Intellectual Property Association of the Philippines
Promote and Protect Intellectual Property Rights

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Protecting Non-Traditional Marks

by: Quisumbing Torres

The wisdom behind the saying *"what is essential is invisible to the eye"* from the Little Prince may have now found its way in the field of trademarks. In a number of jurisdictions across the globe, trademarks are no longer limited to words, logos, or symbols used to identify or represent goods or services. The types of marks used by businesses to distinguish their goods and services have expanded beyond "traditional" word and device marks.

Marks that come in the form of sound, taste, smell, texture, hologram, motion, shape, or other non-visible forms are now capable of being registered. One of the most famous registered non-traditional trademark is *Metro-Goldwyn-Mayer Lion* Corp.'s sound trademark for its roaring lion. Play-Doh, a brand for modeling compound used for arts and crafts and has a distinctive smell, was also able to register the sweet, slightly musky, vanilla-like fragrance, with slight overtones of cherry, and the natural smell of a salted, wheat-based dough, with the United States Patent and Trademark Office in 2018. There are plenty of other examples of registered non-traditional trademarks such as the shape mark of the Tobleron chocolate bar, Tiffany & Co.'s "Tiffany Blue" color mark, and Christian Louboutin's position trademark for the red color on the soles of its shoe products.

Undoubtedly, non-traditional trademarks are gaining importance especially nowadays in view of the world's departure from visual advertisements and platforms. However, national and regional laws and practices have responded differently to the demand to provide adequate protection for non-traditional marks. Countries differ in their acceptance of the extent to which these beyond-conventional marks can fulfill the primary function of a trade mark, which is to identify the origin or source of the goods or services in respect of which it is registered.

In order to qualify for registration, a non-traditional mark must generally be capable of distinction in a way where consumers will immediately be able to identify a product or service upon encountering it. However, difficulties may arise in clearly defining, graphically representing, publishing and searching for these types of trademarks. Color marks, for example, must be recognized as an indication of origin as opposed to simply being used for decorative or other purposes. Hence, many countries allow the registration of colors per se as trademarks only on the basis of their acquired distinctiveness. The same appreciation of distinctiveness is applied for three-dimensional shapes, since some are solely functional or necessary in relation to the goods for which they are used.

At present, many legal frameworks remained inadequate and unable to ensure the protection for non-traditional marks. In the Philippines, the Intellectual Property Code still limits the registration to visible signs and does not afford the same type of safeguard over other non-traditional marks.[1] On the other hand, in countries like the United States of America, the definition of trademarks is comprehensive enough to cover non-traditional marks.[2] In order for a non-traditional mark to qualify for registration, the applicant will just have to prove that its mark is 1) not functional and 2) distinctive.[3] Similarly, in the United Kingdom, trademarks may consist of words (including personal names), designs, letters, numerals, colors, sounds or the shape of goods or their packaging.[4] The same broad protection is afforded to trademarks in Singapore, where registration is granted to *shapes and colors, and other non-conventional signs*.[5]

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[1] *There are currently three house bills related to amending the IP Code, namely House Bills No. 1597, 8062 and 8620. House Bill No. 8620 seeks to remove the visibility requirement for trademarks.*

[2] *The Lanham Act serves as the primary trademark law in the United States. It defines a trademark as a mark that may come in the form of "any word, name, symbol, or device, or any combination thereof used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principal register… 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).*

[3] *A mark is considered functional if "it is essential to the use or purpose of the article or if it affects the cost of quality of the articles, that is, if exclusive use of the feature would put competitors at a significant non reputation related disadvantage" (*Inwood Labs., Inc. v. Ives Labs., Inc*., 456 U.S. 844). Inherently distinctive marks are usually those categorized under arbitrary or suggestive marks. Descriptive marks, on the other hand, can be registered if it develops or acquires a secondary meaning (or distinctiveness).*

[4] *The UK Trademarks Act 1994 provides that a trademark refers to "any sign which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and of distinguishing goods or services of one undertaking from those of other undertakings."*

[5] *The Singapore Trademark Act refers to a trademark as* "any sign which is capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person."

Although these so-called non-traditional marks have existed for a while now, registration of these marks is still proven to be more difficult. In most of the jurisdictions where registration of these marks are allowed, the representation of a "non-conventional" trade mark must be clear, precise, easily accessible and intelligible. For color marks, registration will be issued if the color alone has acquired distinctiveness through use or if the same is inherently distinctive in relation to certain goods or services. For sound marks, if it will be difficult to provide a graphical representation of the sound, it should at least be represented by musical notation or other description or by means unequivocally reproducing the sound. For smell marks, it should be represented by means unequivocally describing or reproducing the smell. Hence, in the absence of any graphical representation, the public must still be provided with the means to understand the nature of the non-traditional mark.

