



NON-TRADITIONAL MARKS COMMITTEE

# **EAST ASIA & PACIFIC**

**PROJECT MOCK APPLICATION**

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2018/2019 TERM)**

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## BACKGROUND

We are instructed that our client, N'Obile, has decided to move into the rather under-developed market for cosmetics for men and wants to see its product line protected in various jurisdictions including China.

Details of the instructions are as follows:

- N'Obile intends to focus distribution on luxury outlets but to avoid high-street chains;
- The products will be advertised as “skin care”, the word “cosmetics” should be avoided at all costs;
- The products will come mainly in the form of glass jars and plastic tubes;
- The colour of the tube caps/jar lids will be “a warm, but not too saturated brown with a slightly yellowish tone” (“**Cap/Lid Brown Colour**”). The caps also might have some sort of texture;
- The jars and tubes themselves will be coloured in a sort of pale green with a touch of, but not quite, turquoise” (“**Jar/Tube Green Colour**”);
- The front side of the jars and upper side of the tubes will not have writing in a contrasting colour, but instead will feature the company name only in an embossed or engraved form, although in a comparatively large font size. The “small print” will be on the back of the tubes and on the bottom of the jars respectively, probably in white;
- The products will be sold in a packaging of a similar style.

*We are asked to advise on the following:*

### **Trademarks**

1. What trademarks should N'Obile apply for in China? How should the marks be depicted/described? If we suggest several applications, clarify which option would provide N'Obile with the greatest protection? What would or would not be enforceable?
2. Explain if the protection of an abstract colour marks is possible in China.
3. Outline if there are differences with regard to acquired distinctiveness if a single colour mark or if the combination of two colours is applied for.
4. If we advise to file a colour mark consisting of two-colours, outline whether the percentage of the two colours should be included and whether colour codes should be used.

5. Advise on whether to file 3D trademarks for the tube and the jar and whether N'Obile should file for the shape alone or combination of shape, name, logo, colour. If a 3D trademark including colour is recommended, outline what the scope of protection of such application would be for the colours.
6. Provide our thoughts on the registration of a texture mark.
7. Provide a strategy on whether both the jar and the tube should be protected.
8. Provide our suggestions to modify the product design.

#### **List of goods and services**

1. Provide a list of the goods and services we suggest N'Obile to cover. This list should allow for future developments of the product range but the products should be aimed at men only. "Cosmetics" shall not be used as a term.
2. If our suggested list includes "retail services", clarify the reasons for this.
3. If a detailed list of products is suggested, outline our reason for this.
4. If Class 5 is included, explain the reasons for doing so.

#### **Acquired distinctiveness**

1. Could the mode of distribution have an impact on the distinctiveness and which one?
2. How could N'Obile improve distinctiveness/recognition?
3. How long should N'Obile wait before being able to file an application based on acquired distinctiveness?
4. Provide information on what evidence of acquired distinctiveness is specifically required.

#### **Survey**

1. Advise whether the survey results would be more convincing to a trademark office and/or court if it has been focused on males only.

**Question 01** - What trademarks should N'Obile apply for? How should the marks be depicted/described?

- (a) word mark "N'Obile"
- (b) combination of word N'Obile, shape (jar/tube), and the colors pale green and brown.
- (c) once secondary meaning can be established, a color mark application
- (d) once secondary meaning can be established, 3D applications for the jar and tube

Under Korean trademark practice, any mark composed solely of color or shape can be registered only where the color or shape has acquired secondary meaning.

However, if any distinctive word or design element is combined therewith, the mark can be registered without proving secondary meaning. Thus, if the shape and colors are combined with the distinctive word "N'Obile", the composite mark can be registered based on its overall distinctiveness.

That said, if the composite trademark is registered because of its overall distinctiveness, but the shape and/or color on their own lacks distinctiveness, the registered trademark rights will not extend to the shape or color alone. Thus, even if the composite trademark is registered, it does not necessarily mean that other parties are excluded from using the shape or colors without the N'Obile name. Nevertheless, the registration of the combination mark can deter third parties from using a similar shape or color mark as there is no disclaimer system in Korea.

- (a) color mark per se after acquiring secondary meaning

The KIPO examination guidelines say simply that:

"When it comes to the mark solely composed of color or a combination of color, examiners can request the applicant to provide additional information to describe the shade of color using a commercial color distinguishing system (e.g., PANTONE, etc.) to better explain the mark."

By way of example, is the below description that was found acceptable for the only registered color mark currently on the register in Korea, Reg. no. 40-1183777, which is for "confectionary":

“This color per se mark is a “Gold color”, which consists of 1) 83% of inherent color number 871C, 2) 15% of inherent color yellow, and 3) 2% of inherent color warm red, according to the PMS (Pantone Matching System) in the commercial color distinguishing system (PANTONE). In the meantime, the “Gold color” of this color per se mark consists of inherent color number L76, a 5, b 45 according to another commercial color distinguishing system (lab figures).”

A color template was also included.

(b) 3D mark per se after acquiring secondary meaning

Applicants are required to submit 2 to 5 drawings or photos which sufficiently show the characteristics of the 3D mark. The below are provided in the examination guidelines as suitable examples of images showing the appearance of a container viewed from the front, back, side, top, and bottom.



- **Please explain if the protection of abstract color marks is possible in your country.**

The Korean Trademark Act has provided protection for abstract color marks since 2007. 7. 1., however secondary meaning is required for registration.

- **Please outline if there are differences with regard to acquired distinctiveness if a single color mark or if the combination of two colors is applied for.**

None.

- **If you have advised filing a color mark consisting of two colors, please outline if you recommend including the percentage of the two colors.**

As secondary meaning will only be recognized when the specimen of the mark is identical to the mark that has actually been used, we suggest indicating the proportion of the two colors as actually used (i.e. the percentage of cap/lid to the tube/jar).

- **Please advise if you recommend filing 3D trademarks for the tube and the jar, showing**

**the combination of colors if the applications for the color marks are being refused for lack of distinctiveness.**

The 3D applications showing the combination of colors may fare better if the shapes have acquired distinctiveness, even if the colors have not.

- **Please provide your thoughts on the registration of a texture mark.**

According to the Korean Trademark Act, a trademark is defined as any type of mark that functions to distinguish one's goods from those of others. Thus, we would not exclude the possibility of a texture mark being registered. However, it is uncertain to what extent a texture mark would actually be protected given that no court or KIPO precedents exist yet. In the meantime, we opine that even if protection for a texture mark is possible, considering the current Korean trademark practice, demonstrating secondary meaning would be necessary.

- **Do you have any suggestion to modify the product design?**

In theory, if the shape itself is very unique and can function as a source identifier, it may be registerable even before obtaining secondary meaning. Thus, the client may consider modifying the product design to the extent that it can function as a source identifier. However, in general, it is very difficult to get recognition that the product shape itself functions as a source identifier.

<b>SOUTH KOREA</b>	<b><u>Question 02</u></b> - Provide the specification of the list of goods and services for the trademark application(s).
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In view of current practice and to protect the goods/services of interest as broadly as possible, we suggest using the descriptions below. With regard to the goods in the classes highlighted in green (i.e., classes 3, 35, 41, and 44), they are the core goods or are closely related to skin care products (for men) under local practice. With regard to the other classes (i.e., 5 and 42), claiming them will provide broader coverage. We included brief reasons for proposing the goods/services for each class in the right-hand column in the chart below:

Class	Proposed Goods/Services	Reason for Proposal
3	Non-medicated skin care preparations; skin care preparations; non-medicated toiletries; soaps for personal use; cosmetic soaps; perfumery; tissues impregnated with cosmetic lotions; beauty masks; cotton sticks for cosmetic use; adhesives for cosmetic use; cotton wool for cosmetic use; dentifrices.	Main goods/class of interest.

5	Medicated skin care preparations; pharmaceuticals; petroleum jelly for medical purposes; medicated skin lotions; medicines for skin care.	Economic relationship to skin care products as well as recent trends in industry
35	Retail services for non-medicated skin care preparations; retail services for skin care preparations; retail services for non-medicated toiletries; retail services for soaps for personal use; retail services for cosmetic soaps; retail services for perfumery; retail services for tissues impregnated with cosmetic lotions; retail services for beauty masks; retail services for cotton sticks for cosmetic use; retail services for adhesives for cosmetic use; retail services for cotton wool for cosmetic use; retail services for dentifrices; retail services for medicated skin care preparations; retail services for pharmaceuticals; retail services for petroleum jelly for medical purposes; retail services for medicated skin lotions; retail services for medicines for skin care; advertising services relating to cosmetics; providing consumer product advice relating to cosmetics; providing consumer product information relating to cosmetics; marketing research in the fields of cosmetics, perfumery and beauty products.	Economic relationship to skin care products
41	Beauty art instruction services; education in make-up; education in cosmetics; education in beauty; beauty academies; arranging and conducting of seminars relating to beauty.	The services related to “beauty art instruction services” in Class 41 are considered similar to skin care products in Class 3 under local practice.
42	Cosmetology research; cosmetic research; operating an internet shopping mall web site for cosmetic; laboratory analysis in the field of cosmetics; cosmetics development services; survey and research services in the field of cosmetics.	Economic relationship to skin care products
44	Beauty care services; massage services; beauty consultation services; beauty salon services; nail/fingernail care services; massage parlor management services; barbershop services; make-up consulting services; providing information regarding beauty care; aroma therapy services; health spa services; hygienic and beauty care.	Beauty care services in Class 44 are considered similar to skin care products in Class 3 under local practice.

**Question 03** - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.

Courts have consistently ruled that acquiring distinctiveness through use means granting rights to what is originally inappropriate for one particular party to monopolize, so it cannot be assumed simply from the fact that the mark has been advertised to some degree or registered overseas; it must be clearly proven with evidence.

To prove acquired distinctiveness, it is required to submit evidence regarding the period, frequency, continuance of using the mark, the volume of manufacture, sales, and market share in respect of the goods on which the subject mark is used, the method, frequency, content, and expenditure with regard to advertisement of the mark, the quality of the goods, the reputation and credit of the user of the marks, the degree of competitiveness and pattern related to the use of the mark, and so on.

