



**Asia-Pacific  
Economic Cooperation**

**Report for APEC Survey on  
Non-Traditional Trade Marks**

**APEC Intellectual Property Experts Group  
APEC Committee on Trade and Investment**

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## **Background & Overview**

Registration of non-traditional marks, for example sound and scent marks is arguably the most significant issue to emerge in trade mark law and practice in recent years. There are several types of non-traditional marks, and not all APEC economies recognise all these marks.

Fundamental questions such as what exactly is a “non-traditional trade mark” and how these are identified have arisen. In this light, member economies agreed at the APEC Intellectual Property Rights Experts’ Group XIX meeting held in August 2004 that a project on the Law and Best Practices to Examine Non-traditional Trade Marks (NTTM) among APEC Economies should be included in the work-plan of IPEG. Singapore, having initiated the survey, became the lead economy for this agenda item.

- What are the various definitions of trade marks in each economy and how do they allow protection for various types of non-traditional trade marks?
- What are the broad requirements to be fulfilled by applicants who wish to register non-traditional trade marks in each economy?
- In applying for non-traditional trade marks, where can one find guidance (e.g. examination guidelines used by IP offices) in order to submit an acceptable application?
- Is there case law available on non-traditional trade marks in the economies?
- What are some broad issues arising in the process of applying for and obtaining recognition for non-traditional trade marks from the perspective of the examiner and the applicant?
- How do the NTTM legislative regimes of the economies compare alongside the provisions of the Singapore Treaty on the Law of Trade Marks?

The survey endeavours to examine and analyse these issues. Singapore prepared a questionnaire (with inputs from various economies) which sought a range of information on the subject to enable sharing of information in line with the broad aims stated above. We would like to thank the 16 economies which have responded to the survey, listed in **Annex A**.

We also acknowledge the time and effort expended by the individuals in each economy which has completed the survey.

The responses to the survey have been digested and analysed by Singapore, but really would not have been possible without the collective effort of these economies. It is hoped that the Report will fulfil the aims stated above and generally contribute to the development of trade mark law and practice in APEC. Should you have any queries or comments on this report, please contact Mr Alvin Sim at (65) 6330 8629 and [Alvin\\_Sim@ipos.gov.sg](mailto:Alvin_Sim@ipos.gov.sg).

8 April 2008

## **A. Definition of Trade Mark in each APEC Economy**

1. Studying the definition of a trade mark in each APEC economy would help to provide insight into the types of NTTM eligible for protection or registration in the economies. Therefore, we have included a section on the definition of trade mark of each of the 16 economies in this report.

### **Protectable Subject Matter**

2. It is observed that all the 16 economies which have responded to the survey are members of the World Trade Organisation and hence, signatories to the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”).
3. Article 15 of the TRIPS Agreement states that “Any **sign**, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark...”. Hence, all the economies have incorporated this principle into their definition of trade mark.
4. It is also stated in the same article that “...Such **signs**, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks...”. Article 15 therefore describes the basic types of **signs** that are capable of being protected as trade marks in the economies.

### **Visual Perception vs Graphical Representation**

5. Most of the economies require NTTM to be graphically represented. In addition, some of the economies have incorporated an additional element of “**visual perception**” into their requirements for trade marks.<sup>1</sup>
6. It should be noted that the requirement of visual perception is different from the requirement of graphical representation.<sup>2</sup> A mark needs to be visible to the eye to satisfy the requirement of visual perception. However, a sign can be represented graphically by providing a pictorial representation, a written description or a combination of both. A sound mark or scent/smell mark may be capable of being graphically represented but not capable of visual perception.
7. Applying this idea, and from solely analysing the various definitions of trade marks submitted by the economies<sup>3</sup>, sound marks or scent/smell marks are not protected in the following economies – Canada, the People’s Republic of China, Japan, Republic of Korea, Mexico, Papua New Guinea, Philippines, Chinese Taipei (no protection for scent/smell marks), Thailand and Viet Nam.

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<sup>1</sup> Article 15 of the TRIPS Agreement states that “...Members may require, as a condition of registration, that signs be visually perceptible.”.

<sup>2</sup> **Editor’s comments:** Refer to the definition of trade marks of the People’s Republic of China, Mexico, Philippines, and Viet Nam. These economies have specific reference to “visual perception” in their definition or requirement of trade marks. In the definition of Japan, the Republic of Korea, Papua New Guinea and Thailand, “visual perception” is arguably implied.

<sup>3</sup> In response to Question A of the survey form.

## Definitions

8. The following definitions of trade marks have been provided by the respective economies. This report supplements such definitions by references to other parts of national legislation where necessary. *Unless otherwise indicated, comments on such definitions in the footnotes have also been provided by the respective economies.*

### Australia

9. A trade mark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person. [Section 17 of the Trade Marks Act 1995 of Australia]
10. A sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand heading, label, ticket, aspect of packaging, shape, colour, sound or scent. [Section 6 of the Trade Marks Act 1995 of Australia]<sup>4</sup>
11. To qualify for consideration as a trade mark, a sign must be able to be represented graphically. [Section 40 of the Trade Marks Act 1995 of Australia]<sup>5</sup>

### Canada

12. "Trade mark" means:
- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;
  - (b) a certification mark;
  - (c) a distinguishing guise; or
  - (d) a proposed trade mark.
- [Trade Marks Act of Canada]
13. The trade mark has to be represented graphically.  
An applicant for the registration of a trade mark shall file with the Registrar an application containing (...)  
(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade mark and such number of accurate representations of the trade marks as may be prescribed.  
[Section 30 of the Trade Marks Act of Canada]

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<sup>4</sup> This definition of a sign is non-exclusive and theoretically, any sign that can be represented graphically and is capable of distinguishing the goods and services of one trader from those of another will be registrable.

<sup>5</sup> Graphic representation can take a number of forms including:

- (1) a pictorial representation;
- (2) a written description of the mark; or
- (3) a combination of both.

## People's Republic of China

14. Any visual sign capable of distinguishing the goods or service of one natural person, legal person or any other organisation from those of others, including words, devices, letters of an alphabet, numerals, three-dimensional symbols, combinations of colours or any combination of the above elements may be applied for the registration of a trade mark. [Article 8 of the Trade Mark Law of the People's Republic of China]<sup>6</sup>

## Hong Kong, China

15. A "trade mark" means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically. [Section 3(1) of the Trade Marks Ordinance (Cap. 559) of Hong Kong]<sup>7</sup>

## Japan

16. "Trade mark" means any character(s), figure(s), sign(s), three-dimensional shape(s), or any combination thereof, or any combination thereof with colours:
- (i) which are used in respect of goods by a person who produces, certifies or assigns such goods in the course of trade;
  - (ii) which are used in respect of services by a person who provides or certifies such services in the course of trade (other than as in (i) above).
- [Article 2, paragraph 2 of the Trade Mark Law of Japan]<sup>8</sup>

## Republic of Korea

17. "Trade mark" is defined as either of the following (referred to as "a mark") that is used on goods related to the business of a person who conducts business activities, such as producing, processing, certifying or selling such goods, to distinguish them from the goods of others:
- (a) a sign, a character, a figure, a three-dimensional shape or any combination of these; or
  - (b) any combination of colour with any of the items of subparagraph (a) of this paragraph.
- [Article 2(1)(i) of the Trade Mark Act of the Republic of Korea]<sup>9</sup>

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<sup>6</sup> In simple words, a trade mark is a sign that distinguishes the origin of goods or service.

<sup>7</sup> The requirement of "graphical representation" of a trade mark is explained in pages 7-10 of the chapter on "Deficiency Checking" in the Hong Kong Trade Marks Registry Work Manual which is available at

[http://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/registry/Deficiencies%20checking.PDF](http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Deficiencies%20checking.PDF).

<sup>8</sup> Note that the Work Manual is only a practice manual and not part of Hong Kong legislation.

<sup>8</sup> According to the aforementioned definition, a "Trade mark" should be "perceptible by the eye." Therefore, sounds, odours and taste are not acceptable as a trade mark under the current Japanese trade mark system.

<sup>9</sup> The Trade Mark Act of the Republic of Korea only protects marks that are visibly recognizable.

## Mexico

18. A trade mark is defined as any visible sign that distinguishes products or services from others of the same type or category on the market. [Article 89 of the Industrial Property Law of Mexico]

## New Zealand

19. Trade mark -

- (a) means any **sign** capable of -
    - (i) being represented graphically; and
    - (ii) distinguishing the goods or services of one person from those of another person; and
  - (b) includes, -
    - (i) except in sections 83 to 87, a certification trade mark; and
    - (ii) except in sections 83 to 87, a collective trade mark
- [Section 5 of the Trade Marks Act 2002 of New Zealand]<sup>10</sup>

## Papua New Guinea

20. A “mark” includes “*a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination of them*”. [Trade Mark Law of Papua New Guinea]

## Peru

21. Any sign that is capable of distinguishing goods and services on the market shall constitute a mark. Signs that are capable of graphic representation shall be eligible for registration as marks. [Article 134 of Decision 486, Common Intellectual Property Regime<sup>11</sup>]

22. This article also states that the following signs, among others, shall be capable of constituting a trade mark:

- (a) words or a combination of words;
- (b) pictures, figures, symbols, graphic elements, logotypes, monograms, portraits, labels, and emblems;
- (c) sounds and smells;
- (d) letters and numbers;
- (e) a colour demarcated to give it a specific shape, or a combination of colours;
- (f) the shape of a product, its packaging or wrappings;
- (g) any combination of the signs or means indicated in the items above.<sup>12</sup>

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<sup>10</sup> Sections 83 to 87 of the Trade Marks Act 2002 of New Zealand are sections of the Act dedicated to Licensees. They refer to the Application for registration of licensee, Registration of licensee, Assigning or transmitting right to use trade mark, Alteration of registration of licensee and Cancellation of registration of licensee. The Trade Marks Act 2002 of New Zealand can be accessed at <http://www.legislation.govt.nz/>.

