decision. After appeal, the Beijing High People's Court also upheld the first instance ruling.

ISSUE: Is the unique shape of a beverage bottle inherently distinctive?

FINDING: No. In determining whether a symbol is distinctive, the relationship between the symbol and the claimed Goods/Services shall be considered. Assuming that the symbol is less closely related to the Goods/Services, it is more distinctive. If the symbol is more closely related to the claimed Goods/Services, it is less distinctive.

When registering a 3-D mark featuring the shape of a product container, the shape shall distinguish the origin of the Goods/Services. The distinctiveness is not attributed to the unique design of the container *per se*, but the design that can be used to identify different origins of products. If the container differs from that used by the same kind of products, but consumers cannot identify the provider of the goods from it, the 3-D mark can only acquire distinctiveness after it has been used to the extent that consumers are able to identify the product provider through it.

The evidence of use submitted by Coca-cola dated after the application date of the 3-D mark. Even considering this evidence, this use was insufficient to demonstrate the acquired distinctiveness.

3.5.5 Dispute regarding use of specific decoration of the noted commodities without authorization between Retrial Applicants (Defendant) Ningbo Weiyada Pen Co., Ltd., Retrial Respondent (Plaintiff) Shanghai Zhonghan M&G Stationary Manufacture Co., Ltd., Defendants Ningbo Weiyada

Stationary Co., Ltd. and Shanghai Chengshuo Industry and Commerce Co., Ltd. – The Supreme People’s court (2010)



FACTS: M&G filed a lawsuit against Weiyada, asserting that the M&G K-35 gel pen was a famous pen, and the Wieiyada 681 gel pen produced and sold by Weiyada and Chengshuo imitated the specific decoration of the K-35 gel pen, which constituted unfair competition. The Shanghai No.2 Intermediate Court held that the pen cap clip and ornament ring of the K-35 gel pen were specific decorations of a famous commodity. The pen cap clip and ornament pen of the 681 gel pen essentially had no differences with K-35 gel pen, which constituted similar product decoration, besides, the other part of the two products were also similar, the similarity of the overall appearance was sufficient to confuse consumers. Weiyada engaged in unfair competition as it produced and sold 681 gel pens carrying the specific decoration of M&G’s famous commodity without authorization. Weiyada appealed, arguing that the court erroneously concluded the product *per se* and the exterior design were specific decoration. It violated law and judicial interpretation. The Shanghai High People’s Court sustained the ruling of the Intermediate Court. Weiyada appealed to the Supreme People’s Court.

ISSUE: (1) Whether an industrial design, after expiration of the patent right, can be protected according to the Anti-Unfair Competition Law? (2) What are the requisite conditions for protecting a shape and structure decoration as the specific decoration of a famous commodity?

FINDING:

(1) As an industrial design may be used as the packaging or decoration of a product, it is also entitled to be protected by Anti-Unfair Competition Law, if the following conditions are satisfied: 1. the products carrying the design shall be a famous commodity; 2. the design can be use to distinguish the origin of products, so it constitutes specific packaging and decoration of the famous commodity; 3. the design is not functional; and 4. use of the design by others will confuse or mislead the relevant public.

(2) Decoration includes two types: One is the word and device decoration, namely, any word, device, color and the arrangement thereof. The other one is the shape and structure decoration: It is inherent in and belongs to a product, and is also the entire and partial shape or structure of the product with decorative function.

In order to prove the shape and structure decoration: two requirements shall be met: 1. the shape and structure shall distinguish itself from the other common designs; and 2. through use in the marketplace, the relevant public has associated the shape and structure with the specific producer and provider, namely, the shape and structure has acquired secondary meaning through use.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidity and Cancellation Proceedings regarding Registered Shape Trade Marks.

The forum and procedure in the opposition, invalidation and cancellation proceeding regarding Registered Shape Trademarks are the same with those of common trademarks. There is no special forum or procedure devised for Shape Trademarks in China.

4.1 Opposition proceeding regarding Shape Trademarks – Articles 33 and 35

If a Shape Trademark is preliminarily approved by the CTMO, any prior right owner or interested parties may file an Opposition against the Shape Trademark based on Article 13.2~3 (well-known mark), Article 15 (unauthorized registration of an agent), Article 16 (geographical indication), Articles 30~31 (prior similar mark applied-for/registered), Article 32 (infringe prior rights of the others / pirate unregistered marks that have been in use and influential) within three months following publication.

Anyone may file an Opposition against a Shape Trademark based on Article 10 (unregistrable marks), Article 11 (non-distinctive marks) and Article 12 (non-functional requirement of 3-D trademarks) within three months following publication.

After filing the Opposition, the Opposer may submit supplementary arguments and evidence within 3 months from the opposition date.

The CTMO, after receiving the opposition materials, shall forward the same to the Opposed Party. The Opposed Party may respond to the opposition within a 30-day period and submit a response within the following 3 months. There is no statutory procedure for the Opposer to file counter-arguments against the response in the opposition.

The statutory period for the CTMO to process and complete an Opposition is 12~18 months. If the CTMO decides to approve the registration, a certificate of registration will be issued. Assuming the Opposer is dissatisfied with it, it is entitled to file an invalidation action against the Registered Shape Trademark with the TRAB.

If the CTMO decides to reject the registration, and the Opposed Party is dissatisfied with it, the Opposed Party may appeal the opposition with the TRAB within 15 days upon receipt of the same. The statutory period for the TRAB to process and complete the appeal is 12~18 months. Assuming the Opposed Party is still unsatisfied with the

appeal decision, it is entitled to file a lawsuit against the decision before the Court within 30 days following receipt of the same.

4.2 Invalidation proceeding regarding Shape Trademark – Articles 44 and 45

(1) If a Registered Shape Trademark violates the provisions of Article 10 (unregistrable marks), Article 11 (non-distinctive marks) and Article 12 (non-functional requirement of 3-D trademarks), or its registration was acquired by fraud or any other illicit means, the CTMO shall declare invalidation of the Registered Shape Trademark; and any other organization or individual may petition the TRAB to declare a Registered Shape Trademark invalid.

The CTMO shall notify the registrant if it makes an invalidation decision. If the registrant is dissatisfied, it may appeal the decision with the TRAB within 15 days after receipt. The TRAB shall make a decision within 9~12 months to process and complete the decision. If dissatisfied, the registrant is entitled to file a lawsuit before the court within 30 days after receipt of the decision.

As for an invalidation filed by another organization or individual, the TRAB shall, after receiving the application, notify the registrant, who may respond to the opposition within a 30-day period and submit supplements within the following 3 months. The TRAB shall forward the response to the petitioner for rebuttal, the petitioner, after receiving a notice for exchange of evidence, is entitled to file counter-arguments and evidence against the response within the following 30 days.

The TRAB shall make a decision within 9~12 months after receiving the application. If dissatisfied with the decision, the party concerned is entitled file a lawsuit within 30 days after receiving the notice. The People's Court shall notify the opposite party in the trademark ruling proceedings to participate in the action as a third party.

(2) Where a Registered Shape Trademark violates Article 13.2~3 (well-known mark), Article 15 (unauthorized registration of a agent), Article 16 (geographical indication), Articles 30~31 (prior similar mark applied-for/registered mark), Article 32 (infringe prior rights of the others / unregistered marks that have been in use and influential), a prior rights holder or an interested party may file an action for invalidation of the registered trademark with the TRAB within five years from the date of trademark registration. If the registration is acquired in bad faith, a well-known trademark holder shall not be subject to the five-year time limit.

The invalidation procedure is the same with the above. The statutory period for the TRAB to process and complete the invalidation is 12 ~18 months.

4.3 Cancellation proceeding – Article 49

Any other organization or individual may file a non-use cancellation for 3 consecutive years against a Registered Shape Trademark.

The CTMO shall notify the registrant of the cancellation. The registrant may respond to the opposition within a 30-day period and submit evidence of use within the

following 3 months. However, there is no statutory procedure for the applicant to rebut the evidence. The CTMO shall complete the cancellation within 9~12 months.

If dissatisfied with the CTMO's decision, the parties are entitled to appeal to the TRAB within 15 days from receipt of a decision notice. The registrant may respond to the opposition within a 30-day period and submit evidence of use within the following 3 months. The applicant is entitled to rebut the evidence within 30 days after receiving a notice of evidence exchanged issued by the TRAB. The statutory review period is 9 ~ 12 months. Upon receipt of the decision, the parties are also entitled to file a lawsuit before the court within a 30-day period.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

5.1 Filing stage

Though the evidence of distinctiveness is not necessary at the filing stage, seeing that the CTMO is cautious in registering a Shape Trademark, it is advisable to analyze the registrability of the Shape Trademark to be filed and plan to prepare and file evidence showing that consumers have associated the Shape Trademark with the provider of the claimed Good after extensive use. By doing this, we may react promptly when a possible rejection occurs.

In addition, a pre-filing search can help to identify the prior blocking marks and the chances of success in overcoming the obstacles.

5.2 Cancellation

Cancellation is a cost-effective, but passive procedure.

In the proceeding, the burden of proof is on the registrant. There is no statutory procedure for the applicant to review and rebut the evidence of use submitted by the registrant. The applicant has to wait until the decision is made by the CTMO, which may take 9~12 months.

If the decision is unfavorable, we usually recommend appealing the cancellation with TRAB, as the applicant then has a chance to review the evidence and rebut it by arguing illegality, authenticity and relevancy of the materials. As for the Shape Trademark, we may argue that the mark is merely a common shape, packaging, or decoration of the products rather than a distinguishable trademark. Accordingly, the evidence cannot prove use of the Shape Trademark.

5.3 Invalidation and opposition

In an invalidation or opposition proceeding against a Shape Trademark Registration, we may take the following measures:

a. Market Survey - collecting materials showing (1), that the shape has been commonly adopted by other providers of the same Goods/Services in the marketplace; and (2) that there is insufficient evidence of use in China before the filing date of the Shape Trademark.

b. Trademark Survey - demonstrating that consumers cannot or do not associate the shape with the product providers.

5.4 Other actions

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

6.1. *Trademark infringement dispute between SOCIETE DES PRODUITS NESTLE S.A. and Kaiping Weishida Seasoning Co., Ltd. – Guangdong High People's Court (2010)*

	
NESTLE (IR.No. 640537)	Weishida

FACTS: Nestle sent two cease and desist letters to Weishida, requesting that they cease infringing the Shape Trademark and stop manufacturing or entrusting others to manufacture any products carrying the trademarks that are identical/similar with NESTLE's IR No. 640537.....

Weishida filed a non-infringement lawsuit before the Guangdong Intermediate People's Court. The court ruled in favor of Weishida. Nestle appealed to the Guangdong High People's Court. The second instance court sustained the judgment.

ISSUE: (1) Whether the IR No. 640537 is a distinctive mark; and (2) whether the asserted infringement items using similar shape design, but carrying a distinguishable word mark and label will confuse or mislead consumers as to the origin of the product.

FINDING: (1) The court held that the IR mark is a container of the products, and has been used as a soy sauce container by many other domestic companies, so the distinctiveness of the mark is weak. In this case, Nestle did not provide sufficient

evidence of use of mark in mainland China, but Weishida provided considerable evidence showing that the mark has been used as a soy sauce container in China before the registration date of the mark in China. Therefore, the IR mark has not acquired distinctiveness through use.

(2) The trademark similarity requires that: “Consumers mistakenly identify the origin of the products or are misled into believing the mark in dispute is related to the products carrying the Plaintiff’s mark”.

In this case, the asserted infringement item is not the brown bottle *per se*, because Weishida uses it as the container of its products rather than as a trademark. In comparing the marks, the packaging, the decoration, the trademark visible to consumers should also be considered. In this case, the brown bottle has the word mark “味事达 Master” which has been recognized as a well-known mark, the labels, and the information of the producer included on it. Therefore, consumers will not mistakenly identify the origin of the products, nor will they be misled into believing that the mark in dispute is related to the products carrying Nestle’s mark.

6.2. Unfair competition dispute between the FERRERO S.p.A and Zhangjiagang Mengtesha Food Co., Ltd. and Tianjin Economic Technology Development Zone Zhengyuan Marketing Co., Ltd. – The Supreme People’s Court (2008)

	
FERRERO	金莎TresorDore

FACT: The Retrial Respondent FERRERO (“the Plaintiff”) was established in Italy in 1946. Ferrero launched the FERRERO ROCHER chocolate on the market in 1982. The products were advertised on TV, in newspapers and magazine in many countries and districts of Asia. In Taiwan and Hong Kong, FERRERO ROCHER chocolate is named “金莎”(Jin Sha), which was registered as a trademark in Taiwan in June of 1990 and in Hong Kong in 1993.

In February of 1984, FERRERO ROCHER entered the market of mainland China through China Cereals Oils and Foodstuffs Import and Export Corporation (COFCO). The products were only sold in the locations permitted by the local policy, such as duty free shops and airport stores. Before 1993, FERRERO ROCHER chocolates were sold in the China market through consignment business between Ferrero and COFCO.

The packaging bore the trademark “金莎” and Device, which was not registered as a trademark in China. The main features of the package and decoration of FERRERO ROCHER chocolates are: 1. Every piece of globular chocolate is wrapped with golden paper; 2. The golden globular paper wrap is decorated with a “oval golden rim” label bearing the trademark FERRERO ROCHER; 3. Every piece of globular chocolate has a brown paper holder; 4. some plastic transparent packages showing the golden globular wrap inside, 5. Every plastic transparent package is decorated with a “oval golden rim” label bearing the product image and trademark, from which a red golden ribbon design is extended. Among them, 8-piece, 16-piece, 24-piece and 30-piece 3-D packages have been registered as 3-D trademarks with WIPO in 1984. In October of 1986, Ferrero registered the trademarks “FERRERO ROCHER and Device” (oval golden rim) and used the same on the products sold in mainland China market. After 1993, Ferrero began a direct-selling business through its general agency and enhanced the advertisement in various areas, including Guangdong, Shanghai and Beijing. In the meantime, it established sales counters in many business areas of big cities and increased the reputation by sponsoring business and sports activities. In 2000, the FERRERO ROCHER trademark was recognized as a National Important Trademark. The overall packaging and decoration of the products has remained unchanged since 1984. The AIC in Guangdong and Hebei has been investigated and punished for counterfeiting activities on numerous occasions.

The Retrial Applicant Mengtesha (Defendant) was established in December of 1991. It is a joint venture company by Jiangsu Zhangjiagang Dairy Products No.1 Factory and a Belgium company. Since 1990, No.1 Factory had sold chocolates bearing the mark “金莎”, which was registered in China. The main features of the package and decoration of the “金莎” products were identical to that of FERRERO ROCHER products. In June of 1990, the Factory applied for the combination mark “金莎” & “oval rim device”, but the CTMO dismissed the mark in the opposition lodged by Ferrero. However, the Factory still used the rejected mark on the products. The “金莎” branded products won several prizes in Zhangjiagang City and Jiangsu Provinces and was recommended and awarded by the industry association.

In 2002, No. 1 Factory transferred the “金莎” mark to Mengtesha. The company began to produce and sell “金莎 TRESOR DORE” branded chocolate products. But the main features of the packaging and decoration of products are similar to that of FERRERO ROCHER products “TRESOR DORE”, which was registered in July 2003.

ISSUE: (1) Whether the FERRERO ROCHER chocolate is a famous commodity? (2) whether the packaging and decoration of FERRERO ROCHER chocolates are specific packaging and decoration? and (3) whether the packaging and decoration of “金莎 TRESOR DORE” branded chocolate products constitutes unfair competition.

FINDING: (1) The reputation of the Goods/Services generally results from the business activities in mainland China. In determining famous commodities, considerations should be taken of several factors, including the sales time, sales locations, sales volume, consumers, period, degree and areas of any kind of advertising, protection history as famous commodities. The factor of overseas

reputation may be also taken into consideration. In this case, given the time of FERRERO ROCHER entering the local market, sales and advertising activities, FERRERO ROCHER products are a famous commodity.

(2) The packaging and decoration of FERRERO ROCHER chocolate are specific packaging and decoration.

If the packaging and decoration of the product can be used to identify the origin of the product, they are specific packaging and decoration under Anti-Unfair Competition Law. The packaging and decoration of FERRERO ROCHER are composed of several factors. If the packaging and decoration are simply composed of (1) foil paper wrapped globular chocolate; and (2) plastic transparent packaging displaying the inside chocolate wrap, they are not specific due to lack of distinctiveness. Besides, each factor thereof is a common packaging or decoration element in the food industry. However, the combination of packaging materials (such as, foil paper, holder, plastic box) and the shape, color providing a broad range of choices, the label size, device and layout are also at a designer's free choice. Within the scope of free design, the unique arrangement and combination of every packaging and decoration element, once it has obtained distinctive features, can constitute specific packaging and decoration.





In this case, the combination of word, device, color, shape and device is so unique that the packaging and decoration of FERRERO ROCHER chocolates form a distinct overall appearance and are unrelated to the product function; moreover, consumers have firmly associated the above overall packaging and decoration with FERRERO ROCHER chocolates after the long-term and extensive use and advertising of Ferrero. The packaging and decoration can be used to identify the origin of products, which falls within specific packaging and decoration.

(3) Relevant public will easily confuse the “金莎 TRESOR DORE” branded chocolate with the FERRERO ROCHER chocolate.

Confusion and misleading conduct under Anti-Unfair Competition Law is where sufficiently confusing or misleading the relevant public as to the origin of the products, including if the public mistakenly believes that the Good has some special relation with the owner of the famous commodity, such as a license to use or the producer is an affiliated company. In this case, the overall packaging and decoration of a FERRERO ROCHER chocolate and a 金莎 TRESOR DORE chocolate are highly similar in visual effect, even though the two products are different in size, quality, taste, class of consumers, name of producer and word mark, it is unavoidable that the relevant public will mistakenly believe there is some business relationship between the two products.

6.3 Trademark infringement dispute between CHIVAS BROTHER (AMERICAS) LIMITED and Yantai Aowei Wine Co, Ltd. – Zhejiang High People's Court (2012)

CHIVAS' registered marks

			
Reg. No. 841288	Reg. No. 877660	IR. No. 854368A	IR. No. 856709C

Yantai Aowei and Yantai Zhihuashi Company produced and sold counterfeit products. The shape of the wine bottle was similar with CHIVAS' IR No. 856709C mark; the devices on the labels and packaging box were similar with the IR No. 854368A and Reg. NO. 877660 marks in composition and overall arrangement; and words on the bottom of the bottles were identical with the Reg. No. 841288 mark. Therefore, the products used the marks and decorative device that were identical/similar with CHIVAS' registered mark. As the overall appearance and visual effect essentially had no difference, the relevant public would be easily confused or misled as to the origin of the products. The defendants infringed the trademark rights of CHIVAS.

6.4 The trademark dispute case between the retrial petitioners Pfizer products Co, Ltd., Pfizer Pharmaceuticals Ltd (collectively refers to "Pfizer") and the Respondents Jiangsu Lianhuan Pharmaceuticals Co., Ltd. ("Lianhuan") and Guangzhou Weierman Pharmaceuticals Co., Ltd. (Weierman) – The Supreme People's Court (2009)

	<p>伟哥</p> <p>(Wei Ge; an unofficial Chinese transliteration of "Viagra")</p>	 
Reg. No. 3110761 in the name of Pfizer products Co, Ltd	Reg. No. 1911818 in the name of Weierman (now owned by Shenzhen Fenghuang Life Culture Media Advertising Co., Ltd.)	Lianhuan's phentolamine mesilate product

FACT: Pfizer registered the above 3-D mark (Reg. No. 3110761) on “*pharmaceutical preparation, etc.*” in 2003. Weierman registered the Chinese character mark “伟哥” (wei ge) on “*medicines for human purposes*” with the CTMO in 1998. In 2005, Lianhuan was licensed to use the word mark on its product “*phentolamine mesilate dispersible tablets*”. The product used a blue paper package bearing the mark “伟哥 TM” and the producer’s name “Jiangsu Lianhuan Pharmaceuticals Co., Ltd.” The tablets, which are in blue diamond shape, were packaged with an opaque material. In 2005, Pfizer filed a lawsuit against Weierman, Lianhuan and a retailer for trademark infringement.

ISSUE: Is it trademark infringement if a product for sale imitated another’s 3-D mark, but wrapped with an opaque material bearing a distinctive mark and the producer’s name?

FINDING: No. The first-instance court held that the defendant’s conducts infringed the trademark right of Pfizer. Lianhuan appealed. Beijing People’s High Court overturned the ruling, holding that though the products at issue were similar with Pfizer’s 3-D mark, consumers would neither confuse it with the prior 3-D mark nor mistakenly believe that it related to the plaintiffs at time of purchasing. The Plaintiffs appealed to the Supreme People’s Court. The Supreme Court held that the foil wrapper of the product displayed a raised diamond shape, and the word “伟哥” was combined with a yellow diamond device, but consumers could not identify the shape of the products at the time of purchasing. The product was wrapped with an opaque material and its color and shape could not be used to identify the origin and the producer, so it was not trademark use in terms of trademark infringement. Even if the product shapes were identical or similar with Pfizer’s 3-D mark, consumers would neither confuse it with Pfizer’s mark, nor mistakenly believe that it had a particular relationship with Pfizer at the time of purchasing.

EUROPE

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "shape trade marks" in your country? Yes/No

Yes, product shapes and packaging can be registered as three-dimensional trade marks under the Regulation No 207/2009 (Community Trademark Regulation, "CTMR"), see in particular Article 4 CTMR. Such a registration provides a powerful and reliable tool to counter infringements. It also has, contrary to other tools of intellectual property protection (patents, designs, copyrights), the advantage of being available for an unlimited number of years provided that the owner renews the registration periodically and the trade mark is used in trade.

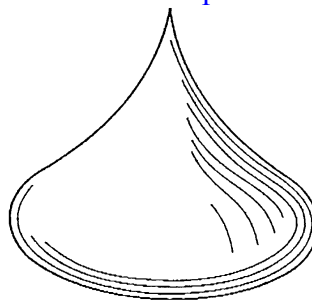
It is, however, not always easy to obtain a registration for a product's shape. The Office for Harmonization in the Internal Market ("OHIM"), as the Community Trade Mark Office, applies rather strict criteria. The reason is that the Court of Justice (the highest judicative body in the EU) has ruled that consumers do not usually make assumptions about the origin of products on the basis of their shape or the shape of their packaging. A three dimensional sign is therefore registrable only if it departs significantly from the norm or customs of the sector or if it has acquired distinctiveness by virtue of its use.

In some cases it may therefore be advisable to consider a design registration as a fallback position or as a means of protection during an initial period of use. Pan European Registered Community Design rights ("RCDs") can be obtained by application to the OHIM. The initial period of protection is five years. It may last 25 years subject to payment of five-yearly renewal fees. The RCD however needs to be novel and to have individual character to be valid.

Now let us stick to the examples provided in the question above. The shape of the Coke bottle was indeed registered at OHIM as a three dimensional mark under CTM no. 2 754 067. No claim of acquired distinctiveness was made. Representation of the mark can be seen below.

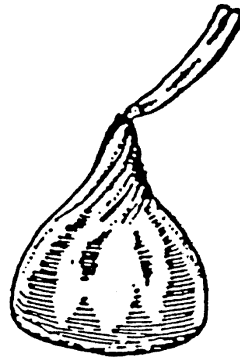


On the other hand Hershey's CTM application No. 712 075 filed on 24 December 1997 for the three dimensional mark below representing a Kiss



was partially refused since it was considered as being devoid of any distinctive character in accordance with Article 7(1)(b) CTMR for the applicant's goods of interest in classes 5 and 30 of the Nice Classification i.e. *inter alia* "non medicated confectionery, milk chocolate with almonds, goods made wholly or principally of chocolate, candy and confectionery, non-medicated chocolate confectionery candy sweets (also made with sugar-free sweetening means)". The CTM application was subsequently abandoned for the rest of goods not objected in classes 5 and 30 and never got registered.

Likewise Hershey's CTM application no. 712 828 (figurative) below suffered the same fate i.e. it was partially refused by OHIM and finally abandoned.



An appeal against the (partial) refusal was brought to the General Court which however upheld the OHIM's decision (judgment of 5 June 2002 in Case T-198/00 *Hershey Foods v OHIM*).

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

A representation of the mark must be supplied. It shall consist of a photographic reproduction or a graphic representation (Rule 3 (4) Regulation No 2868/95). If filed in colour, the colours making up the mark must be indicated.

The photographic or graphic representation may consist of up to six perspectives of the mark. The OHIM Guidelines clarifies that it *"must be submitted in one single JPEG file in the case of e-filed applications or on one single A4 sheet in the case of paper-filed applications. ... A single view of the shape is sufficient where the shape to be protected can be ascertained from that single view."* (Guidelines for Examination in the Office, Part B, Examination, Section 2 Formalities, paragraph 9.3).

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

Under EU trademark law, actual use is not a requirement to acquire trademark rights. There has to be no use in the EU or elsewhere at the time of filing, or at the time of registration. Likewise, no statement of use is requested at later stage (e.g. upon renewal of the mark).

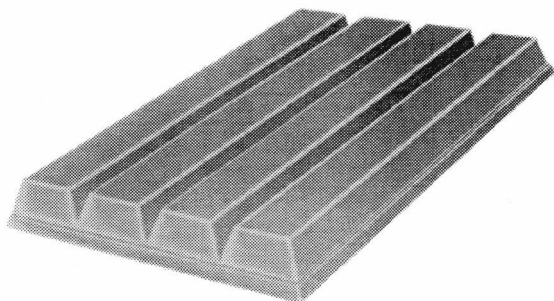
That said, the applicant may need to file evidence of acquired distinctiveness to overcome notice of refusal issued by OHIM if the latter finds the Shape Trade Mark devoid of any distinctive character (Article 7(1)(b) CTMR), descriptive (Article 7(1)(c) CTMR) or generic (Article 7(1)(d) CTMR).

2. Please give some examples of actual shape trade marks (two-dimensional or three-dimensional) that have been successfully registered in your country

Apart from the Coke bottle reported under paragraph 1 above, we would like to highlight CTM no. 1 162 395 which has been successfully registered as inherently distinctive.



The General Court ("GC") in Case T-393/02 of 24 November 2004 held that the container in question has a particular and unusual appearance which distinguishes it from other shapes available on the market for washing and cleaning products. Likewise CTM no. 2 632 529 below has also been registered by OHIM:



The mark had to endure a Cancellation action, but the OHIM Board of Appeal took the view that the CTM owner had proved that its mark acquired distinctive character in a substantial part of the EU. It could not therefore be declared invalid for having been registered in breach of Article 7(1)(b) CTMR. An appeal against that decision is currently pending before the General Court. The Court's response is eagerly awaited as it may clarify some important aspects on three dimensional marks.

In contrast to the recent approach requiring proof of acquired distinctiveness in a substantial part, but not in all EU (inspired by CJEU judgment C-98/11 P, of 24 May 2012), there existed a previous line of case law which was stricter. An example in that regard is GC judgment of 8 July 2009 in Case T-28/08 *Mars v OHIM - Ludwig Schokolade* concerning the following shape of a chocolate bar



The mark was finally invalidated since the Court confirmed that there was insufficient evidence of acquired distinctiveness in the whole of the relevant EU territory (at that point in time consisting of 15 countries).

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with shape trade marks

Regulations

- Regulation No 207/2009 of 26 February 2009 on the Community trade mark. See in particular Article 4 (signs of which a Community trade mark may consist) and Article 7(1)(b), (c), (d) and (e) (i), (ii) and (iii) (absolute grounds for refusal);
- Regulation No 2868/95 of 13 December 1995 so called "Community trade mark implementing regulation". See in particular Rule 3 (4) (Representation of the mark).

OHIM President Communication

- Communication No 2/98 of the President of the Office of 8 April 1998 concerning the examination of three-dimensional marks

Case law

- CJEU judgment of 24 May 2012 in Case C-98/11 P *Chocoladefabriken Lindt & Sprüngli v OHIM*
- CJEU judgment of 12 January 2006 in Case C-173/04 P *Deutsche SiSi-Werke v OHIM*
- CJEU judgment of 7 October 2004 in Case C-136/02 P *Mag Instrument v OHIM*
- CJEU judgment of 8 April 2003 in Joined cases C-53/01 to C-55/01 *Linde and Others*

4. Please describe the forum and procedure that must be followed in opposition, invalidation and cancellation proceedings regarding registered shape trade marks

Opposition and Cancellation proceedings at OHIM have an administrative nature. OHIM will not kick off these proceedings on its own motion; they can only be initiated upon initiative of one party. Proceedings involving registered Shape

Marks do not differ from the ordinary ones. A brief (and not exhaustive) outline of these proceedings is provided below.

- **OPPOSITION:** After the opposition has been found admissible the opposition proceedings will commence with a so called "cooling-off" period of two months which is meant for the parties to negotiate an amicable settlement and which can be extended up to 24 months. If no solution is reached, the adversarial part of the proceedings begins and the opponent will have two months to submit its statement of grounds. After the applicant has replied, the parties usually get the opportunity to further comment on the other side's allegations until the Office is convinced to have all the necessary information. It will then close the proceedings and issue a decision.
- **INVALIDITY/CANCELLATION:** A cancellation action against a CTM can only be started at OHIM and be based on relative and/or absolute grounds (including bad faith of the CTM owner). As defence, cancellation of CTM can also be pursued by means of counterclaim before a CTM Court dealing with infringement proceedings (Article 100 CTMR). Cancellation proceedings can be lodged at any time after registration, there is no time limit. However, the owner of an earlier right must not tolerate the use and registration of a junior CTM for five successive years otherwise he may be prevented from bringing an action (Article 54 CTMR Acquiescence). The basic procedural steps are similar to those of opposition proceedings.

