

Preliminary Analysis of Examination of Three-dimensional Trademarks

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Article 8 of the Trademark Law of the People's Republic of China provides that any visual sign capable of distinguishing the goods or service of one natural person, legal person or any other entity from those of others, including words, devices, letters, numerals, three-dimensional symbols, combinations of colours or any combination of the above elements, may be applied for the registration of a trademark. It may be seen from the provision on the components of a registered trademark that any visual sign comprising three-dimensional symbols or three-dimensional symbol containing other elements may be registered as a trademark known as a three-dimensional trademark. Trademarks of the kind may be divided into two categories: single three-dimensional trademarks, namely those composed of elements of three-dimensional symbol, and combination three-dimensional trademarks, namely those composed of three-dimensional symbols containing other elements. The elements of three-dimensional symbol of a three-dimensional trademark may be the shape of goods per se, its package, or any other three-dimensional symbol. This article is intended to explore and

discuss about the examination of three-dimensional trademarks.

Examination of absolute grounds for refusal of three-dimensional trademarks

The provisions of the Trademark Law on refusal of trademarks are divided into two parts: one part of the provisions are on those prohibited to be used as trademarks intended to address the issue of the accepted fine public orders and social morals or customs as embodied by Article 10 of the Trademark Law; the other part of these are the provisions on signs prohibited to be applied for registration as embodied by provisions of Articles 11 and 12 of the Trademark Law on the distinctive character of trademarks.

(I) Application of Article 10 of the Trademark Law

Article 10 of the Trademark Law provides that such word or device as the State name, national flag or national emblem should not be used as a trademark. This provision also applies to a three-dimensional trademark.

標的某個構成部分有顯著性,商標整體就有顯著性,所以《商標法》禁止註冊條款有一個“僅”或“僅僅”的限定。其次,組合立體商標是一個整體,通過註冊產生的權利是針對商標整體的,對註冊人在整體上主張權利是沒有異議的;第三,對組合立體商標而言,左右該商標整體印象的往往是其顯著性較強的構成要素,即商標的主要部分,該部分受法律保護的力度是較強的。而作為商標次要部分的構成要素的權利是要受到限制的,即組合立體商標中含有本商品的通用形狀、包裝物和裝飾物,或者直接表示商品的主要原料等特點,或者由商品自身的性質產生的形狀、為獲得技術效果而需有的商品形狀及使商品具有實質性

價值的形狀,註冊商標專用權人無權禁止他人正當使用。■

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¹ 參見《商標審查標準》第四部分立體商標的審查,國家工商總局商標局商標評審委員會 2005 年 12 月公佈。

² 同註 1。

³ 見國家工商行政管理總局商標局編:《中華人民共和國商標法釋義》,第 71 頁,中國工商出版社,2003 年 4 月第一版。

⁴ 陳曉華:“淺析商標駁回相對理由的審查”,載(香港)《中國專利與商標》2006 年第 3 期。

For example, an application for registration of the three-dimensional shape of the national emblem of a nation as a three-dimensional trademark will be refused, so will an application for registration of the three-dimensional head sculpture of a political figure as a three-dimensional trademark.

(II) Application of Article 11 of the Trademark Law

Under Article 11 of the Trademark Law, any three-dimensional trademark that consists exclusively of the common shape of goods or characteristics having direct reference to the main raw material of goods, or is devoid of any distinctive character should not be registered as a trademark. Firstly, three-dimensional trademarks of the kind are incapable of distinguishing the goods or services made or provided by one producer or operator from those by another, and devoid of distinctive character, which is the essential feature of trademarks. Secondly, if these signs, being commonly used in the industry, are registered as trademarks, the applicants thereof will gain the exclusive right, and thus render it impossible for other parties to use them in their business activities without authorization. It is obviously unfair to the other parties, particularly to the competitors of the trademark registrants.

1. Any three-dimensional symbol that exclusively has the commonly used shape of designated goods should not be registered as a three-dimensional trademark.

