

Examination of Three-dimensional Marks:

Interpretation of the Trademark Examination Standards (2)

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The three-dimensional marks are a new class of registrable trade marks introduced in the revised Chinese Trademark Law as of 2001. Corresponding provisions were set forth with regard to the examination of three-dimensional marks in the Trademark Examination Standards issued by the Trademark Office and Trademark Review and Adjudication

Board (TRAB) in 2005. This article is intended to present another interpretation of the Trademark Examination Standards on the basis of a series of cases of trade mark examination, review and adjudication in recent years.

I. Formality examination of three-dimensional marks: determination of three-dimensional shape

Article 13, paragraph three of the Regulations for the Implementation of the Trademark Law (the Regulations) provides that “if applying for registration of a three-dimensional sign as a mark, the applicant shall make a statement in the application, and submit a reproduction thereof by which the three-dimensional shape can be identified or determined”, without specifying the legal consequence of failure to make the statement to this effect and the way the shape of a three-dimensional sign is determined. Based on the practical experience and with reference to international practice, the inadequacy of the Regulations has been made up for¹: first, where the applicant does not make the statement, the mark applied for registration shall be deemed to be a two-dimensional mark; and second, the applicant may determine the three-dimensional shape by way of filing multiple views. The views shall be put in the same sample of the mark applied for registration, and shall not exceed six of them as it is enough to determine a three-dimensional sign from six perspectives of a three-dimensional sign: the front, rare, left, right, top, and bird's eye. If it is difficult to determine the three-dimensional sign of the sample of a mark filed, it is determined that the trade mark as a three-dimensional mark lacks distinctive character.

Case 1: Three-dimensional mark No. 3784747 refused²

In this case, the trade mark applied for registration was to be used in services, such as “paving road and highway” in classes 37, but the sample of the trade mark from the applicant was only a two-dimensional view of the building of the “Jiefang Commercial Auto Sale and Service Centre”. It could not show the three-dimensional effect. With the trade mark sample, it was difficult to determine the three-dimensional effect and shape of the trade mark applied for registration, so the trade mark was refused.



Case 2: Three-dimensional mark No. 3538127 refused³

In this case, the trade mark applied for registration is to be used in services, such as a “restaurant” in class 43, but the sample of the trade mark from the applicant was merely a two-dimensional view of a combination of a container and a cross,



and it was impossible to determine the three-dimensional shape.

Case 3: Three-dimensional mark No. 3531587 refused⁴

In this case, the trade mark applied for registration was to be used in goods of garment in class 25. The sample of the trade mark applied for registration is a combined two-dimensional view of a two-dimensional garment or apparel. As a whole, it did not show a three-dimensional effect, nor was it possible to determine its three-dimensional shape, so it was determined as devoid of distinctive character.



II. Examination of whether use of a three-dimensional mark is prohibited under law provisions

Examination of whether use of a three-dimensional mark is prohibited under the law provisions, namely the examination of whether a three-dimensional mark applied for registration was contrary to Article 10 of the Trademark Law. In practice, applicants often apply for registration of containers or packages with something like a bottle label to show trade dress functioning as a three-dimensional mark in which there are often signs showing the source and quality of goods. For that reason, such an application is contrary to Article 10, paragraph two of the Trademark Law, or misleads the relevant sector of the public.

Case 4: Reexamination of refusal of trade mark No. 3095303⁵

In this case, the trade mark applied for registration was to be used in goods of perfumery, perfume products and toilet water in class 3. It also contained the indication of place of origin “Paris” and its Chinese equivalent “巴黎”. The Trademark Office refused the trade mark applied for registration on the ground that “Paris”, a foreign geographic name known to the public, should not be used as a trade mark. Dissatisfied with the refusal, the applicant applied for reexamination, arguing that the distinctive part “One San Show” of the trade mark applied for registration was one originally created by the applicant for famous brands of goods of perfume and other cosmetics, and the mark acquired high reputation in the industry through use for a long time. The word “Paris” showed the place of production. Be-



sides, the applicant abandoned its exclusive right to use the nondistinctive parts including “Paris” when it filed its application for the registration of said three-dimensional mark. Upon examination, the TRAB held that the word “Paris” used in the trade mark applied for registration was a foreign geographic name known to the public, so it was a sign that should not be used as a trade mark under Article 10, paragraph two of the Trademark Law. In addition, the application was domiciled in the Netherlands, and its evidence was not sufficient to show that the goods in respect of which the trade mark in suit was used were all made in Paris, nor was it sufficient to show that said mark had acquired its distinctive character through use in China. Therefore, the applicant’s use of the three-dimensional sign containing the word “Paris” as a trade mark to be used in goods of perfumery, perfume products and toilet water in class 3 was likely to mislead consumers as to the source of the products, so its registration application should be refused.

