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Trademark Office Practice

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Abstract

Diese Masterarbeit untersucht die materielle Prüfung nichttraditioneller Marken (NTMs) aus vergleichender Perspektive mit Fokus auf die Europäische Union, die Vereinigten Staaten und ausgewählte asiatische Rechtsordnungen (Japan, China und Singapur). Obwohl moderne Markengesetze Zeichen wie Formen, Farben, Klänge und Bewegungsmarken anerkennen, ist der praktische Zugang zum Schutz weiterhin eingeschränkt. Die Masterarbeit argumentiert, dass die materielle Prüfungspraxis trotz formaler Angleichung der Gesetzessprache und internationaler Harmonisierungsbemühungen fragmentiert und amtsspezifisch bleibt.

Die Studie verwendet eine vergleichende dogmatische und administrative Methodik. Anstatt sich auf Gerichtsentscheidungen zu konzentrieren, analysiert sie, wie Markenämter absolute Zurückweisungsgründe in der täglichen Prüfungspraxis anwenden. Besonderes Augenmerk liegt auf Unterscheidungskraft, Funktionalität und den Nachweisanforderungen für erworbene Unterscheidungskraft. Durch die Analyse von Prüfungshandbüchern und administrativen Begründungsmustern untersucht die Masterarbeit, wie abstrakte Rechtsnormen in operative Kriterien umgesetzt werden.

Die Ergebnisse zeigen, dass Unterscheidungskraft in allen untersuchten Rechtsordnungen als restriktiver Filter fungiert. Während der rechtliche Test die Fähigkeit eines Zeichens zur Kennzeichnung der kommerziellen Herkunft in den Mittelpunkt stellt, spiegelt seine Anwendung Annahmen über die Verbraucherwahrnehmung und Branchennormen wider. In der EU setzt der Test der „Abweichung von Branchennormen“ eine hohe Schwelle für die inhärente Unterscheidungskraft. In den USA schaffen kategorische Rechtsgrundsätze – insbesondere der Ausschluss der inhärenten Unterscheidungskraft für Produktdesign – strukturierte Hürden im Prüfungsverfahren. Auch in Japan, China und Singapur zeigt die Verwaltungspraxis Skepsis gegenüber der inhärenten Unterscheidungskraft, die sich in unterschiedlichen institutionellen Ansätzen ausdrückt.

Die Nachweisanforderungen für erworbene Unterscheidungskraft unterstreichen zudem die Bedeutung des Ermessensspielraums der Prüfer. Da die meisten Systeme keine quantitativen Schwellenwerte für den Nachweis der Verkehrsgeltung definieren, hängt die Bewertung von Umfragen, Verkaufsdaten und Werbematerialien maßgeblich vom Ermessen der Verwaltung ab. Die Funktionalitätslehre verankert ebenfalls wettbewerbsrechtliche Belange im

Prüfungsverfahren und schränkt die Eintragungsfähigkeit von Zeichen ein, die sich mit Produktdesign oder technischen Merkmalen überschneiden.

Die Arbeit kommt zu dem Schluss, dass die Grenzen der internationalen Harmonisierung nicht im Fehlen gemeinsamer Definitionen, sondern in der unterschiedlichen administrativen Anwendung liegen. NTMs legen diese Lücke deutlich offen, da offene Standards den institutionellen Ermessensspielraum erweitern. Multinationale Anmelder sehen sich daher mit Rechtsunsicherheit konfrontiert und müssen länderspezifische Registrierungsstrategien entwickeln. Eine Harmonisierung auf Ebene der gesetzlichen Anerkennung garantiert keine Konvergenz in der materiellen Prüfungspraxis.

This thesis examines the substantive examination of non-traditional trademarks (NTMs) in a comparative perspective, focusing on the European Union, the United States, and selected Asian jurisdictions (Japan, China, and Singapore). Although modern trademark statutes recognize signs such as shapes, colours, sounds, and motion marks, the practical accessibility of protection remains limited. The thesis argues that, despite formal convergence in legislative language and international harmonization efforts, substantive examination practices remain fragmented and office-specific.

The study adopts a comparative doctrinal and administrative methodology. Rather than concentrating on judicial decisions, it analyses how trademark offices apply absolute grounds for refusal in day-to-day examination practice. Particular attention is given to distinctiveness, functionality, and evidentiary requirements for acquired distinctiveness. By reviewing examination manuals and administrative reasoning patterns, the thesis explores how abstract legal standards are translated into operational criteria.

The findings show that distinctiveness functions as a restrictive filter across all jurisdictions examined. While the legal test focuses on a sign's capacity to indicate commercial origin, its application reflects assumptions about consumer perception and sector norms. In the EU, the "departure from sector norms" test imposes a demanding threshold for inherent distinctiveness. In the US, categorical judicial doctrines—especially the exclusion of inherent distinctiveness for product design—create structured barriers at the examination stage. In Japan, China, and Singapore, administrative practice likewise reveals scepticism toward inherent distinctiveness, expressed through different institutional approaches.

Evidentiary requirements for acquired distinctiveness further highlight the role of examiner discretion. Because most systems do not define quantitative thresholds for proving secondary meaning, the evaluation of surveys, sales data, and advertising materials depends heavily on administrative judgment. Functionality doctrine similarly embeds competition concerns within examination and limits the registrability of signs overlapping with product design or technical features.

The thesis concludes that the limits of international harmonization lie not in the absence of shared definitions, but in divergent administrative application. NTMs expose this gap clearly, as open-ended standards amplify institutional discretion. Multinational applicants therefore

face legal uncertainty and must adopt jurisdiction-specific registration strategies. Harmonization at the level of statutory recognition does not guarantee convergence in substantive examination practice.

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The Coca-Cola Company v EUIPO (Case T-411/14) ECLI:EU:T:2016:94.

Hauck GmbH & Co KG v Stokke A/S and Others (Case C-205/13) ECLI:EU:C:2014:2233.

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Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Joined Cases C-456/01 P and C-457/01 P) [2004] ECR I-5089, ECLI:EU:C:2004:258.

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Table of Abbreviations

Courts and Institutions

Abbreviation	Definition
CCPA	United States Court of Appeals for the Federal Circuit
CJEU	The Court of Justice of the European Union
CNIPA	China National Intellectual Property Administration
EUIPO	European Union Intellectual Property Office
Fed Cir	United States Court of Appeals for the Federal Circuit
IPOS	Intellectual Property Office of Singapore
JPO	Japan Patent Office
SGCA	Singapore Court of Appeal
SGHC	Singapore High Court
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

Legalisation and Legal Instruments

Abbreviation	Definition
EUTMR	European Union Trade Mark Regulation 2017/1001
TMEP	Trademark Manual of Examining Procedure
TRAB	Trademark Review and Adjudication Board
TRIPS	Trade-Related Aspects of Intellectual Property Rights

Case Law References

Abbreviation	Definition
C	Court of Justice
ECLI	European Case Law Identifier
ECR	European Court Reports
SLR (R)	Singapore Law Report (Reissue)

Book Publishers

Abbreviation	Definition
Aspen	Aspen Publishing
CAP	Carolina Academic Press
CUP	Cambridge University Press
Edward Elgar	Edward Elgar Publishing
ERIA	Economic Research Institute for ASEAN and East Asia
Harvard UP	Harvard University Press

Kluwer
OUP

Kluwer Law International/ Wolters Kluwer
Oxford University Press

Journals

Abbreviation	Definition
Ariz St LJ	Arizona State Law Journal
Boston U L Rev	Boston University Law Review
Cal L Rev	California Law Review
Campbell L Rev	Campbell Law Review
Chi-Kent L Rev	Chicago-Kent Law Review
Duke LJ	Duke Law Journal
Emory LJ	Emory Law Journal
Hous L Rev	Houston Law Review
IIC	International Review of Intellectual Property and Competition Law
Iowa L Rev	Iowa Law Review
J Corp L Stud	Journal of Corporate Law Studies
Loy LA Int'l & Comp L Rev	Loyola of Los Angeles International and Comparative Law Review
Marq Intell Prop L Rev	Marquette Intellectual Property Law Review
Minn L Rev	Minnesota Law Review
Mod L Rev	Modern Law Review
Notre Dame L Rev	Notre Dame Law Review
St Louis U LJ	St Louis University Law Journal
Rev Econ & Stat	Review of Economics and Statistics
Sing JLS	Singapore Journal of Legal Studies
UCLA L Rev	UCLA Law Review
U Pa J L & Soc Change	University of Pennsylvania Journal of Law and Social Change
Yale LJ	Yale Law Journal

