



Product Configuration Trademark Protection in China

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Laws and Regulations on product configuration protection in China

Patent Law

Article 2 The “inventions” as used in this Law means inventions, utility models and designs.

The term “invention” refers to any new technical solution relating to a product, a process or an improvement thereof.

The term “utility model” refers to any new technical solution relating to a product's shape, structure, or a combination thereof, which is fit for practical use.

The term “design” refers to any new design of a product's shape, pattern or a combination thereof, as well as the combination of the color and the shape or pattern of a product, which creates an aesthetic feeling and is fit for industrial application.

Anti-Unfair Competition Law

Article 6 A business shall not commit the following acts of confusion to mislead a person into believing that a commodity is one of another person or has a particular connection with another person:

(1) Using without permission a label identical or similar to the name, packaging or decoration, among others, of another person's commodity with certain influence.

.....



Laws and Regulations on product configuration protection in China

Copyright Law

Article 1 This Law is enacted, in accordance with the Constitution, for the purpose of protecting the copyright of authors in their literary, artistic and **scientific works** and the rights and interests related to copyright, encouraging the creation and dissemination of works conducive to the building of a socialist society that is advanced ethically and materially, and promoting the progress and flourishing of socialist culture and sciences.

Article 3 For purposes of this Law, the term “works” includes, among other things, works of literature, art, natural sciences, social sciences, **engineering and technology**, which are created in any of the following forms:

- (1) written works;
- (2) oral works;
- (3) musical, dramatic, *quyi*, choreographic and acrobatic works;
- (4) works of the fine arts and **architecture**;
- (5) photographic works;
- (6) cinematographic works and works created by a process analogous to cinematography;
- (7) **graphic works** such as drawings of engineering designs and product designs, maps and sketches, and model works;
- (8) computer software; and
- (9) other works as provided for in laws and administrative regulations.



Laws and Regulations on product configuration protection in China

Trademark Law

Article 8 Any sign capable of distinguishing the goods of a natural person, a legal person, or any other organization from those of others, including but not limited to word, design, letter, numeral, **three-dimensional symbol**, combination of colors, and sound, as well as a **combination of the above**, may serve as a trademark for registration application.

Article 12. Registration shall be refused where a three-dimensional design **merely indicates the shape inherent in the nature of the goods** concerned. Registration also shall be refused where a three-dimensional design is only dictated by the need to **achieve technical effects** or the need to **give the goods substantive value**.

Laws and Regulations on product configuration protection in China

Regulations for the Implementation of the Trademark Law of the People's Republic of China

Article 13 ... Where an application is filed for registering a three-dimensional symbol as a trademark, it shall be stated in the application, the instructions for use of the trademark shall be provided, and a design including, at a minimum, the three-view drawing shall be submitted based on which the three-dimensional shape could be determined.

...

Article 43 When applying for a territorial extension to the People's Republic of China and requesting the protection of a three-dimensional sign, a combination of colors or sound as a trademark, or the protection of a collective mark or a certification mark, the applicant shall **submit the materials required by Article 13** of these Regulations **through a trademark agency established in accordance with law** to the 17 Trademark Office, **within 3 months** from the date on which the trademark is recorded in the International Register at the International Bureau. Where no relevant materials are submitted within the said time limit, the Trademark Office shall refuse the application for territorial extension.



Laws and Regulations on product configuration protection in China

Regulations on Several Issues Concerning the Trial of Administrative Cases Involving the Granting and Confirmation of Trademark Rights

Issued by Judicial Committee No. 1703 of the Supreme People's Court on December 12, 2016; effective on March 1, 2017.

Article 9 Where a trademark registration application is made for a 3-dimensional sign that consists solely of the shape of the goods themselves or a part thereof, the relevant public will generally not view the sign as an identifier of origin, and the three-dimensional sign will not possess distinctiveness as a trademark.

The fact that the shape was originally created or first used by the applicant does not necessarily mean that it possess distinctiveness as a trademark.

Where a sign referred to in the first paragraph has been used for a long time or extensively, such that the relevant public can distinguish the source of goods based on the sign, then the sign can be ruled as possessing distinctiveness.



Basic Registration requirements for 3-D marks:

**According to the trademark law and related regulations,
a 3-D mark shall possess features of :**

- 1. Non-functionality**
- 2. distinctiveness**

Basic Registration requirements for 3-D Trademarks

According to the Supreme Court's Regulations: 3-D trademark consists solely of a 3-D sign or a 3-D sign including other elements. It can be:

- shape of the goods themselves or a part thereof,
- the shape of the goods packaging or container,
- other 3-D sign (irrelevant with goods or their packaging or container).