Case 5: Reexamination of refusal of the “Hennessy FINE de COGNAC and the device” trade mark No. 3240987

In this case, the trade mark applied for registration was to be used in “spirits and wine” in class 33. The Trademark Office believed that the words “FINE de COGNAC” in the trade mark applied for registration meant “fine brandy”, which should be excluded from protection as a nondistinctive part of the mark in suit, and its use in respect of the goods other than brandy would cause confusion, so the trade mark applied for registration was partially refused, that was, preliminarily examined the trade mark applied for registration in respect of “alcohol (drinks), alcoholic drinks (except beer) and distilled alcoholic drinks” and its use in respect of “gin, fruit wine (containing alcohol), fruit drink containing alcohol, alcoholic drinks containing fruit, cocktails, wine and whiskey” was refused. During the reexamination proceedings, the applicant presented evidence showing its qualification to make cognac. Accordingly and in view of the fact that the trade mark applied for registration as a whole had distinctive character and was unlikely to mislead the relevant sector of the public, the TRAB approved the preliminary examination and publication of the trade mark applied for registration in suit.

The two trade marks applied for registration in the above two cases respectively contained the word “Paris” and “Cognac” showing the source and quality of the relevant products. In case 4, the place where the applicant was



domiciled was not the same as where the products were made in respect of which the trade mark applied for registration was to be used, so the application for registration of the trade mark was refused for it was likely to mislead the relevant sector of the public as to the source of the products. In case 5, the applicant was qualified to make cognac. It was hence assumed that containing the word in the trade mark in suit would not cause confusion, so it was preliminarily examined. With this in mind, it should be noted when one files an application for the registration of a three-dimensional mark containing signs showing source or quality of products, he/it should see to it that the characters of the source or quality of products are consistent with the contents shown in the sign in suit.

III. Examination of distinctive character of three-dimensional marks

1. General principles for determination of distinctive character

A three-dimensional sign of a trade mark applied for registration that is not related to the designated goods is generally deemed to have its distinctive character (case 6). A sign that is in the shape of goods or their package or container is held to be devoid of distinctive character, with exception to these circumstances:

- 1) where a mark contains other sign of distinctive character (case 7)
- 2) where a three-dimensional sign has been originally created, and has its own distinctive character (cases 8 and 9); and
- 3) where a sign has acquired distinctive character through long-time use (case 10).

Case 6: Application for registration of the “device” mark No. 3223150

In this case, the Shanxi Xinghuacun Fen Liquor Group Ltd. applied for registration of a trade mark to be used in such services as “restaurant, hotel, place providing accommodation, bar and cafe” in class 43. The three-dimensional sign was in the shape of a shepherd on a cow’s back, which was not related to the services, so it had distinctive character.



Case 7: Application for registration of “LU and the device” mark No. 763835 of international registration

In this case, the French General Biscuit Inc.



applied for registration of the trade mark to be used in the goods of “sugar” in class 30. While the three-dimensional sign of the mark may be deemed to be a package, it contained the distinctive letters “LU”, so as a whole it had its own distinctive character.

Case 8: Application for registration of the “device” mark No. 3213005

In this case, the Ferrero applied for registration of a trade mark to be used in the goods of “sweets” in class 30. The three-dimensional sign of said mark was unique, not in the common shape of sweets, so it had its own distinctive character.



Case 9: Application for registration of the “device” mark No. 747337 of international registration

In this case, the German Henkel Corporation applied for registration of a trade mark to be used in the goods of “cosmetics” in class 3. The three-dimensional sign of said mark was especially unconventional, and not in a common shape of container, so it had its own distinctive character.



