Non-Traditional Marks in Asia Pacific: Learnings from a diverse and developing region

Country  | Contributor  | Q1  | Q2  | Q3  
---|---|---|---|---
Australia  | Carly Mansell, Davies Collison Cave  | Yes, non-traditional marks that are otherwise inherently distinctive may be accepted based on evidence of acquired distinctiveness. Typical examples include the registration of colour marks, which are generally considered not to be inherently adapted to distinguish. Several colour marks have received objections based on lack of distinctiveness, but have been ultimately accepted based on the evidence provided, including in Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551 (‘The Terracotta case’). In this case, Philmac’s extensive use and promotion was sufficient to establish that the terracotta colour claimed was distinctive in fact in respect of a narrow range of goods, namely ‘plastic compression fittings for irrigation pipes’.
A non-exhaustive list of the types of evidence that are relevant in demonstrating acquired distinctiveness includes:
- Details of first use or importation of goods bearing the mark in Australia (e.g. including first shipment of goods to Australia);
- Annual sales figures in Australia;
- Annual marketing expenditure in Australia;
- Details of Australian customers;
- Examples of use of the mark (e.g. on packaging, swing tags);
- Promotional materials, particularly highlighting the NTM (e.g. “look for the colour green”);
- Details of foreign TM registrations for the mark;
- Marketing and business plans;
- Survey evidence of the relevant consumers.

Other successfully registered non-traditional trade marks which were considered otherwise inherently non-distinctive, but accepted on the basis of acquired distinctiveness through evidence include:
- No. 1754249 of HJ Heinz Company Australia Limited for Class 29: beans and products predominantly containing beans, including baked beans;
- No. 704779 of MHCS for Class 33: sparkling wines;
- No. 802758 of Perfetti Van Melle SpA for Class 30: confectionery;

The legal tests for infringement are sourced from the same sections of the Act when comparing non-traditional marks to non-traditional marks as for other types of infringement, namely Section 120. The Act provides that a person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered. Use of a substantially identical or deceptively similar mark in relation to goods or services of the same description or that are closely related will infringe where it can be established that said use was likely to cause confusion. Theoretically, therefore, the use of a 2D mark can infringe a 3D trade mark registration. The issue of whether a non-traditional mark combining different elements will be infringed by the use of only one of those elements will depend on the comparison of the marks as a whole and how distinctive and important the shared element is within the respective marks.
In theory, the application of the legal test of infringement, when comparing whether the use of a traditional mark infringes on a non-traditional mark, should be the same. However, in cases where a plaintiff seeks to enforce a non-traditional mark in respect of an infringement claim, the difficulty that can arise is demonstrating that the alleged infringing use is, in fact, use as a trade mark. For example, where the use of a shape is said to infringe a registered shape trade mark, it will be necessary to firstly establish that the respondent is in fact using the shape (or in a 2D context: the silhouette or outline) as a badge of origin to denote the source of the respondents goods from those of other traders. Only once that limb is confirmed will a Court go on to consider whether the marks are deceptively similar and whether the use will lead to confusion and infringe on the registered rights.

Coca-Cola Company v PepsiCo Inc (No 2) [2014] FCA 1287 involved infringement proceedings on the basis of the alleged infringement by use of a three dimensional shape (Pepsi’s Carolina bottle) in relation to Coca-Cola’s trade mark and two dimensional Device mark for its distinctive Classic Contour Bottle shape. From this case, we take away:
- It was found that the use by PepsiCo of the Carolina bottle did not amount to infringement of the registered device mark. This is because the Court found that it could not merely focus on the outline or silhouette of the Carolina Bottle, but must take into consideration the other branding elements that were functioning to identify Pepsi as the source of the goods. Due to the presence of other brand features, the Court found that Pepsi’s Carolina bottle was not deceptively similar.
- In that case, the parties were not in dispute as to whether Pepsi’s use of a 3-dimensional shape could infringe Coca’s 2-dimensional registration. Coca-Cola had previous success in enforcing its rights in Coca-Cola Co v All-Fect Distributors Ltd [1999] FCA 1721 for use of the same two dimensional contour drawing of Coca-Cola’s distinctive Classic Contour Bottle in relation to the 3-dimensional shape used by All-Fect in relation to candy.

