

# ANNEX I

## EXCERPTS OF LEGAL PROVISIONS OF THE ASEAN COUNTRIES RELEVANT TO THE SUBSTANTIVE EXAMINATION OF MARKS

### CONTENTS

BRUNEI DARUSSALAM	4
Trade Marks Act (Cap.98), 2000	4
Trade Marks Rules (s. 27/2000), 2000	14
Chapter 94 -- Emblems and Names (Prevention of Improper Use)	15
20 of 1967, 3 of 1974 - Amended by: S 128/80 S 163/81	15
CAMBODIA	17
Law concerning Marks, Trade Names and Acts of Unfair Competition, Royal Decree of 7 February 2002 - N5IRKM/0202/006	17
Law on Geographical Indication, 30 December 2013	19
Sub-Decree No. 46 of July 12, 2006, on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition	20
Trademarks Manual - Department of Intellectual Property Rights - July 2013	21
INDONESIA	22
Law N° 15 of 2001, regarding Marks	22
Government Regulation N° 23, 1993, regarding the Procedure of Application for Registration of Mark	24
Technical Guidelines for Trademark Examination (Rev. 2012)	24

LAOS	25
Law on Intellectual Property (Amended) N° 01/NA, 20 December 2011	25
Decision No. 753 /MOST on the Implementation of Law on Intellectual Property concerning Trademarks and Trade Names, 20 September, 2012	29
Trademarks Manual - September 2003	40
 MALAYSIA	 41
Trade Marks Act 1976 - Act N° 175 (amendments up to 1 January 2006)	41
Trade Marks Regulations 1997 (to February 2011)	51
Manual of Trade Marks Law & Practice, 2003 (2nd Edition)	54
 MYANMAR	 55
 PHILIPPINES	 56
REPUBLIC ACT N°. 8293 - an Act prescribing the Intellectual Property Code and establishing the Intellectual Property Office, providing for its powers and functions, and for other purposes, 1997	56
Rules And Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, of 29 <sup>th</sup> day of October 1998, as <i>last amended by Office Order No. 13-61 (2013)</i>	59
Guidelines for Trademark Examination - Draft as of August ___, 2012	62
 SINGAPORE	 63
Trade Marks Act [Cap. 332, 2005 Ed.]	63
Trade Marks Rules 15th January 1999, revised 2008	74
Geographical Indications Act (Chapter 117B) of 1999	76

Trade Mark Work Manual – 2012	77
THAILAND	78
Trademark Act B.E. 2534 (1991), as amended by Act (No. 2) B.E. 2543 (2000)	78
Notification of the Ministry of Commerce, 20 September, 2004, Prescribing Geographical Names under Section 7(2) of the Trademark Act	82
Notification of Ministry of Commerce of 11 October 2012 prescribing regulations for demonstration of distinctive character according to Section 7(3) of the Trademark Act	83
VIET NAM	84
Law on Intellectual Property, No. 50/2005/QH11, amended and supplemented by Resolution No. 51/2001/QH10 of December 25, 2001 and amended by Law No. 36/2009/QH12 of 2009	84
Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property	91
Circular No. 01/2007/TT-BKHHCN Of February 14, 2007, Guiding the Implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, Detailing and Guiding the Implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property	92

## **BRUNEI DARUSSALAM**

### **Trade Marks Act (Cap.98), 2000**

#### **Trade Marks**

4. (1) In this Act, “trade mark” means any visually perceptible sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark and a certification mark.

#### **Registered trade marks**

5. [...]

(2) No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act affects any law relating to passing off.

#### **Absolute grounds for refusal of registration**

6. (1) The following shall not be registered —

(a) signs which do not satisfy the requirements of subsection (1) of section 4;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of —

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is —

- (a) contrary to public policy or to accepted principles of morality; or
- (b) of such a nature as to deceive the public.

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in Brunei Darussalam by any law.

(5) A trade mark shall not be registered in the cases specified or referred to in section 7.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

### **Specially protected emblems etc.**

7. (1) A trade mark which consists of or contains —

- (a) a representation of the Emblem, Arms and Regalia of Brunei Darussalam, including the Royal Arms, State Crest, the Insignia of Royalty, armorial bearings and other insignia and emblems of Brunei Darussalam; or any device so closely resembling any of them as to be likely to be mistaken for them;
- (b) a representation of the Royal crowns, and His Majesty the Sultan and Yang Di-Pertuan's Standard or any other Royal flag, or any colourable imitation thereof;
- (c) a representation of His Majesty the Sultan and Yang Di-Pertuan or any member of the Royal family, or any colourable imitation thereof;
- (d) any word, letter or device likely to lead persons to believe that the applicant either has or recently has had Royal patronage or authorisation; or
- (e) any name or thing which is a specified name or specified emblem as defined in section 2 of the Emblems and Names (Prevention of Improper Use) Act (Chapter 94), or any colourable imitation thereof,

shall not be registered, unless it appears to the Registrar that consent has been given by or on behalf of His Majesty the Sultan and Yang Di-Pertuan or, as the case may be, that member of the Royal family.

(2) A trade mark which consists of or contains a representation of the national flag of Brunei Darussalam shall not be registered if it appears to the Registrar that the use of that trade mark would be misleading or grossly offensive.

(3) A trade mark shall not be registered in the cases specified in section 55 or 56.

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains —

(a) arms which a person is authorised to use by virtue of a grant of arms by His Majesty the Sultan and Yang Di-Pertuan; or

(b) insignia so closely resembling such arms as to be likely to be mistaken for them, unless it appears to the Registrar that consent has been given by or on behalf of that person. Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to any law relating to arms.

### **Relative grounds for refusal of registration**

8. (1) A trade mark shall not be registered if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which —

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Brunei Darussalam and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Brunei Darussalam is liable to be prevented —

(a) by virtue of any law protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right, other than those referred to in subsections (1), (2) and (3) or in paragraph (a), or by any law relating to the infringement of copyright or registered designs.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

### **Meaning of “earlier trade mark”**

9. (1) In this Act, “earlier trade mark” means —

(a) a registered trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) of subsection (1), subject to its being so registered.

(3) A trade mark within paragraph (a) of subsection (1) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no *bona fide* use of the mark during the 2 years immediately preceding the expiry.

### **Raising of relative grounds in case of honest concurrent use**

10. (1) This section applies where, on an application for the registration of a trade mark, it appears to the Registrar —

(a) that there is an earlier trade mark in relation to which the conditions set out in subsection (1), (2) or (3) of section 8 apply; or

(b) that there is an earlier right in relation to which the condition set out in

subsection (4) of section 8 is satisfied, but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purpose of this section, “honest concurrent use” means such use in Brunei Darussalam, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purpose of section 33 of the repealed Act.

(4) Nothing in this section affects —

(a) the refusal of registration on the grounds mentioned in section 6; or

(b) the making of an application for a declaration of invalidity under subsection (2) of section 48.

(5) This section does not apply when there is an order in force under section 11.

### **Registration subject to disclaimer or limitation**

**15.** (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

and where the registration of a trade mark is subject to such a disclaimer or limitation, the rights conferred by section 12 are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of such a disclaimer or limitation.

### **Registration: supplementary provisions**

**42.** (1) Provision may be made by rules as to —  
[...]

(c) the registration of a series of trade marks.

(2) In paragraph (c) of subsection (1), a series of trade marks means a number

of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

[...]

### **Collective marks**

**50.** A collective mark is a mark distinguishing the goods or services of members of an association which is the proprietor of that mark from those of other undertakings.

### **Application of Act to collective marks.**

**51.** This Act applies to collective marks, subject to the First Schedule.

### **Certification marks.**

**52.** A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of that mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

### **Application of Act to certification marks**

**53.** This Act applies to certification marks, subject to the Second Schedule.

### **Protection of well-known trade marks**

**54.** (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, including such a trade mark entitled to the benefits of the Paris Convention by virtue of the World Trade Organisation Agreement are to the trade mark of a person who —

(a) is a citizen of, is domiciled, ordinarily resident or has a right of abode in, a Paris Convention country or a World Trade Organisation country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, any such country,

whether or not that person carries on business, or has any goodwill, in Brunei Darussalam. References to the proprietor of such a trade mark shall be construed accordingly.

(2) Subject to section 49, the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to

restrain by injunction the use in Brunei Darussalam of a trade mark which, or the essential part of which, is identical or similar to his trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

### **National emblems etc. of Paris Convention and World Trade Organisation countries**

55. (1) A trade mark which consists of or contains the flag of a Paris Convention country or a World Trade Organisation country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Paris Convention country or a World Trade Organisation country which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Paris Convention country or a World Trade Organisation country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of that country.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a citizen of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Paris Convention country or a World Trade Organisation country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the mark in Brunei Darussalam without their authorisation.

## **Emblems etc. of certain international organisations**

56. (1) This section applies to —

- . (a) the armorial bearings, flags and other emblems; and
- . (b) the abbreviations and names,

of organisations of which the government or governments of one or more Paris Convention countries or World Trade Organisation countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the World Trade Organisation Agreement shall not be registered without the authorisation of the organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

(a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use of the mark in Brunei Darussalam which was not authorised by it.

(5) Nothing in this section affects the rights of a person whose *bona fide* use of a trade mark began before the making of this Act.

## **FIRST SCHEDULE -- COLLECTIVE MARKS**

### **Signs of which a collective mark may consist**

**General. 1.** This Act applies to collective marks, subject to the following provisions.

**2.** In relation to a collective mark, the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

### **Indication of geographical origin**

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a collective mark may be registered which consists of signs or indications which may serve, in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

### **Mark not to be misleading as to character or significance**

4. A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a collective mark. Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

### **Regulations governing use of collective mark**

5. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse. Further requirements with which the regulations have to comply may be imposed by rules.

### **Approval of regulations etc.**

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark —

(a) comply with sub-paragraph (2) of paragraph 5 of this Schedule and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

[...]

## **SECOND SCHEDULE -- CERTIFICATION MARKS**

### **General**

1. This Act applies to certification marks subject to the following provisions.

### **Signs of which a certification mark may consist**

2. In relation to a certification mark the reference in subsection (1) of section 4 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

### **Indication of geographical origin**

3. Notwithstanding paragraph (c) of subsection (1) of section 6, a certification mark may be registered which consists of signs or indications which may serve in business, to designate the geographical origin of the goods or services; but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.

### **Name of proprietor's business**

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

### **Mark not to be misleading as to character or significance**

5. A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark; and the Registrar may require that a mark in respect of which application has been made for registration include some indication that it is a certification mark.

Notwithstanding subsection (2) of section 40, an application may be amended so as to comply with any such requirement.

### **Regulations governing use of certification mark**

6. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate the person authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to

be paid in connection with the operation of the mark and the procedures for resolving disputes. Further requirements with which the regulations have to comply may be imposed by rules.

### **Approval of regulations etc.**

7. (1) A certification mark shall not be registered unless —

(a) the regulations governing the use of the mark —

(i) comply with sub-paragraph (2) of paragraph 6 of this Schedule and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

[...]

### **Trade Marks Rules (s. 27/2000), 2000**

#### **Prohibition on registration of mark consisting of arms.**

11. Where a representation of any arms or insignia as is referred to in subsection (4) of section 7 appears on a mark, the Registrar shall refuse to accept an application for the registration of the mark unless satisfied that the consent of the person entitled to the arm has been obtained.

#### **Persons living or recently dead.**

12. (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar, before proceeding to register the mark, may require the applicant to furnish the Registrar with consent of the person or, in the case of a person recently dead, of his legal representatives.

[...]

#### **Series of trade marks**

17. ( 1) The proprietor of a series of trade marks may apply to the Registrar on Form TM 1 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series; and the Registrar shall, if satisfied that the marks constitute a series, accept the application.

[...]

(3) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the Registrar shall delete the mark accordingly.

[...]

**Chapter 94 -- Emblems and Names (Prevention of Improper Use)**  
**20 of 1967, 3 of 1974 - Amended by: S 128/80 S 163/81**

2. In this Act unless the context otherwise requires —

[...]

“specified emblem” means any emblems, seal, flag, pennant, insignia, formation sign, ensign or coat of arms specified in Part I of the Schedule;

“specified name” means any name specified in Part II of the Schedule and includes any abbreviation of any such name.

3. (1) Notwithstanding anything contained in any law for the time being in force, no person shall, except with the written permission of His Majesty the Sultan and Yang Di-Pertuan —

[...]

(c) use or continue to use any specified name or specified emblem, or any colourable imitation thereof, in the title of any patent, or in any trade mark of design;

[...]

4. Notwithstanding anything contained in any law for the time being in force, no competent authority shall —

(a) register any company, firm or other body or persons under any name; or

(b) register a trade mark or design which bears any emblem, name, photograph, drawing or other pictorial representation;

[...]

if the use of such name, emblem, photograph, drawing or pictorial representation would be in contravention of section 3.

## **SCHEDULE**

### **Part I – Emblems**

1. The standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri.
2. The State Seal of Brunei Darussalam.
3. The Brunei Coat-of-Arms.
4. The emblem or official seal of the United Nations Organisation.
5. The Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty.
6. The Emblem or official seal of the International Criminal Police Organisation (Interpol).
7. The emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam [...]

### **Part II – Names**

1. The name of His Majesty the Sultan and Yang Di-Pertuan.
2. The name of Her Majesty the Raja Isteri.
3. The name ICPO - Interpol or International Criminal Police Organisation (Interpol).

## **CAMBODIA**

### **Law concerning Marks, Trade Names and Acts of Unfair Competition, Royal Decree of 7 February 2002 - N5IRKM/0202/006**

#### **Article 2**

(a) - "mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise;

(b) - "collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

(c) - "trade name" means the name or/and designation identifying and distinguishing an enterprise.

#### **Article 4**

A mark cannot be validly registered:

(a) - if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;

(b) - if it is contrary to public order or morality or good custom;

(c) - if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;

(d) - if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of , or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorized by the competent authority of that State or organization;

(e) - if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in the Kingdom of Cambodia for identical or similar goods or services of another enterprise;

(f) - if it is identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well-known and registered in the Kingdom of Cambodia for goods or services which are not identical or similar to those in respect of which registration is applied for , provided that use of the mark in

relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark that the interests of the owner of the well-known mark are likely to be damaged by such use; or

(g) - if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

#### **Article 14**

The Ministry of Commerce has the right to order the cancellation to the registered mark where:

[...]

(e) - It is convinced upon evidence that the owner of the registered mark is not the legitimate owner.

(f) - It is convinced that the registered mark is similar or identical to a well-known mark owned by third party.

#### **Article 17**

(a) - An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.

(b) - The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in paragraph (a).

