

**WHERE IS THE RIGHT BALANCE?—EXPLORING THE  
CURRENT REGULATIONS ON NONTRADITIONAL  
THREE-DIMENSIONAL TRADEMARK REGISTRATION  
IN THE UNITED STATES, THE EUROPEAN UNION,  
JAPAN AND CHINA**

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**ABSTRACT**

Trademark rights are very important intellectual property rights. Currently, one heated and controversial issue in intellectual property law is the trend of nontraditional trademark registration. One important form of nontraditional trademarks is the three-dimensional trademark. This article discusses some background information about trademarks and intellectual property rights, then introduces the international protection of trademarks, and different intellectual property substantive regulatory regimes concerning nontraditional trademarks, especially three dimensional marks in the United States, the European Union, Japan and China. In addition, this article compares different regulatory regimes. It tries to summarize their merits and drawbacks, and analyze or predict the results for Kenzo's applications for its fragrance bottles as three-dimensional trademarks. Finally, this paper suggests a more effective regulatory framework.

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## INTRODUCTION

Creativity plays an important role in human history. In 1957, Robert Merton Solow discovered that only a small percentage of per-capita growth was in connection with the increasing ratio of capital to labor.<sup>1</sup> This discovery called peoples' attention to the role of another factor in economic growth: innovation and technology.<sup>2</sup>

Intellectual property is closely related to innovation and technology. It is aimed at protecting the rights that authors and inventors have in their creative works,<sup>3</sup> so these persons will have more incentive to bring out additional creative works. And these creative works will therefore promote economic growth.<sup>4</sup> Article 1 Section 8 of the U.S. Constitution provides: "[t]he Congress shall have power to . . . promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."<sup>5</sup> Nearly every developed country provides the authors and inventors of creative works with similar protections.<sup>6</sup>

However, in recent years, people and organizations have increasingly sought protection for their creative works that are not in traditional forms.<sup>7</sup> Trademarks are one category of intellectual property that develops many nontraditional forms. Traditionally, a mark consists of a name, word, phrase, logo, symbol, design, image, or a combination of these elements.<sup>8</sup> As the result of international treaties dealing with intellectual property and the social and economic changes, the definition

<sup>1</sup> JEAN TIROLE, THE THEORY OF INDUSTRIAL ORGANIZATION 389 (1988).

<sup>2</sup> *Id.*

<sup>3</sup> See SHUBHA GHOSH ET AL., INTELLECTUAL PROPERTY: PRIVATE RIGHTS, THE PUBLIC INTEREST, AND THE REGULATION OF CREATIVE ACTIVITY 2 (2007).

<sup>4</sup> *See Id.*

<sup>5</sup> U.S. CONST. art. I, § 8, cl. 8. This is also known as "the copyright and patent clause." GHOSH ET AL., *supra* note 3, at 2. In the United States, trademarks receive registrations based on the Commerce Clause of the Constitution. U.S. CONST. art. I, § 8, cl. 3; *The USPTO: Who We Are*, <http://www.uspto.gov/about/index.jsp> (last modified Dec. 19, 2011, 11:11 AM).

<sup>6</sup> *About Trademarks*, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/trademarks/en/about\\_trademarks.html](http://www.wipo.int/trademarks/en/about_trademarks.html) (last visited Dec. 30, 2011).

<sup>7</sup> For example, Justice Breyer mentioned in the *Qualitex* opinion, that, "[t]he courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread). *See, e. g.*, Registration No. 696,147 (Apr. 12, 1960); Registration Nos. 523,616 (Apr. 4, 1950) and 916,522 (July 13, 1971); *In re Clarke*, 17 U.S.P.Q. 2d 1238, 1240 (TTAB 1990)." *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995).

<sup>8</sup> *Nontraditional Trademarks*, INT'L TRADEMARK ASS'N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx> (last visited Dec. 30, 2011).

of “trademark” has gradually broadened, and nontraditional marks have become increasingly common.<sup>9</sup> Courts and administrative agencies in various countries now face a challenging task: to determine whether nontraditional items qualify for trademark protection.<sup>10</sup>

Courts face a dilemma as to whether to expand or limit trademark protection.<sup>11</sup> If trademark protection is expanded to nontraditional marks, their owners may have more incentive to promote and produce the goods.<sup>12</sup> Besides, consumers may incur less cost searching for the goods they want.<sup>13</sup> On the other hand, limiting trademark protections for nontraditional products would allow others to

<sup>9</sup> *Id.* In contrast to those traditional trademarks, nontraditional trademarks include, but are not limited to motion marks, color marks, sound marks, scent marks, hologram marks, and three-dimensional (shape) marks. *Id.*

<sup>10</sup> Courts in several countries have seen an increase in cases concerning nontraditional trademarks over the last decade. *Compare Qualitex*, 514 U.S. at 159, *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000), *In re Vertex Group LLC*, 89 U.S.P.Q.2d (BNA) 1694 (T.T.A.B. 2009), *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d (BNA) 1393 (T.T.A.B. 2009), and *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539 (6th Cir. 2005) (providing examples of how courts in the United States approach this issue), with Ralf Sieckmann, *Non-traditional Trade Mark Archives*, COPAT.DE, [http://www.copat.de/markenformen/mne\\_markenformen.htm](http://www.copat.de/markenformen/mne_markenformen.htm) (last updated Mar. 6, 2007) (illustrating that the European Union is concurrently struggling to solve general, nontraditional trademarks issues), and Robert C. Weiss & Michiru Takahashi, *Japan's Intellectual Property High Court Recognizes Mini Maglite® Product Shape as 3-D Trademark*, JONES DAY (Aug. 2007), <http://www.jonesday.com/japans-intellectual-property-high-court-recognizes-mini-maglite-product-shape-as-3-d-trademark-08-23-2007/> (summarizing how Japanese courts have ruled on three-dimensional marks in recent years).

<sup>11</sup> See *Qualitex*, 514 U.S. 159, 161–62.

<sup>12</sup> Trademark owners are entitled to public notice of their ownership and exclusive right to use their marks. *Trademark FAQs: What Are the Benefits of Federal Trademark Registration?*, [http://www.uspto.gov/faq/trademarks.jsp#\\_Toc275426681](http://www.uspto.gov/faq/trademarks.jsp#_Toc275426681) (last modified Sept. 16, 2010). With this protection, owners can focus on the production and promotion of their products, without concern that free-riders will take advantage of the marks.

<sup>13</sup> Justice Breyer said in the majority opinion of *Qualitex*, that “[i]n principle, trademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby ‘encourage[s] the production of quality products,’ and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer’s inability quickly to evaluate the quality of an item offered for sale.” *Qualitex*, 514 U.S. at 163–64 (alteration in original) (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01[2] (3d ed. 1994)).

be able to access the “marks” without any unnecessary burden, and ensure more vigorous market competition.<sup>14</sup>

Case law in several jurisdictions has reflected this problem. In *Qualitex*, the United States Supreme Court held that a color could be registered as a trademark only upon a showing of secondary meaning.<sup>15</sup> Courts outside the United States are facing this issue as well. In 2008, Coca-Cola successfully registered its glass bottle as a trademark in Japan.<sup>16</sup> The Japanese Intellectual Property High Court (hereafter “Japan IP Court”)’s decision that Coca-Cola’s bottle is trademarkable shows some cautious willingness of that conservative country to expand, rather than restrict or limit, the definition of trademark.

Many companies might find some hope from these successes. The luxury brand, Kenzo, is now seeking trademark registration for its fragrance bottles in multiple countries.<sup>17</sup> In spring 2010, the United States Patent and Trademark Office (USPTO) received Kenzo’s two applications for bottle designs for Flower By Kenzo and Kenzo Pour Homme EDT.<sup>18</sup> The two have already received their registrations.<sup>19</sup> In April of 2010, the Flower by Kenzo bottle was registered as a three dimensional mark in International Trademark Registration.<sup>20</sup> On May 24, 2010, Kenzo also successfully registered its Flower By Kenzo bottle as a community trademark in the European Union.<sup>21</sup> Many regions have provided extended protection for the mark.

Understandably, Kenzo, as the designer and creator, wants obtain protections for its distinctive design and marketing efforts. Additionally, consumers benefit by distinctive design and marketing

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<sup>14</sup> In *Qualitex*, the Court rejected Jacobson’s argument that by allowing the color mark registration, a competitor’s inability to find a suitable color will put that competitor at a significant disadvantage due to the limited supply of colors. *Id.* at 168.

<sup>15</sup> *Id.* at 163.

<sup>16</sup> Masaru Adachi, *A Lost Decade of 3D Trademark Registration in Japan: Coca-Cola Bottle 3D TM Case*, JAPANESE TRADE ASS’N 3 (Apr. 22, 2009), [http://www.jp-ta.jp/pdf/committee/005/AIPLA2009/2009\\_CocaCola\\_Bottle\\_3D\\_TM\\_case.pdf](http://www.jp-ta.jp/pdf/committee/005/AIPLA2009/2009_CocaCola_Bottle_3D_TM_case.pdf).

<sup>17</sup> See U.S. Trademark Application Serial No. 79,047,629 (filed Nov. 12, 2007); U.S. Trademark Application Serial No. 79,070,988 (filed Oct. 13, 2008); U.S. Trademark Application Serial No. 79,081,641 (filed Mar. 4, 2010); U.S. Trademark Application Serial No. 79,082,138 (filed Apr. 12, 2010); KENZO, Community Registration No. 8,532,442; KENZO, International Registration No. 1,036,168.

<sup>18</sup> U.S. Trademark Application Serial No. 79,081,641 (filed Mar. 4, 2010); U.S. Trademark Application Serial No. 79,082,138 (filed Apr. 12, 2010).

<sup>19</sup> KENZO, Registration No. 3,933,848 (Mar. 22, 2011); KENZO, Registration No. 3,919,070 (Feb. 15, 2011).

<sup>20</sup> KENZO, International Registration No. 1,036,168.

<sup>21</sup> KENZO, Community Registration No. 8,532,442.

efforts because inferior products will not confuse them. However, it is also understandable that intellectual property offices and courts may feel reluctant to grant such protection, since the “bottle mark” is quite unlike the ordinary two dimensional marks which they traditionally work with.<sup>22</sup>

## I. INTRODUCTION OF TRADEMARKS

### A. INTRODUCTION OF TRADEMARKS AND NONTRADITIONAL TRADEMARKS

Trademarks,<sup>23</sup> like copyrights and patents, are a type of intellectual property<sup>24</sup> protected by intellectual property laws.<sup>25</sup> Trademarks originated in ancient times when craftsmen reproduced their signatures, or “marks,” on their artistic or utilitarian products so that consumers could identify the products as being made by them.<sup>26</sup> Today, consumers continue to identify the manufacturers of products through such “marks.” According to the World Intellectual Property Organization (WIPO), trademarks are “distinctive signs, used to differentiate between identical or similar goods and services offered by different producers or services providers.”<sup>27</sup> Similarly, in the United States, the Lanham Act of 1946 defines trademarks as “any word, name, symbol, or device, or any combination thereof [that is] (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or

<sup>22</sup> Adachi, *supra* note 16, at 26. (“Coca-Cola Bottle is the first container to be registered as 3D TM in Japan. This is the first case that [sic] the court refused to apply [Japan Patent Office]’s examination standard.”).

<sup>23</sup> “Trademark”, as a single word is predominantly used only in the United States and Philippines, while “trade mark” is used in many other countries around the world, including the European Union and Commonwealth and ex-Commonwealth jurisdictions. Canada officially uses trade-mark pursuant to the Trade-mark Act, but trade mark and trademark are also commonly used there.

<sup>24</sup> GHOSH ET AL., *supra* note 3, at 450.