As the world embraces the new normal, businesses are coming up with new innovative marketing means to make their brands distinctive and highly appealable to the public. Non-traditional trademarks are now being recognized in many countries as capable of registration. Other jurisdictions, like the Philippines, are exerting efforts to amend their respective legal requirements and administrative procedures to expand the coverage of trademarks to those types of marks which are non-visible or unconventional. Trademark offices should cooperate to harmonize and promote effective methods of protection. In developing standards, regulators should keep in mind that distinctiveness should always be a factor in the registration of non-traditional marks, since ultimately, the purpose of trademarks to operate as a badge of origin must still be fulfilled.

Philippine FDA Guidelines on COVID-19 Clinical Trial Applications

by: Ma. Sophia Editha C. Cruz-Abrenica and Maria Patricia P. Cruz Villaraza and Angangco

So as to foster a clear, simplified, and transparent process for the conduct of clinical trials of prospective COVID-19 treatments and vaccines, as well as to align the current regulatory practices of the Food and Drug Administration (FDA) with the Inter-Agency Task Force for the Management of Emerging Infections Disease Resolution (IATF) and the Department of Science and Technology (DOST), the FDA issued Circular No. 2020-029, entitled "Guidance on Applications for the Conduct of COVID-19 Clinical Trials", (FDA Circular No. 2020-029) on 14 October 2020.

FDA Circular No. 2020-029 applies to all sponsors, Contract Research Organizations (CROs), and investigators involved in the conduct of COVID-19 related clinical trials, as well as to Research Ethics Committees (RECs), Regulatory Reviewers/Scientific Advisory Committees (SACs), and DOST-Vaccine Expert Panel (VEP) engaged in review, approval, and monitoring of the conduct of COVID-19 related clinical trials.

Entities intending to undertake COVID-19 related clinical trials are required to follow the guidelines set forth in FDA Circular 2020-029 and in Department of Health (DOH) Administrative Order No. 2020-0010, entitled "Regulations on the Conduct of Clinical Trials for Investigational Products" (AO 2020-0010). Before conducting clinical trials or applying for further authorizations to conduct said clinical trials, covered entities are mandated to first secure from the FDA a License to Operate (LTO) as a Sponsor and/or CRO through the Unified Licensing Procedure under DOH Administrative Order No. 2020-0017, entitled "Revised Guidelines on the Unified Licensing Requirements and Procedures of the Food and Drug Administration Repealing Administrative Order No. 2016-0003" (AO 2020-0017).

Upon securing the LTO, the Sponsor and/or CRO shall submit the COVID-19 clinical trial application, along with the documentary requirements under AO 2020-0010, to the FDA via email at clinicalresearch@fda.gov.ph. Nonetheless, it must be noted that the applicant must use only one email address in submitting documents and corresponding with the FDA regarding the application.

It must be noted that the FDA's evaluation and regulatory decision-making processes differ for therapeutic and vaccine clinical trial applications. Applications relating to therapeutic COVID-19 clinical trials should take only 30 days to process, while applications for vaccine clinical trials would take 40 days to complete.

Further, the following processes and guidelines shall be observed for therapeutic COVID-19 clinical trial applications: (a) an application is deemed filed upon submission to the FDA of the documentary requirements, including payment of fees; (b) upon receipt of the application, the FDA shall review the completeness and veracity of the documentary requirements within eight (8) calendar days and shall assign a Regulatory Reviewer for the clinical trial application; (c) the application shall be processed by FDA Regulatory Reviewer/s within fourteen (14) calendar days upon its receipt of the application, following the applicant's payment of a Sixty Thousand Peso (P60,000.00) fee; (d) if there is a need for any clarification, an electronic notification shall be sent to the applicant, in which case the processing time or clock stops in this step; (e) the applicant has seven (7) days from the delivery of the electronic notification to respond to the clarificatory queries; (f) if the applicant fails to send a timely response, the application shall be disapproved; and (g) the FDA shall decide on the application within eight (8) calendar days from receipt of the recommendation from the Regulatory Reviewer/s.