Filing requirements for 3-D Trademarks in China

Direct filing in China:

- Provide use instruction,
- Provide 3-view drawings.
- other 3-D sign (irrelevant with goods or their packaging or container).

For IR TM via territorial extension to China:

- within 3 months from the date on which the trademark is recorded in the International Register at the International Bureau, applicant should submit the three-view drawing,
- through a trademark agency established in accordance with the law.



Tests: formalities examination + substantive examination

Formalities examination: general + Special

Special formality requirements:

- **must file** trademark specimens or pictures that can demonstrate the three-dimensional shapes. These can take the form of 3D views, multi-views or graphical maps;
- **must indicate** on the application form that the trademark is a "three-dimensional trademark".
- If necessary, the applicant **may describe** the three-dimensional trademark specimen with words in the section for trademark description, and it **can also renounce** exclusive rights for parts of the trademark where exclusive rights are not being claimed.
- If the specimen is incapable of showing the three-dimensional shape or it shows an unrecognizable three-dimensional shape, the trademark will not be considered as a three-dimensional trademark.

Tests: formalities examination + substantive examination

Substantive examination :

- an examination of the terms on trademarks prohibited for use,
- a functionality examination,
- a distinctiveness examination,
- an examination of identical or similar three-dimensional trademarks.

Tests: formalities examination + substantive examination

- an examination of the terms on trademarks prohibited for use,

The registration of three-dimensional trademarks shall not breach the provisions on prohibited use under the Trademark Law, and Part One of these Standards shall be applied.

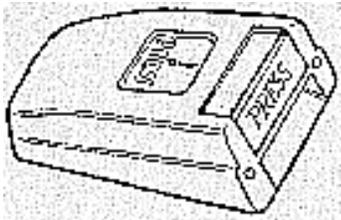


(Specified goods: perfume). Skull shape has a negative effect

Tests: formalities examination + substantive examination

- a functionality examination,

1. Where a three-dimensional sign only consists of a three-dimensional shape that is derived from the nature of goods themselves, i.e., the three-dimensional shape is necessary and commonly used for fulfilling the inherent function and use of the relevant goods, the three-dimensional sign shall be viewed as functional.



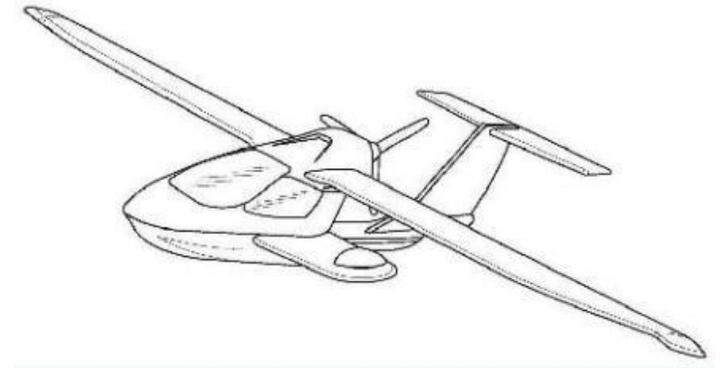
safety buckles



tires



folding ruler



aircrafts

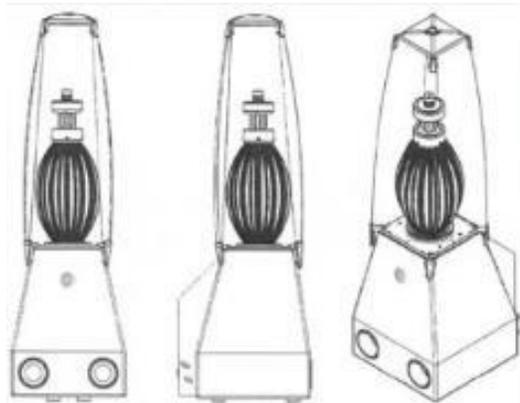
Tests: formalities examination + substantive examination

- a functionality examination,

Where a three-dimensional sign only consists of a three-dimensional shape that is necessary for the goods to obtain a technical effect, i.e., the three-dimensional shape is for the goods to contain certain special functions or to make it easier to fulfil their inherent function, the three-dimensional sign shall be viewed as functional.