For example, in Fig. 1, the shape of the ordinary elliptic pill is the common shape of pills, which, used on goods of medicine, is devoid of distinctive character. In Fig. 2, however, the three-dimensional shape with three small balls around and used on goods of nutrient is neither commonly nor frequently used; it has its distinctive character.



Fig. 1



Fig. 2

2. Any three-dimensional symbol that exclusively has the commonly used shape or the common package of designated goods should not be registered as a three-dimensional trademark.

For example, the ordinary bottle (Fig. 3) used in the goods of beer is a commonly used package of goods, and it is devoid of distinctive character. The fish-shaped bottle (Fig. 4), however, used on the goods of liquor is not a package of the goods commonly or frequently used, so it is registrable.



Fig. 3



Fig. 4

3. Any three-dimensional symbol that exclusively has the commonly used shape or decoration of designated goods or service should not be registered as a three-dimensional trademark.

For example, the stone lion sculpture (Fig. 5) commonly placed at the entrance of a hotel or building is a symbolic patron saint, which is frequently used to decorate the hotel or building. If it is applied for registration as a three-dimensional trademark on a hotel service, the application is likely to be refused. However, a three-dimensional symbol having no direct reference to goods or service *per se* is registrable as is the case with the shape of cowboy riding on the back of a cow used by a hotel (Fig. 6) since it has no direct reference to the hotel service.



Fig. 5



Fig. 6

4. Any three-dimensional symbol that exclusively has direct reference to the characteristic of goods, such as the main raw material, should not be registered as a three-dimensional trademark.

For example, application for registration as a three-dimensional trademark (Fig. 7) of the ordinary shape of apple used on the goods of juice would be refused since it exclusively has direct reference to the characteristic of the main raw material of goods. However, the specially designed shape of the three-dimensional sheep used on goods of knitting wool is registrable since it does not lead people to believe that it has direct reference to the main raw material of knitting wool.



Fig. 7

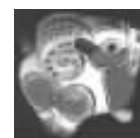


Fig. 8

5. If the three-dimensional shape of the trademark sample submitted by an applicant is difficult to be determined, it is determined as being devoid of distinctive character.

For example, since the sample of the bar-shaped device (Fig. 9) used in glasses case is impossible to be determined as a three-dimensional shape, it is determined as being devoid of its distinctive character.



Fig. 9

A three-dimensional symbol containing such conventional element as the lexical element of another trademark is registrable in principle. The significance of protection, however, does not necessarily lie in the three-dimensional feature. For example, a beer container (Fig. 10) with a tag con-

taining the distinctive character of the lexical part is generally deemed registereable. What is under protection is the lexical part having its distinctive character, rather than the ordinary shape of the container.



Fig. 10

(III) Application of Article 12 of the Trademark Law

Article 12 of the Trademark Law provides that where a three-dimensional sign is applied for the registration of a trademark, it shall not be registered if it consists exclusively of the shape which results from the nature of the goods themselves, the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.

1. Any three-dimensional symbol consists exclusively of the shape which results from the nature of the goods themselves is not registered as a three-dimensional trademark.

By the shape resulting from the nature of the goods themselves is meant the shape necessarily or commonly used for realizing the inherent function or use of goods.¹ For example, the shape of a buckle and a pair of scissors is closely related to the function thereof.



Fig. 11



Fig. 12

2. Any three-dimensional symbol consists exclusively of the shape of goods which is necessary to obtain a technical result should not be registered as a three-dimensional trademark.

By the shape necessary to obtain a technical result is meant the shape necessary to be used for easy realization of the specific or inherent function of goods.² Take for an example the application for registration of a three-dimensional symbol as a three-dimensional trademark as shown in Fig. 13 used on non-metallic goods of container. Said three-dimensional symbol per se is in the shape of the container, the only special character of which lies in the prismatic shape of its lower-right corner, aiming at producing a specific technical result of slipping prevention, so it is not registrable. Take for another example the application of the three-dimensional symbol as shown in Fig. 14 for registration as a three-dimensional trademark in electric toothbrush. Said three-dimensional symbol is in the shape of an electric toothbrush, having some distinctive character or some originality and novelty in its design compared with other toothbrush. However, the final



Fig. 13

object of the design is to achieve its special technical result. For this reason, the three-dimensional symbol used in the goods of electric toothbrush is not registrable.