The path to establishing infringement of registered non-traditional marks can face additional hurdles. As in the Coca-Cola v PepsiCo case, it can be difficult to demonstrate that the alleged shared element that is subject of the registered non-traditional mark, is the dominant element of the respondent’s use, resulting in a likelihood of confusion. It can also be difficult to show that the alleged infringer is using the NTM as a trade mark. Furthermore, the scope of rights in some NTMs (such as colour marks) may be relatively narrow.

There is not a great deal of existing Australian case law dealing with successful infringement proceedings where the mark being enforced is a non-traditional mark, perhaps partly reflecting the above difficulties with enforcement.
In China, it is possible to register a 3D trademark with no inherent distinctiveness based on acquired distinctiveness. For colour trademarks and sound trademarks, the China Trademark Office, during its examination, will usually require the applicant to submit use evidence to prove that the applied trademark has obtained sufficient distinctiveness for being registered as a trademark. Evidence for this purpose can be marketing and advertisement materials, Internet search results, search reports issued by the China National Library, transaction documents such as audit reports, sales contracts, invoices, purchase orders and the like, documents showing the geographic coverage of the sales channel of the applied trademark and the relevant goods/services, survey reports, etc..

Examples:

<table>
<thead>
<tr>
<th>TM No.</th>
<th>Type of Trademark</th>
<th>Sample Trademark</th>
<th>TM Owner</th>
<th>Supporting Evidence on Acquired Distinctiveness</th>
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<tbody>
<tr>
<td>145</td>
<td>Sound trademark</td>
<td>[Sound: di-di-di-di-di-di-di-di-di-di]</td>
<td>Tencent Company</td>
<td>1. Notarisation reports showing that the sound mark has been used as the notification sound of the TM Owner's QQ software; 2. Annual reports of the TM Owner from 2004 to 2015; 3. Market research reports on instant messenger issued by Shanghai Research Market Consulting Co., Ltd. (a market research company); 4. Details of the sound mark including its optical spectrum, frequency spectrum and oscillogram; 5. Search reports issued by the China National Library; 6. Guinness World Records granted to the TM Owner confirming that its QQ software has the largest active registered users at the testing time; 7. Sound trademarks approved and registered in other countries which are in a similar situation of the applied trademark, i.e. 3 to 6 seconds, in simple tune and no words.</td>
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In China, the following general rules will be applied when comparing a non-traditional trademark to a traditional trademark.

1. For a 3D trademark, it may be regarded as similar to a 2D trademark if (a) it contains a distinctive two dimensional design and this design is similar to that of a 2D trademark, or (b) its overall appearance is similar to that of a 2D trademark, and the 3D trademark may cause confusion to the relevant public on the source of the goods and services.

2. For a colour trademark, it may be regarded as similar to a 2D or a 3D trademark if the colour combination in those marks is similar and the colour trademark may cause confusion to the relevant public on the source of the goods or services, unless the overall appearances of the relevant trademarks are so different that the confusion is unlikely to be caused.

3. For a sound trademark, it may be regarded as similar to a word trademark or word part of a trademark if the word / phrase / sentence in the sound mark is similar to the word trademark or word part, and the sound trademark may cause confusion to the relevant public on the source of the goods and services, or may cause the relevant public to believe that the relevant trademarks have certain connections.

The above means that it is possible to hold a 3D trademark in infringement of a 2D trademark, or vice versa. It is also possible to hold the use of certain components of a non-traditional trademark in infringement of a non-traditional trademark. When determining this type of infringement, the key is whether the relevant public will be confused.