(shaving head)



(loudspeaker)



(lifesaving hoop)



(hiking stick)

Tests: formalities examination + substantive examination

- a functionality examination,

Where a three-dimensional sign only consists of a three-dimensional shape that caused the goods to have substantial value, i.e., the appearance and shape of the three-dimensional shape are used to influence the value of the goods, the three-dimensional sign shall be viewed as functional.



(Specified goods: porcelain)



(Specified goods: pendants)



(Specified goods: candy)

Tests: formalities examination + substantive examination

- a distinctiveness examination,

1. Three-dimensional shapes devoid of distinctiveness

(1) Basic three-dimensional geometric shapes and simple and generic three-dimensional shapes that cannot distinguish the source of goods shall be considered as lacking distinctiveness.

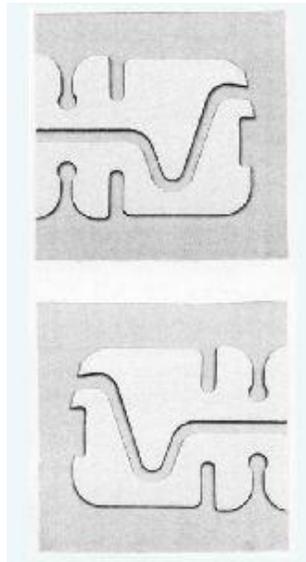


(Specified goods: clothing)

An exception exists where the basic three-dimensional geometric shapes have acquired distinctiveness

Tests: formalities examination + substantive examination

(2) Decorative three-dimensional shapes that cannot distinguish the source of goods shall be considered as lacking distinctiveness.



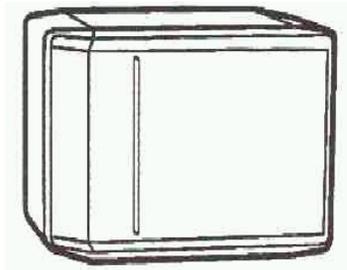
An exception exists where decorative three-dimensional shapes have acquired distinctiveness through use and this can be proven by sufficient evidence.

(Specified goods: sun-glasses)

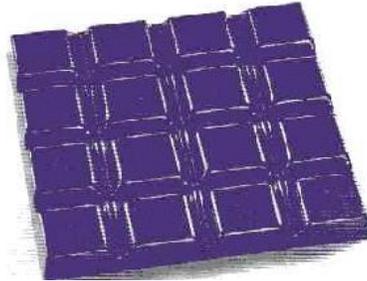
Tests: formalities examination + substantive examination

- a distinctiveness examination,
2. Three-dimensional shapes of the goods themselves

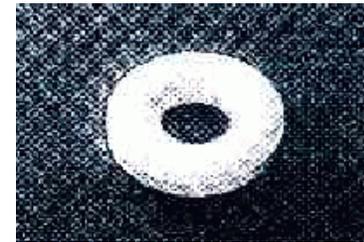
Where the three-dimensional shape of goods themselves is a generic or commonly-used three-dimensional shape for goods in an industry, the shape cannot function to distinguish the source of goods and it shall be considered as lacking distinctiveness.



(Specified goods: loudspeakers)



(Specified goods: chocolate)



(Specified goods: candies)

Where a trademark registration application for a three-dimensional shape looking like a culture relic is filed for goods related to the shape of the cultural relic, such as "containers, jewelry boxes", etc., then if the said three-dimensional shape looking like the culture relic depicts the three-dimensional shape of the goods themselves, that three-dimensional shape shall be considered as lacking distinctiveness.

An exception exists where the three-dimensional shape of goods which have acquired

Tests: formalities examination + substantive examination

- a distinctiveness examination,

3. Three-dimensional shapes of packaging of goods

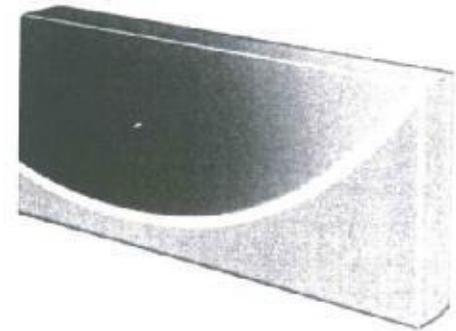
(1) Basic geometrical three-dimension shapes, simple and common three-dimensional shapes and decorative three-dimensional shapes that cannot function to distinguish the source of goods, shall be considered as lacking distinctiveness.



(Specified goods: cheese)



(Specified goods: blankets for children)



(Specified goods: drugs)

An exception exists where basic geometrical three-dimensional shapes, simple and common three-dimensional shapes and decorative three-dimensional shapes have acquired distinctiveness through use, and this can be proven by sufficient evidence.