- **How could the client improve distinctiveness / recognition?**

As sales volume and extent of advertisement are the main factors for judging whether secondary meaning has been achieved or not, the client needs to sell and advertise the product through major sales channels and prominent media so it will be exposed to as many consumers as possible.

- **Please advise how long the client should wait before being able to file an application based on acquired distinctiveness.**

There is no special fixed period of use; it is recognized that secondary meaning can be acquired in just a short period of time depending on the characteristics of the designated goods or sales performance.

**SOUTH KOREA**

**Question 04** – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).

Acquired distinctiveness is based on the consumers of the designated goods. Therefore, even if the product in this case is a skin care product for men, we suggest setting the proportion of male and female participants based on the statistics regarding the proportion of men and women who purchase men's cosmetics (or skin care products) rather than focus on males only.

- **What are the main three questions you would ask in the survey?**

*In relation to acquired distinctiveness of color mark*

- 1) Do you buy or use men's skin care products?
- 2) [If they say yes to the previous question] (showing respondents the color) have you seen this color applied to men's skin care products?
- 3) [If they say yes to the previous question] Does this color identify a particular company to you?  
[If yes] which one?

*In relation to acquired distinctiveness of 3D mark*

- 1) Do you buy or use men's skin care products?
- 2) [If they say yes to the previous question] (showing respondents the shape of the product) have you seen men's skin care products offered in this shape?
- 3) [If they say yes in the previous question] Does this shape identify a particular company to you?  
[If yes] which one?

**Question 01** - What trademarks should N'Obile apply for? How should the marks be depicted/described?

We suggest N'Obile to apply to register the following marks ("Suggested TMs") in China:

- (a) a color trademark: to file the combination of Cap/Lid Brown Color and Jar/Tube Green Color as a color trademark ("Suggested TM No.1").
- (b) a 3D trademark: to file the shape of the jar/tube + the two colors as a 3D trademark ("Suggested TM No.2").
- (c) a 3D trademark: to file the shape of the jar/tube + the two-color + the company name as a 3D trademark ("Suggested TM No.3").
- (d) a word mark: to file N'Obile as a word mark ("Suggested TM No.4").

The best approach is to file all the Suggested TMs in China. For the Suggested TMs No.2 and No.3, the jar and tube should be filed as a separate trademark and therefore N'Obile needs to file a total of 6 trademark applications. As Suggested TM No. 4 is not a non traditional mark (which is not the focus of this advice), we will comment briefly on it whenever necessary and will focus our advice on Suggested TMs No.1 to No.3. Suggested TM No.4's registrability will be subject to the similarity review of the China Trademark Office ("CTO").

Our suggestion is based on the following assumptions and reasons:

- (1) It is important to protect the color combination by registering it as a trademark. Two-color combination can be registered as a color trademark in China but in practice, the CTO may regard a two-color combination as being too simple to be registered as a trademark and therefore rejects the registration on the ground of lack of distinctiveness. The key to overcome this rejection is to prove "acquired distinctiveness".
- (2) We have assumed that the jar/tube is of an ordinary shape. If our assumption is correct, the shape itself is not registrable as a 3D trademark. The ways to overcome this problem include: (a) to add distinctive components to the applied trademark, (b) to prove "acquired distinctiveness".
- (3) As for the Suggested TM No.2, the CTO examiner may regard the shape or the two-color combination as lacking distinctiveness. To improve the chance of success, we suggest to file

Suggested TM No.3 as a back-up application.

- (4) In our view, the Suggested TM No.3 has the best chance of success because the company name has sufficient distinctiveness for trademark registration purposes.

- **How should the marks be depicted/described?**

- (1) Suggested TM No.1: the combination of Cap/Lid Brown Color and Jar/Tube Green Color

In the application, N'Obile should specify the following:

It is a color trademark application. The Jar/Tube Green Color will be applied to the jars or tubes themselves and the Cap/Lid Brown Color will be applied to the jar lids or tube caps. The color code (Pantone code) of these two colors must be specified in the application.

- (2) Suggested TM No.2: (a) the shape of the jar + the two colors; (b) the shape of the tube + the two colors.

As mentioned earlier, the jar and tube should be filed as two separate trademarks but for the purpose of this Memo, we will treat the marks as a single mark and refer to it as “jar/tube”. In the application, N'Obile should specify the following:

It is a 3D trademark application. The shape will be applied to the jar/tube containing skin care products. The Jar/Tube Green Color will be applied to the jars/tubes themselves and the Cap/Lid Brown Color will be applied to the jar lids/tube caps. It is advisable to specify the color code (Pantone code) of these two colors in the application.

- (3) Suggested TM No.3: (a) the shape of the jar + the two-color + the company name; (b) the shape of the tube + the two-color + the company name.

Again, the jar and tube should be filed as two separate trademarks but for the purpose of this Memo, we will treat the marks as a single mark and refer to it as “jar/tube”.

In the application, N'Obile should specify the following:

It is a 3D trademark application. The shape will be applied to the jar/tube containing skin care products. The Jar/Tube Green Color will be applied to the jars/tubes themselves and the Cap/Lid Brown Color will be applied to the jar lids/tube caps. The company name “N'Obile” will be engraved in a large font size on the front side of the jars/the upper side of the tubes and in a small font size on the bottom of the jars/the back of the tubes. It is advisable to specify the color code (Pantone code) of these two colors in the application.

- **Are the mark and its components enforceable?**

Once a trademark is registered, it can be enforced in China. However, if any part of a registered trademark lacks distinctiveness, it cannot be enforced. For example, an ordinary shape of the jar/ tube cannot be enforced even if it is registered as a component of a trademark unless the registrant can prove that it is distinctive and should be protected as a trademark.

- **Explain if the protection of an abstract color marks is possible in China**

An abstract color mark can be registered as a color trademark in China but the law requires the ways to apply the color to the products be specified in the application.

Please refer to our advice on the specifications of the Suggested TM No.1. Specifications are the key for the protection of a registered color trademark.

- **Outline if there are differences with regard to acquired distinctiveness if a single color mark or a combined two-color mark is applied for registration**

Acquired distinctiveness is essential for the successful registration of a single-color trademark in China. The only way to persuade the CTO's examiners to grant registration is to prove "acquired distinctiveness". The purple color of Cadbury UK Limited is the only precedent in China. This mark was gazetted by the CTO in 2006 but eventually failed to be registered due to third party opposition.

As we advised earlier, the combination of two colors is allowed for registration by law but the CTO inclines to reject this type of application on the ground that it is too simple to be registered and lacks distinctiveness. The solution to overcome this rejection is also to prove "acquired distinctiveness".

If "acquired distinctiveness" is required, the requirements for proving it are the same for a single color and a two-color combination.

- **If we advise to file a color mark consisting of two-colors, outline whether the percentage of the two colors should be included and whether color codes should be used**

N'Obile can specify the percentage of each color if it helps to clarify the ways to apply the colors but it is not compulsory to do so because in the application, they are required to include a detailed description of how the colors should be applied.

The color codes are mandatory and should be specified in the application of a color trademark.

- **Advise whether to file 3D trademarks for the tube and the jar and whether N'Obile should file for the shape alone or combination of shape, name, logo, color. If a 3D trademark including color is recommended, outline what the scope of protection of such application would be for the colors.**

We suggest to register the Suggested TMs No.2 and No.3 to protect the tube and jar for reasons outlined at the beginning of this advice.

As for the protection of colors in these Suggested TMs, the color combination can be protected only if it is regarded as distinctive.

- **Provide our thoughts on the registration of a texture mark**

Texture mark is not available for registration in China.

- **Provide a strategy on whether both the jar and the tube should be protected**

Based on the types of non- conventional trademarks available for registration in China, we suggest to protect the jar and tube by registering the Suggested TMs in China. Please refer to our detailed comments at the beginning of this advice.

- **Provide our suggestions to modify the product design**

In our view, N'Obile can consider modifying the product design in the following ways to make the design distinguishable, hence improve the registrability of the design:

- (a) To add one or more colors to the color design of the jar/tube; or
- (b) To make the shape of the jar/tube sufficiently unique for trademark registration.

**CHINA #1**

**Question 02** - Provide the specification of the list of goods and services for the trademark application(s).

**Class 3:**

*after-shave lotions; whitening cream; antiperspirants (toiletries); Eau de Cologne; beauty mask; shampoo; bath lotion; facial cleanser; essential oil.*

**Class 5:**

*pharmaceutical preparations for skin care; nutritional supplements*

**Class 44:**

*beauty salon*

- **If our suggested list includes “retail services”, clarify the reasons for this**

We did not include “retail service” because “retail of skin care products” is not available for trademark registration in China.

- **If a detailed list of products is suggested, outline our reason for this**

The CTO requires the applicants to use standard terms in their trademark applications and will require the applicants to correct the terms if non-standard terms have been used. Standard terms are listed in the Classification of Similar Goods and Services published by the CTO and we selected the suggested goods and services from this Classification.

- **If Class 5 is included, explain the reasons for doing so**

We included Class 5 because it covers skin care products for pharmaceutical purposes or for edible use which are highly relevant to ordinary skin care products, such as facial cleanser and cream.

<b>CHINA #1</b>	<b><u>Question 03</u></b> - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.
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1. Could the mode of distribution have an impact on the distinctiveness and which one?

The wider the distribution channels are, the more likely that the examiner or judge will decide that distinctiveness has been established. Limiting the mode of distribution is a negative factor in establishing distinctiveness unless this limitation can be justified by product orientation.

2. How could N'Obile improve distinctiveness/recognition?

The key is to create a link between the applied trademark and the company, and to strengthen that link as far as possible.

Increasing the exposure of the applied trademark and the products as far as possible is very important and this can include extensive marketing to a broader audience by social media, conventional media, etc,

using high profile celebrities, participating in international expos, using the applied trademark in all business activities, organising events with potential customers, etc, etc. Supporting documents in respect of these marketing and advertisement activities are very important and should be properly prepared and well kept for evidence purpose.

3. How long should N'Obile wait before being able to file an application based on acquired distinctiveness?

There is no statutory period. Generally speaking, a longer use period is a positive factor in establishing "acquired distinctiveness".