<sup>25</sup> See generally *WIPO Lex Search (Trademarks)*, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/wipolex/en/results.jsp?countries=&cat\\_id=4](http://www.wipo.int/wipolex/en/results.jsp?countries=&cat_id=4) (last visited Dec. 30, 2011) (listing trademark-related laws enacted by different countries and international treaties).

<sup>26</sup> *Trademarks*, WORLD INTELLECTUAL PROP. ORG., <http://www.wipo.int/trademarks/en/trademarks.html> (last visited Dec. 30, 2011).

<sup>27</sup> *Trademarks Gateway*, WORLD INTELLECTUAL PROP. ORG., <http://www.wipo.int/trademarks/en/> (last visited Dec. 30, 2011).

sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>28</sup>

Unlike other types of intellectual property such as copyrights and patents, trademarks are tied almost exclusively to commercial transactions.<sup>29</sup> The predominant objective of trademark law is to prevent consumer confusion in the marketplace.<sup>30</sup> Consumers can choose products based on brands or trademarks, which reduces searching and shopping costs.<sup>31</sup>

A second objective of trademarks is to provide the owner with protection by ensuring that the owners can use it to market and advertise their goods or services, and authorize others to use the marks.<sup>32</sup> In a word, “trademarks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit.”<sup>33</sup>

Trademark protection also prevents counterfeiters from using distinctive signs to market inferior products or services.<sup>34</sup> The system enables people with skill and enterprise to “produce and market goods and services in the fairest possible conditions, thereby facilitating international trade.”<sup>35</sup>

To enjoy fully the benefits of trademarks, the owner must register the mark. Trademarks can be registered and protected in almost every country in the world.<sup>36</sup> Each national or regional office of trademark maintains information on trademark applications, registrations and renewals. They also facilitate examinations and searches for potential opposition by third parties through the “register of trademarks.”<sup>37</sup> The period of protection varies among different countries.

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<sup>28</sup> 15 U.S.C. § 1127 (2006). The Lanham Act is the federal trademark law of the United States. *See* 15 U.S.C. § 1051 (2006).

<sup>29</sup> GHOSH ET AL., *supra* note 3, at 450. Copyrights and patents were intended to benefit society by promoting creativity and innovation. U.S. CONST. art. I, § 8, cl. 8.

<sup>30</sup> GHOSH ET AL., *supra* note 3, at 450.

<sup>31</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995).

<sup>32</sup> WORLD INTELLECTUAL PROP. ORG., *supra* note 6.

<sup>33</sup> *Id.* The financial profit will come from consumers’ preference on certain products based on their recognition of the trademark associated with the product.

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* With respect to the impact on international trade, imagine that developing countries like China and Thailand, can effectively prevent unfair competition by combating counterfeits. If it is true, then luxury brands like Kenzo will be more willing to introduce its products in these countries, for its potential market will be less likely to be threatened by fake products.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

Generally, a trademark can be renewed indefinitely, if the owner pays renewal fees.<sup>38</sup> Courts enforce trademarks through actions for trademark infringements.<sup>39</sup> The effects of such registration and protection are, however, limited by the country or region's borders.<sup>40</sup>

In addition to national or regional registration, WIPO administers a system of international trademark registration.<sup>41</sup> This system is governed by two treaties, the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol.<sup>42</sup> A person who has some connection with a member of one or both of the treaties may receive an international registration, which will be effective in some or all of the other country members of the Madrid Union by simply registering in that member country's trademark office.<sup>43</sup>

## B. THE SCOPE OF PROTECTION OF NONTRADITIONAL TRADEMARKS

In recent years, trademark owners have been seeking to extend the protections of trademarks to items previously deemed ineligible for registration.<sup>44</sup> Traditional trademarks consist of words, numerical and two-dimensional designs. However, as the result of international treaties dealing with intellectual property, the definition of "trademark" has gradually broadened. Individuals and organizations are now trying to register various kinds of marks, such as those for motions, colors,

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* See also *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004) ("The holder of a registered mark (incontestable or not) has a civil action against anyone employing an imitation of it in commerce when 'such use is likely to cause confusion, or to cause mistake, or to deceive.'").

<sup>40</sup> WORLD INTELLECTUAL PROP. ORG., *supra* note 6.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* See generally List of Members of the Madrid Union, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf) (last updated Oct. 14, 2011).

<sup>43</sup> WORLD INTELLECTUAL PROP. ORG., *supra* note 6.

<sup>44</sup> Catherine Saez, *Some See Rise in Non-Traditional Trademarks; National Registries Not Yet*, INTELLECTUAL PROPERTY WATCH (Jun. 20, 2008, 1:45 PM), <http://www.ip-watch.org/weblog/2008/06/20/some-see-rise-in-non-traditional-trademarks-national-registries-not-yet/>. As Matthew Schmidt, communications manager of the International Trademark Association (INTA) said, "Non-traditional trademarks are on the rise because new technology and new innovation are allowing brand owners to protect intellectual property never seen before." *Id.*



sounds, scents, and holograms.<sup>45</sup> Courts and administrative agencies in various countries must now determine whether nontraditional marks are sufficiently similar to traditional trademarks to receive similar protection.

### C. CASE LAW AND STATUTORY REGULATIONS: A PREVIEW

Courts in the United States have confronted difficult cases concerning nontraditional marks.<sup>46</sup> In a 1995 landmark case,<sup>47</sup> *Qualitex Co. v. Jacobson Products Co.*, the United States Supreme Court ruled that under the Lanham Act, a color used by Qualitex could meet the requirements for trademark registration.<sup>48</sup> In the opinion, Justice Breyer emphasized that the scope of registerable trademarks in the United States is potentially very broad.<sup>49</sup>

European courts have addressed the issue of nontraditional trademarks in the United States in a 2002 case. In *Ralf Sieckmann v. Deutsches Patent- und Markenamt*, the European Court of Justice emphasized the graphic representation requirement for trademark registration.<sup>50</sup> That is, the trademark should “be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”<sup>51</sup> This means that scent marks<sup>52</sup> and complicated sound marks would be difficult to register in the European

<sup>45</sup> Lesley Matty, *Rock, Paper, Scissors, Trademark? A Comparative Analysis of Motion as A Feature of Trademarks in the United States and Europe*, 14 CARDOZO J. INT’L & COMP. L. 557, 558 & n. 6 (2006).

<sup>46</sup> See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 160–61 (1995); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 25–26 (2001); *In re Vertex Group LLC*, 89 U.S.P.Q.2d (BNA) 1694 (T.T.A.B. 2009); *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d (BNA) 1393 (T.T.A.B. 2009).

<sup>47</sup> Daniel R. Schechter, Comment, *Qualitex Co. v. Jacobson Prods., Inc.: The Supreme Court “Goes for the Gold” and Allows Trademark Protection for Color Per Se*, 5 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 481, 482 (1995).

<sup>48</sup> *Qualitex*, 514 U.S. at 161.

<sup>49</sup> *Id.* at 162. According to the Lanham Act, trademarks can be “any word, name, symbol, or device, or any combination thereof [that is] (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. §1127 (2006).

<sup>50</sup> Sieckmann, *supra* note 10.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* The Court held that the requirement could not be met by a chemical formula, a description in written words, the deposit of an odor sample or a combination of those elements. And therefore technically a scent cannot be described in the European Union. *Id.*

Union, because it is almost impossible to represent them graphically.<sup>53</sup> Although the scope of European Union (EU) trademarks is still broad, it is different and arguably narrower than in the United States.<sup>54</sup>

Asian countries are also trying to find a balanced solution to the nontraditional trademark. The conservative Japanese courts opened the door to nontraditional trademark registration when they granted trademark registration for Coca-Cola's glass bottle.<sup>55</sup> In February 2007, the Japan Patent Office (JPO) announced its final rejection of Coca-Cola's request to register its bottle as a three-dimensional trademark. Coca-Cola later appealed the JPO's decision. The Japan Intellectual Property High Court in May 2008 approved the trademark application, based on the finding that the mark acquired distinctiveness through extensive use in the market.<sup>56</sup>

China is also taking steps to deal with newly emerging intellectual property issues including nontraditional trademarks. Since 2000, China has been revising intellectual property laws. The 2001 Amendment of the Trademark Law added three-dimensional objects as the trademarkable subject matter.<sup>57</sup> Article 12 of the Trademark Law provides that, when an applicant is seeking trademark registration for three-dimensional marks, he or she may fail if 1) the three-dimensional figure is generated simply by the nature of the products, 2) the figure is necessary for technical effects or 3) the figure contributes substantial value to the products.<sup>58</sup> At present, the Chinese legislature and government are proposing new amendments to the Trademark Law to keep up with international progress.<sup>59</sup>

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<sup>53</sup> See *Id.*

<sup>54</sup> Notably, a scent can be registered as a trademark in the United States. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

<sup>55</sup> Adachi, *supra* note 16, at 26.

<sup>56</sup> *Id.* at 3, 8.

<sup>57</sup> Juanjuan Zhang, *Coca-Cola Failed to Obtain a Registered Three-Dimensional Trademark for Fanta After Its 8-Year Application in China*, DAILY FINANCIAL NEWS, <http://money.163.com/10/1230/02/6P4BBLUH00253B0H.html> (last update Dec. 30, 2010).

<sup>58</sup> Shangbiao Fa (商标法) [Trademark Law of the People's Republic of China] (promulgated by the Standing Comm. Nat'l People's Cong., Oct. 27, 2001, effective Dec. 1, 2001), art. 12 (2001) (China) <http://www.people.com.cn/zixun/flfgk/item/dwjf/falv/7/7-3-01.html>.

<sup>59</sup> Robert H. Hu, *International Legal Protection of Trademarks in China*, 13 MARQ. INTELL. PROP. L. REV. 69, 116 (2009).

#### **D. BACKGROUND INFORMATION ABOUT KENZO AND ITS FRAGRANCES**

Kenzo's efforts in registering its fragrance bottles as trademarks provide an example of the recent trend of trying to trademark nontraditional items. Kenzo (specifically, its fragrance manufacturer, Kenzo Parfums) has created many of the most groundbreaking fragrances which have creatively designed bottles in the past few decades.<sup>60</sup> Flower by Kenzo, Kenzo Pour Homme EDT, Tokyo By Kenzo EDT and Kenzo Power EDT will be the examples to illustrate different regulatory regimes on three-dimensional marks in different jurisdictions.

### **II. CURRENT REGULATORY REGIMES IN THE WORLD**

In this part, this paper will introduce the international protection trademark owners may enjoy under the Madrid System, as well as the regulation regimes on trademarks in general as well as nontraditional marks in the United States, the European Union, Japan, and China. This introduction makes possible the comparative analysis in the next part on these four regimes, which will cover both common law jurisdictions and civil law jurisdictions, both Western countries and Eastern countries, and both developed countries and developing countries, and provide some guidance to the globalized world in general.

#### **A. INTERNATIONAL TRADEMARK PROTECTION**

##### **1. WIPO**

WIPO is a specialized agency of the United Nations (UN).<sup>61</sup> Its aim is to develop a balanced and accessible international intellectual property system that will reward creativity, stimulate innovation and contribute to economic development while protecting the public

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<sup>60</sup> *About Kenzo – Company History*, KENZOUSA.COM, <http://www.kenzousa.com/about-kenzo#aboutkenzo-companyhistory> (last visited Dec. 30, 2011).

