

The background features a complex, abstract design. It consists of several overlapping, wavy bands of fine, parallel lines. The colors of these bands range from light blue and cyan to bright yellow and orange. Additionally, there are concentric, dashed circular lines scattered across the lower half of the image, creating a sense of depth and movement.

**Baker
McKenzie.**

**Baker McKenzie
Asia Pacific IP updates:
A focus on Trademarks**

Regional Highlights

Hong Kong

- Implementation of Madrid Protocol pushed back to late 2024 / early 2025
- Option to choose electronic registration certificates from mid-2024

Thailand

- Image search system recently implemented by the DIP has helped facilitate a device mark availability search well enough.
- Slogans/taglines as a trademark face difficulties in successful registration
- TCIR system of the Customs Department advances protection of trademark and copyright at the Thai border

Myanmar

There have been multiple major IP developments in Myanmar: (a) the copyright and industrial design registration systems commenced in February 2024; (b) the Trademark Law took effect on 1 April 2023, with the first trade mark examination reports issued in March 2024; first marks have been published in April 2024; (c) mark owners are now able to file for customs recordation, a useful anti-counterfeiting measure; (d) the new Patent Law is expected to take effect by mid-2024, and rights holders will soon be able to register with the MIPD via the electronic filing system; and (e) specialist IP courts have been established to adjudicate IP issues which will assist rights holders with enforcement of IP rights.

Vietnam

- The amended IP Law-guiding decree and circular were promulgated in late 2023, offering detailed guidance for brand owners on brand protection strategies, including some noteworthy issues such as opposition procedures, bad-faith demystification, and prosecution and post-registration procedures.
- Trademark examination practices in Vietnam are facing significant delays and inconsistent viewpoints, prompting brand owners to devise practical strategies for effectively protecting and enforcing key brands, as well as for business growth.

Malaysia

Distinctiveness of foreign words in the context of trademark registration: *Fumakilla Ltd v The Registrar of Trademarks* [2023] 11 MLJ 691 has shed some light on the assessment of distinctiveness and registrability of foreign words as trademarks.

China

China is continually strengthening its legislative and enforcement actions in combating malicious trademark filings. In recent cases, the Chinese courts have shown willingness to grant enhanced protection to both domestic and foreign renowned IP right holders.

Taiwan

Expedited examination for trademark registration: An applicant may pay an additional examination fee to the Taiwan Intellectual Property Office (TIPO) to expedite the examination procedure. The average examination time will reduce from 6-7 months to 2 months.

Japan

From 1 April 2024 letters of consent will be recognized by the JPO if there is no risk of confusion between the marks

Philippines

There are various initiatives to combat infringement on the internet, including voluntary site-blocking rules and the Internet Transactions Act. There are also proposed amendments to procedural rules in order to streamline the process of resolving IP violation cases.

Australia

Lower courts find that disclaimers and other material surrounding the use of a mark are not to be considered when determining deceptive similarity in infringing cases, as they seek to resolve the controversy arising from High Court's decision.

New Zealand

Use of a mark in order to communicate that a product is compatible with another product will not automatically be considered non-infringing. A Court will look at factors such as the connotations of the word or mark used, and its size or prominence in context.

Singapore

There have been several IP developments in Singapore, including: (a) the launch of the Intangibles Disclosure Framework; (b) a new collective management organisation (CMO) class licensing scheme; (c) a pilot initiative to add new goods/services descriptions to the IPOS Classification Database; (d) successful mediation cases under the WIPO-Singapore ASEAN Mediation Programme; (e) practice directions issued on NFTs and metaverse-related goods/services; and (f) Singapore's first case under the simplified IP dispute resolution system.

Indonesia

Coordination between local IP consultants and the Indonesian Trademark Office is needed to ensure proper classification of goods and services as part of the implementation of the Nice Agreement and those designation filings for Indonesia through Madrid Protocol.

Australia





Australia

1. Australia Key Developments

Australian Courts grapple with the application of the H.C.'s decision regarding the extent to which circumstances surrounding allegedly infringing conduct are to be considered when assessing deceptive similarity between two marks.



Official fees paid for services provided by IP Australia set to increase, with some significant increases expected for opposition and non-use removal matters.



IP Australia adopts the Madrid Goods and Services List.



2. Latest issues

2-1 Did the H.C. expand the consideration of deceptive similarity under section 120(1) of the Trade Marks Act, to circumstances surrounding the actual use of the allegedly infringing mark?

The Agency Group Australia Limited v H.A.S. Real Estate Pty Ltd [2023] FCA 482 (*The Agency*)



Conclusion

The High Court in *Self Care IP Holdings Pty Ltd & Anor v Allergan Australia Pty Ltd & Anor* [2023] HCA 8 (*Self Care*), "cited with approval a number of authorities which have held that material external to the respondent's mark is irrelevant to the issue of deceptive similarity". It was therefore appropriate to disregard the parts of the High Court judgment in *Self Care* which referred to actual use of an allegedly infringing mark as "unfortunate errors".

McD Asia Pacific LLC v Hungry Jack's Pty Ltd [2023] FCA 1412



Conclusion

Consideration of the circumstances surrounding the actual use of an infringing trademark is not relevant to the question of deceptive similarity under the infringement provisions. In "*Self Care* it is apparent that the Court was referring to the actual use of the impugned trademark in the sense of the use of the impugned sign alone, rather than the broader context of use", which is a comparison "that has long been established by the authorities".



Comment

There remains some controversy as to whether actual use of an allegedly infringing mark, including disclaimers and use of other marks on packaging or advertising, is relevant in assessing whether a mark is deceptively similar to another mark, for the purposes of establishing infringing conduct under section 120(1) of the Trade Marks Act.

2-2 Marks found not to be substantially identical or deceptively similar

The Agency Group Australia Limited v H.A.S. Real Estate Pty Ltd [2023] FCA 482 (*The Agency*)



Trademarks



Conclusion

The respondents did not infringe the applicant's marks. The registered mark THE AGENCY was a composite mark rather than a word mark due to the stylised "A". In the case of a composite mark, the whole of the marks and devices, which may consist of a number of elements, must be considered in their context including the size, prominence and stylisation of words and device elements used in the mark and their relationship to each other, and any essential feature. The ordinary consumer would not fail to recall the stylised "A" element of the applicant's composite mark. The inclusion of the word NORTH in the mark THE NORTH AGENCY substantially differentiated it from the applicant's THE AGENCY mark.



Comment

Composite marks must be considered as a whole and the protection afforded to the words included in a composite mark is limited to the effect created by the mark as a whole.



Australia

2. Latest issues

McD Asia Pacific LLC v Hungry Jack's Pty Ltd [2023] FCA 1412



Trademarks

BIG MAC/MEGA MAC v BIG JACK / MEGA JACK



Conclusion

The marks were not deceptively similar from the perspective of a hypothetical consumer who had never heard of the McDonald's business. The words BIG and MEGA, shared by both marks, were descriptive in nature, while the word MAC would be seen to be a coined name and the word JACK to be a recognised forename. A consumer, with imperfect recollection, would readily call to mind MAC and JACK and identify each as an important and distinctive part of the mark. The marks were unlikely to confuse the notional consumer.



Comment

A mark is unlikely to be considered to be deceptively similar to another mark when the only element shared by both marks is a descriptive word, and the marks are accompanied by coined or distinctive terms not shared by both marks.

2-3 First use trumps first to register

Cantarella Bros Pty Ltd v Lavazza Australia Pty (No 3) [2023] FCA 1258



Trademarks



Conclusion

The ORO registrations were invalid as Cantarella was not the owner of the mark. The owner of the mark, as a result of first use of "ORO" in Australia in respect of coffee, was coffee trader Caffè Molinari SpA.



Comment

Trademark applicants must also ensure that they are the first users of the mark they are seeking to register and thus the true owners of the mark. Prior use of a mark in respect of the same or similar goods or services may be enough to invalidate a registration.

2-4 "Use as a trademark"

Seven Network (Operations) Limited v 7-Eleven Inc [2023] FCA 608 (7Now)



Trademark

7NOW



Conclusion

Use "as a trade mark" must be assessed having regard to the facts and context. The use a domain name merely to redirect Internet users to a website where a different trade mark was depicted, without any other use or advertising, did not amount to trade mark use.



Comment

Mere registration and/or use of a domain name that incorporates a trade mark, without more, is unlikely to amount to trade mark use.



China



China

1. Law Amendments/Practice Updates

Amendments to Trademark Law (draft for comments – issued in Jan. 2023)

Latest status in 2024: pending

- Trademark use requirement to foster utilization
- Continuous efforts against malicious registration
- Streamlined examination and registration progress



Amendments to Anti-Unfair Competition Law (draft for comments – issued in Nov. 2022)

Latest status in 2024: pending

- Fill in gaps between existing legal framework and unconventional acts of unfair competition, and regulate contributory infringement
- Specify confusion acts and expand scope of protection
- Reinforce penalties and legal liabilities



Provisions on Standards for Evidence in Trademark Administrative Enforcement (draft for comments - Dec. 2023)

Latest status in 2024: pending

- Highlight crucial role of electronic data in modern trademark administrative enforcements.
- Clear formality requirements of overseas evidence.