A decision in Opposition or Cancellation proceedings can be appealed before OHIM's Boards of Appeal. The Boards are the second instance, independent, quasi-judicial bodies of the Office. Boards' decisions in turn can be appealed to the General Court and subsequently to the Court of Justice, both based in Luxembourg (appeals before the latter may brought on points of law only).

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against shape trade mark applications

As explained above under paragraph 1, OHIM applies rather strict criteria when examining a three-dimensional mark. To be registerable, it must depart significantly from the norm or customs of the sector concerned or have acquired distinctiveness by virtue of its use. If that is not the case, filing national marks with national trade mark Offices or international marks through the WIPO seems an effective way to achieve protection, in spite of the significant downsides which national trademarks have compared to CTMs.

Alternatively, a fast and cost-effective way to register new three dimensional shapes is to file a Registered Community Design ("RCD") with OHIM, which is registered without substantive examination in a matter of days and for which an assumption of validity exists. The RCD is an effective means of protection during an initial period of use. While the design protection is in place, the owner may be able to create a trade mark case by heavily promoting the shape or get-up as such.

Subsequently, a trade mark that would not be registrable per se may be obtained on the basis of acquired distinctiveness through use.

On the enforcement side, when relying on Shape Trade Marks as a basis for opposing or cancelling junior marks at OHIM, it may be advisable to file a consumers' survey showing that the public perceives the shape as such as a business identifier. Other evidence of the shape's recognition on the market may also be useful to that end. That significantly increases the chances of success since marks with highly distinctive character enjoy broader scope of protection, as consistently pointed out by the case law.

To cancel or remove a Shape Trade Mark it is advisable to contest its acquired distinctiveness and additionally refer to the grounds for refusal set out in Article 7 (1) (e) (ii) and (iii) CTMR. They concern shapes of the goods which are necessary to obtain a technical result and shapes that give substantial value to the goods (so called "aesthetic functionality"). Those grounds for refusal have the advantage for the party seeking to cancel the mark that they cannot be overcome by acquired distinctiveness. An example of application of aesthetic functionality is the GC judgment of 6 October 2011 in Case T-508/08 *Bang & Olufsen v OHIM* concerning the loudspeaker below.




The Court held that the specific design of Bang & Olufsen's loudspeaker increased the appeal of the product and with that its value. So Article 7 (1) (e) (iii) CTMR was correctly applied by OHIM and the mark was rightly rejected.

6. Please give some examples of registered shape trade marks that were enforced (successfully or not) against third party uses.

Registered Shape Trade Marks are regularly enforced in *inter partes* proceedings before the Office. They are used to prevent registration or invalidate junior trade marks or designs. Few examples are provided below.

- GC judgment of 4 March 2010 in Case T-24/08 *Weldebräu v OHMI - Kofola Holding*.

Earlier CTM	Contested CTM Application
	

The opposition based on the earlier three-dimensional CTM consisting in a shape of a bottle with a helically formed neck was rejected by OHIM both at first instance and on appeal since likelihood of confusion pursuant to Article 8 (1) (b) CTMR was excluded. The General Court confirmed that. It held that the signs at issue have significant differences and the opponent did not show that the earlier mark is highly distinctive. The Court added that the selling arrangements for the bottles - namely their display in the food aisles of supermarkets or their being ordered in a bar or restaurant - mean that prior to purchase the consumer will concentrate mainly on the word and figurative elements on their labels such as the trade mark's name or logo.

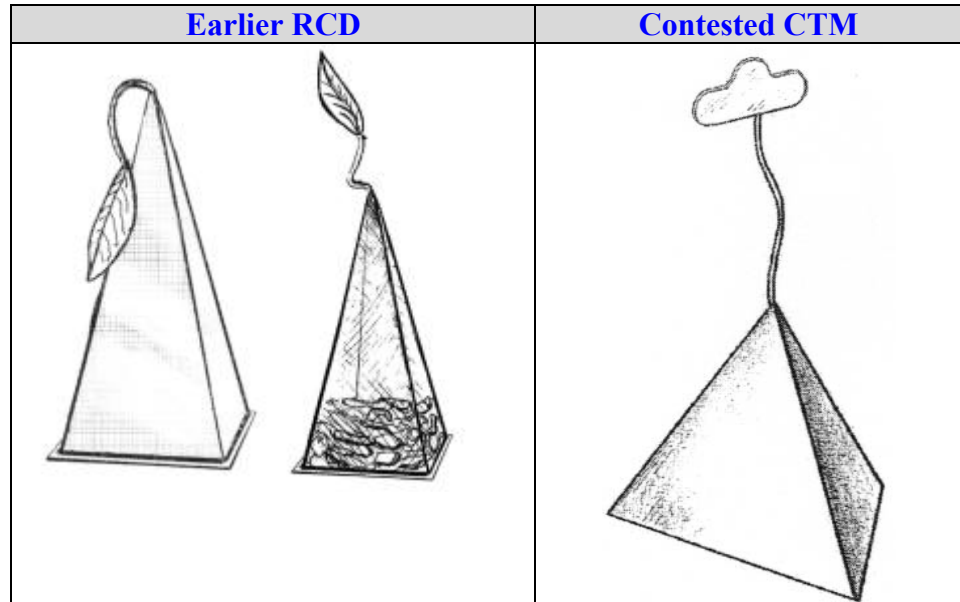
- GC judgment of 27 June 2013 in Case T-608/11 *Beifa Group v OHMI - Schwan-Stabilo Schwanhäußler*

Earlier national mark	Contested RCD
	

The case concerned invalidity proceedings against a registered Community Design ("RCD"), successfully attacked by the owner of the earlier German three-dimensional trade mark reproduced in the table above. The Board of Appeal held that the national mark had been registered and was in force so it enjoyed at least a minimum degree of distinctiveness. The RCD was declared

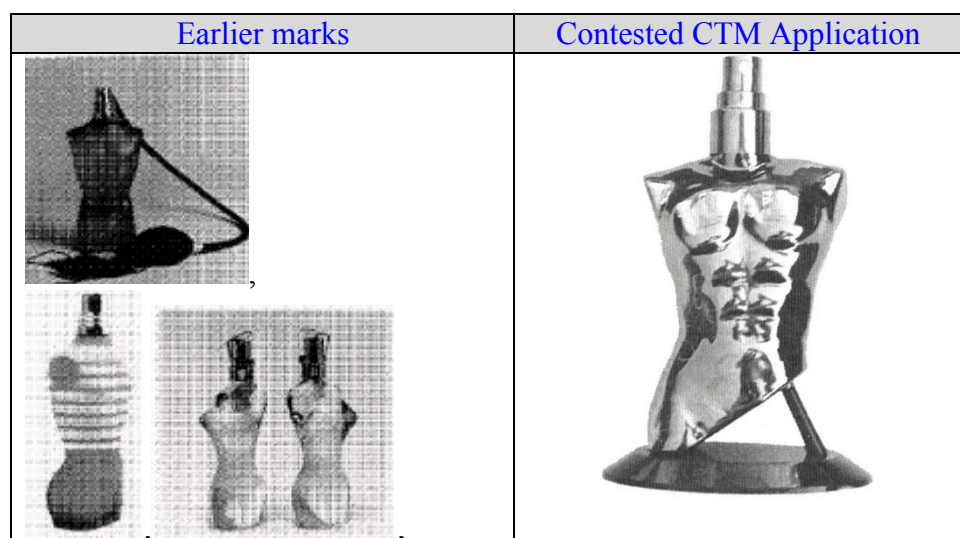
invalid due to its resemblances with the earlier sign. The General Court upheld the Board's decision and confirmed invalidity of the contested RCD.

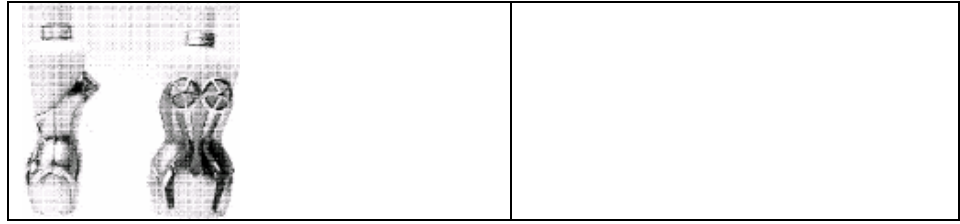
- Decision of the OHIM Second Board of Appeal of 14 February 2012 In Case R 2492/2010-2 (Shape of a teabag)



The decision is rather peculiar since the invalidity action against the CTM registration depicted above was based *inter alia* on a RCD. The ground for invalidity based on earlier design rights (Article 53(2)(d) CTMR) was held admissible, but the action failed since the earlier RCD and the contested CTM have in the Board's view a different overall impression.

- Decision of the OHIM Second Board of Appeal of 9 June 2009 in Case R 1089/2008-2 (Bottle representing a part of human body)





The Opposition based on both article 8 (1) (b) CTMR (likelihood of confusion) and 8 (5) CTMR (unfair advantage) was upheld in its entirety by OHIM, on both instances. The CTM application was rejected. The Board emphasized that the public is accustomed to perceive the shapes of the bottles in question as being part of a family of marks referable to a famous fashion designer.

FRANCE

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Questions:

Shapes are protectable under French Trademark Law. Thus, according to Article L.711-1 of the *French Intellectual Property Code*, "*Shapes, particularly those of a product or its packaging or those that identify a service, may constitute a valid sign*".

When an application for a trademark for a shape is made, the French PTO (INPI) will perform an initial screening. First, it will ensure that the trademark is not misleading and respects public policy and morals.

Following this, the French PTO will ensure that the particular shape does satisfy very specific conditions.

Indeed, protection of a shape under Trademark Law can be combined with other protections - a sign may be protected both by Trademark, Registered Design, Copyright or Patent. The situation should not arise where protection under Trademark Law constitutes a way of by-passing other legislation. The trademark has a specific function: it must guarantee consumers the origin of goods and services by allowing the consumer to distinguish them from those of a different origin.

Therefore, to avoid purely functional or aesthetic shapes - which should only enjoy protection limited in time (by Patent or Registered Design) - taking shelter under Trademark Law, the law sets out three specific grounds for refusing registration "*signs which consist exclusively of the shape imposed by the nature, or function of the product, or which confer thereon its substantial value are not distinctive*"³. This means that a shape will not be registered if it appears exclusively natural, functional or ornamental.

Difficulties obviously arise when the sign "is" the product. The adverb "*exclusively*" is important here, since the aim is not to systematically exclude shapes that are somewhat utilitarian or attractive. A balance needs to be sought between the essential condition of preserving availability and the possibilities the law provides for allowing trademarks consisting of the shape of the product.

In practice, assessment of these criteria is complex and not always easy to appreciate.

³ Article L 711-2 c) French Intellectual Property Code

1) Assessment of specific criteria

→ *shapes which are exclusively natural*: these are shapes imposed by the nature of the product.

Thus, the question arose as to whether the famous Havaianas thong [flip flop] could be



protected as a trademark.

In first instance proceedings, the Paris District Court considered that the sign was "*a thong in its most commonplace shape*" and as such, registration should be refused because signs consisting of the shape which results from the very nature of the product should be refused⁴. This ruling was reversed by the Court of Appeal of Paris which held on December 12, 2014, that the filing of the Community three-dimensional mark No. 9,039,892 filed in Class 25 for "shoes, sandals" was valid on the grounds that "*this trademark combines a series of elements the combination of which is unusual, substantially differentiating it from similar shapes existing on the market; therefore this sign does fulfill an identification function for the goods concerned*"⁵.

Similarly, the Paris District Court considered that the International three-dimensional mark



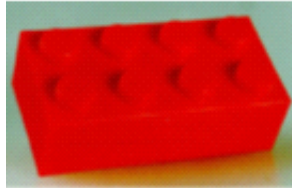
⁴ Paris District Court, 3rd Chamber 1st section, February 13, 2014 Alpagatas v/ JA Diffusion

⁵ Paris Appeal Court, Pole 5, 2nd Chamber, December 12, 2014 Alpagatas v/ JA Diffusion

No. 1002313 was valid on the grounds that *"the mark is constituted by a shape of a recipient on which figurative elements, arranged in a specific manner, are present, which are not imposed by the nature of the product and do result from a singular combination combined in one single visual point"*⁶.

→ exclusively functional shape: these are shapes all the essential elements of which are dictated by a technical solution.

The CJEU stated in the Lego case⁷,



that *" the presence of one or more minor arbitrary elements in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect, does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result"*.

Here, the aim is *"to prevent trademark law from granting a company a monopoly on technical solutions or functional characteristics of a product."* Prohibiting registration of such signs ensures Trademark Law is not used to perpetuate, without limitation in time, exclusive rights relating to technical solutions. These must be able to be freely used subsequently by all economic operators.

The CJEU has also ruled, in relation with the three rotary heads of the Philips shaver that *"there is no point in seeking whether shapes do exist on the market which lead to the same result, the functionality of a shape needing to be ascertained from the viewpoint of technical result of the product"* (see Philips case⁸).

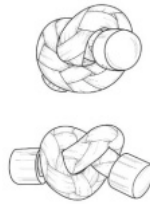
In France, the approach seems to be more flexible than at European Community level.

The Paris District Court considered that Community three-dimensional trademark No. 8717688

⁶ Paris District Court, 3rd Chamber 4th section, November 6, 2014 Ferrero v/ Cagla Sekerli Mamuller Sanayi Ve Ticaret Anonim Sirketi

⁷ CJEU, Grand Chamber, September 14, 2010, Case C-48/09 P Lego Juris A/S v/ OHIM

⁸ CJEU, June 18, 2002, matter C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.



filed in Class 18 to designate leather goods, trunks, suitcases and composed of two drawings of a closure in the form of a knot was valid. Indeed, *“although the clasp in the form of a knot is functional, i.e. for opening and closing the bag, it is not its specific shape that makes this possible”*. This trademark therefore has sufficient distinctive character to identity the origin of the product⁹.

Similarly, the Court of Appeal of Paris ruled on Dec. 13, 2013 that the International three-dimensional mark No. 804396 filed in Class 30 for "chocolate-coated bars" was valid.



When considering chocolate bars present on the French market, *“it appears that the shape filed by Société des Produits Nestlé is not imposed by the nature or function of the product but on the contrary is the result of arbitrary choice”*. Moreover, *“if the fact that the two bars are aligned and connected by a thinner base can help facilitate splitting of the product, the breakable character does nevertheless not make the shape filed exclusively functional, seeing there are other ways to make a bar breakable”*¹⁰.

→ shape which gives substantial value to the product: these are shapes that determine, wholly or to a large part, the economic value of the product. This immediately raises the question as to whether the consumer would have chosen the product if it had been of another shape? If the answer is yes, the shape is secondary and only serves to distinguish the product from another product of the same nature: it is now playing the traditional role of a trademark and deserves full protection. If the answer is no, then it is the shape which plays a determining role: the product is sought for itself. It could consequently only enjoy protection under Copyright or d\esign, the purpose of a Trademark not being to protect the aesthetics of a shape, but rather to allow the public to identify the origin of a product.

⁹ Paris District Court, 3rd Chamber 2nd section, January 18, 2013 Bottega Veneta v/ Paris Heritage and Julma

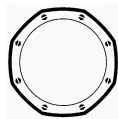
¹⁰ Paris Appeal Court, Pole 5, 2nd Chamber, December 13, 2013 Sté des Produits Nestlé SA v/ French PTO

Of course, depending on the products involved, shape will not always have the same impact. There are certain products for which shape is not decisive. This is typically the case in the food sector where it is rare that the shape of a product is at the origin of a decision to purchase. We can take as an example chocolate confectionery in the shape of twisted twigs:



The French Judges acknowledged that *“it is not their appearance which gives them their value but rather their gustative qualities, consistency and generally their intrinsic qualities that are sought by the consumer of chocolate and not their formal presentation”*¹¹. This trademark was consequently declared valid.

In the field of watchmaking, the Paris District Court held November 16, 2007 that the following two international trademarks:



No. 594072 and



No. 729271

were valid because the *“consumer making the purchase of a watch necessarily pays attention not only to the visual appearance of the product, but also to the materials used for its design, the expertise of the watchmaker who came up with the product and above all, to the product's ability to fulfill its primary function of telling the time.”*

2) Shapes that identify a service

French Law allows protection of shapes characterizing a service. Indeed, the trademark plays, in terms of services, the same role it does in terms of products: it allows a service provider to distinguish the services it offers from those provided by its competitors and the public to recognize them.

However, the intangible nature of services makes it difficult to identify them by trademark, in the absence of a material object to which the mark can be applied. In this case, traders often opt for the shape or the internal or external presentation of a sales area in which the services are provided. The layout of the premises, the furniture, the location and presentation of the products, the materials, range of colors, lighting ...

¹¹ Paris Appeal Court, 4th Chamber section B, January 30, 2009, PIBD 2009 No. 896, III, p. 1053 Trianon Chocolatiers BV v/ Revillon Chocolatier and Mademoiselle de Margaux

are all elements that would clearly distinguish the sales area of a trader from that of its competitors.

The CJEU called on to give an opinion on the question of "Apple store" (flagship stores of Apple Inc.) pointed out that the representation of a sales area can be adopted as a trademark *"provided its arrangement, when viewed, diverges so significantly from the norm or customs of the economic sector in question"* adding *"even if there is no indication of size or proportion"*¹². Such registration remains subordinate to the condition that the trademark be appropriate to distinguish its owner's services from those of other enterprises, which does imply a certain degree of specificity to the store layout. It will now be interesting to see how the German office, which put the matter to the CJEU, will decide.



3) Disregard for use and reputation for signs which consist exclusively of natural, functional or ornamental shapes

According to Article L 711-2 of the *Intellectual Property Code*, *"the distinctive character of a mark may be acquired through use except for signs which consist exclusively of a shape."*

No protection can be acquired for these trademarks regardless of the use to which they might be put. Their protection is excluded, without exception. Here, it is a question of refusing access to protection, in all circumstances, for trademarks which, intrinsically, would fall under rules applying to Patents, Copyright or Designs.

The same applies to questions of fame. A sign can be distinctive and well-known without it nevertheless being able to have access to protection, if its distinctiveness and fame are only built on its aesthetics.

Conclusion

It is certain that it is more difficult to protect a shape under trademark more than it is for conventional signs. All these examples show how it is difficult to derive clear

¹² CJEU, 3rd Chamber, July 10, 2014, matter C-421/13 Apple Inc v Deutsches Patent-und Markenamt

guidelines, assessment of criteria being objective and sometimes poorly understood. This is why it is important, when the forms have important characteristics, not to limit the protection to Trademarks and to consider, where possible, alternatives to enjoy effective protection (Copyright, Designs or Patents if applicable).

In any case, the practice of the French Trademark Office appears to remain more favorable to the applicant than does the OHIM's practice. It is indeed established that the relevant public's perception is not necessarily the same in France as it is in Europe.

Indeed, according to Community case law, "*consumers are not accustomed to supposing the origin of goods on the basis of their shape or of their packaging, in the absence of any graphic or textual elements and it could consequently prove more difficult to demonstrate the distinctive character of a three-dimensional trademark when compared to that of a word mark*"¹³. Thus, the closer the shape comes to the most probable shape the product will take, the more likely it is that it will be lacking in distinctive character. And, *a contrario*, only a shape which diverges in a significant manner from the norm or customs of the sector, is not lacking in distinctive character.

In 2009, protection of the Bounty chocolate coated bar was refused at Community



level, while it is made up of an elongated and rectangular shape, with rounded ends, with three arrows or chevrons on its top face. It is not certain that these characteristics would be refused in France, notably in view of the acceptance of the KitKat bar by the Paris Appeal Court in 2013.

¹³ Court of First Instance, July 8, 2009, matter T-28/08 Mars v/ OHIM

INDIA

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

Protection in India for such shapes would be available as a 'Design' as well as a 'Shape Mark'.

Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

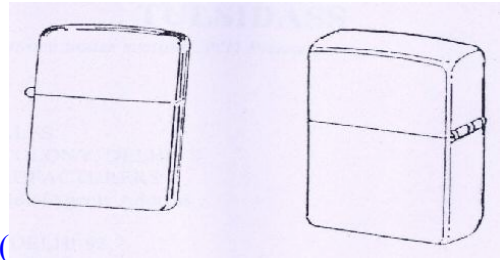
Two-dimensional graphic or photographic representations of the Shape Mark are to accompany the application. Different perspective views of the shape are to be submitted. At times, the Registrar may even require a specimen to be submitted.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

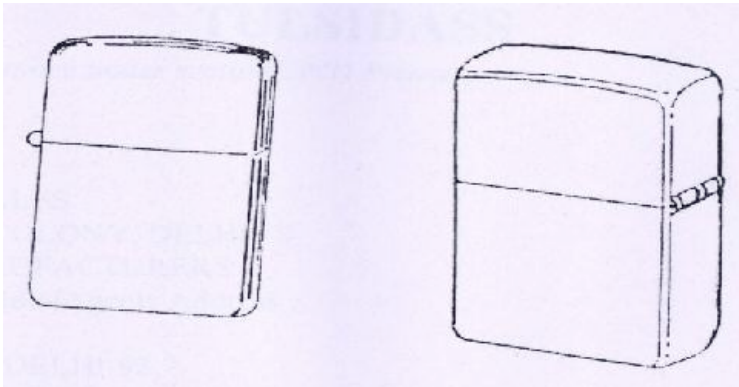
Evidence of distinctiveness need not be provided unless specifically asked for by the Examiner at the Trade Mark Office. As a matter of (current) Trade Mark Office practice, such evidence is not asked for as a matter of routine.

Actual prior use of the shape trade mark is not a pre-requisite for registration. Registration may be obtained even without actual use of the mark (viz. if the application for registration is filed on a proposed to be used basis). If, on the other hand, prior use of the shape trademark is claimed in the application, evidence of use will likely be required.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.



a) The 3D shape of the ZIPPO Lighter () -
Registration No. 714368



b) The shape of the Gorbatschow Wodka bottle ()
– Registration No. 1648594

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The Trade Marks Act, 1999 and The Trade Marks Rules, 2001 govern shape trade marks in India.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

The forum and procedure for opposition and cancellation proceedings regarding shape trade marks is the same as that for regular trade marks.

An opposition can be filed against an advertised application for a shape trade mark within 4 months from the date of advertisement. The opposition is to be filed before the Registrar of Trade Marks at the Trade Marks Office. The grounds on which an opposition can be filed against a shape trade mark are the same as the

grounds on which an opposition can be based against a regular trade mark. Some of the more frequently used grounds are deceptive similarity with an earlier mark, lack of distinctiveness, bad faith at the time of filing of the application, etc.

A cancellation action can be filed against a registered shape trade mark before the Registrar of Trade Marks at the Trade Marks Office or before the Intellectual Property Appellate Board (IPAB). The grounds on which a cancellation can be based against a shape trade mark are the same as the grounds on which a cancellation can be filed against a regular trade mark. Some of the more frequently used grounds are non-use, lack of bona fide intention to use, deceptive similarity with an earlier mark, etc.

Once an opposition or a cancellation petition is filed, the Trade Marks Office (or IPAB) will serve the opposition or cancellation petition on the Applicant or the Registrant of the shape trade mark. Upon such service, the Applicant/Registrant will have 2 months to contest by way of filing a Counter Statement. The Trade Marks Office (or IPAB) will serve such counter-statement upon the other side, after which service the evidence stage in the proceedings will commence. The Applicant/Registrant will be given an opportunity to file its evidence in support of its application/registration. The Opponent/Cancellation Petitioner will be given an opportunity to file its evidence in support of its opposition/cancellation petition. The Applicant/Registrant will be given a further opportunity to file any evidence in Reply, which marks the end of the evidence stage. The opposition/cancellation will then be taken up for hearing at the Trade Marks Office (or IPAB) and then decided on merits.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

Owners of Shape Trade Marks should evaluate whether to seek protection as a Design and/or whether to seek protection as a Shape Trade Mark – often, both forms of protections are available.

Owners of Shape Trade Marks, in addition to commissioning trade mark journal watch services to discover potentially infringing third party applications in India, should also commission periodic market watch services. Market watch services, in the context of Shape Trade Marks in particular, are often a more effective way of discovering potentially infringing uses.

India, being a common law jurisdiction, rights in a Shape Trade Mark can stem through use of the mark (viz. trademark registration is not mandatory). Periodic market watch services can pick up on such use and enable timely action. Trade mark journal watch services are often insufficient.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

a) In *Zippo Manufacturing Company v. Anil Moolchandani* [185 (2011) DLT 51], the Plaintiff (Zippo) successfully enforced its registered shape trade mark for lighters against the Defendant. The Delhi High Court enjoined the defendant from use of the Plaintiff's registered shape trade mark.

b) In *The Coca Cola Company v. Narsingh Rao* [CS (OS) 1493/2013], the Delhi High Court, observing that the shape of the Defendants' club soda bottle was virtually identical to the shape of the plaintiff's club soda bottle, enjoined the defendants' infringing use of the plaintiff's shape trade mark.

c) In *Gorbatschow Wodka KG v. John Distilleries Limited* [2011 (47) PTC 100 (Bom)], the court observed that the Defendant's adoption of a bottle for its vodka product that was strikingly similar to the Plaintiff's vodka bottle was dishonest. The court also observed that the defendant's use of the bottle would result in dilution of the plaintiff's shape trade mark.

INDONESIA

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?

Yes.



- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?


We need a specimen of a 3-D Shape Trademark in JPG format.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

Evidence-of-Use is not required.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Shape Trademark	Class	Registration No.	Owner
	32	IDM000015915	The Coca Cola Company
	3	IDM000243186	KENZO S.A.

	30	IDM000230841	Societe des Produits Nestle S.A.
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3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Basically, there is no written regulation on Shape Trademarks/3D marks in the *Trademark Law No. 15 of 2001*, even if Article 1,1 of the *Trademark Law No 15 of 2001*, defines a mark as: “a sign in the form of a picture, name, word, letters, figures, composition of colours, or a combination of said elements, having distinguishing features and used in the activities of trade in goods or services” does not mention the protection of a Shape/3D trademark in Indonesia.

However, in practice, the Indonesian Trademark Office has already accepted applications for shape/3D marks and has registered shape/3D marks.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

According to the Article 90:

Any person who deliberately and without right uses a Mark which is similar in its entirety to a registered Mark of another party for the same kind of goods and/or services produced and/or traded shall be sentenced to imprisonment for a maximum period of 5 (five) years and/or a fine of a maximum amount of Rp. 1,000,000,000.00 (one billion rupiahs).

Article 91:

Any person who deliberately and without right uses a Mark which is similar in its essential part to a registered Mark of another party for the same kind of goods and/or services produced and/or traded shall be sentenced to imprisonment for a maximum period of 4 (four) years and a fine of a maximum amount of Rp. 800,000,000.00 (eight hundred million rupiahs).

In view of the above, the use of a Shape Trademark/3D mark, which having overall or basic similarity with the registered Shape Trademark/3D mark, is considered to constitute the Trademark Infringement.

However, there are some infringers who apply to the Design Office for an industrial Design Application, without any right to the registered Shape Trademark/3D mark owned by the another party. As there is no any cross-checking conducted by the Design Office with the Trademark Office, it is highly that such an Application will be accepted and registered by the Design Office.

Should this happen, then the original owner of registered Shape Trademark/3D mark may file a cancellation law suit in the Commercial Court against the registered design on the ground of bad faith.

The original owner may show that he is a first user and first registrant of Shape Trademark/3D mark both in Indonesia and/or in other countries before the Commercial Court.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

A product shape can also be protected in Indonesia by Industrial Design Law. Trademark owners should consider applying for both Design and trademark rights to have overall brand protection for a shape/3D mark. Shape marks can be a formidable weapon to protect valuable intellectual property. In some cases, protection of functional items, which previously have not been eligible for protection, can be achieved through registration of a shape mark.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Based on the Indonesian Trademark Office's record, until now there have not been any trademark infringement nor cancellation actions of registered Shape Trademarks/3D trademarks.

JAPAN

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

The best way to protect the shape of the product is to file a design application before disclosure of the shape and to obtain a design registration. Even if the shape has been disclosed, an owner can file a design application claiming an exception to lack of novelty within 6 months of the disclosure.

It is possible to obtain a registered trademark for the shape of a product if the shape is inherently distinctive or has acquired distinctiveness.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

In the same way as applications for other types of trademark such as figurative mark, picture(s) or drawing(s) which identifies the shape trade mark should be attached in the application. In addition to that, it is necessary to state that the applied trademark is a "three dimensional mark" in the application.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

If an examiner issues an Official Action against the application for the shape trade mark because of lack of distinctiveness, it is necessary for the applicant to provide evidence of distinctiveness (inherent distinctiveness or acquired distinctiveness) for the shape trade mark to obtain a registration.

If the applicant would like to prove the acquired distinctiveness after long and extensive use of the trademark, according to the Examination Guideline the following evidence is helpful:

- (i) Printed matter (newspaper clippings, magazines, catalogues, leaflets, etc.) carrying advertisements, public notices, etc.;
- (ii) Invoices, delivery slips, order slips, bills, receipts, account books, pamphlets, etc.;
- (iii) Photographs, etc. showing the use of a trademark;

- (iv) A certificate by an advertisement agency, broadcasting agency, publisher or printer;
- (v) A certificate by a trade association, fellow traders or consumers;
- (vi) A certificate by a public organization, etc. (the state, a local public entity, a foreign embassy in Japan, a Chamber of Commerce and Industry, etc.);
- (vii) Articles in general newspapers, trade journals, magazines and the internet; and
- (viii) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark. (However, due consideration will be given to the objectivity of the questionnaire with respect to the conductor, method, and respondents).