Intellectual Property- Specific Journals

Abbreviation	Definition
J Intell Prop L	Journal of Intellectual Property Law
J Intell Prop L & Prac	Journal of Intellectual Property Law & Practice
QMJP	Queen Mary Journal of Intellectual Property
Trade Mark Rep	Trade Mark Reporter
World Trade Rev	World Trade Review

General Terms

Abbreviation	Definition
art	Article
ch	Chapter
Ed	Edition
EU	European Union
MS	Member State
IP	Intellectual Property
LJ	Law journal
n	Footnote
NTMs	Non-traditional trademarks
para	Paragraph
Rev	Review
s	Section
US	The United States of America
vol	Volume

Chapter 1: Introduction

1.1. Background and relevance of NTMs

Traditionally, trademarks consisted of words, logos or graphic designs applied to goods or packaging.¹ These trademarks have long been the foundation of brand identity in business.²

Given the flexible conceptual boundaries established in the trademark provisions of the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), the evolution of trademarks—particularly the growing recognition of so-called non-traditional trademarks (NTMs)—has developed into a global trend.³ NTMs refer to distinctive brand elements that go beyond the usual text-based or visual logos including trade dress (such as product design, packaging, or configuration), colour, scent, sound, taste, touch and moving images (combining colour, sound, and aspects of product design).⁴ A classic example of a motion mark is the “The future is exciting. Ready?” owned by Vodafone, registered under European Union Trade Mark No. 17894840.⁵ An example of a sound mark is the “YAHOO yodel”, registered under United States Patent and Trademark Office (USPTO) Serial No. 75807526.⁶ NTMs are increasing recognized as essential tools for distinguishing goods and services in the market.⁷ The factors are as follows. First, having a distinctive sound, colour or motion mark helps brands to create

¹ Lionel Bently, Brad Sherman, Dev S Gangjee and Phillip Johnson, *Intellectual Property Law* (6th edn, OUP 2022) 885–887; Annette Kur and Thomas Dreier, *European Intellectual Property Law* (2nd edn, Edward Elgar 2019) 327–330.

² Barton Beebe, ‘*The Semiotic Analysis of Trademark Law*’ (2004) 51 UCLA L Rev 621–702; Graeme Dinwoodie and Mark Janis, *Trademarks and Unfair Competition: Law and Policy* (6th edn, Aspen 2022) ch 1.

³ Graeme Dinwoodie and Mark Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar 2008); Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), opened for signature 15 April 1994, 1869 UNTS 299, art 15(1); Peter Cane and Joanne Conaghan, ‘Intellectual property rights, international harmonization of’ in *The New Oxford Companion to Law* (OUP 2008); Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 1–2.

⁴ WIPO Standing Committee on the Law of Trademarks, New Types of Marks (SCT/16/2, 2006); Gangjee Dev S, ‘Paying the Price for Admission: Non Traditional Marks Across Registration and Enforcement’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non Traditional Trademarks: Critical Perspectives* (OUP 2018) 221–222.

⁵ European Union Intellectual Property Office (EUIPO), Guidelines for Examination of European Union Trade Marks.

⁶ ‘Trademark Sound Mark Examples’ <<https://www.uspto.gov/trademarks/soundmarks/trademark-sound-mark-examples>> accessed 13 January 2026.

⁷ Gangjee (n 4) 223–225; Ilanah Fhima, ‘Rethinking Distinctiveness of Shape Trade Marks’ Faculty of Laws, University College London, Law Research Paper No 09/2025, 1 August 2024; Irene Calboli, ‘Non-traditional trademarks as barriers to competition, innovation, and creativity: what if their protection could be effectively limited in practice?’ in Gustavo Ghidini and Valeria Falce (eds), *Reforming Intellectual Property I* (Routledge 2022); Mitchell Adams and Amanda Scardamaglia, ‘Non-Traditional Trademarks: An Empirical Study’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018).

memorable and immediately recognizable identities.⁸ Second, marks that engage human sensory perception, such as sound marks, create stronger emotional ties with customers than those traditional marks.⁹ Third, as commercial activity increasingly shifts to digital platforms, motion marks and holographic elements serve as tools for fostering more interactive and immersive brand experience.¹⁰ Taken together, these trends illustrate the growing strategic significance of NTMs in globalized markets.¹¹

At the international level, trademark law formally allows the registration of NTMs. Article 15(1) of the TRIPS Agreement adopts a broad definition of trademarks, referring to any sign capable of distinguishing goods or services.¹² Many jurisdictions have formally amended their trademark laws to allow NTMs.¹³ However, in reality, their registration remains difficult in practice— trademark offices apply strict and often divergent standards when examining distinctiveness, functionality, and evidentiary requirements for NTM.¹⁴ Consequently, identical or similar NTMs may be accepted in one jurisdiction and refused in another.¹⁵ Such inconsistencies raise concerns regarding legal certainty and calls into question the extent of international harmonization in trademark law.¹⁶

This thesis focuses on trademark examination practice rather than judicial decisions because trademark offices play a decisive role in determining whether (or to what extent) NTMs can be protected.¹⁷ At the broad terms, most trademark applications are resolved at the examination stage and only a small number of cases reach the courts.¹⁸ For NTMs in particular, outcomes

⁸ Fhima, ‘Rethinking Distinctiveness of Shape Trade Marks (n 7); Katya Assaf-Zakharov, ‘Non-Traditional Trademark Protection as (Non-Traditional) Means of Cultural Control’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018).

⁹ Rebecca Tushnet, ‘Sight, Sound and Meaning: Teaching Intellectual Property with Audiovisual Materials’ (2008) Georgetown Law Faculty Publications and Other Works 793; Assaf-Zakharov (n 8).

¹⁰ Fhima, ‘Rethinking Distinctiveness of Shape Trade Marks (n 7); Gangjee (n 4) 223–225.

¹¹ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 2.

¹² TRIPS Agreement (n 3) art 15(1); Cane and Conaghan (n 3).

¹³ WIPO SCT, New Types of Marks (n 4); Gangjee (n 4) 223–224; John Tessensohn, ‘Expanding the realm of the senses: non-traditional trade marks in Japan’ (2014) 9 J Intell Prop L & Prac 909-914; Tan Tee Jim, *Law of Trade Marks in Singapore* (4th edn, Sweet & Maxwell 2021).

¹⁴ Gangjee (n 4) 63–70; Caitlin Canahai and Mark McKenna, ‘The case against product configuration trade dress’ in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021); Michael Frakes and Melissa Wasserman, ‘Are There as Many Trademark Offices as Trademark Examiners?’ (2020) 69 Duke LJ 1807–1853.

¹⁵ Tessensohn, ‘Expanding the realm of the senses’ (n 13); Tan (n 13); Qian Zhan, ‘The Registration of Non-Traditional Trademarks in China: A Cautious Approach’ (2020) 10(1) QMJIP 34-61.

¹⁶ Graeme Dinwoodie, ‘The Architecture of the International Intellectual Property System’ (2002) 77 Chi-Kent L Rev 993; Lionel and Sherman (eds), *Intellectual Property Law* (n 1) ch 16; Christopher Heath and Anselm Sanders, *Intellectual Property in the Digital Age: Challenges for Asia* (Wolters Kluwer 2001).

¹⁷ Calboli, ‘Non-traditional trademarks as barriers’ (n 7); Gangjee (n 4).

¹⁸ Kur and Dreier, *European Intellectual Property Law* (n 1) 327–330.

are shaped primarily by examiner discretion, office guidelines and evidentiary expectations, rather than by settled judicial doctrine.¹⁹ Court decisions tend to address exceptional or appealed cases and therefore provide only a partial picture of how registrability standards operate in day-to-day practice.²⁰ By examining how trademark offices apply concepts such as distinctiveness and functionality, this study explores the practical realities faced by applicants²¹ and offers a more accurate assessment of the limits of harmonization in trademark law.²²

1.2. Research Gap

Despite the formal acceptance of NTMs in international instruments and national legislation, a gap remains between legal recognition and examination practice.²³ While treaties such as the TRIPS Agreement and national laws in the EU, the US, and several Asian jurisdictions permit the registration of NTMs in principle, their registrability is largely determined by how trademark offices apply substantive examination standards in practice.²⁴

Most existing academic literature has tended to focus on court decisions or theoretical justifications for NTM protection.²⁵ By contrast, there is less attention to trademark examination as an administrative decision-making process, even though examination outcomes largely determine whether NTMs can be registered.²⁶ This thesis addresses that gap by focusing on trademark office practice and the role of examiners in shaping the practical availability of protection for NTMs.