<sup>61</sup> *What is WIPO?*, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/about-wipo/en/what\\_is\\_wipo.html](http://www.wipo.int/about-wipo/en/what_is_wipo.html) (last visited Dec. 30, 2011).

interest.<sup>62</sup> WIPO established the Madrid System for the International Registration of Marks to realize these goals.<sup>63</sup>

## 2. INTERNATIONAL TRADEMARK PROTECTION: THE MADRID SYSTEM

The Madrid System for the International Registration of Marks (the Madrid System) was established in 1891.<sup>64</sup> It functions under the Madrid Agreement (1891) and the Madrid Protocol (1989), and is administered by the International Bureau of WIPO.<sup>65</sup>

With the international registration system, the Madrid System gives trademark owners the possibility to have their trademarks protected in Madrid Union member countries by filing one application directly with his own national or regional trademark office.<sup>66</sup> An international mark registered in this way is equivalent to a registration of the same mark directly in each of the countries by the applicant.<sup>67</sup> If one member country's trademark office fails to respond within a specified period, the protection of the mark is the same as if it had been registered in that country.<sup>68</sup> The mark can enjoy the extended protection in the latter country.<sup>69</sup> The Madrid System also simplifies the subsequent management of the registered mark.<sup>70</sup>

Three-dimensional marks registered under the Madrid System generally use the International Classification of the Figurative Elements of Marks (Vienna Classification).<sup>71</sup> It is an international classification established by the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks in 1973,<sup>72</sup> which puts the figurative elements of marks into categories, divisions and sections

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<sup>62</sup> *Id.*

<sup>63</sup> See *Madrid System for the International Registration of Marks*, WORLD INTELLECTUAL PROP. ORG., <http://www.wipo.int/madrid/en/> (last visited Dec. 30, 2011).

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

<sup>66</sup> For a list of the Members of the Madrid Union, see WORLD INTELLECTUAL PROP. ORG., *supra* note 42.

<sup>67</sup> WORLD INTELLECTUAL PROP. ORG., *supra* note 63.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> See *International Classification of the Figurative Elements of Marks (Vienna Classification)*, WORLD INTELLECTUAL PROP. ORG., <http://www.wipo.int/classifications/vienna/en/> (last visited Dec. 30, 2011).

<sup>72</sup> *Id.*

from general to specific, based on their shapes into a hierarchical system.<sup>73</sup>

## B. THE UNITED STATES

### 1. FEDERAL STATUTE: THE LANHAM ACT

The Lanham Act is the federal trademark law of the United States.<sup>74</sup> The Lanham Act defines a trademark as “any word, name, symbol, or device, or any combination thereof [that is] (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>75</sup>

Subchapter I (§§ 1051–1072) of the Lanham Act is about the Principal Register.<sup>76</sup> There are three requirements for federal trademark registration on the Principal Register: (1) the mark must be used in interstate commerce; (2) the mark must be distinctive; and (3) the mark must not be barred from registration under § 1052.<sup>77</sup> One of the most important grounds to reject applications in § 1052 is subsection (e) (5), that the mark “comprises any matter that, as a whole, is functional.”<sup>78</sup> Federal registration provides nationwide protection for the mark and prima facie evidence of its validity. After five years of continuous registration and use, trademarks become incontestable.<sup>79</sup>

Distinctiveness is particularly important to nontraditional trademarks. To be registered, a mark must be capable of distinguishing the applicant’s goods from those of others.<sup>80</sup> Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly in 1976, they may be (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.<sup>81</sup> The latter

<sup>73</sup> *Id.*

<sup>74</sup> See 15 U.S.C. § 1051 (2006).

<sup>75</sup> 15 U.S.C. § 1127 (2006).

<sup>76</sup> *Id.*

<sup>77</sup> GHOSH ET AL., *supra* note 3, at 463.

<sup>78</sup> 15 U.S.C. § 1052(e) (5) (2006).

<sup>79</sup> 15 U.S.C. § 1065 (2006).

<sup>80</sup> GHOSH ET AL., *supra* note 3, at 484.

<sup>81</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976).

three are deemed inherently distinctive and no further proof is needed.<sup>82</sup> In contrast, generic marks are not registerable as trademarks.<sup>83</sup> As for the descriptive marks, they may acquire distinctiveness allowing them to be protected under the Lanham Act.<sup>84</sup> The acquired distinctiveness is generally called “secondary meaning.”<sup>85</sup> That is, the public views its primary significance as identifying the source rather than the product itself.<sup>86</sup>

## 2. CASES

### *a. Qualitex Co. v. Jacobson Products Co., Inc. (1995)*

As discussed above but retained here for consistency, *Qualitex* may be one of the most influential cases in the United States regarding nontraditional trademarks. Many decades ago, the shape of a Coca-Cola bottle, a sound of NBC’s three chimes, and a scent of plumeria blossoms on sewing thread had already been registered as valid federal trademarks in the United States.<sup>87</sup> The *Qualitex* case, however, was the first time the U.S. Supreme Court clearly included that the extremely broad scope of registerable trademarks potentially included colors.<sup>88</sup>

In *Qualitex*, the U.S. Supreme Court held that the Lanham Act permits registration of a trademark that consists only of a color.<sup>89</sup> Justice Breyer said that “[b]oth the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark.”<sup>90</sup> This broad holding illuminated many later opinions.<sup>91</sup> For the distinctiveness requirement, the Supreme Court stated that although a color alone could not be

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 10.

<sup>85</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>86</sup> *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 38 (1st Cir. 2001).

<sup>87</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995). *See also* COCA-COLA, Registration No. 0696147; THE MUSICAL NOTES G, E, C, PLAYED ON CHIMES, Registration No. 0916522; *In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990).

<sup>88</sup> *See Schechter*, *supra* note 47.

<sup>89</sup> *Qualitex*, 514 U.S. at 174.

<sup>90</sup> *Id.* at 162.

<sup>91</sup> According to LexisNexis Shepard’s summary, since it was decided, *Qualitex* has been followed by eighty-one and distinguished in 6 later opinions. Also, it has been mentioned in 1 concurring and 4 dissenting opinions, and explained in four opinions (as of Nov. 5, 2011).

“fanciful,” “arbitrary,” or “suggestive” as some words and designs,<sup>92</sup> it could nevertheless acquire distinctiveness if it has developed secondary meaning.<sup>93</sup> The District Court’s findings indicated that Qualitex’s green-gold color met all the requirements.<sup>94</sup> Finally, the Supreme Court upheld the validity of Qualitex’s registration of its color trademark.<sup>95</sup>

*b. Wal-Mart Stores v. Samara Bros. (2000)*

In *Wal-Mart*, respondent Samara alleged that Wal-Mart infringed on its trade dress by selling knockoff dresses.<sup>96</sup> The Court held that a product configuration, like color, could only become distinctive if it developed a secondary meaning.<sup>97</sup> In an action for unregistered trade dress infringement, a producer was required to establish secondary meaning in order to show that its trade dress is distinctive.<sup>98</sup> In short, the Court conditioned its acceptance of a product configuration trademark application on a showing of acquired distinctiveness.<sup>99</sup>

*c. Traffix Devices v. Marketing Displays (2001)*

After the expiration of Marketing Displays, Inc. (MDI)’s utility patents on its dual-spring design of a stand mechanism, Traffix copied the design and used in its own products.<sup>100</sup> MDI sued Traffix for trade dress infringement on the basis of design.<sup>101</sup> The Supreme Court held that the design or packaging of a product can be protected under the Lanham

<sup>92</sup> *Qualitex* 514 U.S. at 162–63. Fanciful, arbitrary, and suggestive marks are inherently distinctive and therefore satisfy the distinctiveness requirement of the Lanham Act. See generally *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

<sup>93</sup> *Qualitex*, 514 U.S. at 163. “[S]econdary meaning’ is acquired when ‘in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.’” *Id.* (alteration in original) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n.11 (1982)).

<sup>94</sup> *Id.* at 166. As for the distinctiveness, the mark acted as a symbol. The customers could identify the color as Qualitex’s, and therefore it had developed secondary meaning. *Id.*

<sup>95</sup> *Id.* at 174.

<sup>96</sup> *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 208–09 (2000). The Court defined “trade dress” as “a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product.” *Id.* at 209.

<sup>97</sup> *Id.* at 216.

<sup>98</sup> *Id.*

<sup>99</sup> Amir H. Khoury, *Three-Dimensional Objects as Marks: Does A “Dark Shadow” Loom over Trademark Theory?*, 26 CARDOZO ARTS & ENT. L.J. 335, 338–39 (2008).

<sup>100</sup> *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 25–26 (2001).

<sup>101</sup> *Id.* at 26.

Act, and may acquire a “distinctiveness which serves to identify the product with its manufacturer or source”.<sup>102</sup> However, the Court ruled against MDI on other grounds, finding that the design was functional, and the trademark protection could not be claimed for functional product features.<sup>103</sup> As for the definition of “functionality”, the Court relied on the language of *Qualitex*, that a functional feature is one “the exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.”<sup>104</sup> One scholar thought that this holding created a second impediment, the nonfunctionality requirement, to three-dimensional trademark registrations.<sup>105</sup>

### 3. TRADEMARK REGISTRATION FOR KENZO’S FRAGRANCE BOTTLES

On November 12, 2007, Kenzo filed an application to register the bottle of Tokyo By Kenzo EDT.<sup>106</sup> And it was registered on January 25, 2011.<sup>107</sup>



108

On October 13, 2008, Kenzo filed an application to register the bottle of Kenzo Power EDT Fresh.<sup>109</sup> It was abandoned on October 6, 2010.<sup>110</sup> The reason was the applicant’s failure to respond.<sup>111</sup>

<sup>102</sup> *Id.* at 28.

<sup>103</sup> *Id.* at 34.

<sup>104</sup> *Id.* at 32 (alteration in original) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

<sup>105</sup> The first hurdle is the acquired distinctiveness requirement. See Khoury, *supra* note 99, at 339.

<sup>106</sup> U.S. Trademark Application Serial No. 79,047,629 (filed Nov. 12, 2007).

<sup>107</sup> KENZO, Registration No. 3,910,262.

<sup>108</sup> *Id.* This is the image of the mark contained in the application. The description of the mark is “[t]he color(s) black, red, purple, brown, blue, yellow and green is/are claimed as a feature of the mark. The mark consists of a container design for Applicant’s products which has a wave effect to make the container appear distorted. The color black appears in a black background in the design with red, purple, brown, blue, yellow and green stripes appearing against the black background in the design.” *Id.*

<sup>109</sup> U.S. Trademark Application Serial No. 79,070,988 (filed Oct. 13, 2008).





112

On March 4, 2010, Kenzo filed an application to register the bottle of Flower By Kenzo.<sup>113</sup> It was registered on March 22, 2011.<sup>114</sup>



115

On April 12, 2010, Kenzo filed an application to register the bottle of Kenzo Pour Homme EDT.<sup>116</sup> It was registered on February 15,

<sup>110</sup> Notice of Abandonment, U.S. Trademark Application Serial No. 79,070,988 (Oct. 06, 2010).

<sup>111</sup> *Id.*

<sup>112</sup> Office Action, U.S. Trademark Application Serial No. 79,070,988 (filed Oct. 21, 2009). This is the image of the mark contained in the application. The description of the mark is “[t]he color(s) silver is/are claimed as a feature of the mark. The mark consists of a configuration of cylindrical bottle, in the color silver, with black and white shading to create a 3-dimensional effect, having straight sides, a curved top terminating in a narrow neck, and a flat lid with a convex top.” *Id.*

<sup>113</sup> U.S. Trademark Application Serial No. 79,081,641 (filed Mar. 4, 2010).

<sup>114</sup> KENZO, Registration No. 3,933,848.

<sup>115</sup> *Id.* This is the image of the mark contained in the application. The description of the mark is “[t]he color(s) red, black and green is/are claimed as a feature of the mark. The mark consists of the configuration of the container for the goods and the image on the container, that is, a perfume bottle containing the image of the flower standing vertically along the length of the bottle. The flower consists of a green stem and red and black petals. The bottle is transparent, with a flat base. Viewed from the front, the left side of the bottle curves inward from the base and then runs parallel to the straight right side, so that the top of the bottle is narrower than the bottom and the bottle has an asymmetrical appearance. The upper surface of the bottle slopes at an acute angle from left to right. The cap portion of the bottle includes a not visible recessed sprayer button containing the word ‘KENZO’.” *Id.*

<sup>116</sup> U.S. Trademark Application Serial No. 79,082,138 (filed Apr. 12, 2010).