Tests: formalities examination + substantive examination

- a distinctiveness examination,

3. Three-dimensional shapes of packaging of goods

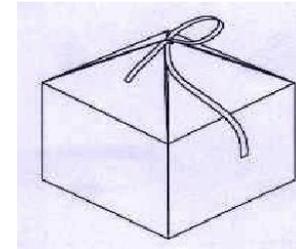
(2) A three-dimensional shape that is generic or usual packing within an industry and that cannot function to distinguish the source of goods shall be considered as lacking distinctiveness.



(Specified goods: alcoholic beverage)

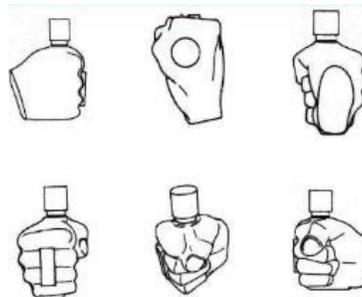


(Specified goods: jam)



(Specified goods: cakes)

An exception exists where three-dimensional shapes are not generic or commonly-used packaging for the specified goods.



perfume

An exception exists where the three-dimensional shape that is generic or usual packaging within an industry has acquired distinctiveness through use and this can be proven by sufficient evidence.

Tests: formalities examination + substantive examination

- a distinctiveness examination,

4. Combination of three-dimensional signs and two-dimensional elements

(1) Where a trademark consists of distinctive three-dimensional signs and other distinctive two-dimensional signs, it shall be considered as a distinctive three-dimensional trademark.

(2) Where a trademark consists of a distinctive three-dimensional sign and other non-distinctive two-dimensional elements, it shall be considered as a distinctive three-dimensional trademark.

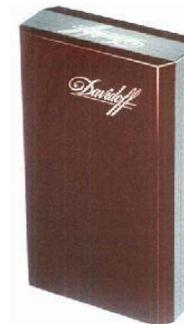
(3) Where a trademark consists of a three-dimensional sign that does not possess distinctiveness and other two-dimensional signs that do possess distinctiveness, that three-dimensional trademark shall be considered as distinctive. However, the scope of exclusive protection for that trademark post-registration should be limited to the two-dimensional sign that possesses distinctiveness. This shall be noted in the publication of preliminary approval and on the registration certificate.



beer



chocolate



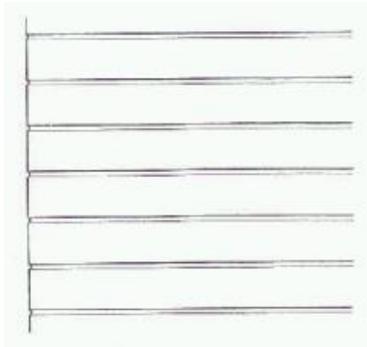
tobacco products

Tests: formalities examination + substantive examination

- a distinctiveness examination,

5. Others that are devoid of any distinctiveness

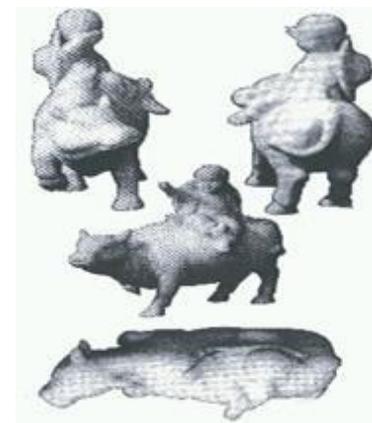
Where the shape and features of a three-dimensional sign are difficult to determine from the trademark specimen submitted by the applicant, even after an explanation has been given by the applicant, the three-dimensional sign shall be viewed as lacking



(Specified goods:
eyeglasses and
eyeglass cases)



(Specified goods: clothing)



(Specified service: restaurants)

Tests: formalities examination + substantive examination

- an examination of identical or similar three-dimensional trademarks.

The examination of identical or similar three-dimensional trademarks includes an examination between three-dimensional trademarks as well as between three-dimensional trademarks and two-dimensional trademarks.

1. Examination of identical / similar three-dimensional trademarks

(1) Where both trademarks consist of three-dimensional signs that are identical or similar, and these are likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar trademarks.



(Specified goods: perfume)

Tests: formalities examination + substantive examination

- an examination of identical or similar three-dimensional trademarks.

(2) Where both trademarks consist of distinctive two-dimensional elements that are identical or similar, and these are likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar trademarks.



