

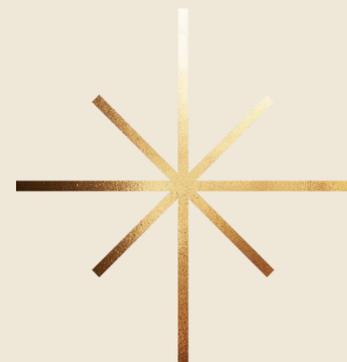
3D TRADEMARKS

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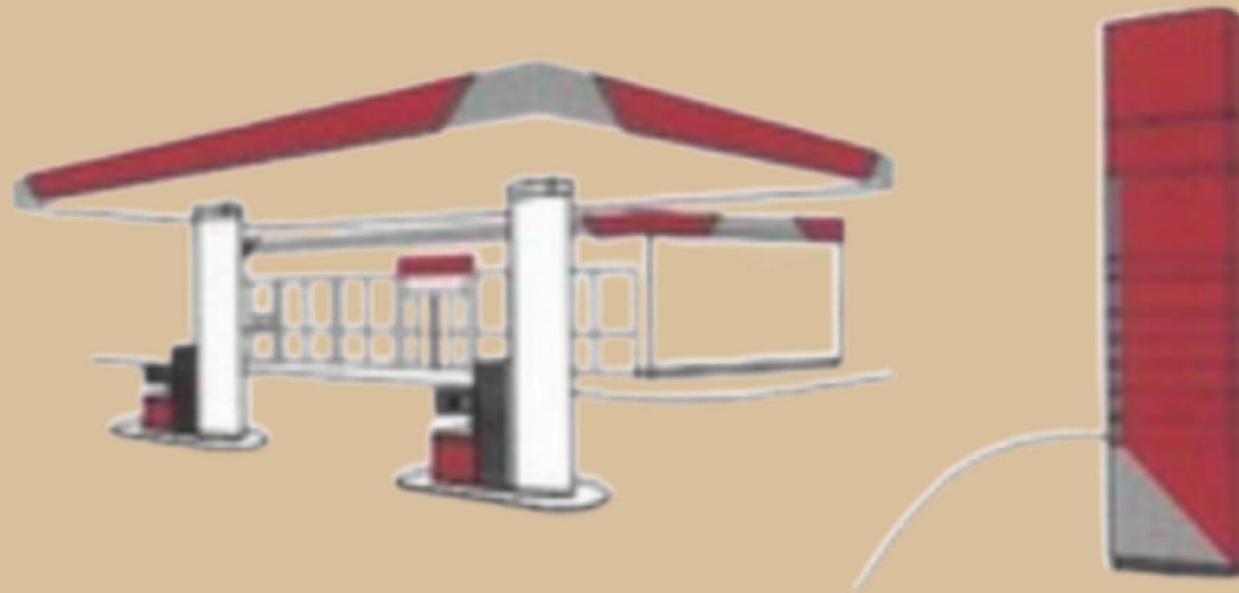
(Madrid Monitor No. 1848606)