#### **Article 21**

(a) - Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) - Any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

#### **Article 25**

An infringement of a registered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used:

(a) - in relation to goods and services identical with or similar to the goods and services for which the well-known mark has been registered, or

(b) - in relation to goods and services which are not identical with or similar to those in respect of which the well-known mark has been registered and the use of the sign in relation to these goods or services would indicate a connection between those goods and services and the owner of the well-known mark and that the interests of the owner of the well known mark are likely to be damaged by such use.

### **Article 26**

An infringement of an unregistered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used in relation to goods or services identical with or similar to the goods or services for which the mark is well-known.

## **Law on Geographical Indication, 30 December 2013**

### **Article 23: Protection of Cambodian and Foreign Geographical Indication**

The Cambodian and foreign geographical indications registered in the Kingdom of Cambodia shall be protected against any:

a. direct or indirect commercial misuse of a registered geographical indication in respect of identical or comparable goods to those of the registered geographical indication where the misuse benefited or would benefit from the reputation of the geographical indication;

b. unauthorized use, imitation, evocation or translation of the geographical indication even if the true origin of the goods is accompanied by the expression such as “style”, “type”, “method”, “manner”, “imitation”, or translations of such expressions, or of similar expressions likely to mislead the public;

c. false or misleading indication as to origin, nature, or specific quality of the goods appearing on packaging, or in advertising materials or on other documents concerning the goods that are likely to mislead its origin;

d. other practices likely to mislead the public as to the true origin of the goods.

### **Article 31: Geographical Indication and Mark**

The Ministry of Commerce shall refuse any application for registration of a mark which is identical with or confusingly similar to a geographical indication which

applied before the filing date of application for mark registration as defined in the Article 23 of this law.

Where a geographical indication is definitely registered in accordance with this law, the application for registration of a mark corresponding to one of the situations defined in Article 23 and relating to the same type of goods shall be refused.

The Ministry of Commerce shall refuse any application for renewal of a mark if it contradicts the provision under Article 23 of this law. The decision of refusal shall be initially taken by the Ministry of Commerce or at the request of any interested person.

The use of a mark corresponding to one of the situations defined in Article 23, and which has been registered, in good faith, before either the date of protection of the geographical indication or the filing date of the application for geographical indication registration in the Kingdom of Cambodia, the mark may continue to be used if there are no grounds for invalidation.

### **Sub-Decree No. 46 of July 12, 2006, on the Implementation of the Law concerning Marks, Trade Names and Acts of Unfair Competition**

#### Article 12 - Transliteration and Translation of the Mark

Upon the Registrar's requirement, where a mark consists of a word or words in characters other than Khmer or Roman, filling in application form, and the additional reproductions of the mark shall be accompanied by a sufficient word by word written scripts, transliteration and translation of such words, stating the language to which each word belongs.

#### Article 23 - Collective Mark

Articles 9 to 22 of this Sub-Decree shall apply, mutatis mutandis, to collective mark subject to the following conditions:

- . 1- The acceptance of an application for registration of a collective mark shall be made, unless in the application for registration, the mark has been designated as a collective mark, and unless the application is accompanied by a copy of the regulation governing the use of the mark, duly certified by the applicant. The certification made by the applicant shall not require any legalization;
- . 2- The regulation governing the use of the collective mark shall define the common characteristics or quality of goods or services which the collective mark shall be designated and the conditions under which the persons using that collective mark shall follow. The regulation shall

provide for the exercise of effective control on the use of collective mark in compliance with the provisions of that regulation and shall determine adequate sanctions for any use contrary to the said regulation;

- . 3- A copy of the regulation governing the use of collective mark shall be appended to the registration of a collective mark;
- . 4- Publication of the registration of a collective mark, in accordance with Article 19(1) of this Sub-Decree, shall include a summary of the regulation appended to the registration;
- . 5- Every notification of changes effected in the regulation governing the use of the mark shall be made in writing;
- . 6- All notifications of such changes shall be recorded in the Register. Changes in the regulations governing the use of collective mark shall have no effect until such recording has been made. A summary record of changes shall be publicly published;
- . 7- For the purposes of use of the collective mark in connection with Articles 15 and 16 of the law, the registered owner of a collective mark may use the mark himself/herself providing that it is also used by other authorized persons in accordance with the regulation governing such use. Use by such persons shall be deemed as using by the registered owner.

**TRADEMARKS MANUAL - Department of Intellectual Property Rights**  
**- July 2013**

Available from the IP authorities of Cambodia.

## **INDONESIA**

### **Law N° 15 of 2001, regarding Marks**

#### **Article 1**

In this Law the following meanings shall apply:

1. Mark is a sign in the form of a picture, name, word, letters, numerals, composition of colours, or a combination of said elements, having distinguishing features and used in the activities of trade in goods or services.
2. Trade Mark is a Mark that is used on goods traded by a person or by several persons jointly or a legal entity to distinguish the goods from other goods of the same kind.
3. Service Mark is a Mark that is used for services traded by a person or by several persons jointly or a legal entity to distinguish the services from other services of the same kind.
4. Collective Mark is a Mark that is used on goods and/or services having the same characteristics that are traded jointly by several persons or legal entities to distinguish the goods and/or services from others of the same kind. [...]

#### **Article 4**

A mark shall not be registered on the basis of an application by an applicant having bad faith.

#### **Article 5**

A mark shall not be registered if it contains one of the following elements:

- a) Contradicts the prevailing rules and regulations, religious morals, or public order;
- b) Having no distinguishing features;
- c) Having become public property; or
- d) Constituting information or related to the goods or services for which registration is requested.

**Article 6**

(1) An application for registration of a mark shall be refused by the Directorate General if the relevant mark:

- a) is similar in its essential part or in its entirety with a mark owned by another party which has previously been registered for the same kind of goods and/or services.
- b) is similar in its essential part or in its entirety with a well-known Mark owned by another party for the same kind of goods and/ or services.
- c) is similar in its essential part or in its entirety with a known geographical indication.

(2) The provision referred to in paragraph (1) b) is also applicable to goods and/or services which are not of the same kind, provided that it fulfills certain conditions that will be further regulated by Government Regulation.

(3) An application for registration of a mark shall also be refused by the Directorate General if:

- a) it constitutes or resembles the name of a famous person, photograph, or the name of a legal entity belonging to another party, except with the written consent of the entitled party;
- b) it constitutes an imitation or resembles a name or abbreviation of a name, flag or coat of arms or a symbol, or an emblem of a state, or of a national or international institution, except with the written consent of the competent authority;
- c) it constitutes an imitation or resembles an official sign or seal or stamp used by a state or a government institution, except with the written consent of the competent authority.

**Article 50**

(1) An application for registration of a trade mark or a service mark as a collective mark shall only be accepted if it is clearly stated in the said application that the mark will be used as a collective mark.

(2) In addition to the affirmation on the use of a collective mark referred to in paragraph (1), the said application must be accompanied by a copy of the agreement on the use of said mark as a collective mark, signed by all the relevant mark owners.

(3) The agreement on the use of a collective mark referred to in paragraph (2) must contain, at least:

- a. the nature, the general characteristics, or the quality of the goods or services to be produced and traded;
- b. provisions for the owner of the collective mark to conduct effective supervision of the use of said mark; and
- c. sanctions for violations of the regulation on use of the collective mark.

[...]

#### **Article 51**

An application for registration of a collective mark shall be subject to an examination of the completeness of requirements as referred to in Article 7, Article 8, Article 9, Article 10, Article 11, Article 12, and Article 50.

### **Government Regulation N° 23, 1993, regarding the Procedure of Application for Registration of Mark**

#### **Article 2**

An application for registration of mark as referred to in Article 1 shall be furnished with:

- a) A written statement that the mark being applied for registration is the property of the applicant; [...]

#### **Article 3**

1. The statement as referred to in article 2 letter a) shall clearly state:
  - a) that the mark applied for registration is his property,
  - b) that the mark applied for registration does not imitate any other's trademark in its entirety or in its essential part; [...]

### **Technical Guidelines for Trademark Examination (Rev. 2012)**

Available from the IP authorities of Indonesia

## LAOS

### Law on Intellectual Property (Amended) N° 01/NA, 20 December 2011

#### Article 3 (revised). Definitions

The terms as used in this law have the following meanings: [...]

9. *Mark* means any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings;

10. *Trademark* means the mark provided for in Item 9 of this Article to use with goods or services as well as to distinguish between these goods or services and other goods or services;

11. *Collective trademark* means the trademark used by affiliated enterprises or members of an association, cooperative, state or private organization or a group of individuals;

12. *Certification mark* means the trademark, which the owner has permitted the use of by individuals, legal entities or organizations for use with their goods or services in order to certify the characteristic, which relates to the origin, raw materials and production methods of the goods or methods of services supply, type, quality, safety or other characteristics of the goods or services;

13. *Well-known mark* means a trademark, which is widely recognized by the relevant sector within the territory of the Lao PDR, including where such knowledge is a result of promotion of the trade mark;

14. *Trade name* means the name of an enterprise used in business to identify the enterprise; [...]

18. *Geographical indication* means a sign used to indicate a good as originating in the territory of a country or region or locality in that territory, where a given quality and reputation or other characteristic of the good is essentially attributable to its geographical origin; [...]

#### Article 16 (revised). Requirements for Obtaining a Trademark Certificate

In order to obtain a trademark certificate, a mark shall meet all the following requirements:

1. the mark may be any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings. Such signs may include words including personal names,

letters, numerals, figurative elements and combinations of colors as well as any combination of such signs;

2. the mark is not identical to a previously registered mark, well-known mark, or geographical indication for the same goods or services;

3. the mark is not similar to a previously registered mark or well-known mark for the same, similar, or related goods and services, where the use of the later mark would tend to cause confusion as to the source of the goods or services or create a false impression that they are connected or associated with another party;

4. the mark does not contain characteristics prohibited under Article 23 of this Law.

Any trademark shall be deemed well-known when it meets all the following requirements:

1. the trademark is a mark, as defined in the above paragraph, which is widely recognized by the relevant sector within the territory of the Lao PDR, as indicating the goods or services of the proprietor of the mark that is claimed to be a well-known mark;

2. the trademark is not contrary to the requirements for registrability in the Lao PDR;

3. In considering whether a mark is a well-known mark, any reasonable evidence may be taken into account, including evidence of such facts as are mentioned below:

3.1 the relevant sector of the public recognize the trademark by way of trade, use of the trademark on or in connection with goods or services or through advertising;

3.2 the products, goods, services are widely circulated bearing the trademark within the territory;

3.3 the volume of goods sold or services provided;

3.4 regular and continuous period of use of the trademark;

3.5 goodwill associated with use of the trademark with the goods or services based on such factors as good quality, service, or their popularity;

3.6 domestic consumers certify and widely recognize the reputation of the trademark;

3.7 high value of investment in the trademark.

A well-known trademark whether registered or otherwise shall be protected in accordance with laws and regulations.

Article 19 (new). Trade name

A trade name shall be protected without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 23 (revised). Marks ineligible for trademarks registration

The following shall be ineligible for trademark registration:

1. the mark that does not distinguish the goods or services of the applicant from those of another individual, legal entity or organization;
2. the mark that consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or of signs that have become customary in the current language or in the good faith and established practices of the trade in the Lao PDR;
3. the mark that is of such a nature as to deceive or mislead the public or trade circles in which the mark is used or is of a fraudulent nature;
4. the mark that consists of or comprises indications that, when used in the course of trade, is liable to mislead the public as to the origin, nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods or services;
5. the mark that consists of or contains without authorization from the relevant governmental entity, armorial bearings, flags, or other national emblems, and official signs, hallmarks, abbreviations or full names of towns, municipalities, provinces or capital of the Lao PDR or foreign countries;
6. the mark that consists of or contains, without authorization from the relevant state or international organization, an emblem of an international organization or symbols created by international conventions, official seals or symbols of state or international organizations;
7. the mark that consists of or contains, without authorization, the name, image, or likeness of a living person;
8. the mark that consists of or contains, without authorization images of cultural symbols or historical monuments, or the name, image, or likeness of a national hero or a leader, or the mark would be offensive or contrary to the fine traditions of the nation;

9. the mark that is identical, or similar to trademarks already registered for the same, similar, or related goods or services;
10. the mark that is identical, or similar to a well-known mark for the same, similar or related goods or services;
11. the mark that is identical, or similar to a trade name for a business that provides the same, similar, or related goods and services;
12. the above-mentioned mark that would lead to a likelihood of confusion as to the source of the goods or services or falsely suggest an association with the registered mark or well-known mark or trade name, as appropriate;
13. the mark that consists of or incorporates a geographical indication which identifies a place other than the true origin of the goods;
14. the mark that consists of or incorporates a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory;
15. the mark consists of or contains matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;
16. the mark is of such a nature as to create confusion with the establishment, the goods, or the industrial or commercial activities, of a competitor;
17. the mark is of such a nature that its use in the course of trade would discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
18. the mark is contrary to national security, social order, culture and the fine traditions of the nation.

The nature of the goods or services to which a trademark applies shall in no case form an obstacle to the registration of the mark.

**Decision No. 753 /MOST on the Implementation of Law on Intellectual Property concerning Trademarks and Trade Names, 20 September, 2012**

**Article 15. Application Requirements.**

The application shall include [...]

3. If required, a brief description of the mark as described in Article 17 of this Decision. [...]

**Article 17. Brief Description of the Mark.**

Unless the mark is in standard characters, the application shall include a brief description of the mark with the following information:

1. If the mark includes figurative elements, a brief statement describing such elements.
2. Where the mark includes words, letters, numbers, or symbols with a special appearance, a brief statement identifying that appearance.
3. If the mark is in a foreign language or contains foreign characters or words, a statement to that effect and a statement of the meaning of such foreign terms or characters, if any, and a transliteration of words or characters into the Lao language or other rendering from which the pronunciation can be ascertained.
4. If color is a feature of the mark, a statement to that effect and the colors of the mark and portions of the mark associated with each color.
5. If the mark is three-dimensional, a statement to that effect.

No description is required where the mark is limited to words, letters, numbers, or symbols, or a combination thereof, that are presented in standard characters and for which none of the above features is a feature of the mark.

**Articles 20. Collective Marks.**

A collective mark is a mark that is adopted by a collective organization, such as an association, union, cooperative, fraternal organization, chamber of commerce, or other organized collective membership organization, to indicate an affiliation with the collective organization. A collective mark is used by members of the collective organization but is not used by the collective organization itself. A collective mark may be

1. a collective trademark that is used by members of the collective

organization to identify their goods or services and distinguish them from those of non-members of the collective organization,

2. a collective membership mark that is used to indicate membership in the collective organization.

A collective mark is distinguished from a trademark in that the collective organization does not itself sell goods or perform services under a collective trademark, although the collective organization may advertise or otherwise promote the goods produced or sold or services provided by its members under the mark. Since a collective mark is used by many persons, it does not perform the essential function of a trademark, which is to indicate the source of goods and services, that is, which produced or sold the goods or provided the services. Instead, the sole function of a collective mark is to indicate that the person displaying the mark is a member of the organized collective group. An application to register a collective mark should be reviewed to determine whether it is, in fact, a collective mark or whether it is more properly a trademark or certification mark. [...]