2011.<sup>117</sup> It seems that the examination and approval process has become faster compared to what it was in 2007. It took Tokyo By Kenzo more than two years to receive its registration, while the period for Flower By Kenzo and Kenzo Pour Homme EDT was about one year.



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## C. THE EUROPEAN UNION

### 1. DIRECTIVES AND REGULATIONS

Within EU member states, national laws usually incorporate European Directives so that the trademark regulation in each jurisdiction can be similar. The Trademark Directive defines the registerable subject matter of trademarks. According to the Directive, a trademark may consist of “any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”<sup>119</sup>

<sup>117</sup> KENZO, Registration No. 3,919,070.

<sup>118</sup> *Id.* This is the image of the mark contained in the application. The description of the mark is: “[t]he color(s) blue is/are claimed as a feature of the mark. The mark consists of specific design features unique to the perfume bottle packaging, which is made up of a blue cap and bottle. The bottle is oval in cross-section. The bottle and cap together form an overall shape which appears roughly rectangular when viewed from the front, with the left upright edge of the rectangle tapering toward the right and with the right upright side of the bottle and cap consisting of a double curve. The right upright portion of the cap curves slightly inward in the middle of the cap. The right upright portion of the bottle curves slightly inward in the lower middle part of the bottle.” *Id.*

<sup>119</sup> Council Directive 89/104, art. 2, 1989 O.J. (L 40) 2 (EC).

Council Regulation on the Community trademark governs the issue of registerability of trademarks in the EU. Article 4 of the Regulation, establishes that “[a] Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”<sup>120</sup> Article 7 of the Regulation, entitled “Absolute grounds for refusal”, provides:

1. The following shall not be registered: (a) signs which do not conform to the requirements of Article 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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service; (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; (e) signs which consist exclusively of: (i) the shape which results from the nature of the goods themselves; or (ii) *the shape of goods which is necessary to obtain a technical result*; or (iii) the shape which gives substantial value to the goods; (f) trade marks which are contrary to public policy or to accepted principles of morality.<sup>121</sup>

## 2. CASES

The European Court of Justice issued its landmark opinion of *Ralf Sieckmann v. Deutsches Patent-und Markenamt* in 2002.<sup>122</sup> Since then, scent marks, hologram marks, shapeless colors, light marks, as well as complex sound marks and motion marks, generally have been reviewed under increasing scrutiny when applicants seek to register

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<sup>120</sup> Council Regulation 40/94, art. 4, 1994 O.J. (L 11) 3 (EC).

<sup>121</sup> *Id.* at art. 7 (emphasis added).

<sup>122</sup> Case C-273/00, *Sieckmann v. Deutsches Patent-und Markenamt*, 2002 E.C.R. I-11737.

them.<sup>123</sup> The EU Court of Justice held that Article 2 of the Trademark Directive requires that a trademark must be able to be represented graphically, particularly by “means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”<sup>124</sup> Particularly with respect to a scent, neither a chemical formula, a description in written words, nor the deposit of an odor sample or a combination of those elements could meet the graphical representation requirement.<sup>125</sup>

For three-dimensional shape marks, the chance for them to receive registrations may be greater. However, the EU courts and Office for Harmonization in the Internal Market (OHIM) can still find registrations invalid if marks fall within any subsection of Article 7, Council Regulation (EC) No 40/94.<sup>126</sup> The first possible ground upon which a trademark application could be rejected is distinctiveness under Article 7(b).<sup>127</sup> In 1996, the appellant Mag Instrument filed five applications for three-dimensional Community trademarks.<sup>128</sup> The three-dimensional objects were shapes of flashlights. The application was rejected by OHIM, the Second Board of Appeal of the Office, and the EU Court of First Instance.<sup>129</sup> The Court of Justice affirmed the rejection of the application, on the ground that the three-dimensional objects lacked the distinctiveness required by Article 7(b).<sup>130</sup> The evidence failed to show that “consumers did not need to become accustomed to the mark through the use made of it, but . . . it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings.”<sup>131</sup> At the end of the opinion, the Court expressed that it could be more difficult to establish distinctiveness in a three-dimensional mark, because average consumers are not in the habit of associating the origin of products with their shape or the shape of their packaging, if there is not any graphic or word element on them.<sup>132</sup>

<sup>123</sup> See Sieckmann, *supra* note 10.

<sup>124</sup> Sieckmann, Case C-273/00 E.C.R. I-11771.

<sup>125</sup> *Id.* at I-11775.

<sup>126</sup> Case C-136/02 P, Mag Instrument Inc. v. OHIM, 2004 E.C.R. I-9165.

<sup>127</sup> *Id.* at I-9185.

<sup>128</sup> *Id.*

<sup>129</sup> *Id.* at I-9187.

<sup>130</sup> *Id.* at I-9212–13.

<sup>131</sup> *Id.* at I-9205.

<sup>132</sup> *Id.* at I-9212.



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Alternatively, another ground for rejecting trademark applications is Article 7(1)(e)(ii), which is similar to the nonfunctionality requirement in the United States. In 1996, LEGO filed a trademark application for a red three-dimensional LEGO toy brick, and subsequently received the registration.<sup>134</sup> However, in the EU, another party contended that the shape of the LEGO brick is unsuitable for trademark registration, because of Article 7(1) (e) (ii) of Regulation No 40/94, which states signs that consist exclusively of the shape of goods necessary to obtain a technical result are unregistrable.<sup>135</sup> The European Court of Justice found against LEGO.<sup>136</sup> It reasoned:

[T]he position of an undertaking which has developed a technical solution cannot be protected - with regard to competitors placing on the market slavish copies of the product shape incorporating exactly the same solution - by conferring a monopoly on that undertaking through registering as a trade mark the three-dimensional sign consisting of that shape.<sup>137</sup>

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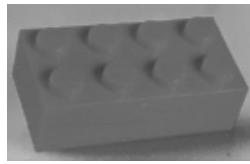
<sup>133</sup> A photograph of one of the flashlight shapes in the applications, “3 C-Cell Mag-Lite.” *See id.* at I-1986.

<sup>134</sup> Case C-48/09 P, *Lego Juris A/S v. OHIM*, 2010 E.C.R., at ¶ 9 (EUR-Lex).

<sup>135</sup> *Id.* at ¶ 12.

<sup>136</sup> *Id.* at ¶ 87.

<sup>137</sup> *Id.* at ¶ 61.



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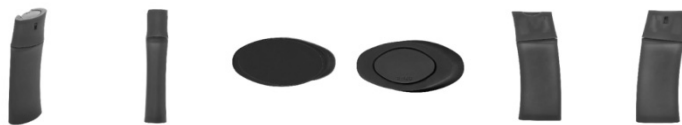
### 3. TRADEMARK REGISTRATION FOR KENZO FRAGRANCE'S BOTTLES

A three-dimensional trademark for the bottle of Flower By Kenzo was successfully registered in OHIM in May 2010.<sup>139</sup> It also received international trademark registration under the Madrid System in the same month.<sup>140</sup>



141

The application of Kenzo Pour Homme EDT's was published in 2010.<sup>142</sup> It also received international trademark registration under the Madrid System in April 2010.<sup>143</sup>



144

<sup>138</sup> *Id.* A photograph of the Lego toy brick is contained in the opinion.

<sup>139</sup> KENZO, Community Registration No. 8,532,442.

<sup>140</sup> KENZO, International Registration No. 1,036,168.

<sup>141</sup> KENZO, Community Registration No. 8,532,442.

<sup>142</sup> See Community Trade Mark Application No. 8,609,372 (filed Dec. 10, 2009).

<sup>143</sup> KENZO, International Registration No. 1,037,491.

The bottle of Tokyo by Kenzo received its registration in April 2008.<sup>145</sup> It also received international trademark registration under the Madrid System in November 2007.<sup>146</sup>



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Instead of a three-dimensional mark, Kenzo Power's bottle was registered as a figurative mark in European Union in 2009.<sup>148</sup> It has received three different international registrations.<sup>149</sup> Two are protected through the Madrid System and one is registered with the European Community.<sup>150</sup>



151

<sup>144</sup> Community Trade Mark Application No. 8,609,372 (filed Dec. 10, 2009).

<sup>145</sup> KENZO, Community Registration No. 5,931,407.

<sup>146</sup> KENZO, International Registration No. 947,245.

<sup>147</sup> *Id.*

<sup>148</sup> KENZO, International Registration No. 1,048,960.

<sup>149</sup> See KENZO POWER, Community Registration No. 8,698,532; KENZO, International Registration No. 1,048,960; KENZO, International Registration No. 1,050,955.

<sup>150</sup> See KENZO POWER, Community Registration No. 8,698,532; KENZO, International Registration No. 1,048,960; KENZO, International Registration No. 1,050,955.

<sup>151</sup> See KENZO POWER, Community Registration No. 8,698,532; KENZO, International Registration No. 1,048,960; KENZO, International Registration No. 1,050,955.

There are less than 10 other international trademark registrations of Kenzo's bottles.<sup>152</sup> All of them were first registered in France.<sup>153</sup> The international protections have been extended to several countries, including some European countries.<sup>154</sup> None of them, however, has received extended protection in the United States, EU, Japan or China.<sup>155</sup>

#### D. JAPAN

Asian countries are also facing the challenge brought by nontraditional marks. This article will take one developed Asian country, Japan, and one developing Asian country, China as examples in examining regulatory regimes on three-dimensional trademarks in Asia.

##### 1. STATUTES AND GUIDELINES

This part will discuss the Trademark Act and the Japan Patent Office Guidelines, which constitute the basic regulatory framework on trademarks in Japan.

###### *a. The Trademark Act*

Japanese laws have been protecting trademarks since 1884.<sup>156</sup> The current Trademark Act took effect in 1959, and has been amended

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<sup>152</sup> See KENZO, International Registration No. 531,333; KENZO, International Registration No. 595,525; KENZO, International Registration No. 595,955; KENZO, International Registration No. 628,984; KENZO, International Registration No. 667,715; KENZO, International Registration No. 693,955. Currently all of them are valid.

<sup>153</sup> See KENZO, International Registration No. 531,333; KENZO, International Registration No. 595,525; KENZO, International Registration No. 595,955; KENZO, International Registration No. 628,984; KENZO, International Registration No. 667,715; KENZO, International Registration No. 693,955.

<sup>154</sup> See KENZO, International Registration No. 531,333; KENZO, International Registration No. 595,525; KENZO, International Registration No. 595,955; KENZO, International Registration No. 628,984; KENZO, International Registration No. 667,715; KENZO, International Registration No. 693,955.

<sup>155</sup> See KENZO, International Registration No. 531,333; KENZO, International Registration No. 595,525; KENZO, International Registration No. 595,955; KENZO, International Registration No. 628,984; KENZO, International Registration No. 667,715; KENZO, International Registration No. 693,955.

