

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

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

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

ASEAN

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

PART 1

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

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INTRODUCTION

Background

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

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

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

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

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

Activities leading up to the Common Guidelines

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

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

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

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

Cambodia: Trademarks Manual, July 2013

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

Laos: Trademarks Manual, September 2003

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

Philippines: Guidelines for Trademark Examination, August 2012

Singapore: Trade Marks Work Manual, 2012

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

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

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

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

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

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

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

Abbreviations used in the Common Guidelines

ASEAN countries (Country Codes)

BN: Brunei Darussalam

ID: Indonesia

KH: Cambodia

LA: Laos

MM: Myanmar

MY: Malaysia

PH: Philippines

SG: Singapore

TH: Thailand

VN: Vietnam

Other abbreviations

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

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

EU: European Union

GI: geographical indication

IPL: Intellectual Property Law

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

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

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

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

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

TMA: Trade Mark(s) Act

TML: Trade Mark(s) Law

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

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

WHO: World Health Organization

WIPO: World Intellectual Property Organization

WTO: World Trade Organization

References

All websites references are current as on 30 September 2014.

ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

1 Signs admissible as ‘trademarks’¹

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

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

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

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

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

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

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

1.1 Visually perceptible signs

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

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

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

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

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

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

1.1.1 Two-dimensional signs

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

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

⁴ TRIPS, Article 15.1, *in fine*.

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

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

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

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

The following examples illustrate this type of sign:

KLAROSEPT

MONT BLANC

AIR INDIA

ΜΙΛΚΥΒΟΝ

αλφάβητο

GML

1886

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

N° 5

H2NO

Giorgio@Play

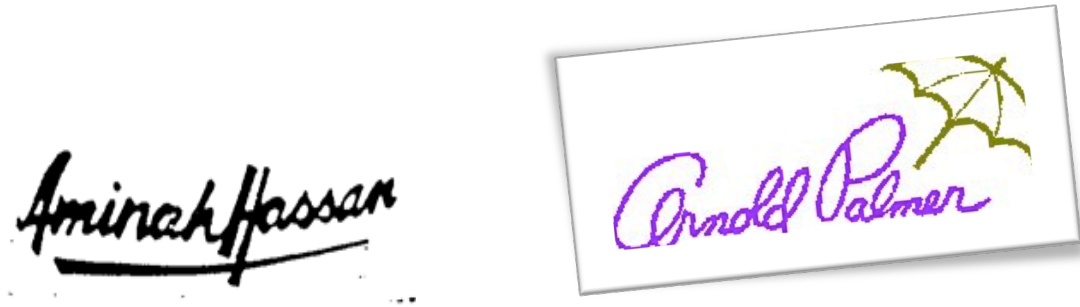
Your *flexible* friend



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

Paul Smith

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



[Examples provided by the Malaysia IP authorities]

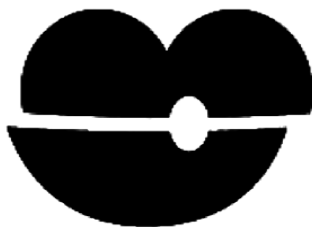
1.1.1.2 *Figurative signs*⁶

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

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

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

Examples:



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



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

1.1.1.3 *Mixed signs*⁷

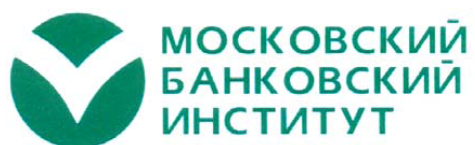
This type of sign will consist of a combination of one or more words, letters, digits, numerals or ideograms with one or more figurative sign or non-word element. The figurative element may be embodied within the word element (for example the figure of a sun in place of the letter “o”), be adjacent to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

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



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

BORA





*Родные
Продукты!*

VietTiger



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

1.1.2 Colours⁸

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

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

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

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



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

⁸ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 18 and 21; ID TML Art. 1.1; LA Decision 753 art. 17.4 and 32, TM Manual p. 4; MY TMA, s.13; MM; PH IP Code, s. 123.1(L), TM Guidelines chapter V item 5.3 p. 28, and chapter XIII p. 136; SG TMA s. 2(1) 'sign' and 'trade mark', TM Manual, chapter 2 'Colour Marks'; TH TMA s. 4 – 'mark'; and VN IPL art. 72.1, Circular 001/2007, s. 39.2.b(i). Also the OHIM Guidelines, Part B, Section 2, item 9.5.

1.1.3 Three-dimensional signs⁹

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

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

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

1.1.3.1 Shapes of devices adjoined to the product

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

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

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

⁹ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 18 and 19; LA Decision 753 art. 17.5, TM Manual, p. 19; MM; PH IP Code, s. 123.1(k), TM Guidelines p. 18, chap. XII; SG TMA s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chap. 3 ‘Shape Marks’; TH TMA s.4 – ‘mark’; and VN IPL art. 72.1 and 74.1. Also the OHIM Guidelines, Part B, Section 2, item 9.3.



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

1.1.3.2 Shapes embodied in the product or in a part thereof

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

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



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

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



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

1.1.3.3 Shapes of containers, wrapping, packaging, etc.

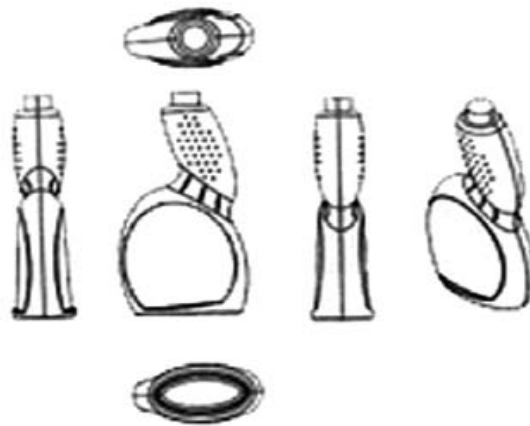
The shape or aspect of the container, wrapping, packaging or other conditioning of a product is a 'visually perceptible' sign and is capable of being 'represented graphically'. To that extent such shape, aspect or external conditioning of goods should, in principle, be admitted for registration as a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

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

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



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



[Examples taken, respectively from trademark applications 1061542 and 1061835 filed under the Madrid Protocol. See http://www.wipo.int/edocs/madgdocs/en/2010/madrid_g_2010_52.pdf]

1.1.4 Movement (animated) signs and holograms¹⁰

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

A movement mark is perceived as a video clip or short film used to distinguish goods or services in the context of, for instance, visual or video communications to the public. They cannot be physically attached to the goods themselves but may be used to distinguish digital products and services on portable devices such as mobile telephones, internet-based services, etc..

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

1.1.5 ‘Position’ marks¹¹

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

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

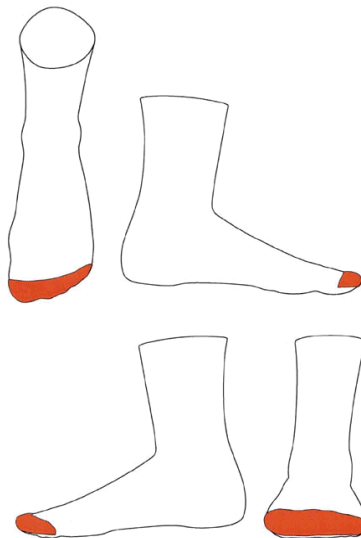
¹⁰ See the provisions in BN TMA, s. 4(1); KH TML art. 2(a); LA IPL art. 16.1; MY TMA s. 10(1)(e); MM; PH IP Code s. 121.1; SG Act s. 2(1) – ‘sign’ and ‘trade mark’, TM Manual chapter 1 “What is a trade mark” p. 13; VN IPL art. 72.1. Also the OHIM Guidelines, Part B, Section 2, item 9.8.1 and Section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

¹¹ See the OHIM Guidelines, Part B, Section 2, item 9.8.2 and Section 4, item 2.2.14.

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

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

A *single colour* applied to a particular part (position) of a product was found to lack distinctiveness in the case of the orange colouring of the toe of a sock (reproduced below). OHIM refused registration of that device as a mark arguing, in particular, that the sign would be perceived by the relevant public as a presentation of the product dictated by aesthetic or functional considerations. The colouring of the toe might indicate the presence of a functional feature, namely a reinforcement. The relevant public was not in the habit of perceiving the colour of the toe of a sock as an indication of commercial origin. Consequently, the device was devoid of distinctive character. The European Court of Justice upheld that decision.¹²



¹² Decision of the European Court of Justice, 15 June 2010, case T-547/08 (“Orange colouring of toe of sock”). See <http://curia.europa.eu/juris/document/document.jsf?text=&docid=79459&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=332038>.

The question of distinctiveness was also raised in the case of Margarete Steiff GmbH vs OHIM (“STEIFF” case). The OHIM refused the registration of a ‘position’ mark consisting of a metal button placed in the center section of the ear of a soft toy animal (e.g. stuffed bear or dog). Such device (the metal button) positioned in the center of the toy’s ear was found not to be distinctive. The device would not be perceived by the relevant public as a sign of commercial origin but merely as part of the aspect of the product or a decorative feature thereof. A button fixed on a soft toy was a usual feature for this type of products and the consumers would not perceive it as a trademark. The European Court of Justice upheld OHIM’s decision.¹³



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

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

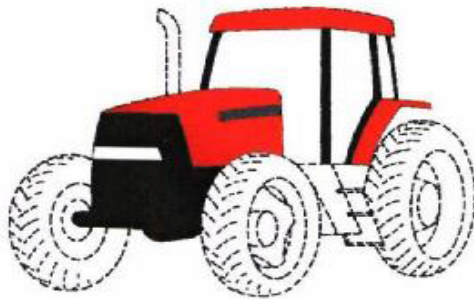
¹³ Decision of the European Court of Justice, 16 January 2014, case T-433/12 (“STEIFF” case). See <http://curia.europa.eu/juris/document/document.jsf?text=&docid=146427&pageIndex=0&doClang=FR&mode=lst&dir=&occ=first&part=1&cid=330342>.



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



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



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

1.2 Non-visually perceptible signs -- Graphic representation

If the law does not confine trademark registration to signs that are 'visually perceptible', any sign that is perceptible by any one of the five basic human senses (sight, hearing, smell, touch and taste) could, in principle, be registered as a mark. However, where non-visually perceptible signs are admitted, their registration will depend on whether the sign can be *represented graphically*. Therefore, the decision to grant or refuse registration of a mark consisting of a sign that is not visually perceptible will pivot on the graphic representation of the sign.¹⁴

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

The graphic representation of a sign applied for registration as a mark should be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*.¹⁵ The means used for the graphic representation should be stable, unambiguous and objective. A representation that may change in time or be subjectively interpreted in different ways would not allow the mark to be objectively defined. This ambiguity would cause legal uncertainty for the trademark owner and for competitors.

