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Trademark Protection for Three-Dimensional Shapes in Thailand

Anyone with even a basic knowledge of intellectual property law knows that a trademark must enable consumers to distinguish the product of one enterprise from the products of other enterprises. To be registrable, the trademark must be distinctive and non-descriptive. A mark can be distinctive in two ways: (1) inherent distinctiveness; and (2) distinctiveness through use. In addition, the trademark must be something other than, and separate from, the goods themselves. This rule applies to the registration and protection of conventional trademarks, as well as configuration marks.

A three-dimensional mark cannot be registered unless the applicant can demonstrate the distinctive character of the mark. When the shape applied for as a three-dimensional mark results merely from the nature of the goods themselves, it cannot be registrable due to the lack of distinctiveness. For example, a light bulb shape is not registrable in relation to light bulbs, and a shape of a tire is not registrable for tires. In this case, the sign (the shape of a product) and the goods are merged and the sign cannot perform the trademark function in conveying information to the consumers as to the origin of a product.

Signs that are not distinctive in nature can still qualify for registration for being distinctive through continued use. Thai law has adopted this approach. A shape mark is considered distinctive if an applicant can prove that, through the long and extensive sale and advertisement, the sign has become fixed in the mind of the public or the consumers to the extent that it can distinguish the goods or services under the sign from goods or services of others. [The DIP Regulation, Clause 3.1.2.]

Shapes as trademarks

Article 15.1 of the TRIPS Agreement provides a definition of a trademark as "[a]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks."

From the definition, the TRIPS Agreement broadly defines "signs" to include figurative elements paving the way for the protection as a trademark of some part or the entire shape of the product. A shape mark can be either two-dimensional pictorial images or three-dimensional shape of a product, or its container or packaging.

The TRIPS definition of trademarks has been incorporated into Thai law. Section 4 of the Trademark Act B.E. 2534 (1991), as amended in 2000, defines a mark as "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" (emphasis added). The express inclusion in this Act of the phrase "shape or configuration of an object" in the definition of registrable marks means that the shape of goods or part of them can be registered as a trademark in Thailand.

The Coca-Cola *Case*

Immediately after the amended Act became effective, The Coca-Cola Company filed an application to register its popular "Coca-Cola" bottle with the Department of Intellectual Property (DIP). However, the amended Act did not provide a clear rule as to how three-dimensional trademarks can be registered. When the application was filed, neither regulations and guidelines nor a special application form for the registration of three-dimensional trademarks had yet been adopted. In the absence of these procedural aids, Coca-Cola represented its bottle as a trademark merely by presenting a two-dimensional image of its bottle; the application did not make any specific attempt to present the mark in three dimensions. Because of this, the DIP considered the sign being sought for registration to be a generic picture and also descriptive of the relevant product. Coca-Cola then appealed the Registrar's decision to the Board of Trademarks and subsequently to the Intellectual Property and International Trade Court (IP&IT Court). While the Board of Trademarks affirmed the Registrar's decision, the IP&IT Court held that the pictorial representation of the bottle was registrable. The case finally went to the Supreme Court. The Supreme Court upheld the decision of the IP&IT Court.

Interestingly, the Supreme Court ruled that the very specific and unique design and the fanciful feature of the "Coca-Cola" bottle, particularly its convex and concave parts and concave spots around the bottle, was sufficient to make it inherently distinctive, and there was no need for the Court to look for evidence

of distinctiveness through use. The Supreme Court further reasoned that the mark sought for registration was "an invented picture" and the applicant did not seek to register it with beverage containers; thus, the subject mark was distinctive enough for trademark protection. As a result, the famous "Coca-Cola" bottle could only be registered in Thailand as a two-dimensional mark, not as a three-dimensional trademark like in many other countries. It is worth mentioning here that, throughout the process of this trademark registration, none of the reviewing authorities—the Registrar, the Board of Trademarks, or the Courts—took into consideration the applicant's intention to apply for the registration of the three-dimensional "Coca-Cola" bottle.

This Supreme Court decision indicates that even if configuration trademarks are now eligible for protection in Thailand, it is vital for the applicant to make clear that the trademark sought to be registered is three-dimensional. The failure of the applicant to demonstrate this real intention may result in a similarly unfavorable outcome.

The lack of rules and regulations on three-dimensional trademark registration made it difficult for the DIP in dealing with this kind of application. As demonstrated in the *Coca-Cola* case, the Registrar would consider the three-dimensional mark merely as a pictorial mark. Since this case, the DIP has adopted several rules facilitating the registration of three-dimensional marks, one of which requires the applicant to indicate, in the application form itself, whether the application is intended to cover a three-dimensional mark. If so, the DIP requires such a mark to be represented in multiple views. As a result of the enactment of these regulations, many of the existing procedural issues in registering three-dimensional marks may have been resolved for future applicants.