<sup>11</sup> Communitarian Law, applied in the Andean Community countries. These are Peru, Columbia, Ecuador and Bolivia.

<sup>12</sup> In short, distinctiveness and graphic representation are required for registration as mark.

## **Philippines**

23. A mark is any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods [Section 121.1, Republic Act No. 8293 or the Intellectual Property Code of the Philippines].
24. A trademark must be visible to the eye, capable of distinguishing the goods of an enterprise and is not prevented from registration under Section 123 of the said Intellectual Property Code.

## **Singapore**

25. "Trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person. [Section 2(1) of the Trade Marks Act of Singapore]

## **Chinese Taipei**

26. A trade mark may be composed of a word, figure, symbol, colour, sound, three-dimensional shape or a combination thereof. A trade mark as defined above shall be distinctive enough for relevant consumers of the goods or services to recognize it as identification to that goods or services and to differentiate such goods or services from those offered by others. [Article 5 of the Trade Mark Act 2003 of Chinese Taipei]
27. When filing for a trade mark application, the applicant shall submit an application stating the proposed trade mark, and the designated use on goods or services and the class(es) thereof to the Registrar Office. The trade mark referred to in the preceding paragraph shall be expressed in a visually perceptible representation. [Article 17 of the Trade Mark Act 2003 of Chinese Taipei]

## **Thailand**

28. "Trade mark" means a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trade mark of the owner of such trade mark is used from goods under another person's trade mark.
29. In turn, "mark" means a photograph, drawing, device, brand, name, word, letter, manual, signature, combinations of colours, shape or configuration of an object or any one or combination thereof.

## **United States**

30. The term "trade mark" includes any word, name, symbol, or device, or any combination thereof –
- (1) used by a person, or

- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured, or sold by others and to indicate the source of the goods, even if that source is unknown. [Section 45 of the Trade Mark Act of the United States]<sup>13</sup>

## **Viet Nam**

31. The term “trade mark” is construed as any sign used to distinguish goods or services of different organisations and individuals.

32. To be eligible for protection as a trade mark, it should meet the following conditions:

- (1) To be a visible sign in the form of letters, words, pictures, figures, including three dimensional figures or a combination thereof, represented in one or more colours;
- (2) To be capable of distinguishing goods or services of the mark owner from those of others.

[See Articles 4, 72, 73 and 74 of the Intellectual Property Law of Viet Nam]

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<sup>13</sup> A trade mark does not have to be visually perceptible. For example, sound marks and scent marks are eligible for registration in the United States. A mark that is not visually perceptible must be represented by including in the application some description of the mark. Section 807.09 – 807.11 of the Trade Mark Manual of Examining Procedure (TMEP) is used by the examining attorneys to determine how these marks must be depicted.

## **B. Types of Non-Traditional Trade Marks allowed**

33. We have included a table to aid in identifying the types of NTTM that may be protected / registered in each economy; and whether such NTTM has been successfully registered. The more common types of NTTM, namely sound mark, scent/smell mark, trade dress, holograms, colour mark and 3-dimensional mark, are included in the table. Any comments on such NTTM in each economy is set out in the “Notes” after the table. Unless otherwise indicated, these comments have been provided by the respective economies.
34. Applicants should find this information useful as a first step in determining if they would be able to seek protection for their NTTM in the various economies. In the event that an economy wants a review of their NTTM protection, this table should also serve as a useful guide in helping to shortlist the appropriate economies’ legislation for reference purposes.

### **Observations**

35. The range of NTTM allowed for registration and protection differs across the economies that had responded to the survey. Although all economies extend protection to at least one form of NTTM, a few economies (i.e. Japan and Mexico) appear to offer protection to only one kind of NTTM while some economies (i.e. Australia, Hong Kong, New Zealand, Peru and the United States) offer protection for the full range of NTTM listed in the survey.
36. The NTTM that may be protected in all economies is the 3-dimensional mark.
37. Colour marks are the next most common NTTM that may be protected. It is noted that most economies protecting such marks either generally disallow marks of a single colour or take the view that they may lack distinctive character and thus, are not likely to be registrable.
38. It is interesting to note that in more than 30% of the economies (i.e. 5 out of 16 economies), there is no registered example of one or more types of NTTM although such NTTM may be protected in the said economies. This may indicate that although economies do allow NTTMs to be protected, applicants may not:
- (i) be fully aware of the possibility of registering a certain NTTM or
  - (ii) have enough information or knowledge on how to go about protecting the same NTTMs.
39. In particular, attempts to register scent/smell marks had been successful only in the United States. For other economies that may allow the registration of scent/smell marks, there has either not been any such application or the application had been unsuccessful. This may be due to the difficulty in representing scent/smell marks to the trade mark office in an acceptable manner.

	Sound Mark	Scent / Smell Mark	Trade Dress	Holograms	Colour Mark	3-D Mark	Others
<b>Australia</b>	•	◇	•	•	•	•	See note 1.
<b>Canada</b>	See note 2.	See note 2.	• See note 3.		• See note 4.	• See note 5.	
<b>People's Republic of China</b>					• See note 6.	•	
<b>Hong Kong, China</b>	•	◇	•	◇	•	•	
<b>Japan</b>						•	
<b>Republic of Korea</b>				◇ See note 7.	◇ See note 7.	•	See note 7.
<b>Mexico</b>			See note 8.			•	
<b>New Zealand</b>	•	◇ See note 9.	• See note 10.	• See note 11.	•	•	See note 12 and 13.
<b>Papua New Guinea</b>					•	•	
<b>Peru</b>	•	◇	• See note 14.	•	• See note 14.	•	
<b>Philippines</b>			• See note 15.	• See note 15.	• See note 15.	• See note 15.	
<b>Singapore</b>	•	See note 16.	•	•	•	•	See note 17.
<b>Chinese Taipei</b>	•		• See note 18.		•	•	
<b>Thailand</b>					• See note 19.	•	
<b>United States</b>	•	•	•	•	•	•	See note 20.
<b>Viet Nam</b>			•			•	

Legend:

- = Trade marks with actual registered examples
- ◇ = Trade marks may be allowed but with no registered examples

Notes:

- (1) Any sign that can be represented graphically and meet the appropriate tests can be registered as a trade mark in Australia.
- (2) Sound and scent/smell marks are excluded from registration in Canada based on the decision in *Playboy Enterprises Inc. v Germain* (No. 1) 1987 16 C.P.R. (3d) 517.
- (3) Such marks are not referred to as trade dress in Canada. The requirements for registrability of a 3-dimensional mark are dependent upon whether the mark falls within the definition of distinguishing guise in Section 2 of the Trade Mark Act of Canada and accordingly upon whether the mark is a shaping of wares or their containers, or is a mode of wrapping or packaging wares. If a 3-dimensional mark falls within the definition of a distinguishing guise, it may be registered only as a distinguishing guise (and is subject to the special requirements applicable to registration of distinguishing guises) and cannot be registered as an ordinary trade mark. (**Editor's note:** In Canada's response, it is not indicated if trade dress had been successfully registered in Canada as a trade mark. The data on its registration in Canada is derived from searches done on the Canadian Trade Marks Database at <http://strategis.ic.gc.ca/app/cipo/trademarks/search/tmSearch.do?language=eng> .)
- (4) Colour per se is not registrable in Canada. However, applicants may claim colour as a feature of a mark. In addition, applicants may register trade marks consisting only of one or more colours applied to the whole of the visible surface of a particular 3-dimensional object, trade marks consisting only of one or more colours applied in a particular position or positions on a particular 3-dimensional object, trade marks consisting of only one or more colours in combination with reading matter and/or 2-dimensional design elements, the elements of the mark being applied in a particular position or positions on a particular 3-dimensional object. (**Editor's note:** In Canada's response, it is not indicated if colour marks had been successfully registered in Canada as a trade mark. The data on its registration in Canada is derived from searches done on the Canadian Trade Marks Database at <http://strategis.ic.gc.ca/app/cipo/trademarks/search/tmSearch.do?language=eng> .)
- (5) In Canada, if a 3-dimensional mark does not fall within the definition of a distinguishing guise, it may be registered as an ordinary trade mark. (Also, see Note 3.) (**Editor's note:** In Canada's response, it is not indicated if 3-dimensional marks had been successfully registered in Canada as a trade mark. The data on its registration in Canada is derived from searches done on the Canadian Trade Marks Database at <http://strategis.ic.gc.ca/app/cipo/trademarks/search/tmSearch.do?language=eng> .)
- (6) **Editor's note:** The People's Republic of China has indicated that applications for colour combination marks are acceptable in the People's Republic of China. It is not clear if a single colour mark may be protected in the People's Republic of China.
- (7) A bill came into effect in July 2007 in the Republic of Korea which extended protection to a mark purely composed of a colour, a hologram, a motion mark and all other marks that are visibly recognizable.
- (8) The legislation of Mexico does not protect trade dress as a distinctive sign. However, the following is recognized as an administrative infringement - the use of a combination of distinctive signs, operative and distinctive elements that identify products or services identical or confusingly similar to others protected by the Industrial Property Law, and that could be deceptive or misleading for the public, understood that they could constitute a false indication of the existence of a relationship between the holder and the unauthorized user.