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

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

¹⁴ See the provisions in SG TMA s. 2(1) – 'sign' and 'trade mark', TM Manual chap.1 "What is a Trade Mark", p. 10. Also the OHIM Guidelines, Part B, Section 2, items 9.4 and 9.7.

¹⁵ See the OHIM Guidelines, Part B, Section 2, items 9.4 and 9.7, and Section 4, item 2.1.1, second paragraph. In the latter connection the OHIM Guidelines refer to the European Court of Justice judgment of 12/12/2002, C-273/00, 'Sieckmann', paragraphs 46-55, and judgment of 06/05/2003, 'Libertel', C-104/01, paragraphs 28-29).

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

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

1.2.1 Signs perceptible by the sense of hearing

If the sign consists of a melody, jingle, tone, song or other musical sound that can be represented clearly and accurately by musical notation, such notation must be submitted with the application and will suffice to comply with the requirement of graphic representation.¹⁶

If the sign consists of a non-musical sound or noise that cannot clearly and accurately be represented by musical notation, and such signs are admissible for registration under the law, the examiner may require a graphic representation consisting of a sonogram¹⁷, sonograph¹⁸ or oscillogram¹⁹ accompanied by a corresponding electronic *sound file* (sound record) submitted by electronic filing or in a standard electronic format.²⁰

¹⁶ See the provisions in SG TMA s. 2(1), TM Manual chap. 1 “What is a trade mark”, p. 10. Also the OHIM Guidelines, Part B, Section 2, item 9.4.

¹⁷ A ‘sonogram’ is a graph representing a sound, showing the distribution of energy at different frequencies. See <http://www.oxforddictionaries.com/definition/english/sonogram?q=sonogram>

¹⁸ A ‘sonograph’ is a graphic representation of the component frequencies of a sound. See http://www.oxforddictionaries.com/definition/english/sonography?q=sonograph#sonography_6

¹⁹ An ‘oscillogram’ is a record produced by an oscillograph, a device for recording oscillations, especially those of an electric current. See <http://www.oxforddictionaries.com/definition/english/oscillograph?q=oscillograph>

²⁰ For example, see the OHIM Guidelines, Part B, Section 2, item 9.4 and Section 4, item 2.1.2.3.

Other representations of a sound mark would not be regarded as a sufficiently clear graphic representation. For example, a written description of the sound or noise, or an explanation using onomatopoeic words would not be acceptable.²¹

1.2.2 Signs perceptible by the sense of smell

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

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

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

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

There is at present no internationally recognised objective classification for smells, odours or scents that could be applied for the purposes of trademark registration.²²

1.2.3 Signs perceptible by the sense of taste

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

The same objections mentioned under item 1.2.2, above, regarding signs perceptible by the sense of smell will be raised against signs perceptible by the sense of taste.²³

²¹ See the SG TMA s. 2(1), TM Manual chap.1 "What is a trade mark", p. 11. Also the OHIM Guidelines, Part B, Section 2, item 9.4.

²² In this regard see the SG TM Manual chap. 1 "What is a trade mark", p.12; and the OHIM Guidelines, Part B, Section 2, item 9.7 and Section 4, item 2.1.2.1.

²³ See, for example, the OHIM Guidelines, Part B, Section 4, item 2.1.2.2.

1.2.4 Signs perceptible by the sense of touch

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

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

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

2 Distinctiveness

The fundamental requirement for a sign to be registered as a trademark is that it be distinctive in respect of the goods or services for which it will be used in trade. This means that the sign must be *capable of distinguishing* goods and services in the course of trade.²⁴

The distinctiveness of a sign for purposes of its registration as a mark must be established on a case-by-case basis with regard to the particular goods and services for which the mark will be used and for which registration is sought. Also, distinctiveness must be determined taking into account the perception of the sign by the public to whom the mark will be addressed, that is, the relevant sector of the public. This assessment must be done for each trademark application, on a case-by-case basis.²⁵

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

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

2.1 Signs not understood or not perceived as trademarks

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

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

²⁴ See the provisions in BN TMA, s. 6(1)(b); KH TML art. 4(a); ID TML art. 5(b); LA IPL art. 23.1, Decision 753 art. 39; MY TMA s. 10(2A); MM; PH IP Code s. 121.1; SG Act s. 7(1)(b); TH TMA s. 6(1); VN IPL art. 72.2. Also the OHIM Guidelines, Part B, Section 4, item 2.2.

²⁵ See the OHIM Guidelines, Part B, Section 4, item 2.2.1.

seen as part of the normal appearance of the product itself or of the product's design.

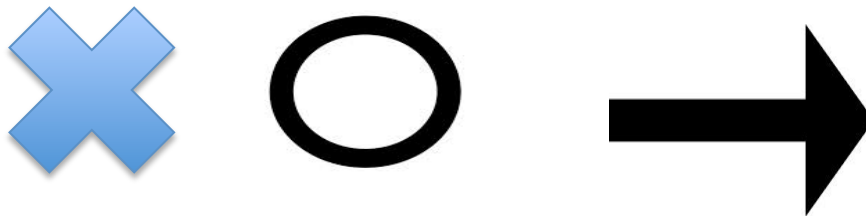
The following categories of signs could be regarded as *prima facie* incapable of being recognised by consumers as marks that indicate a commercial origin:

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

2.1.1 Simple figures

A sign consisting of a simple geometrical shape devoid of any feature that will give it a special appearance, or attract the attention of consumers when the sign is used in trade, will generally not be distinctive and cannot function as a trademark.²⁶

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



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

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

2.1.2 Complex or unintelligible signs

Signs that are composed of elements that are unintelligible or unduly complex will likewise not be perceived as trademarks by the average consumer if used in trade, or are difficult for consumers to recognize or to remember. Such signs lack the ability to distinguish goods and services in trade and therefore cannot be registered as marks.²⁷

For example:²⁸



Application No.: 4-2009-24600:



International Application No.: 1101043

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

²⁷ See the provisions in LA TM Manual p. 26; VN Circular 01/2007 s. 39.4.b.

²⁸ Examples provided by the Vietnam IP authorities.

alphabets or characters such as Arabic, Cyrillic, Sanskrit, Chinese, Japanese, Korean or others.

For example:

维尔迪

ほんだし



[Examples provided by the Vietnam IP authorities]

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

2.1.3 Colours²⁹

2.1.3.1 Single colour

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

²⁹ See the provisions in BN TMA s. 6(1)(b); KH TM Manual p. 21; ID TML art. 1.1, TM Guidelines chapter II.A.1; LA TM Manual p. 26; MY TM Manual chapter 4 paragraph 4.8; PH IP Code, s. 123.1(L), TM Guidelines chapter XIII; SG TMA s. 2(1) – ‘mark’ and ‘trade mark’, TM Manual, ‘Colour marks’ p. 4 and 6; TH TMA s. 4 – ‘mark’; and VN Circular 01/2007 s. 39.2.b(i). Also the OHIM Guidelines, Part B, Section 4, items 2.1.2.5 and 2.2.4.

definition of the scope of the registration. To that extent the sign would not be capable of distinguishing goods or services in trade.

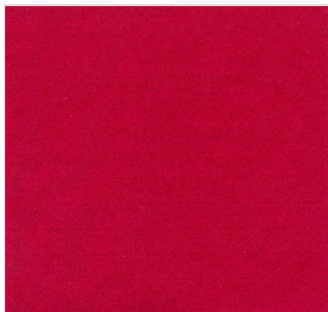
Moreover, claiming a single colour in the abstract could unduly restrict the freedom of other traders to use colours to offer goods or services of the same type as those in respect of which registration is sought. This would interfere with legitimate trade and hence be contrary to public policy.

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

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

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

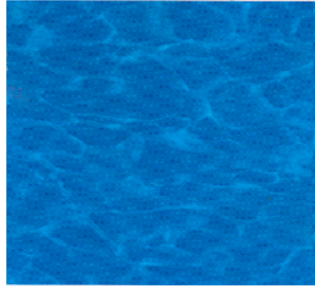
For example, the following sign consisting of the colour red *per se* was refused registration in Vietnam, as it was found incapable of functioning as a mark:



International Application No. 801739

[Example provided by the Vietnam IP authorities]

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



01015661 – SOCIÉTÉ DES PRODUITS NESTLÉ S. A.

[Example provided by the Malaysia IP authorities]

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

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

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

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

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

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

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

2.1.3.2 *Abstract combinations of colours*

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

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

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

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

2.1.4 Single letters and digits

A single letter or a single digit may comply with the requirement of distinctiveness to be registered as a mark.³⁰

³⁰ See the provisions in BN TMA s. 4(1); KH TM Manual p. 28; ID TML Art. 1.1; LA Decision 753 art. 17.2, TM Manual p. 4 and 26; MY TMA s. 3(1); MM; PH IP Code, s.

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

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

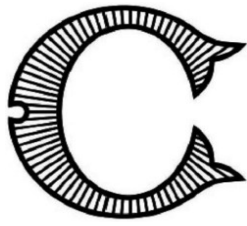


[Image taken from <https://www.etsy.com/listing/177338132/mosaic-number-house-number-number-6?ref=market>]



[Logos of Google and Amazon, respectively]

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



[Examples provided by the Philippines IP authorities]



06007262 - RADIANCE HOSPITALITY GROUP PTE. LTD.



08025300 - REPSOL S.A.