<sup>156</sup> Kenneth L. Port, *Protection of Famous Trademarks in Japan and the United States*, 15 Wis. INT'L L.J. 259, 262 (1997).



about twenty times to incorporate national and international changes.<sup>157</sup> This article will discuss its latest amendment, the Trademark Act of 1996. In Article 3 and 4, the statute provides some absolute grounds for rejecting trademark applications. The most notable ones are Article 4, Paragraph 1, Item 18, “trademarks consisting solely of a three-dimensional shape of goods or their packaging with the shape being indispensable to secure the functions of the goods or their packaging. . .”<sup>158</sup>, and Article 3, Paragraph 1, Item 3 and Paragraph 2, the “distinctiveness” requirement in Japan.<sup>159</sup>

In Article 3, Paragraph 1, Item 3 of the Japanese Trademark Act, an absolute ground for denying registerability of a trademark is that, if a trademark consists solely of a mark showing the shape, or packaging of the product, it will not receive registration.<sup>160</sup> The “inherent distinctiveness” in Japan is very rigid.<sup>161</sup>

Article 3, Paragraph 2 of the Trademark Act addresses three-dimensional trademark registration.<sup>162</sup> When a claim is based on Article 3 Paragraph 2, the trademark must have the capability of being distinguished in use.<sup>163</sup> In order to claim distinctiveness, the trademark must be identical to the pertinent trademark, and must be identical to the goods that use that trademark.<sup>164</sup> Generally, a trademark without inherent distinctiveness can be registerable, if consumers are able to associate the goods or services of the business with the use of the trademark.<sup>165</sup>

For claims based on the “distinctiveness” requirement of Article 3, Paragraph 2 of the Trademark Act, a mark in registration must be identical to the mark actually used.<sup>166</sup> Therefore, a three-dimensional trademark generally cannot be registered if it bears another two-dimensional trademark (e.g., a Coca-Cola bottle with the letters “Coca-Cola” on it) when it is actually used in commerce.<sup>167</sup>

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<sup>157</sup> Japan: Trademark Act (Act No. 127 of April 13, 1959, as last amended by Act No. 16 of April 18, 2008), WIPO.INT, <http://www.wipo.int/wipolex/en/details.jsp?id=6957> (last visited Dec. 30, 2011).

<sup>158</sup> Shōhyōhō [Trademark Act], Law No. 127 of 1959, art. 4 (Japan). The nonfunctionality requirement is specific to three-dimensional trademarks in Japan. *Id.*

<sup>159</sup> *Id.* at art. 3.

<sup>160</sup> *Id.*

<sup>161</sup> Weiss & Takahashi, *supra* note 10.

<sup>162</sup> Shōhyōhō [Trademark Act], Law No. 127 of 1959 (Japan). art. 3.

<sup>163</sup> *Id.*

<sup>164</sup> *Id.*

<sup>165</sup> Weiss & Takahashi, *supra* note 10.

<sup>166</sup> Adachi, *supra* note 16, at 22.

<sup>167</sup> *Id.*

*b. Japan Patent Office Guidelines*

The Japan Patent Office uses its examinational manual (hereafter “Guidelines”) in determining the registerability of trademarks. The Guidelines may be confusing.<sup>168</sup> With respect to the distinctiveness requirement, the JPO generally interprets it very restrictively.<sup>169</sup> Three-dimensional marks that are, as consumers recognize, merely within the scope of the products’ configurations, cannot receive registrations.<sup>170</sup> A shape cannot be inherently distinctive even if it is new, unique, and characteristic in appearance if it is “potentially adoptable by competitors.”<sup>171</sup>

According to the Guidelines, there is an exception to the Article 3 Paragraph 2, if an applicant can show that (i) the three-dimensional shaped portion and the trademark in the application are identical; (ii) for the three-dimensional shaped mark to function, it is not necessary to have a two dimensional mark attached, but rather, by rendering changes or attaching decorations to the two-dimensional shape, the three-dimensional trademark can strongly impress upon the consumers more than the two-dimensional mark; and (iii) all the objective evidence has been submitted is enough to establish that the trademark is now acknowledged by the consumers as connected to the product and the applicant’s business.<sup>172</sup>

When applying the exceptional rule, a claim based on distinctiveness will not be rejected simply on the ground that the whole trademark composition is not identical.<sup>173</sup> Instead, the issue becomes whether the three-dimensional shaped portion of the trademark can be deemed as independently functional that can differentiate the source of the applicant’s product and its competitors.<sup>174</sup> If so, the mark may be able to receive registration.<sup>175</sup>

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<sup>168</sup> See, e.g., *id.* at 23.

<sup>169</sup> See Weiss & Takahashi, *supra* note 10.

<sup>170</sup> *Id.*

<sup>171</sup> *Id.*

<sup>172</sup> Adachi, *supra* note 16, at 23.

<sup>173</sup> *Id.*

<sup>174</sup> *Id.*

<sup>175</sup> See *id.*

## 2. CASES

Despite the rigid rules, there have been several famous three-dimensional marks successfully registered in Japan, like the doll of Fujiya restaurant's,<sup>176</sup> the statue of Waseda University,<sup>177</sup> and Ajinomoto's bottle.<sup>178</sup>



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<sup>176</sup> FUJIYA, Japan Registration No. 4,157,614.

<sup>177</sup> WASEDA, Japan Registration No. 4,164,983.

<sup>178</sup> AJINOMOTO, Japan Registration No. 5,009,334.

<sup>179</sup> FUJIYA, Japan Registration No. 4,157,614. The doll of Fujiya restaurant is now a registered three-dimensional trademark, the registration has two drawings. *Id.*

<sup>180</sup> WASEDA, Japan Registration No. 4,164,983. The statue of Waseda University is now a registered three-dimensional trademark, the photo is one of the four contained in the registration.



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In recent years, more and more corporations in Japan have been seeking three-dimensional trademark registrations. Successful or not, there are some notable landmark cases among them.

One case, *Yakult Honsha v. Commissioner of the JPO*, illustrates the rigid standard of “inherent distinctiveness” in Japan.<sup>182</sup> The Japan IP Court found one three-dimensional mark unregistrable. The item in question was the packaging of Yakult, the plaintiff’s lactic-acid beverage.<sup>183</sup> To reach this result, the Court reasoned that the packaging had some unique features, but all its characteristics could still be potentially adopted by the plaintiff’s competitors, in light of “the manufacturing method, usage, and function of plastic lactic-acid containers in general.”<sup>184</sup> Another case, *Okaya v. Commissioner of the JPO*, explains how the Court would determine traditionally whether the “acquired distinctiveness” standard could be met.<sup>185</sup> In this case, the plaintiff sought to register a three-dimensional mark.<sup>186</sup> It consisted of the shape of a plastic pencil that is used on golf courses.<sup>187</sup> The Japan IP Court rejected the registration, and held that the three-dimensional shape failed to acquire secondary meaning independently, because words such as “Okaya” and “pencil” appeared on the plaintiff’s products, with which consumers associated the products.<sup>188</sup> And the plaintiff never sold or

<sup>181</sup> AJINOMOTO, Japan Registration No. 5,009,334. This bottle is now a registered three-dimensional trademark owned by Ajinomoto, this photo is one of the three contained in the registration.

<sup>182</sup> Weiss & Takahashi, *supra* note 10.

<sup>183</sup> *Id.*

<sup>184</sup> *Id.*

<sup>185</sup> *Id.*

<sup>186</sup> *Id.*

<sup>187</sup> *Id.*

<sup>188</sup> *Id.*

produced products identified solely by the shape of pencil without words on it.<sup>189</sup>

The use of words on the shape usually disqualified Japanese applicants.<sup>190</sup> However, this situation partially changed by the Japan IP Court's decision in *Mini Maglite v. Commissioner of the JPO*.<sup>191</sup> In 2007, the Japan IP Court recognized the product configuration of the Mini Maglite flashlight as a three-dimensional trademark.<sup>192</sup> In the opinion, the Court stated the general rule concerning the acquired distinctiveness in Japan.<sup>193</sup>

“Whether distinctiveness is gained as a result of the use of a trademark consisting of the three-dimensional shape of a product shall be determined by looking at, in aggregate, the shape of the product, the starting date of usage, usage period, usage region, sales volume of the product, advertising period, region and scale, [and] the existence of other products with a similar shape.”<sup>194</sup>

The Japan IP Court further held, however, that it is not appropriate to deny acquired distinctiveness solely and directly by the word mark of the source company on the product.<sup>195</sup> Instead, “whether the three-dimensional shape appears conspicuous to consumers,” “whether it leaves a strong impression in the consumers,” and other circumstantial factors should be used to determine whether the application meets the independently acquired distinctiveness standard.<sup>196</sup>

In 2008, 49 years after the company received its bottle mark registration in the United States,<sup>197</sup> the Japan Intellectual Property High Court approved the registration of Coca-Cola's famous bottle as its trademark.<sup>198</sup> In reaching this result, the Japan IP Court took another step

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<sup>189</sup> *Id.*

<sup>190</sup> *Id.*

<sup>191</sup> *Id.* Interestingly, Mag Instrument (the manufacturer of Mini Maglite) failed to obtain three-dimensional trademark registrations for its torch shapes in the European Union. See *supra* notes 128–32 and accompanying text.

<sup>192</sup> Weiss & Takahashi, *supra* note 10.

<sup>193</sup> *Id.*

<sup>194</sup> *Id.*

<sup>195</sup> *Id.*

<sup>196</sup> *Id.*

<sup>197</sup> See COCA-COLA, Registration No. 696,147.

<sup>198</sup> Adachi, *supra* note 16, at 8.

to welcome three-dimensional trademarks after the Mini Maglite case.<sup>199</sup> It rejected the JPO's examining standard in the Guidelines concerning the distinctiveness requirement in the Trademark Act.<sup>200</sup> The Court held that the mark had acquired distinctiveness through the evidence of its extensive use in the market, although the bottle used in the market bears the word mark prominently.<sup>201</sup> In sum, Japan has adopted for three-dimensional marks the same rule used for two-dimensional marks.<sup>202</sup> The future standard will require an applicant to establish the following: 1) the three-dimensional portion actually used in the market and the trademark sought for registration are substantially identical; and 2) a totality of objective evidence has established that the trademark is now recognized by the consumers as associated with the product of the applicant's business.<sup>203</sup> This case is a milestone representing Japan IP Court's 12-year effort since Japan recognized three-dimensional mark registration in 1997.<sup>204</sup>

Below are pictures of the two Coca-Cola bottles bearing the mark "Coca-Cola" currently registered in Japan.



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<sup>199</sup> *Id.* at 27.

<sup>200</sup> *Id.* at 29.

<sup>201</sup> *Id.* at 8.

<sup>202</sup> *See id.* at 29.

<sup>203</sup> *Id.* at 28.

<sup>204</sup> *Id.* at 30.

<sup>205</sup> COCA-COLA, Japan Registration No. 4,918,091.

<sup>206</sup> COCA-COLA, Japan Registration No. 4,993,660.

Compared to the two marks above, the newly registered Coca-Cola bottle mark does not have any word on it, as shown below.<sup>207</sup> To further compare, please also see the picture next to it, which is the illustration contained in the registration of Coca-Cola bottle in the United States.<sup>208</sup>



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### 3. TRADEMARK REGISTRATION FOR KENZO FRAGRANCE'S BOTTLES

So far, Japan has not recognized Flower By Kenzo's international registration as a three-dimensional mark. With respect to the bottles of Kenzo Pour Homme EDT and Kenzo Power EDT, neither of them has been recognized and registered in Japan yet. As for the bottle of Tokyo by Kenzo EDT, no information can be found in the JPO's database.<sup>211</sup>

## E. CHINA

### 1. STATUTES AND REGULATIONS

The first Chinese trademark law was enacted on August 23, 1982, thirty-three years after the founding of the PRC.<sup>212</sup> The 1982

<sup>207</sup> COCA-COLA, Japan Registration No. 5,225,619.

<sup>208</sup> COCA-COLA, Registration No. 696,147.

<sup>209</sup> COCA-COLA, Japan Registration No. 5,225,619.

<sup>210</sup> This is the picture of the Coca-Cola bottle registered in 1960 in the United States. It seems that the United States cares less about the Coca-Cola logo on the bottle. Specifically, its mark drawing code is (3), which is "decision plus words, letters, and/or numbers." See COCA-COLA, Registration No. 696,147.