¹⁹ Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16); Gangjee (n 4) 231-234; Kung-Chung Liu (eds), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019); Graeme Dinwoodie, 'The International Intellectual Property System: Treaties, Norms, National Courts, and Private Ordering' in Daniel Gervais (ed), *Intellectual Property, Trade and Development* (OUP 2007) 61; Michael Lemley and Bhaven Sampat, 'Examiner Characteristics and Patent Office Outcomes' (2012) 94 *Rev Econ & Stat* 817-827.

²⁰ Rebecca Tushnet, 'Reforming trademark registration' in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021) 77; Gangjee (n 4) 70-72.

²¹ Gangjee (n 4).

²² Calboli, 'Non-traditional trademarks as barriers' (n 7).

²³ Robert Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law' (2011) 86 *Boston U L Rev* 547, 582-586; Jessica Litman, 'Breakfast with Batman: the Public Interest in the Advertising Age' (February 1999) *Yale LJ Vol* 108, No 7, 1999; Beebe, 'The Semiotic Analysis of Trademark Law' (n 2).

²⁴ Mark McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 *Notre Dame L Rev* 1839; Lisa P Ramsey, 'Descriptive Trademarks and the First Amendment' (2005) *University of San Diego Law and Economics Research Paper Series* No 9; Jeremy Sheff, 'Veblen Brands' (2012) 96 *Minn L Rev* 769.

²⁵ Bone (n 23) 582-586; Litman (n 23); Beebe, 'The Semiotic Analysis of Trademark Law' (n 2); McKenna, 'The Normative Foundations of Trademark Law' (n 24); Ramsey, 'Descriptive Trademarks' (n 24); Sheff (n 24) 174; Annette Kur, 'Trade Marks Function, Don't They? CJEU Jurisprudence and Unfair Competition Principles' (2014) 45 *IIC* 434-454.

²⁶ Graeme Dinwoodie and Mark Janis, 'Confusion Over Use: Contextualism in Trademark Law' (2007) 92(7) *Iowa L Rev* 1597, 1623-1626; Gangjee (n 4) 60-63; Frakes and Wasserman (n 14) 1807-1853.

1.3. Research Questions and Objectives

This thesis examines how trademark offices in the EU, the US, and the selected Asian jurisdictions substantively examine NTMs at the registration stage, along with the assessment of distinctiveness, functionality and evidentiary requirements. The research further investigates how examination standards and outcomes differ across jurisdictions, and analyses the extent to which administrative priorities and competition considerations shape examiner practice.

The objective of the thesis is to analyse and compare how trademark offices substantively examine NTMs in practice, with a focus on absolute grounds for refusal, in order to assess the practical limits of international harmonization and the implications for legal certainty and trademark applicants.

1.4. Academic Hypothesis

Although NTMs are officially accepted across major trademark systems, substantive examination practices remain fragmented and office-specific.²⁷ Trademark offices in the EU, the US and Asia apply different thresholds for distinctiveness, functionality and evidentiary proof, shaped by administrative priorities and competition concerns. These differences undermine legal certainty for applicants and demonstrate the practical limits of international harmonization in trademark law.²⁸

1.5. Methodology and Approach

The thesis adopts a comparative doctrinal and administrative methodology. It is based on an analysis of trademark legislation and registrability provisions in the selected jurisdictions, with particular attention to absolute grounds for refusal relevant to NTMs. The jurisdictions selected for comparison are the EU, the US, and selected Asian countries, namely Japan, China, and Singapore. These jurisdictions were chosen primarily for their practical relevance. The EU and the US represent two of the most influential and economically significant trademark systems and have played a major role in shaping trademark law and practice internationally.²⁹ In Asia,

²⁷ Gangjee (n 4) 59–88; WIPO SCT, *New Types of Marks* (n 4); Dinwoodie, ‘The International Intellectual Property System (n 19)’ 61.

²⁸ Kur and Dreier, *European Intellectual Property Law* (n 1) 327–330.

²⁹ WIPO, *World Intellectual Property Indicators 2023* (WIPO 2023).

Japan, China, and Singapore are selected because they are among the region's most active trademark systems and account for a high volume of filings.³⁰

This analysis is based on the examination of trademark office examination guidelines and manuals, which provide detailed instructions to examiners on how legal standards such as distinctiveness and functionality should be applied during the examination process. In addition, the research considers selected administrative and judicial decisions insofar as they influence or reflect examination standards applied by trademark offices. International materials, including reports and comparative studies produced by World Intellectual Property Organization (WIPO), are used to provide a broader contextual framework and to support cross-jurisdictional comparison. The emphasis is on how examiners apply legal standards in practice rather than on purely theoretical analysis.

Administrative practice is assessed through the combined analysis of these sources. Examination guidelines and manuals are particularly important because they are used directly by trademark examiners in their day-to-day decision-making and therefore provide insight into the operational interpretation of legal standards. Administrative and judicial decisions are used to illustrate how these standards are applied in specific cases and how examination practice develops over time. Although these sources may not capture every individual examination decision, together they provide a reliable and widely accepted representation of the general approach adopted by trademark offices.

By focusing on administrative practice, the methodology aims to find out the realities faced by the applicants and to evaluate the extent to which formal legal harmonization results in consistent examination outcomes.

1.6. Scope and Limitations

The scope is limited to the substantive examination stage and absolute grounds for refusal. The jurisdictions examined are the EU, the United States, Japan, China, and Singapore. The types of NTMs analyses are shape, colour, sound and motion marks. Opposition proceedings, enforcement, litigation outcomes and scent marks are excluded.

³⁰ *ibid*; China National Intellectual Property Administration, 'China National Intellectual Property Administration Statistical Report' (CNIPA 2025); Japan Patent Office, JPO Status Report 2025 (JPO 2025); ASEAN Secretariat, 'ASEAN Intellectual Property Register to Officially Launch' (20 August 2023).

1.7. Structure of the Thesis

The thesis consists of eight chapters. Chapter 1 introduces the research topic, outlines the research questions and explains the methodology. Chapter 2 sets out the international legal and conceptual framework for NTMs. Chapters 3, 4, and 5 examine substantive examination practice at the European Union Intellectual Property Office (EUIPO), the United States and Patent and Trademark Office (USPTO), and the respective selected Asian trademark offices in Japan, China and Singapore, namely, Japan Patent Office (JPO), China National Intellectual Property Administration (CNIPA) and Intellectual Property Office of Singapore (IPOS). Chapter 6 provides a comparative analysis of examiner approaches across these jurisdictions, focusing on distinctiveness, functionality, and evidentiary requirements. Chapter 7 discusses the practical implications of divergent examination practices for trademark applicants. Chapter 8 concludes the thesis by summarizing the findings and considering future developments in the protection of NTMs.

Chapter 2: International Framework for NTMs

2.1. Purpose and Scope of the Chapter

This chapter examines the international and conceptual framework governing the protection of NTMs, with a focus on how that framework shapes examination outcomes in practice. It proceeds in three steps. First, it analyses the role of international trademark law and explains why its harmonizing effect remains limited. Second, it examines the core trademark concepts of distinctiveness, functionality, and consumer perception, focusing on how their abstract formulation affects the examination of NTMs. Third, it considers the competition-related concerns embedded in trademark doctrine and their influence on examiner decision-making. Taken together, these elements explain why the registrability of NTMs is determined primarily at the examination stage rather than by formal legal recognition.

2.2. International Trademark Law and the Limits of Harmonization

International trademark law establishes a shared framework for protection, but it does not meaningfully harmonize the application of registrability standards.³¹ The TRIPS Agreement sets minimum standards and defines trademarks broadly as any sign capable of distinguishing

³¹ Graeme Dinwoodie and Mark Janis, 'The drivers of trademark law reform: perspectives from the academy' in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021) 1–5; Susy Frankel and Daniel Gervais, *Advanced Introduction to International Intellectual Property* (Edward Elgar 2016) 89–94.

the goods or services of one undertaking from those of others.³² This open and technology-neutral approach allows trademark law to accommodate new forms of signs, including NTMs.³³

At the same time, TRIPS leaves substantial discretion to national authorities.³⁴ It does not prescribe how core concepts such as distinctiveness or functionality should be interpreted or applied during substantive examination. Instead, Members of the World Trade Organization (Members) retain autonomy in operationalizing these abstract standards within their domestic systems.³⁵ As a result, international harmonization is largely confined to formal recognition, while substantive assessment remains fragmented.³⁶

This structural choice has significant consequences. By privileging flexibility over uniformity, international trademark law shifts regulatory authority to national trademark offices.³⁷ In the absence of detailed international guidance, examination practice becomes the primary site where the scope of trademark protection is defined.³⁸ This dynamic is particularly pronounced for NTMs, whose assessment relies heavily on administrative interpretation rather than settled international norms.³⁹

2.3. Formal Acceptance of NTMs

The broad definition of trademarks in international law has enabled the formal acceptance of NTMs in many jurisdictions.⁴⁰ Trademark legislation in the EU, the US, and several Asian jurisdictions now recognizes that signs such as shapes, colours, sounds, and motion marks may,

³² TRIPS Agreement (n 3) art 15(1).