Fig. 14

3. Any three-dimensional symbol consists exclusively of the shape which gives substantial value to the goods should not be registered as a three-dimensional trademark.

The provision of the Trademark Law on the absolute grounds for refusal mainly applies to the design and model with aesthetic value. Take for an example the three-dimensional symbol used in the china decoration shown in Fig. 15. It is a work of art. Consumers, in general, appreciate its shape, which has influenced the value of the goods, and do not regard it as a trademark. In Fig. 16, the three-dimensional symbol is registered and used in the goods of soft cushion. The animal shape of the soft cushion is generally seen as an enhancement of the attractiveness of the soft cushion and it has no connection with its manufacture or resource; Fig. 17 shows the shape of a toy car, the appearance of which is also to attract consumers' attention.



Fig. 15



Fig. 16



Fig. 17

Unlike with Article 11 of the Trademark Law, Article 12 thereof, stressing that the functional three-dimensional symbol should not be protected as a three-dimensional trademark, is an associate provision set forth specially for the examination of three-dimensional trademark, laying down the above condition for restricting the registrability of three-dimensional trademarks. Why has such restrictive condition been laid down? These restrictive provisions are related to the term of protection of trademark and patent. The exclusive right to use a trademark may last for good. The longer a mark is in existence, the more clearly consumers identify it, and the more distinctive the mark becomes. However, in respect of patent (right), a due term or duration is provided for, and a permanent patent is not conducive to the social progress. If the subject matters involved in the above cases were registered as the patent for industrial design or utility model, the patent would enter the public domain after their term of protection expires. But, if they are registered as three-dimensional trademarks, another party will possibly not be allowed

to produce the products without authorization of the registrants. Situation like this is not initially expected in establishing the industrial property system, nor is it conducive to the protection of the public interests.³

Examination of relative grounds for refusal of three-dimensional trademarks

In China, the “examination principle” is currently adopted, that is, the trademark registration administrative authority conducts comprehensive examination of a trademark registration application. It not only examines it as to formalities, but also examines the relative grounds for refusal of the application.⁴ Provisions along the line are set forth in Articles 28 and 29 of the Trademark Law.

As abovementioned, a three-dimensional trademark may consist exclusively of elements of three-dimensional symbols, and, as well, of the combination of the three-dimensional trademark sign elements and other two-dimensional elements. To make the point readily clearly, this writer will be analyzing the three aspects of the registration for trademark refusal.

(I) Similarity of three-dimensional elements

Two trademarks having similar distinctive character in structure, shape and global visual effect of the three-dimensional elements are determined as similar trademarks.

For example, the two three-dimensional trademarks in the shape of vehicle used in the goods of poker cards (Figs. 18 and 19), with substantially the same shape, should be determined as similar trademarks.



Fig. 18



Fig. 19

However, the two trademarks (Figs 20 and 21) in the shape of bottle used in wine, though similar in the shape of the bottle per se, are not determined as similar trademarks because the bottle is a commonly used package of wine, devoid of its own distinctive character, and the words on the bottle label are obviously different.



Fig. 20

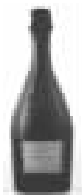


Fig. 21

(MOET CHANDON) (LA GRANDE DAME)

(II) Similarity of two-dimensional elements

Two trademarks similar in appearance, sound and

global presentation of two-dimensional elements and having their distinctive character are determined as similar trademarks.

Fig. 22 shows a pure word trademark. Fig 23 shows a three-dimensional trademark containing a lexical element. The two are similar in the lexical parts, so determined as similar trademarks.

la bamba

Fig. 22 la bamba



Fig. 23 BOMBA

(III) Similarity of three-dimensional element to two-dimensional element

Two trademarks similar in visual effect of the distinctive three-dimensional element and in the distinctive two-dimensional elements are determined as similar trademarks.