<sup>211</sup> See *Japanese Trademark Database*, INDUSTRIAL PROPERTY DIGITAL LIBRARY, [http://www3.ipdl.inpit.go.jp/cgi-bin/ET/ep\\_main.cgi?1326142502351](http://www3.ipdl.inpit.go.jp/cgi-bin/ET/ep_main.cgi?1326142502351) (last visited Dec. 30, 2011).

<sup>212</sup> Hu, *supra* note 59, at 73.

Trademark Law, and its amendments in 1993 and 2001, are “a critical part of China’s economic development and modernization program,” as well as “a response to the political and diplomatic pressures for reform exerted primarily by the United States.”<sup>213</sup>

China joined the WTO in 2001 and has been involved more in the globalized economy ever since.<sup>214</sup> To keep up with the rapidly changing international trend in trademark registration area, in that same year, China amended its Trademark Law added three-dimensional objects as registerable subject matter. Specifically, Article 8 of the Trademark Law of the People’s Republic of China (2001 Amendment) provides:

An application for trademark registration may be filed for any visible mark including word, design, letter, number, 3D (three-dimension) mark or color combination, or the combination of the elements above mentioned, that can distinguish the commodities of the natural person, legal person or other organization from those of others.<sup>215</sup>

Article 11 establishes that a sign may not be registered as a trademark, if 1) it only has generic names, designs or models of the designated product; 2) it merely indicates the “quality, main raw materials, functions, use, weight, quantity or other characteristics” of designated product; or 3) it lacks distinctiveness.<sup>216</sup>

Specifically, Article 12 provides:

In case of application for trademark registration on 3D marks, the registration shall not be granted if the figures are generated simply by the nature of the commodities, the commodity figures are needed for technical effects or the figures make the commodities become substantially valuable.<sup>217</sup>

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<sup>213</sup> *Id.*

<sup>214</sup> *Id.*

<sup>215</sup> Shangbiao Fa (商标法) [Trademark Law of the People’s Republic of China] (promulgated by the Standing Comm. Nat’l People’s Cong., Oct. 27, 2001, effective Dec. 1, 2001), art. 8 (2001) (China) <http://www.people.com.cn/zixun/flfgk/item/dwjf/falv/7/7-3-01.html>.

<sup>216</sup> *Id.* at art. 11.

<sup>217</sup> *Id.* at art. 12.



With respect to three-dimensional trademarks, Chapter 2, Article 13 of the Implementing Regulations of the Trademark Law of the People's Republic of China (2002) provides that, "[w]here an application is filed for the registration of a three-dimensional sign as a trademark, a statement shall be made in the application, and the reproduction capable of defining the three-dimensional formation be submitted."<sup>218</sup>

China is still trying to make a transition.<sup>219</sup> It is trying to develop a national intellectual property regulatory regime that matches with the international norms.<sup>220</sup> In April 2007, the Supreme People's Court of China and the Supreme People's Procuratorate issued the Interpretation on the Application of Law to Several Issues Arising from the Handling of Intellectual Property Crime Cases.<sup>221</sup> This Interpretation has many sections on statutory criminal thresholds for cases involving intellectual property rights.<sup>222</sup> Very recently, China began drafting new trademark laws that will incorporate changes happening all over the world.<sup>223</sup>

## 2. CASES

Many companies have successfully received three-dimensional trademark registrations from the China's Trademark Office. Among them are the packaging of Toblerone Swiss chocolate, Zippo lighter, and Coca-Cola's cola bottle.

<sup>218</sup> Zhonghua Renmin Gongheguo Shangbiao Fa Shishi Tiaoli (中华人民共和国商标法实施条例) [Regulation for the Implementation of the Trademark Law] (promulgated by the St. Council, Aug. 3, 2002, effective Sept. 15, 2002), art. 13 (2002) (China).

<sup>219</sup> RICHARD P. SUTMEIER & XIANGKUI YAO, NAT'L BUREAU OF ASIAN RESEARCH, SPECIAL REPORT NO. 29, CHINA'S IP TRANSITION: RETHINKING INTELLECTUAL PROPERTY RIGHTS IN A RISING CHINA 2 (2011), available at [http://www.nbr.org/publications/specialreport/pdf/Preview/SR\\_29\\_ChinaStandards\\_preview.pdf](http://www.nbr.org/publications/specialreport/pdf/Preview/SR_29_ChinaStandards_preview.pdf).

<sup>220</sup> *Id.*

<sup>221</sup> Hu, *supra* note 59, at 116.

<sup>222</sup> *Id.*

<sup>223</sup> *Id.* at 117.

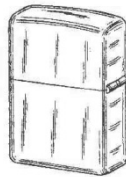


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Classification des éléments figuratifs:  
19.3; 25.1; 26.3; 27.5; 29.1.

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On November 12, 2007, the First Intermediate People's Court of Beijing rendered an opinion on whether FERRERO-Società per Azioni (Ferrero) could receive extended trademark protection for its chocolate packaging. It recognized Ferrero's international trademark registration of its chocolate packaging<sup>228</sup> as a three-dimensional trademark in China.<sup>229</sup> The Court found that the packaging and the color are special in the chocolate industry, and consumers can associate the packaging with Ferrero Rocher.<sup>230</sup> Therefore, the mark had acquired the distinctiveness required by Article 11, and could be registered.<sup>231</sup>

<sup>224</sup> This is the photo in the official trademark registration information of the shape of Toblerone Swiss chocolate. See KRAFT FOODS, China Registration No. G615994.

<sup>225</sup> This is the photo in the official trademark registration information of the packaging of Toblerone Swiss chocolate. See KRAFT FOODS, China Trademark Registration No. G615992.

<sup>226</sup> This is the photo in the official trademark registration information of Zippo's lighter. See ZIPPO, China Registration No. 3,031,816.

<sup>227</sup> This is the photo in the official trademark registration information of Coca-Cola's cola bottle. See COCA-COLA, China Registration No. 3,032,478.

<sup>228</sup> FERRERO, International Registration No. 783,985. The trademark was first registered in Italy. *Id.*

<sup>229</sup> FERRERO-Società per Azioni v. Comm'r of the Trademark Office, <http://www.marketbook.cn/zcxzlal/224051633.html> (last updated Feb. 11, 2010)

<sup>230</sup> *Id.*

<sup>231</sup> *Id.*



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Interestingly, Ferrero lost another case on the same day.<sup>233</sup> The First Intermediate People's Court of Beijing refused Ferrero's application to extend its international trademark registration<sup>234</sup> for its chocolate container, on the ground that it lacks distinctiveness as required by Article 11.<sup>235</sup> Ferrero appealed and in a final decision, the Higher People's Court of Beijing affirmed on March 12, 2008.<sup>236</sup> To support its decision, the court found that the visual effect of the mark to consumers is mainly only a transparent container.<sup>237</sup> The golden-red decorative strip is not manifest enough, and the tags are blank, although the golden ball-shaped objects could be seen from the outside of the container.<sup>238</sup> Merely a container is not enough for consumers to associate the mark with the source of the designated product, and therefore cannot meet the distinctiveness requirement.<sup>239</sup>



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In December 2010, Coca-Cola failed to obtain the trademark registration for its Fanta bottle in China despite eight years' efforts.<sup>241</sup> The Court held that the bottle could only contain beverage and lacked

<sup>232</sup> FERRERO, International Registration No. 783,985.

<sup>233</sup> FERRERO-Societa per Azioni v. Comm'r of the Trademark Office, <http://www.148com.com/html/47/406921.html> (last updated Apr. 7, 2008).

<sup>234</sup> FERRERO, International Registration No. 783,646.

<sup>235</sup> FERRERO-Societa per Azioni v. Comm'r of the Trademark Office, [http://ipr.chinacourt.org/public/detail\\_sfws.php?id=16537](http://ipr.chinacourt.org/public/detail_sfws.php?id=16537) (last updated Apr. 14, 2008).

<sup>236</sup> *Id.*

<sup>237</sup> *Id.*

<sup>238</sup> *Id.*

<sup>239</sup> *Id.*

<sup>240</sup> FERRERO, International Registration No. 783,646.

<sup>241</sup> Zhang, *supra* note 57.

distinctiveness required by Article 11, and a viewer cannot distinguish the source of the product.<sup>242</sup> This decision indicates that China's Trademark Office and courts still hold a conservative and cautious attitude towards three-dimensional trademarks, especially those with functional aspects.<sup>243</sup>



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### 3. TRADEMARK REGISTRATION FOR KENZO FRAGRANCE'S BOTTLES

So far China has not recognized the registration of Flower By Kenzo as a three-dimensional mark in International Trademark Registration (Madrid System). The international registrations of Kenzo Pour Homme EDT<sup>246</sup>, Tokyo by Kenzo<sup>247</sup> and Kenzo Power EDT<sup>248</sup> have been recognized in China according to the Trademark Office's official database. Also, so far, there has been no separate application or registration of Kenzo's fragrance bottles in China.

## IV. COMPARISON AND ANALYSIS

Putting four regulatory regimes together, it is easy to understand that some historically-reluctant countries have become more willing to accept three-dimensional trademark registrations. All of the four

<sup>242</sup> *Id.*

<sup>243</sup> *Id.*

<sup>244</sup> This picture shows the Fanta bottles in dispute. The Fanta bottles used in different countries may be different, and these bottles are used in China. See <http://www.jmxfw.com/ListMerchant/ViewProduct.aspx?merid=4291&pid=3034>.

<sup>245</sup> See Chinese Trademark Application Serial No. 3,330,291 (filed Oct. 8, 2002).

<sup>246</sup> See KENZO, China Registration No. G1037491.

<sup>247</sup> See KENZO, China Registration No. G947245.

<sup>248</sup> See KENZO, China Registration No. G1048960.

countries and regions discussed herein have a broad scope of “trademarkable” subject matter. The two hurdles in the United States case law, *i.e.*, distinctiveness and nonfunctionality, also exist in the other three.

#### A. THE SCOPE OF TRADEMARKABLE SUBJECT MATTER

The United States, the European Union, Japan, and China all define a very broad scope of trademarkable subject matter in their latest version of statutes or directives. In the United States, the Lanham Act defines a trademark as “any word, name, symbol, or device, or any combination thereof.”<sup>249</sup> Justice Breyer in *Qualitex* read the statute very broadly, since “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning.”<sup>250</sup> In the European Union, the Trademark Directive defines the trademarkable subject matter, as “any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging.”<sup>251</sup> The Japan Trademark Act of 1996, Article 2, Paragraph 1, provides that “[t]rademark” . . . means any character(s), sign(s), or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors.”<sup>252</sup> Article 8 of the China Trademark Law (2001 Amendment) defines registerable trademark as “. . . any visible mark including word, design, letter, number, 3D (three-dimensional) mark or color combination, or the combination of the elements above mentioned. . . .”<sup>253</sup>

The United States has the broadest scope of trademarkable subject matter. As Justice Breyer stated, the language in the Lanham Act alone is not restrictive.<sup>254</sup> In addition, the symbol and device, which are not in the statutory language of the other three countries and regions, are so broad that they can include “almost anything at all that is capable of carrying meaning” and used by human beings.<sup>255</sup>

<sup>249</sup> 15 U.S.C. § 1127 (2006).

<sup>250</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

<sup>251</sup> Council Directive 89/104, art. 2, 1988 O.J. (L 40) 2 (EC).

<sup>252</sup> Shōhyōhō [Trademark Act], Law No. 127 of 1959, art. 2 (Japan).

<sup>253</sup> Shangbiao Fa (商标法) [Trademark Law of the People’s Republic of China] (promulgated by the Standing Comm. Nat’l People’s Cong., Oct. 27, 2001, effective Dec. 1, 2001), art. 8 (2001) (China), <http://www.people.com.cn/zixun/flfgk/item/dwjf/falv/7/7-3-01.html>.