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

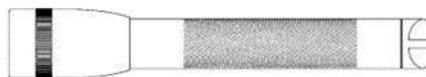
(1)Coca-Cola bottle



Registration number: 5225619
 Application date: July 2, 2003
 Registration date: April 24, 2009
 Holder: The Coca-Cola Company
 Class, Goods & Services: 32, cola drinks
 History: Rejected by the Examiner in the JPO on October 22, 2004 (lack of distinctiveness)
 Rejected by the Appeal Board in the JPO on February 6, 2007 (lack of distinctiveness)

Allowed by the IP High Court on May 29, 2008 (acquired distinctiveness)

(2)MAG-LITE



Registration number: 5094070
 Application date: January 19, 2001

Registration date: November 22, 2007

Holder: Mag Instrument Inc.

Class, Goods & Services: 11, flashlights

History: Rejected by the Examiner in the JPO on November 11, 2002 (lack of distinctiveness)

Rejected by the Appeal Board in the JPO on August 21, 2006 (lack of distinctiveness)

Allowed by the IP High Court on June 27, 2007 (acquired distinctiveness)

(3)Y chair



Registration number: 5446392

Application date: February 19, 2008

Registration date: October 28, 2011

Co-Holders: Carl Hansen & Søn Japan and Carl Hansen & Søn Møbelfabrik A/S

Class, Goods & Services: 20, armchair

History: Rejected by the Examiner in the JPO on April 1, 2009 (lack of distinctiveness)

Rejected by the Appeal Board in the JPO on June 23, 2010 (lack of distinctiveness)

Allowed by the IP High Court on June 29, 2011 (acquired distinctiveness)

(4) HONDA SUPER CUB



Registration number: 5674666

Application date: February 18, 2011

Registration date: June 6, 2014

Holder: Honda Motor Co., Ltd

Class, Goods & Services: 12, two-wheeled motor vehicles

History: Rejected by the Examiner in the JPO on January 24, 2013 (lack of distinctiveness)

Allowed by the Appeal Board in the JPO on March 27, 2014 (acquired distinctiveness)

(5) Jean Paul Gaultier perfumes



International Registration number: 600167

Application date: April 28, 2006

Registration date: December 22, 2011

Holder: Beauté Prestige International

Class, Goods & Services: 3, Beauty products (cosmetics), soaps, perfumery, cosmetics

History: Rejected by the Examiner in the JPO on June 27, 2008 (lack of distinctiveness)

Rejected by the Appeal Board in the JPO on July 27, 2010 (lack of distinctiveness)

Allowed by the IP High Court on April 21, 2011 (acquired distinctiveness)

(6) Hermes Birkin Bag



Registration number: 5438059

Application date: March 6, 2008

Registration date: September 9, 2011

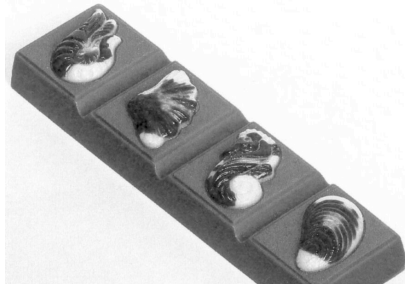
Holder: HERMES International

Class, Goods & Services: 18, Handbags

History: Rejected by the Examiner in the JPO on February 1, 2010 (lack of distinctiveness)

Allowed by the Appeal Board in the JPO on May 31, 2011 (acquired distinctiveness)

(7) Guylian chocolate

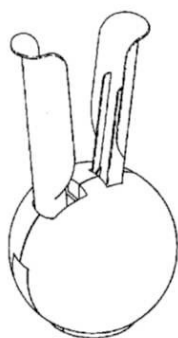


International Registration number: 803104

Application date: April 4, 2003

Registration date: May 29, 2009
 Holder: Chocolaterie Guylian N.V.
 Class, Goods & Services: 30, Chocolate pralines
 History: Rejected by the Examiner in the JPO on March 24, 2004 (lack of distinctiveness)
 Rejected by the Appeal Board in the JPO on April 6, 2007 (lack of distinctiveness)
 Allowed by the IP High Court on June 30, 2008 (inherent distinctiveness)

(8) Chef'n Pepper Grinder



Registration number: 4925446
 Application date: June 7, 2001
 Registration date: February 3, 2006
 Holder: Chef'n Corporation
 Class, Goods & Services: 21, a grinder for seasoning or spice, non-electric
 History: Rejected by the Examiner in the JPO on February 6, 2003 (lack of distinctiveness)
 Allowed by the Appeal Board in the JPO on December 9, 2005 (inherent distinctiveness)

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

(1) Definition of “trademark”

Under the Current trademark law, “trademark” is defined in Article 2 (1) as follows:

*A “trademark” is:
 any characters, figures, signs or three-dimensional shapes,
 or any combination thereof,
 or any combination thereof with colors.*

Under the amended law which is expected to come into force on April 1, 2015, “trademark” is defined in Article 2 (1) as follows:

*A “trademark” is:
 (i) recognizable by human perception, and comprises,
 (ii)(a) characters, figures, signs, three-dimensional shapes or colors, or
 (b) any combination thereof, or
 (c) sounds, or
 (d) other matters which designated by Cabinet Order.*

Thus, three-dimensional shapes are within the scope of the “trademark” which can be registered and protected both under the current law and the amended law.

(2) Distinctiveness of shape trade mark

Trademark law Article 3 (1) (iii) stated that the trademark that consists solely of a mark indicating shape (including shape of packages) in a common manner

cannot be registered. So, usually, SHAPE TRADE MARKS are rejected based on the Article 3 (1) (iii).

However, Trademark law Article 3 (2) also says that a trademark that falls under Article 3 (1) (iii) may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.

So, if the applicant could have successfully proved that the SHAPE TRADE MARK has acquired distinctiveness, the SHAPE TRADE MARK can be registered under the Article 3(2).

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

There is no specific forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks. The Opposition, Invalidation and Cancellation Proceedings are handled in the same manner as those for trademarks in other types such as word marks or figurative marks.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

It is very rare for Shape trademarks to be registered with inherent distinctiveness. They are usually registered under the Article 3(2) by proving the acquired distinctiveness after long and extensive use of the trademark. So, for persons who take action against the Shape trademark applications/registrations, it is a helpful strategy to make the validity of the proof doubtful.

For example, if a questionnaire is included in the proof, it might have been controlled in favor of the applicant/registrant. In this case, it may be a good strategy to argue that the questionnaire is unfair with regards to the conductor, method, and respondents.

Also, even if the applicant/registrant filed a large amount of proof of use of the shape trademark in order to prove the acquired distinctiveness, sometimes the proof includes not only the use of the shape trademark but also word mark/figurative mark attached on the shape (e.g. “Coca Cola” words on the Coca Cola bottle shape). In this case, it may be a good strategy to argue that contribution of the shape trademark is smaller than that of the word mark/figurative mark, and the acquired distinctiveness has not come from the shape trademark but from the word mark/figurative mark.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Although there are very few examples of enforcement of registered shape trade marks, at least one court case exists: *Hermes International vs. DHS Corp, Tokyo district Court, H25 (wa) 31446*, as explained below:

Plaintiff, Hermes International, is an owner of the Registered Trademark No. 5438059 regarding the shape of their Birkin Handbag (See the above 2. (6)). The Defendant, DHS Corp, was importing handbags whose shape is similar to the registered trademark owned by the plaintiff, and selling them through the Internet. The plaintiff filed a lawsuit against the defendant before the Tokyo District Court seeking an injunction and damages based on infringement of registered trademark rights (registered shape trademark).

The Court ruled in favor of the Plaintiff, that is, the Court approved the injunction and damages for the Plaintiff.

KAZAKHSTAN

Contributor: Ms. Nataliya Shapovalova

DENTONS
Almaty
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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?

Yes, based on the Republic of Kazakhstan Law on Trademarks, Service Marks and Appellations of Origin dated July 26, 1999 No. 456-I shape trademarks, including three-dimensional marks, are protected in Kazakhstan.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The application should indicate that a mark applied is three-dimensional and the image of the general view, and other views of a three-dimensional trademark should be provided ensuring the completeness of perception of the designation.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

No.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

RK Reg. certif
No. 30625



RK Reg. certif
No. 32373



RK Reg. certif
No. 29911



RK Reg. certif
No. 29910



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

- The Republic of Kazakhstan Law on Trademarks, Service Marks and Appellations of Origin dated July 26, 1999 No. 456-I;
- The Rules on preparation and consideration of the trademark application adopted by the Minister of Justice of the Republic of Kazakhstan dated February 24, 2012 No. 89.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

It does not differ from the same procedures for other types of trademarks. Please let us know if you need this procedure in detail.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

To the best of our knowledge the practice of registration of three-dimensional trademarks is not widely spread in Kazakhstan. We are not familiar with the cases of cancel/remove/oppose against Shape Trade Mark Applications.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

We are not familiar with such cases.

MALAYSIA

Contributor: Mr. Kim Tean Ng

NANYANG LAW-H²
Kuala Lumpur
www.houlihan2.com

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

Shape trademark is best protected by

- a. Submitting substantial evidence of use and acquired distinctiveness.
- b. Depositing a specimen of the goods with a description.

Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

Some forms of non-traditional trade marks (NTMs) such as color and shape, although not specifically included in the definition, have been accepted by MyIPO. However, such marks are accepted only when substantial evidence of use and acquired distinctiveness are submitted. The definition however definitely does not allow for sounds, smells, color and shape, taste and textures and these NTMs cannot currently be registered as trade marks in Malaysia.

The provision is not exhaustive and it can be argued that three-dimensional marks do fall within the boundaries of the statutory definition.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The application for registration should be accomplished by the following:

- a. A specimen/model of the three dimensional mark;
- b. Description of the mark for example "a bottle of the shape shown in the representation";
- c. Any subsequent advertisement or entry on the register;
- d. If the specimen is very large, the model of reduced scale can be deposited;
- e. Evidence of distinctiveness of Shape Trade Mark.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

Yes. Shape trademarks are accepted only when substantial evidence of use and acquired distinctiveness are submitted. The applicant should prove to the

satisfaction of the Registrar that before the date of the application, the mark had acquired a distinctive character because of the use made of it.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Example 1:



Malaysian Application No.	96006247
Mark	TOBLERONE TOBLER
Trade Mark Type	Combined
Disclaimer / Condition	THE TRADE MARK IS LIMITED TO THE COLOURS AS SHOWN IN THE REPRESENTATION ON THE FORM OF APPLICATION.
Vienna Coding	060102 - Mountains, mountain landscapes 060104 - Mountains or volcanoes stylized 270512 - Letters crossed or barred by letters, numerals or a figurative element
Class(es)	30
Filing Date	13/06/1996
Mark Status	Registered
Mark Status Date	03/09/2008
Expiry Date	13/06/2023

Example 2:



Malaysian Application No.	06000813
Mark	COCA-COLA
Trade Mark Type	Combined
Vienna Coding	190716 - Bottles or flasks with inward-curving sides
Class(es)	32
Filing Date	18/01/2006
Mark Status	Registered
Mark Status Date	25/06/2008
Expiry Date	18/01/2016

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Legislation Governing Trade Marks in Malaysia:

Trade mark protection in Malaysia is governed by the Trade Marks Act 1976 (TMA) and the Trade Marks Regulation 1997 (TMR). The TMA came into force on 1st September 1983, while the TMR, which repealed the initial Trade Marks Regulations 1983, was enforced on 1st December 1997.

Before 1st September 1983, i.e. prior to the enforcement of the TMA, trade mark protection in Malaysia was governed by three separate Ordinances: the Trade Mark Ordinance 1950, the Trade Mark Ordinance of Sabah and the Trade Mark Ordinance of Sarawak, which have all been repealed by the TMA.

The TMA and the TMR are administered by the Intellectual Property Corporation of Malaysia (Corporation). The Corporation, also known as MyIPO, is an agency under the jurisdiction of the Ministry of Domestic Trade, Cooperative and Consumerism which is responsible for the development and management of the intellectual property (IP) system in Malaysia.

Definition of a Trade Mark:

“Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.”

“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 the person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI.”

Only printed or other visual use of the mark is to be construed as references to use of a mark. Part XI refers a special kind of mark called a certification trade mark.

In Malaysia, while the law is clear that "sounds" and "smells" do not fall within the statutory definition of a "mark" (because the Act states that only printed or other visual use of the mark is to be construed as references to use of a mark), there appears to be no specific provision allowing three-dimensional trademarks. The Trade Marks Act states that a "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof", which therefore means that the provision is not exhaustive and it can be argued that three-dimensional marks do fall within the boundaries of the statutory definition.

Although there is a lack of specific legislation, the three-dimensional marks are registrable in Malaysia and in fact there have been many instances of three-dimensional marks being successfully registered with the Malaysian Trade Mark Office. One of the best-known examples of this is the registration of the triangular three-dimensional configuration of the TOBLERONE chocolate bar. In addition to trade mark protection, three-dimensional shapes are also afforded protection through the Malaysian registered designs and copyright regimes.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

Opposition:

(i) Notice of Opposition:

Any person may, within two months from the date of the advertisement in the Government Gazette give notice in writing to the Registrar of Trade Marks (Registrar) on Form TM 7 accompanied by the prescribed fee. A copy of the notice must also be sent to the applicant.

A notice of opposition shall include a statement of the grounds upon which the opponent objects to the registration of the applicant's mark. If registration is opposed on the ground that the mark resembles another mark already on the Register, or the registration of which is the subject of a current application, the number and class of that other mark and, except in the case of an application not yet advertised, the number of the Gazette in which it has been advertised shall be set out in the notice.

(ii) Counter-statement:

Within two months of the receipt of a **Notice of Opposition**, the applicant may file with the Registrar a counter-statement on Form TM 8 setting out the grounds to support his application. A copy of the counter-statement must be sent to the opponent.

(iii) Opponent's Statutory Declaration

Within two months of the receipt of the **Counter Statement**, the Opponent is required to file a Statutory Declaration in support of its grounds of Opposition at the Registry and a copy of the same must be served on the Applicant.

(iv) Applicant's Statutory Declaration

Within two months of the receipt of the **Opponent's Statutory Declaration**, the Applicant is required to file Applicant's Statutory Declaration in support of its Application at the Registry and a copy of the same must be served on the Applicant.

(v) Evidence in Reply

Within two months of the receipt of the **Applicant's Statutory Declaration**, the Applicant is required to file Evidence in Reply to the Applicant's Statutory Declaration at the Registry and a copy of the same must be served on the Applicant.

(vi) Written submission.

Within two months of the receipt of a notice of opposition, the applicant may file with the Registrar a counter-statement on Form TM 8 setting out the grounds to

support his application. A copy of the counter-statement must be sent to the opponent.

Cancellation / Invalidation (in Malaysia Revocation / Rectification Action):

Generally rectification and revocation proceedings are commenced at the High Court by way of an Originating Motion supported by affidavit.

Section 45 of the Trademarks Act provides that an aggrieved person may apply to the High Court for the rectification of the register if an entry is wrongfully made or wrongfully remains on the register as the registrant's mark is likely to cause confusion and deception to members of the public.

In order to establish confusion and deception to members of the public, the Applicant has to submit evidence to Court that members of the public associate the mark with Applicant rather than the Registrant.

This can be done by providing evidence of the Applicant's reputation and goodwill in the Applicant's mark particularly in Malaysia.

In a rectification proceeding, the Applicant needs to only prove that Applicant's mark is sufficiently well known in Malaysia. Consequently, members of the public would be likely deceived or confused as to goods bearing the disputed mark originates from the Applicant.

On the other hand in a Revocation proceeding, Section 46(1) of the Act provides that an aggrieved person may apply to the Court for an order for the removal of a trade mark from the Register in respect of which the mark is registered on either of the following grounds:

(a) that the trade mark was registered without an intention in good faith, on the part of the applicant for registration, to use it in relation to those goods or services and there has in fact been no use in good faith of it in relation to those goods or services by the registered proprietor for the time being up to the date of one month before the date of the application for removal; or

(b) that up to one month before the date of the application for removal, a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of it in relation to those goods or services by the registered proprietor or registered user for the time being.

In order to succeed in this action the Applicant has to firstly establish that it is an aggrieved party and secondly, that the registered proprietor of the cited mark has not used the relevant mark for a continuous period of not less than three years plus one month in relation to the registered goods or services.

In establishing non-use, the Applicant has to submit market survey which complies with the minimum criteria propounded in *Imperial Group plc & Another v Philip Morris Limited & Another* [1984] RPC 293.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.
 - a. Trademark legislation can be amended to extend the scope of trademark protection to include non-conventional trademarks such as three-dimensional marks, sounds and even smells.
 - b. Non-conventional trademarks should be assessed in the same way as traditional trademarks, both in substantive and procedural terms.
 - c. Provision should also be included to convert the existing two-dimensional trademarks to three dimensional trademarks.
 - i) File trademarks in various (relevant) classes
 - ii) Ensure use of the trademark in accordance with local laws/regulation
 - iii) To create awareness in marketing campaign or educate consumers about the trade mark significance of a shape involve.
 - iv) Conducting watch of new filings by third parties / filing oppositions or cancellation actions.
6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Malaysia Dairy and Yakult:

Malaysia Dairy (MD) has produced and marketed a milk drink in a plastic bottle since 1977. Following an application filed in 1980, MD obtained the registration as a trade mark of its similar plastic bottle in Malaysia.

Kabushki Kaisha Yakult Honsha (Yakult) filed a similar plastic bottle in 1982 under the same class (Class 29) but the application was withdrawn.

Yakult



Malaysia Dairy



The Trademark Register details of Malaysia dairy and Yakult are as follows:

Malaysia Dairy

Malaysian Application No.	R/020893
Mark	VITAGEN
Trade Mark Type	Combined
Disclaimer/ Condition	THE TRADE MARK IS LIMITED TO THE COLOURS AS SHOWN IN THE REPRESENTATION ON THE FORM OF APPLICATION.
Vienna Coding	190701 - Bottles or flasks in circular or elliptical horizontal cross section 190722 - Bottles or flasks with vertical, horizontal or other ribs
Class(es)	29
Filing Date	22/01/1980
Mark Status	Registered
Mark Status Date	14/02/2011
Expiry Date	22/01/2021

Yakult

Malaysian Application No.	R/023601
Mark	YAKULT

Trade Mark Type	Combined
Disclaimer Condition	/ REGISTRATION OF THIS TRADE MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE DEVICE OF A "CONTAINER".
Vienna Coding	190701 - Bottles or flasks in circular or elliptical horizontal cross section 190722 - Bottles or flasks with vertical, horizontal or other ribs
Class(es)	29
Filing Date	17/08/1982
Mark Status	Withdrawn
Mark Status Date	09/05/1997

MEXICO

Contributor: Ms. Marcela Bolland González

Juan Carlos Amaro *

**UHTHOFF GOMEZ VEGA
+ UHTHOFF**
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**BECERRIL, COCA &
BECERRIL, S.C.**
Mexico City

www.uhthoff.com.mx

www.bcb.com.mx

Questions:

1. Is it possible to protect “SHAPE TRADE MARKS” in your country? Yes/No

Yes. From a Mexican perspective, shape marks are understood as being the product configuration, packaging, wrapping or presentation of the product.

A two-dimensional logo would be understood as a design mark.

In Mexico, shape or three-dimensional marks were not provided for in our Law until 1994, when the Law of Industrial Property was enacted. Before that, presentation, packaging or configuration of goods was protected and enforced by means of two-dimensional registrations.

- a. What do you need to provide to accompany an Application for registration of a Shape Trade Mark?

Along with the application form, where you will have to tick the corresponding three-dimensional box, you should exhibit an image of proposed mark showing its dimensions (view of the front, side, top and bottom of the figure). Both drawings and pictures are acceptable.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

No.

2. Please give some examples of actual Shape Trade Marks that have been successfully registered in your country.

The following Shape Trade Mark has been registered in Class 14:



Registration No.: 1063164

Granting date: 19/09/2008

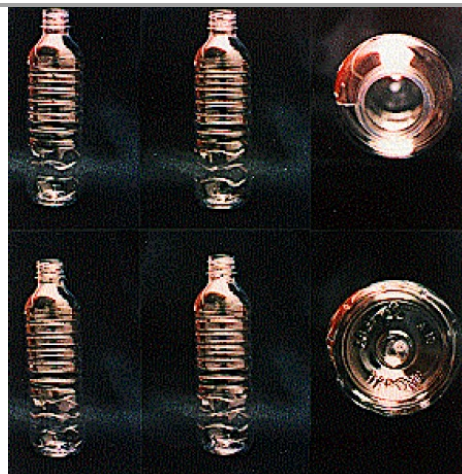
Class: 32



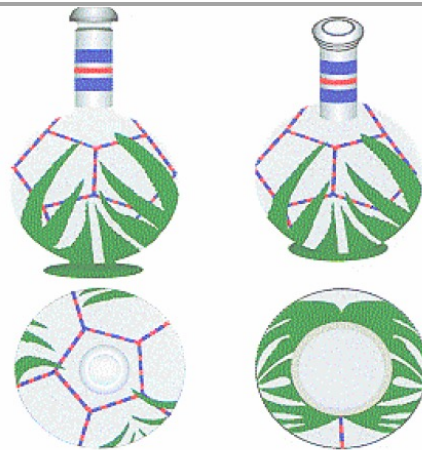
Registration No.: 654232

Granting date: 19/05/2000

Class: 32



Registration No.: 633993
Granting date: 25/11/1999
Class: 32



Registration No.: 916265
Granting date: 24/01/2006
Class: 32



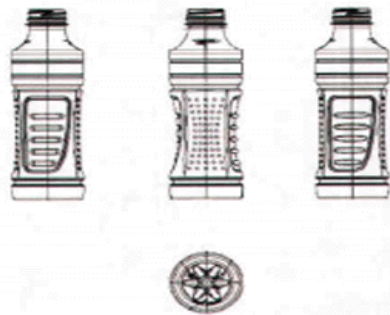
Registration No.: 816710
Granting date: 11/12/2003
Class: 32



Registration No.: 1088940

Granting date: 10/03/2009

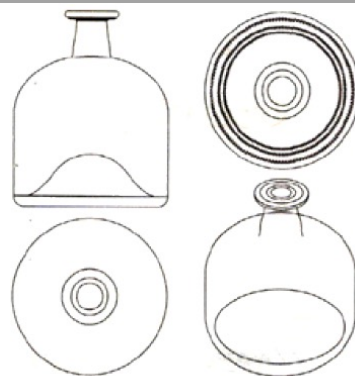
Class: 32



Registration No.: 1077774

Granting date: 18/12/2008

Class: 32



Registration No.: 1080577

Granting date: 23/01/2009

Class: 38



Registration No.: 1081531

Granting date: 28/01/2009

Class: 3



Registration No.: 1180077
Registration date: 22/09/2010
Class: 03



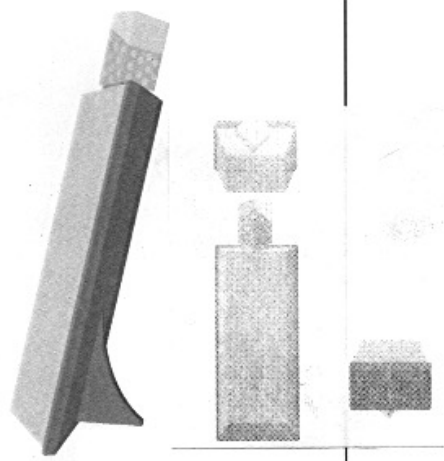
Registration No.: 892433
Registration date: 27/07/2007
Class: 03



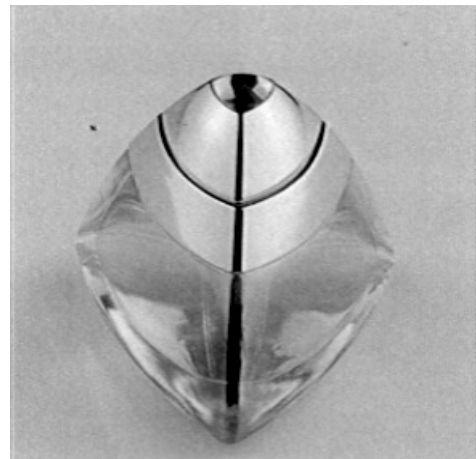
Registration No.: 844692
Registration date: 28/07/2004
Class: 03



Registration No.: 784215
Registration date: 24/03/2003
Class: 03



Registration No.: 784199
Registration date:
24/03/2003
Class: 03



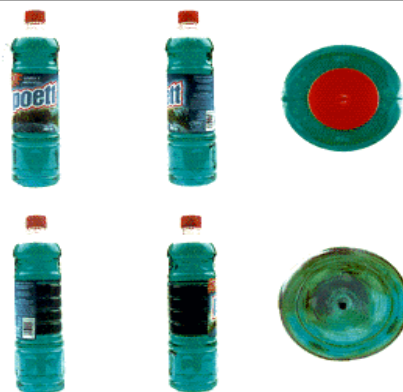
Registration No.: 766104
Registration date: 31/10/2002
Class: 03



Registration No.: 866769
Registration date: 31/01/2005
Class: 03

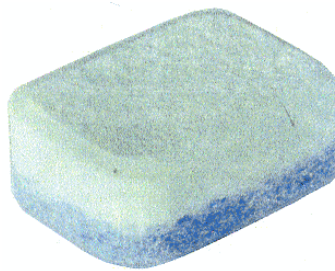
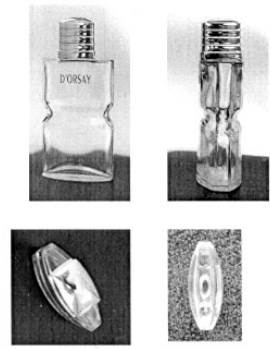


Registration No.: 744116
Registration date: 30/04/2002
Class: 03



Registration No.: 848385
Registration date: 23/08/2004
Class: 03



<p>Registration No.: 746415</p> <p>Registration date: 10/05/2002</p>	
<p>Registration No.: 685890</p> <p>Registration date: 31/01/2001</p> <p>Class: 03</p>	

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Mexican Law of Industrial Property and its Administrative Regulation.

*Shape trademarks are regulated in Article 6^{quinquies} of The Paris Convention and in the Industrial Property Law (“IPL”), specifically, in Article 88, which indicates that all visible signs that distinguish goods or services can be registered as trademarks; Article 89, which expressly establishes that 3D shapes can be registered as trademarks; and Article 90 of the IPL, which establishes the requisites of registration for any kind of trademark.

The criteria issued by the Federal Courts are:

1.- Date: March 2009, Decision I.9o.A.107 A, Page 2811.

In order for a 3D shape to be registrable, it is mandatory that it has relevant characteristics in its constitution that prove distinctiveness and originality.

Amparo 334/2007. Cervecería Cuauhtémoc Moctezuma, S.A. de C.V.

2.- Date: December 2001, Decision: I.9o.A.18 A, Page 1759

Registration of 3D trademarks does not proceed in cases where the same are descriptive of the product sought to be covered.

Amparo 3349/2000. Square D Company.*

4. Please describe the forum and procedure that must be followed in opposition, invalidation, cancellation and opposition proceedings regarding Registered Shape Trade Marks.

In Mexico, both the registration process and litigation, are followed before the Mexican Institute of Industrial Property.

To date, Mexican Law does not provide for an Opposition Procedure. For the registration procedure, please refer to the Trademark Flow Chart attached herein.

Regarding cancellation and invalidation procedures, those referring to Registered Shape Trade Marks follow the same procedure as word design and combined marks, namely:

- Plaintiff must file a cancelation action along with the evidence that supports its grounds of cancelation.
- The Institute issues an official letter admitting the cancelation action and grants a one-month term for defendant to produce its response.
- Defendant files its responsive brief along with the evidence that supports its exceptions.
- The Institute issues an official letter admitting the responsive brief and grants plaintiff a three-working day term to rebut defendant's exceptions and evidence.
- Plaintiff files its rebuttal brief.
- The Institute issues an official letter admitting plaintiff's rebuttal brief and grants a ten- working day term for both parties to file their final allegations.
- The parties submit their final allegations.
- The Institute issues an official letter admitting allegations briefs and commences with the study of the file.
- The Institute issues its decision either canceling conflicting registration or rejecting the cancelation action.
- The Institute's decision may be challenged either by an administrative recourse before the same Institute, within a fifteen-working day period, or by means of a nullity action before the Federal Court of Fiscal and

Administrative Justice, for which purpose the parties have a forty-five working day deadline.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

The Mexican examiners tend to object shape marks by arguing they correspond to the natural form of the goods to be covered and thus are not subject to registration.

Consequently, whenever distinctiveness of a three-dimensional mark is not very clear we suggest adding other graphic elements to argue its overall distinctiveness.

On the other hand, the Federal Court of Fiscal and Administrative Justice, Court in charge of reviewing the decisions from the Mexican Institute of Industrial Property, is more open when studying three-dimensional figures provided that they do not correspond to the natural form of the goods that are intended to be covered.