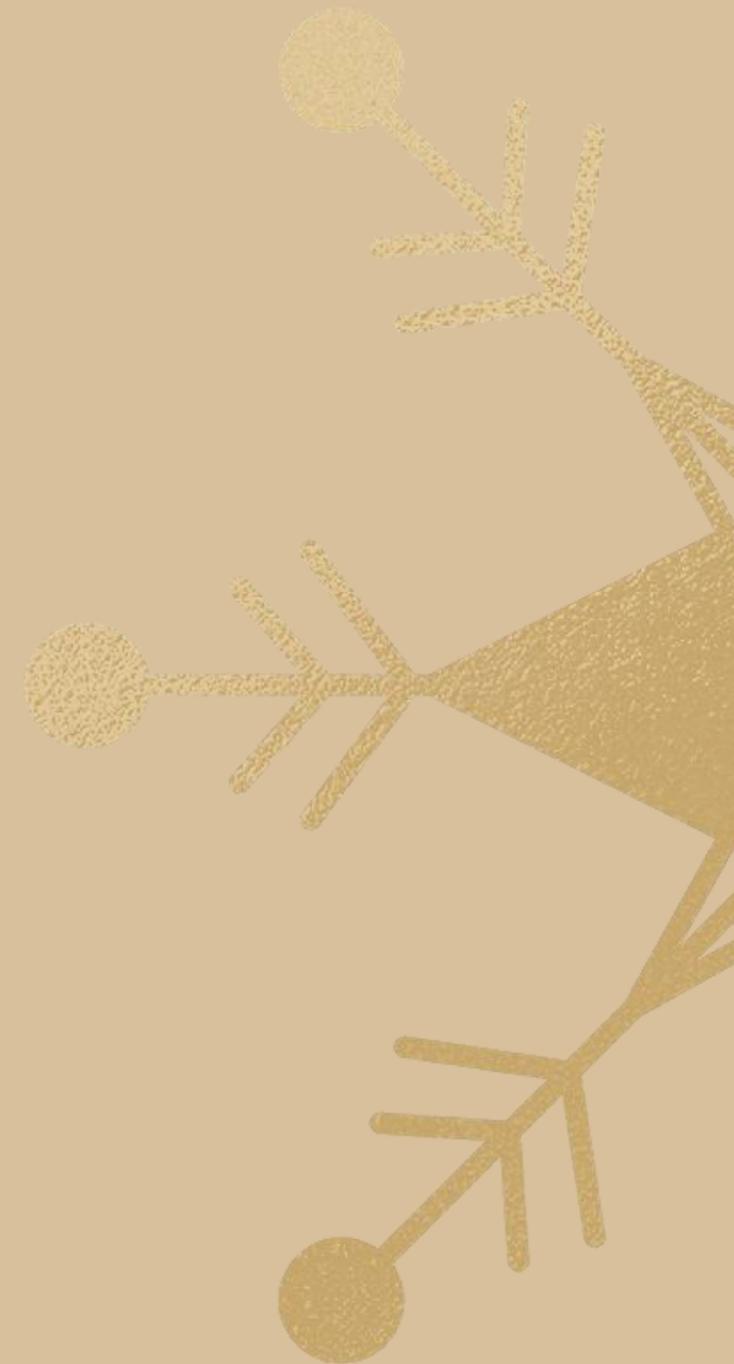
(Madrid Monitor No. 1692375)



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(Madrid Monitor No. 1808729)



Definition of 3D trademarks



A three-dimensional (3D) trademark is a type of mark expressed in three dimensions: length, width, and height.

Based on definitions from WIPO and following the practice in many countries, the classification of 3D trademarks can take several forms:

- The shape of packaging, such as the iconic contour of the Coca-Cola bottle or the Chanel perfume box.
- The shape of a product or a part of it, such as the body design of the Volkswagen Beetle or the form of a Zippo lighter.
- Another category includes trade dress or overall get-up, such as the architectural layout and interior design of McDonald's restaurants.



Protection standards for 3D trademarks

Basic requirements for trademark protection:

- Must be distinctive
- Must not fall into prohibited categories (eg, national flags, emblems)

A 3D trademark must meet general requirements,
but the key challenges are:

- Distinctiveness
 - Non-functionality
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Distinctiveness



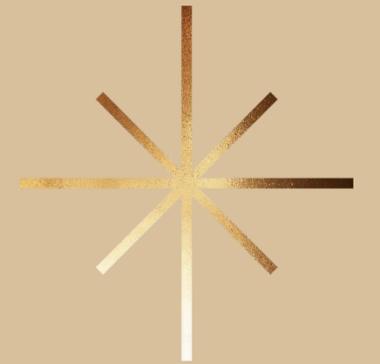
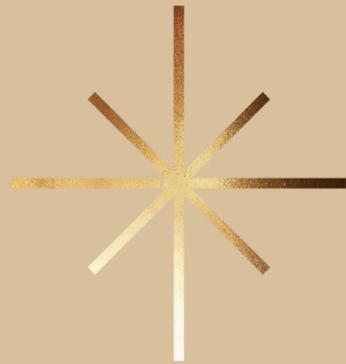
- A 3D trademark must be unique enough for consumers to recognize where the product comes from.
- 3D trademarks are harder to prove distinctive, especially when shapes in the industry are common or similar.

Distinctiveness



Can you tell which brand this bottle comes from?

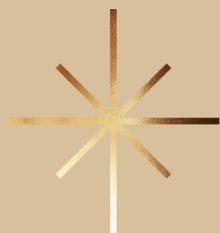
Distinctiveness



Say, the brand name is blurred, but the bottle's unique shape still makes it recognizable

Acquired distinctiveness

In countries like the US, China, or Vietnam, even if a shape isn't inherently distinctive, it can still be registered if it has acquired distinctiveness.