Examples:


In this case, the plaintiff registered one side of a shoe as a device mark in Class 25 and applied this design to the shoes manufactured and sold by it. The defendant applied a similar design to shoes it produces and sells in China, which was held by the court as infringing the trademark right of the plaintiff.

2. Chanel trademark infringement case: Chanel Sosedé Anonyme vs. Ye Mengzong

Infringed TM No. 888415

Use of the Infringing Product

Infringing Product

Infringed TM No. 1620118

Use of the Infringing Product

Infringing Product

The answer is Yes. Examples are set out below:


Infringed TM No. 7182194

Use of the Infringing Product

Infringing Product

2. Enforcement of a colour combination trademark — Rextec AB vs. MS-CISCO Electrical (Suzhou) Co., Ltd.

Infringed TM No. 4496717

Use of the Infringing Product

Infringing Product
Japan

Kazuko Matsuo
k.matsuo@nakapat.gr.jp
Nakamura & Partners

One or two trademark registrations were granted with respect to unique appearance of the restaurant under the trademark Law. Such the outlooks of the Coffee-shop retail store and the like and their interior such as desk and chair as a whole are, at present, discussed to accept for registration as a sort of configuration of goods as a trademark at the Patent Office.

Almost same time, but a little before, another Governmental Committee for Amendment of Design Law has been fully discussing with respect to "Building and Interior design in the Building) should be a protectable "registrable new designs" under the newly amended Design Law. Such an amendment will be almost accepted, in very near future. Public opinion will be formally taken for such amendment. Surprisingly enough, another Committee for Trademark revision has published about proposed amendment of the Trademark Law and now invite public opinion for this amendment with respect to "enlargement of configuration of goods."

Indonesia

Tania Lovita
Tlovita@rouse.com

No, Indonesia does not accept acquired distinctiveness. All marks require high level of distinctiveness. The types of NTMs registrable are 3D shape, colour, pattern, position, sound, smell, movement and hologram.

Typical evidence for establishing acquired distinctiveness are catalogues, sales invoice, sales figures, promotional materials, amount of promotional expenses, market survey and statements from trade.

Examples of NTMs that have been accepted based on acquired distinctiveness:
- Ferrers Rocher (pattern mark);
- Louis Vuitton (pattern mark);
- Ferrs, Rocher, Dior (3D shape mark);
- Sony (sound mark).

There is no case law of infringement of NTMs in Indonesia.

Generally, according to the Trademark Law, a trademark infringement occurs when a third party uses a trademark which is similar or identical to a registered mark of another party for the same kind of goods and/or services.

The use of 2D mark that is similar to a registered 3D mark may amounts to infringement. However, there is no case law of infringement of non-traditional marks in Indonesia so the legal test has not yet been tested.

Hong Kong

Annie Tsoi
Wilkinson & Grist
annietsoi@wilgrist.com

NTMs can be accepted based on acquired distinctiveness in Hong Kong. The types of NTMs registrable are 3D shape, colour, pattern, position, sound, smell, movement and hologram.

Typical evidence for establishing acquired distinctiveness are catalogues, sales invoice, sales figures, promotional materials, amount of promotional expenses, market survey and statements from trade.

Examples of NTMs that have been accepted based on acquired distinctiveness:
- Ferrers Rocher (pattern mark);
- Louis Vuitton (pattern mark);
- Ferrs, Rocher, Dior (3D shape mark);
- Sony (sound mark).

There is no case law of infringement of NTMs in Hong Kong.

There is no case law of infringement of non-traditional marks in Hong Kong.

Regardong the infringement of a registered 3D mark by use of a 2D mark, it is unlikely that the courts will treat them to be the same as the Trade Marks Registry has followed a UK case law stating that a 3D mark was not identical to a 2D picture of it.