#### **Article 21. Certification Marks.**

A certification mark is a mark that is adopted for use by a person other than its owner to certify that the user of the mark, or goods or services of the user of the mark, meet the standards or possess the characteristics that are the subject of the certification. A certification mark may be used to indicate, for example, that goods meet certain standards of safety or cleanliness, or that they were produced by persons with certain characteristics or qualifications.

A certification mark is distinguished from a trademark in that the owner of the mark does not itself sell the goods or perform the services to which the certification mark applies. Since a certification mark is used by many persons, it does not indicate the source of goods and services, that is, who produced or sold the goods or services. Instead, the sole function of a certification mark is to indicate that the goods or services in connection with which the mark is used, or the person providing such goods or services, have certain characteristics or have satisfied standards established by another person, that is, the party that provides the certification. [...]

An application to register a certification mark should be reviewed to determine whether it is, in fact, a certification mark or whether it is more properly a trademark or collective mark. [...]

#### **Article 32. Trademark Subject Matter.**

As provided in Article 16 of the Intellectual Property Law, a trademark may be any sign or combination of signs capable of distinguishing the goods or services of one undertaking from goods or services of another. In particular, in addition to the signs mentioned in Article 16 of the Intellectual Property Law,

a trademark may be a word or combination of words including a brief slogan; one or more letters, numbers or symbols alone or in combination; colors or combinations of colors; figurative elements including pictures or drawings; or a three-dimensional sign; provided that all such signs must satisfy other requirements of the Intellectual Property Law and this Decision. Unless an application claims color as a feature of the mark, or restricts words or symbols to their presentation in a specific form, it will be presumed that such restrictions do not apply to the mark. [...]

#### **Article 34. Identical and Similar Marks.**

For purposes of Articles 16 and 23 of the Intellectual Property Law, a mark that is the subject of an application shall be considered to be

- 1. Identical** where it cannot be distinguished in its essential aspects from a registered trademark, well-known mark, or trade name.
- 2. Similar** where it resembles a registered trademark, well-known mark, or trade name as described below in such a way as to give the same overall commercial impression.

In determining whether a mark is identical or similar to a registered trademark, well-known mark, or trade name, the Department shall evaluate the marks, or the mark and trade name, with regard to the overall commercial impression of each, taken as a whole, based on the appearance of the mark, and taking into account its pronunciation and its meaning, if any. In conducting this evaluation, the Department may give more weight to prominent features of a mark and less weight to minor features. For purposes of this article, a well-known mark must have been well-known by the relevant sector of the public in the Lao PDR as of the effective filing date of the application.

The similarity or dissimilarity of two marks, or of a mark and trade name, or of a mark and a geographical indication, is determined on the basis of the commercial impression of each in its entirety. The addition or deletion of minor features or of merely descriptive terms normally is not sufficient to change the commercial impression of a mark, nor is the use of color in a mark, where color is not a feature of the mark that is used for comparison.

Even though a mark must be visually perceptible, marks that include words or symbols are likely to be used in situations in which they are **pronounced**, for example, in television advertising or by placing an order. For purposes of Articles 16 and 23 of the Intellectual Property Law, homonymous marks (marks with the same pronunciation) will be considered to be identical or similar. The fact that a mark could be pronounced in some other manner will not be sufficient to avoid a refusal where an ordinary person reading the mark would reasonably expect to pronounce the mark in a way that is identical or similar to the pronunciation of a registered mark, well-known mark, or trade name.

Where a mark includes words or symbols that are equivalent in **meaning** to another mark, the Department may also judge such mark to be similar to another mark or trade name with the same meaning. Where such marks are presented in different languages, the marks will be considered similar or identical if likely purchasers of the goods would be expected to recognize the marks as having the same meaning.

For purposes of this Decision, images and words are considered to be interchangeable when both refer to the same object. Likewise, letters, numbers, and symbols, or combinations thereof, will be treated as interchangeable whether presented in such form or rendered phonetically this Decision.

### **Article 35. Same, Similar, or Related Goods or Services.**

For purposes of Articles 16 and 23 of the Intellectual Property Law, goods and services are the same, similar, or related to each other where such goods are of the same type or same general type, or where such goods would commonly be used together, or used for the same purpose, or sold together in the same types of stores.

### **Article 36. Likelihood of Confusion; Permissible Exceptions.**

A mark will be refused registration pursuant to Articles 16 and 23 of the Intellectual Property Law where the Department finds that

1. the mark is of such a nature as to create confusion with the establishment, the goods, or the industrial or commercial activities, of a competitor, or
2. the use of the mark, on or in connection with the goods or services stated in the application would tend to cause confusion as to the source of the goods or services.

Refusal under this paragraph shall be based on a preponderance of the evidence, that is, a mark will be refused registration where the Department finds it more likely than not that such confusion would occur.

In evaluating the likelihood of confusion, the Department shall consider the following factors with regard to the mark that is the subject of the application and a registered mark, well-known mark, or trade name:

1. Their similarity or dissimilarity, taking into account the criteria of Article 34 of this Decision. If the marks are not identical or similar for purposes of Article 34 of this Decision, no further inquiry is needed.
2. The similarity, dissimilarity, or relatedness of the goods or services to which each applies, taking into account the criteria of Article 35 of this Decision. Even where similarity of the marks has been found under the

criteria of Article 34 of this Decision, no further inquiry is normally required for purposes of this article if the goods or services are not similar and not related in accordance with Article 35 of this Decision.

In general, there is a greater likelihood of confusion when there is greater similarity between the marks, or between the mark and trade name, and when there is greater similarity between the goods or services of each. However, a greater similarity of one may require less similarity in the other to sustain a finding of likelihood of confusion.

Where the mark that is the subject of the application is identical or essentially identical to a registered mark, well-known mark, or trade name, and the goods and services are the same or essentially the same as those associated with the registered mark, well-known mark, or trade name, a likelihood of confusion shall be presumed and registration shall be refused.

Where the marks, or mark and trade name are found to have some similarity but are not identical or essentially identical, and the goods or services are found to be identical, similar, or related, the Department shall additionally take into account the following **factors**, as such factors are appropriate to the application, to determine whether there exists a likelihood of confusion:

1. Similarity or dissimilarity of the trade channels of the goods or services, including whether such goods are normally sold together or purchased in the same places, or otherwise encountered by the same persons. The use of similar channels of distribution increases the likelihood of confusion with similar or related goods sold under a similar mark.
2. Conditions under which the goods are encountered and the degree of care normally exercised in making a purchase. Less similarity is required to find a likelihood of confusion where it is likely that consumers will exercise a lower degree of care in making a purchase, while a likelihood of confusion may not exist for similar marks and similar goods that require special knowledge to purchase.
3. Fame of the earlier mark as determined by its length of use, advertising and promotion, revenues from sales, large number of different types of goods or services in connection with which the mark is used, or the like. The greater the fame of a mark, the likelier that purchasers will assume a relationship between the same or a similar mark with the more famous mark.
4. Number and nature of similar marks for the same or similar goods or services. Where a large number of unrelated persons use the same or essentially the same mark for the same or closely related goods or services, it indicates that the mark itself is weak, and a likelihood of confusion will exist only when the Department finds that both the mark and goods and services associated with it are identical, or nearly identical, to those of the registered trademark, well-known mark or trade name. This situation most often arises in connection with marks that incorporate

descriptive or geographical terms.

5. Nature and extent of any actual confusion. The criterion established by Articles 16 and 23 of the Intellectual Property Law is whether the later mark would tend to cause confusion, not whether such confusion has actually occurred. However, evidence of actual confusion may suggest a tendency to cause confusion if the number of instances is large relative to the number of opportunities for confusion, while a small number of such instances relative to the number of opportunities may suggest that no such tendency exists.

6. Length of time during and conditions under which the marks have been concurrently used without evidence of actual confusion. Co-existence of the marks or of the mark and trade name, in the same market for a reasonable time period without any known confusion may be evidence that there is no likelihood of confusion.

7. Intent of the later user. Generally, the intent of the applicant is not an element to be considered in evaluating the likelihood of confusion except where there is evidence that the applicant has adopted or is attempting to register a mark in order to create confusion or an association with the registered or well-known mark or trade name. Evidence of such intent can be inferred from facts showing the applicant's knowledge of the earlier mark or trade name, or where the applicant acknowledged an intent to use a similar mark, or advertises or promotes his or her goods or services in a way that strongly shows an intent to mislead consumers, for example, by copying other trade dress of the registered or well-known mark.

Where the Department finds a likelihood of confusion between the mark that is the subject of an application and another mark that is also owned by the applicant, the applicant may avoid a refusal under this article by amending the application and, if the cited mark is the subject of a registration or pending application, the registration or application of the cited mark to indicate that the two marks are commonly owned. Where the Department finds a likelihood of confusion between the mark that is the subject of an application and a trade name or well-known mark that is not the subject of an application or registration, the applicant may avoid such refusal by amending the pending application as stated herein and providing satisfactory evidence that the applicant is the owner of such mark or trade name. In such cases, ownership must be identical for the two applications, or for the application and registration, or for the application and well-known marks, or for the application and the trade name, as appropriate.

A refusal pursuant to this article may be avoided where the applicant submits a verified statement by the owner of an earlier registered mark, or of a mark that was well-known at the time of application, or of an earlier trade name, consenting to such registration concurrently with the earlier rights, together with a statement explaining how the two marks can exist concurrently without creating a likelihood of confusion, and further provided that the Department finds that approval of registration is unlikely to lead to confusion as set forth in

paragraph 1 of this article. Such situations may exist, for example, where the goods and services of the parties are sold in different channels of commerce or in different geographical areas in a manner that is unlikely to result in sales or advertising to the same customers.

### **Article 37. False Impression of Association.**

The Department shall refuse registration where the mark would tend to create false impression that the goods or services to which an application pertains are connected or associated with the goods or services of a registered or well-known mark or with a trade name. A false impression of connection or association may be created for purposes of Articles 16 and 23 of the Intellectual Property Law where a registered mark with an earlier filing date than the application, or a mark that is well-known in the Lao PDR before the effective filing date of the application, or a trade name that is used or known in the Lao PDR before the effective filing date of the application, meets one or more of the following criteria:

1. The marks are identical or similar and the goods or services identified in the application, **even if not similar or related** to those in connection with which the earlier mark or trade name is used, represent a likely area for **expansion** of the goods or services.
2. The marks are identical or similar and the earlier mark or trade name has such a degree of fame that the relevant sector of the public would be likely to assume a **connection** between the goods or services of the applicant and those of the owner of the earlier mark or trade name.
3. The mark of the applicant appears to be **derived** from a more famous mark or trade name.

The Department shall also refuse registration pursuant to Article 23 of the Intellectual Property Law where a mark consists of or contains material that falsely suggests a connection with persons, living or dead, or with institutions, beliefs, or national symbols. Such connection or association may be created by the use of a person's name or image; by the use of the name or symbol or mark of an institution; by the use of terms or symbols commonly used in reference to beliefs; and by the use of national symbols or of the names therefor.

The Department may find a tendency to create a false impression of connection or association in other circumstances where the evidence suggests that such a false association or connection is more likely than not to be created among the relevant sector of the public.

### **Article 38. Well-Known Marks.**

For purposes of Articles 16 and 23 of the Intellectual Property Law, the relevant sector means that part of the public that would be expected to have knowledge of a mark and includes persons who have knowledge of a mark as a result of advertising or marketing. Such persons shall include, but are not necessarily limited to:

1. Actual and/or potential consumers of the type of goods and/or services to which the mark applies;
2. Persons involved in channels of distribution of the type of goods and/or services to which the mark applies; and
3. Business circles dealing with the type of goods and/or services to which the mark applies.

Recognition of a well-known mark in the Lao PDR does not require that the goods or services associated with the mark be sold or distributed in the Lao PDR.

### **Article 39. Lack of Distinctiveness.**

A mark shall be refused registration where it is not of such a nature as to distinguish the goods or services of one undertaking from those of another. In particular, a mark that consists entirely of terms that are descriptive of the goods and services, or of the common names for such goods, shall be refused registration.

### **Article 40. Descriptive or Customary Terms.**

Where a mark is capable of distinguishing the goods or services of one entity from those of another, but the mark includes terms that are descriptive or customary terms for the goods or services, the Department shall require the applicant to **disclaim** the descriptive or customary terms apart from the mark as shown in the application. A term is considered to be **descriptive** for purposes of this article if it describes the goods or services or some characteristic of the goods or services. Such terms must be disclaimed to preserve the right of other producers or providers to use the same terms in connection with their goods. Examples of descriptive terms include laudatory terms (best, tastiest, quality, and the like); terms that merely describe the location of the applicant; and terms that indicate some quality or characteristic of the goods or services (pain-free, home-cooked, prompt service, and the like). While a descriptive term must be disclaimed, a term that is merely suggestive may function as a mark or may be incorporated in a mark and need not be disclaimed.

Refusal is also appropriate where a mark consists exclusively of signs or indications designating the kind, quality, quantity, intended purpose, value, or place of origin of the goods, their time of production, or signs that have become customary in the current language or in the good faith and established practices of the trade in the Lao PDR.

Where a mark incorporates such terms but does not consist exclusively of them, the Department will require such terms to be disclaimed. If such terms appear on a drawing, the Department will inquire whether they are intended to be part of the mark, and if not, will require the drawing to be amended to delete the terms.

#### **Article 41. Deceptive or Misleading Marks.**

Registration shall be refused under Article 23 of the Intellectual Property Law where a mark falsely indicates that the goods or services identified in the application have a certain nature, quality, or characteristics, or that they are suitable for a particular purpose or originate from a particular place or are made by a certain process or to certain standards.

Registration shall also be refused under Article 23 of the Intellectual Property Law where the mark as a whole, when used on or in connection with the goods or services identified in the application, would tend to deceive or mislead the public as to the nature, quality, characteristics, or suitability of the goods or services, or their geographic origin. A refusal under this paragraph is appropriate, for example, where the mark incorporates geographical terms that falsely suggest that the goods and services originate in a region from which they do not in fact originate. A refusal under this paragraph may also be appropriate where the mark contains elements that would tend to indicate the suitability of goods or services for a particular purpose or group if goods are not suitable for such purpose or group, for example, by incorporating a picture of a baby on goods not suitable for use with a baby.

The fact that a mark can be understood in a non-deceptive way is not a bar to refusal of registration. Where a mark is susceptible of more than one understanding, the Department should refuse the registration if it would be reasonable for a purchaser to understand the mark in its deceptive or misleading sense.