In contrast, clinical trial applications for COVID-19 vaccines shall be governed by the following processes and guidelines: (a) all evaluations shall follow Section C of Resolution No. 65, series of 2020, dated 20 August 2020 of the IATF, stating that all applications for vaccine clinical trials must be initially submitted to the DOST-VEP; (b) simultaneous with the evaluation by the DOST-VEP, the application shall likewise be reviewed by the designated Ethics Board; (c) if the application is found to be meritorious by the DOST-VEP and the designated Ethics Board, it shall be submitted to the FDA for evaluation; (d) the applicant shall submit to the Sub-Technical Working Group for Vaccine Development (Sub-TWG) through the DOST-Philippine Council for Health Research and Development (PCHRD) additional documents via email at VEPsubmissions@pchrd.dost.gov.ph; (e) upon receipt of the endorsement from the DOST-VEP and designated Ethics Board through the Sub-TWG, the applicant shall submit the complete documentary requirements to the FDA along with payment of Php2,525.00 fees; (f) the application is deemed filed upon acceptance by the FDA of the documentary requirements, including payment of fees; (g) upon receipt of the application, the FDA shall review the completeness and veracity of the documentary requirements and shall assign a Regulatory Reviewer for the clinical trial application; (h) the application shall be processed by FDA Regulatory Reviewer/s within fourteen (14) calendar days upon its receipt of the application, following the applicant's payment of a Sixty Thousand Peso (P60,000.00) fee; (i) if there is a need for any clarification, an electronic notification shall be sent to the applicant, in which case the processing time "stops" in this step; (j) the applicant has seven (7) days from the delivery of the electronic notification to respond to the clarificatory queries; (k) if the applicant fails to send a timely response, the application shall be disapproved; (l) the FDA shall decide on the application within eight (8) calendar days from receipt of the recommendation from the Regulatory Reviewer/s; and (m) COVID-19 vaccine trials shall follow the existing zoning guidelines issued by the Sub-TWG.

Regardless of whether the application covers COVID-19 therapeutic clinical trial or vaccine clinical trial, the actual conduct of the clinical trial shall only commence once the approval from the FDA and Institutional RECs have been issued. The Import License (IL) and the Clinical Trial Approval (CTA) then issued shall each have a validity of three (3) years.

Responsibility for ensuring the quality of the products used in the clinical trial shall lie with the Sponsor/s and CROs involved. The Sponsor/s and/or CROs shall notify the FDA, on a quarterly basis, of shipments of investigational products and ancillary supplies entering the country by submitting the necessary requirements under AO 2020-0010. The Sponsors and/or CROs are also required to submit monthly progress reports to the FDA using the format in Appendix G of AO 2020-0010 and are mandated to inform the FDA of an early trial termination or the end of the clinical trial in accordance with AO 2020-0010. Sponsors and/or CROs are likewise obliged to report to the FDA all Suspected Unexpected Serious Adverse Reactions (SUSAR) in accordance with all applicable regulatory requirements and the International Council for Harmonisation Guideline for Clinical Safety Data Management: Definition and Standards for Expedited Reporting (ICH E2A).

For transparency, all COVID-19 clinical trials shall be uploaded to the Clinical Trial Registry (CTR) within thirty (30) days from the applicant's receipt of the FDA CTA and/or approval of amendments. Clinical trial protocol amendment applications, whether for notification or prior approval, shall be decided upon by the FDA within fifteen (15) days from its filing. For any clarification on the application, an electronic notification shall be sent to the applicant, who has five (5) calendar days to respond. If no response is received, the amendment application shall be disapproved.

In any event, the FDA retains authority to enter concerned establishments to conduct inspections for the following purposes: (a) to ensure that rights, safety, and well-being of the study subjects have been protected; (b) to ensure integrity of scientific data collected; and (c) assess adherence to GCP principles and other applicable FDA regulations.

House Bill No. 8620: The Scent of Success?

by: Atty. Steffi Nicole P. Flores, Ortega, Bacorro, Odulio, Calma & Carbonell Law Office

A trademark has long been defined as "any ***visible*** sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods."[1] It came as a surprise then when House Bill No. 8620[2] was filed which removed the term "visible" in the definition of a mark. Its enactment would result to the registration of what are called "non-conventional" or "non-traditional marks" which will include motion, sound, texture, scent, color or shape of a product or packaging.

A trademark will no longer be confined to words, logos and pictures. This is welcome news to trademark owners and would-be applicants since other features of their products will be registrable as well. This will provide a broader protection and will consequently increase the "notoriety"[3] of their brand and product.

The proposed change follows the laws in other jurisdictions which do not require a trademark to be a visible sign.