(please see p.4 of Trade Marks Registry Work Manual on "Relative grounds for refusal" at https://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Relative_grounds_for_refusal.pdf)
### Malaysia

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<tr>
<th>Name</th>
<th>Email</th>
<th>Details</th>
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<tbody>
<tr>
<td>Siew Ling Su</td>
<td><a href="mailto:sawfna.s@zicolaw.com">sawfna.s@zicolaw.com</a></td>
<td>The current Trade Mark Act 1976 (“Act”) does not expressly provide for the registration of non-traditional marks and there is currently</td>
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<td>limited precedents on the registrability of non-traditional marks in Malaysia.</td>
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<td>Jyeshta Mahendran</td>
<td><a href="mailto:jyeshta@shearndelamore.com">jyeshta@shearndelamore.com</a></td>
<td>There is however an interesting obiter statement made by the High Court in the case of Kraft Foods Schweiz Holding GmbH v Pendentair Cap</td>
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<td>Dagangan [2016] 11 MLJ 702, where Wong Kian Khoang JC (as he then was) took the view that 3D shape mark may be considered as a “device”</td>
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<td>which falls within the definition of a “mark” of the Act and thus, registrable as a trade mark if the applicant is a bona fide</td>
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<td>proprietor, the shape mark is distinctive and the shape mark is not prohibited by provision under the Act. The judge further held</td>
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<td>that distinctiveness of a trade mark (including the shape mark in question) may be ascertained from either its own inherent</td>
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<td>distinguishing feature or by being factually capable of distinguishing or both cumulatively. It is therefore possible for trade mark,</td>
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<td>including non-traditional mark to be accepted for registration based on acquired distinctiveness. The High Court however found the</td>
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<td>shape mark in the Kraft case to be non-distinctive and not registrable. This position may change come 27th December 2019 when the new</td>
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<td>Trademarks Act 2019 comes into force as the new legislation expressly recognizes non-traditional trademarks, such as shape, sound,</td>
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<td>and smell. Section 25(3) of the said legislation provides that the Registrar shall not refuse to register an application of a</td>
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<td>trademark if, before the date of application for registration, the trademark has in fact acquired a distinctive character as a result</td>
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<td>of its use. Since non-traditional marks will not be treated differently from traditional trade marks in term of the distinctiveness</td>
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<td>requirement, it is reasonable to infer that non-traditional trade mark may be accepted for registration based on acquired</td>
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<td>distinctiveness. Evidence that would be persuasive in showing acquired distinctiveness would be sampling of invoices, delivery</td>
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<td>orders, bills, debit notes, shipping and customs documents and any other documents evidencing sale of products/services bearing the</td>
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<td>3D features (independent of the other conventional trademark features in the product) in Malaysia, yearly sales figures of the</td>
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<td>products/services bearing the mark since first use of the mark in Malaysia; promotional materials and advertisements in Malaysia,</td>
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<td>yearly advertisements and promotional expenses ; degree of knowledge or recognition of the 3D mark in the relevant sector of the</td>
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<td>public and other useful information or material which indicates public awareness of the mark including research and consumer surveys.</td>
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<td>As non-traditional marks are not explicitly provided under the current Act, there has been no litigation concerning infringement of a</td>
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<td>registered non-traditional mark as such. For infringement of a 2D mark by use in 3D form, the issue has not been tested in court. There</td>
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<td>is nothing in the Act (current or new law) that explicitly deals with this issue, or which rules out the possibility of such infringement</td>
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<td>conceptually. The Malaysian courts may be influenced by the interpretation taken in courts in the UK and Singapore especially under the</td>
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<td>new law, where our infringement provisions are similar. In relation to infringement of only one of several aspects of a non-traditional</td>
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<td>mark, we would anticipate assessment of infringement to be akin to a composite or complex trade mark. The mark will be considered as a</td>
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<td>whole, and thus taking just one of the features may not infringe unless that feature is the dominant element within the overall impression</td>
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<td>created by the mark which may lead to the likelihood of confusion.</td>
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<td>There is no case law to date as NTMs will only be explicitly recognised and introduced under the new Act.</td>
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<tr>
<td>Jonathan Aumonier-Ward</td>
<td><a href="mailto:jonathan.aumonier-ward@ajpark.com">jonathan.aumonier-ward@ajpark.com</a></td>
<td>Yes non-traditional marks which are otherwise inherently non-distinctive, and therefore difficult to register, can be accepted based on</td>
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<td>AJ Park</td>
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<td>acquired distinctiveness. A New Zealand trade mark can be any sign capable of being represented graphically and of distinguishing the</td>
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<td>goods or services of one person from those of another person. The term “sign” is defined as including a brand, colour, device, heading,</td>
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<td>label, letter, name, numeral, shape, signature, small, sound, taste, ticket, or word; and any combination of signs. The word “including”</td>
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<td>is not limiting meaning pretty much anything can be a sign and can therefore be a trade mark as long as it can be represented</td>
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<td>graphically and is sufficiently distinctive, either inherently or by acquired distinctiveness. Evidence must be presented in the form</td>
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<td>of a statutory declaration, an affidavit or an affirmation. Those should be typed, if possible. The statutory declaration, affidavit or</td>
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<td>affirmation must be declared, sworn or affirmed before an authorised person, such as a solicitor or a Justice of the Peace. Any</td>
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<td>exhibits must be signed by this person as well. The evidence must relate to use of the trade mark before the date of application.</td>
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<td>The legal tests for infringement of NTMs is the same as for standard marks. For example, using an identical or similar mark in the course</td>
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<td>in relation to identical similar services where the use would be likely to deceive or confuse and that it is being used in such a manner</td>
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<td>as to render the use as likely to be taken as being use as a trade mark. As time goes on consumers become more educated. Owners of</td>
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<td>NTMs would should try to use their own NTMs in such as way as to educate consumers as to their trade mark significance. The more educated</td>
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<td>the consumers the possibility greater chance of success if the NTM ever needs to be enforced. Yes, theoretically if you have a 3D mark</td>
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<td>registered and someone is using a 2D mark, this can be an infringement. The same tests would apply. If the 2D mark is clearly an</td>
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<td>exact, all be it ‘flat’, representation of the 3D mark, it is very likely the Courts would find considerable likelihood of confusion.</td>
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<td>But if it is not exact there could be more of a problem. If a non-traditional mark combined different elements such as shape, sound,</td>
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<td>and colour, use of only one of those elements will not necessarily infringe the NTM. There is not a lot of case law in New Zealand relating to the enforcement of NTMs. This reflects the uncertainty and possible difficulty of enforcement here in New Zealand. Owners of NTMs must balance the high litigation costs with the possible outcomes. Often New Zealand will not be the jurisdiction of choice.</td>
</tr>
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</table>
Evidence should include:

- the date the trade mark was first used on the goods/services in New Zealand
- how widely used the trade mark has been in New Zealand
- annual sales/turnover figures of the goods/services traded under the trade mark in New Zealand
- annual advertising or promotional expenses for the goods/services provided under the trade mark in New Zealand
- examples showing how your trade mark has been used in New Zealand (these are referred to as ‘exhibits’, for example, copies of sales brochures, copies of advertisements, samples of packaging for the goods or letterhead.)
- supporting declarations from persons in the relevant trade attesting to the mark’s distinctiveness and the length of time the mark has been known
- survey evidence as to distinctiveness
- as many specific examples as possible to show the NTMs has been used ‘as a trade mark’ or that consumers have been educated as to the trade mark nature of the NTMs
- any other information that may assist in establishing that the trade mark has become distinctive as a result of its use in New Zealand.

Here are some examples of non-traditional marks that have been accepted based on acquired distinctiveness.

- (211576) owned by BP P.L.C. “The mark consists of the colour green, applied to the exterior surfaces of service stations used for the supply of the said goods”
- (285611) owned by Cadbury UK Limited “The mark consists of the colour purple (Pantone 2685C), as applied predominantly to the packaging of the goods”
- (315006) owned by New Zealand Rugby Union Incorporated “The mark consists of the colour Black”

The test must be applied to the marks as wholes. Just like standard marks, if only one or some of the elements exist in the infringing mark, consumer confusion is less likely.