[Amendments to the Industrial Property Law of Mexico (January 2006)] The use of those distinctive elements is considered unfair competition. [Article 213(XXVI) of the Industrial Property Law of Mexico]

- (9) Only one application had been filed for a smell mark in New Zealand. However, an objection was raised against the application on the grounds of non-distinctiveness and the application was abandoned in 1997.
- (10) No marks are specifically registered / described as “trade dress” in New Zealand. Such applications are dealt with in the same manner as device or 3-dimensional marks.
- (11) No marks are specifically registered / described as “holograms” in New Zealand. Such applications are dealt with in the same manner as device marks. (Also, see Note 13.)
- (12) Taste marks are also included within the definition of “sign” in New Zealand. However, no such application has been filed, and there are no specific guidelines for examination yet.
- (13) Applications for “animation” marks have also been accepted in New Zealand.
- (14) In Peru, Trade dress is not treated as a separate category and must be registered as a mixed, figurative or 3-dimensional mark. With respect to colour marks, signs that consist solely of one colour, without any demarcation to give it a specific shape, may not be registered as marks [Article 135 of Decision 486].
- (15) Registrable as an ordinary trade mark, and not specially categorised as trade dress, holograms or colour marks respectively. In respect of colour marks, the colour or colours must be defined by a given form. In the Philippines, 3-dimensional marks are registrable as ordinary trademarks, but with specification that they are 3-dimensional marks or with a statement to that effect. [Section 124(h), Intellectual Property Code of the Philippines]
- (16) In Singapore, no application has been received for scent/smell mark. It is unlikely that scent/smell marks would be registrable in Singapore as it appears that at the present stage of technology, there is no acceptable graphical representation for such marks.
- (17) Moving marks may also be registered in Singapore.
- (18) Trade dress (e.g. the décor of the place where services are performed, or the shape of the packaging of the goods which is often used in combination with word(s), design(s) and/or colour(s), giving consumers a visually unitary impression) is registered as 3-dimensional mark in Chinese Taipei.
- (19) In Thailand, only a combination colours mark can be registered. A single colour mark cannot be registered.
- (20) Motion marks have also been registered in the United States.

**C. Information to be furnished by applicants when seeking to register NTTM**

40. Information required by individual trade mark offices for the registration of NTTMs may vary:

- (i) between different types of NTTM; and
- (ii) between economies for a particular NTTM.

41. This section serves as a reference to those interested in registering a particular NTTM in the different economies. The information provided is based on, or adapted from the various economies' trade marks examination manuals and guidelines.

42. The following table lays out the key information that applicants need to submit to each trade mark office when lodging an application to register their NTTMs. It is hoped that this information would give applicants a clear starting point on how to obtain successful registration of their NTTMs.

43. For details of the official forms to be completed for such applications and application procedures, applicants should approach the intellectual property office concerned.

<b>Economy</b>	<b>Information to be furnished by applicants</b>
Australia	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A graphical representation of the mark - This may be a simple verbal description of the sounds. Musical notation is also acceptable as a graphical representation of a sound mark consisting of a musical piece.</li> <li>• A description of the mark</li> <li>• Recordings of the mark on a medium which allows for easy replaying - Audio tapes, Compact Discs or other media which are easily and commonly accessible are acceptable.</li> </ul> <p><u>Scent/Smell Mark</u></p> <ul style="list-style-type: none"> <li>• A graphical representation of the scent mark – This could be a precise verbal description of the scent.</li> <li>• A description of the scent</li> <li>• An actual sample of the scent is not required at filing but may be needed during the course of examination.</li> </ul> <p><u>Trade Dress<sup>14</sup></u></p> <ul style="list-style-type: none"> <li>• A representation of the mark - Where practicable, it should be in the form of perspective or isometric drawings that show clearly all the features of the trade mark.</li> <li>• A written description of the mark – This must accompany the drawings, views and/or photograph of the mark.</li> </ul>

<sup>14</sup> **Editor's comments:** The IP Australia Trade Marks Office Manual of Practice and Procedure did not indicate the information required for registering a Trade Dress. However, paragraph 3.8 of the manual states that "The same considerations as to functionality and capability to distinguish that apply to the shape or configuration of the goods themselves also apply to the shape or configuration of the packaging of goods".

Economy	Information to be furnished by applicants
	<p><u>Hologram</u></p> <ul style="list-style-type: none"> <li>No information is available/provided for the registration of a hologram.</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>A pictorial representation showing the colour claimed and the manner in which it is to be applied to the goods or packaging (especially in cases where the description is complex)</li> <li>A description of the mark</li> <li>An example of the actual colour or colour combination claimed</li> <li>If the applicant chooses to define the colour(s) more precisely by the use of a recognized colour matching system, this reference may be included in the descriptive endorsement.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>A representation of the mark - Where practicable, it should be in the form of perspective or isometric drawings that show clearly all the features of the trade mark.</li> <li>A written description of the mark – This must accompany the drawings, views and/or photograph of the mark.</li> </ul> <p>More information can be obtained from Part 21 of the IP Australia Trade Marks Office Manual of Practice and Procedure<sup>15</sup>.</p>
Canada	<p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>A drawing/drawings of the mark</li> <li>Evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade mark has been used in Canada and with other evidence such as sales figures; sample advertising; specimens (pictures)</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>A drawing</li> <li>A description that the colour is applied to the whole visible surface of the particular object as shown in the drawing</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>A drawing/drawings of the mark</li> <li>A description of the mark – The description should make clear that the mark is a 3-dimensional mark.</li> </ul> <p>More information can be obtained from the Practice Notice for 3-Dimensional Marks of the Canadian Intellectual Property Office<sup>16</sup>.</p>

<sup>15</sup> The IP Australia Trade Marks Office Manual of Practice and Procedure can be accessed at [http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade\\_marks\\_examiners\\_manual.htm](http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm).

<sup>16</sup> The Practice Notice for 3-Dimensional Marks of the Canadian Intellectual Property Office can be accessed at [http://strategis.ic.gc.ca/sc\\_mrksv/cipo/tm/tm\\_notice/tmn2000-12-06-e.html](http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/tm_notice/tmn2000-12-06-e.html).

Economy	Information to be furnished by applicants
People's Republic of China	<p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A statement indicating the application for the registration of a colour mark</li> <li>• A clear-cut colour reproduction of the mark, indicating the code numbers of the colours used</li> <li>• A description of the mark</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A statement indicating the application for the registration of a 3-dimensional mark</li> <li>• A reproduction by which the 3-dimensional shape can be determined</li> <li>• Where multiple views are submitted, such views should be limited to 6 in one trademark application</li> </ul> <p>Detailed information can be obtained from Article 13 of the Regulations for the Implementation of Trade Mark Law<sup>17</sup> and Part 5 of the Guidelines for Trade Mark Review and Examination of the People's Republic of China<sup>18</sup>.</p>
Hong Kong, China	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A graphical representation of the mark – This requirement is met where it is represented by a stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.</li> <li>• A description of the mark</li> </ul> <p><u>Scent/Smell Mark</u></p> <ul style="list-style-type: none"> <li>• A graphical representation of the mark – A mark was not sufficiently described if it required the assumption of a previous experience on the part of the examiner. The requirements of graphic representability are also not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.</li> <li>• A description of the mark</li> </ul> <p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>• No additional information is available/provided for the registration of trade dress<sup>19</sup></li> </ul>

<sup>17</sup> The Regulations for the Implementation of Trade Mark Law of the People's Republic of China can be accessed at <http://sbj.saic.gov.cn/english/show.asp?id=53&bm=flfg> .

<sup>18</sup> The Guidelines for Trade Mark Review and Examination of the People's Republic of China is not available in English.

<sup>19</sup> Trade dress could be the packaging of the goods, shape of the goods or colour(s) as a trade mark. The applicant should state precisely what he is claiming and the requirements applicable to each of those claims should be adhered to.

Economy	Information to be furnished by applicants
	<p><u>Hologram</u></p> <ul style="list-style-type: none"> <li>No additional information is available/provided for the registration of a hologram.</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>A statement claiming the colour or colours as the mark, or as an element or elements of the mark</li> <li>A representation of the mark in the particular colour(s) claimed</li> <li>A description in words of the colour(s) concerned</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>A representation of the mark</li> <li>A statement claiming the shape as the mark or as an element of the mark</li> <li>A description of the mark</li> </ul> <p>Detailed information can be obtained from the chapter on “Deficiencies Checking”, “Colour Marks”, “Shape Marks” and “Sound Marks” of the Hong Kong Trade Marks Registry Work Manual<sup>20</sup>.</p>
Japan	<p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>A description of the mark</li> </ul> <p>Note: A sample of the 3-dimensional mark may be submitted. However, the mark will only be examined based on the description in the application.</p> <p>Detailed information can be obtained from “Part 2: Principal Paragraph of Article 3(1)” of the Examination Guidelines for Trade Marks of the Japan Patent Office, Trade Mark Division<sup>21</sup>.</p>
Republic of Korea	<p><u>Holograms</u></p> <ul style="list-style-type: none"> <li>No information is available/provided for the registration of holograms.</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>No information is available/provided for the registration of a colour mark.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>A representation of the mark in the form of perceptive or isometric drawings or photographs that clearly show all features of the mark</li> <li>A description of the mark</li> </ul>

<sup>20</sup> The Hong Kong Trade Marks Registry Work Manual can be accessed at [http://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/registry.htm](http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm).