³³ Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (4th edn, Sweet & Maxwell 2012) 257–260; Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th edn, Thomson Reuters, looseleaf).

³⁴ Matthias Herdegen, *The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) in Principles of International Economic Law* (OUP 2016) 273–86.

³⁵ Carlos M Correa, *Interpreting the Flexibilities Under the TRIPS Agreement* (South Centre Research Paper No. 132, 2021) 1–30; Frankel and Gervais, *Advanced Introduction* (n 31) 89–94.

³⁶ *ibid.*

³⁷ Irene Calboli and Jane Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020).

³⁸ Barton Beebe and Jeanne Fromer, ‘Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion’ (2018) 131 Harv L Rev 945–1045; Gangjee (n 4) 221–244.

³⁹ Gangjee (n 4) 59–88; Kur, ‘Trade Marks Function, Don’t They?’ (n 25) 434–454; Heath and Sanders (n 16).

⁴⁰ Gangjee (n 4) 59–88; Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37).

in principle, function as trademarks.⁴¹ This development is often presented as evidence of an adaptive and forward-looking trademark system.⁴²

In practice, however, formal acceptance has not resulted in consistent access to registration.⁴³ WIPO reports on new types of marks repeatedly acknowledge that NTMs continue to face particular difficulties at the examination stage.⁴⁴ These difficulties do not arise from a lack of legal recognition, but from the application of existing registrability standards to signs that fall outside traditional trademark categories.⁴⁵

This reveals a structural gap between legal possibility and administrative reality.⁴⁶ While NTMs are accommodated at the level of statutory definitions, examination standards operate as a filtering mechanism that restricts their successful registration.⁴⁷ As a result, acceptance remains largely symbolic, while practical protection is difficult to obtain.⁴⁸

2.4. Abstract Standards and Administrative Discretion

Trademark law relies on core concepts—such as distinctiveness, functionality, and consumer perception—that are framed in abstract and open-ended terms.⁴⁹ Rather than operating as precise rules, these concepts function as flexible standards that require interpretation in concrete cases.⁵⁰ While this abstraction allows trademark law to adapt to changing commercial practices, it also places significant interpretative responsibility on trademark offices.⁵¹

This responsibility is particularly pronounced for NTMs. As Kur and Senftleben observe, non-traditional signs often sit at the margins of trademark law, where the boundaries between

⁴¹ European Union Intellectual Property Office, Examination Guidelines for European Union Trade Marks (Version 2019, EUIPO 2019); Irene Calboli and Martin Senftleben, 'Introduction' in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018) 1; Litman (n 23).

⁴² Calboli and Senftleben, 'Introduction' in *The Protection of Non-Traditional Trademarks* (n 41) 1; Robert Burrell and Michael Handler, '(Re)claiming trade mark protection' in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021) 51; Litman (n 23).

⁴³ WIPO SCT, New Types of Marks (n 4).

⁴⁴ WIPO, Methods of Representation and Description of New Types of Marks (SCT/17/2, 29 March 2007).

⁴⁵ Gangjee (n 4) 236–238; Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454.

⁴⁶ Gangjee (n 4) 59–88; WIPO, Methods of Representation (n 44).

⁴⁷ EUIPO, Examination Guidelines (n 41); Gangjee (n 4) 63–70.

⁴⁸ *ibid.*

⁴⁹ Dinwoodie and Janis, *Trademark Law and Theory* (n 3).

⁵⁰ Lionel Bently, 'The Making of Modern Trade Mark Law: The Construction of the Legal Concept of Trade Mark (1860–1880)' in Lionel Bently, Jennifer Davis and Jane Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (CUP 2008) 3–36.

⁵¹ Annette Kur and Martin Senftleben, *European Trade Mark Law: A Commentary* (OUP 2017).

trademark protection, product design, and competition policy are unclear.⁵² In the absence of detailed international harmonization, trademark offices must balance these competing considerations when examining NTMs.⁵³ This balancing exercise is shaped by institutional priorities and risk-management concerns rather than uniform legal criteria.⁵⁴

Administrative discretion therefore plays a central role in determining registrability. Examination outcomes may vary across jurisdictions even where the same legal concepts apply.⁵⁵ This discretionary space contributes to fragmentation and undermines legal certainty for applicants seeking protection for NTMs across multiple markets.⁵⁶

2.5. Distinctiveness as a Structuring Filter

Distinctiveness is formally presented as the central criterion for trademark protection.⁵⁷ In practice, however, it operates as a structuring filter that favours traditional forms of branding.⁵⁸ Although the legal test focuses on a sign's capacity to indicate commercial origin, this capacity is assessed against consumer expectations shaped by long-standing exposure to word and figurative marks.⁵⁹ Distinctiveness therefore embeds normative assumptions about what a trademark should look like.⁶⁰

For NTMs, this creates a structural disadvantage.⁶¹ Non-traditional signs are rarely assessed on their own communicative potential, but instead through comparison with established trademark categories.⁶² This approach narrows the scope for inherent distinctiveness and shifts the burden of justification onto applicants, reinforcing a cautious and restrictive examination culture.⁶³

2.6. Inherent and Acquired Distinctiveness: From Law to Proof

The distinction between inherent and acquired distinctiveness masks a deeper shift in the examination of NTMs.⁶⁴ While inherent distinctiveness is theoretically available, it is rarely

⁵² *ibid.*

⁵³ Gangjee (n 4) 59–88.

⁵⁴ Gangjee (n 4) 100–105.

⁵⁵ Beebe and Fromer, 'Are We Running Out of Trademarks?' (n 38).

⁵⁶ *ibid.*

⁵⁷ Gangjee (n 4) 55–60.

⁵⁸ Beebe and Fromer, 'Are We Running Out of Trademarks?' (n 38).

⁵⁹ Calboli and Senftleben, 'Introduction' in *The Protection of Non-Traditional Trademarks* (n 41) 1; Sheff (n 24).

⁶⁰ Gangjee (n 4) 59–88.

⁶¹ Gangjee (n 4) 60.

⁶² Calboli and Senftleben, 'Introduction' in *The Protection of Non-Traditional Trademarks* (n 41) 1.

⁶³ WIPO SCT, New Types of Marks (n 4); WIPO, Methods of Representation (n 44).

⁶⁴ Gangjee (n 4) 59–88.

attainable in practice for non-traditional signs.⁶⁵ Examination therefore tends to focus on acquired distinctiveness, transforming registrability into an evidentiary rather than a legal inquiry.⁶⁶

This shift has important consequences. Acquired distinctiveness requires proof of market recognition, favouring applicants with substantial commercial presence and long-term use.⁶⁷ As a result, examination practice rewards market power rather than conceptual distinctiveness.⁶⁸ In this sense, acquired distinctiveness thus functions less as an exception and more as the default pathway for NTMs, undermining claims of neutral assessment, reinforcing inequality between applicants and undermining claims of neutral assessment.⁶⁹

2.7. Consumer Perception and Examiner Discretion

Consumer perception is treated as the decisive benchmark for assessing distinctiveness, yet it is inherently indeterminate.⁷⁰ Because perception cannot be directly observed, trademark offices rely on proxy evidence such as surveys, sales figures, and advertising expenditure.⁷¹ The evaluation of such material is highly sensitive to methodological choices and administrative expectations.⁷²

In the context of NTMs, this evidentiary model significantly expands examiner discretion.⁷³ Decisions depend less on shared legal standards and more on judgments about what constitutes

⁶⁵ *Ralf Sieckmann v Deutsches Patent und Markenamt* (Case C-273/00) [2002] ECR I-11737, ECLI:EU:C:2002:748.

⁶⁶ *ibid.*

⁶⁷ Sean Morris, 'The Economics of Distinctiveness: The Road to Monopolization in Trade Mark Law' (2011) 33(3) *Loy LA Int'l & Comp L* 321–354; Ramsey, 'Descriptive Trademarks' (n 24).

⁶⁸ Martin Senftleben, 'The Trademark Tower of Babel: Dilution Concepts in International, US and EC Trademark Law' (2009) 40 *IIC* 45; Morris (n 67); *Société des produits Nestlé SA v Mondelez UK Holdings & Services Ltd* (Joined Cases C-84/17 P, C-85/17 P and C-95/17 P) ECLI:EU:C:2018:596.