In what concerns, cancellation procedures, the results of an investigation within the corresponding market could prove useful, as from such survey you can sustain either that the shape mark is not common and thus that it was distinctive and legally registered, or that it is common within the market, and thus that it should not have been granted into registration.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

*There are several cases concerning shape trademark enforcement in Mexico.

In one such case, a well-known candy enterprise filed an infringement action, since there were products within Mexican commerce bearing a confusingly similar shape trademark of its best-seller products.

In this case, the legal standing of the petitioner was the following shape trademark registration No. 514849.

A similar case was held in relation to the snackfood industry, whereby the holder of shaped trademark registration No. 1172732 used over the design of the chips, as follows:

In this case, the IP holder discovered that a competitor started using a confusingly similar design and filed an application to register it.

Due to the particularities of this case, a “cease and desist letter” was sent, formally requesting not only that the use cease, but also that the trademark applications filed by the alleged infringers be withdrawn.*

NEW ZEALAND

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

One would file two-dimensional and three-dimensional Shape Trade Mark Applications for the shape of the bottle Coke bottle or Hershey's Kiss.

Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes

The statutory definition of a "*Trade Mark*" in New Zealand, set out in Section 5 of the *Trade Marks Act 2002* ("the Act"), incorporates all "*signs*" that are capable of being represented graphically and of functioning as a Trade Mark, that is, by distinguishing the Goods or Services of one person from those of another. "*Shape*" is included in the definition of "*sign*" in Section 5 of the Act.

According to the Intellectual Property Office of New Zealand ("IPONZ") Guidelines, shapes are registrable as Trade Marks unless: the sign is not a Trade Mark (Section 18(1)(a)); the Mark has no distinctive character (Section 18(1)(b)); the Mark consists only of signs or indications that serve in trade to designate characteristics of the Goods or Services (Section 18(1)(c)); or the Mark consists only of signs or indications that have become customary in the current language or in the *bona fide* and established practices of trade (Section 18(1)(d)).

IPONZ will assess whether a Shape Mark is capable of distinguishing the Applicant's Goods (under Section 18(1)(a) and (b)) by considering whether the Mark is the shape of the Goods themselves, whether the shape is common to the specific trade, for example as packaging, and whether the shape is functional in some way. Where a shape is commonly used in the trade, it is unlikely to be regarded by IPONZ as a badge of origin for a particular trader.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The Application must be accompanied by representations of the two-dimensional and/or three-dimensional shape in a form that clearly shows all of the features of the Mark. In practice, this is usually achieved for three-dimensional Shape Marks by providing multiple aspect views of the shape. Under Regulation 42 of the

Trade Marks Regulations 2003 (“the Regulations”), the representation of the Mark filed must be sufficiently clear to allow examination of the Application to commence. Furthermore, the representation of the Mark must not bring the scope of the Application into doubt. If there is any uncertainty regarding the scope of protection sought for the Mark, a filing date may not be allocated to the Application (Regulations 42(b) and (c)).

Accurate representations of the Mark are important and all the features of the Mark must be clearly shown. The Trade Mark will be examined in the exact form shown on the Application.

In addition, a written description or statement must be included. For two-dimensional Marks the statement typically refers to the shape of the Mark, such as “[T]he Trade Mark consists of the particular shape of a sweet as shown in the accompanying drawing.” For three-dimensional Marks, the statement typically refers to the shape of the Mark and distinguishes the Mark from a two-dimensional Trade Mark, such as: “[T]he Mark consists of a three-dimensional shape of a bottle, as shown in the representation attached to the Application.” Applications describing three-dimensional shapes in words only will not be given a filing date until a pictorial representation of the shape is supplied.

- b. Is it necessary to provide evidence of distinctiveness of shape trade mark? For example: Do you need to provide Evidence-of-Use?

There is no statutory filing or registration requirement for filing Evidence-of-use when prosecuting an Application for a Shape Trade Mark in New Zealand.

However, in practice, meeting the “capable of distinguishing” criterion under Section 18(1)(a) of the Act has proven difficult for many Applicants. Numerous Applications are rejected on the basis that the shape of the Goods is functional and therefore lacks distinctiveness as a Trade Mark. By way of illustration, at the time of writing there are 398 applications for three-dimensional Shape Marks on the Register of IPONZ that have been rejected or abandoned.

Many Applicants resort to filing Evidence-of-use during prosecution of an Application for a Shape Trade Mark to address an objection that the mark is not a Trade Mark under Section 18(1)(a), or that the Mark is not capable of distinguishing the Goods under Section 18(1)(b) of the Act. Evidence-of-use, in this context, may serve to demonstrate that the Trade Mark has acquired distinctiveness through use, and is usually filed in support of a submission that the Trade Mark has acquired a distinctive character (Section 18(2) of the Act).

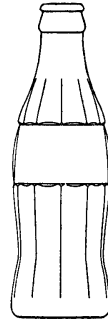
2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Registered two-dimensional shape Trade Marks

Two-dimensional Shape Trade Mark Applications do not have a specific “type” designation and are simply categorized together with other “images.” However, a written statement describing the Mark as applying to a shape is usually included.

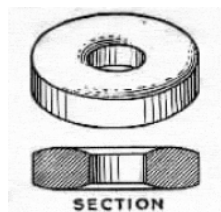
The Coke Bottle

Trade Mark Registration No. 47221 was filed on 3 December 1948 by the Coca-Cola Company in Class 32 for beverages and syrups for the manufacture of such beverages, and the following representation (without any written statement):



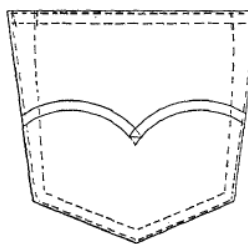
The Lifesaver sweet

Trade Mark Registration No. 41890 was filed on 9 August 1945 by Société des Produits Nestlé S.A. in Class 30 for confectionery with the statement “[T]he trade-mark consists of the particular shape of a sweet as shown in the accompanying drawing” and the following representation:



The Levi Strauss pocket stitching

Trade Mark Registration No. 104530 was filed on 12 June 1973 by Levi Strauss & Co. in Class 25 for pants for men, women, and children with the statement “[T]he mark consists of orange coloured double arcuate lines as shown on the representation attached to the application applied by stitching or paint to the hip pockets of the goods. This mark was advertised before acceptance under section 27(1) of the Trade Marks Act 1953” and the following representation:

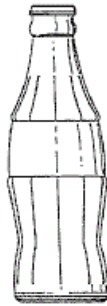


Registered three-dimensional shape Trade Marks (type = “3D”)

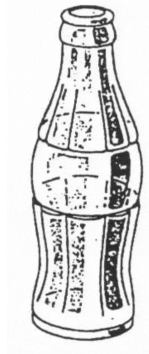
Three-dimensional shape trade mark applications are specifically designated as “3D” type applications at IPONZ. At the time of writing, there are 211 registered three-dimensional Shape Trade Marks on the Register of IPONZ.

The Coke Bottle

Trade Mark Registration No. 244906 was filed on 20 January 1995 by the Coca-Cola Company in Class 32 for mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, with the written statement “[t]he Trade Mark consists of the three-dimensional bottle shape as shown in the representation attached to the Application” and the following representation:

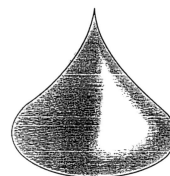


Trade Mark Registration No. 295168 was filed on 14 July 1998 by the Coca-Cola Company in Class 32 for mineral and aerated waters, carbonated and non-carbonated soft drinks, fruit drinks, fruit juices, syrups, concentrates and powders used for making beverages, with the written statement “[T]he sign is a three-dimensional shape.” and the following representation:



The Hershey Kiss

Trade Mark Registration No. 251795 was filed on 28 July 1995 by the Hershey Company in Class 5 for medicated confectionery, cough lozenges, throat drops, cough suppressant tablets; infants’ and invalids’ foods, with the written statement: “[T]he Mark consists of the three-dimensional configuration of a conically-shaped flat bottom configuration” and the following representation:

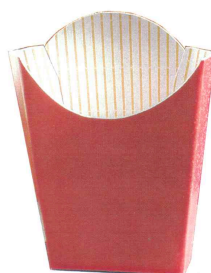


The Hershey Company also filed Trade Mark Registration No. 251796 on 28 July 1995 in Class 30 for preparations made from cereals including biscuits, cakes, pastries and other confections; confectionery including ice and ice cream

confectionery, with a similar written statement and the same representation as shown above.

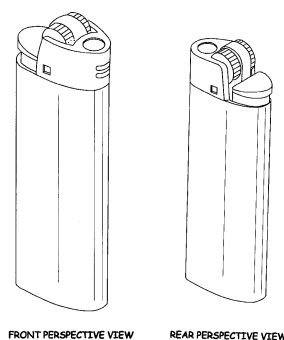
MacDonald's French Fries container

Trade Mark Registration No. 648524 was filed on 14 November 2001 by MCD Asia Pacific LLC (MacDonalds) in Class 29 for cooked vegetables in the nature of fried potatoes, with the written statement “the Mark consists of the three-dimensional shape of a container as shown in the representation attached to the Application. This Mark was advertised before acceptance under Section 27(1) of the *Trade Marks Act 1953*.” The Mark was limited to the colour red (Pantone 485) and yellow (Pantone 123) as shown in the following representation that was attached to the Application:



The BIC lighter

Trade Mark Registration No. 251213 was filed on 14 July 1995 by Bic (NZ) Limited in Class 11 for lighters, with the written statement “[T]he Mark consists of a three-dimensional shape as shown in the representation attached to the Application. This Mark was advertised before acceptance under Section 27(1) of the *Trade Marks Act 1953*” and the following representation:



Bic (NZ) Limited also filed Trade Mark Registration No. 251220 on 14 July 1995 in Class 34 for lighters for smokers, with the same written statement and representation as shown above.

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Legislation

“Shape” is incorporated in the definition of “*sign*”, which is included in the

statutory definition of a “Trade Mark” in New Zealand set out in Section 5 of the *Trade Marks Act 2003*. The *Trade Marks Act 2003* and accompanying Trade Mark Regulations 2003 accordingly define and deal with Shape Trade Marks.

Case Law

Benckiser N.V.’s Application (Commissioner’s Decision No T23/2004, 05/03/2002)

A Trade Mark Application for the shape of a dishwashing powder tablet with blue and white colours was refused by IPONZ. The Assistant Commissioner upheld this decision and considered that the Shape Mark lacked inherent distinctiveness and that the Evidence-of-Use provided was insufficient. The Assistant Commissioner agreed with IPONZ’s conclusions, regarding the shape of the tablet as functional and the blue and white colours of the tablet as not unusual and an indication of its cleansing function.

Mag Instruments Inc’s Application (Commissioner’s Decision No T55/2002, 4/11/02)

Mag Instrument applied to register the shape of its MAG-LITETM torch as a three-dimensional shape Trade Mark. The Assistant Commissioner acknowledged the registrability of Shape Marks, provided that such Marks met other registrability criteria set out in the Act. The Assistant Commissioner emphasized that the test for Trade Mark distinctiveness is not one of “eye appeal” which is part of the test for design registrability. The shape of the MAG-LITETM torch was held to lack inherent distinctiveness, and the Assistant Commissioner was not convinced by Mag Instrument’s arguments that the shape of the torch had acquired Trade Mark significance through use.

Philips Electronics NV’s Application (Commissioner’s Decision No T23/2003, 4/8/03)

IPONZ refused to register the shape of a three-headed electric shaver of the Applicant as a Trade Mark. The Assistant Commissioner upheld IPONZ’s decision and concluded that the shape of the goods was entirely functional, was a representation of part of the Goods and was descriptive of the Goods, and that other traders were likely to use the same or similar three-dimensional shape for their own electrical shaving apparatus.

Société des Produits Nestlé SA’s Application (Commissioner’s Decision No T14/2005, 9/5/05)

An Application to register the shape of the LIFESAVER sweet (without the LIFESAVER Trade Mark embossed on it) was successfully opposed on the grounds that it lacked both inherent and acquired distinctiveness.

The NZ Rugby Football Union Inc’s Application (Commissioner’s Decision No T31/2005, 12/12/05)

The Applicant unsuccessfully applied to register a three-dimensional shape comprising a black rugby jersey bearing a fern with a white collar as a Trade Mark. The Assistant Commissioner considered that since the Goods could be made from any fabric and worked by a variety of people in a variety of contexts, other traders would be likely to desire to use the Shape Mark without improper

motive, and the shape Mark would be unlikely to act as a badge of origin. The NZ Rugby Football Union Inc. submitted Evidence-of-Use, but this was considered to be insufficient to demonstrate acquired distinctiveness as other traders had already sold similar Goods before the Application was filed.

Beauté Prestige International's Application (Commissioner's Decision No T20/2006, 18/09/06)

Beauté Prestige International applied to register two three-dimensional shapes of a container in class 3. However, the Assistant Commissioner deemed each Mark to lack distinctive character, concluding that the shapes did not appear to have any unusual features that a consumer could use as a reference point, were largely functional and were therefore likely to be something which other traders without improper motive might wish to use. The Applicant's earlier registration for a similar container was also relied upon. In this case, the representations of the Shape Mark did not accurately show the distinctive feature of the shape and the Applicant was unsuccessful in their request to amend the Application.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidity and Cancellation Proceedings regarding Registered Shape Trade Marks.

Opposition Proceedings

In the event that the Commissioner does not reject the Shape Mark in the examination process and it proceeds through to acceptance, anyone can oppose its registration by filing the required Notice of Opposition with IPONZ within three months of the Mark having been advertised in the Official Journal.

Section 47(1) of the Act states that: "*a person may, within the prescribed time and in the prescribed manner, give the Commissioner written notice of opposition to an Application.*" This must contain a Statement of Grounds of Opposition and any other prescribed matters under Section 47(2), meaning that those applying for opposition can use the same grounds in Section 17. It is worthwhile noting that the onus lies on the Applicant to prove the Application should be registered.

Once this notice is filed, it is sent by the Commissioner to the Applicant, and two months from this date, a Counterstatement must be filed by the Applicant. This Counterstatement contains any facts accepted by the Applicant and is sent to the Opponent (Section 48). Within two months of this date, evidence in support of the Opposition must be filed by the Opponent, usually taking the form of Affidavits or Statutory Declarations. Evidence can be filed by the Applicant, strictly covering the matters raised by the Opponent, within two months of the submission of the supporting evidence. The Opponent then has one month to file evidence strictly in reply to the Applicant's evidence. If at any time submissions or evidence are not filed within the prescribed timeframe and whereby an Extension of Time has not been granted under Regulation 75, the Opposition, or indeed the Application, will be deemed to be abandoned.

Once the filing of evidence has finished, the Commissioner will hold a Hearing for the matter. A fee is required for the parties to be heard, and this can be done in

written form, orally by Counsel, or a combination of the two. Once the Hearing has concluded, Section 49 dictates that the Commissioner must determine the outcome of the Opposition, and, upon the evidence, determine if the Trade Mark is to be registered and any conditions that attach thereto.

Invalidation Proceedings

After registration, it is still possible for a Trade Mark to be declared “invalid” by a successful Application for a declaration of invalidity. Section 73(1) provides that: “the Commissioner or the court may, on the Application of an aggrieved person (which includes a person who is culturally aggrieved), declare that the registration of a Trade Mark is invalid to the extent that the Trade Mark was not registrable under Part 2 at the deemed date of its registration.” Part 2 of the Act includes the Section 17 absolute grounds for not registering a Mark.

The timeline for such an Application is as follows:

- (a) The owner of the Trade Mark must oppose this Application by filing a written Counterstatement within 2 months of receiving the Application (Regulation 109);
- (b) The Counterstatement must respond to the Application by admitting, denying or otherwise addressing the allegations made and the facts relied thereon;
- (c) If the owner fails to file same, the Commissioner will assess the Application on the documents filed by the Applicant (Regulation 108(2));
- (d) Within two months of receiving a copy of the Counterstatement, the Applicant must either file Evidence-in-Support, notify they will not be filing same, or withdraw their Application;
- (e) Within two months of receiving a copy of the evidence in support of the Application for a declaration of invalidity, the Trade Mark owner may file evidence in support of registration or notify otherwise. If this is filed, the Applicant will be given one month to file evidence strictly in reply;
- (f) The matter will then be determined by the Commissioner, which usually takes place at a Hearing in the form of written and oral submissions from both parties.

A person must have standing to file an Application for a declaration of invalidity and the definition of “a person aggrieved” is given a wide interpretation (*Khalaf Stores v Phoenix Dairy Caribe NV*). Likewise, a person will be considered to be aggrieved if they are:

- (a) in the same trade as the owner of the registered Mark (*Powell v Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54, 80);
- (b) an infringer of the Mark (*Baker v Rawson* 8 R.P.C. 89);
- (c) a person with a substantial or real interest in the removal of the registered Trade Mark (“*Daiquiri Rum*” Trade Mark [1969] RPC 600);
- (d) a person who would be disadvantaged in a legal or practical sense by the Register remaining unrectified (*McLelland J in Ritz Hotel Ltd v Charles of the Ritz Ltd (No 4)* (1988) 14 NSWLR 132); or
- (e) a person who is culturally aggrieved.

The Application must be based on a substantial matter, and, if considered trivial or vexatious, will be refused by the Commissioner (Section 65(2) of the Act). An Applicant for a declaration of invalidity must prove that, on the balance of probabilities, the Mark should not have been registered.

If the Mark is declared to be invalid under said Application, Section 74(1) of the Act provides that the Mark will be treated as if it had not been registered and the Commissioner may alter the Register according to this finding.

Under Section 170 of the Act, a person who is aggrieved by a decision of the Commissioner may appeal to the High Court.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

File good quality representations of the Shape Mark from the start

It is important to file accurate representations showing the distinguishing features of the Shape Mark as the Application will be examined on the basis of the representations provided at filing. In practice, this is usually achieved by providing multiple aspect views of the shape. If poor quality representations are filed, it is difficult to amend the Application at a later date to include better representations that more clearly depict the distinguishing feature of the shape Mark. If the distinguishing feature identified by the Applicant is not apparent from the representations as filed, then such amendments are viewed by IPONZ as having the effect of materially altering the meaning or scope of the Mark, which is not permitted under Section 37(2)(b) as applied by Section 38(2) of the Act. This situation was encountered in the Beauté Prestige International's Application case, discussed above.

Emphasize non-functional distinctive features of the Shape Mark

The Shape Mark must be shown by the representations filed with the Application to have a distinctive character which is not functional. When considering the functionality of a Shape Mark, it is helpful to consider whether the shape results from the nature of the Goods themselves and whether the shape is necessary to achieve a technical result. A distinctive character is not necessarily inferred where there may be a number of other shapes that could perform the same function. Other considerations include whether the shape gives substantial value to the goods, for example, a novelty shape for goods aimed at children, or a decorative shape in any industry where decorative variations are commonplace. If a shape that falls within one of these categories is unlikely to be regarded by IPONZ as having distinctive character, as it is unlikely to "communicate that the goods or services with reference to which it is used recurrently are those of one and the same undertaking". Furthermore, small variations of unregistrable shapes will usually themselves be unregistrable.

The above considerations are particularly important where the Applicant's Goods, or the type of packaging involved, are new to the Market, or are specialised and therefore unfamiliar to consumers in New Zealand.

Consider filing Trade Mark Applications for silhouettes of the Shape Mark

The New Zealand Court tends to construe the scope of a registered Shape Trade Mark narrowly. Accordingly, if the silhouette of a shape is an important aspect of the shape, and one that a competitor may be able to incorporate in combination with their own branding, then it may be worth protecting the silhouette of a Shape Mark independently from the two-dimensional or three-dimensional shape of a Mark.

Cancel/remove/oppose

There have been very few Applications for declarations of invalidity of Shape Marks in New Zealand. However, if an Applicant cannot show that the Shape Mark is a “limping Mark” and does not function as a badge of origin on its own, such that a consumer will immediately perceive the origin of the Goods bearing the Shape Mark independently of its packaging and other Marks, then the Applicant is likely to be unsuccessful.

Likewise, if a Trade Mark owner can provide persuasive evidence that customers use the shape to identify the product; that the Shape Mark is marketed along with the brand name; that alternative shapes may have been used to achieve the same purpose; and the shape contained aesthetic components, the owner is more likely to be successful in repelling an Application for a declaration of invalidity.

Enforce

There is little precedent for the enforcement of Trade Mark Rights in Shape Marks in New Zealand. However, the Court tends to construe the scope of a registered Shape Trade Mark narrowly. Furthermore, if an infringer uses prominent branding in combination with a registered Shape Trade Mark, or includes additional features, the Court may focus more on the differences between the Shape Trade Mark and the infringing Goods than on the similarities. It is advantageous for a Trade Mark owner commencing infringement proceedings to provide evidence of actual confusion. Furthermore, enforcing Trade Mark Rights in New Zealand as soon as possible after becoming aware of the infringement is advisable as any delay in bringing proceedings may weigh against a Trade Mark owner in Court.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Successful enforcement

Fredco Trading Ltd v Miller [2004] 65 IPR 653

In *Fredco Trading Ltd v Miller* [2004] 65 IPR 653, Miller applied for a declaration of invalidity of Fredco Trading Ltd’s registered Trade Mark for the shape of a plastic kiwifruit vine tie (“the Klipon vine tie”) for use in kiwifruit orchards:



Fredco Trading Ltd had sold in excess of a billion units of the vine tie over 24 years. There had only been one other product on the New Zealand Market during this time with a similar function, manufactured by another party, which did not look the same. In 2002, Miller started selling vine ties that were virtually identical in shape and configuration to the Klipon vine tie. Fredco Trading Ltd responded by filing an Application for a Shape Trade Mark, which proceeded to registration after evidence of distinctiveness was provided. Fredco Trading Ltd commenced proceedings for *inter alia*, infringement of the Shape Trade Mark registration, arguing that: the Klipon vine tie was marketed by its shape along with the brand name; consumers used the shape to identify the product; alternative shapes may have been used to achieve the same purpose; and the shape contained aesthetic components.

The Court held that the shape of the Klipon vine tie was a sign and met the requirements of a Trade Mark in accordance with Section 5 of the Act as it was capable of distinguishing the Goods of Fredco Trading Ltd. The Shape Mark was considered, on the evidence, to have acquired a distinctive character through use sufficient to support its registration under the Act. The Application for a declaration of invalidity was dismissed. This decision was upheld on appeal (*Fredco Trading Ltd v Miller* [2006] 8 NZBLC 101,761). The infringement aspect of the case has not been reported on, and it is presumed that the parties came to a settlement agreement.

Unsuccessful enforcement

Coca-Cola Co v Frucor Soft Drinks Ltd and Another [2013] NZHC 3282

In *Coca-Cola Company v Frucor Soft Drinks Limited* [2013] NZHC 3282, the Coca-Cola Company commenced Trade Mark infringement proceedings against Frucor Soft Drinks Limited in respect of its Trade Mark Registrations for two-dimensional and three-dimensional Shape Marks covering the well-known Coca-Cola “Contour” shaped bottle. Frucor Soft Drinks Limited acted as the bottler and distributor of PepsiCo products in New Zealand, using PepsiCo’s redesigned bottle, the “Carolina” bottle. The Coca-Cola Company claimed that PepsiCo’s use of the Carolina bottled and the silhouette of the bottle shape was use of a sign in the course of trade and an infringement of its Trade Mark Registrations.



The Court noted that the Coca-Cola Company has not registered the silhouette of its Contour bottle simpliciter as a Trade Mark and held that its use of the silhouette of its bottle was not normal and fair use of its registered Trade Marks. After comparing the shape and appearance of the Carolina bottle with the representations of the Registered Trade Marks, the Court found several differences in shape, noting in particular the distinguishing PepsiCo branding applied to the Carolina bottle and the addition of further shape features such as a series of wavy lines. No material similarities were found between the registered Trade Marks and the Carolina bottle such as to lead to a likelihood of confusion or deception. Furthermore, the Court noted the lack of any evidence of actual confusion sufficient to demonstrate damage suffered and commented on the tardiness of the Coca-Cola Company in bringing infringement proceedings until almost a year after it first became aware of the Carolina bottle. The Coca-Cola Company's claim of Trade Mark infringement was accordingly dismissed.

NIGERIA

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Introduction:

The current Nigerian Trade Marks Act (no 29 of 1967 (Chapter 436, Laws of the Federation of Nigeria, 1990), appears to have some shortcomings, including the exclusion of the provision of protection of service marks, the absence of the provision of priority claims and the absence of the protection of well-known marks, to name a few.

Although beyond the scope of this discussion, we would like to point out that the Act, which was modeled on the 1938 UK Trade Mark Act, does not make any reference to service marks, and the definition of a trademark refers only to goods. In addition, the Fourth Schedule to the Regulations makes mention of only 34 goods classes. In 2007, the Minister for Commerce and Industry issued a Regulation (although the correct procedures in this regard were never followed) which expanded the Fourth Schedule to include service classes. In practice, we might add, the Registrar accepts applications covering service marks. Although the enforceability of service marks may be questionable, it is our recommendation that proprietors protect their service marks and stake their claim, rather than run the risk of having their marks filched by unscrupulous parties.

Although the protection of service marks may not necessarily have anything to do with the protection of shape marks, we recommend the questionnaire be read against this background. Although the correct procedures and legislative amendments may not be in place, the Registrar still accepts applications for shape marks, as will be discussed below.

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

The Nigerian Trade Marks Act, no 29 of 1967 (Chapter 436, Laws of the Federation of Nigeria, 1990), does not make express provision for the protection of shape marks.

However, in practice, proprietors have had success in securing registration for shape or container marks.

In addition to filing trade mark applications, proprietors would be well advised to file Industrial Designs, in terms of the Patents and Designs Act no 60 of 1970 (Chapter 344, Laws of the Federation of Nigeria, 1990).

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

As shapes or containers do not form part of the definition of a mark, there are no corresponding regulations to deal with the registration of these types of marks. Our suggestion would be to sufficiently define the scope of protection sought in the application.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

There are no requirements to prove use in order to obtain registration.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Proprietors have secured the registration of shape or container marks. However, in light of the legislative lacunas, it is difficult to predict how the courts will deal with this aspect.

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

As mentioned, the definition of a mark does not include non-traditional marks. The definition, as well as for a trademark, reads as follows:

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof".

"trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act.

In practice, however, the Registrar allows the filing of such marks on the basis that they fulfill the requirements for registrability. A mark should contain or consist of a distinctive feature and should be inherently adapted to distinguish or should have become adapted to distinguish through use.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

OPPOSITION

Although not specific to shape marks, the Registrar is likely to apply much the same procedure. Once accepted, an application is published for opposition purposes. Opposition may be lodged within two months from the date of publication of the application in the Journal. It is not possible to extend this two month period.

Opposition proceedings are set out in the Act. A notice of opposition must include a statement of the grounds upon which the opponent objects to the registration. The Registrar of Trade Marks serves the notice of opposition on the applicant, who then has one month to file a counter-statement.

Within one month of receipt of the applicant's counter-statement, the opponent must file evidence in support of its opposition in the form of a statutory declaration. If the opponent does not file the evidence within the prescribed time period, the opposition is deemed to have been abandoned.

Following the delivery of the opponent's evidence, the applicant has one month to file its answering evidence. If it fails to do so, it is deemed to have abandoned its application. Within one month of the filing of the applicant's answering evidence, the opponent may file evidence in reply. Extensions of these periods are allowed.

Once all the papers have been filed, the opposition will be heard by the Registrar.

CANCELLATION

Any person concerned may apply in the prescribed manner to the Registrar or to the court for an order making, expunging or varying an entry in the case of:

- the non-insertion in or omission from the register of any entry;
- an entry wrongly made in the register without sufficient cause;
- an entry wrongly remaining on the register; or
- any error or defect in any entry in the register.

The procedure for the cancellation is very similar to the procedure for opposition. However, the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement. In any case of doubt, any party may apply to the Registrar for directions.

A trade mark registration may also be cancelled and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed. Any person concerned may apply to the Registrar or the court for the removal/cancellation of a registered trade mark on the grounds that:

- it was registered by the proprietor without any bona fide intention to use the mark in connection with the relevant goods, and that there has in fact been no bona fide use thereof in connection with such goods;
- that up to a date one month before the date of application for cancellation, there has been no bona fide use of the trade mark in connection with such goods for a continuous period of five years or longer unless in either case such

non-use is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to such goods.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

It is not clear how the courts will deal with the registration of shape marks, if challenged on the basis of their invalidity, i.e. no provision for the protection of shape marks in the Act.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

We are not aware of any case law in Nigeria dealing with shape trade marks.

THE PHILIPPINES

Contributor: Ms. Editha Hechanova

HECHANOVA & CO., INC.

Makati City

www.hechanova.com.ph

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes

a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

To file an application for registration of a three-dimensional Shape Trademark, the information and documentary requirements are:







1. Signed Power of Attorney (original); notarization/legalization not required;
2. Name of applicant as well as country of incorporation and principal place of business, if body corporate;
3. Enumeration of goods and/or services to be covered;
4. Illustration of mark (if any, the size should not exceed 1MB, in .jpg format with the following dimensions: 2" x 3");
5. Colors to be claimed (if any);
6. If with claim of priority, photocopy or scanned copy of the priority registration.