[Examples provided by the Malaysia IP authorities]



Application No.: 4-2011-19180



Application No.: 4-2011-21087



Application No.: 4-200511949

[Examples provided by the Vietnam IP authorities]

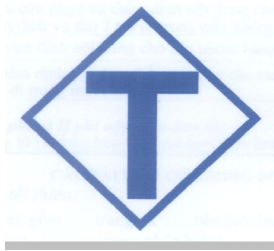
In case of a single letter or digit presented in *standard characters*, i.e. devoid of any particular shape, style or colour or combination of colours, the examination should be more careful. Such signs carry a heavy presumption of lack of distinctiveness. Registration could be accorded if the sign is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

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



[Example provided by the Philippines IP authorities]

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



Application No.: 4-2009-06807



Application No.: 4-2009-27613



Application No. 4-2010-17584

[Examples provided by the Vietnam IP authorities]

2.1.5 Three-dimensional shapes

Three-dimensional shapes are signs that can be registered as marks if they are distinctive. This will not apply where the law precludes the registration of three-dimensional marks.³¹

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

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

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

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

³¹ See the provisions in BN TMA, s. 4(1) and 6(2); KH TM Manual p.18; LA Decision 753 art. 17.5, TM Manual p. 4; MM; PH IP Code, s. 121.1, TM Guidelines chapter XII; SG Act s. 2(1) and 7, TM Manual chapter 3 "Shape Marks", p. 7; TH TMA s. 4 – 'mark'; and VN IPL, art. 74.2.b. Also the OHIM Guidelines, Part B, Section 4, items 2.2.12 and 2.5.

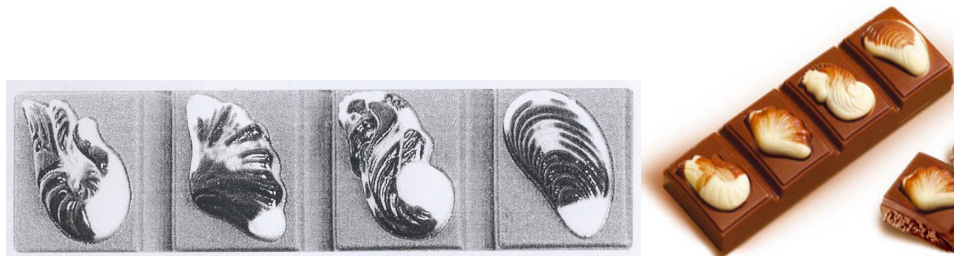


For fruits, preserves - Application No. 4-2009-17819

[Example provided by the Vietnam IP authorities]

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

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



TM application N° 05015047 - 'SEASHELL CHOCOLATE BAR

[Example provided by the Malaysia IP authorities]

The examination of this type of signs should proceed from the basis that the shape of a product or of the product's packaging or container will not normally be perceived by the public as a sign that conveys information about the product's

commercial origin. Rather, the shape of a product will usually be perceived as the design of the product, or as a decorative or aesthetic presentation used in order to make the goods more attractive to potential consumers. On this ground the examiner should raise an objection for lack of distinctiveness. The burden of proof that the shape of a product is perceived as a mark and not just as a product design lies with the applicant.

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

Unlike industrial designs, rights in registered trademarks, including three-dimensional marks, may remain in force indefinitely (if renewed at regular intervals). It is therefore a matter of public policy that exclusive private rights in the shape of a product be protected through the industrial design system, and only benefit from trademark protection when the shape of the product is clearly distinctive as an indicator of commercial origin.

In connection with the required distinctiveness, three-dimensional marks should be refused registration on the following particular grounds, which *cannot be overcome* by acquired distinctiveness as these grounds are based on the underlying policy considerations mentioned above:³²

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

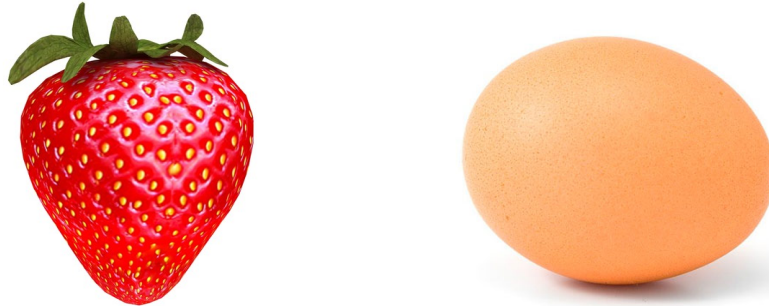
2.1.5.1 *Shape is usual, common or derives from the nature of the product*

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

³² See the provisions in BN TMA, s. 6(2); KH TM Manual p. 19; LA Decision 753 art. 17.5, TM Manual p. 4; PH IP Code, s. 123.1(k), TM Guidelines chapter XII p. 122, 133, 134; SG TMA s. 7(3), TM Manual, chapter 3 'Shape marks' p. 7 and 9; TH TMA s. 4 'mark'; and VN IPL, art. 74.2.a and b. Also the OHIM Guidelines, Part B, Section 4, item 2.5.

a mark if it consists of the usual shape for the product or of the packaging or container of that product, or if it is a shape that is common in the industry to which the product relates.

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



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

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



For sports shoes Application No. 4-2005-13334

[Example provided by the Vietnam IP authorities]

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

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



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

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



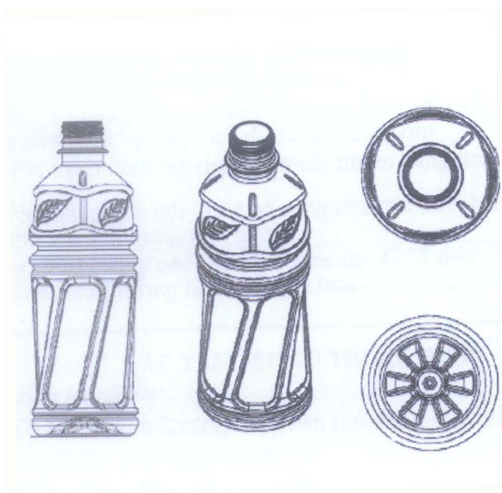
Application N° 03002023 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

[Example provided by the Malaysia IP authorities]

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



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



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

[Examples provided by the Vietnam IP authorities]

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



Application 4-2012-18308

[Example provided by the Vietnam IP authorities]

The *wrapping* and product *shape* in the following example were found to be commonplace for chocolate products and devoid of the required distinctiveness:³³



In the case illustrated above the shapes derived directly from the products themselves or were undistinguishable from the natural or usual shapes of the

³³ Judgement of the European Court of Justice, 24 May 2012, case C-98/11 P 'Shape of a bunny made of chocolate with a red ribbon', taken from <http://curia.europa.eu/juris/document/document.jsf?jsessionid=9ea7d0f130de8db454cc04a44f3dabf88c90f1347635.e34KaxiLc3eQc40LaxqMbN4OaNuOe0?text=&docid=123102&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=540089> .

relevant products. Such shapes must be left free from private appropriation because all competitors operating in the market in trade relating to those products need to be able to use the same or similar shapes freely in connection with their products, unencumbered by claims from any individual competitor. Granting exclusive trademark rights on shapes that are common or necessary in trade would unfairly limit competition in respect of the goods in question, with undesired consequences for the economy and the public.

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

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

2.1.5.2 Shape with a functional nature or a technical effect

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

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

The patent system will require specific conditions for the protection of technical solutions and will bar the grant of exclusive rights for technology that does not meet those conditions. Moreover, where exclusive rights are granted under a patent, their duration will normally not exceed the standard term of 20 years, after which the technology disclosed in the patent falls into the public domain. If technically determined shapes of products were granted exclusive rights through the trademark system, technical solutions (inventions and utility models) could

remain under private control indefinitely by renewing the trademark registration. Such permanent appropriation of functional shapes would run contrary to public policy that aims at facilitating the dissemination and access to new technology by bringing technical solutions into the public domain as soon as possible.

The examiner should raise this objection if the main features of the shape are functional, even if the shape includes other features that do not have a functional or technical nature. A shape should be regarded as functional -- and therefore objectionable -- in any case where the essential elements of the shape have a technical, economic, commercial or practical effect in relation to the product.

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

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

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

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

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



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

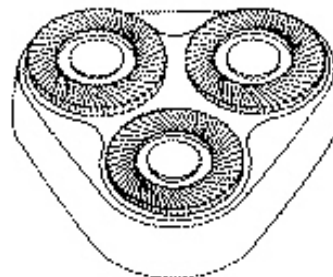
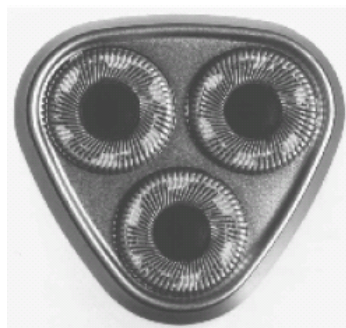


for “lights for medical purposes, namely operating lights”

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

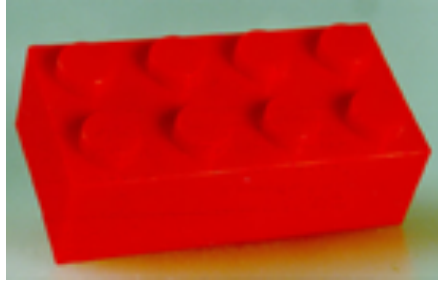
If a shape is functional because it provides a technical effect or functional advantage (including at the stages of manufacture, assembly, transportation or use of the product for its intended purpose) the objection cannot be overcome even if other shapes are available that would afford equivalent functionality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

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



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

Another example of a functional shape that was excluded from registration as a mark on grounds of functionality is the LEGO toy building brick.³⁴

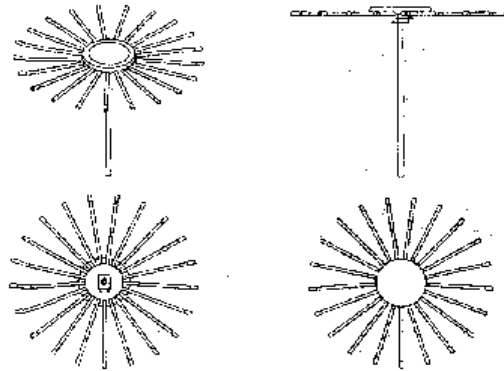


In Vietnam the following three-dimensional shapes were found to be functional or to provide a technical effect, and were refused registration as a trademarks for the goods indicated:



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

³⁴ See the decision of the European Court of Justice, case C-48/09, ‘Red Lego Brick’, of 14 September 2010. Also, the OHIM Guidelines, Part B, Section 4, item 2.5.3.