<sup>254</sup> See *Qualitex*, 514 U.S. at 162.

<sup>255</sup> *Id.*

With respect to the EU, Japan and China, their definitions are similar. There is one notable restriction in the EU's definition: the graphical representation requirement.<sup>256</sup> In China, a similar restriction can be found in the word "visible," although it is not as clear as "represented graphically," and there are insufficient case law or interpretations to establish its meaning. At least one inference with respect to nontraditional trademarks can be made. That is, sound marks and complex scent marks cannot receive successful registration in these two areas, since they can in no way be "graphically represented" or "visible."<sup>257</sup>

As for graphical representation for three-dimensional trademarks, the registrations in different countries and regions have different styles. In the European Union and Japan, the sample picture(s) contained in the registration information always contains more than one picture.<sup>258</sup> The pictures are generally of the same mark photographed from different perspectives.<sup>259</sup> In contrast, the registration information in the United States and China typically only has one picture.<sup>260</sup> And the pictures in the United States are sometimes real photos of the mark, while in China are generally linear perspective drawings.<sup>261</sup>

As for three-dimensional marks, they can now be registered in all of the four countries and regions.<sup>262</sup> Japan and China have accepted three-dimensional trademarks in recent years. In Japan the first successful three-dimensional trademark registration was in 1997,<sup>263</sup> and China added three-dimensional objects as trademarkable subject matter to its Trademark Law in 2001.<sup>264</sup>

Comparing different regulatory regimes, it might be more efficient and workable to have a broad enough scope of trademarkable subject matter, and then to specifically restrict it in subsequent sections of the statute. The initial scope should be broad, because the current

<sup>256</sup> Council Directive 89/104, art. 2, 1988 O.J. (L 40) 2 (EC).

<sup>257</sup> See *supra* notes 124–125 and accompanying text.

<sup>258</sup> See, e.g., KENZO, Community Registration No. 8,532,442; FUJIYA, Japan Registration No. 4,157,614.

<sup>259</sup> It is easy to understand that the pictures in the application will serve as evidence showing that the mark is capable of being represented graphically in the European Union.

<sup>260</sup> See, e.g., KENZO, Registration No. 3,933,848; COCA-COLA, China Registration No. 3,032,478.

<sup>261</sup> See KENZO, Registration No. 3,933,848; COCA-COLA, China Registration No. 3,032,478.

<sup>262</sup> The language of "the shape of goods or of their packaging" in the directive clearly indicates that the European Union recognize three-dimensional trademarks as trademarkable subject matter.

<sup>263</sup> Adachi, *supra* note 16, at 10.

<sup>264</sup> Zhang, *supra* note 57.

trend is that more and more nontraditional objects can represent products and business. Additionally, consumers are becoming more and more sophisticated with the help of new technology, and therefore they are more likely to associate the marks with the underlying product and business. As long as there can be clear and workable conditions in subsequent sections, there is no need to restrict the scope of marks at the very beginning. As Justice Breyer asked in *Qualitex*, “[i]f a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?”<sup>265</sup>

The representation requirement which limits the scope of registerable trademarks, seems too rigid, because at a minimum it will reject all scent marks.<sup>266</sup> However, to have more than one picture of the mark taken from different perspectives in the application and final registration is helpful, particularly when infringement suits are brought and courts have to determine the likelihood of confusion caused by a similar mark.

## B. THE “DISTINCTIVENESS” REQUIREMENT

In the United States, a trademark should be able to “identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>267</sup> In *Wal-Mart*, the Supreme Court held that product configuration can never be inherently distinctive and an applicant must show it has acquired secondary meaning.<sup>268</sup> Secondary meaning is acquired when “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”<sup>269</sup>

In the European Union, one absolute ground for rejection of trademark application is also distinctiveness: “trade marks which are devoid of any distinctive character.”<sup>270</sup> As for three-dimensional trademarks, an applicant must show that the mark has acquired

<sup>265</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

<sup>266</sup> This is not the main issue of this article. For more information about scent marks, see generally notes 124–25 and accompanying text.

<sup>267</sup> 15 U.S.C. § 1127 (2006).

<sup>268</sup> Khoury, *supra* note 99, at 338.

<sup>269</sup> *Qualitex*, 514 U.S. at 163 (alteration in original) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n.11 (1982)).

<sup>270</sup> Council Regulation 40/94, art. 7, 1994 O.J. (L 11) 4 (EC).

distinctiveness, *i.e.*, that “consumers did not need to become accustomed to the mark through the use made of it, but . . . it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings.”<sup>271</sup>

Japan also has the distinctiveness requirement.<sup>272</sup> It is impossible for a three-dimensional mark to meet the inherent distinctiveness standard, but if consumers can associate the goods or services of the business with the use of the trademark, it could be deemed to have acquired distinctiveness.<sup>273</sup> After the registration of Coca-Cola bottle, Japan will adopt for three-dimensional marks the same rule used for two-dimensional marks.<sup>274</sup> The future standard may be require that (1) the three-dimensional portion actually used in the market and the trademark sought for registration are substantially identical; and (2) a totality of objective evidence has established that the trademark is now recognized by the consumers as associated with the product of the applicant’s business.<sup>275</sup>

In China, Article 11(3) of the Trademark Law provides an applicant will not receive registration if its mark lacks distinctiveness.<sup>276</sup> The Chinese courts generally require the applicant to show that consumers are able to associate the mark with the underlying product and business, and distinguish the goods or services bearing the mark from the applicant’s competitors.<sup>277</sup>

Comparing the four standards of distinctiveness, it is clear that they are substantially identical. Three-dimensional marks cannot be inherently distinctive.<sup>278</sup> They can only acquire distinctiveness through consumer recognition.<sup>279</sup> However, there are still some slight differences. The most notable issue is whether a three-dimensional trademark can have a word or two-dimensional design mark on it. In the United States, there seems to be less concern about a three-dimensional trademark bearing a word or two-dimensional design mark on it. In the United

<sup>271</sup> See *supra* notes 126–33 and the accompanying text.

<sup>272</sup> See Shōhyōhō [Trademark Act], Law No. 127 of 1959, art. 2 (Japan).

<sup>273</sup> *Id.*

<sup>274</sup> Adachi, *supra* note 16, at 29.

<sup>275</sup> *Id.* at 28.

<sup>276</sup> Shangbiao Fa (商标法) [Trademark Law of the People’s Republic of China] (promulgated by the Standing Comm. Nat’l People’s Cong., Oct. 27, 2001, effective Dec. 1, 2001), art. 11 (2001) (China), <http://www.people.com.cn/zixun/flfgk/item/dwjf/falv/7/7-3-01.html>.

<sup>277</sup> See Zhang, *supra* note 57.

<sup>278</sup> Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 212 (2000).

<sup>279</sup> *Id.*



States, an applicant can choose whether to register a “design only” mark (a mark without bearing a word mark), or a “word and design” mark (a mark bearing a word mark).<sup>280</sup> However, in the EU, Japan, and China, the registration of a three-dimensional mark may be a problem if the three-dimensional trademark bears a word or two-dimensional design mark on it. In the EU and China, courts have expressed a concern that a consumer is unlikely to associate a flashlight shape or a chocolate container with the source of the underlying product if there is no word or two-dimensional design on it.<sup>281</sup> In Japan, although the “absolutely identical” requirement will have less effect after the Coca-Cola case, the mark still must be substantially identical to the object actually used in commerce, and the applicant bears the burden of raising circumstantial evidence showing the consumer recognition and the acquired distinctiveness.<sup>282</sup>

The old “absolutely identical” standard in Japan was too rigid. The important issue here is not whether the three-dimensional mark has to accompany some words or two-dimensional designs, but it is whether consumers associate the three-dimensional object, rather than the words or designs, with the underlying product and business. Therefore, it is acceptable that the three-dimensional mark has to bear some words or designs on it when used in commerce. The real issue before the trademark examiners, offices, and courts is whether consumers are able to distinguish the underlying product by recognizing its three-dimensional mark.

### C. THE “NONFUNCTIONALITY” REQUIREMENT

To deter unfair competition, functional items may not be registerable as trademarks. In the United States, according to the Lanham Act, Section 1052(e) (5), a mark cannot be registered if it “comprises any

<sup>280</sup> *Trademark Basics*, U.S. PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/basics/index.jsp> (last modified Jan. 6, 2011). In the United States, an applicant can choose to file either of the two mark formats: (1) standard character format; or (2) stylized or design format. The standard character format should be used to register “word(s), letter(s), number(s) or any combination thereof, without claim to any particular font style, size, or color, and absent any design element.” Registration of a mark in the standard character format will provide broad rights, namely use in any manner of presentation. The stylized or design format, on the other hand, may be proper if the applicant wishes to register a mark with a design element and/or word(s) and/or letter(s) having a particular stylized appearance to be protected.

<sup>281</sup> See *supra* notes 128–133, 235–241 and accompanying text.

<sup>282</sup> See *supra* notes 201–203 and accompanying text.

matter that, as a whole, is functional.”<sup>283</sup> In *Qualitex*, a functional feature is defined as one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.”<sup>284</sup>

In the European Union, according to Article 7(e) (ii) of the Regulation, a shape mark cannot receive its registration if “the shape of goods is necessary to obtain a technical result.”<sup>285</sup> With respect to this section, the EU Court of Justice expressed concerns based on unfair competition.<sup>286</sup> Competitors may launch into the market slavish copies of the product shape incorporating exactly the same technical feature.<sup>287</sup> To grant registration for these functional marks, is to confer a monopoly on the applicant and its business through registering a three-dimensional trademark.<sup>288</sup>

In Japan, trademarks which “consist solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function” are not registerable.<sup>289</sup> According to Japanese case law, if the characteristics of a mark can be potentially adopted by the applicant’s competitors, in light of “the manufacturing method, usage, and function of plastic lactic-acid containers in general,” it cannot be registered despite having some uniqueness.<sup>290</sup>

Further, in China, a trademark application will be rejected if the mark merely indicates the “quality, main raw materials, functions, use, weight, quantity or other characteristics” of the designated product.<sup>291</sup> In other words, if it is functional. Although most of China’s case law has focused on distinctiveness, the courts have shown some concerns about nonfunctionality. With respect to Fanta’s bottle, some evidence the court relied on was that the bottle’s use as an ordinary beverage container.<sup>292</sup> From that evidence, one can certainly draw the conclusion that the bottle lacks acquired distinctiveness. But one can also conclude that the bottle

<sup>283</sup> 15 U.S.C. § 1052(e)(5) (2006).

<sup>284</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

<sup>285</sup> Council Regulation 40/94, art. 7, 1994 O.J. (L 11) 4 (EC).

<sup>286</sup> See *supra* note 137 and accompanying text.

<sup>287</sup> *Id.*

<sup>288</sup> *Id.*

<sup>289</sup> Shōhyōhō [Trademark Act], Law No. 127 of 1959, art. 4 (Japan).

<sup>290</sup> Weiss & Takahashi, *supra* note 10.

<sup>291</sup> Shangbiao Fa (商标法) [Trademark Law of the People’s Republic of China] (promulgated by the Standing Comm. Nat’l People’s Cong., Oct. 27, 2001, effective Dec. 1, 2001), art. 11 (2001) (China), <http://www.people.com.cn/zixun/flfgk/item/dwjf/falv/77-3-01.html>.

<sup>292</sup> Zhang, *supra* note 57.

is merely functional and can potentially be used by the applicant's competitors as well. Another concern in China is the apparent inconsistency existing in its case law might be difficult to resolve. If Fanta's bottle, or Ferrero's chocolate box fails to acquire distinctiveness, or it is just functional, why could Coca-Cola's bottle, or Ferrero's individual chocolate packaging receive its registration? Although it seems that China gradually has begun to welcome three-dimensional trademarks, it remains unclear how Chinese decision makers will apply the nonfunctionality requirement in the future.