⁶⁹ Nuno Pires de Carvalho, 'Signs That Constitute Trademarks' in Nuno Pires de Carvalho (ed), *The TRIPS Regime of Trademarks and Designs* (Kluwer 2018); Irene Calboli, 'Hands Off "My" Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation' in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018) 341–364.

⁷⁰ Thomas Lee, Eric DeRosia, and Glenn Christensen, 'An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness' (2009) 41 *Ariz St LJ* 1033; *SABEL BV v Puma AG, Rudolf Dassler Sport* (Case C-251/95) [1997] ECR I-6191, ECLI:EU:C:1997:528.

⁷¹ *ibid.*

⁷² Barton Beebe, 'An Empirical Study of the Multifactor Tests for Trademark Infringement' (2006) 94 *Cal L Rev* 1581.

⁷³ David Franklyn and David Hyman, 'Trademarks as Search Engine Keywords: Much Ado About Something?' (2013) 26 *Harv J L & Tech* 481–543; *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots und Segelzubehör Walter Huber and Franz Attenberger* (Joined Cases C 108/97 and C 109/97) [1999] ECR I 2779, ECLI:EU:C:1999:230; Dinwoodie, 'The International Intellectual Property System' (n 19) 61; Lemley and Sampat (n 19).

sufficient proof.⁷⁴ This contributes to inconsistent outcomes across jurisdictions and reinforces the central role of administrative practice in shaping trademark protection.⁷⁵ Although framed as an empirical inquiry, consumer perception operates as a flexible tool for managing uncertainty and limiting access to registration.⁷⁶

2.8. Functionality as a Policy-Driven Limitation

Functionality operates as a core limitation on trademark protection in the interest of competition.⁷⁷ Although formally expressed as a legal exclusion, it is inherently policy-driven.⁷⁸ By preventing trademark protection from extending to features that competitors may need to use freely, functionality embeds competition concerns directly into the examination process.⁷⁹

For NTMs, functionality provides a particularly strong basis for refusal.⁸⁰ Because many non-traditional signs overlap with product design or technical features, functionality objections are frequently used to resolve uncertainty.⁸¹ In this way, the doctrine operates not only as a safeguard against over-protection but also as a risk-avoidance strategy.⁸²

2.9. Technical and Aesthetic Functionality: Doctrinal Uncertainty

The distinction between technical and aesthetic functionality illustrates the limits of doctrinal clarity in trademark law.⁸³ While technical functionality is widely accepted, aesthetic functionality remains contested and unevenly applied.⁸⁴ This uncertainty is especially problematic for NTMs, where visual appeal and source identification often overlap.⁸⁵

The absence of a consistent approach leaves substantial room for administrative interpretation.⁸⁶ Trademark offices may characterize the same feature as functional, aesthetic,

⁷⁴ *ibid.*

⁷⁵ Kimberlee Weatherall, 'The Consumer as the Empirical Measure of Trade Mark Law' (2017) 80 Mod L Rev 57.

⁷⁶ *ibid.*

⁷⁷ Mark McKenna, '(Dys)Functionality' (2011) 48 Houston L Rev 823, 825–828.

⁷⁸ *ibid* 824–826.

⁷⁹ *TrafFix Devices, Inc v Marketing Displays, Inc* 532 US 23 (2001).

⁸⁰ McKenna, '(Dys)Functionality' (n 77) 843–848.

⁸¹ *ibid* 848–852.

⁸² *Qualitex Co v Jacobson Products Co* 514 US 159 (1995); McKenna, '(Dys)Functionality' (n 77) 836–843.

⁸³ McKenna, '(Dys)Functionality' (n 77) 843–848.

⁸⁴ *TrafFix Devices* (n 79); Mark McKenna (n 66) 843–852.

⁸⁵ McKenna, '(Dys)Functionality' (n 77) 848–852.

⁸⁶ *Qualitex Co* (n 82); *Wal-Mart Stores, Inc v Samara Bros, Inc* 529 US 205 (2000); McKenna, '(Dys)Functionality' (n 77) 836–843.

or source-identifying depending on institutional priorities and competition concerns.⁸⁷ This doctrinal instability further undermines legal certainty and contributes to fragmented examination outcomes.⁸⁸

2.10. Competition Considerations in Examination

Competition concerns are embedded within trademark examination rather than external to it.⁸⁹ Although rarely articulated explicitly, they shape the application of distinctiveness and functionality standards, particularly for NTMs.⁹⁰ Trademark offices thus act not only as legal adjudicators but also as regulatory gatekeepers managing the risk of over-protection.⁹¹

This implicit balancing lacks transparency.⁹² Applicants often cannot predict whether refusals are grounded in doctrinal reasoning or broader competition policy concerns.⁹³ Examination practice therefore becomes a key site where trademark law's regulatory function is exercised without clear normative guidance.⁹⁴

2.11. NTMs as a Point of Tension

NTMs expose the structural limits of international trademark harmonization.⁹⁵ While legal frameworks converge at the level of recognition, the application of abstract standards remains highly office-specific.⁹⁶ Examination outcomes reflect administrative cultures and policy priorities rather than shared international norms.⁹⁷

⁸⁷ McKenna, '(Dys)Functionality' (n 77) 830–36, 848–852.

⁸⁸ *ibid* 852–856.

⁸⁹ *Traffix Devices* (n 79); Mark Lemley, 'The Modern Lanham Act and the Death of Common Sense' (1999) Yale LJ 108.

⁹⁰ *Qualitex Co* (n 82); Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7.

⁹¹ *Wal-Mart Stores* (n 86); Rochelle Dreyfuss, 'and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity', New York University School of Law, Public Law & Legal Theory Research Paper Series, Working Paper No 06/30, September 2006.

⁹² McKenna, '(Dys)Functionality' (n 77) 848–852.

⁹³ Dinwoodie and Janis, *Trademarks and Unfair Competition* ch 7 WIPO SCT, New Types of Marks (n 4); Dreyfuss (n 91); Lemley, 'The Modern Lanham Act' (n 89); Kal Raustiala and Christopher Sprigman, *The Knockoff Economy: How Imitation Sparks Innovation* (OUP 2012).

⁹⁴ Lemley, 'The Modern Lanham Act' (n 89); Raustiala and Sprigman (n 93).

⁹⁵ Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018).

⁹⁶ *Sieckmann* (n 65); Gangjee (n 4) 59–88.

⁹⁷ Qian Zhan, 'The International Registration of Non-traditional Trademarks: Compliance with the TRIPS Agreement and the Paris Convention' (2016) World Trade Rev 16 (1) 111–140; Frakes and Wasserman (n 14) 1807–1853; Assaf-Zakharov (n 8); Dinwoodie, 'The International Intellectual Property System' (n 19) 61; Lemley and Sampat (n 19) 817–827.

In this sense, NTMs function as a stress test for the international trademark system.⁹⁸ They demonstrate how discretion, evidence, and competition concerns interact to produce fragmented and unpredictable results, highlighting the gap between formal harmonization and practical protection.⁹⁹

2.12. Conclusion and Transition

This chapter has shown that the difficulties faced by NTMs are structural rather than incidental.¹⁰⁰ International trademark law formally accommodates NTMs through broad definitions, but relies on abstract standards that leave substantial discretion to national trademark offices.¹⁰¹ In practice, this discretion produces restrictive and divergent examination outcomes.¹⁰²

By exposing the gap between formal harmonization and substantive assessment, the chapter explains why examination practice plays a decisive role in determining the registrability of NTMs. The following chapter builds on this analysis by examining how these abstract standards are operationalized in practice by the EUIPO.

Chapter 3: Substantive examination of NTMs at the EUIPO

3.1. Introduction

This chapter examines how NTMs are examined in practice by the EUIPO. Although EU trademark law formally accommodates a wide range of non-traditional signs within a harmonized legislative framework, EUIPO examination practice adopts a cautiously and restrictively.¹⁰³

⁹⁸ Gangjee (n 4) 59-88; Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2).

⁹⁹ *Windsurfing* (n 73); *Nestlé SA v Mondelez UK* (n 68).

¹⁰⁰ Gangjee (n 4) 223-226; Kur, 'Trade Marks Function, Don't They?' (n 25) 434-454; McKenna, '(Dys)Functionality' (n 77) 843-848; Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95).

