

**APAA TRADEMARK COMMITTEE (2016)**  
Special Topic - **Scope of Trade Dress Protection**  
**PHILIPPINE GROUP**

*Submitted by:*

Trademark Committee members (Philippine Group)  
**ATTYS. RISEL CASTILLO-TALEON and VIDA PANGANIBAN**

**INDEX**

**I. Background for Discussion**

**II. Questions per Theme**

**1. Current Trade Dress Protection**

**(1) Types of Trade Dress and Current Protection**

**(2) Basis for Current Protection**

**2. Requirements for Protection**

**(1) Distinctiveness, Secondary Meaning, etc.**

**(2) Likelihood of Confusion**

**3. Exclusions or Restrictions to Protection of Trade Dress**

**(1) Functionality /Ornamentation of Goods / Packages**

**(2) Others (Public Policy)**

**4. Enforcement, etc.**

**(1) Enforcement**

**(2) Conflict with Another Party's Right**

**5. Discussions on Possible Expansion of Protection in the Future**

**I. Background for Discussion**

**Trade dress is the overall appearance and visual image (look and feel) of a product or service in commerce which distinguishes the source of a product or service from those of others. It may be referred to as "get-up".**

Originally, trade dress was limited to product packaging or labels, but the concept of trade dress has continued to expand beyond the traditional concept in recent years. Now, it may encompass restaurant or store interior designs, decoration, layout, menu, uniform of staff, etc. In light of the above, we would like to review the concept of trade dress, its scope of protection (traditional & newly protected or discussed), and how it is protected in each recognized group. We would also like to review the types of trade dress that are under discussion to be protected in your jurisdiction, and also the realistic evaluation on expanding the scope of trade dress protection.

**II. Questions per Theme**

**1. Current Trade Dress Protection**




**(1) Types of Trade Dress and Current Protection**







In the next page, please check whether each type of the trade dress indicated below is recognized for protection in your jurisdiction, assuming that certain requirements for protection are fully satisfied.


**(2) Basis for Current Protection**

We would like to know whether trade dress is protected under your Trademark Act, unfair competition laws, etc., or recognized through precedents or examination practice.

Please check the basis for current protection in your jurisdiction. **Please mark with an (\*) if the trade dress can be protected only when it is established that secondary meaning has been acquired and/or that it is well-known and otherwise, it is not protected.**

TYPES OF TRADE DRESS	(SAMPLE IMAGE)	(1) PROTECTED ?	(2) APPLICABLE LAW, PRACTICE, ETC.					
			Trade mark Registration	Design Registration	Copyright (Reg. Y/N)	Unfair Competition Law	Court Precedents (case law)	Others (tort, criminal punishment, etc.)
(a)Word/picture marks		Y	Y	N	N	Y	Y	N
(b)Product 3D shapes	 (Guylian chocolate)	Y	Y	Y	Y	Y	N	N
(c)Product package design	 (tortellini)	Y	Y	Y	Y	Y	N	N

<p>(d)Single color of product/packaging</p>	 (Press pad)	<p>Y</p>	<p>Y</p>	<p>N</p>	<p>N</p>	<p>Y</p>	<p>N</p>	<p>N</p>
<p>(e)Store interior design</p>	 (Apple store)	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>
<p>(f) Layout of store display</p>	 (a paint sample floor display unit consisting of upper trim display panels with various photos and/or text displayed; five (5) distinctive shelving units)	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>
<p>(g)Store exterior design</p>	 ((gas station))	<p>Y</p>	<p>N</p>	<p>N</p>	<p>Y</p>	<p>N</p>	<p>N</p>	<p>N</p>
<p>(h)Position mark (jeans)</p>	 (red tab attached to the hip pocket of jeans)	<p>Y</p>	<p>Y*</p>	<p>N</p>	<p>N</p>	<p>Y</p>	<p>N</p>	<p>N</p>
<p>(i)Uniform of sales clerks/staff (parcel delivery service)</p>		<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>	<p>N</p>

(j)Menu design (restaurant service)		*1	Y	N	N	Y	N	N	N
(k)(Please suggest other types of trade dress of your interest)			N/A						

\*1 <http://designbump.com/restaurant-menu-designs/>

## 2. Requirements for Protection

### (1) Distinctiveness, Secondary Meaning, etc.

In relation to the protection system of trade dress in operation in your jurisdiction, please answer the following questions as to the requirements for protection:

	Trademark Registration	Design Registration	Copyright (Reg. Y/N)	Unfair Competition Law	Court Precedents (case law)	Others (tort, criminal punishment, etc.)
(a) Is distinctiveness of trade dress required?	Y	N	N	Y	Y	N/A
(b) Is novelty of trade dress required for protection?	N	Y	N	Y	Y	N/A
(c) In case the trade dress is not inherently distinctive, should the acquisition of secondary meaning through	Y	N/A	N/A	N/A	Y	N/A

usage be established?						
-----------------------	--	--	--	--	--	--




(2) Likelihood of Confusion:

Are trade dress owners required to present (prima facie) evidence establishing a likelihood of confusion between her/his trade dress and the accused?	N

3. Exclusions or Restrictions to Protection of Trade Dress

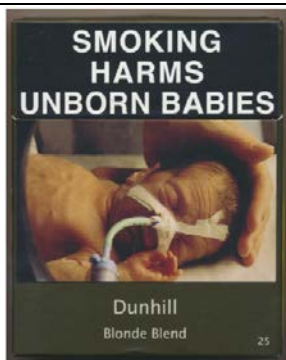
In relation to the protection system of trade dress in operation in your jurisdiction, we would like to review exclusions and/or restrictions of protection.

(1) Functionality/ Ornamentation of Goods / Packages:

(a) Is a trade dress protected if the product itself is fully functional?	 (ballpoint pen)	N
(b) Is a trade dress protected if not fully but mostly/basically functional?	 (computer carrying case)	Y  In terms of copyright protection, there is jurisprudence which provides that a useful article may be copyrightable only if and only to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article. ( <i>Ching v. Salinas</i> , G.R. No. 161295, June 29, 2005)
(c) Is a trade dress protected if the product itself is only ornamental or decorative?	 (pendant)	Y

(2) Others (Public Policy)

Are there laws/regulations restricting the protection of trade dress of a certain category of goods? (For example, there are regulations requiring plain packaging for tobacco in Australia. Are there any similar laws, regulations or practices in your country? If yes, are there any concerns on such restrictions in terms of protection of trade dress?)

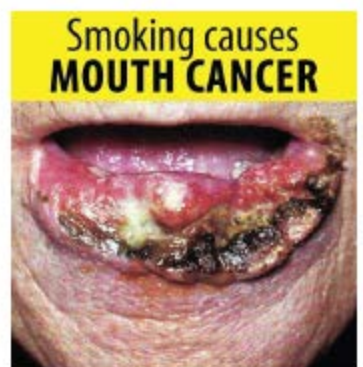


(tobacco)

Y

Republic Act No. 10643 or the Graphic Health Warnings Law, which was promulgated on July 15, 2014, requires cigarette packages and other tobacco product packages to bear the prescribed highly visible full-color Graphic Health Warnings, which have 2 components: (1) a photographic picture warning and (2) and accompanying textual warning that is related to the picture.

Graphic Health Warnings are required to be printed on 50% of the principal display surfaces of any tobacco product package, including package inserts and onsets, and it shall occupy 50% of the front and 50% of the back panel of the packaging. A sample template of the Graphic Health Warnings is shown below:



Mastercases which contain the logo or trademark of tobacco brands are also required to contain the textual health warning "SMOKING KILLS" which shall be printed in the same single color and in bold print as the trademark logo. The textual health warning shall be of equal prominence and visibility as the logo or trademark of tobacco companies.

There is no indication at present that the adoption of the plain packaging scheme

		for tobacco products in the Philippines is imminent, as the country's Department of Health is currently focused on the mechanics of the full implementation of the Graphic Health Warnings Law.
--	--	---

**4. Enforcement, etc.**

**(1) Enforcement:**

**1) What kinds of remedies are available in case of trade dress infringement?**

(a) Injunction	Y
(b) Damages	Y
(c) Others	Destruction of infringing material, imprisonment and/or fine

**2) Are there any laws/regulations enforcing rights against the dilution of trade dress in your country?**

N	
---	--

**(2) Conflict with Another Party's Right:**

After you obtained a registration of a certain type of trade dress when another party had obtained prior/anterior rights to overlapping or conflicting object under a different law, are there any law/regulations to prevent you from using the trade dress?

N	
---	--

**5. Discussions on Possible Expansion of Protection in the Future**

Please describe the current discussions in your jurisdiction regarding the protection of new types of trade dress in the future.

Types of Trade Dress	Please describe current discussions regarding future introduction of <i>registration</i> system for Trade Dress	Please describe current discussions regarding measures for future protection of Trade Dress, except by means of registration?
(a) Word/picture marks	N/A	N/A
(b) Product shapes	N/A	N/A
(c) Product package design	N/A	N/A
(d) Single color of product/packaging	N/A	N/A

(e)Store interior design	N/A	N/A
(f) Layout of store display	N/A	N/A
(g)Store exterior design	N/A	N/A
(h) Position mark	N/A	N/A
(i)Uniform of sales clerks/staff	N/A	N/A
(j)Restaurant menu design	N/A	N/A
(k)(Please suggest other types of trade dress of your interest)		

(end of document)