<sup>21</sup> The Examination Guidelines for Trade Marks of the Japan Patent Office, Trade Mark Division can be accessed at [http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/tt1302-002.htm](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-002.htm).

Economy	Information to be furnished by applicants
Mexico	<u>3-Dimensional Mark</u> <ul style="list-style-type: none"> <li>• 6 drawings or photographs of the figure that show the three planes: width, height and volume</li> </ul>
New Zealand	<u>Sound Mark</u> <ul style="list-style-type: none"> <li>• A graphical representation of the mark - Where possible, include a musical score showing the notes included in the application for registration</li> <li>• A written description of the sound</li> <li>• A sound file containing the sound in .mp3 format, not exceeding 1MB, and not allowing loops or streaming</li> <li>• If the musical instrument used to produce the sound forms part of the mark, this should be stated.</li> </ul> <u>Scent/Smell Mark</u> <ul style="list-style-type: none"> <li>• A written description of the mark</li> </ul> <u>Trade Dress<sup>22</sup></u> <ul style="list-style-type: none"> <li>• A clear, graphical representation of the mark – There are no specific rules for “trade dress”. Therefore, the general principles for all trade marks apply.</li> </ul> <u>Hologram<sup>23</sup></u> <ul style="list-style-type: none"> <li>• A clear, graphical representation of the mark – There are no specific rules for “holograms”. Therefore, the general principles for all trade marks apply.</li> </ul> <u>Colour Mark<sup>24</sup></u> <ul style="list-style-type: none"> <li>• A representation of the colour(s); or</li> <li>• A description of the colour(s) using a widely known and readily available colour standard. It should also include information on how the colour(s) are being used, or are to be used, in relation to their goods or services.</li> </ul> <u>3-Dimensional Mark</u> <ul style="list-style-type: none"> <li>• A representation of the mark – It must be in a form that clearly shows all of the features of the mark. Unless the subject matter can be demonstrated by a single perspective view, multiple views of the shape are necessary.</li> <li>• A written description of the mark</li> </ul> <u>Others – Animated Image</u>

<sup>22</sup> In New Zealand, applications relating to trade dress are dealt with in the same manner as device or 3-dimensional marks.

<sup>23</sup> In New Zealand, applications relating to holograms are dealt with in the same manner as device marks.

<sup>24</sup> This information for colour marks in New Zealand relates only to applications to register a colour or colours as a trade mark, not where colour is an element of a device or pictorial mark.

Economy	Information to be furnished by applicants
	<ul style="list-style-type: none"> <li>• A sequence of still pictures</li> <li>• A written description of the nature of the mark and the sequence corresponding to the mark in use</li> </ul> <p><u>Others – Taste Mark</u></p> <ul style="list-style-type: none"> <li>• No information is available/provided for the registration of a taste mark.</li> </ul> <p>Detailed information can be obtained from “Part 05: Absolute Grounds Distinctiveness” of the Practice Guidelines of the Intellectual Property Office of New Zealand<sup>25</sup>.</p>
Papua New Guinea	<p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A sample of the mark</li> <li>• If the mark is refused by the examiner because of the nature of the mark, the applicant will be requested to provide evidence of its distinctiveness by way of submission of documentary evidence in a form of sworn statement.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A sample of the proposed mark</li> <li>• If the mark is refused by the examiner because of the nature of the mark, the applicant will be requested to provide evidence of its distinctiveness by way of submission of documentary evidence in a form of sworn statement.</li> </ul>
Peru	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A graphic representation of the mark</li> <li>• A description of the mark</li> <li>• Audiocassettes and compact disk containing the sound or melody to be registered as a mark</li> </ul> <p><u>Smell/scent Mark</u></p> <ul style="list-style-type: none"> <li>• No information is available/provided for the registration of a smell/scent mark.</li> </ul> <p><u>Holograms</u></p> <ul style="list-style-type: none"> <li>• Visual views of the hologram.</li> <li>• A description of the hologram</li> </ul>

<sup>25</sup> The Practice Guidelines of the Intellectual Property Office of New Zealand can be accessed at [www.iponz.govt.nz](http://www.iponz.govt.nz) > Information Library > 02 Trade Marks > 3 Trade Mark Practice Guidelines > Trade Marks Act 2002.

Economy	Information to be furnished by applicants
	<p><u>Color Mark</u><sup>26</sup></p> <ul style="list-style-type: none"> <li>• A graphic representation of the mark.</li> <li>• A description of the mark.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark which presents the mark in 3-dimension and depicts a single rendition of the mark.</li> <li>• A description of the mark.</li> </ul> <p><u>Note</u> : Applicants are allowed to deposit a sample for 3-dimensional marks. However, they are used by the examiners for reference only.</p>
Philippines	<p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• If the applicant claims color as a distinctive feature of the mark : a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color.</li> <li>• One or more reproductions of the mark, as prescribed in the Rules of Practice in Trademark and Service Marks.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• Where the mark is a three-dimensional mark, a statement to that effect.</li> <li>• One or more reproductions of the mark, as prescribed in the Rules of Practice in Trademark and Service Marks.</li> </ul> <p><u>Note</u> : In respect of Trade Dress and Holograms, the information to be furnished follows the requirements found in Section 124 of the Intellectual Property Code of the Philippines<sup>27</sup> , applicable to all trademarks generally.</p>
Singapore	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A representation of the mark – Sound marks are to be represented by a stave divided into measures, showing, in particular, a clef, musical notes, rests and where, necessary, accidentals.</li> <li>• A description of the mark</li> <li>• 2 copies of CD recording of the mark</li> </ul> <p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>• Trade dress could be the packaging of the goods, shape of the goods or colour(s) as a trade mark. The applicant should state precisely what he is claiming and the requirements applicable to</li> </ul>

<sup>26</sup> In Peru, a color demarcated to give it a specific shape, or a combination of colors may be registered as a trademark [Article 134 of Decision 486].

<sup>27</sup> The Intellectual Property Code of the Philippines can be accessed at <http://www.ipophil.gov.ph/IPCode/IPCodeMain.htm>

Economy	Information to be furnished by applicants
	<p>each of those claims should be adhered to.</p> <p><u>Holograms</u></p> <ul style="list-style-type: none"> <li>• Visual views of the hologram in various frames with descriptions of angle and appearance (unless it is a simple hologram in which the essential features do not change)</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A representation of the mark in the colour(s) claimed – It is important for the applicant to be precise about his claims for protection, such as the specific arrangement of colour(s) and the manner of application of the colour(s) to the goods or their packaging or to other commercial item.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A representation of the mark – Where practicable, it should be in the form of a perspective or isometric drawing that shows clearly all the features of the mark.</li> <li>• Various visual views of the mark (unless all aspects of the shape can be captured from a single view)</li> </ul> <p>Note: For the various marks, samples are useful only for reference purpose and do not qualify as representation of the mark.</p>
Chinese Taipei	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A representation of the mark by musical score, numerical musical score or a written description – If the musical score or numerical score is provided, a written description shall also be enclosed.</li> <li>• A CD recording of the sound for reference.</li> </ul> <p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>• See the requirements for a 3-Dimensional Mark.<sup>28</sup></li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A graphical representation of the mark</li> <li>• A description of the mark – The colour(s) shall be specified along the description. The applicant may choose to define the colour(s) more precisely by the use of a recognized colour matching system.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark in 3-dimensional form</li> <li>• A description of the mark</li> <li>• To present the exact image of the 3-dimensional shape of the trademark, the applicant may submit at the same time, a maximum</li> </ul>

<sup>28</sup> Trade Dress (e.g. the décor of the place where services are preformed, or the shape of the packaging of the goods which is often used in combination with word(s), design(s) and/or colour(s), giving consumers a visually unitary impression) is registered as a 3-Dimensional Mark in Chinese Taipei.