4. Provide information on what evidence of acquired distinctiveness is specifically required

Evidence should focus on the use of the applied trademark in China and on the following aspects:

- (a) acknowledgement of the relevant public in China on the applied trademark and the relevant products;
- (b) how the applied trademark has been actually used on the relevant products in China and for how long, and such use should be compared with the use of the trademarks by the competitors in China;
- (c) how the relevant products are manufactured, distributed, advertised and promoted in China;
- (d) nature and characteristics of the relevant products;
- (e) other evidence which can prove that the Chinese customers link the applied trademark to the manufacturer.

**CHINA #1**

**Question 04** – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).

In our view, the relevant public of male skin care products should not be confined to male customers. Female customers may purchase skin care products for their husbands, fathers, boyfriends, sons and male friends. Accordingly, they should be included in the relevant public and the survey candidates.

Ordinary consumers who are able to understand skin care products and their functions should be treated as the relevant public.

**Question 01** - What trademarks should N'Obile apply for? How should the marks be depicted/described?

Under Article 8 of the Trademark Law of the People's Republic of China ("PRC Trademark Law"), an application may be made to register as a trademark any mark, including any word, device, any letter of the alphabet, any number, three-dimensional symbol, color combination and sound, or any combination thereof, that identifies and distinguishes the goods of a natural person, legal person, or other organization from those of others. While mark in the form of sound are not relevant to the present case and registration of texture mark is not feasible in China, we propose to apply for separate registration of the logo, color combination, 3D shape and a combination of 3D shape and colors for the N'Obile skin care product rather than a combination of everything so as to broaden the trademark protection as much as possible.

## (a) Logo

It is likely that the logo "N'Obile" can be registered in China. However, the risks lie in three areas:

- a. If there exists a similar logo which may cause confusion to the general public, then N'Obile cannot be registered (Article 31 of PRC Trademark Law);

## (b) Color combination

The special colors used onto the lid/cap and the jars/tubes can be protected by applying for registration of such colors. Pursuant to the Standard for Examination of Trademarks, single color mark is regarded as lack of distinctiveness, and that color marks are required to consist of two or more colors (Standard for Examination of Trademarks, page 44). Therefore, we would suggest registering a color combination of "a warm, but not too saturated brown with a slightly yellowish tone" and "a sort of pale green with a touch of, but not quite, turquoise", and clearly specify in the application form which part of the product each of the colors will be applied to. Also, color specimen with colors named by reference to Pantone numbers have to be submitted along with the application.

## (c) 3D shape

Pursuant to Article 12 of the PRC Trademark Law, registration shall be refused where a 3D design merely indicates the shape inherent in the nature of the goods concerned. As skin care products are generally kept in either jars or tubes, it is likely that they will be caught under Article 12 and registration may be

refused. In terms of distinctiveness, if the 3D design is only referring to the general shape or wrapping registration would also fail for lack of distinctiveness.

Generally, it is not easy to obtain the registration of 3D mark in China. The authorities tend to apply strict criteria in reviewing the 3D trademark applications. As a result, only limited number of 3D marks can be successfully registered. Also, according to case laws, it may need to take around 5 years for the registration of 3D mark based on acquired distinctiveness.

However, N'Obile can consider modifying the design of the jars/tubes which can make the mark more distinctive and thus the likelihood of successful registration of 3D mark can then increase.

<b>CHINA #2</b>	<b><u>Question 02</u></b> - Provide the specification of the list of goods and services for the trademark application(s).
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The exact classification of the goods and/or services depends on the actual function and content of the product. Under the PRC Trademark Law, each subclass is treated discretely and registration of a class leading is usually not allowed, the trademark has to be registered in sub-class(es) within a class. Since the products involved are related to skin care, cosmetics or toiletries, we would suggest filing a detailed list of goods covering as many sub-classes under Class 3 and Class 5 as possible to increase trademark protection. Also, it is suggested to include peripheral goods and services in class 16, 21 and 44.

With the development of the e-commerce, there is a possibility that the client may open a online shop to sell goods in China. Therefore, we suggest filing the application in class 35 covering “presentation of goods on communication media for retail purposes; sales promotions for others; demonstration of goods.” If the client does not have plan to open the online store, the application could serve for defensive purposes.

The following sub-classes should be applicable:

<b>Class 3</b>	
0301	Skin cleansing towel impregnated with a liquid
0301	Beauty soap
0306	Moisturizing lotion
0306	Styling mousse
0306	Sunscreen lotion
0306	Hair balm

0306	Personal antiperspirant
0306	Conditioner liquid
0306	Hand Cream
0306	Toner
0306	Pomade
0306	After-sun lotion
0306	Body lotion
0306	Hair styling gel
0306	Hair care formulations
0306	Eye liner
030005	Astringents
030017	Shaving soap
030019	Cotton sticks for cosmetic purposes
030020	Beauty masks
030023	Skin whitening creams
030033	Make-up preparations
030052	Mustache wax
030060	Colorants for toilet purposes
030066	Cotton wool for cosmetic purposes
030078	Make-up removing preparations
030096	Depilatories
030097	Depilatory wax
030120	Oils for toilet purposes
030123	Cleansing lotion
030125	Toiletries
030128	Essential oil
030131	Eyebrow cosmetics
030147	Make-up powder

030148	Shaving preparations
030154	Eyebrow pencils
030155	Talcum powder, for toilet use
030162	Antiperspirants [toiletries]
030176	Beard dyes
030200	After-shave lotions
030201	Hair spray
030219	Aloe vera preparations for cosmetic purposes
030220	Massage gels other than for medical purposes
030222	Balms other than for medical purposes
030225	Sunscreen preparations
C030049	Anti-wrinkle cream
C030050	Whitening cream
C030051	Acne cream
C030052	Freckle-eliminating cream
C030053	Prickly heat powder
C030054	Talcum powder
C030055	Prickly heat lotion
C030056	Blusher
C030057	Eye shadow cream
C030058	Hairdressing
C030062	Mousse
<b>Class 5</b>	
050041	Bath preparations for medical purposes
050042	Salts for mineral water baths
050044	Sea water for medicinal bathing

050058	Medicinal mud
050059	Mud for baths
050069	Pharmaceutical preparations
050402	Douching preparations for medical purposes
<b>Class 16</b>	
160007	Posters
160130	Wrapping paper / packing paper
160147	Photographs [printed]
160179	Printed publications
160244	Paper ribbons
160246	Bags [envelopes, pouches] of paper or plastics, for packaging
160351	Paper bows
<b>Class 21</b>	
2110	Lip Brush
2110	Powder box (empty)
210115	Toilet cases / fitted vanity cases
210123	Toilet sponges
210148	Powder puffs
210195	Powder compacts
210331	Abrasive sponges for scrubbing the skin
C210036	Cheek brush
C210037	Eye shadow brush
C210038	Eyelash brush
<b>Class 35</b>	
350092	Presentation of goods on communication media for retail purposes
350071	Sales promotions for others

350023	Demonstration of goods
<b>Class 44</b>	
4401	Dermatology service
440203	Visagists' services

<b>CHINA #2</b>	<b><u>Question 03</u></b> - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.
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Pursuant to the PRC Trademark Law, acquired distinctiveness refers to marks that acquired specific meaning in the market through a long time of using that mark, and the relevant market uses the mark to distinguish its product or service from others, the significance of the mark being the ability to identify the source of the product.

The following can serve as evidence of acquired distinctiveness if N'Obile intends to use acquired distinctiveness as a basis of application:

- The relevant public's recognition of the trademark;
- The actual use of the trademark in terms of time, method and its use in the industry
- Features in using the trademark in production, sales, marking and usage; and
- Other factors that helped the trademark acquire distinctiveness.

The waiting time before being able to file an application based on acquired distinctiveness depends on the extent of marketing effort and sales volume. However, as per case laws, it is suggested that 5 years will be good for registration.

<b>CHINA #2</b>	<b><u>Question 04</u></b> – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).
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The conducting of survey in China is feasible and normally it is the “relevant public” whom should be asked to participate in the survey. The “relevant public” is defined in both the *Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising*

from Trademarks (the “**Interpretation**”), dated October 12, 2002, and the *Provisions on the Determination and Protection of Well-Known Trademarks (2014 Revision)* (the “**Provisions**”), dated July 3, 2014. *Article 8 of the Interpretation* provides that “‘relevant general public’ as mentioned in the Trademark Law refers to the consumers relating to a certain type of commodities or services to which the trademark represents and other business operators that are closely connected with the marketing of the aforesaid commodities or services”; whereas, *Article 2 of the Provisions* provides that “‘relevant public’ include the consumers related to certain kind of commodities or services indicated by a trademark, manufacturers of the aforesaid commodities or other operators providing relevant services, and the sellers and relevant people involved in marketing channels.”

**Question 01** - What trademarks should N'Obile apply for? How should the marks be depicted/described?

## (a) Word mark: N'Obile

If the term "N'Obile" which forms part of client's company name will be used on the products as a brand identifier in order to distinguish its products from those of others, we recommend registering the word mark "N'Obile" if the same will be applied on the products. We do not anticipate any strong obstacles in terms of registrability (such to any prior marks on the Register). If the said word "N'Obile" is used in plain type font and also in a stylized manner, we may file both versions of the mark as a series mark application.

## (b) Colors

The Malaysian Trademark Act 1976 does not specifically include color within the definition of a mark under Section 3(1) of the Trademark Act 1976 (the Act). Registration of a single color has not been accepted and will not be held to be distinctive.

However, color is one of the aspects taken into account in considering whether a mark is distinctive as per Section 13(1) of the Act if it is the case that the mark is so limited in whole or in one or more specified colors.

However, there has been cases of combination of colors being registered in Malaysia. However, such registrations though limited has only been successful after rounds of objections/ written submissions/hearings and submission of extensive evidence of use of the mark and evidence of foreign registrations. Evidence of usage of the color combination in Malaysia on the relevant products will need to be provided and evidence as far back as at least 5 years will be advisable in order to show acquired distinctiveness which will be a determining factor as well. There is no formal requirement to provide color codes in the application to register a color as a mark though the combination of the two-color brown with yellowish tone and pale green represented below will need to be provided in a tangible and legible form.



