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How to Register 3-Dimensional Trademarks for Product Designs in Hong Kong

Brand owners have always been keen to obtain protection for their uniquely designed but often simple product shapes through 3D trademark registration. This is because 3D trademark registration can confer perpetual monopoly over the use of a product design on its designated goods. It is also an attractive alternative where the product design has already been introduced in the market and is therefore no longer eligible for industrial design registration. As such, even where the Hong Kong Trade Marks Registry often considers such shapes to lack inherently distinctive character, brand owners have tirelessly submitted use evidence to demonstrate the acquired distinctiveness of these shapes. Nevertheless, obtaining 3D trademark registration in Hong Kong through use has generally proved to be a difficult task.

One of the main reasons why 3D trademark applications are refused for registration in Hong Kong is because the evidence submitted fails to show that the general public is able to recognise the shape of the 3D trademark as the badge of origin for its designated goods. For example, the Registry has been reluctant to accept traditional marketing materials (e.g. brochures, billboard advertisements, television commercial screenshots) as use evidence, since the public tends to

appreciate the 3D trademark as displayed for its overall design and aesthetic appeal rather than treating it as a badge of origin.

Given the difficulty in proving the acquired distinctiveness of 3D trademarks, brand owners may consider first filing a 3D trademark application of their product design, with a registered 2D mark printed or imprinted on the design. This should confer some degree of protection on the brand

owners' use of the product design. Subsequently, brand owners should develop long term use and promotion of the shape of the 3D trademark separate from the other registered marks so that an exclusive association between the shape of the 3D trademark and the brand of the product design will be formed in the mind of the general public.

As we discussed above, traditional forms of use evidence for 2D trademarks will unlikely be sufficient in showing the acquired distinctiveness of 3D trademarks. Instead, brand owners should consider market surveys which, if carried out

properly, may constitute direct evidence of the general public's ability to identify the source of the 3D trademark from its shape alone. An effective market survey should set out how the survey was conducted, the number and profession of the participants, and, above all, non-leading questions on the participant's recognition of the trademark applicant's brand from the 3D trademark. This, together with other evidence such as pre-filing sales figures and promotional expenses for the 3D trademark, may increase the likelihood of success of registration.