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

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

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

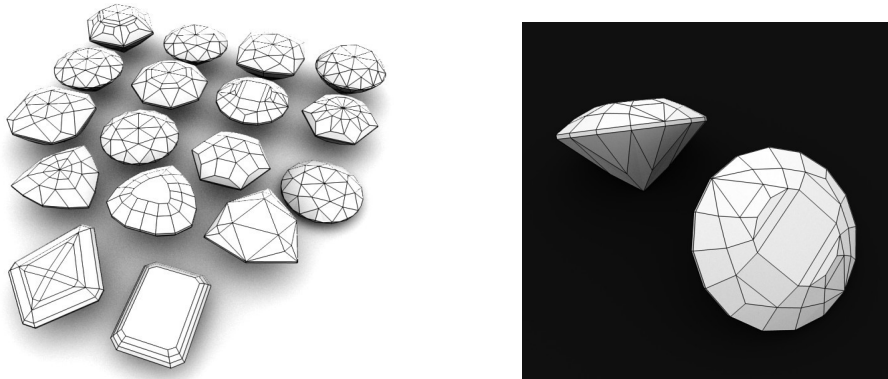


[Images taken, respectively, from <http://www.cdxetextbook.com/steersusp/wheelsTires/construct/treaddesign.html> and from <http://thumbs.dreamstime.com/x/running-shoe-yellow-black-tread-pattern-11961527.jpg>]

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

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

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



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

2.1.6 Patterns and surface designs

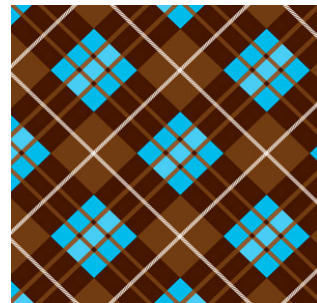
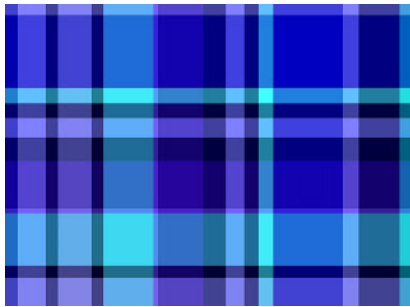
Patterns are often applied to the surface of certain products or used in flat products such as textile materials and fabrics (plaids), clothes, wallpaper, tiles, tableware, leather goods and other similar products.³⁵ Such patterns will normally not be

³⁵ See the OHIM Guidelines, Part B, Section 4, item 2.2.13.

perceived by the public as trademarks indicating commercial origin, but merely as decorative designs that make the product more attractive.

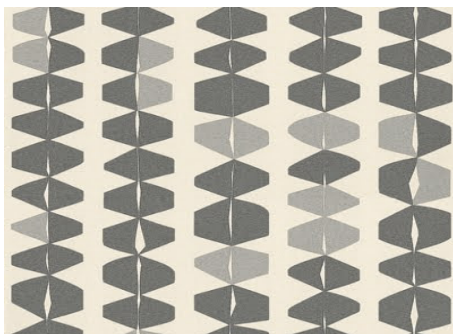
A pattern on a product's surface will normally function as a product design and be seen by consumers as part of the product itself. It will not be perceived as a sign distinct and separate from the product added to indicate commercial origin. Such patterns do not function as marks and the examiner should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

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



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

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



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

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

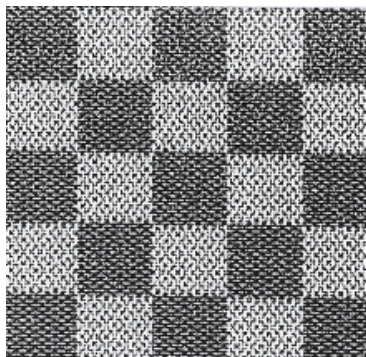


For “building materials, not of metal” - Application No. 4-2009-23542

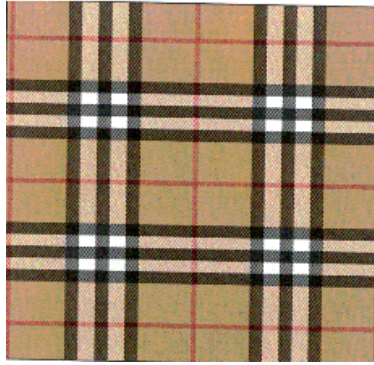
[Example provided by the Vietnam IP authorities]

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

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



07015465 -- Louis Vuitton Malletier



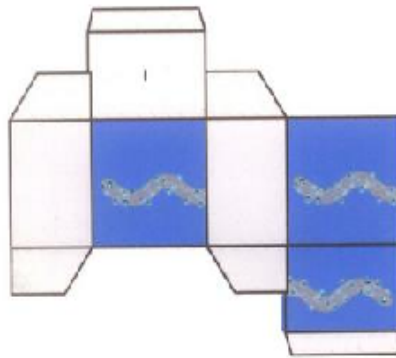
00004038 - BURBERRY Ltd.

[Examples provided by the Malaysia IP authorities]

2.1.7 Common labels and frames

Certain labels and frames are commonplace or usual in trade in general, or in respect of a particular industry, and therefore cannot be recognized by the public as specific marks indicating commercial origin.³⁶

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



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

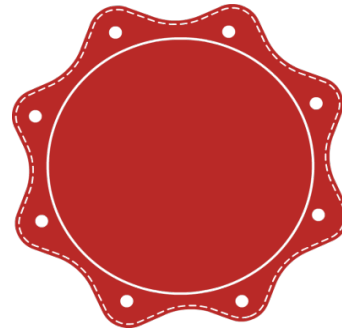
³⁶ See the OHIM Guidelines, Part B, Section 4, item 2.2.11.



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

[Examples provided by the Vietnam IP authorities]

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



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

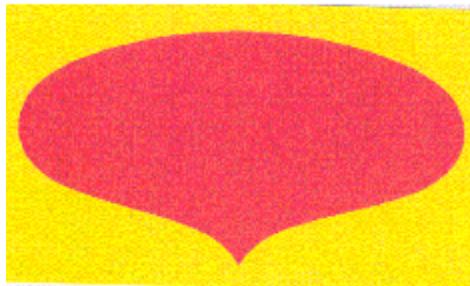
In the examples above, if a distinctive sign (word or figurative) were inserted or juxtaposed on the basic label or frame, the resulting composite sign could become distinctive and be registered as a whole.

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

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



02006414 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.



03003257 - SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

[Examples provided by the IP authorities of Malaysia]

2.1.8 Simple advertising phrases

Simple advertising or promotional phrases and slogans that contain a standard sales message or information about a product, service or trader will not be perceived as signs that indicate commercial origin. Such phrases and slogans are not distinctive and cannot function as marks. The examiner should raise an objection on these grounds.³⁷

A phrase or slogan can be regarded as sufficiently distinctive if it is unusual or striking by reason of its meaning, choice of words or structure, for instance in the following cases:³⁸

³⁷ See the provisions in BN TMA s. 6(1); KH TM Manual p. 28; ID TML, art. 5.b; LA TM Manual p. 26; MY TMA, s. 10(1)(d) and (e); MM; PH IP Guidelines chapter IX, p.72; SG TM Manual chapter 14 'Slogans'; TH TMA s. 4 'mark' and 6(1); and VN IPL, art. 74.2.c, Circular 01/2007 s. 39.3.f and g.

³⁸ See the OHIM Guidelines, Part B, Section 4, item 2.2.6.

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

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

‘The brand you can trust’

‘You're in good hands with us’

‘We do things better’.

“Not just water..... the health water! “³⁹

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

The following advertising phrases were regarded as *not* being distinctive enough for registration as marks in the Philippines, for the goods or services specified:⁴⁰

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

³⁹ Example provided by the Malaysia IP authorities.

⁴⁰ Examples provided by the Philippines IP authorities.

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

Likewise, in Vietnam the following advertising phrases were refused registration for lack of distinctiveness:⁴¹

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

In contrast, the following advertising phrases were regarded as distinctive in the Philippines and registered as marks for the specified goods:⁴²

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

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

⁴¹ Examples provided by the Vietnam IP authorities.

⁴² Examples provided by the Philippines IP authorities.

2.2 *Generic, customary and necessary signs* ⁴³

2.2.1 Generic, customary or necessary words

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

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

For instance, the following words were refused registration in Vietnam on grounds of being generic, customary or necessary for the goods and services indicated: ⁴⁴

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

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

⁴³ See the provisions in BN TMA, s. 6(1)(c) and (d); KH TML art. 4(a), TM Manual p. 30; ID TML, art. 5.d); LA IPL art. 23.2; MY TMA, s. 10(1)(d); MM; PH IP Code, s. 123.1(h) and (i); SG TMA s. 7(1)(c) and (d); TH TMA s. 7(2); and VN IPL, art. 74.2.b), Circular 01/2007 s. 39.3.e). Also the OHIM Guidelines, Part B, Section 4, item 2.4.

⁴⁴ Examples provided by the Vietnam IP authorities.

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

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

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

2.2.1.1 *Plant variety denominations*

A special case of generic designations refers to the designation of *plant varieties* protected under the plant breeder protection system. Protected plant varieties are assigned a specific variety denomination that is reserved to designate plants and material of that variety. In this connection the UPOV Convention provides that a protected variety must be designated by a '*denomination*' that will be its generic designation. Each Contracting Party must ensure that no rights are acquired in the denomination of the variety that could hamper the free use of that denomination in connection with the variety, even after the expiration of the breeder's right.⁴⁵

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

⁴⁵ UPOV Convention for the Protection of New Varieties of Plants (1991), Article 20 at http://www.upov.int/upovlex/en/conventions/1991/w_up912.html#_20.

National plant variety protection laws usually contain similar provisions regarding variety denominations.⁴⁶ Where such provisions apply in the country concerned, the examiner should raise an objection to the registration of a mark consisting of a variety denomination, if the goods specified in the application relate to products of that variety.

2.2.1.2 *International Non-proprietary Names - INNs*

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

“International Non-proprietary Names (INN) identify pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized and is public property. A non-proprietary name is also known as a generic name. [...] To make INN universally available they are formally placed by WHO in the public domain, hence their designation as "non-proprietary". They can be used without any restriction whatsoever to identify pharmaceutical substances.”⁴⁷

If a sign filed for registration as a trademark consists of, or contains, a term that is entirely or substantially the same as a recommended or proposed INN, and is intended for use in respect of pharmaceutical or medicinal products, the examiner should raise an objection. In case of doubt, the examiner should consult the latest list of INNs published by the WHO.⁴⁸

2.2.2 Generic, customary or necessary figurative signs

Certain figurative signs have, by convention or by custom, a particular meaning that is widely understood in the relevant business circles and by the consumers, or

⁴⁶ For example, in **Indonesia** see Regulation N° 13 of 2004 under Law N° 23 of 2000 on Plant Variety Protection, article 4(g); in **Laos** see Law on Intellectual Property, article 73; in **Malaysia** see the Protection of New Plant Varieties Act 2004, s. 16; in **Singapore** see Plant Variety Protection Act N° 22 of 2004, s. 37; in **Vietnam** see Intellectual Property Law No. 50/2005/QH11 of 29 November 2005, article 163.