Apart from evidence of use to show acquired distinctiveness, legal submission of distinctiveness including citation of judicial precedents such as the UK case of **Smith, Kline & French**, where a particular color combination applied to the whole visible surface of the goods in question was registrable will be supportive authority. Evidence of acceptance/registration of prior filings of other combination of color marks on the Malaysian Register would also be persuasive evidence.

(c) Three-dimensional trademarks/Texture marks/2d marks:

In Malaysia, a 'mark' is defined under **Section 3(1) of the Trade Mark Act 1976 ("the Act")** to include "device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof". It has been argued previously that three-dimensional shapes fall under the heading of 'device' within the statutory definition. However, the Trademark Office has taken the position, more so recently that 3d marks are not registrable without specific provisions under the Act which allows for such 3d registrations. Hence, the 3d shape of the glass jar will not be registrable as a 3d trademark. There are also no provisions for texture marks under the Act.

The glass jars and tubes can be considered eligible for trade mark protection as a 2-dimensional mark instead if it is the case that the shape of the jar will be affixed on the product packaging/label.

(d) Industrial Design protection of the shape of the jar

Clients may consider industrial design protection of the three-dimensional features such as the shape and configuration of the jar or the two-dimensional features, such as pattern and ornamentation on the jar. However, it is important for clients to note that industrial design protection only protects the ornamental or aesthetic aspect of the article an article wherein protection is not granted for aesthetic appearances of the article which is not significant or if the design features differs only in immaterial details or based on the design a functional purpose. Further, the design has to be new around in Malaysia and around the world at the time of filing. Hence, clients may consider filing the design of the jar as an industrial design provided the above minimum requirements are met.

**Class 3:**

*skin cleansers; skin soap; antibacterial soap; hand soap; bar soap; liquid soap; cleansing mousse; cleansing gels; cleansing body oil; body wash; body cleansers; bath and shower gels and creams; deodorants and antiperspirants; skin toners; facial polish; body scrubs; facial scrubs; foot scrubs; skin care preparations; skin creams; skin lotions; skin moisturizers; skin gels; skin moisturizing gel; body cream; body oil; body butter; body balms; body lotion; non-medicated skin care preparations, namely for face and body ; skin lotion containing sunscreen; after sun gels, lotion and creams; teeth cleaning preparations; sunscreen cream; shaving gel; shaving foam; shaving balm; aftershave preparations; mouth wash; breath freshener; non-medicated acne treatment preparations; non-medicated bath salts, bath preparations and bubble bath preparations; non-medicated body and foot soak preparations; eye creams, gels and lotions; hair shampoos; hair conditioners; ; hair gels; non-medicated scalp treatment cream; hand cream; nail cream; shaving cream; antiperspirants; deodorants; all included in class 3.*

**Class 35:**

*Retail store services in the field of personal care products and skin care products; on-line retail store services featuring personal care products, and skin care products; retail store services, online retail services, retail catalogue services (including research, consultancy, and providing of information, advice and assistance relating thereto) in respect of skin cleansers; skin soap; antibacterial soap; hand soap; bar soap; liquid soap; cleansing mousse; cleansing gels; cleansing body oil; body wash; body cleansers; bath and shower gels and creams; deodorants and antiperspirants; skin toners; facial polish; body scrubs; facial scrubs; foot scrubs; skin care preparations; skin creams; skin lotions; skin moisturizers; skin gels; skin moisturizing gel; body cream; body oil; body butter; body balms; body lotion; non-medicated skin care preparations, namely for face and body ; skin lotion containing sunscreen; after sun gels, lotion and creams; teeth cleaning preparations; sunscreen cream; shaving gel; shaving foam; shaving balm; aftershave preparations; mouth wash; breath freshener; non-medicated acne treatment preparations; non-medicated bath salts, bath preparations and bubble bath preparations; non-medicated body and foot soak preparations; eye creams, gels and lotions; hair shampoos; hair conditioners; ; hair gels; non-medicated scalp treatment cream; hand cream; nail cream; shaving cream; antiperspirants; deodorants; intermediary services relating to mail order selling by electric communication; business administration of retail and online stores; administration of loyalty schemes and incentives; marketing and promotional activities; information or enquiries on business and marketing; business operation, business administration and office functions; all included in class 35.*

**MALAYSIA**

**Question 03** - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.

Amongst the absolute grounds the Registrar may object to the registration of the mark is that the mark is not distinctive as it consists of a representation which is not registered in a special or unique manner.

**Section 10(2A) of the Trade Marks Act 1976** defines “distinctiveness” as a mark which is “capable of distinguishing the goods/services in respect of which a trade mark is proposed to be registered with which the proprietor of a trade mark is concerned, in the court of trade, from goods/services with which no connection subsists, either generally, or subject to conditions, amendments, modifications, or limitations, in relation to use within the extent of the registration”.

According to **Section 10(2B) of the Act**, in determining whether a trade mark is “capable of distinguishing”, regard may be had to whether:

- “(a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.”

Hence, there are provisions under the Trade Marks Act 1976 which allows marks to be capable of distinguishing the good/services by virtue of acquired distinctiveness. Generally, the evidence taken into account when determining acquired distinctiveness may include the market share held by the Applicant in relation to the business bearing the said mark, how geographically widespread the use of the mark is, how long-standing the use of the mark has been in terms of period of use, amount invested in promoting and advertising the mark, the goodwill and reputation generated in the mark and the business, the proportion of relevant class of persons who, because of the mark, identify the products as originating from a particular undertaking by virtue of the use and recognition of the mark, the well know nature of the mark both locally and internationally. Essentially, clients will have to show that the use of the mark has been continuous, extensive and substantial such that by this use, the public has come to associate the mark to that of the client and none other.

The evidence that may be adduced in order to show that the mark has acquired distinctiveness are as follows:

- (a) Date of first use of the mark in Malaysia in order to show priority in terms of use of the mark and that use of the mark has been long standing.
- (b) Date and place of first use anywhere in the world which will help show that the mark has become recognized and associated to the Applicant by virtue of use of the mark overseas, thus becoming well known amongst the public in Malaysia.
- (c) A sampling of copies of invoices, delivery orders, bills, debit notes, shipping and customs documents and any other documents evidencing sale of products/services bearing the mark in Malaysia in order to show the manner of use of the mark and how the products bearing the mark is circulated/ distributed and offered for sale.
- (d) Yearly sales figures of the products/services bearing the mark since first use of the mark in Malaysia. If the figures for Malaysia are insignificant or not available, worldwide figures may also be furnished.
- (e) Copies of promotional materials and advertisements in Malaysia for at least a period of 3 to 5 years prior to the application date of the mark including press releases, newspaper and magazine advertisements, website link of the Applicant's website with copies of pages on the website and photographs of the physical stores where products are offered for sale.
- (f) Yearly advertisements and promotional expenses since first use of the mark in Malaysia together with a sampling of the invoices for these expenses. If the figures for Malaysia are insignificant or not available, worldwide figures may also be furnished
- (g) Knocked-down cartons or cardboard/paper/plastic packaging of reasonable size, depicting the trade mark
- (h) Geographical use/location and distribution network of the products including listing of outlets/distributors etc. in order to show extent of circulation of products
- (i) Any other useful information or material which indicates public awareness of the mark.

In addition, the following supporting documents will be useful:

- (j) Copies of registration certificates and/or gazette advertisements of the mark in other classes in Malaysia which will help support arguments that the mark.
- (k) Copies of registration certificates and/or gazette advertisements for the mark from other countries, in particular Commonwealth countries such as United Kingdom, Australia and Singapore.

**MALAYSIA**

**Question 04** – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).

Survey evidence may be accepted in Malaysia and can be useful in demonstrating the acquired distinctiveness of a mark. However, its probative value will depend on the integrity of the data and the manner in which it is collected. There is no specific legislation issued in Malaysia for market survey evidence however we may be guided by Malaysian cases which makes mention of the same including UK case law. In a market survey, interviewers should be asked to participate in the survey should be representative of the relevant cross-section of the relevant public which could be potential and actual customers. In this matter, the relevant cross-section of the public would not just be male participants as this product may be bought by spouses, mothers etc. for their spouse, sons etc. The questions should also be formulated in such a way that it should not consist of leading questions. Survey evidence is only likely to be useful to the client when their mark has been used for sufficient time for the public to have recognition of them. In this case, the survey evidence may be sought in relation to the application for the color combination mark in order to ascertain whether the two-color combination as used on the Applicant's products has acquired distinctiveness though it is essential that the two-color combination mark has been used consistently on the packaging for an extended period of time.

**Potential survey questions:**

In the course of the survey the two-color combination needs to be shown to the public and the initial questions that may be posed to them is whether they buy skin care products. If so, whether the color combination relates to any skin care range for men and women and whether the colors indicate any specific brand that comes to mind or any specific company.

**Question 01** - What trademarks should N'Obile apply for? How should the marks be depicted/described?

Applications to the Intellectual Property Office of New Zealand (**IPONZ**) to register the following trademarks should be filed:

The word "N'Obile" along with the word "N'OBILE", as a series of trade marks.

The colours Green and Brown, as applied to the visible surface of the jar (a first application) and the tube (a second, separate application).

In each case, the trade mark should be described as follows and a representation showing the jar or tube should accompany each application.

*"The mark consists of the colours green (Pantone number xxx) and brown (Pantone number yyy) applied to the entire visible surface of the container for the goods in the manner shown in the representation attached to the application, the colour green being applied to the entire surface area of the body of the container and the colour brown being applied to the entire surface of the cap of the container".*

The coloured jar with the word "N'Obile" as embossed or engraved on the actual jar.

The coloured jar with the word "N'Obile" as embossed or engraved on the actual tube.

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Registered trade mark protection for the textured caps could readily be obtained for the "look" of the textured cap, for example as a part of marks of the type described at (c) and (d) above.

However, while there is no theoretical bar to registering a "touch" mark to protect the "feel" of the textured caps here, in practice it is likely to be difficult to obtain a registration for *'the natural feel of leather'*.

Texture or touch is not one of the signs listed in the definition for a sign in the Trade Marks Act. However, the definition is inclusive. A texture that is capable of being represented graphically, is capable of distinguishing the goods of one person from another, and is distinctive could be registered.

The main challenge in applying to register such a mark will be to describe the touch or feel in a manner that is sufficiently clear and certain.