Fig. 24 shows a three-dimensional trademark, and Fig. 25 a two-dimensional trademark containing a device element. The two trademarks, similar in the bird-shaped part, are determined as similar trademarks.



Fig. 24



Fig. 25

Several issues encountered in the registration and protection of three-dimensional trademarks

The three-dimensional trademarks are one form of trademarks capable of distinguishing the origin of goods; hence they are registrable and eligible for legal protection. China is a country in which a lot of trademarks are registered. For the past five years, we have accepted a lot of applications for registration of three-dimensional trademarks, some of which are registered upon examination. In the five-year legal practice, this writer believes that two issues in the registration and protection of three-dimensional trademarks require our attention: the issue of registrability of pure three-dimensional trademarks and the issue of protection of combination three-dimensional trademarks.

(I) Issue of registrability of pure three-dimensional trademarks

A pure three-dimensional trademark not directly relevant to the goods or service in respect of which it is used is registrable. But a lot of pure three-dimensional trademarks applied for registration as three-dimensional trademarks of the shape or package of the goods are generally held non-distinctive for being devoid of inherent distinctive character for them to be distinctive, and the applicants are under the burden of proof to show they have acquired their distinctive character for these trademarks. Besides, since protection for three-dimensional trademarks, especially those consist of the shape or package of the goods may conflict with that for copyright and patent, especially for the patent for design, most countries that accept applications for registration of three-dimensional trademarks have set forth stringent restrictions on the part of function of the three-dimensional trademarks.

(II) Issue of protection of combination three-dimensional trademarks

In China, the registrable three-dimensional trademarks are mostly combination three-dimensional trademarks. To date, the major issue besetting the three-dimensional trademark protection is the determination of the scope of protection for them. Since the trademark registration administrative authority, when examining combination three-dimensional trademarks, does not make substantial decision on the registrability of the three-dimensional part, which will lead the relevant section of public to misunderstand the three-dimensional trademark. Of course, this also happens to the conventional two-dimensional trademarks. Since three-dimensional trademarks are something new in China, however, the misconception is likely to be more serious. As a case in point, we may read in newsreports sentences, such as “a three-dimensional trademark has been registered; the registrant will enjoy the exclusive right to use said three-dimensional shape”. But in fact, the reported registered trademark is a combination three-dimensional trademark whose three-dimensional part may be of the common shape or the package of the goods. Provisions on the matter are strictly defined and set forth in the Chinese Trademark Law, the Regulations for the Implementation of the Trademark Law and the Trademark Registration Examination Standards. First, the most essential attribute of a trademark is its distinctive character. In other words, as long as one component of a combination trademark has its distinctive character, the trademark as a whole has its own distinctive character. That is why the word “exclusively” is used in the provision on the prohibited

registration of trademarks in the Trademark Law. Second, a combination three-dimensional trademark is an integral whole; and there is no objection to the right claimed by the registrant in the trademark as a whole. Third, what has the impact on the global impression of a combination three-dimensional trademark is its more distinctive element, that is, the main part thereof. This part is under stronger legal protection, and the right in the elements of the trademark as the secondary part is limited. That is, if a combination three-dimensional trademark contains the common shape, package and decoration of goods or directly indicates the characteristic of the goods, such as the main raw material, or is in the shape formed by the character of the goods per se, shape of the goods required for achieving the technical effect and shape of the substantial value of the goods, the registrant/holder of the exclusive right to use said mark has no right to prohibit another party from due use of it. ■

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¹ See Part Four Examination of Three-dimensional Trademarks of the Trademark Examination and Adjudication Standards issued by the Trademark Office and the TRAB of the State Administration for Industry and Commerce in December 2005

² Ibid.

³ See the Interpretation of the Trademark Law of the People's Republic of China compiled by the Trademark Office of the State Administration for Industry and Commerce, the China Industrial and Commercial Publishing House, 2003

⁴ Chen Xiaohua, the Preliminary Analysis of Examination of Relative Grounds for Trademark Refusal, the Chinese Patent & Trademarks, 2006, issue 3, Pp. 67-73.