Owners of NTMs should be careful not to include too many elements in their combination marks. They should focus on the ‘hero’ elements and try to register them alone or in combination of as few elements as possible. Preferably just enough to achieve a sufficient level of acquired distinctiveness to be registrable.
Evidence which may be submitted include:

- **Shape Marks**: The mark consists of a three-dimensional shape of a biscuit, comprising a fluted edge biscuit base, fully enrobed in chocolate, and topped with squiggly icing.

- **Colour Marks**: The mark consists of a three-dimensional shape of a biscuit, comprising a round biscuit base, topped with a half sphere dome, and fully enrobed in chocolate.

Trademarks may be accepted based on acquired distinctiveness by showing consistent and extensive use in Singapore (for at least a period of 5 years). Relevant evidence would generally include examples of use of the mark (on store locations, on products etc), revenue figures and supporting evidence (annual reports etc) and advertising figures and material. Any evidence of use must show “use as a trade mark” in connection with the relevant goods and services.

**Colour Marks** may be registered based on acquired distinctiveness. Evidence of the colour being promoted apart from the goods or their packaging should be submitted, such as:

- Examples of advertising text referring specifically to the colour in respect of the goods, eg. Statements such as “look for the orange coloured box”, or “unusual colours; exceptional goods”
- Consumer surveys based on recognition of the colour
- Declarations from the trade and from consumers attesting to the recognition of the colour as an indicator of trade source
- Research or information demonstrating that the usual colour for the goods in question is something quite different.

Colour of the goods in question is something quite different.

**Shape Marks** may be registered based on acquired distinctiveness. Evidence which may be submitted include:

- Examples of advertising text referring specifically to the shape in respect of the goods, eg. Statements such as “look for the star shaped

There have been no local cases which definitively examined the question of whether use of a 2D mark would infringe a registered 3D mark.

There has however been a local case where the Court found that registration of a 2D Mark does not cover use of a 3D Mark, and that use of said 3D Mark does not infringe a registration for said 2D Mark.

- In the case of Nation Fittings (M) Sdn Bhd v Oyster Tec plc and another suit [2005] SGHC 225 (see: https://www.singaporelawwatch.sg/Portals/0/Docs/Judgments/[2005]%20SGHC%20225.pdf), the Court held that the Plaintiff’s registered 2D marks “were two dimensional trade marks and were registered as such. There is nothing in the both of them to suggest any intention to appropriate a three-dimensional right as such”.

- The Court thus found that the case for infringement failed at this point.

In addition, although prevailing case law does not specifically examine the question of whether use of a 2D mark would infringe a registered 3D mark, the Courts nevertheless appear to take the position that use of a 2D mark does not amount to use of a 3D mark as they are considered to be of a different nature.

- In the case of Re Societe des Produits Nestle to, no non-traditional marks have been successfully enforced in infringement proceedings in Singapore. There has been one local case where a proprietor was unsuccessful in enforcing their registered shape marks in infringement proceedings as said marks were invalid before the question of infringement could be examined.

- In the case of Societe Des Produits Nestle SA and another v Petra Foods Ltd and another [2014] SGHC 252 (see: https://www.singaporelawwatch.sg/Portals/0/Docs/Judgments/[2014]%20SGHC%20252.pdf), the proprietor, Nestle, sought to enforce their registered 2 finger shape mark

and 4 fingers chocolate waters against the defendants’ 2 fingers shape mark

and 4 fingers chocolate wafers

Infringement proceedings.

- In the matter of a trade mark application by Societe Des Produits Nestle SA [2007] SGIPOS 1 (https://www.ipos.gov.sg/docs/default-source/resources/library/trade-marks/info/pack/trm_work_manual_6-evidence-of-use_nov2015-v2.pdf?sfvrsn=1), the Registrar had also remarked that a conventional 2D mark and a 3D shape mark are “obviously different in nature”.