The difficulty will then be in convincing IPONZ that the trade mark is distinctive. The natural feel of a leather top or lid is unlikely to be considered inherently distinctive.

Even with evidence the texture/touch mark has been used, there are likely to be significant difficulties in convincing IPONZ that a leather-feel lid or top is functioning, and is recognised by consumers, as a trade mark.

There does not seem to be anything special about the jars or plastic tubes that suggest a shape trade mark is a worthwhile option. N'Obile could consider developing a distinctively shaped bottle or tube.

**NEW ZEALAND**

**Question 02** - Provide the specification of the list of goods and services for the trademark application(s).

We suggest applications are filed in the below classes:

**Class 3**

*Non-medicated skin care products and preparations; after shower lotions; antiperspirants (toiletries) including deodorants, antiperspirant soap; essential oils including aromatics; hair care preparations, including shampoo and conditioners; beard dyes; hair colourants, hair dyes; hair lotions, hair wax, hair gel; boot cream and boot polish, shoe cream, shoe polish and shoe wax; breath freshening sprays and strips; mouth washes (non-medicated); dentifrices, dental bleaching gels, preparations for cleaning dentures; foot care preparations including soap for footwear perspiration; lip balm (non-medicated); shaving preparations including shaving soap; eau de cologne; soap; sunscreen preparations (non-medicated); sun-tanning preparations (non-medicated); talcum powder for toilet use; depilatory and exfoliating preparations.*

**Class 5**

*Medicated skin care products and preparations; lip balm.*

**Class 35**

*Retail and wholesale services, namely services related to the sale of men's toiletries, skin care, body care and hair care products and preparations; administration, marketing and management services; administration of incentive and loyalty schemes.*

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IPONZ does not require a narrow and precise description of the goods to be used but will not allow an unduly broad description of the product or services. A balance must be struck to find a fair description of the goods. This is a question of fact and degree.

A specification of goods can be restricted during the examination process. The specification cannot be expanded. Accordingly, erring on the side of a more general description initially is to be preferred.

For a trade mark that is inherently distinctive IPONZ will allow a general description of goods and services. It is a requirement that the applicant uses or intends to use the marks on the goods and services as at the application date. For trademarks that are accepted on the basis of factual distinctiveness IPONZ limits

the description of goods or services to the goods or services on which/in respect to which the mark is used. Factual distinctiveness will not be proved for the goods or services the applicant intends to use the mark on in the future.

Ultimately, the evidence filed about the type or range of goods will determine the final form of the specification.

<b>NEW ZEALAND</b>	<b>Question 03</b> - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.
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Trade marks (a), (c) and (d) should all qualify for registration as inherently distinctive as they each consist of, or include, the word N'Obile. However, IPONZ is reluctant to register colour marks in the absence of evidence of acquired distinctiveness.

IPONZ will infer distinctiveness from the extent a trade mark has been used. Only evidence relating to the period prior to the application date will be considered by IPONZ when assessing factual distinctiveness. Factors IPONZ will consider include:

- a. The New Zealand market share held by the mark.
- b. Duration. When was the mark first used in New Zealand? Has there been continuous use since that date up until the date of application?
- c. Geographical extent of use. Nationwide or just in specific regions of New Zealand?
- d. Sales values and sales volume. Annual figures are preferred and typically for at least the three-year period preceding the application date.
- e. Promotional and advertising expenditure. Annual figures are preferred and typically for at least the three-year period preceding the application date.
- f. Details of New Zealand trade channels.
- g. Details of use and promotion of the trade marks on the internet and social media accessible by New Zealanders.
- h. References and reviews of the product in the New Zealand media or publications distributed/circulated in New Zealand.
- i. Statements from New Zealand industry, trade or professional associations (e.g. Chambers of commerce, regulatory bodies) commenting on how the trade mark acts as

an indication of source.

- j. Supporting declarations from New Zealand-based retailers, wholesalers or consumers.
- k. Examples of the trade mark in use in New Zealand.

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There is no prescribed time before a trade mark is considered factually distinctive. However, typically IPONZ prefers the applicant to show at least three years' use. However, it is a fact driven determination. A major nationwide publicity campaign may see the mark becoming distinctive in a relatively short period of time. If the trade channels are limited, and market penetration and publicity is small, it may require more than three years.

The applicant could assist its position by advertising and promoting the products as much as possible. That advertising should specifically emphasise the colours or leather caps as a trade mark and explicitly educate the consumer to the trade mark significance through statements, tag lines and promotions. For example, *"You know it's N'Obile by the leather top"* or *"Brown and green for that N'Obile clean"*.

The position is the same for a texture/touch mark. The applicant could take steps to positively educate consumers of the trade mark significance of the texture through advertising and promotion.

<b>NEW ZEALAND</b>	<b>Question 04</b> – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).
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Market survey evidence directed at establishing factual distinctiveness of a trade mark is used and admitted in trade mark cases before the IPONZ and the New Zealand courts. Increasingly the methodology of the survey is being rigorously scrutinised by IPONZ during examination, and the methodology of the survey will almost definitely be challenged when an application is opposed or a matter gets before the courts. The admissibility and how persuasive a survey depends on how rigorously it has been conducted.

At the least, the survey needs to be targeted to the relevant consumer universe and the precise instructions on how the survey is conducted need to be disclosed and followed.

For the N'Obile products the end-users are men but purchasing consumers will not be limited to men. Accordingly, limiting a survey to men may not include all relevant consumers. To submit survey evidence

limited to an exclusively male panel risks also focussing IPONZ or the courts on restricting the description of goods in the specification to 'men's' goods, rather than a more neutral or non-gender specific description that would be of advantage for later infringement claims.

The issues around framing and conducting a robust market survey need careful consideration. Care needs to be taken to ensure questions are clear and non-leading. This can present difficulties for colour trademarks. Engaging an appropriate expert to design and administer an appropriate survey is highly desirable. It is also desirable to have expert opinion evidence on the conclusions that can be drawn from the results of the survey. As such, it is not appropriate to propose three questions here that will meaningfully give rise to a robust result.

We understand that N'Obile is planning to launch a skin care product for men in jar and tube packaging with color combination of brown and soft color pale green. We would recommend filing some applications as below:

- (a) Word mark for the product name.
  - (b) Product label with the product name.
  - (c) Color combination.
- (a)
- (b)
- (c) A color combination can be registered as a trademark in Indonesia. It is possible to have a color combination filed as blocks of colors. However, the scope of protection is still rather unclear – whether a combination of color (when represented on the certificate in the block form) extends to the color composition as applied to a packaging that may not be necessarily in the block form. There is no field for stating “claim language” on how the color combination is to be applied. Specific pantone colors can be mentioned on the color specification field.

Our advice is that you should try to file the mark considering this is possible and you will likely find lookalikes in the market.

- (a) 3D application for jar and tube.

Based on Indonesian Trademark Law, protected Marks consist of signs in the form of drawing, logo, names, word, numeral, color arrangement, in 2 (two) and/or 3 (three) dimensional shape, sound, hologram, or combination of 2 (two) or more of those elements to distinguish goods and/or services produced by a person or legal entity in trading of goods and/or services.

The Indonesia Trademark Office has been accepting registration for 3D and shape marks. If your product packaging (Jar and Tube) are distinctive, we would recommend filing 3D trade mark applications.

A registration is likely to be of some deterrent value against imitating your 3D design. This is especially

the case in Indonesia where the law on unfair competition is underdeveloped and very weak at trade dress protection and slavish imitation.

A plain jar and tube may be considered descriptive given that jar and tube are common to be used as packaging for skin care products. We would recommend adding the word mark N'OBILE in the 3D application to avoid rejection based on descriptiveness.

We would also recommend filing the 3D mark in color as it is intended to use - this will also show the proportion of the two colors.

**INDONESIA**

**Question 02** - Provide the specification of the list of goods and services for the trademark application(s).

The following are suggested class and goods specification:

**Class 3:**

*Cosmetics; skin care preparations; skin care products; soaps; hair lotions; creams for skin care; face and body creams; lotions for skin care; skin cleanser; shampoo; skin moisturizing preparations.*

**Class 35:**

*Retail and wholesale services, including online retail services.*

The above proposed goods specification would allow future development of the product range for men skin care product.

We did not include class 5 as skin care product does not contain medicated substance; please confirm if it is the contrary.

**INDONESIA**

**Question 03** - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.

There are no formal requirements with respect to submission of evidence of acquired distinctiveness at the time of filing of the application or post filings. As there are no formal requirements, any forms of evidence (evidence on the continuous use of the mark at covering a long period of time and a wide area of geographical indication; survey) that enable the application to prove acquired distinctiveness may be useful. As discussed above, you may consider adding word elements into the 3D mark, to avoid rejection.

**INDONESIA**

**Question 04** – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).

The Trademark Law does not recognize surveys on trademark registration process. There is no formal avenue to submit a survey.

**1. What trademarks should N'Obile apply for?**

N'obile should apply to register the following marks at the Intellectual Property Office of Singapore ("IPOS"):

- (a) A word mark for the word "N'Obile";
- (b) Shape marks for the shape of the tubes, jars and packaging (the "**Shape Marks**");
- (c) A colour mark for the brown and pale green used on the jar, tubes and packaging as individual colours; and
- (d) A colour mark for the combination of brown and pale green used on the jar, tubes and packaging.

**2. How should the marks be depicted or described?**General guidelines

Section 2(1) of the Trade Marks Act (Cap. 332) (the "**Act**") provides that a trademark must be capable of being represented graphically. To this end, the sign must be able to be represented visually, by means of images, lines or characters, so that it can be precisely identified. The mark must also be presented in a way that is "*clear, precise, self-contained, easily accessible, intelligible, durable and objective*" (*Ralf Siekmann* (Case C-273/00)).

- (a) The Shape Marks

According to the Trade Marks Work Manual, the representation of a shape mark should, where practicable, be in the form of a perspective or isometric drawing that shows clearly all the features of the shape mark. The parts of the configuration claimed to constitute the shape mark should be shown in solid lines, while the unclaimed parts should be shown in broken lines.