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[1] *Section 121.1. of Republic Act No. 8293.*

[2] *February 3, 2021.*

[3] *Bleeker, G. W., & Koplow, M. (2019, May 1). Can you trademark sounds, smells, colours, motions and flavours? Retrieved from https://www.worldtrademarkreview.com/brand-management/can-you-trademark-sounds-smells-colours-motions-and-flavours*

In the US, a mark can be registered if it satisfies two (2) requisites, namely: a) the mark should not be functional; and b) the mark should be distinctive. [4] A mark is considered to be functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.[5] Further, a trademark applicant must show that his mark is inherently distinctive or has acquired distinctiveness through its use in commerce.

In the EU, a mark can be registered provided it can be represented in such a way that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.[6]

Despite the wide scope of registrable marks, there are a few non-conventional marks that seem to elude registration, one of which is scent.

Records show that only a few scent marks have been successfully registered. A few examples are the strong smell of bitter beer applied to flights for darts[7]; the bubble gum scent of MELISSA sandals[8]; and the sweet, slightly musky, vanilla fragrance with slight overtones of cherry combined with the smell of a salted, wheat-based dough scent of the PLAY-DOH product.[9] Meanwhile, several applications have been denied due to issues in functionality, distinctiveness and visual representation of the mark.[10]

The strict interpretation of trademark laws is meant to discourage anti-competitive practices. However, what if instead of promoting free expression, we are actually stifling it? In fact, the difficulty in registering a scent mark has deterred the filing of scent mark applications in other countries.[11]

This raises the question as to whether the same difficulties will be faced by applicants in the Philippines.

The purpose of a trademark is to identify the origin or source of goods or services. A scent mark can accomplish this purpose. A scent is a powerful tool which can evoke emotions and memories. The smell of the sea can remind us of the beach, or the smell of freshly cut grass can remind us of days of running around in the playground.

Dawn Goldworm, a renowned expert in olfactive branding, recognized that a scent is an “incredible application” to “emotionally engage with their customers or their clients.”[12] This is why business owners strive to associate their products or services to a specific scent. This is not to say that generic scents or fragrances should be allowed registration. However, if an applicant can show that his scent mark has acquired distinctiveness, the mark should be considered registrable.

The varying trademark laws, and its interpretations, illustrate the fact that registration of a scent mark is not yet fully embraced. But this should not discourage business owners from developing a scent mark and seeking its registration should House Bill No. 8620 be passed.

Admittedly, challenges will arise in the registration of scent marks. This includes issues on subjectivity and on how the courts will resolve a claim for scent infringement.[13] Nonetheless, these issues are not insurmountable as evidenced by existing registrations of scent marks. These can be addressed by creating standards that would allow their registration.

Business owners continue to recognize the ability of a scent mark to build and maintain brand loyalty. The filing of House Bill No. 8620 is likewise a recognition by our lawmakers of the value of these non-traditional marks. Thus, it would be interesting to see how our trademark law will develop if this bill is enacted.

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[4] *Trademark Manual of Examining Procedures (TMEP) §1202.13.*

[5] *TrafFix Devices Inc. vs. Mktg Displays Inc, 532 US 23, 33 (2001).*

[6] *Article 4, Section 1 of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification).*

[7] *Trademark No. UK00002000234.*

[8] *U.S. Registration No. 4,754,435.*

[9] *U.S. Registration No. 5,467,089.*

[10] *Handler, M. (2019, February). What Should Constitute Infringment of a Non-traditional Mark? Retrieved from Oxford Scholarship Online: https://oxford.universitypressscholarship.com/view/10.1093/oso/9780198826576.001.0001/oso-9780198826576-chapter-9*

[11] *Flynn, J. P. (2017, November 1). "Each day has a Color, a Smell...": Searching for New Trademark Worlds . Retrieved from An International Lawyers Network IP Group Publication : https://www.ilnipinsider.com/2017/11/each-day-has-a-color-a-smell-searching-for-new-trademark-worlds/*

[12] *Sisters of Scent: 12.29's Dawn + Samantha Goldworm . (n.d.). Retrieved from The Flair Index: https://www.theflairindex.com/women/sisters-of-scent-12-29s-dawn-samantha-goldworm/*

[13] *Galbo, F. (2017, December 21). Making Sense of the Nonsensical: A look at Scent Trademarks and their Complexities. Retrieved from https://www.ipwatchdog.com/2017/12/21/scent-trademarks-complexities/id=91071/*

January – April 2021 filings grow 21%, shows early recovery - IPOPh

Source: IPOPh Website, May 26, 2021

Demand for intellectual property rights protection is showing early signs of pickup as filings in the first four months grew 21% to 15,028 from the 12,409 in the comparable period last year.