In case of doubt, or where a mark is susceptible of more than one understanding, the Department shall make an inquiry regarding the nature of the goods and services, their qualities, characteristics, or origin, as appropriate, to determine whether a mark may be descriptive or whether it may be deceptive or misleading.

#### **Article 42. Marks Containing Elements Not Permitted or Authorized.**

Pursuant to Article 23 of the Intellectual Property Law, the Department will

refuse to register a mark that consists of, or contains, any of the following elements:

1. Flag, armorial bearing, or other emblems of a country or intergovernmental organization, official seals or symbols of state or international organizations, or symbols created by international conventions, except where such elements are authorized by the relevant governmental or intergovernmental entity. For purposes of this paragraph, such elements shall be determined as provided in the Paris Convention.
2. Abbreviations or full names of towns, municipalities, provinces or capital of the Lao PDR or foreign countries except as authorized by the relevant governmental entity, unless such abbreviations or names are disclaimed.
3. Official signs and hallmarks indicating control and warranty adopted by them, and any imitation thereof, where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind, except where such elements are authorized by the relevant governmental entity.
4. The name, image, or likeness of a living person without such person's authorization.

Where the applicant claims authorized use, such authorization must be presented in writing.

Authorization is required for purposes of this article unless the applicant is the governmental or intergovernmental authority entitled to give such authorization or, for purposes of subparagraph 4 of paragraph 1 of this article, the person whose name, image, or likeness is used, or a person such as a parent or legal guardian who is authorized to act on such person's behalf.

#### **Article 43. Trade Names.**

Trade names shall be protected whether or not they are registered.

The same principles shall apply in evaluating whether a trademark application is identical with or similar to a trade name as apply in regard to a registered mark.

A trade name shall be entitled to protection against infringement in accordance with the same principles that apply to trademarks.

#### **Article 44. Marks that Consist of or Incorporate a Geographical Indication.**

Pursuant to Article 23 of the Intellectual Property Law, the Department shall refuse to register a mark that consists of or incorporates a geographical indication where the goods identified in the application, or any portion of such

goods, do not in fact originate in the place associated with the geographical indication, unless the applicant amends the application so as to apply the mark solely to goods that originate in the place associated with the geographical indication.

Pursuant to Article 23 of the Intellectual Property Law, the Department shall also refuse registration of a mark that consists of or incorporates a geographical indication where the use of such geographical indication in connection with the goods identified in the application, or any portion of such goods, may be literally true as to the territory, region or locality in which the goods originate, but nevertheless falsely represent to the public that the goods originate in another territory. Such situation may occur, for example, where the name of the location where the goods actually originate is identical or similar to the name of a territory, region, or locality to which the geographical indication pertains.

The Department will refuse registration in accordance with this article where a mark, or element of a mark, is **homonymous** with a geographical indication.

For purposes of this article, a geographical indication is as defined in paragraph 18 of Article 3 of the Intellectual Property Law.

The Department will apply the provisions of this article to any geographical indication that is registered in the Lao PDR, or that may be entitled to protection in the Lao PDR even if not yet registered in this country. Where such conditions are not satisfied, for example, because a geographical indication is not yet protected in its country of origin, the Department may refuse registration to a mark that consists of or includes such geographical indication pursuant to Article 36 of this Decision if it finds that the use of the geographical indication would tend to deceive or mislead purchasers as to the true origin or characteristics, quality, or reputation of the goods.

#### **Article 45. Marks that Disparage or Discredit Another.**

The Department shall refuse registration of a mark pursuant to Article 23 of the Intellectual Property Law that consists of or contains elements that may disparage persons, living or dead, or institutions, beliefs, or national symbols.

Such disparagement may be created by the use of a person's name or image; by the use of the name or symbol or mark of an institution; by the use of terms or symbols commonly used in reference to beliefs; and by the use of national symbols or of the names therefor, under circumstances, or in such manner as to ridicule, discredit, show contempt for, or bring into disrepute such person, institution, belief, or symbol.

The standard to be applied in evaluating whether a refusal is appropriate under this article is whether the mark, or element of the mark, as used in connection with the goods or services to which it applies, would be viewed by an ordinary

Lao person as disparaging, discrediting, or showing contempt for such persons, beliefs, institutions, or symbols, or bringing them into disrepute.

In particular, the Department may refuse registration under this article when the mark is applied to goods relating to bodily functions, or where the use of the goods in connection with the mark would bring the mark into proximity with intimate parts of the body, or in any other manner where the use of the mark in connection with the goods or services would indicate contempt for the person, institution, belief, or symbol.

Note that a refusal may not be based on the nature of the goods for which a mark is applied. Goods or services relating to bodily functions or to goods the use of which may be objectionable on some ground may still be the subject of an application to register a mark. Such situation should be distinguished from a refusal based on the manner of use of the mark pursuant to paragraph 15 of Article 23 of the Intellectual Property Law. Note that in the general case, there is no objection to registration of a mark based on the nature of the goods or services, except as provided herein where it is the connection between the mark and its use with such goods or services that would disparage persons, institutions, beliefs, or national symbols that would disparage them or bring them into contempt or disrepute.

#### **Article 46. Marks Contrary to Social Order and Fine Traditions of the Nation.**

In accordance with Article 23 of the Intellectual Property Law, registration may be refused where a mark or its intended use is contrary to **social order** and the fine traditions of the nation. A mark will be considered to be contrary to social order and the fine traditions of the nation where it consists of, comprises, or includes material that is scandalous or obscene or otherwise offensive, where it includes disparaging material, or where publication of the mark would constitute a violation of national law. For purposes of interpreting Article 23 of the Intellectual Property Law, this provision shall be interpreted as being consistent with the terms *ordre public* or **public order** and **morality** as used in international agreements to which the Lao PDR is a party.

### **TRADEMARKS MANUAL - September 2003**

Available from the IP authorities of Laos.

## **MALAYSIA**

### **Trade Marks Act 1976 - Act N° 175 (amendments up to 1 January 2006)**

#### **Section 3. Interpretation**

(1) In this Act, unless the context otherwise requires—

[...]

“geographical indication” means an indication which identifies any goods as originating in a country or territory or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;

“in the course of trade”, in relation to the provision of services, means in the course of business;

[...]

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

[...]

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

[...]

“specification” means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered;

“trade mark” means, except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and a person having the right either as proprietor or as registered user to use the mark whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI; [...]

“word” includes an abbreviation of a word.

(2) In this Act—

- (a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;
- (b) references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods; and
- (c) references to the use of a mark in relation to services shall be construed as references to the use thereof as a statement or as part of a statement about the availability or performance of services.

### **Section 10. Registrable trade marks**

(1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:

- (a) the name of an individual, company or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word or words;
- (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
- (e) any other distinctive mark.

(2) A name, signature or word which is not described in paragraph (1)(a), (b), (c) or (d) is not registrable unless it is by evidence shown to be distinctive.

(2A) For the purposes of this section, “distinctive”, in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in the Register in respect of any goods or services.

### **Section 12. Use by proposed registered user to be considered for the purpose of determining distinctiveness, etc.**

(1) Where an application for registration of a trade mark has been made by a person, and before the date of the application the trade mark had been used by a person other than the applicant under the control of and with the consent and authority of the applicant, and where an application is made by the applicant and that other person for the registration of that other person as a registered user of the trade mark immediately after the registration of the trade mark and the Registrar is satisfied that the other person is entitled to be registered as a registered user of the trade mark, the Registrar may, for the purpose of determining whether the trade mark is distinctive of or capable of distinguishing the goods or services of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by the applicant and may make an order that the trade mark is so distinctive or capable of distinguishing.

(2) An order of the Registrar under subsection (1) is subject to appeal to the Court.

(3) Where an order is made under subsection (1), the registration of the trade mark shall cease to have effect if at the expiration of the prescribed period, or such further period not exceeding six months as the Registrar may allow, that other person has not become registered as the registered user of the trade mark.

### **Section 13. Colour of trade mark**

(1) A trade mark may be limited in whole or in part to one or more specified colours and, in any such case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2) Where a trade mark is registered without limitations as to colour, it shall be deemed to be registered for all colours.

### **Section 14. Prohibition on registration**

(1) A mark or part of a mark shall not be registered as a trade mark—

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

- (b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;
- (c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;
- (d) if it is identical with or so nearly resembles a mark which is well known in Malaysia for the same goods or services of another proprietor;
- (e) if it is well known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for:

Provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well known mark, and the interests of the proprietor of the well known mark are likely to be damaged by such use;

- (f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or
- (g) if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

(2) Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well known trade mark.

#### **Section 14A. Where registration shall not be refused**

(1) A trade mark shall not be refused registration by virtue of paragraphs 14(f) and (g) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either—

- (a) before the commencement of the Geographical Indications Act 2000 [Act 602]; or
- (b) before the geographical indication in question is protected in its country of origin.

(2) A trade mark shall not be refused registration by virtue of paragraphs 14(f) and (g) if the geographical indication in question—

- (a) has ceased to be protected; or

(b) has fallen into disuse,  
in its country of origin.

### **Section 15. Where registration may be refused**

The Registrar shall refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as is likely to be taken for that mark:

- (a) the word or words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design” and “Copyright” or a word or words to the like effect in any language whatsoever; or
- (b) any mark which is specifically declared by the Minister in any regulations made under this Act to be a prohibited mark.

### **Section 16. Use of name of another person**

Where a person makes an application to register a trade mark which consists of or includes the name or representation of another person whether living or dead the Registrar may require the applicant to furnish him with the consent of that person if living or of the legal representative of that person if deceased before permitting the name or representation to be used as a trade mark.

### **Section 17. Registration for particular goods or services**

(1) A trade mark may be registered in respect of any or all of the goods comprised in a prescribed class of goods or in respect of any or all of the services comprised in a prescribed class of services.

(2) If any question arises as to the class in which goods or services are comprised that question shall be decided by the registrar whose decision shall be final.

### **Section 18. Disclaimer**

(1) If a trade mark—

(a) contains any part—

- (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains matter which is common to the trade or business or is not distinctive,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain in the Register, may require as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any such part or matter, to the exclusive use of which the Registrar or the Court holds him not to be entitled or that the proprietor shall make such other disclaimer as the Registrar or the Court may consider necessary for the purpose of defining his rights under the registration.

(2) No disclaimer on the Register shall affect any right of the proprietor of a trade mark except a right arising out of the registration of the trade mark in respect of which the disclaimer is made.

### **Section 19. Identical trade marks**

(1) No trade mark shall be registered in respect of any goods or description of goods—

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services—

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

(a) such applications are in respect of the same goods or description of goods; or

- (b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and—

- (a) such applications are in respect of the same services or description of services; or

- (b) at least one of such applications is in respect of services and the other or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

## **Section 20. Concurrent use**

(1) Notwithstanding subsection 19(1), in the case of honest concurrent use or of the circumstances described in paragraph 6(4)(c) or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same goods or description of goods; or

- (b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods, subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(1A) Notwithstanding subsection 19(2), in the case of honest concurrent use or of other special circumstances which, in the opinion of the Court or the Registrar, make it proper so to do, the Court or the Registrar may permit the registration of more than one proprietor in respect of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors—

- (a) is in respect of the same services or description of services; or

(b) in the case of at least one proprietor, is in respect of services, and in the case of the other or others, is in respect of goods closely related to those services,

subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

(2) The Registrar shall not refuse to register a trade mark which is identical to or so nearly resembling another trade mark in the Register if the applicant of the first mentioned trade mark or his predecessor in business has continuously used that trade mark from a date before—

(a) the use of that other trade mark by the registered proprietor or his predecessor in business or by a registered user; or

(b) the registration of that other trade mark by the registered proprietor or his predecessor in business,

whichever is the earlier.

#### **Section 24. Series of trade marks**

(1) Where several trade marks in respect of the same goods or description of goods in a single class or in respect of the same services or description of services in a single class resemble each other in material particulars but differ in respect of—

. (a) statements or representation as to the goods or services in respect of which the trade marks are used or proposed to be used;

. (b) statements or representations as to number, price, quality or names of places;

. (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or

. (d) colour,

and a person who claims to be the proprietor thereof seeks to register the trade marks, the trade marks may be registered as a series in one registration.

[...]

#### **Section 25. Registration**

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner.

[...]

### **Section 37. Registration conclusive**

In all legal proceedings relating to a trade mark registered in the Register (including applications under section 45) the original registration of the trade mark under this Act shall, after the expiration of seven years from the date thereof, be taken to be valid in all respects unless it is shown—

(a) that the original registration was obtained by fraud;  
[...]

### **Section 45. Rectification of the Register**

(1) Subject to the provisions of this Act—  
[...]

(c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;

[...]

### **Section 56. Certification trade marks**

(1) A mark which must be capable, in relation to any goods or services, of distinguishing in the course of trade goods or services certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods or services not so certified shall be registrable as a certification trade mark in the Register in respect of those goods or services in the name of that person as proprietor thereof except that a mark shall not be so registrable in the name of a person who carries on a trade in goods or services of the kind certified.

(2) In determining whether a mark is capable of distinguishing, the Registrar may have regard to the extent to which—

(a) the mark is inherently capable of distinguishing in relation to the goods or services in question; and

(b) by reason of the use of the mark or any other circumstances, the mark is in fact capable of distinguishing in relation to the goods or services in question.

[...]

(9) In dealing with an application under this section the Registrar shall have regard to the like considerations, as far as relevant, as if the application were an application under section 25 and to any other considerations relevant to applications under this section, including the desirability of securing that a

certification trade mark shall comprise some indication that it is such a trade mark.

(10) An applicant for the registration of a trade mark under this section shall transmit to the Registrar draft rules for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorize the use of the trade mark and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorize the use of the trade mark in accordance with the rules) and such rules, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the Register.

(11) The Registrar shall consider the application with regard to the following matters, that is to say—

(a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;

(b) whether the draft rules are satisfactory; and

(c) whether in all the circumstances the registrations applied for would be to the public advantage,

and may either—

(i) refuse to accept the application; or

(ii) accept the application and approve the rules, either without modification and unconditionally or subject to any conditions, amendments, modifications or limitations of the application or of the rules, which he may think requisite,

[...]

### **Section 57. Defensive registration of well known trade marks**

(1) Where a trade mark consisting of an invented word or words has become so well known as regards any goods or services in respect of which it is registered and, in relation to which it has been used, that the use thereof in relation to other goods or services would likely to be taken as indicating a connection in the course of trade between the other goods or services and a person entitled to use the trade mark in relation to the first mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first mentioned goods or services does not use or propose to use the trade mark in relation to the other goods or services and notwithstanding anything in section 46 the trade mark may, on the application in a prescribed manner of the proprietor registered in respect of the first mentioned goods or services, be registered in his name in respect of the other goods or services as a defensive trade mark and while so registered, shall not be liable to be taken off the Register in

respect of other goods or services under section 46.  
[...]