- (b) Colour mark for the brown and pale green used on the jar, tubes and packaging as individual colours

In this regard, guidance provided by the Trade Marks Work Manual on the requirements for graphical representations of colour marks is helpful and is quoted in full:

*“Where the trade mark consists solely of colour(s), a sample of the colour(s) is required to be lodged with the application. In addition, the Registrar recommends that the applicant includes a designation from an internationally recognised identification code where the colour or shade exists in the coding system. However, the failure to indicate such a designation on the application form will not result in the application being denied a filing date.*

*There are a number of colour code identification systems in existence e.g. Pantone®, RAL and Focoltone®. It is not an exhaustive list and it is the choice of the applicant to decide which system to use.*

*An appropriate description should also be included in the application form to indicate whether the mark consists of the colour(s) applied to the goods or their packaging or to other commercial item. Where colour is applied to the whole (or substantially the whole) surface of the object in question, a statement in words to this effect will suffice. In other cases, a picture or diagram may be necessary to identify the area(s) of the item to which the colour(s) is/are applied. Example:*

*“The trade mark consists of the colour green (RAL \_\_\_\_), applied to the cap of a container as shown in the representation on the application form.”*

*Note: A claim for colour as “an essential element” is unacceptable terminology as it neither restricts the trade mark to colour, nor gives any useful information as to the use of the colour within the trade mark.” (emphasis added)*

- (c) Colour mark for the combination of brown and pale green used on the jar, tubes and packaging.

In relation to the graphical representation of a combination of brown and pale green as a trademark, the Trade Mark Work Manual, citing *Heidelberger Bauchemie GmbH* (Case C-49/02), provides that:

*“a graphic representation consisting of 2 or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way. The mere juxtaposition of 2 or more colours, without shape or contours, or a reference to 2 or more colours “in every conceivable form”... lacks precision and uniformity. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.”*

It was further noted that:

*“If the distinctive character of the mark used by the applicant depends in part on other factors, such as a specific arrangement of colours or the manner of application of colour(s) to goods and he did not make that clear in his application form, it will not be possible for him to amend his application later on to include such claims since such an amendment would affect substantially the identity of the mark sought to be registered”*. (emphasis added)

**3. Please include information on what would or would not be enforceable**

There is a small chance the “N’OBILE” word mark will be unenforceable for the following reasons.

First, there is a small possibility of the “N’OBILE” word mark being deemed to be descriptive since “N’OBILE” might have been derived from “Nobile”, an Italian title of nobility ranking between that of knight and baron.

The Trade Marks Work Manual lists several principles for assessing if a mark is exclusively descriptive. The principles are:

- (a) A mark is to be assessed as a whole;
- (b) A mark is descriptive if one of its possible meanings is capable of designating a characteristic of the goods or services. In other words, the mark might be found to be descriptive as long as one of its possible meanings is descriptive of the goods and services;
- (c) A mark is not descriptive if it alludes to attributes but yet does not speak of a specific and objective characteristic of the goods or services. For example, a mark which consists of laudatory elements or attributes which do not inform the consumers of specific and objective characteristics of goods or services is not descriptive; and
- (d) A mark is descriptive if it consists of a word or neologism composed of elements, each of which is descriptive of the characteristics of the products or services, unless there is a perceptible difference between the word or neologism and the mere sum of its parts.

On the facts, an allusion to the high quality of the cosmetics by association with royalty is likely to be considered a laudatory term that is not descriptive in this case.

Further, we note that in the “N’obile” word mark, there is an embellishment on the root word “Nobile”. As the client’s application is for the word “N’Obile”, where the root word “Nobile” is divided into two with an apostrophe, the proposed mark is distinguishable from the descriptive term “Nobile”.

Secondly, we caution that Section 28 of the Act provides that a person does not infringe a registered

mark when he uses his name or the name of his place of business. We note that Nobile is used as a name. Accordingly, the “N’obile” word mark might be subject to the ‘own name’ defence in Section 28.

We would also caution that the N’obile word mark might face opposition on the ground that it bears a passing similarity to an earlier word mark “ACQUA DI PARMA ACQUA NOBILE” which is registered in Class 3 for, *inter alia*, “soaps; perfumery, essential oils; cosmetics, hair lotions”. However, we believe that N’obile should be able to overcome such an opposition if it arises.

Potential problems of enforceability relating to the Shape Marks and the proposed colour marks for the colours used for the jar, tubes and packaging are discussed below in our answers to Questions 6, 9 and 11.

**4. If you suggest several applications, please clarify which option would provide the client with the greatest protection.**

The word mark and device mark (if any) would provide the client with the greatest protection because:

- (a) a word or device mark would be more easily registered *vis-à-vis* the other non-traditional marks suggested as it is less likely to face objections based on the lack of distinctiveness of the marks; and
- (b) a word or device mark would be more easily enforced.

**5. Please explain if the protection of abstract colour marks is possible in your country**

The protection of abstract colour marks is possible in Singapore.

Mark consisting of a single colour

Single colour trademarks are registrable under the Act. However, the registrability of a particular mark depends heavily on how it looks applied to the goods. A key consideration is whether the colour is inherently distinctive, or has acquired distinctiveness through use. It is difficult to consider/explore this option without having sight of the goods.

Mark consisting of a combination of two or more colours

According to the Trade Marks Work Manual,

*“the combination of two or more colours may be registrable prima facie depending on how unusual the colour combination is in relation to the goods and whether, prima facie, the combination is likely to strike the relevant consumer as an indication of trade source. This would also involve a consideration of whether the colours serve a function or is common in the market place or relevant trade”.*

**6. Please outline if there are differences with regard to acquired distinctiveness if a single colour mark or if the combination of two colours is applied for.**

There is no guidance as regards the differences with regard to the acquired distinctiveness of a single colour mark and a combination of two colours.

However, a single colour mark is likely to face greater difficulty in establishing that it has acquired distinctiveness. A mark is registrable under section 7(2) of the Act if the applicant can show that the mark has in fact acquired a distinctive character as a result of the use made of it before the date of registration. According to the Trade Marks Work Manual, the evidence required to establish if a mark is factually distinctive will be proportionate to the strength of the *prima facie* objection raised in the trademark application. The strength of the objection raised in the trademark application would possibly be stronger in the case of a single colour mark as compared to a combination of two colours since a single colour is less likely to be identified with the minds of the public with a particular trader's goods and services as compared to a combination of colours.

**7. If you have advised filing a colour mark consisting of two colours please outline if you recommend including the percentage of the two colours**

There is no guidance as to whether it is necessary for the percentage of the two colours to be included. An examination of the existing registered multi-colour marks indicates that this is not a requirement. A possible reason why the indication of the percentages of the two colours is not a formal requirement might be because graphical representation submitted to the Registrar already indicates the rough proportion of each colour.

If the indication of the relative percentages of colour is not a requirement, it is not recommended for the said percentage to be included. This might unnecessarily limit the use of the trademark to the ratio of colours filed with the mark, if the Registrar were to consider the percentage of the colours as a feature of the mark.

**8. Please include information whether colour codes (Pantone, RAL etc.) should be used**

As with any trademark application, the principles of graphic representation must be clear. The applicant should file the colour combination in the form used with the Pantone references and a description. For example, *"The trade mark consists of the colour brown (RAL \_\_\_) applied to the cap of the container for the goods in combination with the colour green (RAL \_\_\_) applied to the container of the goods as shown in the representation on the application form."*

A representation of the jar, tube and packaging should be included in the application for the avoidance of doubt.

**9. Please advise if you recommend filing 3D trademarks for the tube and the jar, showing the combination of colours if the applications for the colour marks are being refused for lack of distinctiveness**

As a preliminary point, 3D products and packaging can be registered as 2D marks as long as there are clear representations filed. However, the registrability of the Shape Marks will depend on whether the designs are inherently distinctive, which may not be in this case.

We note from the factual background given that the tube, jar and packaging do not have inherently distinctive shapes. Thus, unless N'obile can prove that the Shape Marks have acquired distinctiveness through use, we would advise against filing a trade mark application for the Shape Marks alone. In such a case, we would recommend showing the combination of colours in the application of the 3D trademark. The addition of the colours could increase the distinctiveness of the 3D trademark such that it would be able to act as an indication of origin. Please refer to our answer to Question 11 below for more details.

Assuming the Shape Marks have acquired distinctiveness, we would not recommend showing the combination of colours in the application for the 3D trademark as doing so would limit the colours protected by the registration. According to the Trade Marks Work Manual, if a coloured representation of a mark is attached to the application form, the Registrar will treat the colours as a feature of the mark. In other words, the mark is only protected in relation to the colour(s) submitted to the Registrar. If the representation of the mark were submitted in black and white, any use of the mark in any colour without consent would be deemed to be infringing use provided that the template or pattern of the mark has been registered. Therefore, if the 3D trademark is distinctive, the addition of the colours to the trademark application would limit the protection of the trademark to those colours. It would be preferable to file the 3D trademark in black and white.

**10. Please provide your thoughts on the registration of a texture mark.**

The registration of a texture mark is not expressly excluded by the Act or any case law but such a registration is yet unheard of in Singapore.

Our view is that whilst a texture mark is technically registrable, it might be difficult to prove that that it is capable of distinguishing goods or services, unless the texture is particularly unique or distinctive.

**11. Should the client file for the shape alone or combination of shape, name, logo, and colour?**

There is no hard and fast rule on whether a client should file for a combination of shape, name, logo and colour. However, in the present case, a combination of shape, name, logo and colour might be necessary

as the client is unlikely to succeed by filing for a shape of the jar, tube or packaging alone.

As discussed above in our answer to Question 9, the tube, jar and packaging do not have distinctive shapes. Accordingly, they may not be registrable as a trademark under section 7(3)(b) of the Act. Shapes which are merely functional *i.e.* motivated by and are a result of technical considerations, are not registrable.

We would recommend that the client file for a combination of shape, name, logo and colour in order to increase the trademark's distinctiveness and hence increase its chances of obtaining registration.

Alternatively, we would also recommend that the client incorporates a major non-functional element, such as an imaginative element which plays an important role in the shape, since the Trade Marks Work Manual has provided that non-distinctive shapes may be acceptable on the basis that other (non-shape) distinctive elements are used in combination with the shape, if it is "*immediately apparent in the representation that the distinctive elements make up an essential or prominent part of the mark*".

