

Protecting unique shapes as trademarks, Part II

In Part I of this article on March 4, we discussed the central role trademarks play in protecting brands in addition to the growing prevalence of 3D trademarks and the difficulty in obtaining registration for such marks in Thailand.

The ability to obtain trademark protection for the shape of a product has given rise to controversy and debate in many countries. The international community has remained divided as to whether a 3D mark could be more appropriately protected by some other form of intellectual property (such as an industrial design or patent) that would offer short periods of protection.

Central to this argument is the belief that by extending trademark protection to shapes, unnecessary and potential perpetual monopoly protection may be extended to functional shapes (i.e. products for which the shape is dictated by functional necessity, such as the shape of a bottle cap or a screw). Functional shapes would typically form the subject matter of patent protection, which offers a more limited period of monopoly for inventors — usually up to 20 years.

This international difficulty with 3D marks has also manifested itself in Thailand. Here, the various laws that make up the Thai intellectual property system offer overlapping protection for shapes. In Thailand, a trademark registration may be renewed perpetually. Hence, the trademark registration of a 3D mark is perceived to offer greater protection than current patent law.

The conservative view is that if 3D trademarks are allowed, then the need for a patent system would be undermined. In fact, the correct approach should be to disallow functional trademark shapes but permit non-functional 3D trademarks. As a consequence, in many of the countries where 3D trademarks are permitted, a mechanism exists to filter out and reject applications that are directed to shapes with functional elements.

It is this difficulty with overlapping protection that has underpinned many of the rejections of 3D trademark applications in Thailand. In fact, the Department of Intellectual Property can be said to operate a very strict application examination system that firmly places the onus on the applicant to clearly demonstrate its entitlement to register the 3D mark. This does not mean that a 3D trademark cannot be registered. However, various considerations and strategies would be

required to ensure a successful application.

In rejecting 3D trademark applications, the Registrar has often found the mark to be “non-distinctive” or “descriptive”.

◆ One of the first steps to demonstrating that a sought mark is distinctive is by adequate and proper representation on the trademark application form. Providing a clear specimen of the proposed 3D mark is a key requirement. In typical trademark applications for 2D marks, it is common to include drawings. However, for 3D marks, the chances of success in registering the mark would be increased by attaching photographs of the shape that clearly show every angle and perspective.

Distinctive attributes such as specific colours would help to increase the distinctive quality of the proposed mark.

◆ In order to increase the chances of successful registration, evidence of prior use that demonstrates a public recognition of the proposed 3D mark is very valuable. Such evidence can often be used to show that the proposed mark has achieved a secondary meaning through use. Having a secondary meaning can defeat an argument that the sought trademark is “descriptive” or inherently “non-distinctive”.

A mark, including a 3D mark, may gain secondary meaning by means of distribution or extensive advertisement. Proof of use of the proposed 3D mark in Thailand is the most influential factor in determining the eligibility for it to be registered. Evidence of use and registration of the 3D mark outside of Thailand reflecting Thais' awareness of the mark is also acceptable.

The rise in the importance of 3D trademarks for modern business has been reflected by the express inclusion of the ability to obtain such marks in the Trademark Act. Unfortunately, achieving such registrations is still a difficult task.

Accordingly, one of the most important matters to be considered by any business seeking to develop or expand its goodwill and reputation for specific shapes is the strategy to employ in seeking protection. For shape trademarks, unlike in the cases of more conventional 2D trademarks, the most important element may not be an early filing date but rather the availability of sufficient evidence of prior use.

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