Economy	Information to be furnished by applicants
	<p>of five additional perspective drawings or samples in different views but with the same scales.</p> <p>Detailed information can be obtained from the Examination Guidelines for 3-Dimensional, Colour and Sound Trade Marks of the Intellectual Property Office of Chinese Taipei<sup>29</sup>.</p>
Thailand	<p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A description of the combination of colours and the arrangement of those colours</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• The pictures of the mark taken from various angles</li> </ul> <p>Note: For the various marks, deposit of sample is acceptable as reference.</p>
United States	<p><u>Sound Mark</u></p> <ul style="list-style-type: none"> <li>• A description of the mark</li> <li>• Audio cassettes and compact disks may be accepted as specimens – The specimen should contain a sufficient portion of the audio content to indicate the nature of the services.</li> <li>• A musical score may be submitted as a specimen if the mark comprises music or words set to music</li> </ul> <p><u>Scent/Smell Mark</u></p> <ul style="list-style-type: none"> <li>• A description of the mark</li> </ul> <p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>• A drawing that depicts the mark in a single rendition – if the mark comprises the design of only a portion of a product or container, broken lines should be used in the drawing to indicate that portion of the product or container that is not claimed as part of the mark.</li> <li>• A description of the mark – if applicable, the description must clearly indicate the portion of the product or container that the mark comprises.</li> </ul> <p><u>Hologram</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark</li> </ul> <p><u>Colour Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing showing the mark in colour</li> <li>• A description of the mark, naming the colour(s)</li> <li>• A colour claim naming the colour(s) that are a feature of the mark</li> <li>• A separate statement describing where the colour(s) appear and</li> </ul>

<sup>29</sup> The Examination Guidelines for 3-Dimensional, Colour and Sound Marks of the Intellectual Property Office of Chinese Taipei can be accessed at <http://www.tipo.gov.tw/eng/laws/crite12.asp>

Economy	Information to be furnished by applicants
	<p>how they are used on the mark</p> <ul style="list-style-type: none"> <li>• A specimen that shows use of the mark depicted in the drawing</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark – It should present the mark in 3-dimension and depicts a single rendition of the mark.</li> <li>• A description of the mark – It should indicate that the mark is 3-dimensional.</li> </ul> <p><u>Others – Motion Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark – It may depict a single point in the movement, or up to 5 freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark</li> <li>• A description of the mark</li> </ul> <p>General Note:</p> <p>(1) For all the marks, applicants are required to provide samples (specimens) of how the mark is used in commerce, unless the application is based on intent-to-use or on a foreign filing.</p> <p>(2) If the mark is a composite of both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter</p> <p>Detailed information can be obtained from the Trade Mark Manual of Examining Procedure<sup>30</sup> and the US Trade Mark Law: Rules of Practice &amp; Federal Statutes<sup>31</sup> of the United States Patents &amp; Trade Marks Office.</p>
Viet Nam	<p><u>Trade Dress</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark – It should provide the perspectives of the mark.</li> </ul> <p><u>3-Dimensional Mark</u></p> <ul style="list-style-type: none"> <li>• A drawing of the mark – It should provide the perspectives of the mark.</li> </ul>

## Observations

44. A clear graphical representation of the mark needs to be submitted in an application for a NTTM in most economies. Some economies also require a clear written representation of the mark.

<sup>30</sup> The Trade Mark Manual of Examining Procedure of the United States Patent and Trade Mark Office can be accessed at <http://tess2.uspto.gov/tmdb/tmep/> .

<sup>31</sup> The US Trade Mark Law: Rules of Practice & Federal Statutes of the United States Patent and Trade Mark Office can be accessed at <http://www.uspto.gov/web/offices/tac/tmlaw2.html> .

45. It is noted that in economies where sound mark and scent/smell mark can be registered, a description of the mark would satisfy the requirement of graphical representation for such marks. (E.g. Australia, New Zealand and the United States)

46. For most economies, deposits of samples are only used for reference and not for the examination of the mark.

47. The following table provides a quick snapshot of the key information required for registration of each NTTM in various economies.

Type of mark	Protected in which economy	Key information required
Sound Mark	Australia Hong Kong, China New Zealand Peru Singapore Chinese Taipei United States	<ul style="list-style-type: none"> <li>Representation of the mark (All economies)</li> <li>Description of the mark (All economies)</li> <li>Recordings of the mark (All economies, except Hong Kong, China)</li> </ul>
Scent/smell Mark	Australia Hong Kong, China New Zealand Peru* United States	<ul style="list-style-type: none"> <li>Representation of the mark (Australia and Hong Kong, China)</li> <li>Description of the mark (All economies)</li> <li>Actual sample of the scent/smell (Australia – may be needed during the course of examination)</li> </ul>
Trade Dress	Australia Canada Hong Kong, China New Zealand Peru <sup>32</sup> Philippines Singapore <sup>33</sup> Chinese Taipei United States Viet Nam	<ul style="list-style-type: none"> <li>Representation of the mark (All economies)</li> <li>Description of the mark (Australia, Hong Kong, China Singapore, Chinese Taipei and United States)</li> <li>Evidence of use (Canada, Philippines)<sup>34</sup></li> </ul>
Holograms	Australia* Hong Kong, China* Republic of Korea*	<ul style="list-style-type: none"> <li>Representation of the mark (All economies)</li> <li>Evidence of use (Philippines – see note</li> </ul>

<sup>32</sup> In Peru, Trade dress is not treated as a separate category and must be registered as a mixed, figurative or 3-dimensional mark.

<sup>33</sup> Trade dress could be the packaging of the goods, shape of the goods or colour(s) as a trade mark. The applicant should state precisely what he is claiming and the requirements applicable to each of those claims should be adhered to.

<sup>34</sup> **Editor's notes:** We understand that in practice, evidence of use in most economies would be required if the mark is not considered distinctive. Note that in the Philippines, the applicant or registrant **must** submit declaration of actual use with evidence to that effect in all trade mark applications **within 3 years from the filing date of such application** [S.124.2, Intellectual Property Code of the Philippines]. One should thus check with the relevant trade mark registry or local solicitors or trade mark agents prior to applying to register a trade dress as a trade mark.

Type of mark	Protected in which economy	Key information required
	New Zealand Peru Philippines Singapore United States	34) • Description of the mark (Peru)
Colour Mark	Australia Canada People's Republic of China Hong Kong, China Republic of Korea* New Zealand Papua New Guinea Peru Philippines Singapore Chinese Taipei Thailand United States	<ul style="list-style-type: none"> <li>• Representation of the mark (All economies, except Thailand)</li> <li>• Description of the mark (All economies, except Papua New Guinea and Singapore)</li> <li>• Sample of the mark (Australia, Papua New Guinea and United States)</li> <li>• Use of a recognised colour matching system to define the colour(s) (Australia, People's Republic of China and New Zealand)</li> <li>• A colour must be demarcated to give it a specific shape, or there must be a combination of colours (Peru)</li> <li>• A statement claiming colour as a distinctive feature of the mark, the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour (Philippines)</li> <li>• Mark must be defined by a given form (Philippines)</li> <li>• Evidence of use (Philippines – see note 34)</li> </ul>
3-dimensional Mark	Australia Canada People's Republic of China Hong Kong, China Japan Republic of Korea Mexico New Zealand Papua New Guinea Peru Philippines Singapore Chinese Taipei Thailand United States Viet Nam	<ul style="list-style-type: none"> <li>• Representation of the mark (All economies, except Japan)</li> <li>• Description of the mark (Australia, Canada, Hong Kong, China, Japan, Republic of Korea, New Zealand, Chinese Taipei, United States)</li> <li>• Evidence of use (Philippines – see note 34)</li> </ul>
Others – Motion	Republic of Korea*	• Representation of the mark (Singapore,

Type of mark	Protected in which economy	Key information required
Mark / Moving Mark	Singapore* United States	United States) • Description of the mark (Singapore, United States)
Others – Taste Mark	New Zealand*	-
Others – Animated Image	New Zealand	<ul style="list-style-type: none"> <li>• Sequence of still pictures</li> <li>• Description of the mark and the sequence corresponding to the mark in use</li> </ul>

Note: \* denotes that no information is available/provided for the registration of such mark in the economy.

**D. Examination Guidelines, Tools or Reference Used in the Course of Examination of NTTM**

48. Applicants (or their solicitors or trade mark agents) attempting to register NTTMs for the first time may find it helpful to understand the examination guidelines used by intellectual property offices in determining registrability. Such understanding may be crucial for applicants who wish to protect NTTMs in multiple economies.
49. To facilitate the above, we have prepared a table listing the examination guidelines, tools or other references used by the examiners of the intellectual property offices in their course of examination of NTTM. Where these materials are available online, we have also provided the URL for applicants / their solicitors' or trade mark agents' easy reference.
50. The guidelines, tools and references listed are provided by the economies. Where no written guidelines are provided/available, we have indicated accordingly together with any other comments/notes given by the economies.
51. It is hoped that the information in this table would direct applicants to references which would aid the registration of their proposed NTTM.