**12. If you advise filing a 3D trademark for each colour please explain further what combination of form and colour shall be applied for (considering that the products will actually be used combining both colours).**

Assuming that the 3D trademark is not sufficiently distinctive, registrations should include the:

- (a) combination of pale green and brown as applied to the jar;
- (b) combination of pale green and brown as applied to the tube; and
- (c) combination of pale green and brown as applied to the packaging.

This will increase the distinctiveness of the mark taken as a whole and would offer protection for the anticipated uses of the mark by the client.

**13. Please provide a strategy on whether both the jar and the tube shall be protected.**

As discussed above in our answers to Question 9 and 11, the tube, jar and packaging do not have inherently distinctive shapes and hence would not be *prima facie* registrable. Hence, a possible strategy would be to file for a shape mark of the jar and the tube in combination with the name, logo and colours of the client. Please refer to our answer to Question 11 above for more details.

**14. If you advise filing a 3D trademark including colour please outline what the scope of protection of such an application would be for the colours.**

Where the 3D trademark simply incorporates the colours, the Registrar will treat the colours as a feature of the trademark *i.e.* only the colour in the graphical representation filed with the Registrar is protected.

The scope of protection for colours in such an application could also depend on whether the applicant files for a colour limitation, which limits the right in the trademark to particular colours stated in the application. Colour limitations are done on a voluntary basis by the applicant.

**15. Do you have any suggestions to modify the product design?**

In relation to the registrability of a shape mark for the product, we suggest the client modify the design of the product by adding a major non-functional element to the shape of the product. This would increase the probability of a successful registration of a shape mark.

<b>SINGAPORE</b>	<b>Question 02</b> - Provide the specification of the list of goods and services for the trademark application(s).
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**16. Suggested List of Goods and Services**

**Class 3**

*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, hair lotions; dentifrices; non-medicated skin care preparations; essential oils; shaving preparations; aftershave creams; anti-ageing creams; face creams; foot care preparations; nail care preparations; hair care preparations; shampoos; hair conditioners; hair colouring preparations; cleaning preparations for the teeth; mouth wash; breath freshener; suntanning and sun care preparations; sun screening preparations; aftersun preparations; skin bronzing preparations; soaps; shower gels and creams; antiperspirants; deodorants.*

**Class 5**

*Pharmaceutical products; medicated skin care preparations; powders for skin care (for medical use); skin care oils (medicated); natural body care products (medicated) for skin; sanitary preparations for medical purposes; bath preparations, medicated; creams, gels, milks, lotions, serums and pomades for medical purposes; dermatological pharmaceutical products; preparations for skin care; sun blocking preparations for medical use; herbal preparations for medical purposes; medicinal herbs.*

**Class 35**

*Advertising; business management; business administration; office functions; retail and wholesale services all connected with the sale of non-medicated skin care preparations, essential oils, shaving preparations, aftershave creams, anti-ageing creams, face creams, foot care preparations, nail care*

*preparations, hair care preparations, shampoos, hair conditioners, hair colouring preparations, cleaning preparations for the teeth, mouth wash, breath freshener, suntanning and sun care preparations, sun screening preparations, aftersun preparations, skin bronzing preparations, soaps, shower gels and creams, antiperspirants and deodorants; marketing services; product marketing; promotional marketing; organisation and management of business incentive and loyalty schemes; administration of the business affairs of retail stores.*

**17. If your list includes “retail services” in Class 35 please clarify the reason for this.**

Class 35 services include:

“Advertising; business management; business administration; office functions”

Class 35 is included for strategic reasons. The client will be protected in the event that it decides to expand their scope of business from manufacturing of cosmetics to include the retail of cosmetics.

Class 35 is also included for cost-saving reasons. The client would not have to incur the costs of filing a fresh application should they decide to expand their scope of business from the manufacturing of cosmetics to include the retail of cosmetics. An application for a trademark cannot be amended such that it extends the goods or services covered by the application (section 14(3) of the Act). The alteration of a registered trademark is limited to the alterations of the name or address of the proprietor provided it does not substantially affect the identity of the mark (section 20(2) of the Act). If the client decides to expand their use of the trademark into retail services, a fresh trademark application is required, resulting in increased costs. By including Class 35 in the initial application, a fresh application would be unnecessary in such an event.

**18. Please note that “cosmetics” shall not be used as a term. Please suggest alternatives if you have used this term.**

We did not use the term cosmetics.

**19. Why a detailed list of products was chosen**

A detailed list was chosen to ensure that the client will be better able to succeed in an argument/opposition/invalidation on the basis of similar or identical goods.

**20. Why Class 5 was included in the list of goods and services.**

Class 5 was included for reasons similar to the inclusion of Class 35, namely, cost-savings and strategic reasons. Please refer to our answer to Question 17 above.

In addition, Class 5 contains goods which potentially overlap with the client’s skin care products, for example, “medicated skin care preparations; powders for skin care (for medical use); skin care oils

(medicated); natural body care products (medicated) for skin". Trademark protection for the N'Obile marks should be extended to the said goods.

<b>SINGAPORE</b>	<b>Question 03</b> - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.
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**21. Could the mode of distribution have an impact on the distinctiveness and which one?**

There is no guidance given on whether the mode of distribution can have an impact on either acquired or inherent distinctiveness.

The mode of distribution could have an impact on acquired distinctiveness to the extent it affects the relevant factors considered in the determination of acquired distinctiveness in Singapore. These include the extent of use (turnover) and advertising expenditure in relation to the goods and services claimed. For example, if N'Obile products are distributed with an exclusive licence with a particular luxury outlet, it is likely that turnover and advertising figures would be less as compared to the situation where N'Obile products are distributed via luxury outlets in general.

**22. How could the client improve distinctiveness or recognition?**

The client can do the following:

- (a) Use the trademark as a means of identifying the trade origins of their goods extensively; and
- (b) Promote the trademark as a trademark extensively.

**23. Please advise how long the client should wait before being able to file an application based on acquired distinctiveness**

Five years pre-filing use with strong sales is usually required. Extensive use over a shorter period may also be sufficient, although use of the mark for less than 2 years prior to filing is very unlikely to be considered to be sufficient.

**24. Please provide information on what evidence of acquired distinctiveness is specifically required**

Types of evidence required to establish acquired distinctiveness

- (a) Sales figures, copies of invoices (dated) and stats showing market share – the volume and value of sales and market share held by the mark for a minimum of 5 years before the application date.

- (b) Printed matter used for promotions, sample adverts, brochures, and look books distributed in Singapore prior to the date of filing showing products which clearly show the particular mark in question. It is essential to be able to demonstrate that these examples have actually been used/distributed/sold in the relevant territory. Accordingly, it is also necessary to have details of how and to whom the promotional material was distributed, and any other relevant details regarding their use.
- (c) Packaging samples/photographs of packaging if they show pictures of the marks.
- (d) Geographical spread and period of use – details of the outlets in locations all around Singapore should be given to demonstrate that sales of products bearing the marks are geographically widespread throughout Singapore.
- (e) Advertising and promotional examples and spending – i.e. any spending on advertising and promotion in Singapore directed at goods specifically bearing the mark or marks over a period of at least 5 years.
- (f) Television, internet, website advertisements run in Singapore prior to the date of filing; details of the channels on which the advertisements were run; when and how many times the advertisements were run; any market research on the exposure of the television advertisements (*e.g.* an estimated figure for the number of people who saw the advertisements).
- (g) Posters and billboards showing the prominent use of the marks displayed in Singapore prior to the date of filing with details of how many posters/billboards were displayed, the location, and period of display; and any market research on the exposure of this sort of advertisement (*e.g.* if in a shopping mall the average daily/weekly footfall).
- (h) Photographs of shop displays and window displays showing the products in Singapore.
- (i) Press articles – examples of independent press articles which make reference to the marks; as well as details of N’Obile’s own press releases referring to the marks with details of where and when the press releases were issued.
- (j) Survey evidence – see our answer to Question 25 below.

- (k) Other third party evidence – evidence from independent third parties can have much greater weight than evidence from the applicant. It would therefore be very useful to obtain evidence from authorised retailers who stock the products featuring the relevant marks.

**Note** – The evidence must relate specifically to Singapore and be clearly identified as used in Singapore *e.g.* showing prices in SGD.

<b>SINGAPORE</b>	<b>Question 04</b> – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).
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Survey evidence is acceptable in Singapore. Survey evidence can be very useful to demonstrate acquired distinctiveness of a mark. From the client’s perspective, this is only likely to be useful when they have used their marks for enough time for the public to have some recognition of them. Before the product is launched, this will be of no use.

## 25. Factors to consider when examining survey evidence

a) How interviewees are chosen

The survey should reveal the criteria for selecting the interviewees. For example, if they are selected to represent a cross section of the relevant industry or consumers, such evidence would definitely be more persuasive in value.

b) Number of interviewees surveyed

The evidence should reveal the number of persons issued with questionnaires or otherwise invited to take part in the survey.

c) Total number of participants

The survey should confirm that the number of responses submitted to the Registrar correspond with the total number of those who had indeed responded to the survey.

d) Questions in the survey

The survey questions should be phrased in an open-ended manner. Well-conducted surveys in which the questions are relevant and not leading and the sample interviewed is properly chosen will be more persuasive.

Open-ended questions like “What does this sign mean to you?” or “Are you able to identify this sign?” are preferable to leading questions like, “Do you regard this sign as a badge of origin for the applicant’s goods?”

It should be clear from the survey whether participants show recognition of the product or recognition of the sign as a trade mark as a result of use.

**e) Representation of mark used in survey**

The survey should include a copy of the mark used in the survey and this should correspond to the mark as filed.

**f) Exact answers from the interviewees**

The survey should disclose the exact answers from the participants in order to get the full picture and not a rephrasing or interpretation of the answers solicited. Complete disclosure of all results, including any that are not favorable, should be presented in the evidence.

**g) Location and instructions of survey**

The place where the survey was conducted, and the exact instructions given to interviewers should be presented.

**h) Balance between strength of evidence and strength of objection**

The amount of evidence sufficient to prove factual distinctiveness will be proportionate to the strength of the objections raised by the Registrar. Hence, the Registrar will not specify any benchmark that must be attained for any survey result.