2. Reduced acceptance of consent letters in application appeal cases

The CNIPA and the courts for administrative trademark litigations have been adopting more prudent and stringent standards towards letters of consent, and the letters of consent or coexistence agreements no longer appear to be an effective way to overcome the rejections of applications. In some cases, even if there are similar precedents, the examiners and judges are not inclined to accept the consent letters in application appeal cases of later trademarks in same or similar situations. Brand owners need to note this change and find ways to cope with the challenges proactively.



3. Examination opinions under Article 4 of PRC Trademark Law



Updates

To recap, since 2022, the CNIPA has frequently issued examination opinions requesting evidence of use when applicants file numerous applications within a short period of time. In recent months, most of these applications were finally approved for registration after we submitted the declaration of intent of use. Additionally, the frequency with which the CNIPA issues notices seems to be lower than before, especially for those clients for whom we filed declarations of intent of use in previous cases.



BM comment

It appears that the CNIPA has adopted a more reasonable review mechanism for issuing examination opinions in recent months. The applicants' active response to examination opinions also seems helpful to some extent.

4. Continuous combat against bad-faith trademark filings

Favorable judgments (1-2)

#1 Emerson Case

Fujian High People's Court determined the defendants' bad faith trademark filings as acts of unfair competition

#2 Gan Ba Case

Fujian Quanzhou Intermediate People's Court ruled that the defendants' bad faith trademark filings, copyright records and Customs records constituted acts of unfair competition



Favorable judgments (3-4)

#3 ReFa Case

Ningbo Yinzhou District People's Court determined the defendants' bad faith trademark filings as acts of unfair competition and ordered the defendants to withdraw the bad faith filings

#4 Yuan Bei Case

Shaanxi High People's Court ruled that use of a registered mark (filed by a third party in bad faith) by its assignee constituted unfair competition against the brand owner

Successful administrative actions

AMR of Guangzhou Baiyun District

- 2 individuals and 13 of their affiliated companies involved in trademark applications
- Penalties of warning and fine imposed

CNIPA and AMR of Changshu City

- An IP agency filed over 800 marks under the name of its affiliate
- Penalties of warning and fine imposed, and permanent injunction of filing trademarks as trademark agent





China

5. Latest issues

Protection of trade dress – Case 1: Crocs v. Quanzhou Zhongkuo



Trade dress

Shape and decoration of Crocs shoes



(example only for reference)



Conclusion

The Fujian High People's Court overturned the first-instance judgment in relation to the claimed trade dress protection and held that the evidence is insufficient to prove that the relevant public has associated the claimed shape and decoration with Crocs. Crocs did not actively defend its rights when many footwear products with the same or similar features emerged in the market, so the decoration has lost its inherent distinctiveness.



BM comment

Chinese courts take various factors into consideration for protection of trade dress, including the distinctiveness and fame of the claimed trade dress, the similarity of the trade dress at issue, and bad faith acts, etc. Legitimate right owners also need to put more efforts into dealing with the infringement at a very early stage to avoid the dilution of distinctiveness.

Protection of trade dress – Case 2: A razor brand



Key facts

The defendants, as a group of repeated infringers, imitated the trade dress of razors under a famous US razor brand. The infringers also registered and used a series of marks similar to the right owner's well-known marks.



Conclusion

The Hangzhou Intermediate Court granted protection of the decorations of the right owner's **five types of razors**, as well as well-known mark protection, and held all defendants jointly liable for the unfair competition acts and trademark infringement.



BM comment

The quantity and quality of the evidence is imperative and determinant to the outcome of case. It is recommended to put more effort into evidence collection to enhance the chances of success.

Parallel import issues – Case for a cosmetic brand



Key facts

The defendant, a local department store, was selling cosmetic products of a famous foreign brand obtained through parallel import and using: (a) the brand owner's marks in store decorations and online promotions, (b) decorations of counters and posters similar to those of brand owner.



Conclusion

The local court found that the defendant's use of brand name and similar trade dress constituted acts of unfair competition (including confusion acts and false advertising) against the brand owner.



BM comment

It is always troublesome for brand owners to deal with parallel imports. While the sale of parallel imported products does not necessarily amount to infringement under PRC laws, considerations may be given to exploring alternative ways to tackle excessive unauthorized use of marks, trade dress, etc. to discourage parallel importers.

High amount damages in recent IP cases in 2023-2024



Pan Pan case

The Supreme People's Court of PRC awarded damages in the amount of over RMB 100 million (USD 13.83 million), with punitive damages amounting to four times the profits from the infringing activities.



Siemens case

The Supreme People's Court of PRC awarded damages in the amount of over RMB 100 million (USD 13.83 million).



Jägermeister case

The Beijing High People's Court awarded damages in the amount of over RMB 10 million (USD 1.38 million) with one-time punitive damages being applied.

Hong Kong





1. Law Amendments/Practice Updates

Electronic registration certificates

- Option to choose electronic registration certificates from mid-2024



Implementation of the Madrid Protocol

- Implementation of Madrid Protocol pushed back to late 2024/early 2025
- Subsidiary legislation to facilitate the international registration system are in the advanced drafting stage



Decreased number of filings

- Number of trademark filings from October 2022 to September 2023 decreased by 6.5% from the corresponding period in 2021 - 2022



2. Latest issues

2-1 Bad faith objection

The Registry may raise a bad faith objection during examination if the circumstances give rise to a reasonable suspicion of the applicant's entitlement to the mark or the honest of his/her intention. The act of applying for a trademark without an honest intention to use would not on itself amount to bad faith, though the Registry can still refuse an application for lack of honest intention to use.



2-2 Names of famous singers or artists

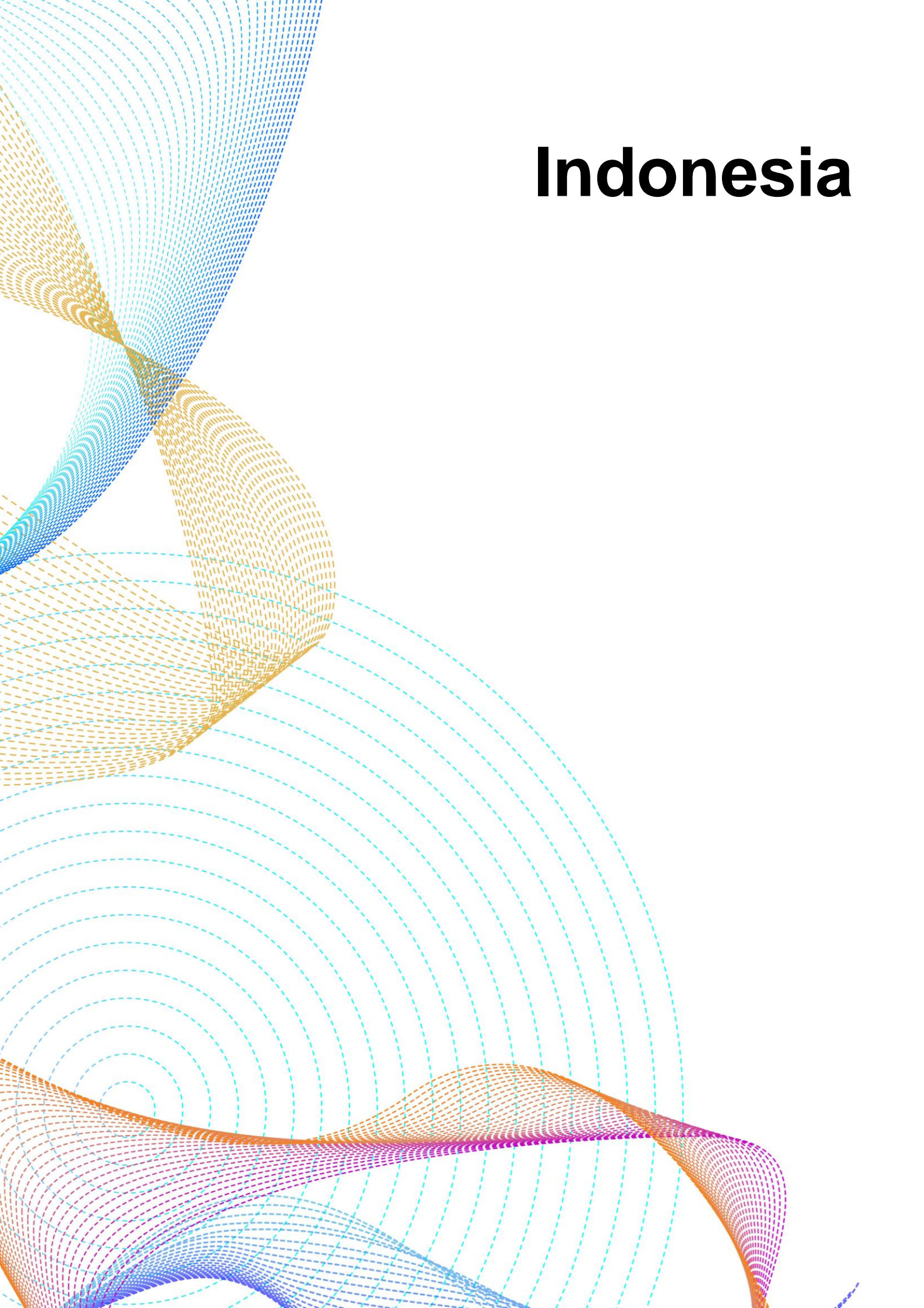
The Registry has been refusing applications to register the names of famous singers or artists, on the basis that use in relation to the relevant goods/services will merely be seen as a commemoration of that famous person or as an indication that they are about that person.