Case 10: Application for registration of the “device” mark No. 640537 of international registration

In this case, the Swiss Nestle applied for registration of a trade mark to be used in “food seasonings” in class 30. The three-dimensional sign of said mark would often be taken as container of the goods by the consumers, and the use thereof would make it difficult to show the source of goods. However, the Nestle presented a great deal of evidence of use of the same during the refusal reexamination proceedings; which was sufficient to show that the sign could distinguish the source of goods, and it had the required distinctive character of a trade mark.⁶



2. Examination of trade mark applied for registration containing over-complicated distinctive part

As discussed above, a trade mark applied for registration in a shape of the goods or their package and containing a sign having other distinctive character is normally, as a whole, viewed as having distinctive character of a three-dimensional mark. But if it contains too many elements having distinctive character or too many elements of decoration or trade dress, which makes it difficult to be identified, it would be determined as devoid of distinctive character of a mark for its over-complicity.

Case 11: Reexamination of refusal of the “device” mark

No. 3200243⁷

In this case, the trade mark applied for registration was to be used in “plant seeds” in class 31. The Trademark Office believed that the words printed on said mark merely directly showed the attribute, quality and applicability of the variety of the goods, and they, as a whole, lacked distinctive character of a mark, and was not a distinguishing mark. During the re-examination, the applicant argued that the trade mark applied for registration, composed of a device and words, was designed by special brand design company appointed by the applicant, and it was distinctive as a mark. Besides, the grass seeds bearing said mark applied for registration had been available in the U.S. and China for many years, which had enhanced the distinctive character of said mark. Upon hearing the case, the TRAB held that the trade mark applied for registration was, as a whole, too complicated as a mark, and lacked distinctive character, and it would be difficult for consumers to identify it as a three-dimensional mark; hence said mark was a sign that should not be registered as a trade mark under Article 11, paragraph 1 (3) of the Chinese Trademark Law. Accordingly, the application for registration of it should be refused.



Case 12: Reexamination of refusal of the “device” mark No. 3060124⁸

In this case, the trade mark applied for registration was to be used in goods, such as apricot kernel cream (drinks) and apricot kernel milk (drinks) in class 32. The Trademark Office held that the words “red egg made of cow milk” used in said mark directly showed the raw material of the goods; the words “good luck and happiness to you”, a common phrase of blessing among people, lack distinctive character as a mark. During the reexamination, the applicant argued that the trade mark applied for registration was the three-dimensional device of an egg to be used in goods of milk, and the two were not directly relevant. Besides, the applicant had registered several word marks containing the “egg” shape. Red egg was not raw material of milk, but a word of advertisement coined by the applicant, and was not directly indicative of the raw material of the designated goods. The mark the applicant applied for registration was a three-dimensional one, the words “good luck and happiness”, which were used only as an attribute, did not have a use of its own. Besides, on the surface of the egg was



printed the mark of words and device of “YIMING and the device” and “LISHI Red Egg”, and carton images. The trade mark applied for registration became relatively reputable among consumers through prolonged advertisement or publicity, and had become a distinctive mark. Upon examination, the TRAB believed that the words, “red egg made of cow milk”, the quality certificate sign and the bar code used on the three-dimensional sign the applicant applied for registration were all signs that should not be used as trademark under Article 11, paragraph 1 (2) and (3) of the Trademark Law. The available evidence from the applicant was not sufficient to show that the mark had obtained distinctive character as a three-dimensional sign through prolonged use and publicity, nor enough to enable consumers to solely associate the trade mark applied for registration with the designated goods. Therefore, the application for registration of said mark should be refused.

In the above cases, the former trade mark applied for registration, package for seeds, is so complicated as a whole that it is difficult for consumers to identify the distinctive part of it; the latter mark is of a milk container in the shape of an egg. While it contains the respectively distinctive words and devices of “YIMING and the device” and “LISHI Red Egg”, and the carton images, it is composed of so many elements that it is difficult to be used as a distinctive mark as a whole.

IV. Examination of functionality of three-dimensional marks

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

1. Shape which results from the property of the goods *per se*

The shape which results from the property of the goods *per se* refers to a shape that must be, or is often, used to achieve the intrinsic function and use of the goods. In the Trademark Examination Standards has been cited the case of “safety buckle three-dimensional mark”, which is in the common shape of a safety buckle.