**i) Other traders using the same sign**

Where the survey evidence shows that a fair percentage of people associate the applicant’s mark with another trader, it may reveal that other traders are also using the same sign as the applicant. If such a conclusion is drawn, even 90% recognition in a survey may not be enough.

**j) Date of survey**

The Registrar will give little weight to the survey evidence if the period of use before the date of application is relatively short and a long period has elapsed between the date of application and the date of survey.

**k) Participants should be the relevant public**

The relevant public is deemed to be average consumers of the particular category of products

concerned and the average consumer is deemed to be “*reasonably well informed and reasonably observant and circumspect*”. It is usually relatively straightforward to assess who the relevant public is. If the mark covers mass consumer goods such as foodstuffs, clothing, *etc.*, the applicant will have to prove that the general public as a whole, or at least a substantial part of it, recognises the sign applied for as a mark. If the goods/services are addressed to a specialist public, say, surgeons active in a specific medical area or a specific sector of a trade such as wholesalers, evidence need generally only relate to the limited public.

**26. Consumers who will be asked to participate in the survey**

Participants in the survey should be a cross section of the relevant public. Please refer to our answer to Question 25 above for what constitutes the relevant public. If the client’s products are bought by female consumers for the male members of their family and friends, then females should be included in the survey sample.

**27. The three main questions that would be asked in the survey**

The main questions to ask in a survey will depend on the mark applied for.

Survey questions for the jar/tube/packaging designs as trade marks

When asking these questions, the participant should be shown an image of the mark as applied for:

1. What does this sign mean to you? Why do you say that?
2. Are you able to identify this sign? [If yes] Which one? Why do you say that?

Survey questions for the colour trade marks

Participants should be shown a piece of paper showing the two exact colours applied for:

1. What does this sign mean to you? Why do you say that?
2. Are you able to identify this sign? [If yes] Which one? Why do you say that?

**28. Please advise if you think that the results of the survey would be more convincing to a trademark office and/or the court if it had been focused on males only**

The results of the survey would likely be deemed less convincing to the trademark office and/or the court if it had been focused on males only. Participants of a survey should consist of the relevant public, which are average consumers of the particular goods and/or services. In the present case, consumers (*i.e.* buyers, as opposed to users) of the product include females buying the products for their male friends

and family. By focusing on males, the survey would not have captured the responses of the relevant public, and would therefore be less convincing.

Trade marks of interest

- (a) N'Obile [word mark]
- (b) Jar with coloured glass pattern & brown leather jar lid [Composite shape and colour mark]
- (c) Tube with coloured pattern & brown leather tube cap [Composite shape and colour mark]

### **Colour trade marks**

A colour, either by itself or in combination with other features may be used as a trade mark. A trade mark may consist of a colour or combination of colours applied to the goods [e.g. jar, tube, shape] or the packaging.

A trade mark application for a colour or combination of colours must include a clear and concise description of the trade mark as an endorsement to the application.

An example of the actual colour or colour combination must be supplied in all cases (Part 21 Section 4.1 of the Trade Marks Office Manual of Practice & Procedure (**Manual**)).

The Trade Marks Office also prefers the descriptive endorsement to include a colour identification system, however this is not essential (Part 21, Section 4.1 of the Manual ).

A possible endorsement would be: *The trade mark consists of the colours GREEN, specifically identified as [PMS XXX] and TURQUOISE [PMS XXX] applied to the glass jar/plastic tube, and the colour BROWN [PMS XXX] applied to the cap/lid as shown in the representations attached to the application form.*

It is possible for a colour trade mark to be inherently distinctive (*Philmac Pty Ltd v Registrar of Trade Marks* (2002) 126 FCR 525).

Generally, a trade mark consisting of a combination of colours is more inherently distinctive than a single colour trade mark (Part 21, Sections 4.2.2 & 4.5 of the Manual).

Evidence of use for colour(s) trade marks needs to meet the same basic requirements (Part 21, Section 4.7 of the Manual).

The question is whether the relevant traders are likely to want to use the colour(s) e.g. are the colour(s) commonly used in the particular trade?

It is not necessary to detail the percentage of the two colours unless this makes the trade mark more distinctive. Although it may be preferred by the office as the trade mark should clearly define all the details which constitute the trade mark.

### **Shape trade mark**

It is possible for shape trade marks to be inherently distinctive (*Kenman Kandy (Aust) Pty Ltd v Registrar of Trade Marks* (2002) 122 FCR 494).

We would recommend filing the composite shape and colour trade marks especially the tube shape as this appears to be a more distinctive shape in relation to skin care products.

A shape trade mark application must include descriptions and representations that clearly shows each feature of the mark (Part 21, Section 3.1 of the Manual).

It is also recommended that the representation of the trade mark include both a written description of the trade mark and be in the form of perspective or isometric drawings that clearly show all the features of the mark (Part 21, Section 3.1 of the Manual).

### **Texture trade mark**

It is possible to file a texture trade mark in Australia if the texture mark is capable of indicating origin.

In order to achieve registration, the texture would need to be something not common to a particular trade (Part 21, Section 10 of the Manual). For example, the texture of leather would not be capable of distinguishing within the clothing trade.

In this case, the applicant's use of the texture of leather on the jar lid and tube cap should be regarded as sufficiently distinctive.

If the applicant is applying for a texture trade mark, an example of the actual texture claimed must be provided and be described clearly in the application (Part 10, Section 3.7 of the Manual).

### **Jar and/or tube**

Prima facie, we consider the tube shape to be more distinctive in respect of the goods of interest. Our advice would also depend on what the tube and jar look like.

It may also be possible to file a design registration for the shape.

### **Composite trade mark**

A composite trade mark is more likely to be inherently distinctive.

An example of a description of a composite trade mark: *The trade mark consists of a combination of the shape of a tube/jar and the colours GREEN and TURQUOISE, as shown in the representation attached to the application form.*

Depending on what is considered distinctive in the trade, the client may consider adding more distinctive features e.g. frosted glass.

<b>AUSTRALIA</b>	<b><u>Question 02</u></b> - Provide the specification of the list of goods and services for the trademark application(s).
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At the time of filing the application(s), the applicant would need to either use/intend to use the trade mark(s) in relation to all of the claimed for goods and/or services.

Example specifications:

*Class 3: Toiletries; soaps; shower gels; aftershaves; shaving preparations; essential oils; anti-perspirants; deodorants; cologne; non-medicated skin care lotions, creams, powders or gels; non-medicated skin care products; nail care preparations; skin care preparations; sun-tanning preparations; hair care preparations; toiletry kits*

*Class 5: Medicated skin care preparations; powders for skin care (medicated); skin care creams (medicated); skin care lotions (medicated); skin care oils (medicated); skin care preparations (medicated); skin care products (medicated); sun skin care products (medicated); pharmaceutical preparations for skin care*

We would recommend filing in class 5 if N'Obile intends to expand into manufacturing skin care products for pharmaceutical or medical purposes.

We would also recommend filing the word mark in class 44 e.g. *Consultancy relating to skin care* or class 35 if N'Obile intends to expand into those areas.

<b>AUSTRALIA</b>	<b><u>Question 03</u></b> - In case you think that your national trademark office might refuse to register the mark on absolute grounds, please advise what evidence of acquired distinctiveness may be submitted.
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When considering the evidence of use of the trade mark, the examiner will weigh up the evidence in conjunction with the degree of distinctiveness of the trade mark (*Blount Inc v The Registrar of Trade Marks* 40 IPR 498).

The client can improve distinctiveness of the trade mark by increasing its use and promotion of the trade mark in connection with the goods or services in Australia.

Generally, the client should use the trade mark in Australia for at least three years to overcome a distinctiveness objection. However, this will depend on the degree of distinctiveness of the trade mark.

The mode of distribution may impact the distinctiveness of the trade mark. How the product is distributed may impact the use and promotion of the trade mark and may be a factor in determining who the relevant person is when assessing the distinctiveness of the trade mark. The test is 1. What is the 'ordinary signification' of the trade mark to any person in Australia concerned with the relevant goods or services; and 2. Do, or will, other traders legitimately need to use the words in respect of their own goods? (*Cantarella Bros Pty Ltd v Modena Trading Pty Ltd*).

Evidence required:

- (a) annual turnover figures of products sold under and by reference to the trade mark in Australia and global figures (if available)
- (b) advertising expenditure in Australia and global figures (if available)
- (c) indication of market share
- (d) advertising and publications mentioning the trade mark e.g. television, radio, print-based advertising, shop signage, display of goods, packaging, press-releases, photographs of promotional events, Internet and social media
- (e) customer base of N'Obile (who are the client's major customers in Australia or overseas?)
- (f) declarations from persons of standing within the relevant trade / expert evidence
- (g) consumer surveys

Preferably, the evidence should be dated and the date of first use and continued use of the trade mark can be shown from the evidence.

In the absence of any evidence of use of the trade mark in Australia, the client can attempt to overcome the distinctiveness objection by providing evidence that shows the use and reputation of the trade mark overseas has spread so that the subject mark is well-known in Australia (*Re 24 Hour fitness Inc* (2001) 54 IPR 411).

<b>AUSTRALIA</b>	<b>Question 04</b> – If your country accepts surveys, please advise your client on its design. (Which consumers should be asked to participate in the survey and what are the main three questions you would ask in the survey).
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As the product has not yet been launched and N'Obile is a newly established business, survey evidence may not be relevant here.

After the client has used their trade mark for some time, survey evidence may be useful to overcome a distinctiveness objection in relation to the shape and/or colour marks.

However, it should be noted that Australian courts are increasingly skeptical of the reliability of survey evidence as the surveys are often not well designed or properly conducted.

Survey evidence should not be conducted long after the filing date (*App Store case*).

The sample size of a survey should be sufficiently large to reflect the views of the relevant customer base (*App Store case*).

If the relevant customer base includes women and men then survey evidence should include both genders.

Survey questions should be relevant, unambiguous and non-leading. Questions which allow for a gradation of answers are considered more appropriate than questions which only provide for 'yes' or 'no' answers (*Vantage Systems Pty Ltd v IVison Pty Ltd* [2011] ATMO 90 at [29]). For example, questions like, 'What does this sign mean to you?' will be considered more appropriate and less likely to be inadmissible than questions like, 'Do you consider this sign as a badge of origin for N'Obile?'