Non-Functionality Requirement

The recent acceptance for registration of product shapes as trademarks in Thailand and other countries raises a number of questions. One particularly important issue has been the effect of such trademarks on competition in the relevant product market. The courts in some countries, such as the United Kingdom, had been quite reluctant to recognize the registrability of shapes. This position remained unchanged until the United Kingdom was bound to give effect to the EU Trademark Directive that provides for trademark registration of the shapes of products. *In re* Cola-Cola Co's Applications, [[1986] 2 All E.R. 274] the House of Lords ruled that shapes were not capable of being registered as trademarks. It was believed at that time that the registration of shapes would grant permanent monopoly over shapes of goods or other common forms of packaging, thus creating barriers to market entry.

Due to the rules contained in the TRIPS Agreement, it has now become possible to register configuration trademarks. However, the national law of countries still bars registration if a shape is essential to and cannot be separated from the function of the goods. This is because functional shapes generally cannot perform the trademark function in distinguishing goods and services. As Burchett J points out in the famous Australian case of *Koninklijke Philips Electronics NV v. Remington Products Australia Pty Ltd,* [[2000] FCA 876] "a shape that goods possessed because of their nature or because of the need for a particular technical result could not function as a trademark because such a shape could not distinguish the trade source."

Protection of product configuration marks may place unwelcome restrictions on competition. Any technical or functional features of the article should be protected under the law of patents, rather than trademark law. Unlike patent rights that have a relatively short life span, trademark rights can be renewed indefinitely and may last forever. In an English case, *Philips Electronics NV v. Remington Consumer Products Ltd.,* [[1998] R.P.C. 283] Jacob J argues:

> [t]he extent to which trademark law, conferring a perpetual monopoly, can interfere with the freedom ... of manufacturers to make an artifact of a desirable and good engineering design... The three-headed shape of the present Philips design is one of the best ways possible of making a rotary shaver... So, if Philips is right, they will have obtained a permanent monopoly in respect of matters of significant engineering design by virtue of a trademark registration.

Another related issue is whether a distinction needs to be drawn between the "function" and the "distinctiveness" of the configuration marks. Can functional shapes acquire distinctiveness through use and then become registrable? It has to be noted the requirement of non-functionality for the registration of three-dimensional trademarks is distinct from the distinctiveness requirement. The law of Thailand should make it clear that all functional shape marks are excluded from protection, regardless of their distinctive features. The exclusion is based on the fact that functional shapes cannot perform the essential trademark function in distinguishing the trademark owner's goods from the same sort of goods sold by another trader. However, the rule should not be used to exclude all types of configuration marks. When a shape mark has certain technical features, it might still be registrable, provided that, as a whole, the shape of the product cannot be regarded as being functional.

Scope of Rights

The acceptance by the Thai Supreme Court of shapes as being registrable as two-dimensional trademarks also raises another difficult issue regarding the scope of trademark rights. Can the trademark owner of a two-dimensional shape mark prevent a competitor from selling a product that contains the three dimensions of the object depicted by the registered two-dimensional mark? This will depend on whether the use of the shape in presentation of the goods is considered "use as a trademark." In other words, it will be infringement of the trademark rights if the two-dimensional shape as applied to the goods has inherent features that would lead a potential purchaser to perceive the shape as an indication of an origin of the product, rather than a representation of the product itself. The issue, however, has not been tested in the Thai courts.

Conclusion

The public policy considerations with respect to shape mark protection in Thailand are not completely clear. The essential issue concerning this form of protection for Thailand is whether the registration of configuration marks will restrict access to functional features or innovations.

We are of the view that the law should clarify the following issues:

- Because trademark rights are essentially unlimited in potential duration, the issue with respect to the relationship and dichotomy between trademarks and other intellectual property rights, such as industrial designs and copyrights, should be clarified by the statute.
- The law of Thailand implementing the TRIPS trademark provisions should make it clear that shapes that substantially perform a technical function are not registrable. This is to ensure that "functional" marks cannot be registered.
- Shapes that do not serve as a function should be capable of registration on the basis of their inherent distinctiveness. Otherwise, it has to be shown that through continued use consumers perceive the appearance of the product itself as an indication of origin.

These clarifications under Thai law would help trademark owners and practitioners to more effectively implement shape mark protection in the jurisdiction.

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