To our knowledge, no non-traditional marks have been successfully enforced in infringement proceedings in Singapore. There has been one local case where a proprietor was unsuccessful in enforcing their registered shape marks in infringement proceedings as said marks were invalid before the question of infringement could be examined.
box”, or “attractive colours; unusual shape”

- Consumer surveys based on recognition of the shape
- Declarations from the trade and from consumers attesting to the recognition of the shape as an indicator of trade source
- Evidence of the shape being promoted and used independently from other primary trade marks (such as the name and logo of the applicant).


The following are some examples of non-traditional marks that have been accepted in Singapore based on acquired distinctiveness:

**Colour Marks**

- SG TM No. T9906795F in the name of 7-ELEVEN, INC.
- SG TM No. T1003719Z in the name of Christian LOUBOUTIN
- SG TM No. T0408412B in the name of Schaeffler Technologies AG & Co. KG

**Shape Marks**

https://www.ipos.gov.sg/docs/default-source/resources-library/trade-marks/infopacks/tm_work_manual_6-evidence-of-use_nov2015-v2.pdf), in assessing whether a 3D mark has acquired distinctiveness through use, the Court found that the evidence of six prior local registrations for 2D marks were irrelevant, as “the relevant public’s perception may not necessarily be the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes”.

For all the reasons above, it appears unlikely that a party can establish similarity to and consequently infringement of a 3D mark merely on the basis that a 2D mark has been used in Singapore.

With regard to the query “If a non-traditional mark combined different elements such as shape, sound, and colour, will use of only one of those elements infringe it,” there have been no local cases which have definitively examined this question. However assessment of the same will likely follow traditional trademark principles. This may include a consideration of the dominant distinctive component of the registered non-traditional mark and whether the offending sign contains additional differentiating elements which are sufficient to dispel confusion.

- On appeal, the invalidation of the registered shape marks was also subsequently upheld by the Court of Appeal (see https://www.supremecourt.gov.sg/news/case-summary/07/05-11-2012/societe-des-produits-nestle-sa-anor-v-petra-food-limited-anor).
In Taiwan, all types of NTMs may be accepted based on acquired distinctiveness as long as drawings and descriptions are submitted in the applications.

Take 3D trademark as an example, it is common for the Taiwan Intellectual Property Office (TIPO) to request an applicant to disclaim the shape of the 3D mark. If the applicant disagrees with the requested disclaimer, it is required to submit sufficient materials attesting to the acquired distinctiveness of such shape in Taiwan. The following documents may be useful to support the applicant’s argument:

1. A trademark list showing the foreign registrations/approvals for the captioned trademarks without disclaimer of the shape, together with photocopies of the certificates/approval notifications issued in the countries/territories, such as Japan, China, Singapore, EU, France, Australia, U.K., Germany, Canada, Hong Kong, Switzerland, South Korea, etc.

2. Photocopies of the advertisements in newspapers or magazines, commercial invoices, shipping documents, catalogs, leaflets, copies of pages downloaded from the websites, commercials in the form of the compact disk and the broadcasting list thereof, etc. showing use of the shape in trademark sense, especially those in Taiwan, its neighboring countries/territories and the countries Taiwanese often visit, such as China, Japan, South Korea, Hong Kong, Thailand, Singapore, Australia, Vietnam, Indonesia, France, U.S.A, UK, Germany, Canada, Malaysia, etc.

3. Any document attesting to advertising expenditures for the shape for the last 3 years, especially those in Taiwan.

Market survey may use as a support but whether market survey can be admitted as evidence has always been controversial in Taiwan and the law is yet settled.

The two examples of non-traditional trademarks that have been accepted based on acquired distinctiveness are listed below:

First of all, the number of cases involving infringement of NTMs is rather limited. Therefore, the legal tests for infringement of NTM is not well-settled and whether there will be an infringement should be determined on a case-by-case basis.