(Specified goods: perfume)

Tests: formalities examination + substantive examination

- an examination of identical or similar three-dimensional trademarks.

(3) Where both trademarks consist of non-distinctive three-dimensional signs and distinctive two-dimensional elements, and where the distinctive two-dimensional elements are identical or similar, such that they are likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar trademarks.



(Specified goods: chocolate)

An exception exists where the other two-dimensional elements are distinguishable from each other and unlikely to mislead the relevant public as to the source of goods or services.

(Letters: KRUG)



(Letters: LA GRANDE DAME)



Tests: formalities examination + substantive examination

- an examination of identical or similar three-dimensional trademarks.

2. Examination of identical / similar three-dimensional trademarks and two-dimensional marks

(1) Where a three-dimensional trademark consists of non-distinctive three-dimensional signs and distinctive two-dimensional elements, and the two-dimensional elements are identical with or similar to the distinctive part of a two-dimensional trademark, and this is likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar.



(Specified goods: cosmetics)



(Specified goods: cosmetics)



GUADÉT

(Specified goods: alcoholic beverages)

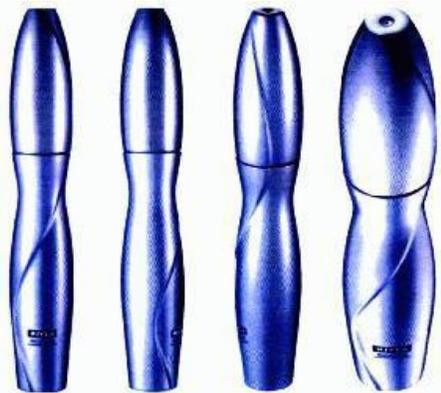
Note: The text is similar to prior mark "GUADÉT"

Tests: formalities examination + substantive examination

- an examination of identical or similar three-dimensional trademarks.

2. Examination of identical / similar three-dimensional trademarks and two-dimensional marks

(2) Where a three-dimensional trademark consists of distinctive three-dimensional signs and distinctive two-dimensional elements, and the two-dimensional elements are identical with or similar to the distinctive part of a two-dimensional trademark, and this is likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar.



(Specified goods: cosmetics)



(words : NIVEA ; BEAUTE)

(Specified goods: cosmetics)

Tests: formalities examination + substantive examination

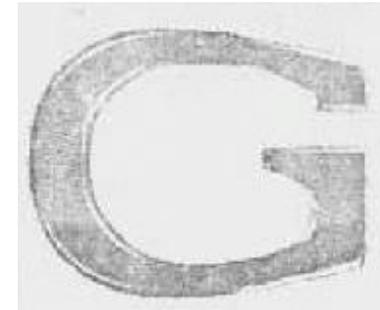
- an examination of identical or similar three-dimensional trademarks.

(3) Where the three-dimensional sign in a three-dimensional trademark possesses distinctiveness, but its visual effect is identical with or similar to the distinctive part of a two-dimensional trademark, and this is likely to cause confusion among the relevant public as to the source of goods or services, the trademarks shall be viewed as identical or similar.



(Specified goods: clothing)

The shape is similar to the prior mark “PAJARO



(Specified goods: : cleaning preparations)

The shape is similar to the prior mark “G”



OFFENSIVE



(Specified goods: perfume)

Note: The texts are similar to the prior mark “OFFENSIVE”, and the shape is similar to a prior football mark.

Case Study 1

TM No.: 7505828

Applicant: PARFUMS CHRISTIAN DIOR

Filing date: June 29, 2009

Class: 3

Goods: Cosmetics, Shampoo, Soap, etc.

Status: Registered



Case study 2: Reheard on April 26, 2018 by Supreme Court, public hearing

IRTM No.: G1221382

Applicant: PARFUMS CHRISTIAN DIOR

TM No: G1221382

Filing date: November 6, 2014

Class: 3

Goods: Perfume products, etc.



CTO	TRAB	1 st instance	2 nd instance	Supreme court
X	X	X	X	Returned to TRAB for re-examination

Supreme Court held :

1. The fact issue on which the decision made by CTO and TRAB were wrong.
2. TRAB did not check the fact and made the decision, violating legal procedure.
3. Abrogate the rulings by the 1st and 2nd instances courts and the decision made by TRAB.
4. Dictate TRAB to make a new decision on distinctiveness of the 3-D mark, with consideration of use time and extent, as well as the examination consistency principle.

- *The 3-d mark was granted soon*

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Thanks !

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