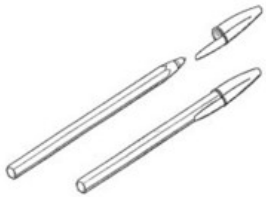

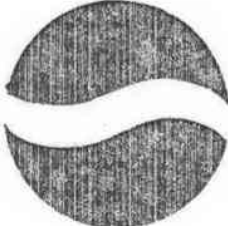


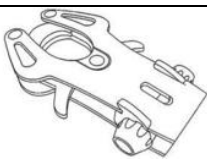
b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

No. Unless the IPPHL questions the distinctiveness of the mark on the ground that the three dimensional shape trade mark is not capable of functioning as a trademark because it is descriptive of the kind, quality, intended purpose and other characteristics of the mark.

No. An evidence of use is not a requirement for the filing of the trademark application, but must be filed within 3 years from date of filing, otherwise the application or registration is deemed withdrawn.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Reproduction of the Mark	Registration No.	TM Owner	Class/ es
	41997123132	MONDELEZ EUROPE GmbH LINDBERGH-ALLEE 1 8152 GLATTPARK (CH)	30
	41997124027	MONDELEZ EUROPE GmbH LINDBERGH-ALLEE 1 8152 GLATTPARK (CH)	30
	42004007907	DAIMLER AG MERCEDESSTRASS E 137 70327 STUTTGART, GERMANY (DE)	9, 14, 16, 18, 24, 25, 28 and 34
	42005008450	MARTELL & CO. PLACE EDOUARD MARTELL, 16100 COGNAC (FR)	33
	42003005351	PFIZER PRODUCTS INC. EASTERN POINT ROAD, GROTON,, CONNECTICUT 06340 (US)	5
	42011005642	SOREMARTEC S.A. RUE JOSEPH NETZER 5, 6700 ARLON,, BELGIUM (BE)	30

	42004005819	SOCIETE BIC 14 RUE JEANNE D'ASNIERES, 92110 CLICHY (FR)	16
	42010001704	BIOFARMA 50 RUE CARNOT 92284 SURESNES CEDEX (FR)	5
	063106	PEPSI CO. INC. 700 ANDERSON HILL ROAD PURCHASE , NEW YORK 10577- 1444, U.S.A. (US)	29
	42002005367	SOCIETE DES PRODUITS NESTLE S.A. VEVEY (CH)	29
	42010013285	KRAFT FOODS BELGIUM INTELLECTUAL PROPERTY BRUSSELESTEEN WEG 450, 1500 HALLE, BELGIQUE, BELGIUM (BE)	30
	42012501835	UNION HARBOUR LTD. 11/F CENTRAL TOWER 28 QUEEN'S ROAD CENTRAL (HK)	3, 9, 14, 16, 18, 25

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Sec. 123.1 (k) makes reference to shapes that are necessitated by technical factors or by the nature of the goods or by factors affecting their intrinsic value. We quote below

A mark cannot be registered if it:

(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;

The wording refers to shapes which could be understood as referring to three-dimensional marks, but also as referring to two-dimensional representations of three-dimensional shapes. The shape applied as a three-dimensional mark may feature the product's design or its packaging.

Two factors are considered in evaluating whether a three-dimensional mark may be allowed registration: Distinctiveness and Functionality. A three-dimensional mark may be refused registration on the ground of either lacking distinctiveness or functionality or of both.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

The trademark rules apply whether the mark is 3D or not. The opposition/cancellation procedure before the Bureau of Legal Affairs of the IP PHL is *inter partes* in nature.

Please see below the procedure for filing a Verified Notice of Opposition/Cancellation:

1. Filing a Verified Notice of Opposition/Petition for Cancellation

The opposition or cancellation must be filed together with the notarized affidavits of the witnesses, Special Power of Attorney, requisite corporate authorization such as the Corporate Secretary's Certificate, and the originals or certified true copies of the supporting documents. The affidavits, power of attorney, secretary's certificate and verification, if executed by a person not in the Philippines, must be duly authenticated by the Philippine embassy or consulate in the country where the documents were executed. Copies of documents may be submitted subject to the presentation of the original or certified true copies during preliminary conference.

2. Issuance of Notice to Answer

The IP PHL will issue a Notice to Answer requiring the respondent to file his answer to the opposition within thirty (30) days from receipt of the said Notice to Answer. The formal requirements mandated for oppositions equally apply to the respondent's Answer. The respondent may also request for a thirty (30) day extension and a second thirty (30) day extension which in total should not exceed ninety (90) days from the publication of the mark.

If the respondent fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the opposer.

3. Mediation Proceedings

The case will be referred to mediation. If no amicable settlement is reached, the IPO will proceed with the preliminary conference.

4. Preliminary Conference

A preliminary conference shall be conducted for purposes of facilitating the resolution of the case through stipulations, clarifications, simplification of issues and the presentation of the original or certified true copies of the evidences, if necessary.

5. Submission of Position Paper/Draft Decision

After termination of the preliminary conference, the IPO shall issue an order in open court requiring the parties to submit their respective position paper within ten (10) days. The hearing officer shall order the case submitted for decisions upon lapse of the period to file the position papers. The director of the Bureau of Legal Affairs shall thereafter render his decision. Said decision may either grant the opposition which shall deny the registration of the mark or deny the opposition. In which case, the opposed mark will be allowed and shall mature to registration.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

Some helpful strategies:

1. Establish fame or well-knownness of your Shape Trade Mark;
 2. Use in the Philippines and around the world;
 3. Registration in the Philippines and around the world;
 4. Wide areas of distribution; and
 5. Extensive promotion/advertisement.
6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

No known registered Shape Trade Marks have been successfully or unsuccessfully enforced against third party uses.

PORTUGAL

Contributor: Ms. Paulo Monteverde

Baptista Monteverde e Associados
Lisbon
paulo.monteverde@bma.com.pt

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?

The best way to protect the shape of the Coke bottle or the shape of the Hershey's Kiss in Portugal is through a 3D trademark registration.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?


The sign should be presented in drawings or photographs that allow apprehending the various perspectives of the relevant format. It should be expressly stated that a three-dimensional trade mark is being filed; otherwise the application will be appreciated as a two-dimensional mark - mixed or figurative.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

In order to proceed with the referred trademark application no documents, other than the referred above, should be filed.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Several shape trademarks have been registered by our PTO.

Registration Number	Trademark	Class
PT 346546		3

PT 415264		29, 31, 32
PT 432319		30
PT 434546		32, 33
PT 439468		30
PT 446197		30
PT 447112		30
PT 467493		32
PT 530005		32

IR 636882		30
IR 765035		30
IR 987293		30

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The most relevant provisions are foreseen in the *Portuguese Industrial Property Code*, namely in Articles 222 and 223.

Article 222

COMPOSITION OF TRADEMARK

1. A trademark may consist of a sign or set of signs that can be represented graphically, namely words - including the names of persons -, drawings, letters, numbers and sounds, the form of the product or respective packaging, provided that they adequately distinguish the products and services of one company from those of others.
2. A trademark may also consist of advertising phrases for the respective products or services, provided that they are distinct in character, regardless of the protection conferred upon them by copyrights.

Article 223

EXCEPTIONS

1. The conditions in the preceding article are not met by:
 - a) Trademarks that are devoid of any distinctive character;

- b) Signs that exclusively consist of the form imposed by the nature of the product itself, the form of the product necessary for obtaining a technical result or the form that confers a substantial value on the product;
- c) Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
- d) Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;
- e) Colours, save where they are combined with each other or with graphics, wording or other particular and distinctive elements.

2. The generic elements referred to in a), c) and d) of the preceding paragraph that are part of the composition of a trademark will not be considered for the exclusive use of the applicant, except where, in commercial practice, the signs have taken on distinctive effectiveness.

3. At the request of the applicant or a complainant, the National Industrial Property Institute identifies, in the respective grant order, the elements that make up the trademark for which the applicant does not have exclusive rights of use.

- 4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

There is no special procedure regarding the opposition, invalidation and cancellation proceedings regarding registered shape trade marks.

- 5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

If it is known that the shape trade mark application has few hypotheses to obtain registration for lack of distinctiveness and the same is already being used in Portugal, the referred trademark application may be accompanied *ab initio* with evidence that said distinctiveness has been acquired through use, thus trying to prevent a provisional refusal decision to be issued.

- 6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

We have disclosed some final PTO's decisions issued on opposition proceedings against shape trade marks applications.

We have also disclosed some Court decisions issued on appeal proceedings filed by interested parties against PTO's granting or refusal decisions of shape trade marks applications.

Trademark Application No.	Applicant	Opponent	Opponent's rights	Situation
IR 844827 	VIZYON CIKOLATA GIDASANAY I VE TICARET LIMITED SIRKETI	Ferrero SpA	IR 665564 	Protection refused in Portugal
IR 849891 	SOLEN CIKOLATA GIDA SANAYI VE TICARET ANONIM SIRKETI	Ferrero SpA	IR 719551  CTM 1410166 	Protection refused in Portugal
IR 960692 	SARAY BISKUVI VE GIDA SANAYI ANONIM SIRKETI	Ferrero SpA	IR 665564  IR 719551  Ir 719821  IR 951408 	Protection refused in Portugal
PT 441753 	Leng-D'Or, S.A.	Frito-Lay Trading Company GmbH	IR 576959  (?)	Application refused. Judicial appeal pending.
PT 447113 	Imperial – Produtos Alimentares, S,A,	SOCIÉTÉ DES PRODUITS NESTLÉ S.A.	IR 804396  (?)	Application granted. Judicial appeal pending.

RUSSIA

Contributor: Ms. Elena Bedareva

DENTONS
St Petersburg
www.dentons.com

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

YES, based on the by Part 4 of the Civil Code of the Russian Federation dated December 186, 2006 and would enter into effect as of January 1, 2008. shape trademarks, including three-dimensional marks, are protected in Russian Federation.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The application should indicate that a mark applied is three-dimensional and the image of the general view, and other views of a three-dimensional trademark should be provided ensuring the completeness of perception of the designation.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

NO.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

RU Reg. certif
No. 297458
IR No 942786



RU Reg. certif
No.335350
IR No 955946



RU Reg. certif
No. 335951
IR No958026



RU Reg. certif
No. 454944
IR No 817028



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

- Part 4 of the Civil Code of the Russian Federation Republic of Kazakhstan Law on Trademarks, Service Marks and Appellations of Origin dated December 18, 2006 and would enter into effect as of January 1, 2008;
- The Rules on preparation and consideration of the trademark application adopted by the Minister of Justice of the Republic of Russian Federation dated March 25, 2003 No. 4322.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

It does not differ from the same procedures for other types of trademarks. Please let us know if you need this procedure in detail.
Opposition Procedure

The preliminary examination of an application may result either in a decision on registration of a trademark or in refusal/partial refusal in registration of a trademark.

Upon receipt of the preliminary refusal an applicant have the right to file the objections with the Chamber for Patent Disputes of Rospatent within three months following the date of sending of the decision. The experts from the Chamber for Patent Disputes of Rospatent considers the objections and decides to register a trademark or to refuse such registration.

In case of final refusal decision, an applicant has the right to appeal the decision with the Intellectual Property Rights Court . The Intellectual Property Rights Court considers the objections to final refusal/partial refusal. The Intellectual Property Rights Court may either to satisfy the objection of an applicant or to uphold wholly or in part the decision of the examination.

Cancellation Procedure

A trademark may be cancelled either on the basis of violation of absolute and/or relative grounds for refusal in registration of a trademark or on the basis of non-use (the non-use period is three years from the date of registration of a trademark).

The cancellation action is filed with the Intellectual Property Rights Court. The defendant is responsible for the evidence.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

To the best of our knowledge the practice of registration of three-dimensional trademarks is widely spread in Russia. In order to provide you with the detailed information regarding cases of cancel/remove/oppose against Shape Trade Mark Applications we need additional search.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

We are not familiar with such cases.

SINGAPORE

Contributor: Mr. Kim Tean Ng

Nanyang Law-H²
Singapore
www.houlihan2.com

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

We would recommend the filing of a Shape Trade Mark Application or an Application for Design Registration.

Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

Yes.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The application for registration should be accomplished by the following:

- a. Representation of a Shape Mark (in the form of a perspective or isometric drawing that shows clearly all the features of the Trade Mark);
- b. Description of the mark for example "a bottle of the shape shown in the representation"; and
- c. Indication on application form that the protection is for a 3D shape.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

Yes. The Applicant should prove to the satisfaction of the Registrar that before the date of the application, the Mark had in fact acquired a distinctive character because of the use made of it. If Examiner raises the objection of lack of distinctiveness, then, one should provide the Evidence-of-Use.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three dimensional) that have been successfully registered in your country.

Example 1:

Singapore Application No.	T0412651H
Application Type	Trade Mark

Trade Mark Type	3-dimensional shape
Description of Particular Feature(s) of Mark	The mark consists of a three dimensional shape of a bottle.
Class(es)	33
Filing Date	21/04/2004
Mark Status	Registered
Mark Status Date	07/11/2003
Expiry Date	21/04/2024

Example 2:



Singapore Application No.	T0412651H
Application Type	Trade Mark
Trade Mark Type	3-dimensional shape
Description of Particular Feature(s) of Mark	The trade mark consists of a combination of the three-dimensional shape of a bottle with a textured surface and a label which contains the words "MANDARINE NAPOLEON", "GRANDE CUVÉE" AND "GRANDE LIQUEUR IMPERIALE" and a device of a hat enclosed in a wreath as shown on the representation attached to the application form.

Class(es)	33
Filing Date	19/05/1999
Mark Status	Registered
Mark Status Date	07/11/2003
Expiry Date	19/05/2019

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Legislation Governing Trade Marks in Singapore:

The *Trade Marks Act (2005 Revised Ed) (Cap. 332)*, together with its subsidiary legislation which consists of the Trade Marks Rules and Trade Marks (International Registration) Rules, form the legislation governing the registration of Trade Marks in Singapore.

On 15 January 1999, Singapore brought its own new Trade Marks Act into force ('the 1998 Act'). Largely based on the 1994 Act, the 1998 Act (or 'the Act') was intended to implement Singapore's obligations as a TRIPS signatory. Almost identical provisions as in the 1994 Act were included in relation to Shape Marks. For registrations that had not yet been registered, Applicants could either have them determined under the old law or irrevocably converted to applications under the new TMA, in which case the converted applications would have to comply with the procedural and substantive registrability requirements of the new Act.

Absolute grounds for refusal of registration:

Section 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.

If the Applicant is seeking protection for a 3D shape, he should tick the appropriate box on Form TM 4. Rule 15(2) of the Trade Marks Rules states that an Application for the Registration of a 3D mark will not be treated as such unless the application form contains a statement to that effect. This indication, together with the representation and description, will indicate clearly that the applicant is applying for a 3D Shape Mark.

Section 7(3) objections applicable to 2-dimensional and 3-dimensional shape marks:

Shape suggests three-dimensional form. Confusion however arises where, although the sign sought to be registered appears to be a 3D Shape Mark, the graphic representation is in two-dimensions. The Registrar will ask the question, *“Is such a sign a three-dimensional shape or a two-dimensional drawing or picture of a figurative mark?”*

Usually the answer to this question should be **clear from the indication/description** of the mark on the application form. But even if it is not, it should make no difference to the applicability of Section 7(3). This was the approach taken in *Philips v Remington [1998] R.P.C. 283*. The sign there was a picture of the head of a three-headed shaver.

Thus, Section 7(3) objections can be raised for 2-D graphical representation of a 3-D Shape Mark. In the *Philips* case, it was found that the Mark was objectionable under an equivalent of our Section 7(3)(b) – that the sign was of a shape which was necessary to obtain a technical result, thus, it shall be refused registration.

(a)Section 7(3)(a) - Shapes resulting from the nature of the goods:

This ground prevents the registration of shapes that result from the nature of the Goods. It is not concerned to prevent registration of Marks consisting of the shapes of the Goods themselves as shapes of distinctively shaped goods can function as a Trade Mark, but rather, shapes that result from the nature of the Goods.

The nature of the Goods refers to their essential qualities or innate characteristics. For example, a sign consisting of the shape of a banana for bananas would be a shape, which results from the nature of the Goods themselves. So too, would a sign consisting of a bunch of bananas for bananas. To assess whether a shape is one which results from the nature of the Goods, the Registrar will look at the Goods to determine their nature and consider the following:

- (i) the extent to which the shape is regarded as the “normal” shape of the Goods;
- (ii) where the Goods have a “uniform” shape, whether the shape is a variation from the “uniform” shape; if so, the shape may not be objectionable on the ground that it results from the nature of the Goods; or
- (iii) where the Goods come naturally in a range of shapes, then any one of the usual shapes will be open to objection.

Example:

A picture of a lemon as a proposed trade mark for lemons would not be acceptable because the sign would consist exclusively of a shape which results from the nature of the goods themselves – lemons; likewise, a picture of lemons on the branch, or a silhouette of a lemon.

If the Goods were lemon juice, then a picture of a lemon should not fall foul of this provision. Likewise if the proposed mark was a yellow plastic container in the shape of a lemon, the shape may not be objected to on the ground that it results from the nature of the goods.

Where the specification is wide, “the Goods” refer to any of the Goods in respect of which the mark is sought to be registered. Thus, a picture of a banana for fruit would be just as objectionable as a picture of a banana for bananas.

Although the natural shapes of the Goods in question cannot be registered, if the shape has been the subject of substantial design input, then this objection no longer applies. For example, in *Philips v Remington (Case C-299/99)*, Phillips’ 3-headed shaver mark for “electric shavers” did not fall foul of this particular provision, since the mark is considered to have been subject to a substantial design input.

There is some overlap between this objection and the objections on the grounds that the mark is devoid of distinctive character or that the mark is descriptive of the Goods or Services. For example, where the Trade Mark is a picture of a bunch of bananas for bananas, obviously, objections can also be taken that the mark is descriptive and thus, not distinctive of the goods in question.

(b) Section 7(3)(b) - Shapes that are necessary to obtain a technical result:

The purpose of this provision is to exclude shapes which are merely functional in the sense that they are motivated by and are the result of technical considerations.

The ECJ in the *Philips v Remington* case ruled that a sign consisting exclusively of the shape of the Goods is unregistrable under this provision if the essential features of that shape are attributable only to the technical result. The fact that there are other shapes which allow the same technical result to be obtained is no defence.

A shape which is necessary to obtain a technical result is also likely to indicate the intended purpose of the Goods, or it may be customary in the trade and therefore, non-distinctive. Thus, the grounds under Section 7(1)(b) (that the shape is devoid of distinctive character), Section 7(1)(c) (that the shape exclusively designates the intended purpose or a characteristic of the Goods) and Section 7(1)(d) (that the shape is a shape that is customary in the *bona fide* and established practices of the relevant trade) would also apply.

(b)Section 7(3)(c) - Shapes which give substantial value to the goods:

The purpose of this provision is to exclude “aesthetic-type shapes” (see remarks of the UK Court of Appeal in *Philips v Remington*), *i.e.*, shapes which have eye appeal or are purchased primarily because of the eye appeal, for example, novelty soaps, ornaments, figurines, toys, etc. The decision whether the value is substantial requires, “*a comparison ... between the shape sought to be registered and shapes of equivalent articles. It is only if the shape has, in relative terms, substantial value that it will be excluded from registration.*” Any other value, for example, value due to use of better quality materials, should be disregarded.

Assessing distinctiveness of Shape Marks:

(a)Whether the shape is devoid of distinctive character:

Even if the preliminary obstacle under Section 7(3) is overcome, it is still necessary to ascertain whether a 3-D mark is to be refused registration under one or more of the absolute grounds for refusal – including whether the mark is devoid of distinctive character. The ECJ in *Philips v Remington* has settled for us the question whether “*there is a special category of marks which, even though not devoid of distinctive character in fact are none the less incapable of being a trade mark as a matter of law*” and the answer is “no”. This means that there is no need to consider the question whether the 3-D mark can, by itself, function as a Trade Mark within the definition of a Trade Mark because, the answer is yes, a 3-D mark can function as a Trade Mark. What needs to be considered is whether the mark is devoid of distinctive character or is objectionable due to any of the other absolute grounds of refusal (e.g. the mark is descriptive of the goods).

With respect to the absolute grounds of refusal, there is no distinction between the different categories of Trade Marks. The criteria for assessing the distinctive character of 3-D marks are thus no different from those to be applied to other categories of marks. As such, in order to be capable of distinguishing the goods, the shape of an article in respect of which a sign is registered does not require any capricious addition e.g., an embellishment which has no functional purpose (see *Philips v Remington*).

The test is simply, whether the mark serves to identify the product in respect of which registration is applied for as originating from a particular person, and thus, is capable of distinguishing the Goods and Services of one person from Goods and Services of other persons. A Trade Mark’s distinctiveness must be assessed by reference to first, the Goods or Services in respect of which registration is sought and second, by reference to the perception of the relevant persons, namely the consumers of the Goods or Services.

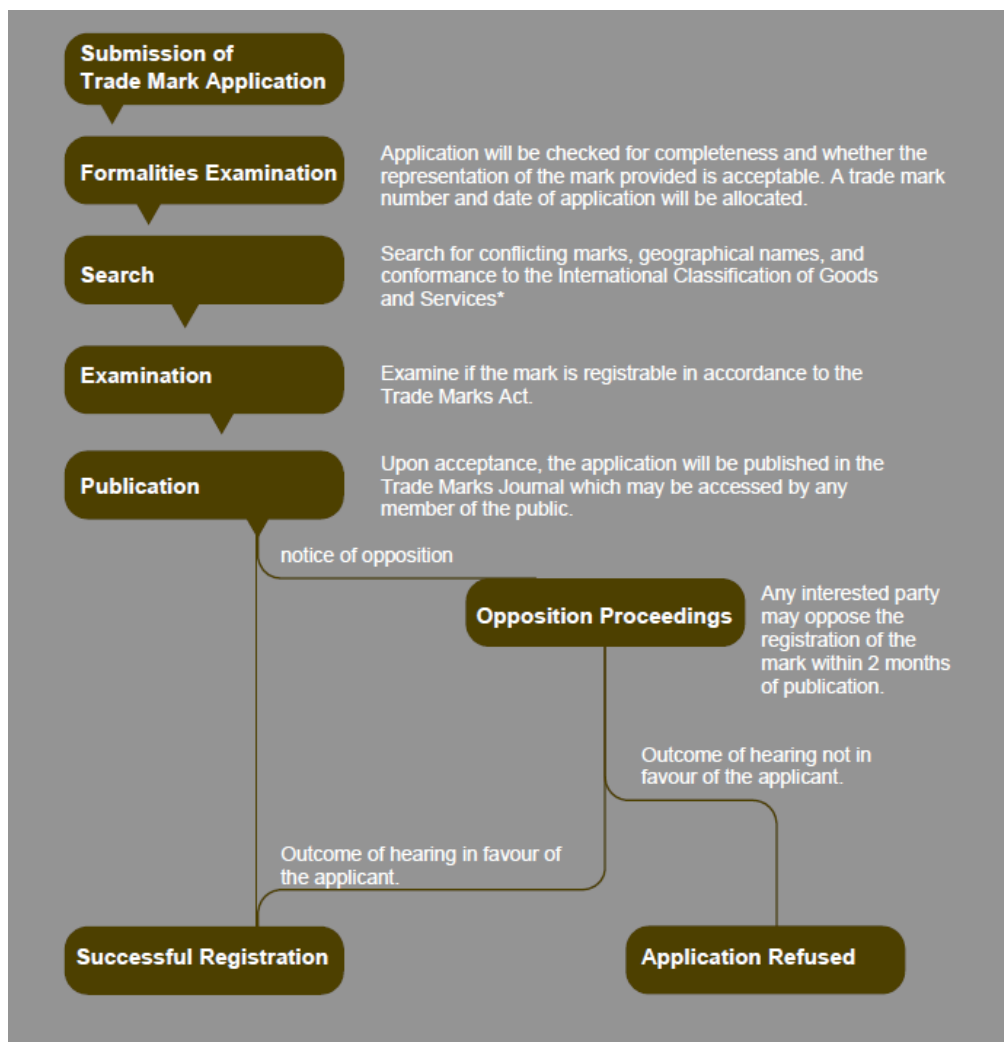
(b)Uniqueness is not the same as distinctiveness as a Trade Mark:

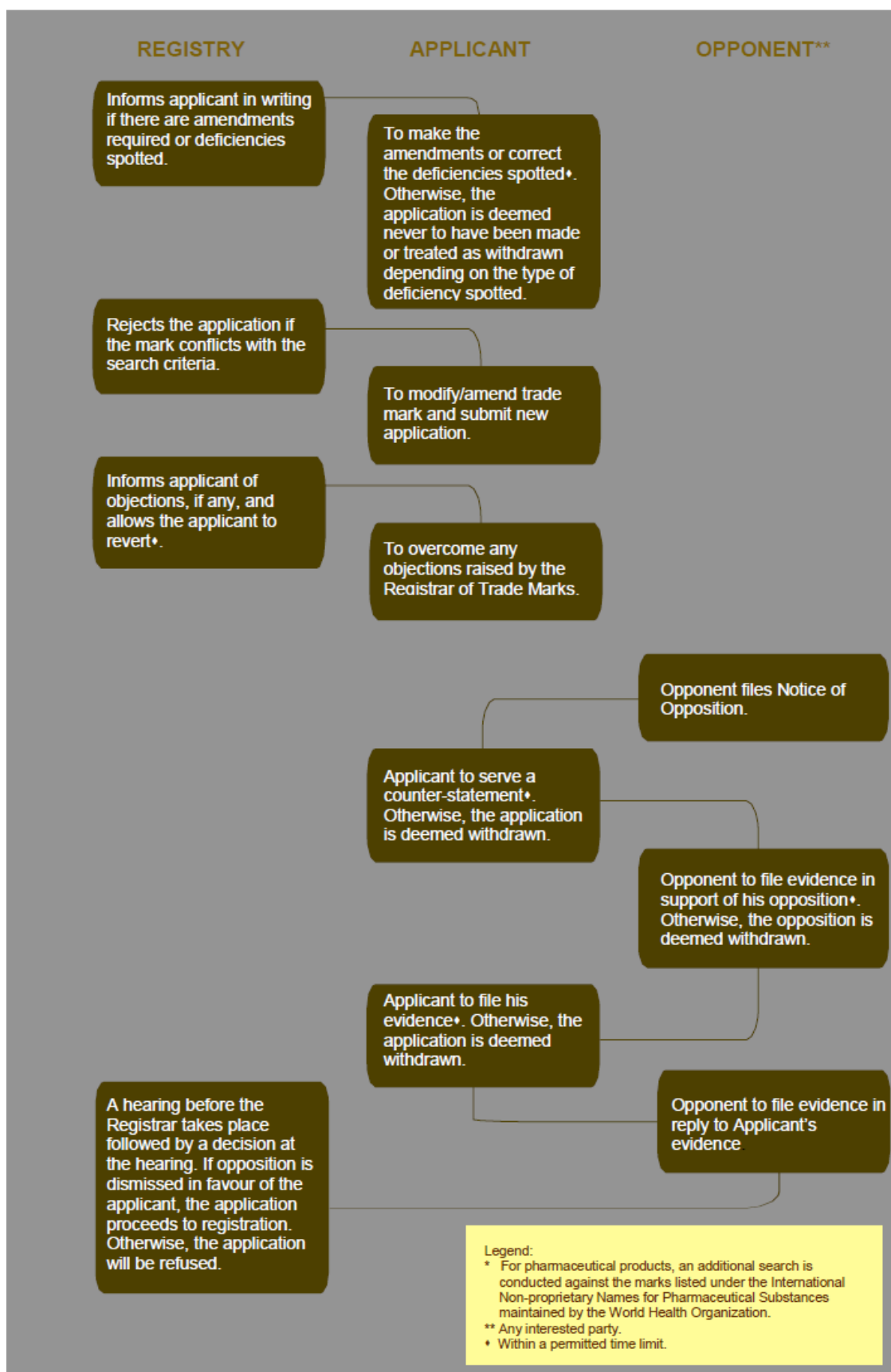
The test for *prima facie* acceptance is whether the average consumer will assume that all Goods that come in that shape belong to the **same undertaking**.

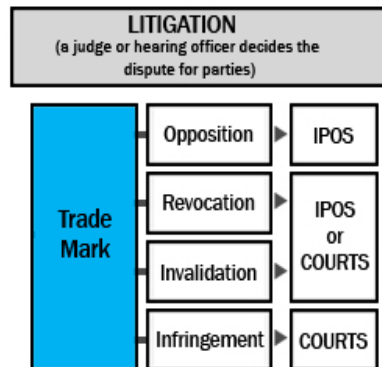
The test is not whether the shape is “*unusual*”, “*memorable*” “*recognisable on being seen a second time*”, or that the mark is eye-catching or highly decorative *per se*.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidity and Cancellation Proceedings regarding Registered Shape Trade Marks.

Below is the general flow chart of a Trade Mark Application which is also applicable to Shape Trade Marks.







Opposition:

Any interested party may oppose the registration of the Mark within 2 months of publication.

Trade Mark Form	Description	New Fee S\$
TM11	Filing of Notice of Opposition to - <ul style="list-style-type: none"> a. an amendment of an application for registration of a trade mark which has been published, where the amendment affects the representation of the trade mark or the goods or services covered by the application for registration b. the registration of a trade mark, collective mark or certification mark c. the removal of any matter from the register d. the alteration of a registered trade mark e. an application to amend the regulations governing the use of a registered collective mark or certification mark 	374.00 x number of class
HC6	Counter-statement to TM11	360.00 x number of classes
HC5	Request for grounds of decision for ex parte hearing	700.00 in respect of each trade mark number

Invalidation:

Trade Mark Form	Description	New Fee S\$
TM28	"Application for Revocation/Invalidation/Rectification"	357.00 x number of classes

Cancellation:

Trade Mark Form	Description	New Fee S\$
CM3	Request to surrender registered design/ request to surrender patent/ request to cancel or partially cancel registered mark	30.00 in respect of each trade mark

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

The application to register a Shape Trade Mark can have one or more columns to justify the following grounds for the shape registration:

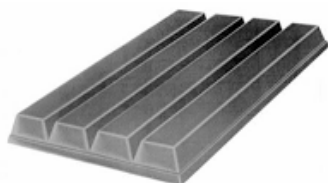
- (a) the shape which results from the nature of the Goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the Goods.

