

Protecting product shapes with 3D trademarks

For many successful businesses, a substantial portion of their value is often attributable to the intangible goodwill that has been established in their brands. A classic example of just how far the value of a brand can exceed the value of the physical assets of a business can be seen in the case of the Coca-Cola Corporation. For the past few years, Coca-Cola has topped the *BusinessWeek* survey of the world's most valuable brands. In 2004, the value of the Coca-Cola brand was estimated to exceed US\$70 billion.

One of the first considerations of a business intent on developing and protecting its brand should be how to legally protect that brand. Brands typically take the form of business names, business get-up and similar insignia, most of which may be protected as a trademark.

A trademark is a sign adopted by a business in order to distinguish the goods or services of that business from those of other businesses. In other words, a trademark operates as a distinctive "badge of

origin". Using trademark law to protect a brand typically begins with the registration of a mark in accordance with procedures.

Under the present Thai Trademark Act, registration can be obtained for a trademark which consists of a name, design, slogan, photo, shape, device, or a combination of these. A key requirement is that the chosen mark must be capable of identifying and distinguishing one's goods and services from those of others.

Today, the vast majority of registered trademarks are names of businesses, business logos and the specific names of products or services offered. In practice, most trademarks are registered in two-dimensional format such as words, graphics or other visual depictions.

In recent times, however, business operators have sought to ensure their monopoly rights over signs other than those in two-dimensional format. For example, the triangular-shaped chocolate bar has become synonymous with Toblerone, and Coca-Cola's glass bottle has become

famous the world over. In fact, in the US, Coca-Cola registered the distinctive shape of its bottle as far back as 1960. McDonald's has sought to register a trademark for its golden arches in many countries, as has Volkswagen for the shape of its Beetle.

In Thailand, the Trademark Act was amended in 2000 to expressly provide protection for three-dimensional (3D) objects. Since that law became effective, many trademark applicants have attempted to register the shape of their products and packaging as 3D marks. Unfortunately, very few shape trademarks have been granted registration.

One of the rejected applications in Thailand involves the shape of the famous Coca-Cola bottle. This application was rejected by both the Trademark Registrar and the Board of Trademarks on the grounds of non-distinctiveness. The pro-

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posed bottle mark was considered to be a generic picture not sufficiently distinctive for registration. As the bottle was considered to be a "container", this was held to be ultimately descriptive of the goods for which the registration was sought. Descriptive trademarks can't be registered.

In the face of this rejection, the Coca-Cola Corporation brought an appeal before the Intellectual Property and International Trade (IP&IT) Court, claiming that its proposed trademark had been widely used not only as a container but also as a trademark and as such, it had acquired sufficient distinctiveness through use to have achieved "a secondary meaning". A generic word or mark can be registered as a trademark if it is shown to have achieved a secondary meaning in use.

In June 2004, the IP&IT Court ruled that the proposed bottle mark was merely

an invented picture presented in two dimensions in the application (length and width) but without the requisite third dimension, depth. For this reason, the application was deemed to be sufficiently distinctive for registration as a 2D trademark, but not as a 3D mark.

The court's decision on the Coca-Cola case underscores the importance of adequate preparation before filing an application for a 3D trademark in Thailand. As the Thai Trademark Act requires that a mark not be descriptive of the applied goods or services, the registration of a product as a 3D mark is difficult. Some of the strategies that can be employed to obtain registration for a 3D mark will be discussed in Part 2 on March 18.

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