Case 13: Refusal of the “device” mark No. 767984 of international registration⁹

In this case, the trade mark applied for registration was to be used in “paint sprayer” in class 7. Upon examination, the Trademark Office believed that said mark was composed only of the common shape of the goods, and refused the application under Article 11, paragraph 1 (1) of the Trademark Law. For this writer, if it is determined that the three-dimensional sign of the trade mark applied for registration is of the shape commonly used to achieve the function of a “paint sprayer”, and it is a shape which results from the goods *per se*, it would be more appropriate to refuse the application under Article 12 of the Trademark Law.



2. The shape of goods which is necessary to obtain a technical result

The shape of goods which is necessary to obtain a technical result refers to a shape necessary to be used for goods to have certain function or for making it possible to more easily perform the intrinsic function of the goods. In the Trademark Examination Standards, “the three-dimensional sign of a power plug” is necessary to obtain a technical result of such products. The texture on “the three-dimensional sign of a capacitor” is anti-slippery, and makes it easier to use, so it is the shape necessary to make it easier to perform the intrinsic function of a capacitor.

Case 14: Refusal of the “device” mark No. 647842 of international registration¹⁰

In this case, the trade mark applied for registration was to be used in “tools (machine parts)” in class 7. The three-dimensional sign of the mark is a cone, the shape of the goods which is necessary to obtain a technical result of easy screwing.



Case 15: Refusal of the “device” mark No. 790272 of international registration¹¹

In this case, the trade mark applied for registration was to be used in “guitar” in class 15. The three-dimensional sign of the mark is in the shape of the guitar head, a shape of the goods which is necessary to obtain a technical result of fixing string.



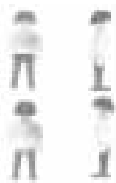
3. Shape giving goods their substantial value

The shape giving goods their substantial value is a shape used for the design and form of the goods to have impact on the value of the goods. In the Trademark Examination Standards is cited an example of “porcelain decorative article” (vase) and “brooch”. Goods of the kind have their value

in their design or shape, not in the raw material they are made of, and consumers want to buy their novel design and appealing form, so the shape is one that gives such goods their substantial value.

Case 16: Refusal of the “device” mark No. 778306 of international registration¹²

In this case, the trade mark applied for registration was to be used in “toys” in class 28. The three-dimensional sign of said mark is one in the shape of a small child, which was sufficient to have impact on the value of the designated goods “toys”. A consumer’s choice of the toy was decided by the shape of the small child, and it was a shape that gave the goods their substantial value.



Case 17: Refusal of the “device” mark No. 4058286¹³

In this case, the trade mark applied for registration was to be used in “soft cushion” in class 20. The three-dimensional sign of said mark was one in the shape of an animal. Using this shape for the goods of soft cushion was to make them more appealing, and gave them unusual value, so it was a shape that gave the goods their substantial value.



V. Registrability and scope of protection of three-dimensional marks

Initially, we understood three-dimensional marks as pure three-dimensional signs reflecting some goods per se or their packages or containers and essentially distinguishing source of goods or services through their “three-dimensional shape”. But, as the practice of examination and registration of three-dimensional marks in many countries shows, a three-dimensional sign showing the shape, package or container of goods is often determined as devoid of distinctive character. Only original, different signs have its distinctive character, and are registrable. Besides, a three-dimensional sign with elements, such as words, device, letters or numbers having distinctive character, is viewed as having distinctive character. China is no exception in this regard. Further, most three-dimensional marks registered or preliminarily examined so far are three-dimensional marks containing “other distinctive signs having their distinctive character”. The distinguishing element of trade marks of the type is their “other distinctive signs”, not their “three-dimensional shape”. Strictly, the signs of such marks are three-dimensional, and are not three-

dimensional marks. Protection of three-dimensional marks of the type lies in “the signs having their distinctive character”, not in their “three-dimensional shape”. In the substantive examination, if marks whose “three-dimensional shapes” are identical or similar and whose “signs having distinctive character” are sufficient to show the source of goods without creating confusion on the part of relevant sector of the public, they are not determined as identical or similar marks. Therefore, to register and protect a “three-dimensional shape”, an applicant had better choose to apply for registration of a single “three-dimensional sign”.

Case 18: The “KURG and the device” mark No. 3276258 and “LA GRANDE DAME” mark No. 3276252¹⁴



(Word: KURG)



(Words: LA GRANDE DAME)

Both marks were to be used in the service of “restaurant” in class 43, and both three-dimensional signs were in the common shape of a bottle. While they were similar in the shape of the bottle, their respective three-dimensional shape lacked distinctive character when used in respect of the designated service. But the words “KURG” and “LA GRANDE DAME” were obviously different, so they were not determined as similar marks.