However, some Courts in Taiwan had held that it would be an infringement if someone uses the 3D version of a 2D registered mark (for example, make a 2D trademark into a 3D model). Therefore, in the same token, even though there is no prior case yet, it might be considered as an infringement if someone uses a 2D version of a 3D registered mark.

Although limited, there were some cases involving the infringement of NTMs in Taiwan. For example, Kinmen Kaoliang Liquor Inc. had successfully enforced its 3D trademark registration (Reg. No. 01233000) in Taiwan against a manufacturer of counterfeit kaoliang liquor. The drawing of the 3D trademark is listed as follows:
(1) KOSE – SEKKISEI (Reg. No. 01768722)

(2) ADIDAS – Three Stripes Jacket (Reg. No. 01958434)
At present, the types of registrable non-traditional marks (NTMs) in Thailand are 3D shapes, a combination of colours, position, and sound. For sound marks, currently the filing number are 44 application of which 3 applications were accepted to registered.

There are certain criteria under the law where the said NTMs will be considered to have inherent distinctiveness. Nevertheless, they can be accepted for registration based on acquired distinctiveness through use in Thailand.

Thai Trademark Act, Section 7 paragraph three provides that “A trademark having no characteristics under paragraph two (1) (11), if used on goods which have been widely sold or advertised in accordance with the rules prescribed in a Notification of the Minister of Commerce (MOC) and if it is proved that the rules have been duly met, shall be deemed distinctive”. Detailed requirements are provided under the MOC’s Notification dated 11 October 2012, which states that in order to acquire distinctive through use, these criteria must be met:

1. Products or services using the mark are continuously distributed, advertised or advertised for a certain period of time in order to enable the general public or the public in the relevant fields in Thailand become aware and understand that the products or services using the said mark are different from those of the others;
2. Distribution, dissemination or advertisement of any goods or services that cause the mark to become widespread in Thailand shall be regarded as the mark deemed distinctive to that product or service only;
3. Mark to be proved the distinctiveness through use must be the same mark as filed for registration.

The MOC’s Notification also provides that the following evidence is considered useful: Sales revenues and annual marketing expenses for the mark; and official website showing the use of the mark; Online marketing, online use, social media, or the company’s billboards, and any other advertising documents for the mark; News clippings, TV advertisements, radio advertisements, Leaflets, brochures, or any promotional material showing the use of the mark; Date of first use of the subject mark together with the evidence; Detailed history or background of the mark; Pictures of the actual use of the mark; Leaflets, brochures, or any promotional materials showing the use of the mark; News clippings, TV advertisements, radio advertisements, billboards, and any other advertising documents for the mark; Online marketing, online use, social media, or the company’s official website showing the use of the mark; Event marketing, trade exhibitions, promotional booths, or other marketing activities showing the use of the mark; Sales revenues and annual marketing expenses for the mark; and Any other documents, including market surveys, market research, etc. which indicate public awareness regarding the mark.

In addition to the above, these evidence/information are considered useful:

- The examples of non-traditional marks that have been accepted in Thailand based on acquired distinctiveness are:

Thailand: Although the Thai Trademark Act does not specifically provide that “position mark” is registrable, many applications for position marks were granted for registration in Thailand in the past. The following position marks have been successfully enforced in infringement proceedings in Thailand. Unfortunately, actual pictures of the infringing products are not available.

Currently, there are two different views in consideration the infringement of the position mark. One opines that it may be possible to enforce clothing which has the same style or depict as filed and registered. In contrary, one other considers that the infringing mark must have the entire mark (dashed line and the three stripes) on the offending products in a prominent part in order to be a trademark infringement case.
Please note that there are no other kinds of non-traditional marks (such as 3D shape, a combination of colours, and sound shape mark) that have been successfully enforced in infringement proceeding at this moment.