⁴⁷ See WHO at <http://www.who.int/medicines/services/inn/innguidance/en/> .

⁴⁸ <http://www.who.int/entity/medicines/publications/druginformation/innlists/en/index.html>

by a significant portion of consumers, in respect of all or specific goods or services. As with common or generic names of goods and services, such figurative signs cannot function as trademarks in respect of the goods or services that they identify.

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



[Images taken from <http://www.tandyleatherfactory.com/en-usd/product/kodiak-oil-tanned-cowhide-side-tan-9075-03.aspx> and from <http://www.vse-seniorum.cz/www-vse-seniorum-cz/eshop/4-1-Pece-o-kozy-nabytek/0/5/20-LM-Strong-silne-znecistení-kuze>]

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



[Example provided by the Philippines IP authorities.]

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



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



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

2.3 *Descriptive signs*

2.3.1 Generally descriptive signs

A mark that consists exclusively or essentially of a sign that is *descriptive* or presumptively descriptive of the goods or services in respect of which the mark is to be used, should be refused registration for those goods or services.⁴⁹

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

⁴⁹ See the provisions in BN TMA, s. 6(1)(c); KH TML art.4(a) TM Manual p. 30 and 31; ID TML art. 5.d); LA IPL art. 23.2 Decision 753 art. 40; MY TMA, s. 10(1)(d); MM; PH IP Code, s. 123.1(J) and (L); SG TMA s. 7(1)(c); TH TMA s. 7(2); and VN IPL, art. 74.2.c), Circular 01/2007 s. 39.3.f) and g), s. 39.4.d). Also the OHIM Guidelines, Part B, Section 4, item 2.3.

a matter of public policy that descriptive terms remain freely accessible to all persons operating in the marketplace.

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

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

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

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

2.3.2 Descriptive words

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

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

The following are examples of descriptive terms:

- as regards the kind or nature of goods or services: ‘RAPILATHER’ for soaps and shaving creams that produce foam, ‘24-SEVEN’ for internet banking services, ‘SOFTER’ for pillows and mattresses;
- as regards the subject matter of goods or services: ‘GEOGRAPHY’ for books and publications, ‘MAGNETIK’ for digital data carriers, software, digital publications, etc., ‘DRAMA’ for television entertainment programs, etc., ‘CAR’ for vehicle and mechanical repair services;
- as regards the quality of goods or services: ‘EXTRA’, ‘PRIME’, ‘PREMIUM’, ‘DELUXE’, “GOOD”, and ‘BEST’, for any goods or services; ‘LITE’, ‘FRESH’ or ‘SKIM’ for food products; ‘14k’, ‘18k’ or ‘24k’ for jewellery;⁵⁰
- as regards the quantity of goods or services: ‘KILOVALUE’ for rice and other cereal grains; “500”, “1000” for pharmaceutical drugs/medicines (describes the milligram dosage content);⁵¹
- as regards the size of goods or services: ‘FAMILY’, ‘GIANT’, ‘JUNIOR’, for any goods or services;
- as regards the purpose or use of goods or services: ‘UPCUTTER’ for cutting instruments, ‘STRIKE’ for matches and fire-lighting products; ‘SANITARY’ in connection with cleaning and sanitation services, ‘THE FIDUCIARY’ for finance and banking services;
- as regards the value of goods or services: ‘2-for-ONE’⁵² in connection with sales and distribution services offering price discounts, ‘50/OFF’ for any goods or services;
- as regards other characteristics of goods or services: ‘FRESH’ for household cleaning products; ‘BRIGHT-N-CLEAR’ for synthetic wall paints; ‘STOUT’ for beers and ales; ‘RUSTOFF’ for metal polishing and care products; ‘TWO LITER’ or ‘TURBO’ for motor engines or motor vehicles; ‘4-GB’ or ‘2-TERA’ for computers and related hardware or software; also ‘3-N-1’, ‘3-in-1’ or ‘3-N-One’ for coffee products (describe that the goods comprise coffee, sugar and cream); ‘125’, ‘250’ for vehicles, particularly, motorcycles (describes the engine size in cubic centimeters); ‘LOW CALORIE’, ‘TASTY’, ‘NUTRITIOUS’ for food; ‘ENERGY SAVER’ for bulbs,

⁵⁰ Examples provided by the Philippine IP authorities.

⁵¹ Examples provided by the Philippine IP authorities.

⁵² Example suggested by the Singapore IP authorities.

fluorescent lamps; ⁵³ 'SMART' for electronic devices that have processors, are programmable, have automated functions or are capable of processing information. ⁵⁴

In Indonesia the following signs were refused on grounds of descriptiveness: ⁵⁵

Best Mart for mini-market services

International Standard Academy for educational services

BESTCHEF for restaurant services

organic water for mineral water

**A
PROPERTY** for real estate agency and management services.

In Malaysia the following terms were found to be descriptive: ⁵⁶

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

⁵³ Examples provided by the Philippine IP authorities.

⁵⁴ See the Trademarks Manual of Cambodia, p. 36.

⁵⁵ Examples provided by the Indonesia IP authorities.

⁵⁶ Examples provided by the Malaysia IP authorities.

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

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

SLIMFIT

SLIM FIT

Slim Fit

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

In Vietnam the following terms were found to be descriptive: ⁵⁷

Perfect

Application No. 4-2011-10424

COOL FRESH

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

In Cambodia the following sign was initially refused on grounds of descriptiveness: ⁵⁸

Plus⁺soft

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

⁵⁷ Examples provided by the Vietnam IP authorities.

⁵⁸ Example provided by the Cambodia IP authorities.

2.3.3 Spelling variations in descriptive words

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

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

The following misspelt words were found to be descriptive in Malaysia for the specified goods:⁵⁹

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

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

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

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

⁵⁹ Examples provided by the Malaysia IP authorities.

For example, the combination 'MINUTE MAID' (which alludes to 'minute made') was found acceptable for a European trademark registration to cover, among other products, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.⁶⁰

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



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

[Example provided by the Malaysia IP authorities]

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



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

[Example provided by the Vietnam IP authorities]

2.3.4 Descriptive word elements

Certain verbal elements that are commonly used as components, prefixes or suffixes to form other words and have a common descriptive or informative

⁶⁰ European Community registration N° 002091262, cited in OHIM Guidelines, Part B, Section 4, item 2.3.2.3. The registration can be seen on the OHIM trademark database at <https://oami.europa.eu/eSearch/#details/trademarks/002091262>

meaning, or are commonly used in the language of a particular country, cannot be registered *per se* as marks for goods or services in general, or in respect of which such common use is relevant. Such word elements must remain free from individual appropriation. Due to their descriptive nature, they are not distinctive and would not be able to function as trademarks, either in general or in respect of certain goods or services.⁶¹

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

- ‘mini’ : meaning small, reduced size (e.g. for electronic components);
- ‘micro’ : meaning very small (smaller than ‘mini’, e.g. for electronic components; microwave ovens);
- ‘nano’ : meaning very small, minute or related to nanotechnology (e.g. for electronic components or electronic devices);
- ‘mid’, ‘midi’ : meaning at the middle of a qualitative or quantitative range (e.g. for wearing apparel; for products usually offered in distinct sizes or size ranges);
- ‘multi’, ‘poly’, ‘pluri’ : meaning multiplicity, or that the goods (or services) have or contain several or multiple characteristics or possible uses;
- ‘plus’, ‘extra’ : meaning additional or beyond the usual or standard performance or features of a product or service;
- ‘eco’, ‘bio’ : meaning ecologically or organically produced or following certain environmentally friendly standards;
- ‘semi’ : meaning incompleteness of the quality or somewhat partial⁶² (e.g. for milk and milk products with partial or skimmed fat content).

The same objection should be raised in respect of other word elements that have a common descriptive meaning in the national language of the country. This ground for refusal will require consideration of the particular perception of the consumers in the country concerned in the languages used locally. It would also require an

⁶¹ See the OHIM Guidelines, Part B, Section 4, item 2.2.2.

⁶² Example provided by the Philippine IP authorities.

assessment of the level of knowledge and use of foreign languages (for example, English, Chinese, etc.) by the relevant consumers in the country.

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

2.3.5 Combinations of descriptive words

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

For instance, in Vietnam the following combinations of descriptive words were found unregistrable:⁶³

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

Likewise, in cases decided by European Community authorities the following word combinations were found to be descriptive and hence unregistrable:⁶⁴

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

⁶³ Examples provided by the Vietnam IP authorities.

⁶⁴ Examples cited in the OHIM Guidelines, Part B, Section 4, item 2.3.2.2.

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

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

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

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



for mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruits juices,
 syrups and other beverages (class 32)
 04005494 -- CHEONG KIM CHUAN TRADING SDN. BHD.



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

[Examples provided by the Malaysia IP authorities]

Also, a combination of words that is unusual or fanciful enough to create an impression sufficiently removed from the plain meaning of the basic words could be regarded as sufficiently distinctive. If the combination of two or more descriptive words or elements is itself fanciful, the combination may become sufficiently distinctive.⁶⁵

For instance, the following combinations of descriptive elements could be regarded as distinctive:⁶⁶

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

⁶⁵ See the OHIM Guidelines, Part B, Section 4, item 2.3.2.2.

⁶⁶ Examples provided by the Singapore IP authorities.

2.3.6 Geographically descriptive signs

2.3.6.1 General considerations

Geographical signs are names, terms, figurative or mixed signs that indicate or convey a sense of geographical origin. Geographical terms include the names of any geographical location, not only political demarcations but also the names of geographic or topographic phenomena including rivers, mountains, deserts, forests, oceans, lakes, etc.⁶⁷

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

For example, 'BOHEMIA' would be geographically descriptive for beer, considering that the region of Bohemia (Czech Republic) is in fact a region where beer is produced. Bohemia is also a region that is known for its traditional crystal products. Therefore the geographical link is *plausible* as regards 'beer' and 'crystal' products. On the basis of that geographical connection, the following marks were refused in Malaysia:⁶⁸

'BOHEMIA'

for beer products (class 32)

Application N° 92008724 - CERVECERIA CUAUHTEMOC S.A. DE C.V.