¹⁰¹ TRIPS Agreement (n 3) art 15(1); Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16); Annette Kur, 'Fundamental concerns in the harmonization of (European) trademark law' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar 2008) 151-76; Kur and Senftleben, *European Trade Mark Law* (n 51) 55-60; Dinwoodie, 'The International Intellectual Property System' (n 19) 61.

¹⁰² Bently and others, *Intellectual Property Law* (n 1) 890; Lemley, 'The Modern Lanham Act' (n 89) 1707-1715; Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7.

¹⁰³ Jennifer Davis, *Intellectual Property Law* (4th edn, OUP 2012) 544-552.

This chapter argues that EUIPO examination is shaped not only by legal doctrine, but also by administrative priorities, evidentiary risk management, and embedded competition concerns.¹⁰⁴ It analyses how abstract concepts—distinctiveness, functionality, and consumer perception—are translated into operational criteria through the EUIPO Guidelines and examiner practice.¹⁰⁵ Despite formal harmonization, EUIPO examination reflects an office-specific calibration of trademark protection that contributes to fragmentation at the international level.¹⁰⁶

3.2. Legal Framework and Examination Guidelines

3.2.1. EU Trade Mark Regulation

The legal basis for EUIPO examination is Regulation (EU) 2017/1001 on the European Union Trade Mark (EUTMR).¹⁰⁷ Article 4 EUTMR defines an EU trade mark broadly as any sign capable of distinguishing goods or services, provided it can be represented clearly and precisely on the Register.¹⁰⁸ The removal of the graphic representation requirement was intended to facilitate the registration of NTMs such as sound, motion, and multimedia marks.¹⁰⁹

However, this formal openness is limited by Article 7 EUTMR, particularly Article 7(1)(b) (lack of distinctive character) and Article 7(1)(e) (functionality).¹¹⁰ While these provisions apply formally to all marks, their practical impact is uneven.¹¹¹ For NTMs, which do not align with conventional trademark forms, they operate as significant barriers to registration.¹¹² The Regulation therefore combines inclusive definition with restrictive filters, leaving substantial interpretative space to the EUIPO.¹¹³

¹⁰⁴ Mark McKenna, ‘Testing Modern Trademark Law’s Theory of Harm’ (2009) 95 Iowa L Rev 63, 88–94.

¹⁰⁵ Fhima, ‘Rethinking Distinctiveness of Shape Trade Marks’ (n 7).

¹⁰⁶ Annette Kur, ‘Aesthetic functionality in EU law - should it be deleted?’ in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021) 168–191; Kur, ‘Fundamental concerns in the harmonization’ (n 101) 151–176; 59–88.

¹⁰⁷ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [2017] OJ L154/1.

¹⁰⁸ *ibid* art 4; *Sieckmann* (n 65) para 55.

¹⁰⁹ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation (EC) No 207/2009 on the European Union trade mark, recital 10.

¹¹⁰ EUTMR (n 107) art 7(1)(b), (e).

¹¹¹ Kur, ‘Trade Marks Function, Don’t They?’ (n 25) 434–454.

¹¹² *ibid*.

¹¹³ Eleonora Rosati, ‘The absolute ground for refusal or invalidity in Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD: in search of the exclusion’s own substantial value’ (2020) J Intell Prop L & Prac 15(2) 103–122.

3.2.2. EUIPO Guidelines as an Administrative Instrument

The EUIPO Guidelines translate the EUTMR and CJEU case law into daily examination practice.¹¹⁴ While not legally binding, the Guidelines exert strong normative influence and structure examiner decision-making.¹¹⁵ The Guidelines recognize that NTMs are admissible in principle but emphasise that they must satisfy the same registrability standards as traditional marks.¹¹⁶ They further acknowledge that NTMs raise “particular difficulties” in relation to distinctiveness and functionality.¹¹⁷ Examiners are instructed to apply strict standards when assessing whether such signs can function as indicators of origin.¹¹⁸

From a critical perspective, the Guidelines do more than clarify the law; they institutionalize assumptions about consumer perception and sector norms.¹¹⁹ In this way, the Guidelines promote internal consistency while limiting the scope for expansive interpretations of registrability.¹²⁰

3.3. Distinctiveness in EUIPO Examination Practice

3.3.1. Consumer Perception as the Central Benchmark

Distinctiveness is the central ground of refusal in EUIPO examination.¹²¹ In line with CJEU case law, a sign is distinctive only if it enables the relevant public to identify commercial origin.¹²²

For NTMs, EUIPO practice assumes that consumers are not accustomed to perceiving non-traditional signs as trademarks.¹²³ This assumption shifts the examination starting point from neutrality to scepticism.¹²⁴ Applicants must therefore demonstrate that their sign performs an

¹¹⁴ EUIPO, Guidelines for Examination, Part B (n 5).

¹¹⁵ Kur, ‘Fundamental concerns in the harmonization’ (n 101) 151–76.

¹¹⁶ EUIPO Guidelines, Part B, s 2 (n 5).

¹¹⁷ *ibid.*

¹¹⁸ *Henkel KGaA v Deutsches Patent- und Markenamt* (Case C-218/01) [2004] ECR I-1725, ECLI:EU:C:2004:88 para 50.

¹¹⁹ Kur and Senfleben, *European Trade Mark Law* (n 51) 70-75.

¹²⁰ Davis (n 103) 271-276.

¹²¹ EUTMR (n 107) art 7(1)(b); *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) [2004] ECR I-1619, ECLI:EU:C:2004:86 para 67.

¹²² *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (Case C-299/99) ECLI:EU:C:2002:377 para 35; *Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C 136/02 P) ECLI:EU:C:2004:592.

¹²³ *Apple Inc v Deutsches Patent- und Markenamt* (Case C-421/13) ECLI:EU:C:2014:2070; *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Joined Cases C-456/01 P and C-457/01 P) [2004] ECR I-5089, ECLI:EU:C:2004:258.

¹²⁴ Kur, ‘Trade Marks Function, Don’t They?’ (n 25) 434–454.

origin-indicating function despite its non-traditional form.¹²⁵ While grounded in case law, this approach also reflects administrative risk management aimed at avoiding over-protection.¹²⁶

3.3.2. The “Departure from Sector Norms” Test

For shape marks and similar NTMs, the CJEU requires that the sign depart significantly from sector norms in order to be inherently distinctive.¹²⁷ This test seeks to prevent trademark protection from covering ordinary product features.¹²⁸

In practice, however, determining sector norms requires evaluative judgments about market practices and consumer expectations.¹²⁹ As a result, even visually distinctive signs may be refused if considered insufficiently removed from existing designs.¹³⁰ This high threshold illustrates how doctrinal standards are applied in a particularly cautious manner at the examination stage.¹³¹

3.3.3. Institutional Caution and Legal Certainty

EUIPO practice reflects a strong concern with legal certainty.¹³² Granting protection for non-traditional signs with unclear scopes may complicate enforcement and restrict competition.¹³³ Strict distinctiveness standards are therefore used to minimize these risks.¹³⁴ However, this approach narrows the practical scope of NTM protection.¹³⁵ The result is a persistent gap between formal admissibility and effective registration.¹³⁶

¹²⁵ *Mag Instrument* (n 122).

¹²⁶ McKenna, ‘Testing Modern Trademark Law’s’ (n 104) 90-94.

¹²⁷ *Henkel v Deutsches Patent* (n 118); *Mag Instrument* (n 122).

¹²⁸ Robert Merges, *Justifying Intellectual Property* (Harvard UP 2011) 288–294; *Philips Electronics* (n 122) para 35.

¹²⁹ Fhima, ‘Rethinking Distinctiveness of Shape Trade Marks’ (n 7).

¹³⁰ *The Coca-Cola Company v EUIPO* (Case T-411/14) ECLI:EU:T:2016:94.

¹³¹ Adams and Scardamaglia (n 7); Kur, ‘Fundamental concerns in the harmonization’ (n 101) 151–176.

¹³² Davis (n 103) 271-276.

¹³³ Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95) 26-30.

¹³⁴ Kur, ‘Trade Marks Function, Don’t They?’ (n 25) 434–454; *Société des Produits Nestlé SA v Cadbury UK Ltd* (Case C-215/14) ECLI:EU:C:2015:604.

¹³⁵ Calboli, ‘Hands Off’ in *The Protection of Non-Traditional Trademarks* (n 69) 341–364.

¹³⁶ Adams and Scardamaglia (n 7).