Following a 1999 English decision about Elvis Presley, the Registry maintains that if a famous person's name is likely to result in a demand for memorabilia, the general public are unlikely to see that name as anything other than an indication of the content of character of goods/services, rather than as an indication of trade origin. A mark may by becoming distinctive for one class of goods or services (e.g., musical performances) become descriptive for another class of goods or services (e.g., posters, mugs and compact discs).

Applicants have to file evidence to show that the name of the famous person has a connection with the applicant, as it is wrong to assume that only a celebrity, or his/her successor, would ever market his/her own character.



Indonesia





Indonesia

1. Law amendments/practice updates

A. Ratification of Nice Agreement.

Following the government's last year ratification of the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the registrations of marks, the implementation in practice has not been somewhat consistent, whereas the availability of kinds of goods and services are not always available in the online pre-approved list of goods and services as provided by the Indonesian Trademark Office ("TMO"). This requires local IP consultant to actively coordinate with the TMO to ensure the availability of goods and services during each new filings at the TMO.

B. Joint taskforce to monitor distribution of IP infringing goods on local marketplaces.

The IP Office is in the process of establishing a joint taskforce with the Ministry of Communication and Informatics ("MOCI") to monitor the distribution of possible IP infringing goods on local marketplaces. It seems from the early discussion that the taskforce may also carry out the function of alerting the marketplaces if there are listings of IP infringing goods, so that the marketplaces can proceed with taking down the listings without relying on takedown requests sent by IP owners.

C. Customs Measures.

In July 2023, the Directorate General of Customs and Excise ("DGCE") issued an official letter encouraging trademark owners to record their trademark rights at the Customs Office. Based on the recordal, the DGCE would be able to exercise customs measures. Trademark owners may lodge a request to the Commercial Court to issue an order of suspension of any suspected counterfeit products from customs zones.

2. Latest issues

Inconsistencies in the implementation of the Madrid Protocol in Indonesia

Subsequent designation of IR trademark to Indonesia

Even though the Madrid Protocol has been ratified for quite some time in Indonesia, in current practice there are still issues with IR trademarks designating Indonesia as the subsequent designation country. In a recent case an IR trademark with multi-class registration that designated only one of the classes to Indonesia somehow cites the other classes as covered in the original IR registration. Trademark owners are required to coordinate further with the TMO to ensure the IR particulars are accurately recorded in the TMO.

3. New regulations on importation permit of certain products

The Ministry of Industry issued Regulation No. 5 of 2024 on Procedures for Issuing Technical Considerations on Imports of Textiles, Textile Products, Bags and Footwear. This regulation outlines procedures and requirements for issuing technical considerations on imports, a letter used as a requirement to obtain an import permit. To issue the technical considerations on imports, the local companies must have a report on general importer verification. The verification is carried out on companies that import textiles, textile products, bags and footwear and that submit an application for verification to the Verification Implementing Agency. Some of the required documents for the application are a trademark certificate and/or trademark license recordal of the products. Hence, this regulation affirms that only local importer having a trademark license arrangement in place with the trademark owner would obtain the permit to import textiles, textile products, bags and footwear with the trademark.



4. Recent court decisions

Another successful cancellation action cases acknowledge well-known mark protection

There was a recent decision issued by the Commercial Court on a cancellation action case brought by a US-based F&B company (as the plaintiff) against a similar trademark registration in Class 32 registered in the name of a local company (as the defendant) for the same kinds of goods.

The Commercial Court decided to accept the plaintiff's request to cancel the defendant's trademark. The panel of judges have the view that: (i) the plaintiff owns the registration of the trademark and has the exclusive right to use the trademark and prevent any other third parties from using a similar trademark without the authorization of the plaintiff; (ii) there are similarities between the plaintiff's and the defendant's trademark from the visual, pronunciation and kinds of goods perspectives; (iii) the plaintiff's trademark is a well-known trademark as it has been registered, used and promoted in several countries around the world; and (iv) the defendant's trademark was registered in bad faith.

A cancellation action case decision based on the basis of bad faith trademark filing

Another recent decision on cancellation action issued by the Commercial Court was the case between a US-based entertainment company (as the plaintiff) and a local company (as the defendant). The plaintiff brought the case to the court as the defendant has registered the plaintiff's well-known trademark for action movie character against a similar registered trademark but for the kinds of goods that are unrelated to the plaintiff's business.

The panel of judges ruled in the favor of the plaintiff and decided that: (i) the plaintiff is the first user and the sole owner of the trademark; (ii) the plaintiff's trademark is a well-known trademark; (iii) the defendant's trademark was registered in bad faith. The Commercial Court decision has been final and binding, as the defendant did not file a cassation to the Supreme Court.

Japan





Japan

1. Law Amendments/Practice Updates from 1 April 2024

There has been a long-awaited amendment to Japan's Trademark Act so that letters of consent from the owners of prior trademark will be accepted by the JPO if there is no risk of confusion between the marks. Registrations will now be approved from 1 April 2024.

BM Comment: There may be some teething issues with the interpretation by the JPO of "no risk of confusion". However, we will need to see how this pans out.

Trademarks containing a person's name could not be registered as a trademark without the consent of all people bearing that name. This caused issues with a well-known trademark using a fictitious name being rejected even though it had acquired distinctiveness. The revised Trademark Law will allow trademarks which are people's names to be registered if they are popular and taking into consideration surrounding circumstances.

BM Comment: A sensible development, although may not be used that much in practice.

2. Latest issues

2-1 Unregistered Well-Known Mark (IP High Court Case)



Trademark

地球グミ (PLANET GUMMI in Japanese)



Conclusion

"地球グミ" (PLANET GUMMI in Japanese), was filed and registered by a Japanese importer which imported from the goods from the trademark owner of PLANET GUMMI (word mark in English). While the importer had made the gummi well-known in Japan by selling the gummi in Japan, its registration was invalidated by the trademark owner of PLANET GUMMI (word mark in English) because PLANET GUMMI was considered as the trademark owner's unregistered well-known trademark.



BM Comments

Since the well-known status of PLANET GUMMI was sufficiently supported by evidence, the trademark owner successfully invalidated "地球グミ" (PLANET GUMMI in Japanese). Filing applications for word marks in Japanese **in addition** to filing applications for word marks in English is still important if evidence is not sufficiently enough to support the well-known status of word marks in Japanese.

2-2 Distinctiveness of Position Mark (IP High Court Case)



Trademark

DR MARTINS'
position mark
(Yellow welt Stitch)



DR MARTINS'
Actual product



Conclusion

The IP High Ct. concluded that DR. MARTINS' yellow welt stitch has not acquired distinctiveness to register the position mark considering actual sales of products in the Japanese market is not high even if DR MARTINS claims their use of yellow welt stitch in Japan for 35 years.



BM Comments

Unfortunately, under the current practice in Japan, it is still not easy to register position marks (although see a successful example below). The IP High Court did mention that products containing not only the yellow welt stitch but together with other features may constitute unfair competition.



Japan

3. The JPO's operation updates

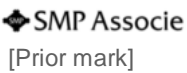




The JPO is becoming more digital!

From 1 January 2024, it is possible to **electronically submit documents** to the JPO, which previously could only be submitted in paper format, such as documents to be filed with the JPO Appeal Board and petitions for recordal of transfer of trademark rights. Although the JPO will still accept paper-based procedural documents.

Also, from 1 April 2024, the JPO has started sending certain documents electronically. For example, the registration certificate and the notice of completion of recordal of transfer, which previously was only issued and sent using paper is now available online. We expect that this will be helpful to improve the efficiency of work and document storage.