Bohemian-Art

for household or kitchen utensils and containers, semi-worked glass, glassware, porcelain and earthenware (class 21)

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

⁶⁷ See the provisions in BN TMA, s. 6(1)(c); KH TM Manual p. 37 and 38; ID TML art. 5.d); LA IPL art. 23.2; MY TMA s. 14(1)(f); MM; PH IP Code, s. 123.1(j); SG TMA s. 7(1)(c); TH TMA s. 7(2), Notification of Ministry of Commerce 20 September 2004, s. 2; and VN IPL, art. 74.2.c) and e). Also the OHIM Guidelines, Part B, Section 4, item 2.3.2.6.

⁶⁸ Example provided by the Malaysia IP authorities

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

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

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

The following are examples of geographical names that may be regarded as descriptive in respect of the goods specified:⁶⁹

‘PARIS’ for clothing and cosmetics;

‘NETHERLANDS’ for alcoholic drinks;

‘ATLANTIC’ for prawn and salmon.

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

In Vietnam the following sign was refused registration for any goods or services because “Ha Noi” is the name of the capital city of Vietnam:⁷⁰



⁶⁹ Examples provided by the Singapore IP authorities.

⁷⁰ Examples provided by the Vietnam IP authorities.

Application No. 4-2008-16905

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



Application No. 4-2011-01766

2.3.6.2 *Fanciful, arbitrary or suggestive geographical signs*

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

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

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

‘TICINO’ for electric accessories and fittings;

‘DUNLOP’ for batteries, optical instruments, glasses and lenses.

‘TUCSON’,⁷¹ ‘TORINO’ and ‘PLYMOUTH’ for automobiles,

Similarly, ‘ALASKA’ for milk and other dairy products, and ‘MANHATTAN’ for clothes and footwear could be admitted for registration.⁷²

⁷¹ Example provided by the Philippine IP authorities.

⁷² Examples provided by the Philippine IP authorities.

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

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

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

2.3.6.3 *Likely future geographical association*

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

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

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

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

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

2.3.6.4 *Figurative geographical signs*

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

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



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

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



Application No. 4-2010-17717

[Example provided by the Vietnam IP authorities]

The following are examples of *mixed* marks containing figurative elements that may be recognized as direct reference to a geographical location:⁷³



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

⁷³ Examples provided by the Philippine IP authorities.



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

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

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

2.3.6.5 *Geographical signs that indicate true geographical origin or link*

Certain geographical signs indicate a true geographical origin or geographical connection. This may result from reasons relating to the original place of establishment or the place of current commercial activity. If those signs have acquired distinctiveness or secondary meaning through use they may be accepted for registration as marks.

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

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

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

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

'MYANMAR' and 'MANILA' for beer products;

'YOKOHAMA' for tyres and related rubber products;

'OERLIKON' for hand tools and electric welding tools;

'ZURICH' for insurance and financial services;

'VAUXHALL' for motor vehicles;

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

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

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

2.3.7 Laudatory expressions and other signs

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

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

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

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

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

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



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

[Example provided by the Vietnam IP authorities]

2.3.8 Descriptive advertising phrases and slogans

An advertising phrase or slogan should be refused registration as a trademark if the phrase is descriptive. Such is the case where the phrase directly conveys information about the relevant goods or services, in particular with reference to their nature, kind, quality, intended purpose, commercial value, cost or other characteristics of the goods or services or of their supply to the public.⁷⁴

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

Examples of descriptive or laudatory slogans include:

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

"We put safety first" (for motor vehicles and parts)

⁷⁴ For instance, see the OHIM Guidelines, Part B, Section 4, item 2.2.6.

“First of the class”

“Number one – now and always”

“Buy the Number One in the market”

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

“Only the best for you!”

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

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



01008384 - US POINT VISION CARE GROUP SDN. BHD.

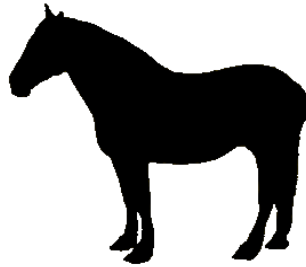
[Example provided by the Malaysia IP authorities]

2.3.9 Descriptive figurative signs

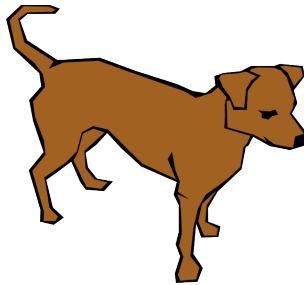
Figurative signs that are descriptive in respect of specific goods or services should be objected as trademarks for those goods or services. In this connection, the same rationale applies as for descriptive word signs.

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

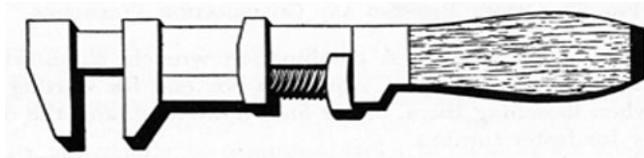
The following are examples of figurative signs that should be regarded as descriptive in connection with the goods or services indicated:



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



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



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



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

[Example provided by the Malaysia IP authorities]



for hotels services

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

[Example provided by the Vietnam IP authorities]

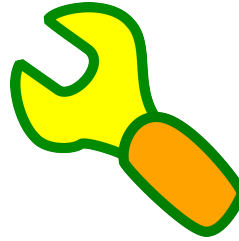
A figurative sign that is markedly different from the usual aspect or shape of the relevant goods or of good related to the specified services, or is *stylized* in a manner that significantly departs from the standard, identical representation of the goods or services, should not be regarded as ‘descriptive’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

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



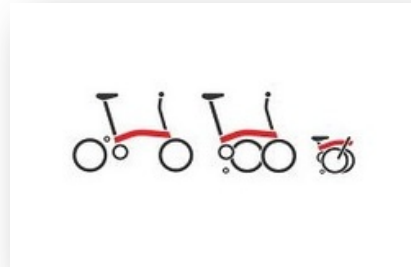
for animal accessories and veterinary services.

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



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

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



for locks and security locks, and for bicycles, folding bicycles and bicycle parts, respectively.⁷⁵



for pickles; processed vegetables and fruit, canned fruits and vegetables; edible oils and fats; poultry and games; meat and meat extracts (class 29).
02001898 - STC CATERERS SDN. BHD.⁷⁶

⁷⁵ Examples provided by the Philippines IP authorities.

⁷⁶ Example provided by the Malaysia IP authorities.

In Vietnam the following sign was accepted because of its unusual distinctive presentation, in spite of the fact that the figure of a weasel is regarded as descriptive for certain types of 'coffee' and 'coffee products' in that country:⁷⁷



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

2.4 Names and likenesses of persons

2.4.1 Names of persons and companies

A mark may consist, in whole or in part, of the name of an individual person or of a legal entity such as a corporation, limited liability company, foundation or a not-for-profit organization (foundation, club, cooperative, etc.). It may also consist of a portrait or likeness of a particular person.⁷⁸

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

⁷⁷ Example provided by the Vietnam IP authorities.

⁷⁸ See the provisions in BN TMA, s. 4(1); KH TM Manual p. 31; ID TML art. 1.1; LA IPL art. 23.7; MY TMA, s. 10(1)(a) and (b); MM; PH IP Code, s. 123.1(c); SG TMA s. 2(1) – 'sign' and 'mark', TMR r. 14; TH TMA s. 4 – 'mark'; and VN IPL, art. 73.3, Circular 01/2007 s. 39.4.f).

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

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

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

Jim Thompson



YVES SAINT LAURENT



04019735 – Registered - RAMLY FOOD PROCESSING SDN. BHD. ⁷⁹

⁷⁹ Example provided by the Malaysia IP authorities.

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

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

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

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

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

For example, in certain countries names such as SUKARNO, LADY DIANA, CHÉ GUEVARA or EINSTEIN may not be allowed registration as trademarks.⁸⁰ Where such names are included in a trademark application the examiner should evaluate the case and, if required, raise an objection against the registration.

The *trade name* of a legal entity such as a corporation, limited liability company, foundation or the name of a not-for-profit organization (foundation, sports club, cooperative, etc.) can be registered as a trademark if the name is distinctive when

⁸⁰ For example, the Brunei TMA, s. 7(c) prohibits the registration of any trademark that consists of or contains a "representation of His Majesty the Sultan or any member of the Royal family, or any colourable imitation thereof".

used in connection with the relevant goods or services. Distinctiveness may be inherent or acquired.

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

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

2.4.2 Fanciful names and characters

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

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

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



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

2.5 *Distinctiveness resulting from a combination of elements*

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

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

'RAPILATHER'

'GILLETTE RAPILATHER'

for soaps and shaving creams that produce foam

'SOFTER'

GUNILLA - Softer Bed Gear

for pillows and mattresses;

'EXTRA'

'ARIEL Extra'

for laundry soaps and detergent products;

'GIANT'

'KELLOG'S Giant Servings'

for cereal food products;

‘COLLAGEN’



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

‘EXPERT IN BONE NUTRITION’

for milk and milk products;

**‘ANLENE
EXPERT IN BONE
NUTRITION’**

‘SUPER’

for coffee products;

‘SAN MIG COFFEE SUPER’

‘HEALTHY WHITENING’

for cosmetic tooth whitening mouthwash;

**‘LISTERINE
HEALTHY WHITENING’**

‘TERIYAKI’



for restaurant services;⁸¹

ECO
MIND

for goods in classes 3 and 5 of the Nice Classification

[Application No. 4-2012-01957]⁸²



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

⁸¹ Example provided by the Philippines IP authorities.

⁸² Example provided by the Vietnam IP authorities.



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

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

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

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

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

‘PRIME’

PRIME

- The figurative element combined with a non-distinctive word element should not consist of any of the following, in particular, as these elements will not introduce the required distinctiveness:
 - a simple, basic shape,
 - a decorative accessory or discrete detail,

- a background pattern,
- a device that is descriptive with regard to the relevant goods, their container or packaging, or their point-of-sale,
- a frame, box, label or shape that is commonly used in trade and will not be noticed or recognized as a trademark by the average consumers.