Economy	Examination Guidelines, Tools or Reference used in the course of examination of NTTM
Australia	<p>Sound Mark; Scent/Smell Mark; Trade Dress; Hologram; Colour Mark; 3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• IP Australia Trade Marks Office Manual of Practice and Procedure (Part 21 – Shapes, Sounds, Colours, Scents and Aspects of Packaging)</li> </ul> <p>The above manual can be accessed at <a href="http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm">http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm</a> .</p>
Canada	<p>Trade Dress; Colour Mark</p> <ul style="list-style-type: none"> <li>• Trade Marks Examination Manual of the Canadian Intellectual Property Office</li> </ul> <p>3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Trade Marks Examination Manual of the Canadian Intellectual Property Office</li> <li>• Practice Notice for 3-Dimensional Marks of the Canadian Intellectual Property Office</li> </ul> <p>The Trade Marks Examination Manual can be accessed at <a href="http://strategis.gc.ca/sc_mrksv/cipo/tm/tm_exam_man-e.html">http://strategis.gc.ca/sc_mrksv/cipo/tm/tm_exam_man-e.html</a> .</p> <p>The Practice Notice for 3-Dimensional Marks can be accessed at <a href="http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/tm_notice/tmn2000-12-06-e.html">http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/tm_notice/tmn2000-12-06-e.html</a> .</p>

<b>Economy</b>	<b>Examination Guidelines, Tools or Reference used in the course of examination of NTTM</b>
People's Republic of China	Colour Mark; 3-Dimensional Mark <ul style="list-style-type: none"> <li>• Guidelines for Trademark Review and Examination</li> </ul> <p>The above guidelines are available only in Chinese and can be accessed at <a href="http://sbj.saic.gov.cn/sbyw/zqyj.asp">http://sbj.saic.gov.cn/sbyw/zqyj.asp</a> .</p>
Hong Kong, China	Sound Mark <ul style="list-style-type: none"> <li>• Hong Kong Trade Marks Registry Work Manual - see:               <ul style="list-style-type: none"> <li>○ Page 10 of the chapter on “Deficiencies Checking” (29 Dec 06 version) regarding the representation of a sound mark</li> <li>○ Chapter on “Sound Marks”</li> </ul> </li> <li>• Case law</li> </ul> Scent/Smell Mark <ul style="list-style-type: none"> <li>• Hong Kong Trade Mark Registry Work Manual (Pages 9 – 10 of the chapter on “Deficiencies Checking” (29 Dec 06 version) regarding the representation of a scent/smell mark)</li> <li>• Case law</li> </ul> Trade Dress <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> </ul> Holograms <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> </ul> Colour Mark <ul style="list-style-type: none"> <li>• Hong Kong Trade Mark Registry Work Manual - see:               <ul style="list-style-type: none"> <li>○ Pages 8 – 9 of the chapter on “Deficiencies Checking” (29 Dec 06 version) regarding the representation of a colour mark</li> <li>○ Chapter on “Colour Marks” – on the registrability of colour marks</li> </ul> </li> <li>• Case law</li> </ul> 3-Dimensional Mark <ul style="list-style-type: none"> <li>• Hong Kong Trade Mark Registry Work Manual (Chapter on “Shape Marks” regarding the registrability of 3-dimensional marks)</li> <li>• Case law</li> </ul> <p>The Hong Kong Trade Marks Registry Work Manual can be accessed at <a href="http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm">http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm</a> .</p>
Japan	3-Dimensional Mark <ul style="list-style-type: none"> <li>• Examination Guidelines for Trademarks of the Japan Patent Office, Trade Mark Division</li> <li>• Trademark Examination Manual</li> </ul>

Economy	Examination Guidelines, Tools or Reference used in the course of examination of NTTM
	<p>The above guidelines and manual can be accessed at <a href="http://www.jpo.go.jp/quick_e/index_sh.htm">http://www.jpo.go.jp/quick_e/index_sh.htm</a> .</p>
Republic of Korea	<p>3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Trademark Examination Guidelines of KIPO - see: <ul style="list-style-type: none"> <li>○ Criteria for 3-dimensional marks under Article 6(13) (formality requirements)</li> <li>○ Criteria for judgement of the functionality as trademark</li> <li>○ Criteria whether submitted representation shows composition and shape of the product</li> </ul> </li> </ul>
Mexico	<p>3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> <li>• A 3-dimensional mark shall be granted protection if it complies with the requirements under Mexican law.</li> <li>• The product must not be prohibited from registration under the grounds listed in Article 90 of the Industrial Property Law, especially grounds number II, III and IV<sup>35</sup>. In respect of ground IV, the mark shall not be the product itself; for example, a 3-dimensional telephone could not be protected to distinguish telephones of one trader from another.</li> <li>• The 3-dimensional trademark must be distinctive and original in order to identify the product just by seeing the 3-dimensional shape.</li> </ul>
New Zealand	<p>Sound Mark; Scent/Smell Mark; Colour Mark; 3-Dimensional Mark; Others – Animation Mark</p> <ul style="list-style-type: none"> <li>• Practice Guidelines of the Intellectual Property Office of New Zealand (Part 05: Absolute Grounds Distinctiveness)</li> </ul> <p>Trade Dress<sup>36</sup></p> <ul style="list-style-type: none"> <li>• No specific rules for trade dress. Such applications are dealt with in the same manner as device or 3-dimensional marks.</li> </ul>

<sup>35</sup> Article 90: The following shall not be registered as marks: (...) II. The technical or commonly used names of products or services for which the protection of the mark is sought, and also those words that everyday language or business practice has made into the usual or generic designation or the said products or services; III. Three-dimensional shapes that are public property or have come into common use, those that lack the originality that readily distinguishes them, and the usual and everyday shapes of products or those determined by their nature or industrial function; IV. Three-dimensional names, figures or shapes which, when their characteristics are considered as a whole, are descriptive of the products or services to which they are intended to afford trademark protection. The above shall include descriptive or indicative words, which, in trade, serve to identify the kind, quality, composition, purpose, value or place of origin of the products, or the time of their production.

<sup>36</sup> No marks are specifically registered / described as “trade dress” in New Zealand. Such applications are dealt with in the same manner as device or 3-dimensional marks.

Economy	Examination Guidelines, Tools or Reference used in the course of examination of NTTM
	<p>Holograms</p> <ul style="list-style-type: none"> <li>• No specific rules for holograms. Such applications are dealt with in the same manner as device marks. (Please also refer to the Practice Guidelines above for animation marks.)</li> <li>• The requirements for device marks can be found in the Practice Guidelines of the Intellectual Property Office of New Zealand (Part 05: Absolute Grounds Distinctiveness)</li> </ul> <p>The above guidelines can be accessed at <a href="http://www.iponz.govt.nz">www.iponz.govt.nz</a> &gt; Information Library &gt; 02 Trade Marks &gt; 3 Trade Mark Practice Guidelines &gt; Trade Marks Act 2002</p> <p>Others – Taste Marks</p> <ul style="list-style-type: none"> <li>○ Currently being drafted.</li> </ul> <p>Other reference tools:</p> <ul style="list-style-type: none"> <li>○ The guidelines and trade mark registers of Australia and the United Kingdom.</li> <li>○ IPONZ Hearing Decisions</li> </ul>
Papua New Guinea	<p>Colour Mark</p> <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> </ul> <p>3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> <li>• Decisions or case authority from Australian judicial cases</li> </ul>
Peru	<p>Sound Mark; Scent/Smell Mark; Trade Dress; Holograms; Colour Mark; 3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• No written guidelines available/provided</li> </ul>
Philippines	<p>Trade Dress; Holograms; Colour Mark; 3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers</li> <li>• Trademark Electronic Application Management System (TEAMS) Search Module/Database</li> <li>• References to relevant case law of other jurisdictions</li> </ul> <p>The above Rules and Regulations can be accessed at <a href="http://www.ipophil.gov.ph">http://www.ipophil.gov.ph</a>.</p> <p>The above Search Module/Database can be accessed online as the Trademarks Online Search System at <a href="http://www.ipophil.gov.ph/tmsearch/">http://www.ipophil.gov.ph/tmsearch/</a>.</p>
Singapore	<p>Sound Mark; Trade Dress; Holograms; Colour Mark; 3-Dimensional Mark; Others – Moving Marks</p> <ul style="list-style-type: none"> <li>• Trade Marks Work Manual</li> </ul>

Economy	Examination Guidelines, Tools or Reference used in the course of examination of NTTM
	<ul style="list-style-type: none"> <li>• Trade Marks Act and Rules</li> <li>• Internet Searches (for registration of a mark in other jurisdiction, specification searches etc)</li> </ul> <p>The above manual can be accessed at <a href="http://www.ipos.gov.sg/leftNav/tra/IP+Resources.htm">http://www.ipos.gov.sg/leftNav/tra/IP+Resources.htm</a> .</p> <p>The above Act and Rules can be accessed at <a href="http://www.ipos.gov.sg/topNav/leg/">http://www.ipos.gov.sg/topNav/leg/</a> .</p>
Chinese Taipei	<p>Sound Mark; Colour Mark; 3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Examination Guidelines for Three-Dimensional, Colour, and Sound Trade Marks of the Intellectual Property Office of Chinese Taipei.</li> </ul> <p>Trade Dress</p> <ul style="list-style-type: none"> <li>• The same guidelines as that for 3-dimensional marks are used.</li> </ul> <p>The above guidelines can be accessed at <a href="http://www.tipo.gov.tw/eng/laws/crite12.asp">http://www.tipo.gov.tw/eng/laws/crite12.asp</a> .</p>
Thailand	<p>Colour Mark; 3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Guidelines can be found on the website of the Department of Intellectual Property of Thailand.</li> </ul> <p>The website of the Department of Intellectual Property of Thailand can be accessed at <a href="http://www.ipthailand.org">www.ipthailand.org</a> .</p>
United States	<p>Sound Mark</p> <ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1202.15)</li> <li>• Case Law</li> </ul> <p>Scent/Smell Mark</p> <ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1202.13)</li> <li>• Case Law</li> </ul> <p>Trade Dress</p> <ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1202.02)</li> <li>• Case Law</li> </ul> <p>Hologram</p> <ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1202.14)</li> <li>• Case Law</li> </ul> <p>Colour Mark</p>

Economy	Examination Guidelines, Tools or Reference used in the course of examination of NTTM
	<ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1202.05)</li> <li>• Case Law</li> </ul> <p>3-Dimensional Mark</p> <ul style="list-style-type: none"> <li>• Trademark Manual of Examining Procedure (TMEP) of the United States Patents &amp; Trade Marks Office (Section 1301.02)</li> <li>• Case Law</li> </ul> <p>The above manual can be accessed at <a href="http://tess2.uspto.gov/tmdb/tmep/">http://tess2.uspto.gov/tmdb/tmep/</a> .</p>
Viet Nam	<p>No established examination guidelines.</p> <p>Note:</p> <ul style="list-style-type: none"> <li>• In the course of examination of NTTMs, the National Office of Intellectual Property of Vietnam also uses their Industrial Design database.</li> </ul>

### Observations

52. It is encouraging to note that most member economies already have established guidelines or manuals for the examination of NTTMs. It is suggested that economies that do not yet have such guidelines or manuals may refer to similar documents in other economies for reference and guidance. It is also suggested that the web links to the various established guidelines and manuals be placed on the APEC website for easy reference.