4. Recent Decisions

Action	Decision (Reason)	Trademark	Detail
Similarity/Likelihood of confusion/Well-known marks			
Appeal	Registered (Dissimilar)	 [Prior mark] 	Class 44 JPO: The marks are easily distinguishable in terms of appearance based on the difference in the presence or absence of the device and "Associe". In terms of pronunciation, "SMP Associe" and "SMP" are easy to distinguish. BM Comments: Not a convincing decision, but it is recommended that sub-brand marks be filed and registered even if they contain a main brand mark that is already registered.
Distinctiveness			
Appeal	Registered (Position mark)		Class 25 The Board held that a continuous arrow design on sports apparel is not a commonly used design. The Board also found that the submitted evidence showed that the continuous arrow design was widely known among consumers. BM Comments: The distinction with the Dr Martins decision is probably due to the more distinctive shape of the continuous arrow design.
	Registered (Position mark)		
Non-Use Cancellation			
Trial	Cancelled (Non-use)	 TM used: "CREMO INGREDIENTS A/"	Class 29 The use of "CREMO INGREDIENTS A/S" was not held to be use of the registered trademark "from a common sense" perspective. Due to the absence of the cheese device and existence of "A/S". BM Comments: "identical use" is narrowly interpreted in Japan so care must be taken.

Malaysia





Malaysia

1. Latest issues

1-1 A survey and/or investigation is not a mandatory requirement to establish non-use for purposes of revocation of a registered trademark



Trademark



Conclusion

As the registered owner of the trademark is non-existent and the purported trademark proprietor has been wound-up for over 10 years, it is not necessary for the applicant to adduce a survey or investigation report to establish a non-use of the subject trademark by the registered owner. Whether or not an applicant has established prima facie non-use of the subject mark is fact-centric.



BM comment

In instances where the registered proprietor of a trademark is a juridical person that has ceased to exist for a period of at least 3 years, on the assumption that there is no assignment of the said mark and the said mark is not in use by a licensee, the said mark is deemed to not be in use; Non-use will be implied upon establishing that the registered proprietor has ceased to exist.

1-2 Use of foreign words is not prima facie a non-invented word



Trademark

KAORI
かおり



Conclusion

By way of background, the case concerns an appeal against the Trademark Registrar's rejection of the appellant's application to register its trademark (which consists of the word Kaori and a combination of Japanese character which mean 'scent') for goods in Class 3 vis-à-vis 'fragrance preparations'. The High Court allowed the appeal and ordered for the subject application to be accepted for registration.

The High Court held that just because a mark consisted of a word that meant something in a foreign language, it did not mean that word could never be an invented word. In this regard, as the mark consisted unique combination of a foreign word and Japanese characters, the mark was regarded an invented word. In addition, the Court was of the view that if the Malaysian public does not understand the words in the mark and had to stop to reflect and ask what they meant, then the mark did not have a direct reference to the character or quality of the subject goods under the mark.



BM comment

Of note, the Malaysian Courts have previously held that 'Oishi' is not an inventive word vis-à-vis goods and services in Classes 30 and 43 (the "**Oishi Case**"). The Court, in its assessment of the registrability of 'Kaori', distinguished the present case from the Oishi Case on the basis that the general Malaysians understand or recognize 'Oishi' but do not readily understand 'Kaori'. The disparity in the outcomes with respect to 'Oishi' vs 'Kaori' illustrates that traders who intend to register foreign words as trademarks should be cautious and consider if a foreign word or transliteration of the same is known and/or recognised in the relevant jurisdiction.

Myanmar





Myanmar

1. Law/practice updates

Trademark Law fully operational

The Trademark Law took effect on 1 April 2023. The Myanmar trademark regime changed from a first-to-use system to a first-to-file system.

Old marks filed before this new trademark filing system have been granted with a common filing date, 26 April 2023. Publication of marks is anticipated to start in May 2024.



Copyright Law took effect

The Copyright Law took effect on 31 October 2023.

Copyrighted works can be voluntarily registered as prima facie evidence of ownership of the works. This registration system began operation on 9 February 2024.



Industrial Design Law took effect

The Industrial Design Law took effect on 31 October 2023. The industrial design registration system began operation from 1 February 2024.

The industrial design must be new and not be made available to the public before the date of registration in Myanmar.



2. Latest Issues

2-1 Issuance of and responding to trademark office notifications

- **Office actions:** The Myanmar IP Department (MIPD) has started formalities and substantive examination of trademark applications, with the first examination reports being issued in March 2024.
- **Timeframe for response:** The deadline to respond to an office notification is 30 days, extendible up to 4 times with valid grounds. The Trademark Law does not expressly state what would be considered "valid grounds". Current MIPD guidance is that a valid ground could be for example: (a) company Board approval required; or (b) the Applicant being unavailable to provide instructions, although such extensions are granted at MIPD's discretion. To avoid the withdrawal of applications, applicants should ensure timely responses to the office actions.



2-2 Trademark examination reports

These are some examples of requests from the Examiner which we have received.

- **Brand owner's contact details:** The brand owner's email address and contact number are to be provided in the application in addition to the TM agent's contact information.
- **Description of the goods and services:** Descriptions such as "parts and fittings for all of the aforesaid goods" have been objected to, and applicants have been asked to provide details of the goods and services under the class for which they have applied. Further, specifications not appropriately classified may need to be reworded.
- **Disclaimer:** Applicants may be requested by MIPD to disclaim less distinctive/generic words in the context of the goods and services claimed.



2-3 Customs recordation and suspension order

- **Overview:** A mark owner can apply for customs recordation with the Myanmar Customs Department (MCD). If the MCD determines that the identified goods are infringing based on the customs recordation, it can seize infringing counterfeit goods arriving at Myanmar's borders. Mark owners can also apply for a suspension order for goods that have been or will be imported, to remove them from market.



Key takeaway: This is a very useful anti-counterfeiting measure. Brand owners should consider obtaining customs recordation together with trademark registrations for their brand portfolios subject to anti-counterfeiting.





Myanmar

4. Limited Copyright Protection for Foreigners

- **Scope of Myanmar Copyright Law:** The law provides protection to (a) local works; and (b) foreign works either (i) first published in Myanmar or (ii) published in Myanmar within 30 days from the first publication outside Myanmar.
- **Berne Convention:** Notably, Myanmar is not presently a member of the Berne Convention, under which countries extend the same copyright protection to foreign authors from other signatory countries, regardless of location of publication.
- **Next steps:** In addition to recordation of works, rights owners should ensure that any future works planned to be published are also published in Myanmar within 30 days of first publication outside of Myanmar to ensure valid protection and to enforce against unauthorised reproduction. Such protection will add to the overall valuation of IP owned by the person or business.



5. Establishment of IP Courts

- **Trademark Law:** The Myanmar Trademark Law allows the Supreme Court of the Union (the apex court in Myanmar) ("SCU") to establish an Intellectual Property Rights Court or assign new jurisdiction to existing courts pending such establishment.
- **Assignment of jurisdiction:** The SCU has issued 5 notifications on 24 March 2023, to confer jurisdiction over intellectual property cases to several courts. In particular, the High Court of Yangon Region, and the High Court of the Regions and States have been granted appellate jurisdiction over orders, decisions and judgments of other such appointed courts.
- **Key takeaways:** This is a welcome development as it demonstrates the rapid development in Myanmar's IP regime. Brand owners now have recourse to specialised courts in Myanmar for the enforcement of their IP rights.