### **Section 70B. Protection of well- known trade marks**

(1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a well known trade mark is entitled to restrain by injunction the use in Malaysia in the course of trade and without the proprietor's consent of the trade mark which, or the essential part of which, is identical with or nearly resembles the proprietor's mark, in respect of the same goods or services, where the use is likely to deceive or cause confusion.

(2) Nothing in subsection (1) shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this Act.

(3) In this section, references to a trade mark which is entitled to protection under Article 6*bis* of the Paris Convention or Article 16 of the TRIPS Agreement as a well known trade mark are to a mark which is well known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia, and references to the proprietor of such a mark shall be construed accordingly.

### **Trade Marks Regulations 1997 (to February 2011)**

Regulation 13. Marks subject to statutory restriction.

(1) The Registrar shall refuse to accept any application for the registration of a mark upon which any of the following appears:

(a) the words "To counterfeit this is a forgery", "Registered Trade Mark", "Registered Service Mark", or any words to the like effect in any language;

(b) the words "Bunga Raya" and the representations of the hibiscus or any colourable imitation thereof;

(c) representations of or words referring to Seri Paduka Baginda Yang di-Pertuan Agong, Ruler of a State or any colourable imitation thereof;

(d) the representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;

(e) the word "ASEAN" and the representation of the ASEAN logotype or any colourable imitation thereof;

(f) the words "Red Crescent" or "Geneva Cross" and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red ground, or such representations in a similar colour or colours.

(2) Where there appears in a trade mark, the registration of which is applied for, a representation of a crescent or a cross in any colour, not being one of those mentioned in paragraph (1)(f), the Registrar may require the applicant, as a condition of acceptance, to undertake not to use the crescent or cross device in red, or in white or silver on a red ground, or in any similar colour or colours.

Regulation 13A. Where registration of mark is not allowed.

The Registrar shall not register a mark or part of a mark where-

(a) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of Malaysia to be well-known in Malaysia, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;

(b) the mark or part of the mark is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known under regulation 13B, which is registered in Malaysia with respect to goods or services whether or not similar to those with respect to which registration is applied for, provided that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the proprietor of the registered mark, provided further, that the interests of the proprietor of the registered mark are likely to be damaged by such use;

(c) the mark or part of the mark is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

(d) the mark or part of the mark is likely to mislead the public if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

Regulation 13B. Criteria of well-known mark.

In determining whether a mark is well-known or not, the following criteria may be taken into account:

(a) the degree of knowledge or recognition of the mark in the relevant sector of the public;

- (b) the duration, extent and geographical area of any use of the mark;
- (c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;
- (e) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities;
- (f) the value associated with the mark.

#### Regulation 14. Royal arms, etc.

The following devices shall not appear on a trade mark the registration of which is applied for:

- (a) representations of, or mottoes of or words referring to, the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;
- (b) representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- (c) representations of, or mottoes of or words referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling any of the foregoing as to be likely to be mistaken for them.

#### Regulation 15. Arms of city, etc.

Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of such official or other person as appears to the Registrar to be entitled to give consent is filed.

#### Regulation 16. Goods or services described on a mark.

- (1) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services, the Registrar may refuse to register such mark in respect of

any goods or services, as the case may be, other than the goods or services so named or described.

(2) Where the name or description of any goods appears on a trade mark for any goods or the name or description of any service appears on a trade mark for any services and in either case the name or description in use varies, the Registrar shall consider whether to refuse to permit the registration of the mark for those and other goods or services, as the case may be, unless the applicant states in his application that the name or description will be varied when the mark is used upon goods or services covered by the specification other than the named or described goods or services.

**Manual of Trade Marks Law & Practice, 2003 (2nd Edition)**

Available from the IP authorities of Malaysia

## **MYANMAR**

NOTE: The trademark legislation of Myanmar is in the process of adoption by the competent authorities and was pending enactment at the time of conclusion of these Guidelines.

## PHILIPPINES

### **REPUBLIC ACT Nº. 8293 - an Act prescribing the Intellectual Property Code and establishing the Intellectual Property Office, providing for its powers and functions, and for other purposes, 1997**

SECTION 121. Definitions. — As used in Part III, the following terms have the following meanings:

121.1. "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

121.2. "Collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark; (Sec. 40, R.A. No. 166a)

121.3. "Trade name" means the name or designation identifying or distinguishing an enterprise; (Sec. 38, R.A. No. 166a)  
[...]

SECTION 123. Registrability. —

123.1. A mark cannot be registered if it:

- a. Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
- b. Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;
- c. Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow;
- d. Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
  - (i) The same goods or services, or

- (ii) Closely related goods or services, or
  - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- e. Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- f. Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;
- g. Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;
- h. Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- i. Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- j. Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;
- k. Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- l. Consists of color alone, unless defined by a given form; or
- m. Is contrary to public order or morality.

123.2. As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods for which registration is requested as a result of the use that have been made of it in commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

123.3. The nature of the goods to which the mark is applied will not constitute an obstacle to registration. (Sec. 4, R.A. No. 166a)

#### SECTION 165. Trade Names or Business Names. —

165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

165.2.

a. Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

b. In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

165.3. The remedies provided for in Sections 153 to 156 and Sections 166 and 167 shall apply mutatis mutandis.

[...]

#### SECTION 167. Collective Marks. —

167.1. Subject to Subsections 167.2 and 167.3, Sections 122 to 164 and 166 shall apply to collective marks, except that references therein to "mark" shall be read as "collective mark".

167.2.

a. An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the agreement, if any, governing the use of the collective mark. [...]

167.3. In addition to the grounds provided in Section 149, the Court shall cancel the registration of a collective mark if the person requesting the cancellation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the agreements referred to in

Subsection 166.2 or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

[...]

**Rules And Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, of 29<sup>th</sup> day of October 1998, as last amended by Office Order No. 13-61 (2013)**

**RULE 100.** *Definitions.* — Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

[...]

(b) "Collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristics, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

[...]

(i) "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods;

[...]

(l) "Trade name" means the name or designation identifying or distinguishing an enterprise, also known or referred to as business identifier.

**RULE 101.** *Registrability.* — A mark cannot be registered if it:

(a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

(b) Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;

(c) Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow;

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
  - (ii) Closely related goods or services, or
  - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services; Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided, further, That the interests of the owner of the registered mark are likely to be damaged by such use;
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services. Geographical indications are indications which identify a good as originating in the territory of a country which is a member of, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;
- (k) Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- (l) Consists of color alone, unless defined by a given form; or

(m) Is contrary to public order or morality.

As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods or services for which registration is requested as a result of the use that has been made of it in commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

The nature of the goods or services to which the mark is applied will not constitute an obstacle to registration.

**RULE 102.** *Criteria for determining whether a mark is well-known.* — In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and,
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

**RULE 103.** *Trade Names or Business Names.* — (a) A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(b) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties. In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

[...]

**Rule 608. *Disclaimers.***

The basic purpose of disclaimers is to make of record, that a significant element of a composite mark is not being exclusively appropriated apart from the composite. The following portions of a mark when forming part of the composite mark, must be disclaimed to permit registration, namely (a) a generic term; (b) a descriptive matter in the composite mark; (c) a matter which does not function as a trademark, or service mark or a trade name.

Such disclaimer shall not prejudice or affect the applicant's rights then existing under some other law or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's rights to registration on another application of later date, where the disclaimed matter has become distinctive of the applicant's goods, business or services.

Where the examiner determines that any portion of a mark contains unregistrable matter which must be disclaimed, he shall communicate his finding to the Applicant by means of an Action document. If the applicant fails to respond within the time allowed under these Rules, the finding of the examiner shall become final and the unregistrable matter shall be disclaimed. *[as amended by Office Order No. 39 (2002)]*

**Guidelines for Trademark Examination - Draft as of August , 2012**

Available from the IP authorities of the Philippines

## SINGAPORE

### Trade Marks Act [Cap. 332, 2005 Ed.]

#### Interpretation

2. —(1) In this Act, unless the context otherwise requires — [...]

“business identifier” means any sign capable of being represented graphically which is used to identify any business;

“certification mark” has the meaning assigned to it in section 61;

“collective mark” has the meaning assigned to it in section 60;  
[...]

“dilution”, in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is —

- (a) any competition between the proprietor of the trade mark and any other party; or
- (b) any likelihood of confusion on the part of the public;

“earlier trade mark” means —

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“geographical indication” has the same meaning as in section 2 of the Geographical Indications Act (Cap. 117B);  
[...]

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

[...]

"trade mark" means any **sign** capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

[...]

"well known trade mark" means —

- . (a) any registered trade mark that is well known in Singapore; or
- . (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
  - (i) is a national of a Convention country; or
  - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

[...]

### **Application for registration**

5.—(2) The application shall — [...]

(c) contain a clear representation of the trade mark; [...]

### **Absolute grounds for refusal of registration**

7.— (1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired

a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of —

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) A trade mark shall not be registered if it is —

- (a) contrary to public policy or to morality; or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(5) A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

(7) Notwithstanding subsection (2), a trade mark shall not be registered if it contains or consists of a geographical indication in respect of a wine or spirit and the trade mark is used or intended to be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.

(8) Subsection (7) shall apply whether or not the trade mark has, or is accompanied by, an indication of the true geographical origin of the wine or spirit, as the case may be, or an expression such as “kind”, “type”, “style”, “imitation” or the like, and irrespective of the language the geographical indication is expressed in that trade mark.

(9) A trade mark shall not be refused registration by virtue of subsection (7) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either —

- (a) before 15th January 1999; or
- (b) before the geographical indication in question is protected in its country of origin.

(10) A trade mark shall not be refused registration by virtue of subsection (7) if the geographical indication in question —

- (a) has ceased to be protected; or
- (b) has fallen into disuse,

in its country of origin.

(11) A trade mark shall not be registered in the cases specified in sections 56 and 57.

(12) The Minister may make rules to provide that a sign specified in the rules shall not be registered as a trade mark, or shall not be so registered unless such conditions as may be prescribed are met.

(13) A trade mark shall not be registered if or to the extent that the registration contravenes any rule made under subsection (12).

### **Relative grounds for refusal of registration**

**8.—** (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

[...]

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

(ii) if the earlier trade mark is well known to the public at large in Singapore —

(A) would cause dilution in an unfair manner of the distinctive character of

the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

(5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith.

(6) In deciding whether any such application was made in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier trade mark.

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

(8) A person entitled under subsection (7) to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(9) The Registrar may, in his discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

(10) The Registrar may, in his discretion, register any trade mark referred to in subsection (3), (4) or (7) where the proprietor of the earlier trade mark or other earlier right fails to give notice to the Registrar of opposition to the registration in accordance with section 13.

(11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no bona fide use of the mark during the 2 years immediately preceding the expiry.

### **Raising of relative grounds in case of honest concurrent use**

**9.—** (1) Where, on an application for the registration of a trade mark, it appears to the Registrar —

(a) that there is an earlier trade mark in relation to which the conditions set out in section 8(1), (2) or (3) apply; or

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use in the course of trade in Singapore of the trade mark for which registration is sought, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect —

(a) the refusal of registration on the grounds mentioned in section 7; or

(b) the making of an application for a declaration of invalidity under section 23(3).

### **Registration of series of trade marks**

**17.—** (1) A person may make a single application under section 5 for the registration of a series of trade marks.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non- distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act and the Registrar is required under section 15 to register the trade marks, he shall register them as a series in one registration.

### **Registration subject to disclaimer or limitation**

**30. —**(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.

(3) The Minister may make rules as to the publication and entry in the register of a disclaimer or limitation.

**National emblems, etc., of Convention countries: Article 6ter of Paris Convention, etc.**

**56.—** (1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without their authorisation.

**Emblems, etc., of certain international organisations: Article 6ter of Paris Convention, etc.**

**57.—** (1) This section shall apply to —

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed —

(a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use in the course of trade of the trade mark in Singapore without its authorisation.

(5) Nothing in this section shall affect the rights of a person whose *bona fide* use of the trade mark in question began before 23rd February 1995 (when the relevant provisions of the Paris Convention entered into force in relation to Singapore).

#### **Notification under Article 6~~ter~~ of Paris Convention, etc.**

**58.**— (1) For the purposes of section 56, state emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

(a) the country in question has notified Singapore in accordance with Article 6~~ter~~(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) Singapore has not objected to it in accordance with Article 6~~ter~~(4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of section 57, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that —

(a) the organisation in question has notified Singapore in accordance with

Article 6*ter*(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) Singapore has not objected to it in accordance with Article 6*ter*(4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6*ter*(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification.

[...]

### **Collective marks**

**60.—** (1) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

(2) The provisions of this Act shall apply to collective marks subject to the provisions of the First Schedule.

### **Certification marks**

**61.—** (1) A certification mark is a sign used, or intended to be used, to distinguish goods or services —

- . (a) dealt with or provided in the course of trade; and
- . (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified.

(2) The provision of this Act shall apply to certification marks subject to the provisions of the Second Schedule.

**FIRST SCHEDULE -- COLLECTIVE MARKS**

[...]

***Signs of which a collective mark may consist***

2. In relation to a collective mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association.

***Indication of geographical origin***

3.— (1) Notwithstanding section 7(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

***Mark not to be misleading as to character or significance***

4.— (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

***Regulations governing use of collective mark***

5.— (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

(3) Further requirements with which the regulations have to comply may be imposed by rules made under this Act.

***Approval of regulations by Registrar***

6.— (1) A collective mark shall not be registered unless the regulations governing the use of the mark —

(a) comply with paragraph 5(2) and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

[...]

**SECOND SCHEDULE -- CERTIFICATION MARKS**

[...]

***Signs of which a certification mark may consist***

2. In relation to a certification mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in section 61(1)(b) from those which are not so certified.

***Indication of geographical origin***

3.— (1) Notwithstanding section 7(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

***Nature of proprietor’s business***

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

***Mark not to be misleading as to character or significance***

5.— (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding section 14(3), an application may be amended so as to comply with any such requirement.

***Regulations governing use of certification mark***

6.— (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

[...]

***Approval of regulations, etc.***

7.— (1) A certification mark shall not be registered unless —

(a) the regulations governing the use of the mark —

(i) comply with paragraph 6(2) and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

[...]

**Trade Marks Rules 15th January 1999, revised 2008**

**Representation of President**

11.—The Registrar shall refuse to register a trade mark which consists of or contains any representation of the President or any colourable imitation thereof.