Driving the growth were utility model (UM) filings which soared 33% to 420 from 315.

Resident filers accounted for over 95% with filings at 401, a 38% year-on-year growth. Meanwhile, the top fields of technology were food chemistry (142 filings); basic materials chemistry (26); other special machines (25); handling (15); and IT methods for management (11).

This was followed by trademark applications which rose 26% to 13,041 from 10,354 a year ago. Residents, which contributed the bulk to trademark filings, gave the boost as it surged 48% to 8,089.

The top industries for trademark filings were in pharmaceuticals, health, cosmetics (3,939); agricultural products and services (3,546); scientific research, information and communication technology (2,848); management, communications, real estate and financial services (2,419); and textiles, clothing and accessories (1,914).

Meanwhile, patent filings declined 6% to 1,235 from 1,320. The biggest dampener was the 31% drop in non-resident filings, bringing the total to 71. On the other hand, resident filings edged up by 15% to 129.

Most patents during the period were filed in the fields of pharmaceuticals (543); organic fine chemistry (311); biotechnology (154); basic materials chemistry (115); and food chemistry (63).

For industrial designs, filings dropped 21% to 332 from 420. This was due to applications both by residents and non-residents falling 5% and 34%, respectively.

The top fields of technology for industrial design fillings were in furnishing (16); articles of adornment (8); other machines (7); fluid distribution equipment, sanitary, heating, ventilation and air-conditioning equipment, solid fuel (6); other household goods (6); packages and containers for the transport or handling of goods (6).

Meanwhile, copyright deposits grew 91% to 444 from 233.

IPOPHL Director General Rowel S. Barba said the pickup in filings, notably in trademarks and utility models, could indicate “a more positive outlook among businesses and innovation players on the country’s pace of recovery from the pandemic.”

“It could also signify that businesses are rebuilding stronger by integrating IP protection in their innovation and branding strategies,” Barba said.

In 2020, filings for the first time were down across all types of IP, with some logging record-lows, as several business activities had been subdued by COVID-19 and the period of extreme uncertainty that followed.

The IPOPHL chief said he maintains his hopes to see IP filings in 2021 bounce back to pre-COVID-19 levels, noting “the Office continues to double awareness and education efforts on the benefits of IP to businesses and streamline our digital registration services to provide ease to registrants

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2021 IP Month and MSMEs

Source: IPOPh Website

With the theme ”**Intellectual Property (IP) and MSMEs: Our Road to Recovery**,” this year’s month-long celebration led by the IPO Phil devoted to driving more Micro, Small & Medium Enterprises (MSMEs) to create, protect and commercially optimize their IPs, help them integrate IP strategies into their business models, and eventually realize the exclusive rewards and competitive advantage they can enjoy form their IP assets.

By helping MSMEs turn their trademarks, copyright, patents, utility models and industrial designs into assets for growth, **IPOPHL** hopes to contribute to the recovery of our resilient and strategic MSMEs during the ongoing pandemic and even beyond

On April 4, 2017, President Duterte signed Proclamation 190 declaring April of every year as National Intellectual Property Rights (IPR) Month. April is also host to international celebrations involving IP: the World Book and Copyright Day every April 23, and the World Intellectual Property Day every April 26.

Tribute to Atty. Risel Castillo-Taleon

by: Atty. Ramon Esguerra

San Beda College of Law Vice Dean and IPAP trustee Atty. Risel Castillo-Taleon died on Feb. 9, 2021, Tuesday, following a vehicular accident along South Luzon Expressway. She was 53.

We are reposting a tribute by Atty. Ramon Esguerra dedicated to the memory of Atty. Taleon

YOUR LIFE

No tears yet I have shed,

There is unbelief you are dead,

A few days ago we just met,

Prayers your way are meant.

I hate to grieve your sudden loss,

Looking here heavenward at the most,

My hands clasped but thoughts are tossed,

Your goodness, your smile, they are now lost.

You lived a life of fortitude,

You met sorrows of magnitude,

But your face beamed of hope,

Beyond despair you showed such hope.

We have seen how well you served,

Your passion to teach must be preserved,

May your example shine to all,

With your life, to serve others is God's call.

You were soft, you were sweet,

Cheer you bring and souls you lift,

The empty space you left no one can fit,

Memories of good times your loss would lit.

Our knees are bent thanking God for you,

A mother, a sister, a friend and a mentor, too;

Go and be with your beloved in that paradise,

We who love you will keep you here in our hearts.

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