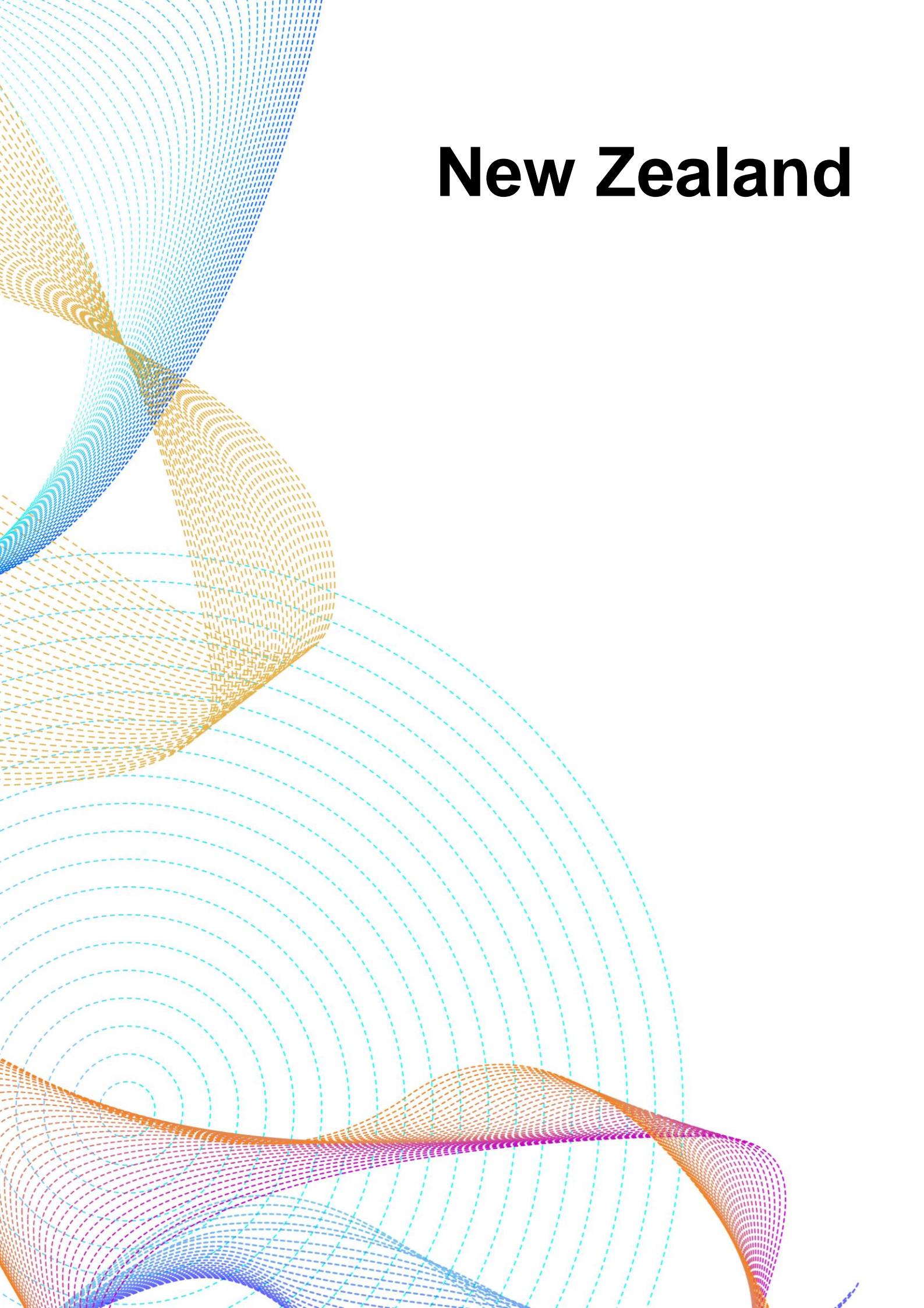


6. Upcoming Developments

- **Patent Law:** Based on informal communications with the MIPD, the Patent Law is anticipated to take effect in May 2024. The Patent Rules, application forms and fees will be released in the following months. Rights holders will be able to register with the MIPD via the electronic filing system.
- We would be delighted to keep you apprised of developments as we publish regular newsletters on IP developments in Myanmar.



New Zealand





New Zealand

1. Law amendments

Protection of Geographical Indicators

Following signature of a free trade agreement with the EU in July 2023, New Zealand has agreed to recognize and provide protection for nearly 2000 Geographical Indications (GIs) used in relation to a variety of European products. Some of the GIs that will now receive protection include feta, sherry, port, and prosecco.

The new protections commenced 1 May 2024 but there are phase out periods recognising that some of the GIs have been widely used to date by businesses. Such periods vary depending on the product – for instance, feta and port have a phase out period of 9 years and prosecco 5 years – and are subject to conditions.

2. Latest issues

2-1 Use of third party mark to indicate compatibility of a product not non-infringing descriptive use

Zuru New Zealand Ltd v LEGO Juris A/S [2023] NZHC 1808



Trademark



Conclusion

Use of statements on packaging such as "LEGO® brick compatible" were found to not involve simple descriptive use of the LEGO mark. Taking into account how consumers would view the use of the mark, the placement of the statement and the size and prominence of the mark, it was employed as a means to distinguish Zuru's products from those of its competitors.



BM comment

The case emphasizes that use of a mark in order to communicate that a product is compatible with another product will not automatically be considered non-infringing descriptive use. A Court will look at factors such as the connotations of the word or mark used, and the size or prominence of the word in context.

2-2 Different goods and services not a barrier to a successful opposition

Jesse Holmes v Middle-earth Enterprises, LLC [2023] NZIPOTM 52



Trademark

LORD OF THE WINGS



Conclusion

Registration of the name LORD OF THE WINGS for food and beverage services was successfully opposed on the basis of Middle-earth's LORD OF THE RINGS marks covering other classes. Previous examples of collaborations between trade mark rights holders across the film and food/beverage industries were relied upon in finding that 'it would not be unexpected' for consumers to wonder whether the proposed mark bore a relation to the Tolkien works or the Lord of the Rings films.



BM comment

This case demonstrates that for well-known marks protection beyond the scope of its registrations is possible where there is some similarity which ties the marks together or might spark a connection in the mind of a consumer.

Philippines





Philippines

1. Law amendments/Practice updates

Mediation rules amendments. The Philippine Intellectual Property Office ("IPOPHL") revised the mediation rules. Key changes include the exclusion of Appeals to the Office of the Director General from the coverage of mandatory mediation (now only optional), briefing on option to submit the dispute to arbitration, and immediate resumption of adjudication proceedings once a Non-Settlement of Dispute has been furnished to the parties.



Proposed amendments to rules governing Intellectual Property Violation ("IPV") cases. The amendments to the rules are designed to streamline and digitize the resolution of IPV cases. Key changes include the online filing and service of pleadings, the inclusion of evidence and affidavits in all initiatory pleadings, a shorter period to file an answer, and the use of videoconferencing for IPV hearings.



Recognition system for trademark and patent representatives.

The IPOPHL has introduced a recognition system for trademark and patent agents, attorneys, and representatives. Non-recognized patent and trademark agents (except lawyers) are prohibited from transacting with or practicing before the IPOPHL. Practitioners must comply with recognition requirements within 24 months from March 2024.



2. Site-blocking rules

The IPOPHL recently released the Rules on Voluntary Administrative Site Blocking ("Site-Blocking Rules"), which allow the blocking of pirate websites through a site blocking order issued to an internet service provider upon application by a copyright owner or a right holder. A "pirate website" is defined under the Site Blocking Rules as "a website that has the primary purpose or effect of infringing copyright or facilitating copyright infringement and/or that contains goods, materials, or contents which are made, produced, or replicated, without the consent of copyright owner (or) right holder". The Site-Blocking Rules also contain a mechanism to prevent a pirate website from circumventing any request by changing its Domain Name or IP Address. An order to block or disable access to a pirate website is final and executory, and may only be appealed to the Court of Appeals.

QT Comment: With an expedited process to block infringing websites now in place, an increase in enforcement against pirate sites is to be expected.



3. Internet Transactions Act

Republic Act No. 11967 or the Internet Transactions Act of 2023 ("ITA") was enacted into law on 5 December 2023. Under the ITA, a digital platform or e-marketplace shall be subsidiarily liable to the online consumer if it fails, after notice, to act expeditiously in removing or disabling access to goods or services that either infringe on another's intellectual property rights or is subject to a takedown order by an appropriate government agency. The ITA also creates the E-Commerce Bureau under the Department of Trade and Industry. The E-Commerce Bureau is mandated to implement the ITA and formulate policies and plans to ensure strict compliance with the provisions of the ITA, as well as to investigate and prosecute violations of the ITA. Within one year from its effectivity, the ITA also mandates the E-Commerce Bureau to establish a database of digital platforms, e-marketplaces, e-retailers and online merchants engaged in e-commerce in the Philippines.

QT Comment: The draft implementing rules have been released for public comments and are expected to be finalized soon. With the implementation of the ITA, it is hoped that infringement on e-commerce platforms will be significantly minimized.



4. Statutory Fair Use Guidelines

Authors or creators of copyrighted works have the exclusive right to carry out, authorize or prevent, among others, the reproduction of the work or substantial portion of the work, and other forms of exploitation of the work. As a limitation to copyright, the Intellectual Property Code provides for the General Fair Use Principle and Statutory Fair Uses. The IPOPHL recently issued its Guidelines on Statutory Fair Use in the Intellectual Property Code which clarify the conditions to be satisfied in the use of a copyrighted material in a manner that does not infringe on intellectual property rights. The Guidelines categorize Statutory Fair Use into three: (i) those that require the application of the General Fair Use Principle in addition to other conditions that govern the specific act, (ii) those that are limited to the specific acts without need for further application of General Fair Use Principle, and (iii) other limitations.

QT Comment: To determine if fair use applies to a specific situation, each component of the fair use act as listed in the Guidelines must be thoroughly examined.