3.4. Acquired Distinctiveness and Evidentiary Practice

3.4.1. Legal Standard under Article 7(3) EUTMR

Article 7(3) EUTMR permits registration where a mark has acquired distinctiveness through use.¹³⁷ The CJEU requires proof that the relevant public perceives the sign as indicating a single commercial origin.¹³⁸ For EU trademarks, evidence must demonstrate acquired distinctiveness across the EU territory where inherent distinctiveness is absent.¹³⁹ This requirement significantly increases the evidentiary burden for NTMs.¹⁴⁰

3.4.2. EUIPO Evidentiary Assessment

EUIPO examination places strong emphasis on evidentiary quality and structure.¹⁴¹ Market surveys are scrutinized for methodology, representativeness, and neutrality.¹⁴² Sales and advertising figures may be discounted if they do not clearly demonstrate consumer perception of trademark function.¹⁴³ Despite detailed guidance, this assessment involves significant examiner discretion.¹⁴⁴ As Gangjee notes, evidentiary requirements often function as a filtering mechanism for NTMs.¹⁴⁵

3.4.3. Practical Implications for Applicants

The evidentiary demands of EUIPO practice are costly and complex.¹⁴⁶ They disproportionately affect small and medium-sized enterprises.¹⁴⁷ As a result, many NTM applications fail at the examination stage.¹⁴⁸ Administrative practice therefore plays a decisive role in shaping market access to trademark protection.¹⁴⁹

¹³⁷ EUTMR (n 107) art 7(3).

¹³⁸ *Windsurfing* (n 73) para 52; Sheff (n 24).

¹³⁹ *Libertel Groep BV v Benelux-Merkbureau* (Case C-104/01) ECLI:EU:C: 2003:244; Rosati (n 113)103–122.

¹⁴⁰ Luis Porangaba, Acquired Distinctiveness in the European Union: When Nontraditional Marks Meet a (Fragmented) Single Market (2019) *The Trade Mark Rep* 109 619-670.

¹⁴¹ Kur and Senftleben, *European Trade Mark Law* (n 51) 200-205.

¹⁴² Ilanah Fhima and Dev S Gangjee, *The Confusion Test in European Trade Mark Law* (OUP 2019) 178–183; EUIPO, Guidelines for Examination, Part B, s 4 (n 5).

¹⁴³ *Windsurfing* (n 73) para 52.

¹⁴⁴ Davis (n 103) 266-270.

¹⁴⁵ Gangjee (n 4) 59–88.

¹⁴⁶ Kur and Senftleben, *European Trade Mark Law* (n 51) 210-215.

¹⁴⁷ McKenna, ‘Testing Modern Trademark Law’s’ (n 104) 92.

¹⁴⁸ Davis (n 103) 274-280; European Union Intellectual Property Office (EUIPO), Statistics on EU Trade Mark Applications and Registrations (2025); 2 European Union Intellectual Property Office (EUIPO), Annual Report 2025 (EUIPO 2025).

¹⁴⁹ Kur, ‘Fundamental concerns in the harmonization’ (n 101)151–176.

3.5. Functionality and Competition Concerns

3.5.1. Legal Basis and Policy Rationale

Article 7(1)(e) EUTMR excludes functional shapes and characteristics from the nature of the goods, necessary to obtain a technical result, or giving substantial value to the goods.¹⁵⁰ These exclusions reflect the close relationship between trademark law and competition policy.¹⁵¹ The CJEU has consistently emphasized that functionality prevents monopolization of product features.¹⁵² This concern is especially relevant for NTMs overlapping with product design.¹⁵³

3.5.2. EUIPO Application and Competition Concerns

EUIPO examiners rely on technical documentation and prior patent or design protection to assess functionality.¹⁵⁴ Even partially distinctive signs may be refused if essential characteristics are functional.¹⁵⁵ This strict application reflects the EUIPO's regulatory role in preserving competitive freedom.¹⁵⁶ While legitimate, this further restricts the registrability of NTMs.¹⁵⁷

3.6. Key Findings

EUIPO examination practice demonstrates how abstract trademark concepts are operationalized through administrative decision-making.¹⁵⁸ Despite formal openness to NTMs, distinctiveness, evidentiary, and functionality requirements are applied cautiously and restrictively.¹⁵⁹

Examiner discretion, guided by the Guidelines and CJEU case law, plays a decisive role in registration outcomes.¹⁶⁰ The EUIPO's approach therefore reflects office-specific priorities that prioritize legal certainty and competition.¹⁶¹ This supports the thesis hypothesis that

¹⁵⁰ EUTMR (n 107) art 7(1)(e).

¹⁵¹ *Philips Electronics* (n 122) para 78; Ramsey, 'Descriptive Trademarks' (n 24).

¹⁵² *Lego Juris A/S v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-48/09 P) ECLI:EU:C:2010:516; Ramsey, 'Descriptive Trademarks' (n 24).

¹⁵³ Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454; Litman (n 23).

¹⁵⁴ Rochelle Dreyfuss and Justine Pila (eds), *The Oxford Handbook of Intellectual Property Law* (OUP 2018); *Philips Electronics* (n 122); EUIPO, Guidelines for Examination, Part B, s 4 (n 5).

¹⁵⁵ *Lego Juris* (n 152).

¹⁵⁶ Rosati (n 113) 103–122.

¹⁵⁷ Davis (n 103) 271–276.

¹⁵⁸ Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176.

¹⁵⁹ Gangjee (n 4) 59–88.

¹⁶⁰ Kur and Senftleben, *European Trade Mark Law* (n 51) 75–80; Ramsey, 'Descriptive Trademarks' (n 24).

¹⁶¹ McKenna, 'Testing Modern Trademark Law's' (n 104) 88–94; Gangjee (n 4) 59–88.

substantive examination remains fragmented and institutionally driven despite formal harmonization.¹⁶²

Chapter 4: Substantive Examination of NTMs at the USPTO

4.1. Introduction

This chapter examines how NTMs are substantively examined by the USPTO. Although US trademark law is frequently described as flexible and receptive to unconventional branding, examination practice reveals a structured and cautious approach.¹⁶³ USPTO practice reflects office-specific priorities, particularly a strong emphasis on use in commerce, evidentiary substantiation, and competition policy concerns.¹⁶⁴

This chapter analyses how distinctiveness, functionality, and consumer perception are operationalized at the examination stage.¹⁶⁵ It argues that, despite formal openness to NTMs, registration outcomes depend heavily on administrative interpretation and evidentiary expectations.¹⁶⁶ This supports the broader hypothesis that substantive examination remains fragmented and office-specific despite international convergence at the level of formal recognition.¹⁶⁷

4.2. Legal Framework and Examination Structure

4.2.1 Statutory Basis under the Lanham Act

The legal foundation for trademark examination in the US is the Lanham Act.¹⁶⁸ Section 45 defines a trademark broadly as any word, name, symbol, or device used to identify and distinguish goods and indicate source.¹⁶⁹ This definition is formally open and has been interpreted to include colours, sounds, product configurations, and other non-traditional signs.¹⁷⁰

¹⁶² Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176; Dinwoodie and Janis, 'The drivers of trademark law reform' (n 31) 1.

¹⁶³ Beebe, '*The Semiotic Analysis of Trademark Law*' (n 2); Mark McKenna, 'Teaching Trademark Theory Through the Lens of Distinctiveness' in 52 St Louis U LJ 837 (2008) 845–855.

¹⁶⁴ Stacey Dogan and Mark Lemley, 'The Merchandising Right: Fragile Theory or Fait Accompli?' (2005) 54 Emory LJ 461–506.

¹⁶⁵ Dinwoodie and Janis, *Trademark Law and Theory* (n 3).

¹⁶⁶ Gangjee (n 4) 59–88.

¹⁶⁷ Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176; Gangjee (n 4) 59–88.

¹⁶⁸ Lanham Act 1946, 15 USC §§ 1051–1127.

¹⁶⁹ Lanham Act (n 168) §1127.

¹⁷⁰ *Qualitex Co* (n 82).

However, this openness is limited by Section 2 of the Act, particularly the bars relating to descriptiveness and functionality.¹⁷¹ Marks that are merely descriptive or functional are excluded unless they have acquired distinctiveness through use.¹⁷² The statutory structure therefore combines broad definitional language with restrictive examination-stage filters, placing substantial responsibility on the USPTO to give concrete meaning to abstract standards.¹⁷³

4.2.2 The Role of the TMEP

USPTO examination practice is structured by the Trademark Manual of Examining Procedure (TMEP).¹⁷⁴ Although not legally binding, the TMEP functions as a central administrative instrument guiding examiner reasoning and promoting internal consistency.¹⁷⁵ It contains detailed sections addressing colour marks, sound marks, motion marks, and product configuration marks.¹⁷⁶ The TMEP does not merely summarize doctrine; it translates judicial standards into operational presumptions about consumer perception and market behaviour.¹⁷⁷ In doing so, it embeds institutional caution into daily examination practice.¹⁷⁸ This administrative structuring contributes to an office-specific calibration of trademark protection that differs from the EU approach.¹⁷⁹

4.3 Distinctiveness and Consumer Perception

4.3.1 Product Design and the Presumption against Inherent Distinctiveness

US trademark doctrine draws a categorical distinction between product packaging and product design.¹⁸⁰ In *Wal-Mart Stores v Samara Brothers*, the Supreme Court held that product design can never be inherently distinctive.¹⁸¹ Product design marks therefore always require proof of acquired distinctiveness.¹⁸² This bright-line rule has become embedded in USPTO examination

¹⁷¹ Lanham Act (n 168) § 1052(e) (equivalent to s 2(e)).