## **E. Decisions or case law in the various APEC economies**

53. Economies were asked to highlight any judicial decisions or case law which clarifies any issue(s) in relation to NTTMs, or which may assist its trade mark examiners in deciding on an application for the registration of such mark, or which may add to any form of jurisprudence on the subject.

### **Case law in common law economies**

54. An analysis of the responses shows that judicial decisions or case law are largely relied on in common law economies, where judicial precedents are an important tool used to guide judges considering trade mark issues. These countries would include Australia, Hong Kong, New Zealand, Papua New Guinea and Singapore.

55. Among these economies, the volume of local judicial decisions is generally not large. These economies still refer to English case law, such as the English Reports of Patents, Designs and Trade Marks Cases or RPC in their local cases although Australia and New Zealand<sup>37</sup>, by the length of their history, have quite a few local cases compared to other newer/smaller economies.

56. Thus, for example, Papua New Guinea has indicated that their examiners would be “required/expected to (refer to) Australian judicial cases when determining whether a 3-dimensional mark is registrable”. Singapore has indicated that “where the legislation is similarly drafted and where the practices are similar, (it) does refer to decisions and case law of the European Court of Justice, United Kingdom, Australia, New Zealand and Hong Kong. New Zealand has indicated that “decisions by English-speaking jurisdictions with similar legislation will be considered most persuasive”. Such jurisdictions would include the United Kingdom and Australia.

57. The United States appears to be unique in APEC – being a leading net exporter of intellectual property for many decades, they have built up a large body of case law on various issues.

### **Civil law jurisdictions**

58. Civil law economies did not feature much case law in their responses to the survey. This may be due to the relatively low number of published court cases in relation to NTTMs in these economies. It does not mean that judicial precedents have no value in these economies – for example:

- (i) China has reported that “some typical judicial cases or judicial principles employed in the judicial review of cases concerning trade mark registration can be used as references for examiners to examine non-traditional trade marks”.
- (ii) Chinese Taipei reported that “foreign legislation and court decision references were collected and studied” to aid in the drafting of the current

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<sup>37</sup> New Zealand has reported that since 1953, a total of 549 trade mark decisions have been delivered by the IP office. This is as compared to 107 trade mark decisions for Singapore since 1999.

Trade Mark Act and Guidelines. Further, the “study of other decisions or case law of other jurisdictions and views exchange with foreign experts are done through international symposiums and roundtables continuously. These assist the trade mark examiners in the decision on the registration of a non-traditional trade mark.”.

- (iii) Thailand has reported that there are a couple of reported cases on “configurative marks” decided by the Central Intellectual Property and International Trade Court (cases number 38-41/2547 and number 66/2547). The judgments can be found on the Central Intellectual Property and International Trade Court’s website <[www.cipitc.or.th](http://www.cipitc.or.th)>.

59. The following table attempts to outline some of the key substantive issues connected to NTTMs, and arising from case law highlighted by economies. It is hoped that such case law will help all to have a broad overview and understanding of such issues.

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
All types	What constitutes a “graphic representation” of a NTTM?	(i) Swizzels Matlow Ltd’s Trade Mark Application [1998] RPC 244 (ii) Swizzels Matlow Ltd’s Application for a 3-dimensional Trade Mark [1999] RPC 879 (iii) Ty Nant Spring Water Ltd’s Trade Mark Application [1999] RPC 392	Hong Kong, China Trade Mark Registry Work Manual	Graphic representation is a primary requirement in most legislation, and may limit the range of NTTM which may be registered.
		Playboy Enterprises Inc v Germain (No.1) 1987, 16 CPR (3d) 517	Canada	In order to be deemed to be used in association with the wares in question, the mark must be something that can be seen, whether it is marked on the wares in question or on the packages in

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
				which they are distributed or whether it is in any other manner so associated with the wares, that notice of the association is then given to the person to whom the wares are transferred.
Smell marks	What is an adequate description of a smell mark?	John Lewis of Hungerford Ltd's Trade Mark Application [2001] RPC 575	Hong Kong, China Trade Mark Registry Work Manual	Pictorial analysis of smell mark was rejected; the court considered that the particular description of the mark in that case lacked precision and was too subjective.
	Can a scent which is functional be registrable?	Re Clarke, 17 USPQ2d 1238 (TTAB 1990)	United States	Scents that serve a utilitarian purpose, such as the scent of perfume, would be functional and not registrable.
Sound marks	What is an adequate description of a sound mark?	Shield Mark BV v Kist (European Court of Justice) (Case C-283/01)	Hong Kong, China Trade Mark Registry Work Manual	A mere sequence of notes does not allow determination of parameters of melody sought to be represented.

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
	Test of determining registrability of a sound mark; how does one tell if it is inherently adapted to distinguish the applicant's goods/services?	W&G Di Cros Appn (1913) 30 RPC 660 at 672	Australia	One must consider if other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark closely resembling it.
Three-dimensional marks	Is a shape capable of functioning as a trade mark?	Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks, [2002] FCAFC 273	Australia	A shape is capable of being a trade mark – it must be considered in the context of the market in which it is placed, and a decision on its ability to distinguish should be made using the usual tests. (See next row for elaboration of this test.)
	What is the test for whether a shape claimed as a trade mark is capable of distinguishing the goods/services of a trade from another?	F.H. Faulding & Son Ltd v Imperial Chemical Industries of Australia and New Zealand Ltd (1965) 112 CLR 537	Australia	Whether the shape in question is one which other traders are likely, in the ordinary course of business and without any improper motive, to desire to use in connection with their goods.

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
		Decision for Registration number 188,179 (Thesis. Subject matter : Administrative); issued on January 2001	Mexico	A 3-dimensional trademark is not registrable if it is descriptive of the product.
	What would be a distinctive shape enabling registration as a three-dimensional mark?	(i) Re Kabushiki Kaisha Yakult Honsha's Trade Mark Application [2001] RPC 756 (ii) Societe de Produits Nestle SA v Unilever plc [2002] EWHC 2709 (Ch) (the Viennetta ice-cream dessert case)	Hong Kong, China Trade Mark Registry Work Manual	The shape must be perceived by consumers as identifying the origin of the product – being eye-catching or highly decorative is insufficient.
	When would a shape give purely “substantial value” to the goods in question and thus, be excluded from registration?	(i) Movado (Hong Kong Trade Marks Registry, 31 December 2002)	Hong Kong, China Trade Mark Registry Work Manual	There are 4 factors to be considered: (i) Does the sign comprise nothing but shape, irrespective of whether it also conveys indication of origin? (ii) Does the shape have eye appeal or other qualities of worth, judged subjectively by customers through more sales or more profitable sales? (iii) Does the shape have

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
				substantial value compared to the shapes of equivalent articles? (iv) Any value attributable to the shape as an indicator of source is to be disregarded.
	Can a purely functional shape be registrable as a trade mark?	Fredco Trading v Miller (2006) NZBLC 101	New Zealand	A shape acquires a distinctive character if it has certain aesthetic features and extensive use. Consumers are drawn to a product by its shape – a shape acts as a badge of origin and is thus entitled to protection.
	How does one accurately describe a 3-dimensional mark?	Levi Strauss & Co v Kimbyr Investments [1994] 1 NZLR 332	New Zealand	A written description of the mark can be limited by reference to a drawing or representation. The word “shown” should be used when referring to the pictorial representation of the 3-D mark.
Colour marks	Can a single colour be constituted as a colour	(i) Re Application by Cadbury Ltd	Hong Kong, China Trade	The colour must be inherently

Type of mark	Issue concerning non-traditional trade mark (NTTM)	Judicial decision (s)	Where referred to, reported or cited	Principles enunciated/ Other remarks
	mark?	55 IPR 561	Mark Registry Work Manual	adapted to distinguish.
	When is a colour mark considered distinctive?	Philmac Pty Ltd v The Registrar of Trade Marks [2002] FCA 1551	Australia	The colour will be inherently adapted to distinguish if it does not serve a utilitarian, ornamental, economic function, and if there is no proven competitive need for the use of the colour.
	Are functional colours registrable ?	In re Ferris Corporation, 59 USPQ2d 1587 (TAB 2000)	United States	No; colour pink used on surgical wound dressings is functional because actual colour of goods closely resembles Caucasian human skin.
	Can a colour be registered in the abstract without considering the manner or context in which the colour is used?	In re International Flavours & Fragrances Inc., 183 F.3d 1361, 1368, 51 USPQ2d 1513 (Fed Cir 1999)	United States	The manner and context in which a colour is used must be considered as matter of law and public policy, otherwise it would result in an unlimited number of works being claimed in a single application.