This may reduce substantial objections on the above grounds.

The Register may make mandatory deposit of the model of the shape to be registered to assist during the course of registration proceedings.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Nestlé vs. Petra Foods



Nestlé's claim that the shape of chocolate bar "Take-it", made by rival firm Petra Foods, infringed its Intellectual Property Rights was thrown out by the High Court. The Court ruled that even if Singapore-based Petra Foods "did copy" the shape of Kit Kat bars, it was not wrong.

“Imitation is no less valid a business strategy than innovation. There is nothing unconscionable about competition,” said Justice Chan Seng Onn in a 153-page judgment.

Swiss food giant Nestlé had registered the shape of its "four-finger" and "two-finger" Kit Kat brand of wafer products. The grooves found in the confection allow for each finger of chocolate to be snapped off easily, and have become part of Kit Kat's identity.

The lawyers argued that Petra had deliberately modelled the shape of its 2-Fingers and 4-Fingers Take-it chocolate wafer bar to ride on Nestlé's "coat-tails".

But Petra's lawyers said the shape of the Take-it products was necessary for efficient production, which meant Nestlé could not register Kit Kat's features as a trademark.

Justice Chan held that Trademark Law should not be misused to *"impede the freedom of competition"*. It will harm the market if *"the registration of a three-dimensional sign has the effect of forcing competitors to resort to a more expensive manufacturing process or to use a cheaper process which would result in a product that is less attractive to customers"*.

The Judge dismissed Nestle's claim "in their entirety" and ordered that its Registered Shapes be removed from the Register of Trade Marks. He ordered damages be assessed to compensate Petra for the "groundless threats of trademark infringement" made by Nestlé.

SOUTH AFRICA

Contributor: Mr. Simon Brown

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

It is possible to protect both shape marks and container marks in South Africa. These types of marks both fall into the definition of a 'mark' in terms of the Trade Marks Act 194 of 1993.

In addition to trade mark protection, it may also be advisable to seek protection of a shape or container through a Design application, in terms of the Designs Act 195 of 1993.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

Regulation 13(1) of the Trade Mark Regulations 1995, state that every application for the registration of a trade mark shall contain a representation, suitable for reproduction, affixed to it. In terms of Regulation 13(3) three dimensional marks must be represented in such a way that all the dimensions are clearly visible. Our courts have held that the pictorial representations of the mark must have the required degree of certainty for the public to know the extent of the monopoly claimed.

In addition to sufficient graphic representations, the application should also be endorsed to clearly describe the mark and define the rights sought.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

In order to be registrable as a trade mark, a mark should be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of other persons either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

A mark is either inherently capable of distinguishing at the date of application, or by reason of prior use.

Accordingly, in order to be registrable, a trade mark should still meet the usual registrability requirements. However, it is not necessary to provide evidence of use in order to obtain registration.

It is also important to mention that there are specific exclusions in the registration of shape or container trade marks. These are provided for in sections 10(5) and 10(11) of the Trade Marks Act (given in full in point 3) where a mark which consists exclusively of a shape is not registrable as a trademark where the shape is necessary to obtain a specific technical result, or results from the nature of the goods themselves.

In addition, a mark which consists of a container for goods or the shape of goods, where the registration of such mark is or has become likely to limit the development of any art or industry, such a mark is not registrable in terms of the Act.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

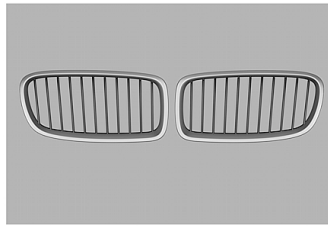
The Coca-Cola Company have secured registration for the shape of their VALPRE spring water bottle shape as well as their COKE bottle shape.



National Brands Limited has secured registration for the shape of their iced zoo biscuits.



BMW (Bayerische Motoren Werke Aktiengesellschaft) has successfully registered trade marks for a number of their radiator grills.



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Section 2(1) of the Trade Marks Act defines a mark as:

“Any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned”.

A trade mark, “other than a certification trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods and services for the purpose of distinguishing the goods or services from the same kind of goods or services connected in the course of trade with any other person”.

Section 10 deals with marks that are not registrable in South Africa. The most notable subsections relating to shape or container marks are the following:

Section 10(5), “a mark which consists exclusively of the shape, configuration, colour or pattern of goods where such shape, configuration, colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves”, and

Section 10(11), “a mark which consists of a container for goods or the shape, configuration, colour or pattern of goods, where the registration of such mark is or has become likely to limit the development of any art or industry”.

Some important case law includes:

- Beecham Group plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA);
- Cointreau et Cie SA v Pagan International (373/89) [1991] ZASCA 89; 1991 (4) SA 706 (AD); [1991] 2 All SA 497 (A);
- Die Bergkelder Bpk v Vredendal Koop Wynmakery 2006 (4) SA 275;
- Weber-Stephen Products Co v Alrite Engineering (Pty) Ltd and OTHERS 1992 (2) SA 489 (A);
- Adidas AG & another v Pepkor Retail Limited (187/12) [2013] ZASCA 3; and
- Société des Produits Nestlé S.A. v International Foodstuffs 100/14) [2014] ZASCA 187

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

Opposition

Any interested person may, within three months following the advertisement of the trade mark application in the Patent Journal, lodge an opposition to the registration of the trade mark.

Extension of the opposition period is available for an initial period of three months by way of a request to the Registrar. Further extensions can only be obtained with the consent of the applicant, or on the basis of good cause shown on application to the Registrar.

Opposition proceedings are prescribed by Regulation. A notice of opposition is lodged, accompanied by a founding affidavit containing the evidence on which the opposition is based. The applicant for registration has one month to notify the opponent whether or not he intends to defend the opposition. Within two months of such notification, the applicant must deliver an answering affidavit with supporting evidence. The opponent has one month to deliver a replying affidavit.

Extensions of deadlines for both parties may be requested and agreed to between the parties or, on the basis of good cause shown, on application to the Registrar be granted by the Registrar.

The matter is thereafter set down for hearing by the Registrar, who has powers equivalent to those of a judge of the High Court.

Cancellation/removal of a trade mark

Any interested person may apply in the prescribed manner to the Registrar or to the court for the desired relief for:

- the non-insertion in or omission from the register of any entry;
- an entry wrongly made in or wrongly remaining on the register; or
- any error or defect in any entry appearing in the register.

Proceedings for the cancellation/removal of a trade mark are brought on notice of rectification supported by an affidavit setting out the facts on which the applicant relies. It is possible to institute rectification proceedings either before the Registrar or in the High Court. Proceedings before the Registrar are essentially the same as application proceedings in the High Court.

Grounds for cancellation/removal of a trade mark

A trade mark registration may be cancelled and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see below), in addition to the following:

- that the trade mark was registered without any *bona fide* intention of the applicant that it would be used, and that there in fact has been no *bona fide* use up to the date three months prior to the application;
- that up to three months before the application for cancellation, there has been no use of the trade mark for a continuous period of five years or more from the date of issue of the registration certificate.

Use requirement and cancellation

Use of the trade mark prior to the application is not required; only the *bona fide* intention to use the trade mark. Registration may be cancelled if the trade mark was registered without any *bona fide* intention to use the mark and there has, in fact, been no use of the mark.

Failure to use the trade mark for a continuous period of five years after date of issuance of the registration certificate will render the registration vulnerable to removal from the register.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

Proprietors defending opposition or cancellation proceedings would be well advised to lead evidence proving that the shape or container mark is, in the eyes of a reasonable consumer, believed to be a source indicator. It is also vital to show that the shape or container differs fairly significantly from other shapes or containers.

Grounds of opposition

Grounds on which an opposition can be based, include:

Both absolute and relative grounds of opposition are available; some of the many grounds listed in the Act are set out below:

- that the mark does not constitute a trade mark, or is not capable of distinguishing the goods or services;
- that the mark consists exclusively of a sign which may serve in trade to designate kind, quality, intended purpose, value, geographical origin, *etc.*;
- that the mark is inherently deceptive, or the use of the mark is likely to deceive or cause confusion, or will be *contra bonos mores*;
- that the mark is identical to the registered trade mark of another party, or identical to the mark which is the subject of an earlier application by another party, or so similar that use thereof on the intended goods or services would be likely to deceive or cause confusion;
- that the mark is identical or similar to a trade mark already registered and which is well known in South Africa, if the use of the mark is likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the well-known registered mark;
- that the mark is one to which the applicant has no *bona fide* claim to proprietorship, or no bona fide intention of using as a trade mark;
- that the mark consists of a sign or an indication which has become customary in the current language or the established practices of the trade;
- that the mark consists of the national flag or armorial bearings of the Republic or another state or an international organization; or
- that the mark was filed in bad faith.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

The South African Courts have generally not shown much enthusiasm for the protection of shape marks.

The Supreme Court of Appeal (SCA) took a very critical approach to container marks in the case of *Die Bergkelder Beperk vs Vredendal Ko-op Wynmakery* in 2006. In that matter, the SCA held that, while from a legal perspective container trade marks do not differ from any other kind of trade mark in that they must be capable of distinguishing in order to be registrable, from a practical point of view they stand on a different footing. The court went on to say that containers are not usually perceived to be source indicators and, as such, in order to be able to fulfil a trade mark function, a container must at least “differ significantly from the norm or custom of the sector”. The court also pointed out that there is generally a dependency between container marks and other marks such as word marks because a container is typically never used without a word mark. As there was insufficient evidence of the container in question differing significantly from the norm or custom of the sector, the registration was removed from the Register.

In light of this decision, it is our recommendation to proprietors to lead evidence relating to the “norms and customs of the sector” to show that their shape or container differs fairly significantly from other shapes or containers and also to show that the public perceive the shape or container as a badge of origin.

Most recently, in *Société des Produits Nestlé S.A. v International Foodstuffs*, the SCA in 2014 held that Nestlé’s registrations for their 2 and 4 wafer finger (KIT KAT) shape trade marks were valid. The judgment dealt with a substantial amount of trade mark law on surrounding issues but ultimately the SCA held in favour of Nestlé.

SPAIN

Contributor: Elia Sugrañes

SUGRAÑES

Barcelona

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

YES, as there is not a closed list of possible kinds of trademarks. Both cases could be registered as the shape itself or the shape together with the word. In case of registering the shape itself, it should be devoid of distinctive character and not descriptive of the goods and services to be protected.

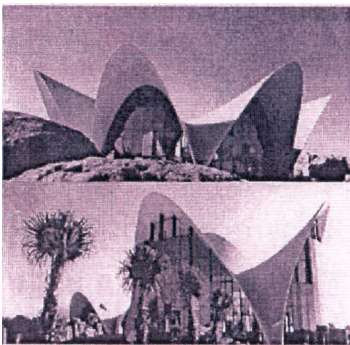
- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

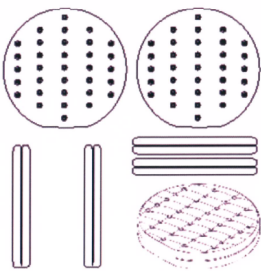


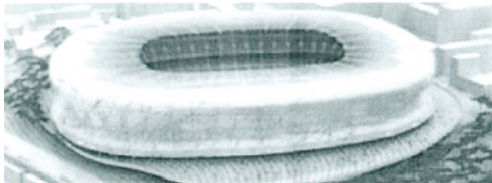
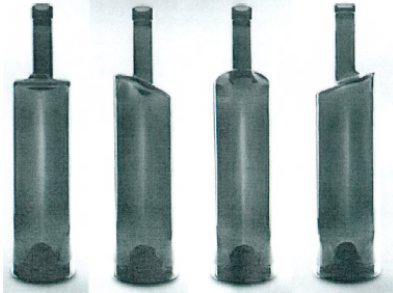
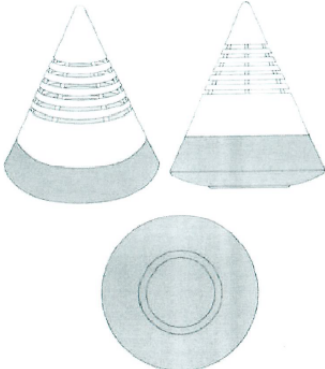
Only the reproduction of the trademark is required.

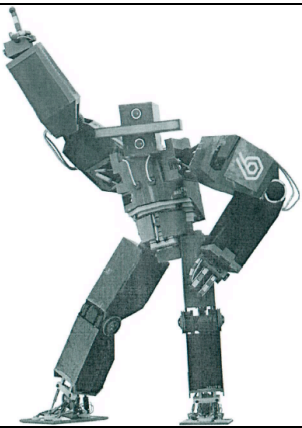
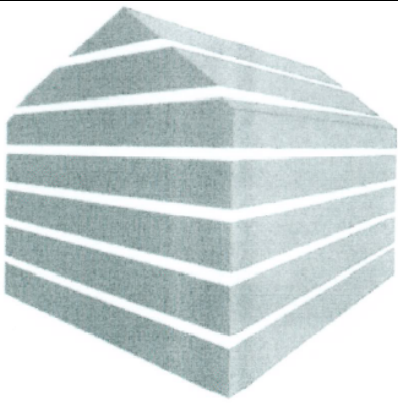
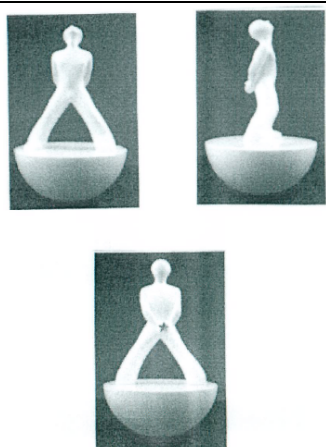
- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

NO, this is only required in cases when the shape mark has acquired distinctiveness.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Registration Number	Trademark	Class
M 3030128 (9)		06, 25, 35, 38, 41

M 3509061(8)		30
M 3500811(3)		03
M 3107366(2)		25
M 3109371(X)		06,09,14,16,18,21, 24,25,41
M 3500604(8)		21,33
M 3503318(5)		05

M 3512528(4)		25
M 3508100(7)		36,45
M 3112554(9)		20,35

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

Spanish Trademark Law 17, 7 December 2001

Concept of a Trademark:

- (1) A trademark means any sign able to be represented graphically and used to distinguish the goods or services of one company from those of other companies in the marketplace.
- (2) Such signs may in particular be:
 - (a) words or combinations of words, including those used to identify individuals;

- (b) images, figures, symbols and drawings;
- (c) letters, numbers and combinations thereof;
- (d) three-dimensional forms including wrappers, packaging and the shape of a product or its presentation;
- (e) sounds;
- (f) any combination of the signs which, for declaratory purposes, are mentioned in the previous subparagraphs.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.



Opposition could be filed in Spain in two months since the application of the trademark is published, depending on the outcome of the opposition the trademark will be granted. This decision could still be appealed at the same Office.

Cancellation and Invalidations proceedings could be filed at the Court of Commerce. They are all civil proceedings that might take a year at a minimum. Once the decision is final, it could be still appealed before the Administrative Court. This proceeding might take a year at a minimum.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

It is important to check the distinctive character it will be used at the end and file a registration with and without a word mark.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Trademark Application No.	Applicant	Opponent	Opponent's rights	Situation
2994227 GPM ESPAÑA 	MOORE, EVA BIRGITTA	KRAFT FOODS SCHWEIZ HOLDING GMBH	CTM 31229 	Protection granted in Spain
ES 2857976 GULLON 02 	GALLETAS GULLON, S.A.	KRAFT FOODS GALLETAS S.A.	ES 1997588 	Protection granted in Spain

<p>ES 2609222 CARBONELL</p> 	<p>KOIKE CORPORACION SL</p>	<p>TETRA LAVAL HOLDINGS &</p>	<p>CTM 1620566</p> 	<p>Protection granted in Spain</p>
<p>ES 2618147 COLA BLANCA PEGA FUERTE LA MADERA RAPIDA SECA TRANSPARENTE SUPERGEN</p> 	<p>TESA TAPE, S.A.</p>	<p>SUPER QUIMICA,S.A.</p>	<p>ES 3052539 CEYS COLA BLANCA RAPIDA</p> 	<p>Protection refused in Spain</p>

TAIWAN

Contributor: Wu-Shung Houn

LOUIS INTERNATIONAL PATENT OFFICE

Taipei

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

Yes. Article 18 of our Trademark Act allows a three-dimensioned figure to be registered as a trademark.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

To apply for a three-dimensional Shape Trademark, the following materials are necessary:

(1) Reproduction of the three-dimensional shape trademark.

If the appearance of a three-dimensional Trademark varies along with different views, a maximum of six drawings of the Trademark in different perspective views may be furnished. The examiner may request the applicant to submit additional perspective drawings in different views if necessary.

The functional element of a Trademark may be depicted in broken lines in the drawings. If a Trademark contains any non-distinctive or functional elements in solid lines rather than in broken lines, either a disclaimer of those elements must be made or the non-distinctive or functional elements should be amended and depicted in broken lines.

(2) Description of the three-dimensional Shape Trademark.

The description of the Trademark should state the type of the Trademark and explain how it is used in connection with relevant Goods or Services. The description shall also explain the parts which use broken lines.

(3) The advertisement, promotional materials, or other explanatory materials.

The advertisement or magazine published by the same trade or business for its products. In the case of the Trademark, it is the shape of Good or the shape of the packaging or container.

If the Trademark is the shape of Good or the shape of the packaging or container of Goods, the advertisement, promotional materials, or other explanatory materials shall be provided.

b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

Yes, if the Shape Trade Mark has become the recognition symbol of the Applicant, Evidence-of-Use shall be provided. If the Trademark is the shape of Good or the shape of the packaging or container of Goods, the advertisement, promotional materials, or other explanatory materials related to the Trademark shall be provided. In addition, it is necessary to prove that there are different shapes or designs for competitors to use by producing advertisements or magazines published by the same trade or other business' products.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Six actual cases are provided below:

Case 1

Registration No. 01208204; Registrant: SOCIETE JAS HENNESSY & CO (France based company)



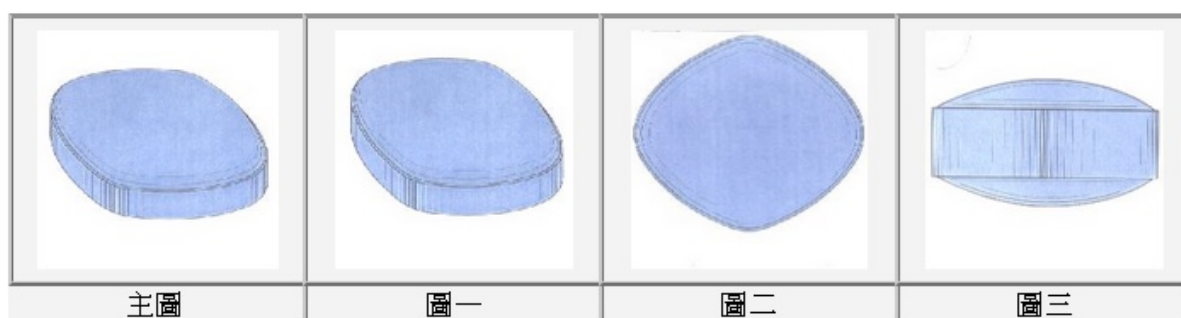
Case 2

Registration No.01579281; Registrant: SOREMARTEC S.A. (Luxembourg based company)



Case 3

Registration No. 01195779; Registrant: PFIZER PRODUCTS INC. (American company)



Case 4

Registration No. 01200293; Registrant: Ferrero S.P.A. (Italian company)



Case 5

Registration No. 01200291; Registrant: Ferrero S.P.A. (Italian company)



Case 6

Registration No.01134031; Registrant: Daimler AG (German company)



3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

(1) Article 18 of Trademark Act:

A trademark shall refer to any sign with distinctiveness, which may, in particular, consist of words, devices, symbols, colors, three-dimensional shapes, motions, holograms, sounds, or any combination thereof.

The term “distinctiveness” used in the preceding paragraph refers to the character of a sign capable of being recognized by relevant consumers as an indication of the source of goods or services and distinguishing goods or services of one undertaking from those of other undertakings.

(2) Article 15 of Enforcement Rules of the Trademark Act

Where the application contains a statement to the effect that the mark is a three-dimensional trademark, the reproduction of the trademark shall consist of not more than six views depicting the three-dimensional shape.

The reproduction under the preceding paragraph may use broken lines to show the manner, placement or context in which the three-dimensional shape is used on the designated goods or services.

The applicant shall furnish a description explaining the three-dimensional shape. Where the trademark contains an element other than the three-dimensional shape, the explanation of the element shall be included in the description.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

There is no difference between the shape trade mark and general trademark related to the forum and procedure of opposition, invalidation and cancellation.

An opposition may be filed within three months after a trademark has been registered and published. An application for opposition may be filed for part of the designated goods or services of the registered trademark.

An invalidation action may be filed only by an interested party against a trademark of which the registration has been granted. (Article 57)

The complainant shall provide evidence of use of the mark of the trademark to be invalidated to show the fact that the mark has been used for more than three years. However, the invalidation may not be filed against a trademark which has been registered for more than five years unless the registration was applied for in bad faith.

A revocation may be filed after a mark has been granted registration on the grounds of non-use of the mark for three years, or if the trademark is altered from the way it is registered such that the trademark has become identical with or similar to another party's registered trademark and thereby a likelihood of confusion is present.

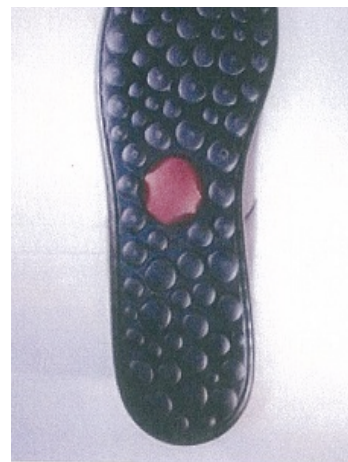
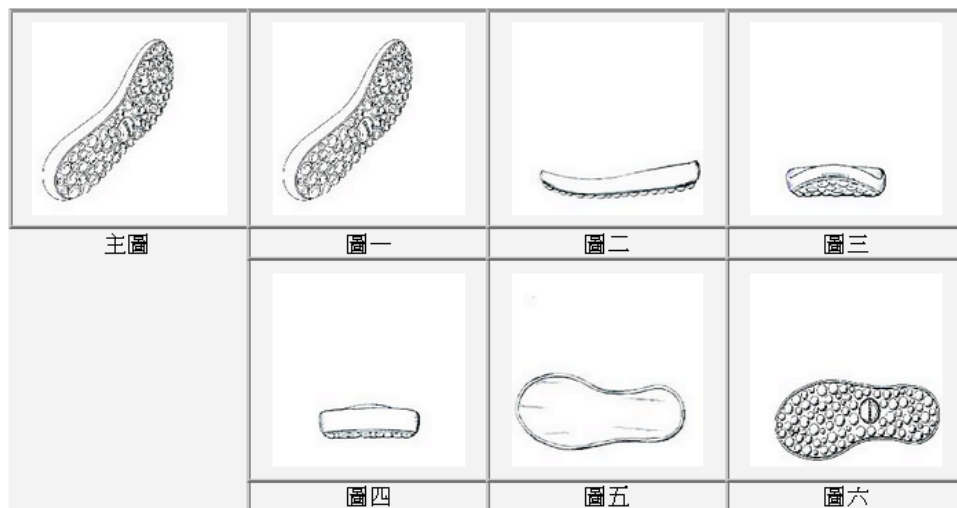
Appeal: In the event that the Intellectual Property Office return an unfavorable decision, it is possible to appeal to Ministry of Economic Affairs. If the decision is still unfavorable, the applicant may file an administrative suit with Intellectual Property court and appeal to administrative Supreme Court.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

The reasons to take action against Shape Trade Mark Applications would be that:
 (1) the trademark is exclusively necessary for the Goods or Services to be functional,
 (2) lack of the distinctiveness. If the reason of invalidation is that the registered trademark is similar to the cited trademark, it shall be borne in mind that the applicant shall provide the evidence-of-use of the cited trademark in the case that the cited trademark has been registered for more than three years. Therefore, before taking action against a Shape Trademark it is necessary to collect and preserve the evidence of use and promotional materials related to the both party's trademarks.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Registration No.01507267; Registrant: CAMPER, S.L. (Spanish company)



Intellectual Property Court First Instance / Judgment of May 2, 2013
 Case No. 2012 Min-Syang-Su-46

In this case, the Intellectual Property Court partially upheld the plaintiff's claim (totally upholding the claim for an injunction and partially upholding the claim for damages).

THAILAND

Contributor: Mr. Kowit Somwaiya

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?



Shape Trade Marks ("STM") can be protected in Thailand as a trademark under the *Trademark Act B.E. 2534* as amend. An STM can also be protected as a product design patent under the *Patent Act B.E. 2522* as amended if it has novelty, *i.e.* if it is a new design which did not previously exist, and was not disclosed or published before the date of its application for registration as a product design. It is also protected by operation of law (without registration) as a copyright work of applied art under the *Copyright Act B.E. 2537* if it is a photographic work representing a configuration with tangible volume for a utilization or commercial purpose in addition to the appreciation in its merit as an artistic work.

The best protection for the STM is Trademark Registration.

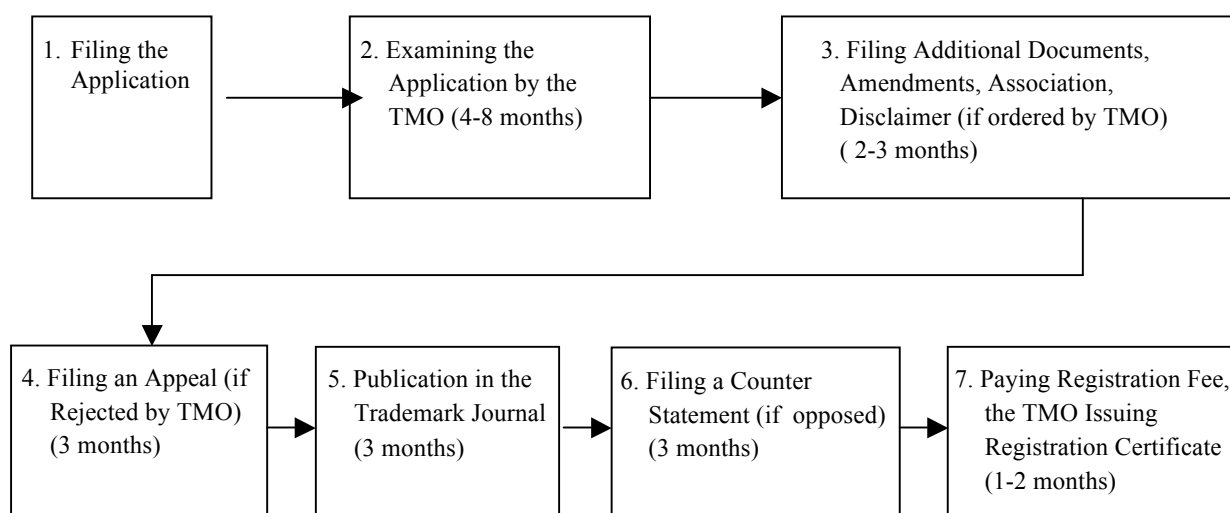
- a. What do you need to provide to accompany an application for registration of a three-dimensional Shape Trade Mark?

An application for registration of an STM must be accompanied by the required information and documents normally required for a trademark application. The filing requirements include a power of attorney from the applicant, a specimen of the mark showing its pictures or drawings from different perspectives, and a

specification of goods or services for which the application is filed. The power of attorney must be signed by the applicant and notarized by a Notary Public confirming the legal status and the signature the applicant.

The application must be filed with the Trademark Office (“TMO”) of the Department of Intellectual Property (“DIP”) under the Ministry of Commerce.

The following steps for obtaining registration of a trademark of an STM. A smooth application goes through only steps 1, 2, 5 and 7 and reaches registration in around 12 to 18 months. A trademark registration is valid for 10 years.



b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?

If the STM is inherently distinctive, there is no need to file any evidence of use to prove its acquired distinctiveness from use and advertising in Thailand.

If the STM is not distinctive, the applicant needs to prove its acquired distinctiveness by filing proof of use and advertising to prove that, through its long and extensive use and advertising with the goods or services in question in Thailand, the mark has become well known to the public or the people in the relevant industry to the extent that the mark can distinguish the goods or services under the mark from goods or services of others.