Case 19: Refusal of the “device” mark No. 783985 of international registration¹⁵

In this case, the trade mark applied for registration was to be used in “chocolate” in class 30. The Trademark Office refused the application for its lack of distinctive character. The applicant’s grounds for reexamination were as follows:



(1) The trade mark applied for registration was a unique package of such colours as golden, maroon, white and red. The package was composed of a three-dimensional shape of fruit kernel candy wrapped with a piece of golden paper, with a small white oval label on top of it and with golden edge and red edge in the middle above the maroon and golden base. The trade mark applied for registration, which was not a common package used in the food industry, was capable of showing the source of products, and had its own distinctive character; and

(2) The applicant’s products had been widely marketed, and the unique package was identifiable by broad masses of

consumers, so it requested for extended protection of the trade mark within the territory of China.

Upon examination, the TRAB took these views:

(1) As a three-dimensional mark, the trade mark applied for registration, only a package commonly used for the designated goods, was difficult to show the source of goods and lacked its distinctive character a trade mark should have, so it fell into the circumstance under Article 11, paragraph one (3) of the Trademark Law; and

(2) Up to the time when the case was under review, the applicant did not present any evidence to show that said mark had acquired its distinguishing function through extensive publicity and use. The applicant's grounds for reexamination were not tenable, and its application for extended protection of the trade mark within the territory of China should be refused.

The following views were held in the first-instance ruling:

(1) The TRAB did not adduce evidence with regard to "common use"; and

(2) The choice of colour and the package of the goods for the trade mark applied for registration fell outside the scope of the industry and the common choice for the package of the designated goods. The originality of the said mark turned into a design particular to the plaintiff's products, which made it possible for the consumer, upon seeing it, to clearly identify the source of the goods bearing the mark; hence the trade mark applied for registration had acquired its distinctive character.

Even if the device of the trade mark applied for registration was not a "commonly used one", by virtue of their customary identification, ordinary consumers usually would identify the trade mark applied for registration as the package and shape of chocolate, rather than a sign showing the source of the goods, with exception to the circumstance that it acquired its distinctive character through use. In the first-instance ruling were described, in detail, the colours and package of the trade mark applied for registration, and it was held that the mark in suit naturally had its distinctive character, without the need to put it in practical use. However, after the trade mark in suit was registered, what was brought under the protection, the "three-dimensional sign" or the "colour and package attached to the sign"? In other word, does a third person who makes chocolate of the three-dimensional shape with package in different colour infringe the trade mark right in suit? This will be an issue worth our close attention. ■

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¹ Section 3 and 4 (4) of Part 4 of the Trademark Examination Standards.

² See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 3784747BH1.

³ See the Trademark Office's Notifications on Refusal of the "Device" Trade Marks Nos. 3538827BH1 and 3538128BH1.

⁴ See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 3531587.

⁵ See the TRAB's Decision No. Shangpingzi 2211/2007 on Reexamination of Refusal of the "Device" Trade Mark.

⁶ See the TRAB's Legal Affairs Information, 2007, Issue 3.

⁷ See the TRAB's Decision No. Shangpingzi 2302/2007 on Reexamination of Refusal of the "Device" Trade Mark.

⁸ See the TRAB's Decision No. Shangpingzi 2234/2007 on Reexamination of Refusal of the "Device" Trade Mark.

⁹ See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 767984BH1 of International Registration.

¹⁰ See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 647842BH1 of International Registration. The applicant, dissatisfied with it, has applied to the TRAB for reexamination.

¹¹ See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 790272BH1 of International Registration. The applicant, dissatisfied with it, has applied to the TRAB for reexamination.

¹² See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 778306BH1 of International Registration. The applicant, dissatisfied with it, has applied to the TRAB for reexamination.

¹³ See the Trademark Office's Notification on Refusal of the "Device" Trade Mark No. 4058286BH1 of International Registration.

¹⁴ (V) 1 (3) in Section 4 of Part 4 of the Trademark Examination Standards.

¹⁵ See the TRAB's Decision No. Shangpingzi 3190/2006 on Reexamination of Refusal of the "Device" Trade Mark; the Beijing No. 1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 815/2007.