The standards of nonfunctionality also seem quite similar in each nation. Unfair competition concerns are shared by the four jurisdictions. In all four jurisdictions, a functional object is not registerable. However, the agencies and courts are still facing an unsolved dilemma. How much uniqueness will be enough to prevail over possible unfair competition concerns? A utility or design patent may solve this problem temporarily.<sup>293</sup> But as *Traffix* indicates, what about after its expiration?<sup>294</sup>

#### **D. PREDICTIONS FOR KENZO'S TRADEMARK REGISTRATIONS IN DIFFERENT JURISDICTIONS**

For the issue of trademarkable subject matter, Kenzo's bottles are clearly three-dimensional objects, and within the scope of trademarkable subject matter in all four jurisdictions.

Kenzo should establish that the fragrance bottles have acquired distinctiveness through their use in commerce. That is, the bottles enable consumers to distinguish Kenzo's fragrances from other fashion designers' fragrances. The difficulty for Kenzo is that, when choosing fragrances, consumers will first associate the unique scent, and then the word mark to the product and Kenzo's business. But it is also undeniable that a large number of consumers can associate the shape of bottle with the perfume and Kenzo. For many of them, the beautiful bottle may be an important factor when they are trying to decide which fragrance to buy.<sup>295</sup>

<sup>293</sup> For more information about utility and design patents, see *Patents*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/patents/index.jsp> (last modified Dec. 22, 2011).

<sup>294</sup> Generally, the protection for a patent can only last for 20 years. *General Information Concerning Patents*, U.S. PATENT & TRADEMARK OFFICE, 1 (Nov. 2011), [http://www.uspto.gov/patents/resources/general\\_info\\_concerning\\_patents.pdf](http://www.uspto.gov/patents/resources/general_info_concerning_patents.pdf).

<sup>295</sup> See *Fragrance Bottles - The Collectors*, COSMETICS BUSINESS (Feb. 22, 2010), [http://www.cosmeticsbusiness.com/technical/article\\_page/Fragrance\\_bottles\\_-\\_The\\_collectors\\_/47950](http://www.cosmeticsbusiness.com/technical/article_page/Fragrance_bottles_-_The_collectors_/47950).

Additionally, the issue of nonfunctionality is slightly difficult for bottle marks. Bottles undoubtedly have their functional feature as containers. However, the shape of fragrance bottles is also artistically important industrial designs and clearly has its uniqueness.<sup>296</sup> Different jurisdictions will weigh the factors in accordance with their statutes to determine whether the applications should be rejected on the ground of functionality.

Considering the substantive standards, Kenzo would have an easier task in the United States. Evidence can be presented that consumers are able to associate the particular bottles to the corresponding fragrance manufactured by Kenzo. Therefore the acquired distinctiveness can be established.<sup>297</sup> As for the nonfunctionality requirement, the bottle with artistic value is clearly not merely functional. Additionally, the exclusive use of the bottle would not “put competitors at a significant non-reputation-related disadvantage.”<sup>298</sup> Currently no fashion designer uses the same or similar bottles, even if most of the fragrance bottles have not been registered as trademarks. The fact also fits the above analysis, since except for the abandoned application of Kenzo Power EDT, all other fragrance bottles have been registered in the United States before the publication of this article in 2012.<sup>299</sup> The examination and approval process became faster,<sup>300</sup> which shows that the USPTO and its examiners may have become more comfortable and confident in dealing with these nontraditional trademark applications.

In the European Union, a similar analysis applies. First, as in the United States, Kenzo would meet the distinctiveness requirement if it could establish the required consumer recognition.<sup>301</sup> Second, as for the nonfunctionality requirement, it is clear that the bottle is not necessary to achieve a technical result, and can therefore pass the European Union’s test.<sup>302</sup> In fact, except that Kenzo Power EDT is registered as a figurative

<sup>296</sup> *Id.*

<sup>297</sup> *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162 (1995).

<sup>298</sup> *Id.* at 165.

<sup>299</sup> KENZO, Registration No. 3,910,262; KENZO, Registration No. 3,933,848; KENZO, Registration No. 3,919,070.

<sup>300</sup> It took Tokyo By Kenzo more than two years to receive its registration, while for Flower By Kenzo and Kenzo Pour Homme EDT, the period was about one year.

<sup>301</sup> *See supra* notes 93–94 and accompanying text.

<sup>302</sup> Council Regulation (EC) No 40/94, *supra* note 120, art. 7(e)(ii).

mark, all other three bottles have already been registered in the European Union as three-dimensional trademarks.<sup>303</sup>

In Japan, the situation is more complex. As for the distinctiveness requirement, it is clear that the bottle actually sold in the market has both the word mark on it and the perfume (scent) in it. Although the Court abandoned the “absolutely identical” standard, Kenzo still needs stronger evidence to support that (1) the bottle actually used in the market and the trademark sought for registration is substantially identical; and (2) a totality of objective evidence established that the bottle is now recognized by the consumers as associated with Kenzo and its fragrance.<sup>304</sup> With respect to the nonfunctionality requirement, the burden is lighter. The analysis is analogous to the European Union, and the key is also to establish consumer recognition.<sup>305</sup> It will take time for Japan to accept bottles as trademarks, especially when considering that none of the four fragrances has been registered or received extended protection in Japan.<sup>306</sup>

China has the most complex situation. Although both its distinctiveness and functionality standards are substantially similar to the other three jurisdictions, the Chinese market is unique. As a developing country, most consumers in China cannot afford luxury products like Kenzo’s fragrances. With respect to consumer recognition and acquired distinctiveness, Kenzo has a weaker case than Coca-Cola in Fanta’s case. As for the nonfunctionality requirement, the Chinese case law reflects a possible trend that China might be more reluctant in granting registration for three-dimensional container marks.<sup>307</sup> A possible reason is their functional features. In China, although Kenzo’s bottles may have more artistic value than Fanta’s bottle and Ferrero’s chocolate box, Kenzo still must provide sufficient evidence on the uniqueness and nonfunctionality of the bottles. However, it seems that China might be more willing to extend international protections, since except for Flower By Kenzo, all other bottles have received extended protection based on their international registrations.<sup>308</sup>

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<sup>303</sup> See *supra* notes 139–150 and accompanying text.

<sup>304</sup> See *supra* note 203 and accompanying text.

<sup>305</sup> *Id.*

<sup>306</sup> See *supra* text accompanying notes 211–13.

<sup>307</sup> See *FERRERO-Societa per Azioni v. Comm’r of the Trademark Office*, [http://ipr.chinacourt.org/public/detail\\_sfws.php?id=16537](http://ipr.chinacourt.org/public/detail_sfws.php?id=16537) (last updated Apr. 14, 2008). See also Zhang, *supra* note 57.

<sup>308</sup> See *supra* text accompanying notes 248–50.

## V. PROPOSAL OF A NEW REGULATORY FRAMEWORK

Given the rapidly changing market, it is almost impossible to propose an ideal regulatory regime for three-dimensional trademarks, but a better one is possible.

This proposed framework will consist of one initial broad scope and two carefully defined conditions. The board scope will adopt the language of the Lanham Act: A trademark can be “any word, name, symbol, or device, or any combination thereof . . . .” There will not be any rigid “graphical representation” requirement, and the only other small requirement for applicants is to submit at least three photographs taken from different perspectives of the same three-dimensional mark.

The first condition is distinctiveness. A three-dimensional mark can never be inherently distinctive, so it must have acquired distinctiveness through its use in commerce. It is acceptable that the three-dimensional mark has to bear some words or designs on it when used in commerce. The real question before the trademark examiners, offices, and courts is whether the three-dimensional mark itself, rather than the words or designs on it, enables consumers to distinguish the applicant’s product from the ones from its competitors. If the answer is positive, the registration shall be granted.

The second condition is “nonfunctionality.” A three-dimensional mark is not registerable if it, taken as a whole, is functional, or if it is a necessary feature for the product to achieve a technical effect. The issue is whether the exclusive use of the mark would put competitors at a significant non-reputation-related disadvantage. The questions are whether a competitor has to use the mark in order to achieve some essential functions of its own product and if the use is necessary to compete with the applicant’s product. A bright line rule does not exist. The agencies and courts have to balance the innovative and unique aspects of the mark, with the functional aspects of the mark and unfair competition concerns.

These two conditions cannot be evaluated separately, since there are close connections between them. If the mark’s main feature is functional, it may be less likely to enable consumers to distinguish the underlying product manufactured by the applicant than those fanciful or arbitrary marks. Agencies and courts should consider the two conditions together with a totality of evidence.

If a three-dimensional object falls within the broad scope of trademarkable subject matter, and overcomes the two conditions, it is

registerable as a three-dimensional trademark. After registration, the applicant can enjoy the exclusive use and protection.

## CONCLUSION

Trademarks are internationally recognized and protected intellectual property rights. Consumers are able to distinguish the source of goods by recognizing their trademarks.<sup>309</sup> Therefore trademarks can protect them from being confused by similar but inferior products.<sup>310</sup> Also, trademarks can help manufacturers promote and merchandize their products more effectively.<sup>311</sup> Corporations are no longer satisfied with traditional trademarks like words and two-dimensional designs. They are trying to seek registration of some nontraditional trademarks, including three-dimensional trademarks. Kenzo, a multinational fashion designer, has sought trademark registrations for its fragrance bottles.

The United States, European Union, Japan, and China, all have their own regulatory regimes for nontraditional, especially three-dimensional trademarks. These regulatory frameworks are dynamic: they have been developing to incorporate the rapid social and economic changes in the world.

Trademark is defined broadly in the United States, EU, Japan, and China. For example, in the United States, Justice Breyer in *Qualitex* read the language of the Lanham Act very broadly, since “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning . . . .” The United States arguably has the broadest scope of trademarkable subject matter.

Two conditions are very important for three-dimensional trademark registrations. The first one is the distinctiveness requirement and the second is the nonfunctionality. Generally, a mark cannot receive registration if it is not distinctive or if it is functional.

The regulatory regimes on trademarks have many differences, although they share a lot of common characteristics of trademarkable subject matter, distinctiveness, and functionality. For example, the European Union and China highlight that marks should be represented graphically, or should be visible. Japanese agencies and courts are more reluctant to accept trademark registration when the three-dimensional

<sup>309</sup> See Khoury, *supra* note 99, at 345.

<sup>310</sup> *Id.*

<sup>311</sup> See *id.*

mark bears some word or two-dimensional design mark on it. For the nonfunctionality requirement, different jurisdictions may weigh relevant factors differently due to the cultural, social, and economic differences. All these facts should be considered carefully by multinationals, like Kenzo, seeking three-dimensional mark registrations.

The world is seeking a better regulatory framework regarding three-dimensional trademarks. First, it should define a broad scope of trademarkable subject matter. Second, it should require clear graphical representation of the mark from multiple angles. Third, it should provide the key issue on acquired distinctiveness is “whether the mark itself, rather than the words or designs on it, enables consumers to distinguish the applicant’s product from the ones from its competitors.” Finally, it should clarify that a three-dimensional trademark’s functional feature should be balanced with its innovative and unique features, and unfair competition.

The world rapidly changes, and every jurisdiction is making efforts to incorporate these changes into its regulatory regimes on intellectual property. Regulations on nontraditional trademarks, especially three-dimensional trademarks may remain as a tough challenge for a long time. It is important for regulators and scholars to continue devoting their efforts to the issues of how to (1) reward manufacturers’ innovation and marketing efforts, (2) protect consumers from being confused by inferior products, and (3) ensure a competitive and effective market at the same time.