Point a, Clause 5, Article 26 of Vietnam's Circular No. 23/2023/TT-BKHHCN:

“the applicant must provide evidence of the extensive use of such signs as trademarks (eg, the number of relevant consumers who are aware of the sign, the starting **date of use, scope and extent of use before the filing date, sales revenue from goods sold or services provided**, etc.), thereby proving that the sign has acquired distinctiveness in respect of the applicant's relevant goods or services. In such cases, the sign must **have been continuously and commonly used in lawful production, business, trade, advertising, and marketing activities** in the form represented in the registration application.”

Acquired distinctiveness

A well-known example of “acquired distinctives” is Dior’s “J’adore” perfume bottle, which has been granted registration in China because over time, its unique shape became strongly connected with Dior in the minds of consumers.



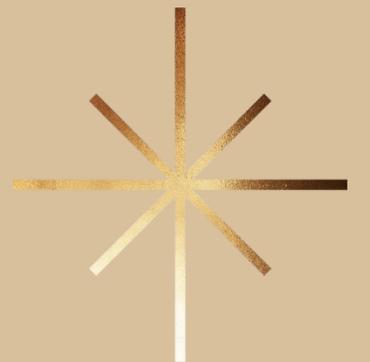
Non-functionality



WIPO explains it pretty simply: a shape is functional if it's necessary to achieve a technical result. Many countries apply what's called a two-prong test:

- First, does the shape actually serve the product's purpose?
- Second, if one company owned this shape, would it put competitors at an unfair disadvantage by stopping them from using the same functional features?

→ If the answer is yes to either of those questions, the shape is considered functional and cannot be registered.