**Singapore Crest, Presidential Coat of Arms, Royal Arms, etc.**

12.— The Registrar shall refuse to register a trade mark which consists of or contains —

(a) any representation of the Crest of the Republic of Singapore, the Presidential Coat of Arms, the Royal or Imperial Arms, or of any crest, armorial

bearing, insignia, or device so nearly resembling any of the foregoing as to be likely to be mistaken for them;

(b) any representation of the Royal or Imperial crown, or of the Singapore flag, or of the Royal or Imperial flag;

(c) the word “Royal”, “Imperial”, “Presidential”, or “Singapore Government”, or any word, letter or device if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal, Imperial, Presidential or the Singapore Government’s patronage or authorisation, whether or not such be the case;

(d) the words “Red Cross” or “Geneva Cross”, any representation of the Geneva Cross or the Red Cross, any representation of the Swiss Federal cross in white on a red background or silver on a red background, or any representation similar to any of the foregoing; or

(e) the word “ANZAC”,

unless it appears to the Registrar that consent to its registration and use of the person or authority entitled to give consent has been obtained.

#### **Registration of mark consisting of arms, etc.**

**13.—** (1) Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate, government body, statutory board, institution or person appears on a trade mark which is the subject of an application for registration, the Registrar, before proceeding to register the mark, may require the applicant to furnish the Registrar with the consent to the registration and use of the matter in question of such official or other person as appears to the Registrar to be entitled to give consent.

(2) The Registrar shall refuse to register the mark if no such consent is furnished within the time specified by the Registrar.

#### **Persons living or recently dead**

**14.—** (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where the consent referred to in paragraph (1) is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the mark.

## **Geographical Indications Act (Chapter 117B) of 1999**

### **Interpretation**

**2.** In this Act, unless the context otherwise requires —  
[...]

“geographical indication” means any indication used in trade to identify goods as originating from a place, provided that —

(a) the place is a qualifying country or a region or locality in the qualifying country; and

(b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place;

“goods” means any natural or agricultural product or any product of handicraft or industry;

“interested party”, in relation to goods identified by a geographical indication, means a producer of the goods, a trader of the goods, or an association of such producers or traders or of such producers and traders;  
[...]

### **Interested party may bring action for certain uses of geographical indication**

**3.—** (1) Subject to the provisions of this Act, an interested party of goods identified by a geographical indication may bring an action against a person for carrying out an act to which this section applies in relation to the geographical indication.  
[...]

(2) This section shall apply to the following acts:

(a) the use of a geographical indication in relation to any goods which did not originate in the place indicated by the geographical indication, in a manner which misleads the public as to the geographical origin of the goods;

(b) any use of a geographical indication which constitutes an act of unfair competition within the meaning of [Article 10 bis](#) of the Paris Convention;  
[...]

(3) Any use of a geographical indication within the meaning of subsection (2)

shall be deemed to be an act to which this section applies even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another place.

(4) For the purposes of subsection (2), “use of a geographical indication” includes the use of a trade mark which contains or consists of the geographical indication in question.

### **Trade Mark Work Manual – 2012**

Available from the IP authorities of Singapore.

## THAILAND

### **Trademark Act B.E. 2534 (1991), as amended by Act (No. 2) B.E. 2543 (2000)**

4. In this Act: —

“mark” means a photograph, drawing, device, brand, name, word, letter, manual, signature, combinations of colors, shape or configuration of an object or any one or combination thereof;

“trademark” means a mark used or proposed to be used on or in connection with goods to distinguish the goods with which the trademark of the owner of such trademark is used from goods under another person’s trademark;

“service mark” means a mark used or proposed to be used on or in connection with services to distinguish the services using the service mark of the owner of such service mark from services under another person’s service mark;

“certification mark” means a mark used or proposed to be used by the owner thereof on or in connection with goods or services of another person to certify the origin, composition, method of production, quality or other characteristics of such goods or to certify as to the nature, quality, type or other characteristics of such services;

“collective mark” means a trademark or service mark used or proposed to be used by companies or enterprises of the same group or by members of an association, cooperative, union, confederation, group of persons or any other state or private organization;

[...]

5. The Minister of Commerce shall have the charge and control of the execution of this Act and shall have the power to appoint the Registrar and competent officers, issue ministerial regulations prescribing fees no higher than those given in the schedule annexed hereto and prescribing other matters and issue notifications in order to carry out the provisions of this Act.

6. To be registrable, a trademark must

- (1) be distinctive;
- (2) not be prohibited under this Act;
- (3) not be the same as or similar to a trademark registered by another person.

7. A distinctive trademark is one which enables the public or users to distinguish the goods with which the trademark is used from other goods.

A trademark having or consisting of any one of the following essential characteristics shall be deemed distinctive: —

- (1) a personal name, a surname not being such according to its ordinary signification, a name of juristic person or trade name represented in a special manner;
- (2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Minister in the Ministerial Notifications;
- (3) a combination of colors represented in a special manner, stylized letters, numerals or invented word;
- (4) the signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission;
- (5) a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;
- (6) an invented device.

Names and words not having the characteristics under (1) or (2) if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is proved that the rules have been duly met shall be deemed distinctive.

8. Trademarks having or consisting of any of the following characteristics shall not be registrable: —

- (1) state arms or crests, royal seals, official seals, Chakkri emblems, emblems and insignia of the royal orders and decorations, seals of office, seals of ministries, bureaus, departments or provinces;
- (2) national flags of Thailand, royal standard flags or official flags;
- (3) royal names, royal monograms, abbreviations of royal names or royal monograms, or
- (4) representations of the King, Queen or Heir to the Throne;
- (5) names, words, terms or emblems signifying the King, Queen or Heir to the Throne or members of the royal family;

(6) national emblems and flags of foreign states, emblems and flags of international organizations, emblems of head of foreign states, official emblems and quality control and certification of foreign states or international organizations, names and monograms of foreign states or international organizations, unless permission is given by the competent officer of the foreign state or international organization;

(7) official emblems and emblems of the Red Cross or appellations “Red Cross” or “Geneva Cross”;

(8) a mark identical with or similar to a medal, diploma or certificate or any other mark awarded at a trade exhibition or competition held by the Thai government or a Thai government agency for public enterprise or any other government organ of Thailand, a foreign government or international organization unless such medal, diploma, certificate or mark has been actually awarded to the applicant for goods and is used in combination with the trademark;

(9) any mark which is contrary to public order, morality or public policy;

(10) a mark registered or not, which is identical with a well-known mark as prescribed by the Ministerial Notifications, or so similar thereto that the public might be confused as to the owner or origin of the goods;

(11) trademarks similar to those under (1) (2) (3) (5) (6) or (7);

(12) geographical indications protected under the law on geographical indications;

(13) other trademarks prescribed by the Ministerial Notifications.

13. Subject to Section 27, where the Registrar finds that the trademark for which on application for registration is filed:

(1) is identical with a trademark already registered by another person; or

(2) is so similar to a registered trademark of another person that the public might be confused or misled as to the owner or origin of the goods, and such application is for goods of the same class or for goods of a different class found by the Registrar to be of the same character, he shall not register such trademark.

14. In the event registered or pending trademarks of the same owner covering goods of the same class or different classes but the same character so similar to one another that the public might be confused or misled as to the owner or origin of the goods of used by different persons, the Registrar shall require the trademarks to be registered as associated trademarks [...].

17. If, in the opinion of the Registrar, a trademark considered as a whole is registrable under Section 6 but contains one or more parts which are common to the trade for some types or classes of goods such that no applicant should have exclusive right thereto or which are not distinctive, the Registrar shall make either of the following:

(1) order the applicant, within ninety days from receipt of the order, to disclaim exclusive right to use of such part of the trademark;

(2) order the applicant, within ninety days from receipt of the order, to make such other disclaimer as the Registrar may consider necessary for the purpose of defining the rights of the owner under such registrations.

For the purpose of implementing the provisions of the first paragraph, the Registrar shall have the power to declare by notification what is common to the trade with respect to certain types or classes of goods.

[...]

46. No person shall be entitled to bring legal proceedings to prevent or to recover damages for the infringement of an unregistered trademark.

The provisions of this section shall not affect the right of the owner of an unregistered trademark to bring legal proceedings against any person for passing off goods as those of the owner of the trademark.

50. Associated trademarks may be assigned or transferred by succession only when all of them are assigned or transferred together.

82. The applicant for registration of a certification mark, in addition to complying with the provisions on registration of trademarks, shall:-

(1) submit the regulations on use of the certification mark together with the application for registration, and

(2) demonstrate an ability to certify the characteristics of the goods or services as provided in the regulations under (1).

The regulations under (1) shall indicate the origin, composition, method of production, quality or other characteristics which are to be certified including the rule, procedures and conditions for authorizing use of the certification mark.

83. The Registrar may require the applicant for registration of a certification mark to amend the regulations on use of the certification mark as he may think

fit within sixty days of the date of receipt of the order and shall in writing promptly notify the applicant of the order with the grounds therefor. [...]

84. If the Registrar is of the opinion that the applicant for registration of a certification mark does not have sufficient ability to certify the characteristics of the goods or services as provided in the regulations on use of the certification mark or that registration of the certification mark would not be in the public interest, the Registrar shall refuse registration and shall in writing promptly notify the applicant of the order with the grounds of the refuse. [...]

94. Except for the provisions of Chapter I, Part 5, the provisions concerning trademarks shall apply to collective marks *mutatis mutandis*.

**Notification of the Ministry of Commerce, 20 September, 2004,  
Prescribing Geographical Names under Section 7(2) of the  
Trademark Act**

[...]

2. The following geographical names shall be held to be geographical names under Section 7(2) of the Trademark Act of 1991:

1. Names of countries, including those of independent zones which have the same characteristics as those of countries, names of country groups that are widely known or regional names.
2. Names of states, regions or counties.
3. Names of capitals, ports or local administrative zones.
4. Names of continents or sub-continents.
5. Names of oceans, seas, gulfs, peninsulas, capes, islands, archipelagos or lakes.
6. Other geographical names, such as names of ports, provinces, districts, sub-districts, countries, islands, hills and mountains, rivers, seas or lakes which are known by public in general.

The above geographical names shall also mean their abbreviations and the words by which they are generally called, without being restricted to only the governmental names.

[...]

**Notification of Ministry of Commerce of 11 October 2012 prescribing regulations for demonstration of distinctive character according to Section 7(3) of the Trademark Act**

[...]

**Clause 2.** Demonstration of distinctive character by distribution, dissemination, or advertisement of the goods or services using a trademark, service mark, certification mark, and collective trademark until widely recognized according to Section 7, paragraph 3 of the Trademark Act B.E. 2534, amended in the Trademark Act (No.2) B.E. 2543, will comprise of the following criteria:

(1) The goods or services using the trademark has been distributed, disseminated, or advertised continuously for an appropriate length of time to the point that the general public or public in a specific sector in Thailand has widely recognized or understood that such good or service is different from other goods or services.

(2) The distribution, dissemination, or advertisement of such product or service to the point that the trademark has been widely recognized in Thailand, such trademark shall be deemed having distinctive characters only with such product or services.

(3) A trademark to be demonstrated for distinctive characters according to this Declaration shall be the same trademark as the one submitted for registration.

**Clause 3.** For demonstration according to Clause 2, the applicant for registration shall submit evidence of distribution, dissemination, or advertisement of such product or service using such trademark being applied for registration such as copies of product purchase receipts, copies of advertisement receipts, copies of invoices, copies of purchase orders, copies of licenses, plant establishment, copies of evidence of advertisements in various media, product samples, or other evidence, including witnesses (if any), etc.

[...]

## VIET NAM

### Law on Intellectual Property, No. 50/2005/QH11, amended and supplemented by Resolution No. 51/2001/QH10 of December 25, 2001 and amended by Law No. 36/2009/QH12 of 2009

**Article 4.-** Interpretation of terms In this Law, the following terms shall be construed as follows:

[...]

16. *Mark* means any sign used to distinguish goods and/or services of different organizations or individuals.

17. *Collective mark* means a mark used to distinguish goods or services of members from those of non-members of an organization which is the owner of such mark.

18. *Certification mark* means a mark which is authorized by its owner to be used by another organization or individual on the latter's goods and/or services, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods or services bearing the mark.

19. *Integrated mark* means identical or similar marks registered by the same entity and intended for use on products or services which are of the same type or similar types or interrelated.

20. *Well-known mark* means a mark widely known by consumers throughout the Vietnamese territory.

21. *Trade name* means a designation of an organization or individual in business activities, capable of distinguishing the business entity bearing it from another entity in the same business domain and area.

A business area mentioned in this clause means a geographical area where a business entity has its partners, customers or earns its reputation.

22. *Geographical indication* means a sign which identifies a product as originating from a specific region, locality, territory or country.

[...]

**Article 6.-** Bases for the emergence and establishment of intellectual property rights

[...]

3. Industrial property rights are established as follows:

a/ Industrial property rights to an invention, industrial design, layout-design, mark or geographical indication shall be established on the basis of a decision

of the competent state agency on the grant of a protection title according to the registration procedures stipulated in this Law or the recognition of international registration under treaties to which the Socialist Republic of Vietnam is a contracting party; for a well-known mark, industrial property rights shall be established on the basis of use process, not subject to any registration procedures.

b/ Industrial property rights to a trade name shall be established on the basis of lawful use thereof;  
[...]

**Article 8.-** The State's intellectual property policies

1. To recognize and protect intellectual property rights of organizations and individuals on the basis of harmonizing benefits of intellectual property rights holders and public interests; not to protect intellectual property objects which are contrary to social ethics and public order and prejudicial to defense and security.  
[...]

**Article 72.-** General conditions for marks eligible for protection

A mark shall be protected when it satisfies the following conditions:

1. Being a visible sign in the form of letters, words, drawings or images, including holograms, or a combination thereof, represented in one or more colors;
2. Being capable of distinguishing goods or services of the mark owner from those of other subjects.

**Article 73.-** Signs not protected as marks

The following signs shall not be protected as marks:

1. Signs identical with or confusingly similar to national flags or national emblems;
2. Signs identical with or confusingly similar to emblems, flags, armorial bearings, abbreviated names or full names of Vietnamese state agencies, political organizations, socio-political organizations, socio-political-professional organizations, social organizations or socio-professional organizations or international organizations, unless permitted by such agencies or organizations;
3. Signs identical with or confusingly similar to real names, alias, pseudonyms or images of leaders, national heroes or famous personalities of Vietnam or foreign countries;

4. Signs identical with or confusingly similar to certification seals, check seals or warranty seals of international organizations which require that their signs must not be used, unless such seals are registered as certification marks by those organizations;

5. Signs which cause misleading or confusion or deceive consumers as to the origin, properties, intended utilities, quality, value or other characteristics of goods or services.

**Article 74.- Distinctiveness of marks**

1. A mark shall be considered distinctive if it consists of one or several easily noticeable and memorable elements, or of many elements forming an easily noticeable and memorable combination, and does not fall into the cases specified in Clause 2 of this Article.