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

‘100% NATURAL’



for cosmetic or health care products

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

‘RIESLING’



for wine products

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

‘BIOMEDICAL’

‘BIOMEDICAL’



for medicinal and health products and services

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

‘FRESHLY FRUIT’



‘FRESHLY FRUIT’

for fruit juices, jams and fruit products

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

2.6 *Acquired distinctiveness*

2.6.1 Acquired distinctiveness and ‘secondary meaning’

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

However, this *a priori* ground for refusal may be overcome in respect of certain signs if it can be proven that the sign has *acquired distinctiveness through use* in

the market and effectively functions as a trademark when used in connection with the particular goods or services.⁸³

This special case is an exception to the rule that non-distinctive, generic and descriptive signs cannot be accepted as marks because they do not function as badges of commercial origin. If evidence shows that -- notwithstanding its initial absence of inherent distinctiveness -- a sign has come to be recognised as a trademark by the consumers and effectively functions to indicate commercial provenance in respect of particular goods or services, that sign could be registered as a mark for those goods or services.⁸⁴

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

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

As with any other sign, acquired distinctiveness must be assessed taking into account the meaning of the sign in the languages that the relevant consumers understand. This may vary within a country depending on the sector of consumers involved and the type of goods or services for which the mark is used.

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

⁸³ For instance, the TRIPS Agreement, Article 15.1 provides that "Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on *distinctiveness acquired through use*." [emphasis added]

⁸⁴ See the provisions in BN TMA, s. 6(1) proviso; KH TM Manual p. 29; MY TMA s. 10(2B)(b); MM; PH IP Code, s. 123.2; SG TMA s. 7(2), TM Manual chapter 6 'Evidence of distinctiveness acquired through use'; TH TMA s. 7 third paragraph and Notification of Ministry of Commerce of 11 October 2012, clause 2; and VN Circular 01/2007 s. 39.5. Also the OHIM Guidelines, Part B, Section 4, item 2.12.



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

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

A logo for 'Secret Recipe' featuring the words 'Secret Recipe' in a cursive script and 'Fine Quality Cakes' in a serif font below it. The logo is set against a light, textured background.

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

[Example provided by the Malaysia IP authorities]

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

2.6.2 Proving acquired distinctiveness

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

Acquired distinctiveness must be proven as of the date of filing of the application for registration of the mark. The evidence must show that, on the filing date, the sign was already distinctive in the country in respect of the relevant goods or

services. This cut-off date results from the fact that the filing date of an application determines its priority in case of conflict with prior or intervening rights.

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

To succeed with a claim of acquired distinctiveness, the examiner must be persuaded “that a *significant proportion* of the relevant public for the claimed goods and services in the relevant territory see the trade mark as identifying the relevant goods or services of a specific undertaking, in other words, that the use made of the mark has created a link in the mind of the relevant public with a specific company’s goods or services, regardless of the fact that the wording at issue would lack the distinctiveness to make this link had such use not taken place.”⁸⁵

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

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

Evidence should include samples of the mark as it is actually used in trade in the country in connection with the goods or services. Evidence of use of the sign together with other marks would be acceptable provided it is clear that the consumers attribute an indication of commercial origin to the sign for which registration is sought. It should be demonstrated that the sign has been used

⁸⁵ See the OHIM Guidelines, item 2.12.7.

continuously or only with interruptions that can be explained and justified. Sporadic use would be unlikely to make a sign distinctive or to acquire secondary meaning.

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

3 Deceptive signs

3.1 General considerations on deceptive signs

A sign that is deceptive or misleading when used in respect of specific goods or services cannot be registered as a trademark for those goods and services.⁸⁶

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

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

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

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

- (a) The owner of the mark will not deliberately seek to deceive the consumers when using his mark; rather, if the sign can be used in a way that does not cause consumer deception, it may be presumed that the sign will be used in that way.
- (b) The average consumer is reasonably attentive and circumspect, and not easily liable to deception. A sign should be objected on grounds of deceptiveness only when it is clearly in contradiction with the characteristics of

⁸⁶ See the provisions in BN TMA, s. 6(3)(b); KH TML art. 4(c); ID TML art. 5.a); LA IPL art. 23.3 and 4; MY TMA, s.14(1)(a) and TMR, r. 13A(c) and (d); MM; PH IP Code, s. 123.1(g); SG Act s. 7(4)(b), TM Manual chapter 12 - "Deceptive Marks"; TH TMA s. 8(9); and VN IPL, art. 73.4 and 5. Also the OHIM Guidelines, Part B, Section 4, item 2.7.

the specified goods or services and this would frustrate a *legitimate expectation* from the consumer based on the *prima facie* meaning of the mark as used in connection with the relevant goods or services, and considering the usual market practices and consumer perception within that market.⁸⁷

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

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

Similarly, the mark "The Coffee Bean & Tea Leaf" may be registered for use in connection with goods and services different from just coffee or tea, for example fresh fruit juices. Such use will not be deceptive for the relevant public.⁸⁸

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

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

- beers, ales;
- beer substitutes;
- mineral waters,

⁸⁷ In this respect see, for instance, the OHIM Guidelines, Part B, Section 4, item 2.7.1.

⁸⁸ Example provided by the Indonesian IP authorities.

other non-alcoholic beverages;

fruit beverages and fruit juices;

syrops and preparations for making beverages’.

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

An objection could also be raised in respect of ‘ales’ if the mark ‘BLUE MOUNTAIN BEER’ used on ales would, in the country concerned and considering the perception and habits of the average consumers of beers and ales and the manner in which those goods are usually offered or presented in shops, be likely to give rise to erroneous purchase decisions among those consumers (i.e. buying ale mistakenly believing it is beer).

Similarly, the mark “ABC Banana Chips” would be acceptable for registration in respect of ‘chips’ generally. However, if the list of goods included ‘mango chips’ specifically, an objection of deceptiveness should be raised in respect of these goods.⁸⁹

3.2 Geographically deceptive signs

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

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

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

⁸⁹ Example provided by the Singapore IP authorities.

presume that the mark will in fact be used on coffee and coffee products originating from Brazil.

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

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

A case of deceptiveness would arise if, for example, an application to register the mark “KALINGA GOLD” was filed for coffee products made with coffee that does not originate from the organic coffee-producing region of Kalinga, in the north of the Philippines.⁹⁰ That mark would be inevitably deceptive if used for goods that do not correspond to those that the relevant public in the Philippines would normally expect if presented with coffee products bearing that mark.

For example, the mark “SWISSTIME” should be regarded as deceptive if applied to watches or timepieces having no connection with Switzerland.⁹¹ The relevant public will assume that the geographical element ‘Swiss’ indicates a true connection to that country and would be deceived if such connection did not exist.

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

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

⁹⁰ Example provided by the Philippines IP authorities.

⁹¹ Example provided by the Philippines IP authorities.

For example, the following mark contains clear references to a geographical location, namely the city of Paris, in France (Europe).⁹² If the specification of goods for that mark is limited to cover only “perfumery, essential oils and cosmetic products of Asian origin”, the mark could be objected on grounds of deceptiveness. The public would be deceived because there would be a contradiction between the information conveyed by the sign (i.e. that the plausible origin of the goods is the city of Paris) and the actual place of origin of the goods (i.e. Asia as specified in the application).



Likewise, the following mark contains a clear indication of a geographical location, namely the city of Rome, in Italy (Europe).⁹³ If the specification of goods for that mark were to cover specifically “coffee and coffee products produced in Colombia”, an objection should be raised on grounds of deceptiveness to the extent that Italy is well known as a place of coffee roasting shops and coffee products, and the reference to Rome is a plausible true origin in the mind of an average coffee consumer.



⁹² Example provided by the Philippines IP authorities.

⁹³ Example provided by the Philippines IP authorities.

In Vietnam the following devices were regarded as geographically deceptive when applied to goods not originating from the countries indicated in the signs: ⁹⁴



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



Application No. 4-2008-20839

In Indonesia the following signs were refused registration because they reproduced the names of foreign countries without the required authorisation: ⁹⁵



for goods in class 25 of the Nice Classification

TURKEY

⁹⁴ Examples provided by the Vietnam IP authorities.

⁹⁵ Examples provided by the Indonesia IP authorities.

for goods in class 29 of the Nice Classification

3.3 Signs with a deceptive reference to official endorsement

A sign should be refused registration as a mark if it contains an express indication or a clear, unambiguous implication that the goods or services have received official authorization or endorsement from an identifiable public body, official authority or statutory organization.⁹⁶

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

For example, a sign containing the words ‘AUTHORITY CHECK’, ‘EXPORT QUALITY’⁹⁷ or ‘INTERNATIONAL STANDARD’ does not refer specifically to any particular authority or institution and should not be regarded as deceptive.

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

In Malaysia similar cases for refusal include marks containing the words ‘HALAL’ and ‘BUATAN MALAYSIA’.⁹⁸

In Vietnam the following signs were not accepted on grounds that they are deceptively allusive to compliance with standards:⁹⁹

- “JAPAN TECHNOLOGY”

⁹⁶ For instance, see ID TML art. 6(3).c); LA IPL art. 23.3, Decision 753 art. 41; SG TMR r. 13; TH TMA s. 8(8); VN IPL art. 73.4.

⁹⁷ Example provided by the Philippines IP authorities.

⁹⁸ Example provided by the Malaysia IP authorities.

⁹⁹ Examples provided by the Vietnam IP authorities.

- “STANDARD GERMANY”



Likewise, a mark consisting of or including, for example, the expression ‘ORGANIC CERTIFIED’¹⁰⁰ could be understood to indicate that the product has been checked for conformity with organic production standards by some competent official authority. Where such is not the case, the examiner should object to the registration of that mark for any goods or services.

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

4 State and official signs, emblems and other symbols

4.1 Signs under Article 6ter of the Paris Convention

Signs containing official signs, emblems and other symbols of States or intergovernmental organizations cannot be registered as trademarks unless the applicant submits evidence that the State or organization concerned has given authorization for such registration. In particular, the following official signs are concerned:¹⁰¹

¹⁰⁰ Example provided by the Philippines IP authorities.

¹⁰¹ See the provisions in BN TMA, s. 7(1)(a) and (b), 55 and 56, Emblems and Names (Cap. 94) s. 3(c), Schedule Part I; KH TML, art. 4(d); ID TML, art. 6(3).b) and c); LA IPL art. 23.5 and 6; MY TMA s. 15(b), TMR, r. 13, 14 and 15, TM Manual item 5.37; MM; PH IP Code, s. 123.1(b); SG Act s. 7(11), (12) and (13), 56 and 57, TMR r. 11, 12 and 13, and Work Manual on “Other grounds for refusal of registration”, p. 9 and 10; TH TMA, s.