The evidence of use can include copies of: purchase orders for the goods under the trademark, bills of lading or delivery receipts of the goods under the trademark, invoices showing sales of the goods under the trademark, invoices for advertising expenses. The evidence of advertising can include advertisement materials showing advertisements or promotion of the goods under the trademark in such media as: newspapers, books, magazines, brochures, leaflets, posters, product catalogues, product manuals, television commercials, radio advertising

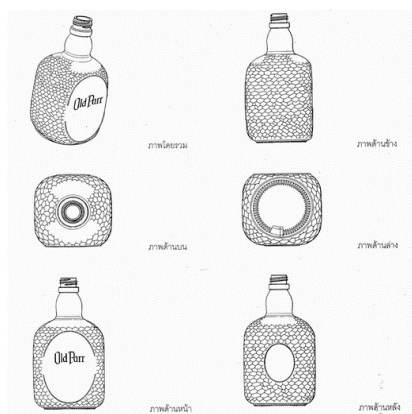
spots, internet advertising printouts, pre-movie commercials, indoor advertising scripts or video clips, signboards, billboards, point-of-sale advertising materials, outdoor advertising materials mounted on buses, taxis or cars and pictures showing, activities, exhibitions, events, or pictures or samples of the goods with labels or packages bearing the trademark.

The evidence of use must show use of the trademark substantially in the form and with the goods or services as filed in the application.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Below samples of STM registered in Thailand:

1. Trademark:



Owner: Diageo Brands BV, Netherlands

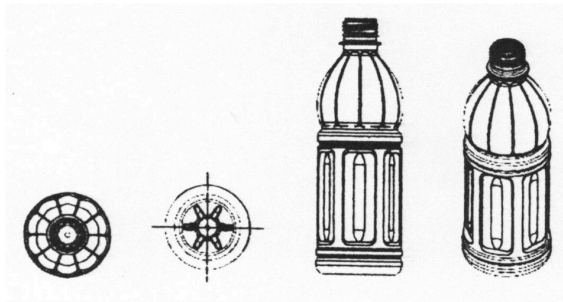
App. No.: 615659

Reg. No.: TM273283

Reg. Date: 20th January 2006

Class: 33

2. Trademark:



Owner: The Coca-Cola Company, USA

App. No.: 626441

Reg. No.: TM286364

Reg. Date: 19th May 2006

Class: 32

3. Trademark:



Owner: The Coca-Cola Company, USA

App. No.: 632685

Reg. No.: TM302889

Reg. Date: 20th July 2006

Class: 32

4. Trademark:



Owner: The Coca-Cola Company, USA

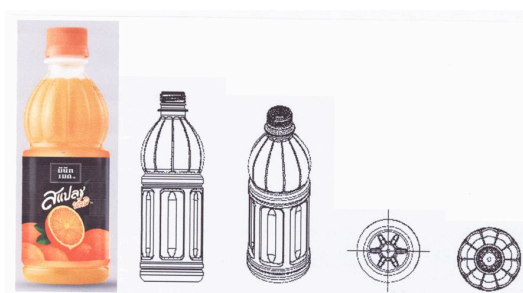
App. No.: 632686

Reg. No.: TM302890

Reg. Date: 20th July 2006

Class: 32

5. Trademark:



Owner: The Coca-Cola Company, USA

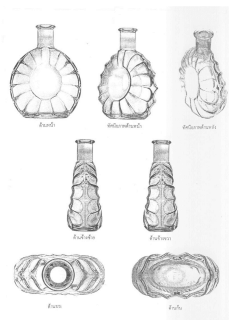
App. No.: 632687

Reg. No.: TM283683

Reg. Date: 20th July 2006

Class: 32

6. Trademark:



Owner: E. Rémy Martin & Co., France

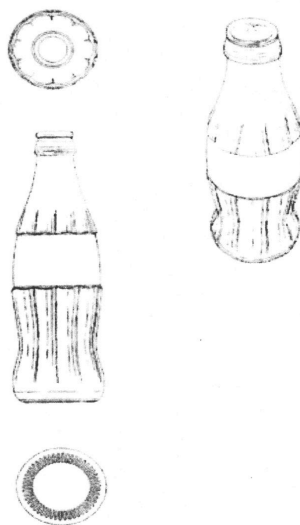
App. No.: 650551

Reg. No.: TM278438

Reg. Date: 15th January 2007

Class: 33

7. Trademark:



Owner: The Coca-Cola Company, USA

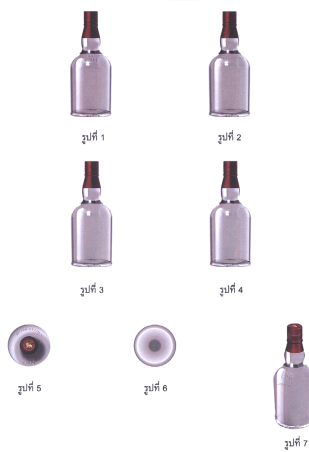
App. No.: 653895

Reg. No.: TM373821

Reg. Date: 21st February 2007

Class: 32

8. Trademark:



Owner: Chivas Holding (IP) Limited, Scotland

App. No.: 724622

Reg. No.: TM330292

Reg. Date: 17th March 2009

Class: 33

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

(1) *The Trademark Act B.E. 2534 (A.D. 1991)* as amended by Trademark Act (No. 2) B.E. 2543 (A.D. 2000)

Section 4. In this Act:-

"mark" means as a brand, name, word, letter, photograph, drawing, device, manual, signature, combination of colors, shape or configuration of an object or any one 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.

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 one which enables the public or users to distinguish the goods with which the trademark is used from other goods.

A trademark having or consisting of any one of the following essential characteristics shall be deemed distinctive:-

- (1) a personal name, a surname not being such according to its ordinary signification, a name of juristic person or tradename represented in a special manner;*

(2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister in the Ministerial Notifications;

(3) a combination of colors represented in a special manner, stylized letters, numerals or invented word;

(4) the signature of the applicant for registration or to predecessor in his business or the signature of another person with his or her permission;

(5) a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;

(6) a shape or configuration device.

Names and words not having the characteristics under (1) or (2) if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met shall be deemed distinctive.

(2) The Regulation of the Department of Intellectual Property (“DIP”) Re: Rules and Procedures for Registration of Shape or Configuration of an Object as a Trademark dated 13th May 2002

Please see an English translation of this regulation below, which was prepared by the authors of this Report. Although care was taken to render the translation as reliable as possible, it does not carry any legal authority. Only the original text in Thai has legal force.

This Regulation sets out the rules and procedures on the meaning of a shape or configuration of an object, how to file an application for registration of a shape or configuration, and the characteristics of a shape or configuration that can be registered as a trademark.

*Regulation of the Department of Intellectual Property
Re: Rules and Procedures for Registration of Shape or Configuration Mark*

The Trademark Act B.E. 2534 as amended by the Trademark Act (No. 2) B.E. 2543 does not define the meaning of a shape or configuration mark and at the present there is no rules and procedures for registration of a shape or configuration mark.

For the purpose of all examinations of shape or configuration marks under the Trademark Act to be carried out correctly and under the same guideline, the Department of Intellectual Property hereby issues rules as follows:

1. Meaning of a Shape or Configuration of an Object

The term "Shape or Configuration" means a mark which has a character of a shape or configuration of an object showing the width, length and depth of the object and clearly distinguishing the mark from the marks in other characters as specified under Section 4, such as photographs, drawings, invented pictures.

The term "Object" means an object used in the form of a shape or configuration which may be a shape or configuration of a photograph, drawing, invented picture, brand, name, word, wording, letter, number, signature, or any one or combination thereof.

2. Procedure for Filing an Application

2.1 The applicant must show all the essential pictures of the shape or configuration to be protected in the form of photographs or drawings affixed to the application form.

2.2 The applicant may also file a description of the shape or configuration to support the application but the description cannot count more than 100 words and it must be filed together with the application.

3. The Characters of a Shape or Configuration Which Is Registrable

3.1 It must be a mark having distinctiveness

3.1.1 A shape or configuration mark which is distinctive must have the following characters:

3.1.1.1 Being a distinctive mark under Section 7. For example, a shape or configuration mark which has or consists of any of the followings as the essential elements shall be deemed distinctive:

(1) a shape or configuration of an object which is a personal name, a surname not being such accordingly to its ordinary signification, a name of a juristic person or a trade name represented in a special manner having no direct reference to the character or quality of the goods;

(2) a shape or configuration of an object which is a word or words having no direct reference to the character or quality of the goods and is not being a geographical name prescribed by the Minister in the Ministerial Notification No. 5 (B.E. 2535);

(3) a shape or configuration of an object which is a combination of colors represented in a special manner;

(4) a shape or configuration of an object in the form of stylized letters, stylized numerals or invented words;

(5) a shape or configuration of an object which is the signature of the applicant or predecessor in his business or the signature of another person with his or her permission;

(6) a shape or configuration of an object which is a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;

(7) a shape or configuration of an object which is an invented picture, such as a shape or configuration of an object which represents a figure of a person running with a torch in hand.

3.1.1.2. Not being a shape or configuration of the goods or services or related to the goods or the services or referring to the character or quality of the goods or the services, such as a shape or configuration of an object which is a shape of a bread loaf used for bread, a shape or configuration of an object which is a shape of a liquor bottle used with liquor, or a shape or configuration of an object which is a figure of a dancing person used for discotheque services.

3.1.1.3 Being a shape or configuration of an object which is the character of the goods or the services or related to the goods or the services or refers to the character or quality of the goods or the services but has been modified or decorated to the extent that the public or users of the goods or the services know and understand that the said shape or configuration is the goods or the services or related to the goods or the services or refers to the character or quality of the goods or the services. For example, a shape or configuration of a duck used with perfume, where the said duck configuration has been modified to the extent that it will not lead the public or the users of the goods to understand the said duck configuration is the bottle of perfume, then it shall be deemed that such duck configuration is not a bottle used with perfume.

3.1.1.4 Not being a shape or configuration of an object, even having been modified or decorated but can still be perceived as the goods or services or related to the goods or the services or referring to the character or quality of the goods or the services. For example, a shape or configuration of an object in the form of a bottle of perfume, even the bottle has been modified as a duck configuration but the head of the bottle is still a perfume spray nozzle.

3.1.2 It a mark which is a shape or configuration of an object does not have distinctiveness under Clause 3.1.1 but has been used as a trademark or a service mark or a certification mark or a collective mark, and has been used for sales or advertisements of the goods or services extensively until it is well known to the extent that the public or the users of the goods or services know and understand that the goods or services for which the mark is used are different from the goods or services of another party, it shall be deemed that such a mark is distinctive. Proofs of distinctiveness based on sales or advertisements shall be made pursuant to the Notification of the Ministry of Commerce Re: Proofs of Distinctiveness under Section 7, Paragraph 3 of the Trademarks Act B.E. 2534 (A.D. 1991) dated 23rd September 1999.

3.2 Shape or Configuration Prohibited from Registration

A shape or a configuration mark must not be a mark that contains any prohibited characteristics under Section 8, such as a shape or configuration that resembles the national flag of Thailand or a shape or configuration that resembles a sea lion, which is the national symbol of Singapore.

3.3 Shape or Configuration Must Not Identical with or Similar to a Registered Mark of Another Person

The shape or configuration mark must be a mark which is not identical with or similar a registered mark of another person to the extent that the public may be confused or misunderstand the ownership or origin of the goods or services under the mark with the ownership or origin of the goods or services of the another person in same class or a different class but where the Registrar has been of a view that they are of the same characteristics, in accordance with Section 13. For example, a shape or configuration of a cup must not be identical with or similar to another registered trademark of another person that is a shape or configuration of a cup alone or a cup plus the word “cup” in the Thai language or a foreign language for goods in the same class or goods in a different class but having the same characteristics.

This regulation shall become effective immediately.

Given on 13th May 2002

Mr. Yanyong Puangraj

Director-General of Department of Intellectual of Property

[*\(3\) The Supreme Court Judgment Red Case No. 7024/2549*](#)

[The Coca-Cola Company \(“Coca-Cola Co”\) filed an application to register its Coca-Cola bottle with the DIP in 2006. The bottle was represented as a two-dimensional image. The DIP found it a generic picture and descriptive of the relevant product \(soft drink\) and refused its registration. Coca-Cola Co appealed with the Trademark Board \(“TMB”\). The TMB sustained the rejection ordered of the DIP. Coca-Cola Co filed the lawsuit with the Intellectual Property and International Trade Court \(“IP&IT Court”\). The IP&IT Court held that the pictorial representation of the bottle was registrable. The DIP appealed with the Supreme Court. The Supreme Court upheld the decision of the IP&IT Court reasoning that the very specific and unique design and the fanciful feature of the Coca-Cola bottle \(its convex and concave parts and concave spots around the bottle\) were sufficient to make it inherently distinctive, and there was no need for the Court to consider the evidence of its acquired distinctiveness through use. The Supreme Court also reasoned that the Coca-Cola bottle was an invented picture and Coca-Cola Co did not seek to register it for beverage containers but for soft drink.](#)

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

There is no specific forum and procedure for opposition, invalidation and cancellation of STMs. The opposition and cancellation proceedings for trademarks in general apply. They are summarized as follows:-

Opposition:

An application for registration of a trademark may be opposed by any person on the grounds of a better title, non-registrability, or the application having been filed in violation of law. The opposition must be filed with the TMO within 90 days of the publication dated of the mark. The TMO notifies the applicant of the opposition and gives him a copy of the opposition. The applicant of the opposed trademark can file a counter statement within 90 days of the date on which the application received the notice from the TMO. The opponent or the applicant may appeal with the TMB against the decision of the TMO.

Cancellation:

- (1) A registered trademark may be cancelled by the trademark Registrar of the TMO if:
- (i) the trademark owner does not apply for renewal of the trademark registration when it expires;
 - (ii) the trademark owner violates or fails to comply with the conditions or restrictions prescribed by the Registrar upon registration of the mark; or
 - (iii) the owner of the trademark or his agent ceases to have an office or address in Thailand.

The trademark owner can file an appeal with the TMB against the cancellation under items 2 and 3 within 90 days from the date of receipt of the cancellation notice from the TMO. The cancellation under item 1 cannot be appealed.

(2) The TMB may cancel a trademark registration upon a request by an interested person on the grounds that at the time of registration the trademark: (1) was not distinctive; (2) contained or consisted of a prohibitory characteristics; (3) was identical with a trademark registered by another person for goods in the same class or in a different class but with the same character; (4) was confusingly similar to a trademark registered by another person to the extent that the public might be confused or misled as to the owner or origin of the goods under the trademark for goods of the other person in the same class or in a different class but with the same character.

- (3) The TMB may also cancel a trademark registration if:
- (i) a person petitions that the trademark is contrary to the public order or the good moral or the public policy; or
 - (ii) an interested person or the Registrar petitions that at the time of registration the owner of the trademark had no bona fide intention to use the trademark with the goods for which it was registered and in fact there was no bona fide use whatsoever of the trademark for such goods or that

during the three years prior to the petition for cancellation there was no bona fide use of the trademark for the goods for which it was registered.

- (4) The Court may cancel a trademark registration if:
- (i) any interested person or the Registrar files a legal action in Court on the grounds that at the time of the filing of the legal action the registered trademark had become common to the trade or the public for certain kinds or certain classes of goods to the extent that the trademark had lost its meaning as a trademark; or
 - (ii) within five years from the date on which the Registrar ordered registration of the trademark, an interested person petitions with the Court that he has better rights in the trademark than its registered owner.
5. Please suggest some helpful strategies that could be adopted to file, cancel / remove / oppose or otherwise take action against Shape Trade Mark Applications.

A distinctive STM should be filed as a trademark with the TMO as soon as possible, preferably before it is used in Thailand. The TMO takes a long time to register a trademark. While the TMO is examining the application if use and advertising of the goods or services under the mark in Thailand are possible, such use and advertising should be launched as soon as possible.

If the TMO rejects the application on the grounds that the mark lacks inherent distinctiveness, then an appeal should be filed with the TMB supported by evidence of use and advertising. The TMB takes one to two years to issue a decision on the appeal. While the TMB is reviewing the appeal, a back-up application should be filed for the mark supported with evidence of sufficient use and advertising of the mark in Thailand between the date of the first application up to the date of the back-up application.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

As of January 2015, we were not aware of a case where the owner of a registered STM has enforced his STM against third party uses. We have checked with the IP&IT Court and the Supreme Court and found no such a case.

TURKEY

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Gun + Partners

Istanbul

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?

Yes. In Turkey, the legal text applicable to trademarks is the *Decree Law Pertaining to Protection of Trademarks No.556* ("The Decree Law") which is the current legislation applicable to trademark practice in Turkey. The "shape of goods or of their packaging" are explicitly set forth under article 5 of the Decree Law which gives the general description of a trademark, "*signs capable of being represented graphically therefore registrable as trademarks provided that they possess distinctiveness.*"

Therefore, in theory, it is possible to register shapes as trademarks. However, when it comes to practice, the Turkish Patent Institute ("TPI") usually applies very strict standards and examines distinctiveness of shape marks with respect to general provisions of distinctiveness and descriptiveness. In practice, a vast majority of the applications for shape marks are rejected at the administrative stage unless the shape has an acquired distinctiveness. Taking the examples of the "Coca-Cola bottle" and the "Hersey Kisses" products shapes, as these shapes are quite well-known and they have already gained a secondary meaning, they would be easily registered as trademarks.

However, they would have difficulties for the product shapes which do not have such reputation. In such cases, it may be advisable to register the shape first as an industrial design before the TPI instead of as a trademark. Under Turkish Industrial Design Law system, a registered industrial design aims to protect the visual aspects of the registered product only and such registration ends upon fulfillment of a 25 year period. During the term of protection of the industrial design, if the shape would gain a secondary meaning, then it may be possible to apply for trademark registration.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The three-dimensional Shape Trade Marks do have the same standard as "regular trademarks. The only documents that are supposed to be submitted during the filing of an application are: (i) the sample of the mark; (ii) goods and services list;

(iii) the PoA; and (iv) the bank receipt showing the payment for the trademark application.

b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

There is no requirement to submit evidence or any other supporting documents when filing an application either as a trademark or an industrial design. Nevertheless, if the TPI rejects the shape trademark application based on the absolute grounds for refusal, *i.e.* lack of distinctive character *etc.*, then the applicant may need to submit evidence during the appeal stage against the TPI's decision to prove the use of the shape as a trademark and its acquired distinctive character.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.
The below shown shapes are duly registered by the TPI as a trademark.

	
Trademark No. 2002 20949	Trademark No. 2010 38554
	
Trademark No. 2007 42081	Trademark No. 2007 57218
	
Trademark No. 2002 32847	Trademark No.
	
Trademark No. 2007 36254	Trademark No. 2002 20947
	
Trademark No. 2008 49887	Trademark No. 2007 07801

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

As per the Article 5 of the Decree Law: “A trademark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, may consist of all kinds of signs being represented graphically such as words, including personal names, designs, letters, numerals, shape of the goods or their packaging and similarly descriptive means capable of being published and reproduced by printing.” Thus, the shapes can be protected as a trademark according to the Turkish Trademark Law providing that it has the distinctive character to be considered as one.

As mentioned above, in practice the TPI’s application is quite rigid and a vast majority of the applications for shape marks are rejected at the administrative stage where the specialized IP Courts’ can be said to make a broader and more profound examination on registrability of shape marks. Indeed both Nutella Jar and Nescafe RED MUG trademark applications were rejected by the TPI but they have been successfully registered following the Court proceedings. The well-known Nutella jar has been found to be inherently distinctive as it was “different from the ordinary shapes in the market” and “did not make a direct reference to the goods covered (mainly chocolate and confectionary)”. The famous Nescafe RED MUG was found to be inherently distinctive as it had an original design with an original color combination of a red background and a golden line.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

In Turkey, opposition proceedings are administrative proceedings before the TPI. The proceeding is a simple one and there are no different stages for filing evidence or for replying the opponent’s/ applicant’s petitions. All evidence must be filed together with the opposition. It is possible to file supplementary evidence when the opposition is pending but there is a risk that the supplementary documents may not reach to Examiner before he makes a decision. Also the TPI usually informs the applicant if an opposition is filed against the trademark application and asks the applicant for filing responses but this is not a standard procedure. If the opposition is rejected, there is an appeal stage before the Higher Board of the TPI, which is called Re-Examination and Re-Evaluation Board (“REEB”). The decision of REEB is final within the administrative stage and can only be challenged by filing a cancellation action before the specialized IP Courts in Ankara.

For invalidation / cancellation of shape marks, the action should be taken before the specialized IP Courts, if there is one depending on the forum of the dispute. Currently there are specialized IP Courts in Istanbul, Ankara and Izmir. The forum of the proceeding is determined with respect to the location of the registrant. So a cancellation/invalidation action against a registered trademark can be filed before the competent Courts – i.e. the IP Court in the residency address of

the registrant (if there is one) or if there is no specialized IP Court, the Civil Court in the same place.

The general course of the court proceedings is as follows: The plaint petition is notified to the defendant together with in order to have defendant's reply petition and the first hearing on the merits of the case is determined upon compilation of exchange of petitions during the stage called "initial examination". The Court may also set a procedural hearing during the exchange of petition phrase, if it requires, to complement/correct the incomplete information/requirements or to examine procedural objections etc. The time period for filing pre-hearing petitions (response and rejoinder petitions) is 2 weeks, starting from the date of service of the relevant document. After hearing the parties' cases, the Court may ex-officio or upon parties' request, appoints an expert and delivers the file to the expert. If the reasoning is explicitly provided, the Court may appoint more than one expert namely an expert panel. The expert(s) are required by the Court to provide opinion merely on the technical points within their specialist area and not the merits of the case. If the court is not satisfied with the expert(s) report or upon parties' objections/requests, it may request an additional report from the same expert(s) or from different expert(s). Consequently, based on parties' submissions, evidence and the expert review on the file, the Court delivers its judgment at the last hearing and within a couple of months timeframe, the reasoned decision is drafted.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

In Turkey, while the TPI's approach with respect to shape marks is rigid; the practice shows that a shape mark sufficiently differentiated from the other signs/shapes available in the relevant market, found not to be arising from the nature of the goods themselves or from a technical requirement, already registered in the country of origin which has been in actual use in Turkey shall be registrable, at least via court proceedings.

Accordingly before filing a trademark application for a shape mark, all evidence showing that the shape has gained a secondary meaning should be well-prepared and should be ready to use in case of a possible refusal.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Ground Trademark(s)	Challenged Products/Trademark/Designs	Result
		These designs have been cancelled.

 <p>FERRERO</p> <p>FERRERO</p>		
 <p>FERRERO</p>		<p>These designs have been cancelled.</p>
 <p>FERRERO</p>	 <p>Şölen Diamond</p>	<p>The trademark application has been rejected upon opposition.</p>
		<p>The trademark application has been refused upon opposition and the applicant's action has been rejected. The decision is finalized and the application is lapsed.</p>
		<p>The trademark application has been rejected upon opposition.</p>
 <p>Raffaello</p>		<p>The Court has decided for the determination and prevention of trademark infringement.</p>

UNITED ARAB EMIRATES

Contributor: Stephen Jiew

Al Tamimi & Company
Dubai
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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country?

Yes. The shape of the Coke bottle or the shape of the Hershey's Kiss may be protected as a trade mark in the UAE by filing a trade mark application for registration of a three-dimensional Shape Trade Mark. Trade mark rights may possibly be in perpetuity as the initial term of registration may be renewed indefinitely.

The shape of the Coke bottle or the shape of the Hershey's Kiss may also be protected as an industrial design in the UAE. An 'industrial design' is the ornamental or aesthetic aspect of an article. A design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. To be protected, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical or functional features of the article to which it is applied. The term of an industrial design is limited in time unlike a trade mark, which term is potentially perpetual.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

An Application for registration of a three-dimensional Shape Trade Mark is regarded the same as any other application for registration of a trade mark and there are no special requirements or additional information for its filing.

The standard requirements for the filing of an application for registration of a trade mark, which would also apply to an Application for registration of a three-dimensional Shape Trade Mark, are as follows:-

- Name of Applicant Company;
- Address of Applicant Company;
- List of Goods and Services pursuant to the Nice Classification;
- A Power of Attorney legalized up to the UAE Embassy / Consulate; and
- A soft copy of the trade mark.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?

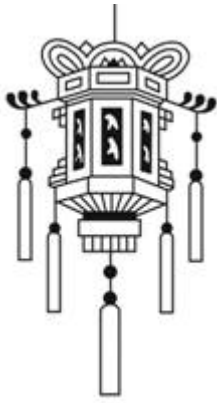
It is not necessary to provide evidence of distinctiveness of Shape Trade Mark, such as evidence-of-use at the outset at the time of filing the application. Distinctiveness of a Shape Trade Mark is judged as per any other kind of trade mark in accordance with generally accepted principles and conventions of trade mark law.

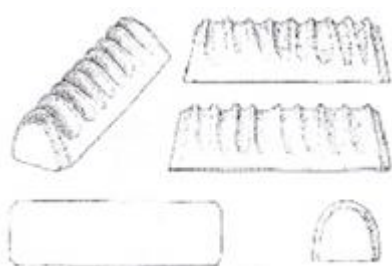
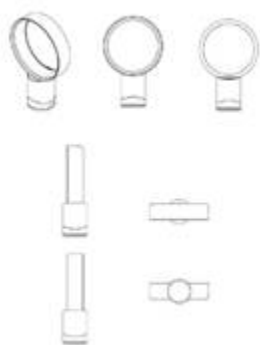
Should the application encounter an official action for being non-distinctive or for being functional, the applicant may attempt to overcome such an official action by submitting evidence that over the course of time, the subject shape has achieved an exclusive association with the applicant in the mind of the consumer through extensive marketing/promotion, such that the subject shape has acquired a secondary meaning in the market and is thus capable of distinguishing the applicant's goods bearing the Shape Trade Mark. Evidence-of-use to such effect should then be produced.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in the UAE include the following:-









3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The relevant law is the UAE Federal Law No. 8 for the year 2002 amending Articles of the Federal Law No. 37 for the year 1992 (*"the UAE Trade Mark Law"*). Articles (2) and (7) of the UAE Trade Mark Law define and deal with Shape Trade Marks as being trade marks, which may be the subject of a trade mark application and registration in the UAE.

ARTICLE (2)

A trademark is anything which takes a distinctive form whether it comprises names, words, signatures, letters, figures, drawings, symbols, titles, tax stamps, seals, pictures, inscriptions, advertisements or packs or any other mark or a combination thereof, used or is intended to be used, either in distinguishing goods, products or services whatever their origin is, or to show that goods or products are owned by the mark owner by virtue of their manufacture, selection or dealing in, or to indicate the performance of a service. Sound is considered a part of the trademark if it accompanies thereto.

ARTICLE (7)

Any person desiring to use a trademark to distinguish goods, products or services, may apply for its registration in accordance with the provisions of this Law.

A trademark application shall be filed at the Ministry under the conditions and terms provided in the Implementing Regulations.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

Opposition

Trademark applications accepted by the Registrar are published in the Trademark Journal as well as in two local daily Arabic newspapers and the cuttings of the notices are to be submitted to the Trademark Office/Registry. Any interested party may file a notice of opposition to the registration of the mark within 30 days

from the date of any publication. The Opposition is filed before the Registry of Trade Marks of the Ministry of Economy.

The Registrar's decision concerning the Opposition may be appealed to the Committee and the Committee's decision to the competent court of the UAE. In the absence of an Opposition, a Trademark is registered and the certificate of registration is issued.

Invalidation/Cancellation

A trademark cancellation lawsuit is a legal action filed through the courts of the UAE, which seeks the cancellation of a trade mark registration that has been duly registered by the Trade Mark Registry of the UAE Ministry of Economy.

Any interested party may apply for the cancellation of a trademark registration, which was unlawfully registered. The Ministry of Economy shall cancel the registration upon receipt of a final judgment thereof.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

The Achilles Heel of any Shape Trade Mark Application is the question of its inherent distinctiveness or lack thereof. This issue is best attacked during Opposition proceedings. Thus, as a matter of strategy, one should be vigilant in conducting a watch of the UAE Trade Mark Gazette to monitor for relevant Shape Trade Mark Applications and launch oppositions within the opposition period.

If such an Opposition period is missed for any reason, then one has a second chance to attack the subject Shape Trade Mark by filing a Cancellation Action.

The basis of such an attack would usually be to argue that the Shape Trade Mark is not sufficiently distinctive for it to be a source-identifier for the applied specification of Goods. A typical argument underpinning such a contention would be that the underlying shape of the subject mark is functional in that its shape is characterized by the function it serves and as such, its shape cannot inherently be considered to be capable of distinguishing the specification of Goods bearing such a Shape Trade Mark from that of another trader's.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Honda, the well-known Japanese automaker, was seeking to enforce a trade mark registration that related to the 3D form of its unique multi-purpose engine before the Dubai court. The Dubai court decided that 3D forms are capable of trade mark registration and that Honda's trade mark registration had been infringed by the offender. The decision demonstrated the Dubai court's increasing willingness to tackle complex Intellectual Property issues, and represents a breakthrough for the owners of non-traditional trade marks in the area.

UNITED STATES

Contributor: Danny M. Awdeh

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Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country? Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No

While it is possible to protect a product's distinctive design/shape and/or packaging in the United States through various means (*i.e.*, a design patent, copyright), trademark law is advantageous because the protection can last indefinitely.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

In addition to the typical registration requirements (*i.e.*, a description of the goods and services, *etc.*), for product design marks, the U.S. Patent and Trademark Office requires: (1) a description of the mark stating clearly and accurately what the mark comprises; and (2) a drawing of the mark, which is used to provide notice of the mark to others and appears on the registration certificate. The drawing must depict a single image of the three-dimensional design, with the applicant indicating that the design is three-dimensional. The drawing must also show the design in black on a white background, unless color is claimed as a feature. If color is claimed, the drawing must show the design in color and the applicant must identify the claimed color(s). Finally, the drawing should use broken or dotted lines to show matter that, while not claimed as part of the mark, is necessary to adequately identify where the claimed design appears in relation to the product taken in its entirety.

- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark? For example: Do you need to provide Evidence-of-Use?


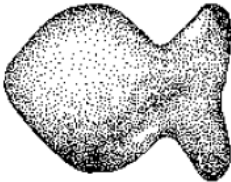

Yes. Under U.S. trademark law, a product's design itself is not inherently protectable. The applicant therefore has the burden of showing that the design has acquired distinctiveness, *i.e.*, that consumers have come to recognize it as a source identifying trademark. This can be accomplished through circumstantial evidence, such as, by submitting examples of advertising and promotional materials that specifically promote the claimed design as a trademark in the U.S.; dollar figures for advertising devoted to such promotion; the commercial success of the product's design; and consumer/other statements recognizing the design as




a trademark. The applicant can also provide direct evidence, such as through a consumer survey. Finally, in some cases an applicant can rely on a claim of five years of use to establish acquired distinctiveness.

If, however, the design consists of the appearance of the product's packaging, then it might be considered inherently distinctive. The distinction between product packaging and product design is not always clear, with the United States Supreme Court noting that a classic Coca-Cola bottle may constitute packaging for those who drink the beverage and discard the bottle, or the product itself for those who are bottle collectors. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 215 (2000). When in doubt, courts tend to classify the shape as a product design and require evidence of acquired distinctiveness.

If the claimed design has not yet acquired distinctiveness, the applicant may seek registration on the Supplemental Register. The Supplemental Register is reserved for marks, such as shapes/product configurations that are *capable* of serving as trademarks, but have not yet acquired distinctiveness. Registration on the Supplemental Register is important because a shape can later become eligible for registration on the Principal Register if and when it acquires distinctiveness. In the meantime, registration on the Supplemental Register offers several benefits, such as granting the owner the right to use the registered ® symbol and serving as nationwide notice of the registered design.

2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Goods/Services	Shape	Owner	Description
Handheld mobile electronic device		Apple Inc.	"The mark consists of the configuration of a rectangular handheld mobile digital electronic device with rounded silver edges, a black face, and an array of 16 square icons with rounded edges. The top 12 icons appear on a black background, and the bottom 4 appear on a silver background. ..."
Crackers		Pepperidge Farm, Inc.	"The mark consists of the configuration of a goldfish. The stippling in the mark is for shading purposes only and is not a feature of the mark ..."
Non-alcoholic beverages, namely, fruit juices and fruit juice drinks		Coca-Cola Co.	"The mark consists of a two dimensional graphic design positioned on the container for the goods."

Goods/Services	Shape	Owner	Description
Retail tire stores		Goodyear Tire & Rubber Co.	"The color(s) yellow is/are claimed as a feature of the mark. The mark consists of a yellow modified elliptical shape forming a silhouette of a non-rigid airship or blimp."
Candy		Jelly Belly Candy Co.	"The mark consists of a three-dimensional mark consisting of a bean shaped clear window on product packaging. The dotted lines show the shape of the packaging which is not claimed as a feature of the mark"
Furniture, namely chairs for use in classroom and childcare settings		Community Products, LLC	"The mark consists of the configuration of a chair with an ergonomic, sculpture-like, curved, one-piece design ..."

- Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The *Federal Lanham Act* is the primary statute for asserting trade dress protection for product design in the federal courts, specifically 15 U.S.C. §§ 1114 and 1125. There is no requirement that the shape be federally registered to bring a claim under 15 U.S.C. § 1125. However, without a registration, a plaintiff asserting trade dress protection has the burden of proving that the mark asserted is distinctive and not functional.

- Please describe the forum and procedure that must be followed in Opposition, Invalidation and Cancellation Proceedings regarding Registered Shape Trade Marks.

The U.S. Patent and Trademark Office has an administrative tribunal for opposing applications and seeking to cancel registered trademarks called the Trademark Trial and Appeal Board ("TTAB"). The TTAB has jurisdiction over opposition and cancellation proceedings.

An opposition must be filed within 30 days after the mark is published, or within an extension of time (of up to 120 days with consent). A cancellation must be filed within five years from the date of registration of the mark or, in limited circumstances, any time after the five-year period if the cancellation petition is based on grounds such as fraud, abandonment, or an assertion that the mark has become generic.

Once initiated, TTAB proceedings are similar in many respects to federal court litigations, but narrower in scope. There is a process for discovery and trial (through written submissions). Unlike federal court litigation, however, the

TTAB may only decide the issue of registration and cannot award monetary damages.

In either an opposition or cancellation proceeding, the plaintiff bears the burden of proof and must establish its case by a preponderance of the evidence. For cases involving product designs, the plaintiff will generally need to show that the challenged design is either functional, and thus not deserving of registration, and/or is likely to cause confusion with plaintiff's mark.

5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

Because acquired distinctiveness is required to register product designs, being aware of the steps needed to establish acquired distinctiveness, and proactively taking those steps *before* filing an application, can reduce the chances of receiving refusals and/or minimize the evidence needed to overcome such refusals, thus simplifying the registration process. It is therefore advisable to be proactive about establishing acquired distinctiveness by, among other things, promoting the claimed design in advertising and teaching consumers to recognize and look for it as signifying the source of the applicant's goods. In this regard, marketing departments should work in tandem with counsel to design and implement effective advertising campaigns early in the product's conception and lifecycle.

In addition to the potential for challenging a product's design on acquired distinctiveness grounds, it may also be vulnerable to challenge on functionality grounds, *i.e.*, that the shape is essential to the product's use or purpose and/or affects the cost or quality of the product. This can be accomplished by demonstrating that a particular design provides a utilitarian advantage; that the design provides a competitive advantage; and/or that the design is the result of a less expensive/more cost effective method of manufacture as compared to alternative designs. Also, evidence that the design is the subject of a utility patent is helpful; designs claimed in utility patents are presumptively functional and thus not protectable under the trademark laws.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

- *Shape of a handheld mobile device.* Jury found that Apple's registered iPhone trade dress was diluted by some Samsung smartphones. Samsung unsuccessfully argued that Apple's trade dress was functional. *Apple Inc. v. Samsung Electronics Co.*, Civ. No. 11-CV-1846 (N.D. Cal. Aug. 24, 2012).

- *A fish-shaped cracker.* Court enjoined distribution of competitor's cracker that was shaped similarly to Pepperidge Farm's mark consisting of an "orange, bite-sized cheddar cheese-flavored, goldfish-shaped cracker." *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 212 (2d Cir. 1999).

- *Shape of guitar body.* No infringement of registered mark in shape of Les Paul single cutaway guitar. Court refused to extend protection of shape to other features of the guitar, such as the placement and style of knobs and switches. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 545 (6th Cir. 2005).
- *Lifesavers circle-shaped candy with hole.* Court granted preliminary injunction against competitor's hard roll candies with a hole given the confusing similarity to plaintiff's candies. *Nabisco Brands, Inc. v. Conusa Corp.*, 722 F. Supp. 1287, 1293 (M.D.N.C.) *aff'd*, 892 F.2d 74 (4th Cir. 1989).

VIETNAM

Contributor: Mr. Nguyen Anh Ngoc

Hanoi

www.investip.vn

Questions:

1. How would you best protect the shape of the Coke bottle or the shape of the Hershey's Kiss in your country?

It is advisable to file trademark applications for registration of the shape of the Coke bottle or the shape of the Hershey's Kiss in Vietnam.

In addition, if the shape of the Coke bottle or the shape of the Hershey's Kiss is "new", the owners may consider filing applications for registration of the shape of the Coke bottle or the shape of the Hershey's Kiss in form of industrial design in Vietnam before filing the trademark applications.

Is it possible to protect "SHAPE TRADE MARKS" in your country? Yes/No
Yes.

- a. What do you need to provide to accompany an Application for registration of a three-dimensional Shape Trade Mark?

The IP Law of Vietnam does not have separate regulation on the required documents to accompany an Application for registration of a three-dimensional Shape Trade Mark. For all kinds of mark, the required documents are regulated in Articles 100 and 105 of the IP Law:

"Article 100. General requirements for industrial property registration applications

- 1. An industrial property registration application consists of the following documents:*
 - a) A request, made in prescribed form;*
 - b) Documents, samples, information identifying the industrial property object claimed for protection as provided for in Articles 102 through 106 of this Law;*
 - c) Powers of attorney, if the application is filed through a representative;*
 - d) Documents evidencing the right to registration, if acquired by the applicant from another person;*
 - dd) Documents evidencing the priority right, if claimed;*
 - e) Receipt of prescribed fees and charges.*
- 2. Industrial property registration applications and communication documents between the applicants and the State administrative authority of industrial property rights shall be made in Vietnamese, except for the followings, which*

can be made in another language but shall be translated into Vietnamese at the request of the State administrative authority of industrial property rights:

- a) Powers of attorney;*
 - b) Documents evidencing the right to registration;*
 - c) Documents evidencing the priority right;*
 - d) Other documents supporting to the applications.*
- 3. Documents evidencing the priority rights of an industrial property registration application shall include:*
- a) A copy of the first application(s) certified by the receiving office; and*
 - b) Deed of Assignment of priority rights if acquired from another person”.*

“Article 105. Requirements of mark registration applications

- 1. Documents, samples, information identifying the mark claimed for protection in a mark registration application shall include:*
 - a) Samples of the mark and list of goods or services bearing the mark;*
 - b) Rules on using collective mark or Rules on using certification mark.*
- 2. The sample of mark shall 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, they shall be transliterated; where the mark consists of words or phrases in foreign languages, they shall be translated into Vietnamese.*
- 3. Goods or services listed in a mark registration application shall be classified in accordance with the Classification List under the Nice Agreement on International Classification of Goods and Services, published by the State administrative authority of industrial property rights.*
- 4. The rule on using collective mark shall consist of the following essential contents:*
 - a) Designation, address, grounds of establishment and operations of the collective organization that is the owner of the mark;*
 - b) Conditions to become a member of the collective organization;*
 - c) List of organizations and individuals permitted to use the mark.*
 - d) Conditions for using the mark;*
 - dd) Remedies applicable to acts violating the rules on using the collective mark;*
- 5. The rules on using certification mark shall have the following essential contents:*
 - a) The organization or individual who is the mark owner;*
 - b) Conditions for using the mark;*
 - c) Characteristics of goods and services certified by the mark;*
 - d) Methods of evaluation of the characteristics of goods and services and methods of supervision of the use of the mark;*
 - dd) Expenses payable by the mark user for the certification and protection of the mark, if any”.*

Regarding the “sample of mark” or “mark specimen”, as the above-mentioned, the IP Law of Vietnam does not have separate regulation on the requirements for mark specimens of a three-dimensional Shape Trade Mark. The requirements are only regulated in Point 37.5.b of the Circular No. 01/2007/TT-BKHCN:

“37.5. Requirements for mark specimens

In addition to the mark specimen attached to the written declaration, the application must be enclosed with 9 identical mark specimens that satisfy the following requirements:

- a. A mark specimen must be clearly presented with the dimensions of each element of the mark ranging between 8 mm and 80 mm, and the entire mark must be presented within a mark model of 80 mm x 80 mm in size in the written declaration;*
- b. For a mark being a three-dimensional figure, the mark specimen must be accompanied with a photo or drawing showing the three-dimensional disposition and may be accompanied with a descriptive specimen in the projection form;*
- c. For a mark involving a claim for protection of colors, the mark specimen must be presented with the very colors sought to be protected. If the protection of colors is not claimed, the mark specimen must be in black and white”.*





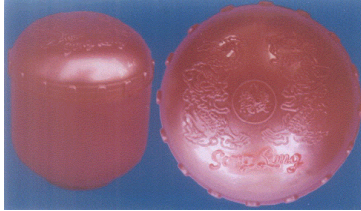
- b. Is it necessary to provide evidence of distinctiveness of Shape Trade Mark?
For example: Do you need to provide Evidence-of-Use?




In practice, the Shape Trade Marks that do not have special shape and not contain a distinctive element (e.g. the word element “Coca Cola” in the shape of the Coke bottle) are often considered by the National Office of Intellectual Property of Vietnam (NOIP) as “Picture of goods” or “descriptive of the goods or services” and therefore “not be considered as distinctive” (Articles 74.2.b, and 74.2.c of the IP Law of Vietnam: *“A mark shall not be considered as distinctive if it is signs falling under one of the following cases: ... b) Signs, symbols, pictures or common names in any language of goods or services that have been widely and often used and are common knowledge; c) Signs indicating the time, place, method of production, kind, quantity, quality, property, composition, intended purpose, value or other characteristics, which is descriptive of the goods or services, except for signs having acquired distinctiveness through use before the filing of mark registration applications”*. In those above cases, if the Article 74.2.c is cited by NOIP, it is necessary to provide evidence of distinctiveness of Shape Trade Marks.

Otherwise, in other cases where the Shape Trade Marks that have special shape or contain a distinctive element and therefore, are considered by the NOIP as distinctive, it is not necessary to provide evidence of distinctiveness of Shape Trade Marks.

- 2. Please give some examples of actual Shape Trade Marks (two-dimensional or three-dimensional) that have been successfully registered in your country.

Examples:

1	Product packages		Registration No. 110269 for “Balm, oriental medicine ...”
2	A part of product packages		Registration No. 23526 for “Detergent, washing powder...”
3	The front of a shop		Registration No. 98240 for “Buying and selling goods, supermarket ...”
4	Interior decoration of a shop		Registration No. 90325 for Class 43: “Services for providing food and drink”. Note: the bottle devices are disclaimed.
5	Picture of the products bearing the mark		Registration No. 131838 for “Oriental medicine”

6	Picture of the products bearing the mark		Registration No. 166412 for “Wind energy equipment”
7	Picture of the products (or container of the products) bearing the mark		Registration No. 157236 for “Pharmaceutical products, functional foods”
8	Picture of the products (or container of the products) bearing the mark		Registration No. 124951 for products in Classes 01, 05, 17. Note: the pictures of the container are disclaimed.
9	Mark contains picture of the products		Registration No. 166859 for Class 30 “Candy, chocolate”.
10	Picture of the products (or container of the products) bearing the mark		Registration No. 105452 for Class 32

Our comments:

It is possible to register for protection of Shape Trade Marks (two-dimensional or three-dimensional) in Vietnam. However, the problem is that there are different understandings among the Relevant Authorities as well as the Governmental Officers in Vietnam in respect of the scope of the protected trademark rights (please see more

details in the Example 2 of the below Item 6). For example: in the above Example 4, when the trademark under the Registration No. 90325 is the interior decoration of a shop, the question is: the scope of the protected trademark rights is limited to picture of the sample of mark (that means that picture / sample of mark have to be fixed / stuck on the products / packaging of the products) or expanded to the shape of the products / shape of the means of supplying services (in this case, it is type of interior decoration of a shop which is shown on the protected mark)?

In some cases, even the Governmental Officers who share the same opinion that the scope of the protected trademark rights should be expanded to the shape of the products / shape of the means of supplying services but they still have different understandings about the scope. For example: in the above Example 6, the mark under Registration No. 166412 for “Wind energy equipment”, there are different understandings among the Relevant Authorities and the Governmental Officers about the scope of the protected trademark rights, namely, it is: (i) picture of a cylinder object for sticking on the products? (ii) a pillar for assembling wind energy turbine? (iii) a spare part of the machine / equipment? (iv) an antenna? or (v) a stick?

Regarding the above Example 8, the mark under Registration No. 124951, the problem is that, the trademark is pictures of the container but it is clearly stated in the Trademark Registration Certificate that: “the pictures of the container are disclaimed”. In this case, the Relevant Authorities and Governmental Officers were embarrassed when identifying the scope of the protected trademark rights, some of them are of the opinion that the trademark is a combination of all the pictures on that mark (as there is no statement that the mark is three-dimensional in the Registration Certificate No. 124951. However, some other Officers are of the opinion that the mark is three-dimensional and the scope of the protected trademark rights should be expanded to the design / representation of the container.

We share the same opinion with the latter. However, in case a third party using containers that are confusingly similar to the container in the protected trademark, this third party may argue that: it is clearly stated in the Registration Certificate No. 124951 that “the pictures of the container are disclaimed”, that means the picture of the container is not protected but the scope of the protection should be limited to the combination of all the pictures on the protected trademark.

3. Please provide the relevant statute, regulation or case law in your country that defines and deals with Shape Trade Marks.

The IP Law of Vietnam does not have separate regulation to define and/or deal with Shape Trade Marks (two-dimensional or three-dimensional). Therefore, procedure of substantive examination and the criteria for assessing the similarity of Shape Trade Marks (two-dimensional or three-dimensional) are the same to that of other marks that are regulated in Points 39.8, and 39.11 of the Circular No: 01/2007/TT-BKHCN:

“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.

...

39.11. 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”.

4. Please describe the forum and procedure that must be followed in Opposition, Invalidity and Cancellation Proceedings regarding Registered Shape Trade Marks.

As it was advised, the IP Law of Vietnam does not have separate regulation to define and/or deal with Shape Trade Marks (two-dimensional or three-dimensional). Therefore, procedure that must be followed in Opposition, Invalidity and Cancellation Proceedings regarding Registered Shape Trade Marks are the same to that of other marks.

Opposition against Shape Trade Mark Application: As from the date of publication of a trademark application until prior to the date of decision on the grant of a trademark registration, any third party shall have the right to present opinions to the NOIP in relation to the grant or refusal of a trademark registration (Article 112 of the IP Law).

Invalidation Proceedings regarding Registered Shape Trade Marks: According to the Article 95.1 of the IP Law: The validity of a trademark registration shall be terminated in the following cases:

- a) Its owner has not paid the due fees for the renewal as prescribed;
- b) Its owner has declared to relinquish the rights conferred by the trademark registration;
- c) Its owner has no longer existed or no longer engaged in business without a lawful successor;
- d) The mark has not been used by its owner or his licensee without justifiable reasons for a term of 5 consecutive years prior to a request for termination of validity, except the use is commenced or resumed at least 3 months before the request for termination;
- d') The owner of a Mark registration Certificate in respect of a collective mark fails to supervise or ineffectively supervises the implementation of the rules on using collective mark;
- e) The owner of a Mark registration Certificate in respect of a certification mark violates the rules on using certification mark or fails to supervise or ineffectively supervises the implementation of such rules; ...

Cancellation/Invalidation Proceedings regarding Registered Shape Trade Marks: According to the Article 96 of the IP Law: *“Article 96. Invalidation of Protection Titles*

1. A Protection Title shall be entirely invalidated in the following cases:

- a) The applicant for registration neither has right to registration nor has been assigned such right (with regard to inventions, industrial designs, layout-designs and marks);*
- b) The subject matter of industrial property failed to satisfy the protection conditions at the grant date of the Protection Title.*

2. A Protection Title shall be partly invalidated if that part failed to satisfy the protection conditions.

3. Any organizations or individuals shall have the right to request the State administrative authority of industrial property rights to invalidate a Protection Title in cases provided for in paragraphs 1 and 2 of this Article, provided that fees shall be paid.

The time period for making request for invalidation of a Protection Title shall be its whole term of protection. With regard to marks, such time limit shall be 5 years as from the grant date, except for the case where the Protection Title has been granted due to the applicant's dishonesty.

4. Based on the result of the examination of request for invalidation of a Protection Title and interested parties' opinions, the State administrative authority of industrial property rights shall make either a decision or a notice of refusal to entirely or partly invalidate the Protection Title.

5. Provisions in paragraphs 1, 2, 3 and 4 of this Article shall also be applied to the invalidation of international registrations with regard to the marks”.

- 5. Please suggest some helpful strategies that could be adopted to file, cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications.

File Shape Trade Mark Applications: As it has been advised in the above Item 1.b, in practice, the Shape Trade Marks that do not have special shape and not contain a distinctive element are often considered by the NOIP as “Picture of goods” or “descriptive of the goods or services” and therefore “not be considered as distinctive”. In those cases, it is advisable that the owner should add a distinctive element to the mark and file application for registration of the combined mark.

In case the combined mark to be accepted for registration in Vietnam, the shape element which is considered by the NOIP as indistinctive shall be disclaimed. However, in practice, the disclaimed elements may also help to protect the trademark rights of the owner from possible infringement actions (please see more details in the Example 1 of the below Item 6).

In addition, if the shape element is “new”, the owners may consider filing applications for registration of the shape of the products in form of industrial design in Vietnam before filing the trademark applications.

Cancel/remove/oppose or otherwise take action against Shape Trade Mark Applications:

In general, like other marks, you may consider taking action against Shape Trade Mark Applications by arguing that the trademarks do not meet criteria for registration in Vietnam (as regulated in Articles 72, 73, 74 of the IP Law of Vietnam), e.g. it is indistinctive or it is confusingly similar to an earlier cited mark in Vietnam.

In particular, if the Shape Trade Marks that do not have special shape and not contain a distinctive element, you may consider taking action against Shape Trade Mark Applications by arguing that the trademarks are indistinctive.

Furthermore, in case you have evidences for proving that a registered Shape Trade Mark has not been used in Vietnam in recent 5 years, you may consider taking a cancellation action against the mark on non-use ground.

6. Please give some examples of registered Shape Trade Marks that were enforced (successfully or not) against third party uses.

Example 1: Successful case

Case’s title: Infringement of trademark “Hao Hao, MI TOM CHUA CAY, Vifon Acecook and device”

Year:	2011
Subject of IPRs:	Trademark (packaging)
Plaintiff:	ACECOOK Viet Nam Company
Infringer:	DN Company

Plaintiff’s registered trademark	Infringer’s Infringing sign
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(Hereinafter referred to as “Hao Hao, MI TOM CHUA CAY, Vifon Acecook and device”)	(Hereinafter referred to as “Hao Tom, MI TOM CHUA CAY and device”)

Summary:

ACECOOK Viet Nam Company is the owner of the registered trademark “Hao Hao, MI TOM CHUA CAY, Vifon Acecook and device” under Registration No. 62360 for Class 30: “Instant noodle”. The words “Hao Hao”, “MI TOM CHUA CAY” and the pictures of the bowl, the noodles, the shrimps and vegetables are disclaimed (Notes: (i) In Chinese, “Hao” means “good”; (ii) In Vietnamese, “MI TOM CHUA CAY” means “SOUR AND HOT INSTANT NOODLE”).

On April 19, 2011, the Inspectorate of the Ministry of Science & Technology of Vietnam (MOST) received a request from ACECOOK Viet Nam Company informing that DN Company has been manufacturing instant noodles wearing the packaging which containing the sign “Hao Tom, MI TOM CHUA CAY and device” infringing the registered trademark “Hao Hao, MI TOM CHUA CAY, Vifon Acecook and device” of ACECOOK Viet Nam Company and requesting the Inspectorate to take enforcement action against the possible infringement.

Based upon the documents and evidence along with the request, on May 15, 2011, the Chief Inspectorate of the MOST issued Decision of inspection No. 32/QD-TTra to conduct an inspection of use of the signs “Hao Tom, MI TOM CHUA CAY and device” by DN Company. At DN Company’s premise, the inspection team detected that DN Company has been manufacturing instant noodles wearing the packaging “Hao Tom, MI TOM CHUA CAY and device” as what posed in the request for the enforcement action. Total complete infringing products found in the store are 500 units of packaging.

Key factor:

To determine whether use of the signs “Hao Tom, MI TOM CHUA CAY and device” as the packaging of the instant noodles by DN Company has constituted an infringement of the registered trademark “Hao Hao, MI TOM CHUA CAY, Vifon Acecook and device” owned by ACECOOK Viet Nam Company or not?

Conclusion and decision on settlement:

Considering that the signs “Hao Tom, MI TOM CHUA CAY and device” are being used as the packaging of the instant noodles by DN Company, the Inspectorate of the MOST is of the opinion that:

The signs “Hao Tom, MI TOM CHUA CAY and device” being used as the packaging of the instant noodles of DN Company containing elements that are confusingly similar to the registered trademark are both composed of word and device elements, of which, the words “Hao Tom”, “MI TOM CHUA CAY” are similar to the words “Hao Hao”, “MI TOM CHUA CAY” in terms of content, presentation and layout; the device elements are also similar in term of color and layout. Despite some minor differences, such differences are not significant and are not enough to create sufficient distinctiveness of the trademarks in question. Both trademarks are used for the same products, namely, instant noodles (identical goods). Therefore, the signs are confusingly similar to the registered trademark.

The DN Company’s acts of use of the sign “Hao Tom, MI TOM CHUA CAY and device” without permission by ACECOOK Vietnam Company, has constituted a trademark infringement and must be settled in accordance with the Decree 97/2010/ND-CP dated September 21, 2010 of the Government on administrative sanction of infringement in respect of industry property

On June 06, 2011, the Chief Inspectorate of the MOST issued Decision No. 36/QD-TTra sanctioning against DN Company with below remedies:

- Monetary fine of VND 4,800,000 for the acts of infringement.
- DN Company was forced to remove the signs “Hao Tom, MI TOM CHUA CAY and device” from the products under the witness of the authorities.

On July 01, 2011, under the witness and supervision of the Inspectorate, DN Company totally removed infringing signs from the products and made a written commitment to cease the infringements.

Our comments:

In cases where a trademark combine both the word and device elements, the word elements are very important as they are pronounceable and are easy to remember, especially if the word itself has a meaning. However, in cases where the word elements are considered by the NOIP to be descriptive of the goods and therefore, non-distinctive, it is very good idea to register for protection of Shape Trade Marks (two-dimensional or three-dimensional) of the packaging of the products, since the registration will assist in more effectively protecting the trademark rights of the owner against any possible infringement.

Example 2: Unsuccessful case

Case's title: Possible infringement of the trademark "Shaving apparatus device"

Year: 2010
Subject of IPRs: Trademark (Three-dimensional mark)
Plaintiff: Koninklijke Philips N.V.
Number of the file: NH 141.2010.YC

Plaintiff's registered trademark	Possible infringing sign
	
(Hereinafter referred to as "Shaving apparatus device")	(Hereinafter referred to as "Possible infringing sign")

Summary:

Koninklijke Philips N.V. is the owner of the registered trademark "Shaving apparatus device" under the International Registration (IR) No. 430839 dated June 14, 1977 for Class 08: "Shaving apparatus; clippers; parts and accessories of the aforesaid articles, not included in other classes".

In 2010, the Vietnam Intellectual Property Research Institute (VIPRI) received a request from Koninklijke Philips N.V. to make an assessment of whether or not use of "Possible infringing sign" is an infringement of the registered trademark under the IR No. 430839.

Key factor:

To determine whether or not use of the sign "Possible infringing sign" as the shape of the shaving apparatus by a third party has constituted an infringement of the registered trademark "Shaving apparatus device" under the IR No. 430839 of Koninklijke Philips N.V..

Conclusion:

Considering that the "Possible infringing sign" is being used as the shape of the shaving apparatus by a third party, the VIPRI is of the opinion that:

- The registered trademark is a picture of the front of a shaving apparatus, the upper part is the shaving surface, the lower part is the handle. There are 3 circular cutting units on the shaving surface that are equidistant from one other. The above

representation / design of the 3 cutting units could attract the attention of consumers (and in practice, the above representation / design of the 3 cutting units has been the particular characteristic of Koninklijke Philips N.V.'s shaving apparatus products for many years).

- The above representation / design of the 3 cutting units make the shaving apparatus products operate efficiently, namely, the circular shape enable the 3 cutting units to rotate and the equidistance of the 3 cutting units help the product have balanced and stable operation; therefore, the VIPRI is of the opinion that, the above representation / design of the 3 cutting units is the indispensable technical characteristics of these kinds of shaving apparatus products. In other words, the above representation / design is the functional characteristic of the products and in practice, this product has been protected under a patent, which is granted by EC (the patent was expired).

Taking the above into consideration, the VIPRI is of the opinion that: (i) The scope of the protected trademark rights has been restricted and limited to the representation / design of the concentric circles of the cutting units and to the representation / design of the equilateral triangle-shaped edge with circular angles of the shaving surface of the products; and (ii) the scope of the protected trademark rights is not inclusive of the equidistance of the 3 cutting units, which is considered to be the technical characteristics of the products. Therefore, the VIPRI is of the opinion that the "Possible infringing sign" is distinguishable from the registered trademark "Shaving apparatus device" under the IR No. 430839 of Koninklijke Philips N.V..

Our comments:

Many Shape Trade Marks (two-dimensional or three-dimensional) are pictures of the products / a part of the products. Therefore, some Shape Trade Marks that were registered for protection in Vietnam contain functional element(s) or are the combination of the functional element(s).

According to Article 74.2.c of the IP Law of Vietnam: A mark shall not be considered as distinctive if it is: *"Signs indicating the time, place, method of production, kind, quantity, quality, property, composition, intended purpose, value or other characteristics, which is descriptive of the goods or services, except for signs having acquired distinctiveness through use before the filing of mark registration applications"*.

Pursuant to the Article 74.2.c, if the functional element(s) / element(s) that are descriptive of the goods or services has *"acquired distinctiveness through use before the filing of mark registration applications"*, the functional element(s) / element(s) that are descriptive of the goods or services may be considered by NOIP to be distinctive and should be protected in Vietnam.

However, in practice, when assessing the similarity between the two (2) trademarks for determination of whether there is a trademark infringement or not, the VIPRI are very reluctant to consider the functional element(s) as distinctive even if the Plaintiff could provide evidence for proving that his trademark has widely been used in Vietnam.