Philippines

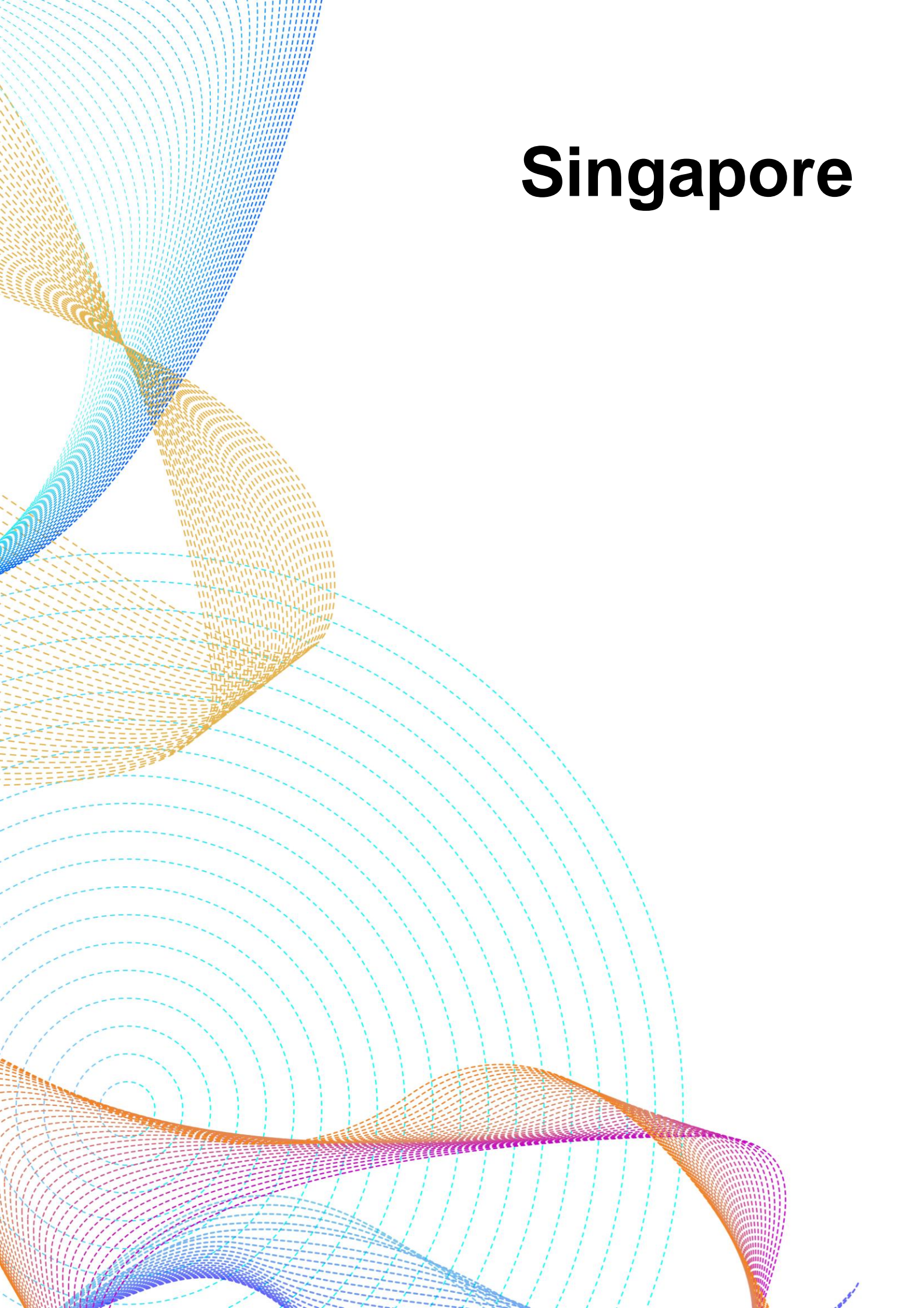
5. Recent Supreme Court decisions

Action	Decision (Reason)	Trademark		Detail
Fraud and bad faith				
Appeal*	Denied registration (Application for "CYMA & LOGO" was filed in bad faith.)	"CYMA & LOGO"	Class 43	<p>Supreme Court: An individual who was part of a partnership cannot register a mark which was conceptualized and used by the partnership. A mark that was conceived for the exclusive use of the partnership cannot be appropriated by an individual. The application was made in bad faith as the individual had knowledge of the partnership's previous use of the mark.</p> <p>QT Comment: The first-to-file rule should not be interpreted to mean that the first application to be filed should, in all cases, be the application that is granted. The factual circumstances of each case must also be scrutinized.</p>
Reconsideration**	Cancelled and disallowed marks ("FARLIN" marks were registered fraudulently and in bad faith.)	"FARLIN"	Classes 5, 10, 11, 16, and 21	<p>Supreme Court upheld its decision which cancelled the petitioner's FARLIN-derived trademarks. This is despite the petitioner's allegations that the loss of its marks will result in job losses and will have a negative impact on the Philippine economy.</p> <p>QT Comments: The Court cannot give preference to a Filipino company which appropriated a foreign company's trademark fraudulently and in bad faith. Much as Filipino companies must be given preference in the grant of economic rights, Filipino consumers likewise deserve protection from mala fide business practices.</p>

*Zulueta v. CYMA Greek Taverna Co., G.R. No. 205699, 23 January 2023.

**Cymar International, Inc. v. Farling Industrial Co., Ltd., G.R. Nos. 177974, 206121, 219072 & 228802 (Notice), 14 June 2023

Singapore





Singapore

1. Law amendments/practice updates

Launch of Intangibles Disclosure Framework (IDF). The Accounting and Corporate Regulatory Authority and Intellectual Property Office of Singapore (IPOS) launched the Intangibles Disclosure Framework (IDF), which aims to help enterprises manage and commercialise their intangibles and IP to support business activities. The IDF provides guidance on disclosing and communicating intangible assets (e.g., brand value, patents or registered designs) in a systematic and comprehensive way.



New collective management organisation (CMO) class licensing scheme. The Ministry of Law and IPOS published subsidiary legislation for a new collective management organisation (CMO) class licensing scheme, effective 1 May 2024. The scheme seeks to raise standards of transparency, accountability and good governance in the CMO ecosystem in Singapore.



2. IPOS Pilots Avenue for new Goods/Services Descriptions to be Added to IPOS Classification Database

Addition of Suggested Descriptions of Goods/Services into Classification Database. IPOS is piloting a new initiative for interested parties to submit suggestions of descriptions of goods and services to be added into IPOS' Classification Database. Under the new initiative, interested parties may submit their suggested descriptions from 1 September 2023 to 30 June 2024. The suggested descriptions will be reviewed and modified for conformity with IPOS' classification practices, prior to acceptance and addition into IPOS' database. IPOS has since been publishing a list of accepted suggestions for addition to the classification database. We encourage brand owners to review and consider submitting suggestions of descriptions of goods and services to be added into IPOS' Classification Database.

3. Mediation under WIPO-Singapore ASEAN Mediation Programme

The WIPO-Singapore ASEAN Mediation Programme (AMP) facilitates resolution of IP or technology disputes by funding mediations administered by the WIPO Arbitrator and Medication Center's Office in Singapore. Since its inception, there have been two successful mediation cases under the AMP.



Key Takeaway: IP Mediation is a recommended form of alternative dispute resolution as it can save costs, result in a timely resolution, and achieve flexible solutions. The new AMP Programme is a key option for parties engaged in IP disputes or negotiations, where one of the parties involved is an ASEAN national or entity.



4. IPOS issues Practice Directions on Non-Fungible Tokens (NFTs) and Metaverse-related Goods/Services

Classification practices on NFTs and Metaverse-related goods/services. To keep pace with the emerging and evolving digital landscape, IPOS has issued guidelines to clarify the Registry's examination practice in respect of NFTs and metaverse-related applications. IPOS appears to have adopted the same approach of both the USPTO and EUIPO, in terms of classification and necessary clarification of virtual goods and services. According to IPOS' recent guidelines, the description "NFTs" is unacceptable as it does not adequately describe a good or service. The digital or physical items linked to the NFTs must be indicated. Likewise, the description of "downloadable virtual goods" is not acceptable as IPOS deems the description as being vague. Applicants are required to specify the exact nature of the "virtual goods" (e.g., downloadable virtual goods, namely, virtual clothing).

Key Takeaway: Carefully drafting specifications of goods and services before filing an application for compliance with acceptance lists to IPOS is essential to mitigate the likelihood of an office action.





Singapore



5. First case under simplified IP dispute resolution system

On 15 May 2023, the Singapore High Court issued its judgement on the first case invoking the Simplified Process for Certain Intellectual Property Claims (**Simplified Process**) under Part 2 of the Supreme Court of Judicature (Intellectual Property) Rules 2022 (SCJ(IP)R). The Simplified Process is an optional track for IP litigation that allows for quicker and more cost-effective resolution of IP disputes.


Key Takeaway: Enterprises should take note of such alternative routes for IP dispute resolution in Singapore to minimize costs, time and resources.