2. A mark shall be considered as indistinctive if it is a sign or signs falling into one of the following cases:

a/ Simple shapes and geometric figures, numerals, letters or scripts of uncommon languages, except where such signs have been widely used and recognized as a mark;

b/ Conventional signs or symbols, pictures or common names in any language of goods or services that have been widely and regularly used and known to many people;

c/ Signs indicating time, place and method of production, category, quantity, quality, properties, ingredients, intended utility, value or other characteristics, which is descriptive of goods or services, except where such signs have acquired distinctiveness through use before the filing of mark registration applications;

d/ Signs describing the legal status and business field of business entities;

e/ Signs indicating the geographical origin of goods or services, except where such signs have been widely used and recognized as a mark or registered as collective marks or certification marks as provided for in this Law;

f/ Signs other than integrated marks which are identical with or confusingly similar to registered marks of identical or similar goods or services on the basis of registration applications with earlier filing dates or priority dates, as applicable, including mark registration applications filed under treaties to which the Socialist Republic of Vietnam is a contracting party;

g/ Signs identical with or confusingly similar to another person's mark which has been widely used and recognized for similar or identical goods or services before the filing date or the priority date, as applicable;

h/ Signs identical with or confusingly similar to another person's mark which has been registered for identical or similar goods or services, the registration certificate of which has been invalidated for no more than 5 years, except where the ground for such invalidation is non-use of the mark according to Point d, Clause 1, Article 95 of this Law;

i/ Signs identical with or confusingly similar to another person's mark recognized as a well-known mark which has been registered for goods or services which are identical with or similar to those bearing such well-known mark, or for dissimilar goods or services if the use of such mark may affect the distinctiveness of the well-known mark or the mark registration is aimed at taking advantage of the reputation of the well-known mark;

j/ Signs identical with or similar to another person's trade name currently in use if the use of such signs may cause confusion to consumers as to the origin of goods or services;

k/ Signs identical with or similar to a geographical indication being protected if the use of such signs may mislead consumers as to the geographical origin of goods;

l/ Signs identical with, containing or being translated or transcribed from geographical indications being protected for wines or spirits if such signs have been registered for use with respect to wines and spirits not originating from the geographical areas bearing such geographical indications;

m/ Signs identical with or insignificantly different from another person's industrial design which has been protected on the basis of an industrial design registration application with the filing date or priority date earlier than that of the mark registration application.

**Article 75.-** Criteria for evaluation of well-known marks

The following criteria shall be taken into account when a mark is considered well-known:

1. The number of involved consumers who have been aware of the mark through purchase or use of goods or services bearing the mark or through advertising;
2. Territorial area in which goods or services bearing the mark are circulated;
3. Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
4. Duration of continuous use of the mark;
5. Wide reputation of goods or services bearing the mark;

6. Number of countries protecting the mark;
7. Number of countries recognizing the mark as a well-known mark;
8. Assignment price, licensing price, or investment capital contribution value of the mark.

**Article 76.-** General conditions for trade names eligible for protection

A trade name shall be protected when it is capable of distinguishing the business entity bearing it from other business entities operating in the same business field and locality.

**Article 77.-** Subject matters not protected as trade names

Names of state agencies, political organizations, socio-political organizations, socio-political- professional organizations, social organizations, socio-professional organizations or other entities that are not involved in business activities shall not be protected as trade names.

**Article 78.-** Distinctiveness of trade names

A trade name shall be considered distinctive when it satisfies the following conditions:

1. Consisting of a proper name, except where it has been widely known through use;
2. Being not identical with or confusingly similar to a trade name having been used earlier by another person in the same business field and locality;
3. Being not identical with or confusingly similar to another person's mark or a geographical indication having been protected before the date it is used.

**Article 79.-** General conditions for geographical indications eligible for protection

A geographical indication shall be protected when it satisfies the following conditions:

1. The product bearing the geographical indication originates from the area, locality, territory or country corresponding to such geographical indication;
2. The product bearing the geographical indication has a reputation, quality or characteristics mainly attributable to geographical conditions of the area, locality, territory or country corresponding to such geographical indication.

**Article 80.-** Subject matters not protected as geographical indications

The following subject matters shall not be protected as geographical indications:

1. Names or indications which have become generic names of goods in Vietnam;
2. Geographical indications of foreign countries where they are not or no longer protected or no longer used;
3. Geographical indications identical with or similar to a protected mark, where the use of such geographical indications is likely to cause a confusion as to the origin of products;
4. Geographical indications which mislead consumers as to the true geographical origin of products bearing such geographical indications.

**Article 81.-** Reputation, quality and characteristics of products bearing geographical indications

1. Reputation of products bearing a geographical indication shall be determined on the basis of consumers' trust in such products through the extent of their being widely known to and selected by consumers.
2. Quality and characteristics of products bearing a geographical indication shall be defined by one or several qualitative, quantitative or physically, chemically, microbiologically perceptible criteria which can be tested by technical means or experts with appropriate testing methods.

**Article 87.-** Right to register marks

[...]

3. Lawfully established collective organizations may register collective marks to be used by their members under regulations on use of collective marks. For signs indicating geographical origins of goods or services, organizations that may register them are collective organizations of organizations or individuals engaged in production or trading in relevant localities. For other geographical names or signs indicating geographical origins of local specialties of Vietnam, the registration must be permitted by competent state agencies.
4. Organizations with the function of controlling and certifying the quality, properties, origin or other relevant criteria of goods or services may register certification marks, provided that they are not engaged in the production or trading of these goods or services. For other geographical names or signs indicating geographical origins of local specialties of Vietnam, the registration

thereof must be permitted by a competent state agency.

[...]

**Article 90.-** The first-to-file principle

[...]

2. In case there are many applications filed by different persons for registration of identical or confusingly similar marks for identical or similar products or services, or in case there are many applications filed by the same person for registration of identical marks for identical products or services, the protection title may only be granted for the mark in the valid application with the earliest priority or filing date among applications satisfying all the conditions for the grant of a protection title.

[...]

**Article 105.-** Requirements on mark registration applications

1. Documents, samples, information identifying a mark registered for protection in a mark registration application include:

a/ A sample of the mark and a list of goods or services bearing the mark;

b/ Regulation on use of collective marks or regulation on use of certification marks.

2. The sample of the mark must be described in order to clarify elements of the mark and the comprehensive meaning of the mark, if any; where the mark consists of words or phrases of hieroglyphic languages, such words or phrases must be transcribed; where the mark consists of words or phrases in foreign languages, such words or phrases must be translated into Vietnamese.

[...]

4. The regulation on use of collective marks consists of the following principal contents:

a/ Name, address, grounds of establishment and operations of the collective organization being the owner of the mark;

b/ Criteria for becoming a member of the collective organization;

c/ List of organizations and individuals permitted to use the mark;

d/ Conditions for use of the mark;

e/ Measures for handling acts violating the regulation on use of marks.

5. The regulation on use of certification marks consists of the following principal contents:

- a/ The organization or individual being the mark owner;
- b/ Conditions for using the mark;
- c/ Characteristics of goods or services certified by the mark;
- d/ Methods of evaluating characteristics of goods or services and methods of controlling the use of the mark;
- e/ Expenses to be paid by the mark user for the certification and protection of the mark, if any.

**Article 163.-** Denominations of plant varieties

[...]

3. Denominations of plant varieties shall be deemed improper in the following cases:

[...]

- e/ They are identical or confusingly similar to marks, trade names or geographical indications protected before the date of publication of protection registration applications of such plant varieties;

[...]

5. When denominations of plant varieties are combined with trademarks, trade names or indications similar to denominations of plant varieties already registered for sale offer or marketed, such denominations must still be distinguishable.

**Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property**

Article 6.- Bases and procedures for the establishment of industrial property rights

1. Industrial property rights to inventions, layout designs, industrial designs, marks and geographical indications are established on the basis of decisions of the state management agency in charge of industrial property which grants protection titles to applicants for registration of those objects according to the provisions of Chapters VII, VIII and IX of the Law on Intellectual Property. Industrial property rights to marks internationally registered under the Madrid Agreement and the Madrid Protocol are established on the basis of recognition of such international registration by the state management agency.

2. Industrial property rights to well-known marks are established on the basis of widespread use of those marks according to the provisions of Article 75 of the Law on Intellectual Property, not requiring the completion of registration procedures.

3. Industrial property rights to trade names are established on the basis of lawful use of those names according to geographical areas (territories) and business domains, not requiring the completion of registration procedures.

[...]

**Circular No. 01/2007/TT-BKHCHN Of February 14, 2007, Guiding the Implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, Detailing and Guiding the Implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property**

1. Grounds for establishment of industrial property rights

[...]

1.2 Industrial property rights to inventions, layout designs of semi-conductor integrated circuits (hereinafter referred to as layout designs), industrial designs and marks shall be established under decisions of the National Office of Intellectual Property (NOIP) on the grant of protection titles to persons that register those objects. [...]

1.3 Industrial property rights to geographical indications shall be established under decisions of the NOIP on the grant of certificates of registered geographical indications to organizations managing those geographical indications

[...]

1.5 Industrial property rights to well-known marks shall be established on the basis of their actual public use that has made them well known, and for those marks the registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over a well-known mark, its proprietor shall evidence his/her/its rights with appropriate proofs specified in Article 75 of the Intellectual Property Law.

1.6 Industrial property rights to trade names shall be established on the basis of the lawful use of those trade names, and for those trade names the procedures for registration with the NOIP is not required. While exercising the rights to and upon the settlement of a dispute over, a trade name, the entity owning that trade name shall evidence his/her/its rights with proofs indicating the period of time, territory and field in which the trade name has been used by that entity.

[...]

## 15. Substantive examination of applications

[...]

### 15.6. Examination contents

[...]

b/ The assessment of the object based on the protection conditions shall be conducted for objects one after another (if the application contains many and still ensures the uniformity). For each object, the assessment shall be conducted based on each specific protection condition:

[...]

(iii) For a mark registration application, the assessment shall be conducted with regard to each component of the mark for each goods or service on the list of goods and services.

[...]

## 37. Requirements for mark registration applications

[...]

37.3 If doubting about the truthfulness of information supplied in an application, the NOIP may request the applicant to submit within one month the following documents in order to certify such information:

[...]

c/ Documents evidencing the right to use/register a mark containing special symbols, for:

(i) Names, emblems, flags or armorial bearings of domestic or international agencies and organizations or certification, control or warranty hallmarks of international organizations as defined in Clauses 2 and 4, Article 73 of the Intellectual Property Law;

(ii) Names of characters or figures in publicly known works under copyright protection or trade names, trade indications, origin indications, prizes, medals or particular signs of a type of product, which may cause confusion, as defined in Clause 5, Article 73 of the Intellectual Property Law;

(iii) Signs covered by the protection of industrial property rights of other persons as defined at Point m, Clause 2, Article 74 of the Intellectual Property Law;

[...]

### 37.4. Requirements for written declarations

An applicant shall submit two written declarations, made according to a set form (not printed herein), with the following attentions:

a/ The section of mark description in the application must clearly indicate the type of mark sought to be registered (common mark, collective mark, association mark, certification mark);

b/ If the mark sought to be registered is an association mark, the applicant shall clearly indicate associated elements being marks or goods or services according to the following provisions:

(i) If associated elements are marks (similar to another mark of the very applicant used for the same goods or service or used for similar goods or services), the applicant shall clearly indicate a mark considered substantial among those association marks (if any). If one or several of those marks have been registered or stated in the previously filed applications, the applicant shall clearly indicate the serial numbers of the protection titles and the previously filed applications.

(ii) If associated elements are goods or services (a mark used for similar or interrelated goods or services), the applicant shall clearly indicate a goods or service considered substantial among those goods or services (if any). If one of those goods or services has been previously registered or stated in a previously filed application, the applicant shall clearly indicate the serial numbers of the protection title and previously filed application.

(iii) If the applicant fails to clearly indicate a substantial mark or a substantial goods or service, then all marks and all goods or services related to the mark stated in his/her application shall be considered independent from one another. The assessment of distinctiveness of the mark stated in the application may not exceptionally apply to association marks defined at Point e, Clause 2, Article 74 of the Intellectual Property Law, but must comply with general provisions on assessment of distinctiveness of Point 39 of this Circular.

c/ For a certification mark, the applicant shall clearly indicate in the written declaration the certification purpose, content and method (certify what: certification of quality, origin, geographical origin or combination thereof; certification content: specific conditions on the entity, goods or services; how to certify: order and procedures for grant of certification licenses, method of inspection and maintenance of the certification purpose and content).

[...]

### 37.6. Requirements for regulations on use of collective marks and certification marks

A regulation on use of a collective mark and a regulation on use of a certification mark must have relevant contents specified in Clauses 4 and 5, Article 105 of the Intellectual Property Law and clarify the following matters:

a/ Brief information on the mark, the mark proprietor and goods and services bearing the mark;

b/ Conditions for the mark registrant to license the mark and conditions for termination of the right to use the mark;

c/ Obligations of the mark user (assuring the particular quality and characteristics of a goods or service bearing the mark, submitting to the control of the mark registrant, paying the mark management charge, etc.);

d/ Rights of the mark registrant (controlling compliance with the regulation on use of the mark, collecting the mark management charge, suspending the mark use right of a person who fails to satisfy the conditions specified in the mark use regulation, etc.);

e/ Mechanism of licensing, control and inspection of use of the mark and assurance of the quality and reputation of goods and services bearing the mark);

f/ Dispute settlement mechanism.  
[...]

### 37.7. Requirements on documents certifying the permission for registration and use of marks certifying geographical origins

a/ For a mark certifying a geographical origin, in addition to the mark use regulation and necessary documents evidencing the right of mark registration, the application must also be enclosed with the local administration's permission for the applicant to register a certification mark containing signs indicating a geographical origin (geographical name, symbol or map of the area or locality) for goods and services bearing the mark.  
[...]

### 39. Substantive examination of mark registration applications [...]

#### 39.2 Assessment of conformity of objects stated in mark registration applications with requests for grant of certificates of registered marks

a/ According to the provisions of Clause 1, Article 72 of the Intellectual Property Law, signs eligible for being registered as marks must be visible ones in the form of letters, numerals, words, pictures, images, including three-dimensional images or their combinations, presented in one or several given colors.

b/ The following types of sign shall not be protected as marks:

(i) Signs that are merely colors and neither combined with character signs or figure signs nor presented in the form of character signs or figure signs;

(ii) Signs pertaining to objects not protectable as marks according to the provisions of Article 73 of the Intellectual Property Law;

(iii) Signs that are contrary to the public order or prejudicial to national security.

39.3. Assessment of distinctiveness of signs in the form of letters or numerals (hereinafter referred to as character signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law.