60. The issues raised by economies' judicial decisions will be further considered in the final section of this report.

## **F. Conclusion**

### **Definition of trade mark**

61. All economies are signatories to the TRIPS Agreement. Hence, they have incorporated the principle of distinguishing the goods and services of one undertaking from those of other undertakings in their definition of a trade mark. This principle is stated in Article 15 of the TRIPS Agreement. Article 15 also describes the basic types of signs that are capable of being protected as trade marks in the economies.
62. Most economies require a mark to be capable of graphical representation. Some economies require an additional element of visual perception in a mark. In the latter, sound marks and scent/smell marks are automatically excluded from being protected as a trade mark since sound and scent/smell are not visible.
63. The difference in the requirements for qualification as a trade mark in the economies may be due to the variation in the level of development of their trade mark regimes. Trade marks have traditionally been viewed as signs that consist of letters, numerals, figurative elements etc. These are visually perceptible elements. Thus, countries which appear to be more conservative towards the protection of trade marks may tend to be less receptive towards giving protection to marks that cannot be distinguished visually. The situation may be further aggravated by the lack of consistency or harmony in the substantive requirements and examination of such marks in the various economies.
64. Even in economies where various NTTMs are not excluded from protection by the legislation, applicants may still face difficulty if they try to register certain NTTMs. For example, although the trade mark legislation of Hong Kong, China and Singapore do not rule out the registration of scent/smell marks, registration of such marks would be difficult. This is because there is presently no acceptable graphical representation for scent/smell marks.

### **Types of NTTM allowed**

65. The range of NTTMs that may be protected in the various economies vary. 3-dimensional marks may be protected in all economies. Colour marks are the next most common NTTM that may be protected. It is observed that these are visual marks and it further supports the hypothesis that economies are more comfortable in giving protection to marks that can be distinguished by sight. This may be due to the fact that traditionally, the core expertise of all trade mark offices has been in marks that consist of visual elements. Also, for certain non-visible marks, there is not yet an internationally recognised method for submitting a representation of such marks. This may be another barrier to the acceptability of such marks in the various economies.
66. Legislative reform to promote or further acceptance of NTTM may be faster in common law economies where judicial decisions may play a more active part in shaping trade mark law.

67. Although a few economies have indicated that they offer protection to the full range of NTTMs identified in the survey, the United States is the only economy with registered examples for the full range of NTTMs. The reason behind this is not clear. However, the innovativeness and enterprising level of the business community in the economies may have played a role in affecting the types of NTTMs that have been registered in each economy.
68. Some less common types of NTTMs are also emerging in a few economies. For example, taste marks and motion marks may be protected in New Zealand and the United States respectively. These marks are not commonly protected in other economies. The status of these marks is not clear. There are also no established guidelines available/provided for the examination of such marks.

### **Information to be furnished by applicants**

69. There are nuances from economy to economy which would not be obvious from just reading the legislation. For example, sound marks may be protected in Australia, Hong Kong, China, New Zealand, Peru, Singapore, Chinese Taipei and the United States. However, a recording of the mark needs not be provided for registration of a sound mark in Hong Kong, China although this is required for other economies. Similarly, 3-dimensional marks may be protected in all economies. However, only Papua New Guinea requires a sample of the 3-dimensional mark to be provided.
70. Due to these differences in the requirements for registration of the NTTMs, it is crucial for applicants and/or their solicitors or trade mark agents to check the examination guidelines of the various economies before they apply for an NTTM registration. However, it is observed that some economies do not appear to have, or provide such information to the public. Therefore, to facilitate smooth registration, applicants may wish to consider engaging the services of a solicitor or trade mark agent in the relevant economies. Alternatively, they can liaise personally with the relevant trade mark offices to obtain the relevant information.
71. Case law and hearing decisions would also be helpful in assisting applicants to understand whether their intended NTTM meets the requirements of a particular economy. It would also be helpful in guiding examiners from economies whose regime for NTTM is relatively new.
72. For the benefit of potential applicants of NTTMs, it would be helpful if the intellectual property offices of economies with more established NTTM regimes can publish the following information on their websites:
- (i) the examination guidelines of NTTMs; and
  - (ii) the decisions of important cases on their websites.
- This would also offer a good source of reference for economies with less established NTTM protection.

### **Decision or case law**

73. There are some issues that have been raised by case law. They point to some common questions surrounding NTTMs. They are as follows:
- (a) For all NTTMs –
    - (i) What constitutes a “graphic representation” of a NTTM?

- (b) For smell/scent marks –
  - (i) What is an adequate description of a smell mark?
  - (ii) Can a scent which is functional be registrable?
- (c) For sound marks –
  - (i) What is an adequate description of a sound mark?
  - (ii) Test of determining registrability of a sound mark; how does one tell if it is inherently adapted to distinguish the applicant's goods/services?
- (d) For 3-dimensional marks –
  - (i) Is a shape capable of functioning as a trade mark?
  - (ii) What is the test for whether a shape claimed as a trade mark is capable of distinguishing the goods/services of a trade from another?
  - (iii) What would be a distinctive shape enabling registration as a three-dimensional mark?
  - (iv) When would a shape give purely "substantial value" to the goods in question and thus, be excluded from registration?
  - (v) Can a purely functional shape be registrable as a trade mark?
  - (vi) How does one accurately describe a 3-dimensional mark?
- (e) For colour marks –
  - (i) Can a single colour be constituted as a colour mark?
  - (ii) When is a colour mark considered distinctive?
  - (iii) Are functional colours registrable?
  - (iv) Can a colour be registered in the abstract without considering the manner or context in which the colour is used?

### **Comparison with the Trademark Law Treaty**

74. The Trademark Law Treaty ("TLT") is an international trade mark law treaty administered by the World Intellectual Property Organisation ("WIPO"). Its aim is to "approximate and streamline national and regional trademark registration procedures". However, it applies to marks consisting of visible signs only, including 3-dimensional marks. It does not apply to holograms and marks not consisting of visible signs. Thus, it is also not applicable to Sound Mark and Scent/Smell Mark.
75. Only 4 among the 16 economies which responded to the survey are parties to the TLT. They are Australia, Japan, Republic of Korea and the United States. Both the People's Republic of China and Mexico had signed the TLT on 28 October 1984, however, they had not yet ratified to it. Therefore, the impact of the TLT on APEC is not significant.
76. Nevertheless, certain elements of the TLT have been adopted by the APEC economies in their trade mark legislation<sup>38</sup>. For example, most economies do not require the applicant to furnish any certificate or extract of a register of commerce, indication of the applicant's carrying on of an industrial or commercial activity, indication of the applicant's carrying on of an activity corresponding to the goods and/or services listed in the trade mark application etc. These requirements are also prohibited under Article 3(7) of the TLT.

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<sup>38</sup> For example, Singapore was unable to accede to the division and multi-class requirements, though it has adopted other elements of the TLT in its Trade Mark legislation as a result of its obligations under the United States – Singapore Free Trade Agreement.

## **Comparison with the Singapore Treaty on the Law of Trademarks**

77. The Singapore Treaty on the Law of Trademarks ("Singapore Treaty") is a newer treaty relating to trade marks that is administered by WIPO. It was concluded at the Diplomatic Conference for the Adoption of a revised Trade Mark Law Treaty in March 2006. The Singapore Treaty aims to harmonise the administrative procedures for trade mark registration. It is applicable to all kinds of marks registrable under the law of a Contracting Party and is also the first international trade mark law treaty which recognizes explicitly non-traditional marks.
78. The Singapore Treaty is not yet in force and Singapore is the only APEC economy that has ratified it. When the Singapore Treaty comes into force, the harmonized framework contained therein will provide greater convenience and benefits to trade mark applicants and intellectual property professionals seeking trade mark registration in signatory countries.
79. The Singapore Treaty has specific regulations for colour marks, 3-dimensional marks, holograms, motion marks, position marks and marks consisting of a non-visible sign. However, these requirements are quite general in nature and the legislation of most economies already complies with a number of the requirements.
80. For example:
- For colour marks, it is stated in Rule 3(2) that the Office may require the name or code of the colour(s) claimed to be indicated in the application.
  - The number of reproductions of the mark that the Office may require from the applicant for marks that are not colour marks, is limited. [Rule 3(3)]
  - The reproduction of a 3-dimensional mark shall consist of a 2-dimensional graphic or photographic reproduction. [Rule 3(4)]
81. Hence, economies should not find much problem in acceding to these requirements. Thus, there may be more interest by the APEC economies in acceding to the Singapore Treaty.

## **Annex A**

Economies which responded to the APEC Survey on Non-Traditional Trade Marks :

**Australia**

**Canada**

**People's Republic of China**

**Hong Kong, China**

**Japan**

**Republic of Korea**

**Mexico**

**New Zealand**

**Papua New Guinea**

**Peru**

**Philippines**

**Singapore**

**Chinese Taipei**

**Thailand**

**United States**

**Viet Nam**