[More detail on this case immediately below.](#)



6. Recent decisions

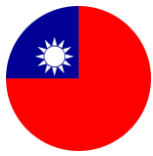
Decision (reason)	Detail
First case under simplified IP dispute resolution system	
In its decision, the High Court identified that three cumulative conditions must be fulfilled for the suit to be deemed suitable to proceed under the Simplified Process: (i) dispute must involve an intellectual property right; (ii) monetary relief claimed by each party in the action does not or is not likely to exceed SGD 500,000 or all parties agree to the application; and (iii) other factors set out by the Supreme Court of Judicature (Intellectual Property) Rules. The High Court also shed light on relevant principles in assessing if the conditions above are fulfilled.	The Claimant commenced action against the Defendant for infringing its copyright in the Chinese film "Moon Man". The Claimant invoked the Simplified Process, and abandoned any claim for monetary relief in excess of SGD 500,000. The Defendant applied for an order from the court asserting that the Simplified Process did not apply. The court dismissed the defendant's application and allowed the claimant's claim to proceed under the Simplified Process. We expect more disputes to be heard under the Simplified Process.

Action	Decision (reason)	Trademark	Detail
Successful declaration of invalidity for trademark			
Opposition	The applicant applied for a declaration of invalidity against the proprietor's registration on the grounds of bad faith, which succeeded because the proprietor had no legitimate reason for registering the exact image used by the applicant for years within Singapore and for decades abroad.		Classes 9 and 25 The term "bad faith" encompasses not just actual dishonesty, but also actions that objectively fall far below the standards of acceptable commercial behaviour in the industry. Further, the decision upheld that the test for bad faith contains both a subjective element (what the proprietor knows) and an objective element (what ordinary persons adopting proper standards would think), which is context-dependent, and its merits are assessed on the specific facts of each case.



Taiwan





Taiwan

1. Law amendments/practice updates

Expedited examination for trademark registration. An applicant may pay an additional examination fee to the Taiwan Intellectual Property Office (TIPO) to expedite the examination procedure. The average examination time will reduce from 6-7 months to 2 months.



Prior Use. The prior use was limited to the "goods and services originally used". The amendments will expand to "the scope of the original use" which will include the original use of goods or services, the geographical area, the scale of production and sales, and the distribution channels.



The Doctrine of Exhaustion. The Amendment clarifies that the doctrine of exhaustion does not apply to goods that have been "reprocessed or reformulated by a third party" after being put on the market.



2. Latest Issues

2-1 Fake domain names using famous trademarks



Trademark

Famous Registered Trademarks



Conclusion

Domain spoofing and fake websites are abundant on the Internet, which seriously damages brands. Brand owners can seek to transfer fake domain names to themselves by enforcing their registered trademarks in the TWNIC domain name dispute resolution process.



BM comments

Transferring or cancelling a fake domain name through the TWNIC domain name dispute resolution process is typically a swifter and more cost-effective way to deal with domain spoofing and fake websites.

2-2 Compound word



Trademark

JuiceLatte

(App. No. 103046875)



Conclusion

If a compound word is composed of two purely explanatory words by connecting or combining them, and there is no significant change in the grammar or the meaning of the words, this compound word is indistinctive.



BM comments

When combining two descriptive words into one word, if it is distinguish from the original descriptive meaning of the individual words and gives consumers an impression that is completely different from the original description of goods or services, this compound word can be distinctive.

2-3 Purely informative devices



Trademark



(App. No. 107014607)



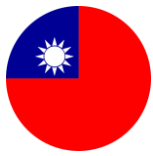
Conclusion

If the overall is distinctive and contains purely informative devices of the goods or services, in order to make the scope of trademark registration clear, the applicant should delete the contains purely informational devices, and the mark shall not be registered by simply disclaiming the exclusive right of purely informative devices.



BM comments

When using simple devices to advertise or imply that goods or services with specific functions, usages or features, if these devices are only used to convey information about the goods or services, such devices will not leave a commercial impression in the minds of consumers to identify the source and are indistinctive.



Taiwan



2-4 Devices for packaging or trade dress



Trademark



(Reg. No. 1857772)



Conclusion

As to the devices for packaging or trade dress design that are commonly seen on product packaging containers, wrapping paper, and hang tags, if these overall composition elements create a single commercial impression as a whole and is sufficient of indicating the source of goods/services, such devices should be registrable.



BM comments

Packaging or trade dress that contains distinctive words or devices are basically inherently registrable and can be registered after deleting the informative part and disclaiming the indistinctive part.

3. IP litigation related

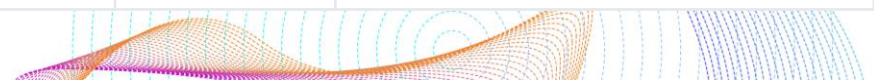
Exclusive first instance jurisdiction. Exclusive first instance jurisdiction. Starting from 30 August 2023, the Intellectual Property and Commercial Court has the exclusive first instance jurisdiction for civil actions involving trademarks.

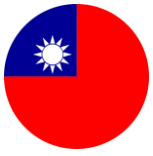
Expert witness. Starting from 30 August 2023, for the IP civil actions in the Intellectual Property and Commercial Court, parties can appoint expert witnesses upon the court's approval.







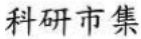
4. Recent decisions

Action	Decision (Reason)	Trademark	Detail
Similarity/Likelihood of confusion/Well-known marks			
Trial	Similarity to well-known trademarks	<p>(Cited Marks)</p>	<p>Class 18 Bags, Wallets, and Suitcases</p> <p>Class 25 Clothing, Belts, Socks, Shoes, and Hats</p> <p>Class 28 Sporting Goods</p> <p>Class 35 Cosmetics, Clothing, Bags, Furniture, Accessories, glasses,</p> <p>The IPC Court did not adopt the defendant's defense of parody as the defendant failed to clearly deliver information that would have allowed relevant consumers to distinguish between the infringing marks and well-known trademarks of LV, Burberry, Dior, Chanel, Dior, Hermes, and Gucci. The defendant was intended to cling to the popularity of these well-known brands.</p> <p>BM Comments: In this case, the IPC Court has clearly conveyed its attitude toward the "parody" defense and has stated its position to protect the long-term efforts of well-known brands to establish famous trademarks.</p>





Taiwan

Action	Decision (Reason)	Trademark		Detail
Doctrine of Exhaustion				
Trial	The doctrine of exhaustion applies	 	Class 03 Cosmetics, Detergent Class 24 Towels, Bath towels, and Handkerchiefs. Class 25 Clothing, Shoes, Scarves, and Hats	<p>If a trademark owner has registered or authorized other parties to register the same trademark in different countries, despite the fact that these are different trademark rights based on the concept of territoriality, the doctrine of exhaustion will apply if the trademark rights legally and economically belong to the same right holders.</p> <p>BM Comment: As long as the trademark owners of different countries have authorization or legal relationship with each other, the doctrine of exhaustion also apply to the trademark owners who have been authorized.</p>
Use of Trademark/Inclusion of shipping service on the official website				
Trial	Does not constitute the use of trademark	 	Class 25 Sportswear, Clothing, Shirts, Class 27 Exercise Mats, Yoga Mat Class 28 Gymnastics Equipment; Exercise Equipment	<p>The website of the Plaintiff is only available in English and lacks a Chinese language option. Additionally, there is no clear information regarding the amount of transactions made in NTD. This suggests that the website was designed for foreign consumers and not Taiwanese consumers. Despite including Taiwan in its global shipping service, the Plaintiff's official website does not provide any concrete evidence of actual transaction records in Taiwan.</p> <p>BM Comment: It is important to have specific marketing evidence showing that Taiwanese consumers actually use the official website for transactions.</p>
Distinctiveness				
Trial	Lack of distinctiveness		Class 1 Industrial Chemicals Class 35 Retail and Wholesale of Chemical Products Class 42 Scientific Research	<p>If the trademark owner often uses the mark in combination with other marks, they must prove the distinctiveness of the individual mark, excluding the other marks.</p> <p>BM Comments: If a mark is often used in combination with other marks or symbols, more use evidence will be required to prove the distinctiveness.</p>

Thailand





Thailand

1. Current Practice/Difficulties

Image Search

The Department of Intellectual Property (DIP) has moved forward in developing its trademark system, leveraging artificial intelligence (AI) technology to assist in trademark searches by implementing image-based trademark search through the Image Search system. This enhances service efficiency of the DIP and facilitates the public and entrepreneurs who wish to check/clear prior device marks before registering their marks.



Slogan/Tagline Marks

Trademark owners encounter difficulties in registering slogan/tagline marks. The current official practice seems to deem slogans/taglines as non-distinctive even though a distinctive mark is a mark which enables the public or users to distinguish the goods/services with which the mark is used from other goods/services. Most slogans/taglines play their role as a trademark, but the registrars tend to establish their own practice in rejecting such mark only because it is a slogan/tagline.



2. Latest Issues

2-1 Difficulties in registering slogan/tagline



Trademark

M&M'S FOR ALL FUNKIND (App. No. 220134028 (IRN: 1673644) in Int'l Class 30)



Conclusion

The registrar had rejected the mark on non-distinctive grounds since "M&M'S" appears as a smaller part in the mark while "FOR ALL FUNKIND" representing the main part are deemed generic.