Except for the exceptions specified at Point 39.5 of this Circular, the following character signs shall be considered indistinctive:

a/ Characters of languages that are imperceptible and unmemorable to the common knowledge of Vietnamese consumers (unreadable, incomprehensible and unmemorable), such as characters not of Latin origin: Arabic, Slavonic, Sanskrit, Chinese, Japanese, Korean or Thai characters, etc.; except when characters of these languages combine with other components to formulate a distinctive whole or are presented in a graphic form or other special forms;

b/ A Latin-origin character that consists of only one letter or consists of numerals only, or consists of two letters which cannot be pronounced as a word, even if it is accompanied with numerals, except when it is presented in a graphic form or other special forms;

c/ A combination of too many letters or words that is imperceptible and unmemorable, such as a sequence of too many characters not arranged according to a given order or rule, or a text or a paragraph;

d/ A Latin-origin character that is a meaningful word, the meaning of which has been so frequently and widely used in a relevant field in Vietnam that it loses its distinctiveness;

e/ A word or phrase that is used in Vietnam as the common name of the very related goods or service;

f/ A word or phrase that describes the very goods or service bearing the mark, such as a sign indicating time, location, geographical origin (except when the registered mark is a mark certifying the geographical origin of a goods or a collective mark), method of manufacture, type, quantity, quality and characteristics (except when the registered mark is a mark certifying the quality of a goods or service), composition, utility and value of a goods or service;

g/ A word or phrase that is liable to describe the legal status or business lines of the mark proprietor;

h/ A character sign that is identical or similar to any of objects covered by the protection of industrial property rights of other persons according to the provisions of Points e, f, g, h, i, j and k, Clause 2, Article 74 of the Intellectual Property Law;

i/ Character signs that cause misunderstanding or confusion or mislead consumers as to the origin, utility, quality, value or other characteristics such as ingredients, process of manufacture, materials or superiority of a goods or service according to the provisions of Clause 5, Article 73 of the Intellectual Property Law;

j/ Character signs that are identical or confusingly similar to real names, alias or pseudonyms of leaders, national heroes or personalities of Vietnam or foreign countries; identical or confusingly similar to names of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.4. Assessment of distinctiveness of signs in the form of pictures or images (hereinafter referred to as figure signs) according to the provisions of Clause 2, Article 74 of the Intellectual Property Law

Except for the exceptions specified at Point 39.5 of this Circular, a figure sign shall be considered indistinctive if:

a/ It is a common figure or geometric figure, such as round, ellipse, triangle, quadrangle, etc., or a simple drawing; a picture or image used merely as a background or ornamental pattern of a product or a product package;

b/ It is a picture or image that is too tangled or complicated for consumers to easily perceive and memorize its details, i.e. a sign that consists of too many combined or overlapped images or lines;

c/ It is a widely used picture, image, emblem or symbol;

d/ It is a picture or image liable to describe the very goods or service bearing the mark; location and method of manufacture, geographical origin, type, quantity, quality, properties, composition, utility, value or other characteristics of the goods or service bearing the mark;

e/ It is identical to or not substantially distinguishable from protected industrial designs of other persons;

f/ It is identical or confusingly similar to images of leaders, national heroes or personalities of Vietnam or foreign countries; identical or confusingly similar to images of characters or figures in other persons' widely known works under copyright protection, unless it is so permitted by the owners of those works.

39.5. The following exceptions shall apply upon assessment of distinctiveness of character signs or figure signs:

a/ A sign that falls into the cases specified at Points 39.3.a, b, c, f and g and Points 39.4.a, b, c, d and e of this Circular has been used as a mark and widely known to consumers and that mark therefore become distinguishable from relevant goods and services.

b/ To be subject to the application of this exception, the applicant shall furnish evidence of the wide use of that mark (the time of beginning of the use, present scope and level of use, etc., in which, the mark shall be considered "in use" when the use is made in lawful production, business, commercial, advertising or marketing activities) and evidence of the mark's distinctiveness from the mark proprietor's relevant goods and services. In this case, that mark shall be recognized distinctive if it is presented in the form in which it has been uninterruptedly and widely used in the reality.

#### 39.6. Assessment of distinctiveness of signs being combinations of character signs and figure signs (hereinafter referred to a combined signs)

A combined sign shall be considered distinctive when a character sign combines with a figure sign in a distinctive whole, specifically as follows:

a/ The character sign and the figure sign are all distinctive and combined into a distinctive whole;

b/ The strong component of the mark (the element that has a strong effect on the senses of consumers, attracts their attention to and gives an impression of the mark) is a distinctive character sign or figure sign, while other components are indistinctive or insignificantly distinctive.

c/ If the combined sign consists of indistinctive or insignificantly distinctive character signs and figure signs, but a unique combination of those signs gives a particular impression, that combined whole is still considered distinctive;

d/ The combined sign consists of indistinctive or insignificantly distinctive character and figure components but that combined whole has become distinctive through the use according to the provisions of Point 39.5 of this Circular.

#### 39.7. Minimum information source

a/ To assess the ability of a sign stated in an application to cause confusion, the NOIP shall conduct the search in the following minimum information source:

(i) Mark registration applications filed with the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination and mark registration international applications designating Vietnam notified by the WIPO to the NOIP with filing dates or dates of priority earlier than the filing date or date of priority of the application currently under examination for identical or similar goods and services;

(ii) Marks already registered or recognized for protection still effective in Vietnam (including well-known marks), for identical, similar or relevant goods and services;

(iii) Registered marks that have ceased to be valid for more than five years, except for those invalidated for non-use defined at Point d, Clause 1, Article 95 of the Intellectual Property Law, for identical or similar goods and services;

(iv) Geographical indications currently protected in Vietnam;

(v) Indications to the geographical origin of goods and services; geographical names, quality or control hallmarks; national flags and emblems of nations; flags, names and emblems of Vietnamese and international agencies and organizations; names and images of leaders, national heroes, names and images of personalities of Vietnam and foreign countries, etc., collected and stored by the NOIP.

b/ When necessary, the search may be conducted in reference information sources other than the minimum information source defined at Point 39.7.a above, such as industrial design registration applications, trade names, etc.

39.8. Assessment of confusing similarity of signs sought to be registered to other marks

a/ To assess whether or not a sign sought to be registered and stated in an application is identical or confusingly similar to another mark (hereinafter referred to as control mark), it is necessary to compare the disposition, content and pronunciation (for character signs), significance and form of expression of the sign (for character signs and figure signs), and concurrently compare the goods and services bearing the sign with those bearing the control mark defined at this Point.

b/ Signs identical to control marks: A sign shall be considered identical to a control mark if it resembles the control mark in terms of disposition, content, significance and form of expression.

c/ A sign considered confusingly similar to a control mark if:

(i) It is similar to the control mark in terms of disposition or/and content or/and pronunciation or/and significance or/and form of expression in such a way that makes consumers misjudge these two objects as one or an object as a variation of the other or these two objects of the same origin;

(ii) It is merely a transliteration or translation of the control mark, in case the control mark is a well-known mark.

39.9. Assessment of similarity of goods and services

a/ Two goods or two services shall be considered identical (of the same type) if these two goods or services have the following characteristics:

(i) They have the same nature (composition, ingredients) and the same function and utility; or

(ii) They have similar natures and the same function and utility.

b/ Two goods or two services shall be considered similar if these two goods or services have the following characteristics:

(i) They are similar in nature; or

(ii) They are similar in function or utility; and

(iii) They are marketed in the same commercial channel (they are distributed by the same mode, or sold together or compete with each other in the same type of shop);

c/ A goods and a service shall be considered similar if they fall into one or several of the following cases:

(i) They have a correlation in nature (a goods or service or a material or component of a goods or service forms constitutes part of the other); or

(ii) They have a correlation in function (to accomplish the function of a goods or service, it is necessary to use the other, or they are usually used together); or

(iii) They have a close correlation in method of realization (a goods or service is the result of the use or exploitation of the other); or

#### 39.10. Inspection of the first-to-file rule

Before issuing decisions on the grant of certificates of registered marks, the NOIP shall inspect the observance of the first-to-file rule defined in Article 90 of the Intellectual Property Law.

#### 39.11. Conclusion on the ability of signs to be confused with control marks

A sign shall be considered identical or confusingly similar to a control mark used for identical or similar or relevant goods in the following cases:

(i) It is identical to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark;

(ii) It is identical to the control mark and goods and services bearing it are identical to goods and services bearing the control mark of the same mark proprietor;

(iii) It is confusingly similar to the control mark and goods and services bearing it are identical or similar to goods and services bearing the control mark, except when the similarity of goods and services and the similarity of signs are unable to cause confusion when similar signs are used;

(iv) It is identical or similar to the control mark being a well-known mark and goods and services bearing it are neither identical nor similar to goods and services bearing the mark, but its use as a mark may make consumers believe that there exists a relationship between goods and services bearing it and the proprietor of the well-known mark and make it possible to reduce the distinctiveness or damage the reputation of the well-known mark.

#### 39.12. Assessment of the ability of signs to cause other confusions

The assessment of the ability of signs to cause other confusions shall comply with the provisions of Article 73 and Clause 2, Article 74 of the Intellectual Property Law and the following specific provisions.

a/ A sign shall be considered having caused confusion of origin of goods or services in the following cases:

(i) It is identical or similar to the name or emblem of a nation or territory (national flag, national emblem, name of the nation or a locality) or confusingly similar to the name or emblem of a nation or territory, causing a mislead that goods or services bearing the mark originate from that nation or territory;

(ii) It is identical or similar to a protected geographical indication, in case its use may mislead consumers as to the geographical origin of goods; it is identical to a geographical indication or contains a geographical indication or is translated or inscribed from a geographical indication protected for a wine or spirit, in case the sign sought to be registered as a mark for a wine or spirit does not originate in the geographical area subject to that geographical indication;

(iii) It is a word identical or similar to the trade name of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are manufactured or provided by the person having above trade name; it is an image identical or similar to the commercial logo of another person, which has been lawfully used for the same type of goods or service, and able to make consumers believe that goods or services bearing it are manufactured or provided by the person having the above commercial logo;

(iv) It is identical or similar to real names, alias, pseudonyms or images of leaders, national heroes or personalities of Vietnam or foreign countries; it is identical or similar to names or images of typical human characters or figures in widely known works, in case its use can make consumers believe that goods or services bearing it are manufactured or provided by owners of those works;

(v) It is identical to or not substantially distinguishable from industrial designs of other persons protected on the basis of industrial design registration applications with filing dates or dates of priority earlier than the filing date or date of priority of the mark registration application.

b/ In the following cases, a sign shall be considered able to cause confusion or mislead to the nature and value of goods and services:

(i) The sign is a word, picture, image or symbol that gives a misleading impression of properties or utilities of a goods or service, i.e., a sign identical or similar to a mark or another sign used so widely that it has been regarded as being associated with a function or utility of a given type of goods or service and thereby making consumers believe that goods and services bearing the sign also have such function or utility;

(ii) The sign is a word or image that gives a misleading impression of composition or ingredients of a goods or service, i.e., a description of another goods or service relevant to the goods or service bearing the sign gives a misleading impression that the goods or service bearing the sign is composed of or has the same nature as the described goods or service.

## 42. Recognition of well-known marks

42.1 Well-known marks are protected by Vietnamese law in accordance with the provisions of Article 75 of the Intellectual Property Law and Article 6*bis* of the Paris Convention for the Protection of Industrial Property.

42.2 Rights to well known marks are protected and belong to proprietors of those marks without any registration procedures. Mark proprietors may use documents specified at Point 42.3 of this Circular to evidence their ownership of marks and prove that their marks satisfy the conditions for being considered well-known.

42.3 Documents evidencing the ownership and reputation of a mark include information on the scope, scale, level and continuity of the use of the mark, including an explanation of origin, history and time of continuous use of the mark; number of nations in which the mark has been registered or recognized as a well-known mark; list of goods and services bearing the mark; the territorial area in which the mark is circulated, turnover from products sold or services provided; quantity of goods and services bearing the mark manufactured or sold; property value of the mark, price of assignment or licensing of the mark and value of investment capital contributed in the form of the mark; investment in and expenses for advertising and marketing of the mark, including those for participation in national and international exhibitions; infringements, disputes and decisions or rulings of the court or competent agencies; surveyed number of consumers knowing the mark through sale, purchase, use, advertisement and marketing; rating and evaluation of reputation of the mark by national or international organizations or the mass media; prizes and medals awarded on the mark; results of examinations held by intellectual property examination organizations.

42.4 If a well-known mark is recognized according to civil procedures or under a recognition decision of the NOIP, that well-known mark shall be recorded in the list of well-known marks kept at the NOIP.

[Annex II follows]

## ANNEX II

### WEBSITES OF LEGAL PROVISIONS RELEVANT TO THE SUBSTANTIVE EXAMINATION OF MARKS

#### **Brunei Darussalam**

<http://www.bruipo.com.bn>

<http://www.brunei-patents.com.bn/index.php/information/lagislation/trademarks>

#### **Cambodia**

[www.cambodiadip.gov.kh](http://www.cambodiadip.gov.kh)

[www.moc.gov.kh](http://www.moc.gov.kh)

<http://www.cambodiaip.gov.kh/TemplateTwo.aspx?parentId=43&menuId=43&childMasterMenuId=43>

#### **Indonesia**

<http://www.dgip.go.id/merek>

#### **Laos**

<http://www.stea.la.wipo.net/law/index.html>

#### **Malaysia**

<http://www.myipo.gov.my/web/guest/cap-umum>

- General Information on Trade Mark

<http://www.myipo.gov.my/web/guest/cap-akta>

- Trade Marks Act and Regulations

<http://www.myipo.gov.my/cap-panduan>

- Manual of Trade Marks Law and Practice in Malaysia

## **Myanmar**

[http://www.most.gov.mm/index.php?option=com\\_frontpage&Itemid=1](http://www.most.gov.mm/index.php?option=com_frontpage&Itemid=1)

## **Philippines**

<http://www.ipophil.gov.ph/images/IPResources/IPCodePartIII.pdf>

- Trademark Law

<http://www.ipophil.gov.ph/index.php/trademark/laws-and-irrs>

- Trademark Regulations

<http://www.ipophil.gov.ph/index.php/trademark>

- Trademark Information

## **Singapore**

<http://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>

## **Thailand**

[http://www.ipthailand.go.th/en/index.php?option=com\\_content&view=article&id=53&Itemid=169](http://www.ipthailand.go.th/en/index.php?option=com_content&view=article&id=53&Itemid=169)

[http://www.ipthailand.go.th/en/index.php?option=com\\_docman&task=cat\\_view&qid=114&Itemid=169](http://www.ipthailand.go.th/en/index.php?option=com_docman&task=cat_view&qid=114&Itemid=169)

## **Vietnam**

<http://www.noip.gov.vn/web/noip/home/en>

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agntDisplayContent\)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agntDisplayContent)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB)

-- IP Laws

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agntDisplayContent\)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agntDisplayContent)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627)

-- IP Governmental Decrees

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agntDisplayContent\)?OpenAgent&UNID=D2945788E58A233F4725767200221575](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agntDisplayContent)?OpenAgent&UNID=D2945788E58A233F4725767200221575)

-- IP Ministerial Circulars

----- 0 -----