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

This ground for refusal is based on the provisions of Article 6*ter* of the Paris Convention that establishes a procedure for the reciprocal communication of the emblems and official signs of States, and of the names and emblems of intergovernmental organizations. The signs and emblems communicated through the Article 6*ter* procedure can be found on the 6*ter* database accessible online on the WIPO website.¹⁰²

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

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

The following are examples of signs communicated under Article 6*ter* of the Paris Convention, that are not registrable as marks or as parts of marks, unless the applicant submits evidence that the competent national or intergovernmental authority has given authorization for such registration:

- Armorial bearings of States

8(1), (2), (6) and (7); and VN IPL, art. 73.1 and 2. Also the OHIM Guidelines, Part B, Section 4, item 2.8.

¹⁰² See the WIPO website at: <http://www.wipo.int/ipdl/en/6ter/> .



- Flags of States



- Other emblems of States



- Official signs and hallmarks indicating control and warranty adopted a State ¹⁰³



- Names and abbreviations of names of international intergovernmental organizations

¹⁰³ Some official signs and hallmarks indicating control or warranty may consist of 'country brands' that a State or a national State agency has adopted as an official sign of control for specific goods or services.

**UNITED NATIONS ORGANIZATION
FOOD AND AGRICULTURE ORGANIZATION
WORLD HEALTH ORGANIZATION
Asia-Pacific Economic Cooperation**

UNO

FAO

WHO

- Armorial bearings of international intergovernmental organizations



- Flags of international intergovernmental organizations



[Organisation for the Prohibition of Chemical Weapons]

[Association of South-East Asian Nations]

- Other emblems of international intergovernmental organizations



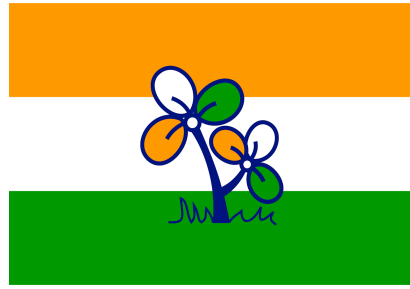
- Heraldic imitations

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

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



[Example provided by the Philippines IP authorities]



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

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



Application No. 4-2008-26144

[Example provided by the Vietnam IP authorities]

Similarly, the registrations of the following marks were declared invalid by a court in the Netherlands because they included, without authorization, the Swiss national emblem.¹⁰⁴

Swiss  Sense®

Swiss  Sense®

¹⁰⁴ See http://www.gevers.eu/sites/default/files/gevers_belgium_feb13-mip.pdf

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

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

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



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

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

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

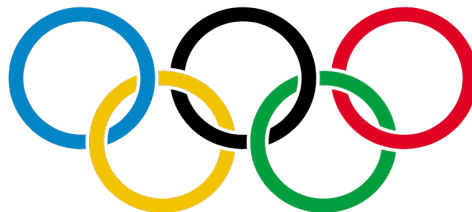


[Example provided by the Philippines IP authorities]

4.2 Other signs and emblems excluded as marks ¹⁰⁵

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

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

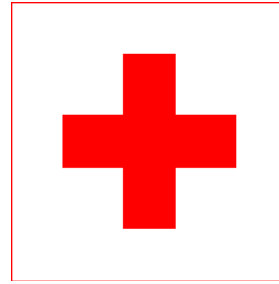


[Olympic symbol]

¹⁰⁵ See the OHIM Guidelines, Part B, Section 4, item 2.8.3.



[Red Crescent]



[Red Cross]

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

The following sign was refused in Vietnam because of its unauthorized inclusion of the Euro sign: ¹⁰⁶



Application No. 4-2012-20098

4.3 Signs excluded by statutory provision

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

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

Brunei: ¹⁰⁷

¹⁰⁶ Example provided by the Vietnam IP authorities.

¹⁰⁷ TMA s. 7(1)(c) and (d), and Chapter 94 - Emblems and Names (Prevention of

- a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colourable imitation thereof
- any word, letter or device likely to lead persons to believe that the applicant either has or recently has had Royal patronage or authorisation
- the standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri
- the State Seal of Brunei Darussalam
- the Brunei Coat-of-Arms
- the emblem or official seal of the United Nations Organisation
- the Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty
- the Emblem or official seal of the International Criminal Police Organisation (Interpol)
- the emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam
- the name of His Majesty the Sultan and Yang Di-Pertuan
- the name of Her Majesty the Raja Isteri

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

Malaysia: ¹⁰⁸

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

Improper Use) Act, 1967.

¹⁰⁸ TMR r. 13(1)(b), (c) and (d), and 14.

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

Singapore: ¹⁰⁹

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

Thailand: ¹¹⁰

¹⁰⁹ TMR r. 11 and 12.

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

¹¹⁰ TMA s. 8(3), (4) and (5).

5 Public order, public policy, morality

5.1 General considerations

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

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

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

Since the definition of ‘public policy’, ‘public order’ and ‘morality’ is a strictly domestic matter, it can only be judged and decided by the competent national authorities in each country. The determination of what is contrary to public order or to prevailing standards of morality will necessarily depend on the political, cultural and religious context prevailing in the country concerned. In addition, factors such as the degree of outrage calculated to be caused by the use of the offensive sign and the size and section of the identified community potentially affected by the sign are factors to be considered in each case .¹¹¹

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

¹¹¹ See the provisions in BN TMA, s. 6(3)(a); KH TML art.4(b); ID TML, art. 5.a); LA IPL art. 23.18, Decision 753 art. 45 and 46; MY TMA s. 14(b) and (c), TM Manual chapter 5 items 5.5 to 5.8; MM; PH IP Code, s. 123.1(a) and (m), TM Guidelines p. 87; SG Act s. 7(4)(a), TM Manual chapter 9 - “Marks Contrary to Public Policy or to Morality”; TH TMA s. 8(9); and VN IPL, art. 8.1 and Circular 01/2007 item 39.2.b.iii. Also the OHIM Guidelines, Part B, Section 4, item 2.6.

5.2 *Particular issues*

5.2.1 Nature of the sign itself

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

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

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

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

For instance, the registration of the mark 'BUDDAH BAR' was invalidated in Indonesia and was refused in the Philippines for reasons of public order based on respect for the Buddhist religious feelings among the interested communities in those countries.¹¹²

Likewise, registration of the following marks were refused, respectively, in Indonesia and in Malaysia on grounds of their contradiction with the prevailing rules of religious morality, causing offense to the sensitivity of Muslim people and misrepresenting Islamic precepts:¹¹³

¹¹² Information provided, respectively, by the IP authorities of Indonesia and the Philippines.

¹¹³ Examples provided, respectively, by the IP authorities of Indonesia and of Malaysia.

MAŞAALLAH41

for goods in class 25 of the Nice Classification



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

In Vietnam the following sign was refused on grounds of public ethics: ¹¹⁴



Application No.4-2012-04183

In Indonesia the following sign was refused registration because the sign could be associated with the official postal service in that country (in Indonesia 'Kantor Pos' means 'Post Office'): ¹¹⁵

KANTOR POS

for restaurant services.

¹¹⁴ Examples provided by the Vietnam IP authorities.

¹¹⁵ Example provided by the Indonesia IP authorities.

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

5.2.2 Nature of the goods and services

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

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

In connection with the trademark examination procedure, this provision has been understood in the sense that the registration of a mark should not be refused only for reasons related to the nature of the goods or services that are included in the specification of goods and services.¹¹⁶

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

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

In such cases, the registration of a mark should be regarded as a matter separate and distinct from the manufacture, importation, distribution or commercialization of

¹¹⁶ For instance, see provisions in LA IPL s. 23 last paragraph, and Decision 753 art. 45 last paragraph.

the goods or services to which the mark will apply. The former may be allowed even where the latter is not allowed.

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

6 Collective and certification marks

6.1 General considerations

6.1.1 Collective marks

The recognition and protection of collective marks is an international obligation under the Paris Convention (Article *7bis*) and the TRIPS Agreement (by reference to the Paris Convention in Article 2.1).¹¹⁷

A *collective mark* is a mark that is owned by a 'collective' organization with the purpose of being used by all the members of that organization or by a specified category of those members. The collective organization that owns a registered collective mark could, for example, be an association of manufacturers, a cooperative of producers, a corporate union of retail distributors, a chamber of traders or a federation of industries.¹¹⁸

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

¹¹⁷ Article *7bis* of the Paris Convention provides that:

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

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

¹¹⁸ See the provisions in BN TMA, s. 50 and First Schedule – 'Collective Marks'; KH TML art. 2(b) and 17, Sub-Decree 46 of 2009, art. 23, TM Manual p. 22 to 25; ID TML art. 1.4, 50 and 51; LA IPL art. 3.11, Decision 753 art. 20, TM Manual p. 21 and 22; MY; MM; PH IP Code, s. 121.2 and 167; SG Act, s. 60 and First Schedule, TM Manual on 'Collective Marks'; TH TMA s. 4 – 'collective mark' and 94; and VN IPL, art. 4.17, 87.3 and 105.4. Also the OHIM Guidelines, Part B, Section 4, item 2.11.

6.1.2 Certification marks

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

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

Unlike collective marks, the registration of certification marks is not mandated under any international treaty. Nevertheless, certification marks are recognised and can be registered under many national trademark laws.¹¹⁹

6.2 Particular conditions for substantive examination

Collective and certification marks will be treated and examined like ordinary standard marks in respect of most of the applicable absolute grounds for refusal of registration.¹²⁰

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

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

- geographical descriptiveness,
- regulations of use of the mark, and

¹¹⁹ For instance, see the provisions in BN TMA, s. 52, Second Schedule – ‘Certification Marks’; LA IPL art. 3.12, Decision 753 art. 21; MY TMA s. 56; MM; SG Act s. 61 and Second Schedule, TM Manual on ‘Certification Marks’; TH TMA s. 4 – ‘certification mark’, 82, 83 and 84; and VN IPL, art. 4.18, 87.4 and 105.5, Circular 01/2007 s. 37.6.

¹²⁰ In this connection, see also the OHIM Guidelines, Part B, Section 4, item 2.11.3.

- use of a certification mark by its registered holder.

6.2.1 Geographical descriptiveness

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

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

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

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

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

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

6.2.2 Regulations of use of the mark

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

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

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

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

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

6.2.3 Use of a certification mark by its registered holder

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

It is generally understood that a certification mark is to be used to indicate that the holder of the mark has performed an independent assessment of the goods or

services of a third party. Such arm's length relationship would be presumed not to exist if the holder of the mark uses the mark on its own goods and services.

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