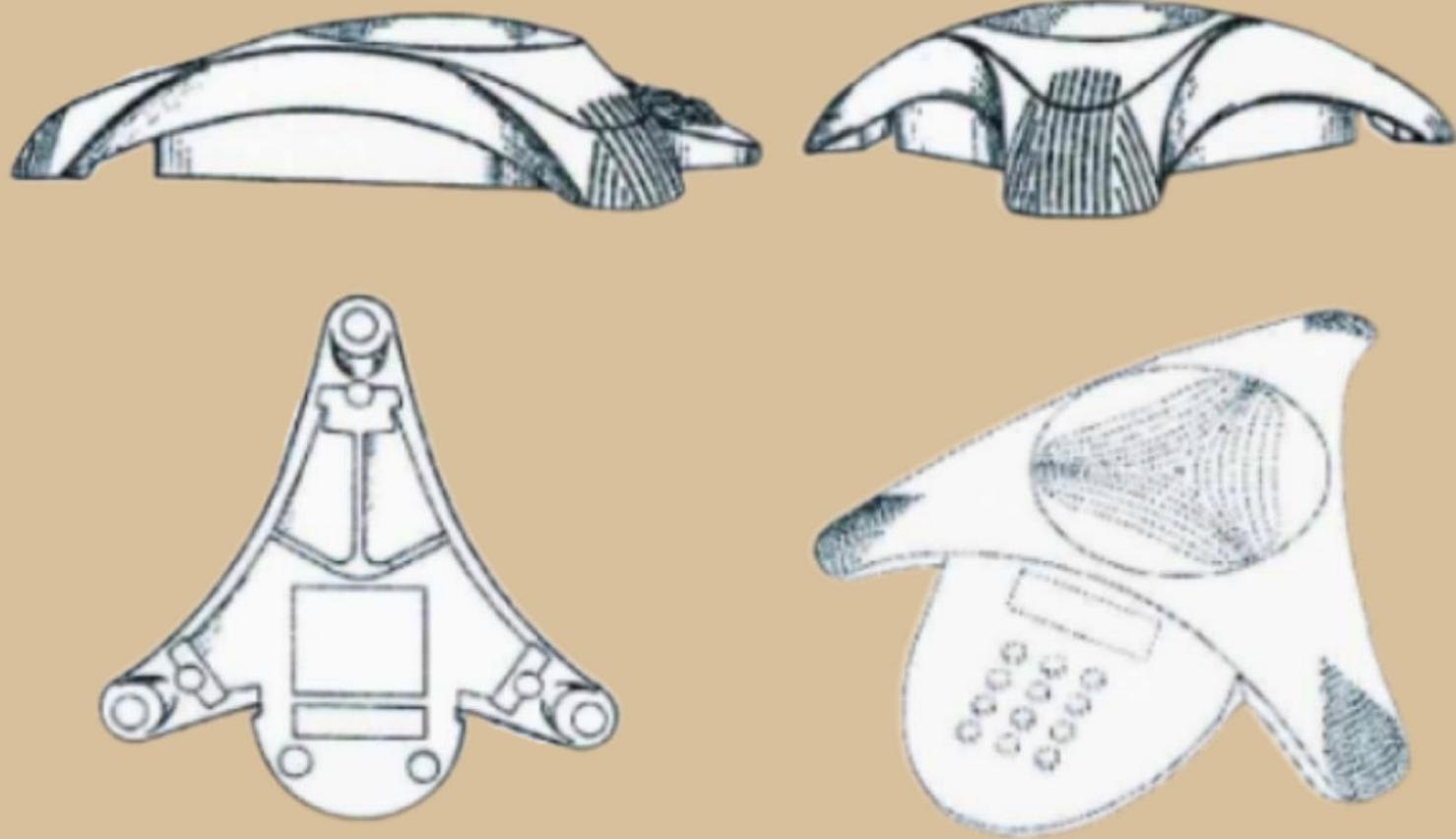
Non-functionality

In Vietnam and China, “functionality”, usually depends on three main situations:

- Natural function: shape from the nature of the product/ common shape of goods (Clause 6, Article 73, IP Law 2005)
- Practical function: shape needed for technical result (Clause 6, Article 73, IP Law 2005)
- Aesthetic function: shape giving decorative/features that add significant value to the goods (Point c, Clause 2, Article 74, IP Law 2005)



Non-functionality



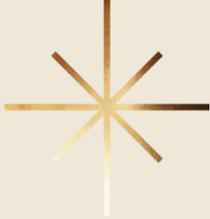
- Court rejected claim of aesthetic functionality.
- Buyers of phones/conference equipment focus on sound quality, not appearance.
- Design didn't give substantial value → trademark upheld.

Polycom Phone Case (China, TM No. 8341029)

Source: <https://www.unitalen.com.cn/html/report/24111819-1.htm>



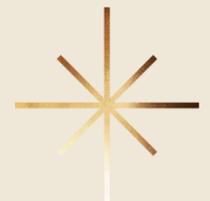
Current Legal Framework in Vietnam



In practice, protection is often refused because the shape is too common or, indeed, adds significant value to the product.

There's no separate legal framework for 3D trademarks yet, but according to the current regulations of Vietnamese law, particularly Articles 72, 73, and 74 of IP Law, a 3D trademark is eligible for protection if it satisfies all of the following conditions:

- It is a visible sign (Article 72)
- It possesses distinctiveness (Article 74): Point b, c and n Clause 2
- It does not fall within the grounds for refusal of protection (Article 73): Clause 6



Challenges in Registering 3D Trademarks

- One major challenge in registering 3D trademarks in Vietnam is the strict requirement of distinctiveness and non-functionality.



VI. Grounds for refusal:

The applied-for mark is refused because it consists exclusively of the shape which results from the nature of the goods themselves, therefore devoid of distinctiveness.

VII. Applicable provisions of the national law:

Art. 74.2b of the Intellectual Property Law

VIII. Information relating to subsequent procedure:

- a) Time limit for requesting review: 3 months from the sending date of this notification by NOIP
- b) Authority to which review should be made:
National Office of Intellectual Property of Vietnam
384 - 386 Nguyen Trai St., Thanh Xuan Dist., Hanoi, Vietnam
- c) The application for requesting review shall be filed through an authorized representative in Vietnam

Source: <https://madrid.wipo.int/documentaccess/documentAccess?docid=1211468501>



Challenges in Registering 3D Trademarks

- In practice, consumers usually see a 3D shape as product design rather than as a brand indicator, making it harder to prove distinctiveness.
 - The lack of clear rules and standardized criteria means examination often relies heavily on the examiner's judgment, leading to inconsistent outcomes between applications.
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PRACTICAL EXPERIENCES AND INSIGHTS

To improve the chances of registering 3D trademarks in Vietnam:

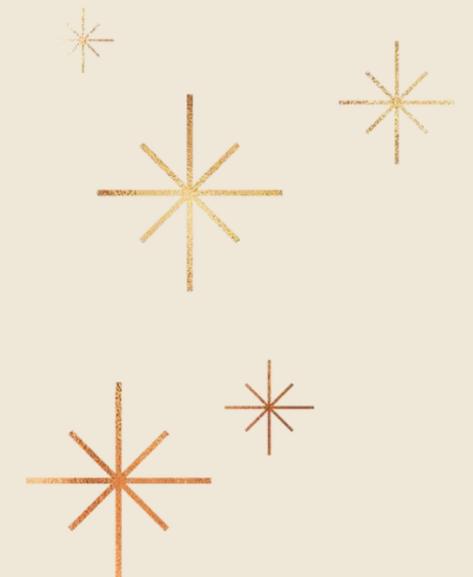
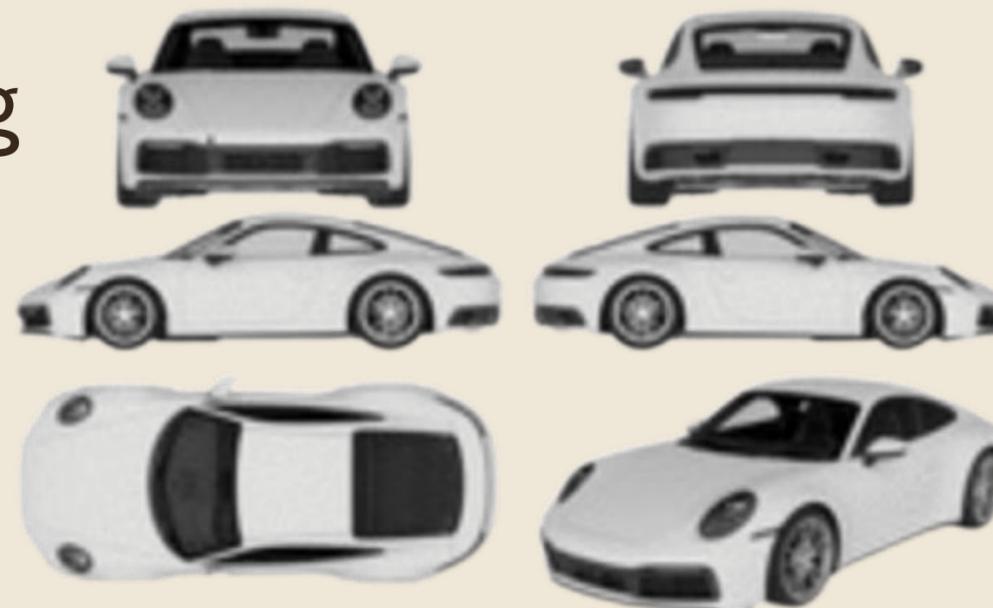
- Submit images from multiple angles (front, back, top, bottom, left, right) so examiners clearly see the structure and unique features.

→ This allows the examiner to gain a comprehensive understanding of the structure and unique identifying features of the shape.



(MM No. 1699396
Porsche Aktiengesellsch)

(MM No.873674 - MontBlanc
Vodka)



PRACTICAL EXPERIENCES AND INSIGHTS

- Provide a detailed description highlighting distinctive, non-functional elements (eg, proportions, embossed details, cuts, unusual curves, edges, uncommon design features):



571 Description of the mark

The mark consists of a stylized image of a bottle in the form of a girl wearing a traditional Vietnamese dress and a conical hat. Below the front flap of the traditional Vietnamese dress is the phrase "MISS Saigon Elegance" in a stylized form and arranged in three rows.

Source: Madrid Monitor No. 1866082 - MISS Saigon Elegance

PRACTICAL EXPERIENCE AND INSIGHTS

- If your shape has acquired distinctiveness through use, you should prepare evidence such as consumer recognition, duration and scope of use, sales revenue, and market presence, as required under Clause 5, Article 26 of Circular No. 23/2023/TT-BKHCHN.
- If the shape has already been registered in places like the EU, Japan, or South Korea, submit those certificates or examination reports. Showing that it's been accepted in strong IP systems abroad can strengthen your case in Vietnam too.

PRACTICAL EXPERIENCES AND INSIGHTS

- Assess distinctiveness early. If the shape is new and creative, consider first registering it as an Industrial Design (5 years, renewable up to 15).
 - This builds brand recognition, which can later support a 3D trademark application based on acquired distinctiveness.

