

REQUEST FOR ACTION BY THE INTA BOARD OF DIRECTORS

Guidelines for Trademark Examination

May 17, 2025

Sponsoring Committee: Trademark Office Practices Committee and Non-Traditional Marks Committee

PROPOSED RESOLUTION:

WHEREAS, the International Trademark Association from time to time needs to analyze and comment on the trademark application examination procedures of national and jurisdictional trademark offices or is asked to provide advice and recommendations to such offices on existing and/or proposed procedures.

WHEREAS, the Trademark Office Practices Committee has recommended the use of Guidelines for Trademark Examination to serve as a baseline standard by which INTA and its advocacy committees can provide analysis, advice, comments, recommendations, and training on the trademark application examination procedures of national and jurisdictional trademark offices.

WHEREAS, the most recent prior version of the Guidelines for Trademark Examination was adopted by INTA's Board of Directors in 2023.

WHEREAS, the Trademark Office Practices Committee and the Non-Traditional Marks Committee have jointly recommended that the Guidelines for Trademark Examination be updated to reflect among other things amendments to INTA's current positions with respect to the protection and enforcement of non-traditional trademarks.

BE IT RESOLVED that the International Trademark Association adopts the attached (revised) Guidelines for Trademark Examination to serve as a standard and guidance for national and jurisdictional trademark office application examination procedures and to be used by INTA and its advocacy committees for purposes of providing analysis, advice, comments, recommendations and training related to national and jurisdictional trademark application examination procedures.

BACKGROUND:

In 2023, INTA's Board of Directors adopted the current version of the Guidelines for Trademark Examination. The 2023 version of the Guidelines represented a significant update to the prior version adopted in 2007 and was the result of the work of the TOPC Examination Guidelines Subcommittee established in 2022 for the 2022 – 2023 term.

The Guidelines suggest a minimum set of standards for examination of trademark applications for, for example, a jurisdiction implementing trademark application examination procedures for the first time, or a jurisdiction amending its trademark application examination procedures. The Guidelines are also used by INTA advocacy committees for purposes of training national and jurisdictional

trademark office personnel in jurisdictions with undeveloped procedural standards or where current procedural standards represent an obstacle to registration of certain types of marks.

Following the Board's adoption of the 2023 version of the Guidelines, the TOPC Examination Guidelines Subcommittee recommended a further review and revision of the Guidelines by a joint task force of TOPC and the NTM Committee to improve and expand the provisions of the Guidelines related to registration examination of NTMs. While the 2023 version of the Guidelines expanded the types of NTMs discussed, it did not provide detailed definitions and examples of each type of NTM and did not fully address issues related to priority, inherent and acquired distinctiveness, or functionality so often encountered in the prosecution of NTM applications.

As a result of this recommendation, in 2024, the Trademark Office Practices Committee (TOPC) along with the Non-Traditional Marks Committee (NTM Committee) formed a Joint-Committee Task Force to continue the work of the 2022 – 2023 TOPC Examination Guidelines Subcommittee and make further recommendations for updates the Guidelines for Trademark Examination with respect to the examination of non-traditional trademarks. The Joint-Committee Task Force was comprised of members from TOPC and NTM. TOPC members were from Argentina, Canada, Switzerland, the United Kingdom, and the United States, all of whom previously served on the 2022 – 2023 TOPC Examination Guidelines Subcommittee and were significantly involved with the work of that subcommittee. NTM Committee members were from Canada, Greece, India, Italy, Mexico and the United Kingdom.

In preparing recommendations for revisions to the 2023 version of the Guidelines for Trademark Examination, the Joint-Committee Task Force reviewed the relevant sections of the INTA Model Trademark Law (2019), the INTA Bulletin articles and presentation listed below, and a White Paper published by the NTM Committee in 2021 entitled *Guidelines for Exemplary Types of Non-traditional Marks*. In addition, the following Board Resolutions were determined to be relevant:

- Recognition, Protection and Registration of Non-Traditional Trademarks (November 2021)

The following INTA Bulletin articles published by the NTM Committee were reviewed:

- *Music to Your Ears, Best Practices for Prosecuting Sound Mark Applications* (October 1, 2019)
- *Protecting Color as a Trademark in the United States – Part 1* (June 15, 2022)
- *Protecting Color as a Trademark in the United States – Part 2* (July 6, 2022)
- *Busting a Move, Best Practices for Protecting Motion Marks in the United States* (March 15, 2023)

The following NTM Committee presentation was reviewed:

- The Sweet Smell of PLAY-DOH® (2018)

The Subcommittee also solicited comments from the following INTA Advocacy Committees:

- Non-Traditional Marks Committee (including all subcommittees)
- Trademark Office Practices Committee (including all subcommittees)



With the context of the above in mind and consistent with the prior work of the 2022 – 2023 TOPC Examination Guidelines Subcommittee, the Task Force incorporated a “best practices” approach to analyzing the relevant provisions of the 2023 version of the Guidelines and making recommendations for proposed revisions. The Guidelines were also revised to further align them with current technological practices and capabilities.

The proposed revisions support registration of NTMs and adopt a positive tone when discussing the analysis of NTMs with respect to distinctiveness and functionality and provide detailed guidance for submission of evidence related to acquired distinctiveness of NTMs. The revisions also address issues often encountered by NTM applicants, including maintenance of priority across jurisdictions with different requirements related to mark description, representation and categorization, and make recommendations for permitting non-substantive amendments to these application details to address jurisdictional differences.

The 2025 revised version of the Guidelines incorporates many relevant examples of non-traditional marks. Permission has been obtained from the owners of all included marks.

In conclusion, the Trademark Office Practices Committee and the Non-Traditional Marks Committee along with the Joint-Committee Task Force recommend that the Board of Directors pass a resolution adopting the Guidelines for Trademark Examination as currently drafted.