



Promoting Intellectual
Property Rights in the
ASEAN Region

TRAINING ON THE ASEAN COMMON GUIDELINES FOR THE SUBSTANTIVE EXAMINATION OF TRADEMARKS

MODULE 1:

DISTINCTIVENESS OF THE THREE-DIMENSIONAL
MARKS

Thom CLARK | 28 May 2020



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- ❑ Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is non-distinctive
- ❑ New types of trademarks – examination of formal requirements and grounds for refusal
- ❑ Comparison of goods and services (similarity of goods and services)

- ❑ Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is non-distinctive
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SHAPE MARKS



SHAPE MARKS

Common Guidelines:

1.1.3 Three-dimensional signs

A three-dimensional shape is a ‘visually perceptible’ sign and is capable of being ‘represented’.

SHAPE MARKS

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

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

(Common Guidelines, 1.1.3, Three-dimensional signs)

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Assessment of the distinctiveness of the sign as a whole

Must be based on the overall impression of the combination of the shape and the elements to which it extends in relation to the goods in question.

Will the addition of a verbal element change this impression?

SHAPE MARKS

Assessment of the distinctiveness of the sign as a whole

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

(Common Guidelines, 2.1.5, Three-dimensional signs)

SHAPE MARKS

Assessment of the distinctiveness of the sign as a whole

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

(Common Guidelines, 2.1.5, Three-dimensional signs)

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Assessment of the distinctiveness of the sign as a whole

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

(Common Guidelines, 2.1.5, Three-dimensional signs)

SHAPE MARKS

Assessment of the distinctiveness of the sign as a whole

Must be based on the overall impression of the combination of the shape and the elements to which it extends in relation to the goods in question.

Will the addition of a verbal element change this impression?

SHAPE MARKS

Factors which may affect the perception of verbal element present in the sign when assessing its distinctiveness:

- Size/proportion
- Contrast
- Position

SHAPE MARKS

Size/proportion

- The assessment should be based on the representation of the sign, as submitted by the applicant, regardless of the usual size of the product.
- The distinctive element must be clearly visible in the representation to render the sign distinctive as a whole.
- No specific proportions between the elements and the shape are required.

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Size / proportion

1. When the verbal/figurative element is sufficiently large to be clearly identified as distinctive, and has sufficient impact on the overall impression given by the sign, it renders the sign as a whole distinctive.

Class 9 : *Secure digital memory cards*



SHAPE MARKS

Size / proportion

2. When the element is large, but identified as non-distinctive, its size alone, in proportion to the shape, will not be sufficient to render the sign as a whole distinctive.

Class 16 : *Cardboard boxes*



SHAPE MARKS

Size / proportion

3. Specific market realities must be taken into consideration.

Class 16 : Business card holders in the nature of card cases



SHAPE MARKS

Size / proportion

3. When the verbal/figurative element is small to the point it is not identifiable as distinctive, it will not have a sufficient impact on the overall impression and therefore will not render the shape as a whole distinctive.

Class 9: Secure digital memory cards



SHAPE MARKS

Contrast

- The use of contrast can affect the capacity of the verbal/figurative element(s) to be identified, and ultimately to render the sign distinctive as a whole.
- Contrast can be achieved by the use of different shades of colours or by embossing/engraving/debossing certain elements on the specific goods.

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Contrast : colour

1. The use of less contrasting colours can still be sufficient to allow an element to be identified as distinctive in the representation and result in a distinctive sign.

Class 32 : *Mineral water*



SHAPE MARKS

Contrast : colour

1. When the element cannot clearly be identified as distinctive in the representation due to a lack of contrast, the element will have no impact on the assessment of the distinctiveness of the sign as the consumer will not be able to immediately identify such element and ultimately to distinguish the sign from others.

Class 28 : *Balls for play*



SHAPE MARKS

Contrast : embossing and debossing

1. The effect of engraving/embossing/debossing may also influence the identification of the element and the overall assessment of the distinctiveness of the sign.

Class 32 : *Non-alcoholic beverages*



SHAPE MARKS

Contrast : embossing and debossing

2. In principle, the fact of engraving/embossing/debossing a non-distinctive element on a non-distinctive shape is not in itself sufficient to render a sign distinctive.

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Class 32 : Non-alcoholic beverages



SHAPE MARKS

Position

- The position of an element to which the sign extends is also a factor to be taken into account when assessing the distinctive character of the sign, as it will affect the capacity of such element to be identified as distinctive or not, and ultimately convey a distinctive character to the sign.

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Position

1. In general, distinctive elements will render a sign distinctive as a whole, irrespective of their position on the good and the usual presentation of the product on the market, as long as they can be identified as distinctive in the representation of the trade mark application.

• Class 32 : *Non-alcoholic beverages*



SHAPE MARKS

Position

2. In some situations, elements may be perceived differently by the consumer because of their position on the goods and thus change the finding of distinctiveness.

Class 3 : *Cosmetics*



SHAPE MARKS

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Class 3 : *Cosmetics*



SHAPE MARKS

Combination of factors

Where a shape mark contains more than one of the elements above or where more than one of the factors above are relevant to determine the impact of the elements in the distinctiveness of the sign, the distinctiveness of the sign will depend on the overall impression produced by the combination of those factors and elements.

(EUIPO)

SHAPE MARKS

Combination of factors

1. When several factors (such as size, position or contrast) negatively affect the element from being identified as distinctive, this will lead to a non-distinctive overall impression of the sign.

Class 9 : *Sunglasses*



SHAPE MARKS

Combination of factors

2. In general, combining a non-distinctive shape with verbal and/or figurative elements, which are considered individually devoid of distinctive character, does not result in a distinctive sign.

Class 30 : *Chocolate*





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