BM Comments

The term "FOR ALL FUNKIND" encountered difficulties in being deemed to be inherently distinctive even though it can function as a trademark. The registrar seemed to employ his/her own understanding of the trademark law on inherent distinctiveness and ignore the legal implications of a distinctive trademark given under the Trademark Act. This kind of examination contradicts court precedent on the mark "TMB Make THE Difference" in class 36 where the court overturned the registrar and the Board's decisions against the slogan/tagline "Make THE Difference". The registrars' current examination also conflicts with their own previous practice, for instance, in the past, the slogans/taglines were considered inherently distinctive and registrable, e.g., the registered marks "TOMORROW'S ANSWERS TODAY" in class 2, "PURE ENJOYMENT. PURE GOODNESS" in class 16, "SO YOU THINK YOU CAN DANCE" in class 41, and "WE MAKE LIPS SMILE" in class 42.

2-2 Distinctiveness of a Coined Term



Trademark

FIELDCORE (App. No. 170108552 in Int'l Class 35, 37, 39, 40, 41 and 42)



Conclusion

The registrar dissected the mark into 'FIELD' and 'CORE' and determined the mark to be a general description that cannot be used to differentiate the applicant's services under the mark from the others'. Therefore, the mark was deemed non-distinctive. The Trademark Board had been convinced by our appeal and accordingly overturned the registrar's decision that 'FIELDCORE' is a coined term as it has no meaning established in dictionaries that is sufficiently distinctive and registrable under the Thai Trademark Act.



BM Comments

This reflects that the registrars may misunderstand the distinctive characters given under the Thai Trademark Act. If the registrars view that the trademark seems to be merely a general description, they will try to establish their own practice in examining the mark to be non-distinctive even though such mark can play its role well, i.e., enabling the public or users to distinguish the goods/services with which the trademark is used from other goods/services, as well as can be deemed to fall within the distinctive characters set out in the Thai Trademark Act. Fortunately, the Board agreed with our justifications on the newly coined term "FIELDCORE" which could function as a distinctive trademark.



Thailand




3. Border Control

The Customs Department launched a new system for customs recordation of trademarks, called the Thai Customs IPR Recordation System (TCIRs)



BM comments: The TCIRs system works well for practitioners to assist trademark owners with recording their rights and information concerning their goods with the Customs Department. It is a more convenient and effective tool for officials to check all relevant information through a single system to inspect and seize suspicious goods at the Thai border.

4. Recent Decisions

Action	Decision (Reason)	Trademark	Detail
Similarity - Likelihood of confusion			
Opposition & Counter-statement	Allowed for registration		<p>JD Sports Fashion Plc's multi-class application for the JD Logo mark was opposed by an individual who found it confusingly similar to his registered "  mark, given that the parties' marks are applied in the same class 25 for similar goods. We filed a counterstatement arguing that the overall appearance and stylization of the "JD" letters in the marks are sufficiently different to the point that there would be no public confusion. This was supported by evidence which shows how the client is a famous clothing brand with massive following in Thailand already. The registrar was convinced with our counterstatement and dismissed the opposition.</p> <p>BM Comments: the opposer has recently filed an appeal to the Board. We expect the Board to affirm the consideration of the registrar based on the same justifications in this case and allow the client's mark to proceed further to registration.</p>
Distinctiveness of Randomized Letters and/or Numerals			
Court's Judgment	Allowed for registration		<p>Nanda's "3CE" mark was deemed non-distinctive by the registrar and Board who found the Roman alphabets in the mark to lack stylization. They argued that "3CE" is not distinctive since it is not an invented term. We appealed the refusal to the IP&IT Court, but the Court affirmed the administrative refusal. We then appealed to the Specialized Court of Appeal (a higher court) who ruled that "3CE" is formed with a combination of letters and a number that are not aligned in an ordinary manner which allows the public to tell the mark from others. Thus, the mark was allowed to be registered.</p> <p>BM Comments: The court judgment is in line with the 2022 Trademark Examination Guideline of the Department of Intellectual Property. The Guideline states that a non-consecutive 3-digit series of either letters or numbers are distinctive and registrable. Thus, this court decision and the DIP's new practice may encourage further filings of randomized letters and/or numerals in Thailand.</p>

Vietnam





Vietnam

1. Law amendments/practice updates

IP Law guiding decree (Decree 65/2023/ND-CP) enacted

- Decree 65 was promulgated and took effect on 23 August 2023.
- Decree 65 offers guidance on several provisions of the 2022 IP Law related to industrial property rights (IPRs), the protection of IPRs, rights to plant varieties, and the state management of IP.



Guiding circular (Circular 23/2023) enacted

- Circular 23 was issued and took effect on 30 November 2023.
- Circular 23 provides detailed guidance on several articles of the 2022 IP Law and instructions on implementing measures under Decree 65/2023/ND-CP for establishing and safeguarding IPRs.



2. Latest issues

2-1 Trademark regulations


- **No opposition procedures for international trademark applications:** Third parties concerned with the registrability of international applications can only submit written opinion letters to the Vietnam IP Office (VNIPO) for reference during the examination process.
- **Bad faith demystified:** Conditions regulated to pursue bad-faith arguments, including: (i) the applicant's awareness/knowledge that their mark is identical or similar to a widely used trademark in Vietnam or a well-known one in other countries; and (ii) the applicant's objective for filing being to profit from well-known marks or engage in unfair trade practices.
- **Use of a registered mark in a different form:** If a mark is used in a way that differs from its registered form but does not significantly change its distinctiveness, it still qualifies as trademark use.
- **Electronic registration certificates:** When filing, applicants can choose to receive an electronic instead of a paper certificate, which eliminates the need to submit the original certificate for post-registration procedures.
- **Grounds for refusing a trademark assignment:** Assignments may be rejected if they risk causing confusion due to: (i) the assigned mark being identical or confusingly similar to the assignor's other protected trademarks in Vietnam; (ii) similarity between the goods/services under the assigned mark and the remaining goods/services in case of partial assignment; and (iii) the presence of misleading elements (e.g., tradename) in the assigned mark.

2-2 Trademark practices

- **Examination delays:** Trademark examination and post-registration procedures are experiencing significant delays beyond the standard timeframes set by law.
BM comments: These delays have posed challenges for trademark owners, impacting their ability to provide certificates for enforcement and daily operations. Practical solutions, like expediting examinations or submitting applications/requests earlier, should be considered.
- **Inconsistent examination results for Madrid applications designating Vietnam:** Some trademark refusals involve over 20 citations, raising concerns about trademark coexistence and citation strength. In contrast, refusals for national applications come with a more concise list of citations.
BM comments: Examiners facing 12-month deadlines for Madrid applications may lead to inconsistent examination outcomes. Trademark owners should strategize for national or Madrid filings and adopt a consistent approach when addressing refusals with numerous citations.



3. Recent decisions

Case	Decision	Trademark	Details
Refusal of trademark assignment due to tradename confusion			
Trademark assignment	Assignment recordal request was refused	 (Reg. No. 211656)	<p>Affiliated companies Cong ty TNHH An Thai (assignor) and Cong ty co phan Sai Gon An Thai (assignee) have an agreement to co-use the "An Thai" mark. However, their assignment recordal at the Vietnam IP Office (VNIPO) was rejected for two main reasons:</p> <ul style="list-style-type: none">▪ Tradename confusion: The assigned mark, containing "ANTHAI," resembles the assignor's tradename.▪ Associated marks: The assigned mark is similar to other marks owned by the assignor. <p>BM comments:</p> <ul style="list-style-type: none">▪ Under current practice, the VNIPO strictly and conservatively examines assignment recordal requests.▪ Trade name citation, among other issues, severely challenges applicants. The VNIPO's rationale is that consumers may be confused when the assigned mark is part of the assignor's tradename.▪ Until the VNIPO adopts new approaches, trademark owners should carefully consider practical strategies and use supporting documents to address tradename issues.
Evidence of use not accepted			
Non-use cancellation	Evidence of use was not accepted, and the challenged mark was cancelled	MOVADO (challenged mark) Reg. No. 36360	<p>The challenged mark faced non-use cancellation, and their owner submitted evidence to prove trademark use, including samples of product labels and copies of invoices.</p> <p>However, the VNIPO dismissed the evidence because it lacked certain details such as label sources and dates, and because uncertified or notarized copies of invoices were used.</p> <p>Consequently, the challenged mark was canceled due to the owner's failure to provide sufficient proof of trademark use in Vietnam.</p> <p>BM comments:</p> <ul style="list-style-type: none">▪ Trademark non-use cancellations are settled on a case-by-case basis according to the arguments and evidence presented.▪ In most cases, trademark owners need to gather evidence demonstrating legitimate trademark use, including use by the registered owner or authorized licensees, adherence to statutory timeframes, and valid samples and materials.▪ If the registered mark is not in use in the market, the trademark owner should consider trademark refiling as a defensive option.



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