

Navigating Asia-Pacific's Nontraditional Marks Maze (2022)

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Registration of a nontraditional trademark is often an onerous task, and nontraditional trademark protection varies from jurisdiction to jurisdiction. In 2021, members of the Non-Traditional Marks Committee, Asia-Pacific Subcommittee developed a matrix summarizing the rules and practices of nontraditional trademarks in 26 Asia-Pacific countries and regions, namely, Australia, Brunei, Cambodia, China, Fiji, Hong Kong SAR, Indonesia, Japan, Kiribati, Laos, Macau SAR, Malaysia, Myanmar, New Zealand, Papua New Guinea, the Philippines, Samoa, Singapore, the Solomon Islands, South Korea, Taiwan, Thailand, Tonga, Tuvalu, Vanuatu, and Vietnam. In 2022, the matrix was updated by the new Subcommittee members. The matrix showcases registrable nontraditional trademarks throughout the Asia-Pacific region, perhaps offering practitioners and brand owners some insights on how to navigate the prosecuting landscape of nontraditional trademarks in the region.

Registrable Nontraditional Trademarks in the Asia-Pacific Region

The Asia-Pacific Subcommittee examined separately the registration requirements of 10 different types of nontraditional trademarks, that is, single color, combinations of colors, sound, 3D signs, touch, smell, taste, motion, position trademarks, and holograms. Colors are used in the matrix to distinguish the availability of different types of nontraditional trademarks: green for acceptable ones, pink for unacceptable ones, and orange for marks that are not explicitly provided in the law but which could technically be registrable.

Six countries and regions offer holistic availability to nontraditional trademarks: Australia, Brunei, New Zealand, Singapore, South Korea, and Taiwan. Although some types of marks are not expressly provided for in the law, in principle, all 10 kinds of nontraditional trademarks are accepted, with, most of the time, a requirement to prove distinctiveness through use. Oceania countries, Kiribati, Papua New Guinea, Samoa, Tonga, Tuvalu, Vanuatu, and the Solomon Islands, are more open to registration but there is no actual registration example yet.

All countries and regions accept certain types of nontraditional marks, though some are more conservative than others. Laos, Macau SAR, and Myanmar only accept combined colors and 3D marks and reject all others. In Cambodia, by inference from Article 2 of the Law concerning Marks, Trade Names and Acts of Unfair Competition, combined colors, 3D and hologram signs might be registrable, but so far there is no example of registration. Fiji only accepts single color marks and color combination

marks. Vietnam only accepts the registration of 3D marks.

The 26 Asia-Pacific countries and jurisdictions reviewed accept certain types of nontraditional marks, although some are more conservative than others.

Some countries' nontraditional trademark protection is evolving. In addition to the three existing registrable non-traditional signs (color combination, sound, and 3D sign), China's Supreme Court seemed to be open, in the Louboutin red sole case, to the registration of signs that are not explicitly mentioned in the law, provided that distinctiveness can be proven. Yet the prospect is less rosy in practice, given it may take years for the China Trademark Office to align its practice and embrace the registration of more types of marks. Malaysia used to only accept sound and 3D marks, both of which are not expressly provided for in the Trade Marks Act 1976, but most types of marks, except touch and taste marks, are acceptable based on the Trademarks Act 2019. The Intellectual Property Office of the Philippines is exploring amendments to the law to allow nonvisual marks, including inter alia sound marks, as registrable marks.

Inherent Distinctiveness or Acquired Distinctiveness

The Asia-Pacific Subcommittee verified distinctiveness requirements of different types of nontraditional trademarks under the legal framework of each country and region, namely, whether the trademark can be registered based on inherent distinctiveness or is only registrable based on the distinctiveness acquired through use.

In Australia, Brunei, Malaysia, New Zealand, the Philippines, and Singapore, nontraditional marks might be perceived as inherently registrable, but most often acquired distinctiveness would still be required subject to the Examiner's view.

In other jurisdictions, most types of nontraditional marks are required in order to furnish proof of acquired distinctiveness and are deemed inherently registrable only in exceptional cases. In China, only 3D marks other than the shape of the product might be viewed as inherently distinctive, whereas all other types, in most cases, have to acquire distinctiveness through use. In Japan, single color and color combination marks clearly require acquired distinctiveness, whereas all other types of marks may be registrable based on inherent distinctiveness, which hinges on the composition of the marks. In South Korea, motion and hologram marks are likely to be deemed as inherently distinctive, and all others would require proof of acquired distinctiveness. In Indonesia, the law only provides for inherent distinctiveness whereas, in practice, evidence of acquired distinctiveness may still need to be submitted.

As one of the most diverse regions of the world, the Asia-Pacific region presents a varied registration and protection regime for nontraditional trademarks.

A few jurisdictions require acquired distinctiveness for all types of marks. In Taiwan, a nontraditional mark is only registrable by evidencing acquired distinctiveness. In Thailand, inherent distinctiveness is accepted only in exceptional cases, and most marks have to show acquired distinctiveness.

In Macau SAR, nontraditional marks can only be registered based on inherent distinctiveness, which diverges from the practice of most jurisdictions.

Registration Examples

In the matrix, registration examples are provided where available for each type of nontraditional trademark in all jurisdictions.

Whereas certain types of nontraditional trademarks are registrable in theory in some countries, there is no successful registration yet. In Australia, New Zealand, and South Korea, all types of nontraditional marks are acceptable, but so far, no taste mark is granted in Australia, and there is no registration of touch, smell, or taste marks in New Zealand or South Korea. In Japan, single color marks have become registrable, yet no registration has been granted. In Brunei, there is only registration of 3D marks, even though all types of nontraditional marks are theoretically registrable. Also, there is no registration of any kind of nontraditional trademark in Cambodia and Laos to date.

Of all the study subjects, 3D marks have been registered in 14 jurisdictions, color combination marks in 13 jurisdictions, sound marks in 10 jurisdictions, position marks and motion marks in nine jurisdictions, holograms in eight jurisdictions, and single colors in six jurisdictions. Only Australia has registration of a smell mark, and there is no registration of touch or taste marks in all 26 countries and regions to date.

Conclusions

As one of the most diverse regions, the Asia-Pacific region has varied prosecution regimes for nontraditional trademarks. The matrix merely aims to offer a brief overview of the rules and practices governing nontraditional trademarks in this region. Brand owners hoping to register nontraditional trademarks in the region are advised to independently verify these findings and/or seek assistance from local counsel. The Non-Traditional Marks Committee, Asia-Pacific Subcommittee will continue updating the matrix as key decisions affecting the registration and prosecution of nontraditional trademarks are made.

Editor's Note

This is one of a series of feature articles authored by INTA's Non-Traditional Marks Committee discussing the protection and enforcement of nontraditional marks in various regions throughout the world. Previously in this series, the Committee published "A Look at Nontraditional Marks in Latin America and the Caribbean." Upcoming articles in this series will cover Canada, India, and the United States.