¹⁷² *ibid* § 1052(f) (equivalent to s 2(f)).

¹⁷³ McKenna, 'The Normative Foundations of Trademark Law' (n 24).

¹⁷⁴ United States Patent and Trademark Office (USPTO), Trademark Manual of Examining Procedure (TMEP) (November 2025).

¹⁷⁵ *ibid* §1202; *In re Bose Corp* 580 F 3d 1240 (Fed Cir 2009).

¹⁷⁶ USPTO TMEP (n 174) §§1202.02–1202.15.

¹⁷⁷ Barton Beebe, *Trademark Law: An Open Access Casebook* (NYU School of Law, Version 10, 2020).

¹⁷⁸ *ibid*.

¹⁷⁹ *Wal-Mart* (n 86).

¹⁸⁰ Rebecca Tushnet, 'Looking at the Lanham Act: Images in Trademark and Advertising Law' (2011) 48 *Hous L Rev* 861.

¹⁸¹ *Wal-Mart* (n 86).

¹⁸² *TrafFix Devices* (n 79).

practice for configuration marks.¹⁸³ Examiners routinely refuse product design applications absent evidence of secondary meaning.¹⁸⁴

Compared to the EU “departure from sector norms” standard, the US rule is more rigid and reduces contextual evaluation at the examination stage.¹⁸⁵ The presumption reflects judicial skepticism toward treating product design as a source indicator without substantial market conditioning.¹⁸⁶

4.3.2 Use-Based Distinctiveness and Evidentiary Expectations

Distinctiveness in US trademark law is structurally tied to use in commerce.¹⁸⁷ Unlike the EU system, registration ultimately requires proof of actual use.¹⁸⁸ This requirement has particular consequences for NTMs, which often lack immediate source-identifying capacity.¹⁸⁹ USPTO examiners commonly require substantial evidence demonstrating that consumers perceive the non-traditional sign as a trademark.¹⁹⁰ Acceptable evidence may include advertising materials, declarations, consumer surveys, and proof of long-standing exclusive use.¹⁹¹

Because no fixed quantitative threshold exists, the sufficiency of evidence depends on examiner evaluation.¹⁹² This transforms distinctiveness from a purely doctrinal inquiry into an evidentiary assessment shaped by administrative judgment.¹⁹³

As McKenna and Lemley observe, evidentiary discretion enables trademark offices to influence the practical scope of protection while appearing formally neutral.¹⁹⁴ For

¹⁸³ Lanham Act (n 168) §1052(f); USPTO TMEP (n 174) §1202.02(b)(i).

¹⁸⁴ Stacey Dogan and Mark Lemley, ‘Grounding Trademark Law through Trademark Use’ (2007) 92 Iowa L Rev 1669, 1698–1702; McKenna, ‘Teaching Trademark Theory’ (n 163) 845–855.

¹⁸⁵ Kur, ‘Trade Marks Function, Don’t They?’ (n 25) 434–454.

¹⁸⁶ *Wal-Mart* (n 86) paras 213–214; Tushnet, ‘Looking at the Lanham Act’ (n 180).

¹⁸⁷ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7; Lanham Act (n 168) §1127.

¹⁸⁸ Beebe (n 2), ‘*The Semiotic Analysis of Trademark Law*’ 676–680; Lanham Act (n 168) §1051(a).

¹⁸⁹ Ilanah Fhima and Dev S Gangjee, *Non-Traditional Marks and the Likelihood of Confusion* (OUP 2018) 55–82.

¹⁹⁰ USPTO TMEP (n 174) §1202 et seq.

¹⁹¹ Dinwoodie and Janis, *Trademark Law and Theory* (n 3) 429–435; USPTO TMEP (n 174) §1212.06.

¹⁹² McKenna, ‘The Normative Foundations of Trademark Law’ (n 24) 1890–1894; USPTO TMEP (n 174) §1212.06.

¹⁹³ Dogan and Lemley, ‘Grounding Trademark Law’ (n 184) 92 1698–1702.

¹⁹⁴ McKenna, ‘Testing Modern Trademark Law’s’ (n 104) 94–100; Lemley, ‘The Modern Lanham Act’ (n 89) 1717–1721.

international applicants, the US insistence on use and proof underscores the limited harmonizing effect of international trademark norms.¹⁹⁵

4.4 Acquired Distinctiveness under Section 2(f)

Section 2(f) of the Lanham Act permits registration of marks that have acquired distinctiveness through use.¹⁹⁶ For NTMs—particularly colour and configuration marks—reliance on Section 2(f) is common.¹⁹⁷ The statute does not define precise evidentiary thresholds.¹⁹⁸ The TMEP lists relevant forms of proof but leaves weight and sufficiency to examiner judgment.¹⁹⁹ As a result, similar factual records may yield different outcomes.²⁰⁰ This variability creates legal uncertainty and complicates strategic planning.²⁰¹ Dinwoodie and Janis note that such administrative discretion illustrates the structural limits of harmonisation in trademark law.²⁰²

4.5 Functionality and Competition Policy

4.5.1 Legal Standard for Functionality

Functionality is a central limitation on trademark protection in US law.²⁰³ In *Inwood Laboratories v Ives Laboratories*, the Supreme Court defined a functional feature as one essential to use or affecting cost or quality.²⁰⁴ In *TrafFix Devices v Marketing Displays*, the Court reaffirmed that functionality doctrine is grounded in competition policy.²⁰⁵ The existence of a utility patent is treated as strong evidence of functionality.²⁰⁶ These principles are directly incorporated into USPTO examination practice.²⁰⁷

4.5.2 Examination Practice and Regulatory Orientation

USPTO examiners routinely consult patent records, technical materials, and product descriptions when assessing configuration marks.²⁰⁸ Even where acquired distinctiveness is

¹⁹⁵ Dinwoodie, ‘The Architecture of the International Intellectual Property System’ (n 16).

¹⁹⁶ Lanham Act (n 168) §1052(f).

¹⁹⁷ *Qualitex Co* (n 82).

¹⁹⁸ Lanham Act (n 168) §1052(f).

¹⁹⁹ *Wal-Mart* (n 86) paras 214–216; USPTO TMEP (n 174) §1212.

²⁰⁰ Dinwoodie and Janis, *Trademark Law and Theory* (n 3) 433–437.

²⁰¹ 676–680; McKenna, ‘Teaching Trademark Theory’ (n 163) 845–855.

²⁰² Dinwoodie and Janis, ‘The drivers of trademark law reform’ (n 31) 1.

²⁰³ McKenna, ‘Testing Modern Trademark Law’s’ (n 104).

²⁰⁴ *Inwood Laboratories Inc v Ives Laboratories Inc* 456 US 844, 850 (1982).

²⁰⁵ *TrafFix Devices* (n 79).

²⁰⁶ *ibid.*

²⁰⁷ *Morton Norwich Products, Inc v N.V. Rubber Co* 671 F.2d 1332 (CCPA 1982); USPTO TMEP (n 174) §1202.02(a)(v).

²⁰⁸ Dinwoodie and Janis, *Trademark Law and Theory* (n 3) 503–508; USPTO TMEP (n 174) §1202.02(a)(v).

demonstrated, functionality remains an absolute bar to registration.²⁰⁹ This strict application reflects the Office's role in preventing trademark law from extending time-limited patent monopolies.²¹⁰ The emphasis on competition and design freedom narrows the practical scope for NTMs overlapping with product features.²¹¹ While doctrinally justified, this approach reinforces the restrictive character of examination practice.²¹²

4.6 Key Findings from USPTO Examination Practice

USPTO examination practice demonstrates a distinct administrative model for assessing NTMs.²¹³ Although US law formally recognizes a broad range of non-traditional signs, distinctiveness, use, and functionality are applied in a structured and cautious manner.²¹⁴ Examiner discretion—particularly in evidentiary assessment—plays a decisive role in shaping registration outcomes.²¹⁵

Compared to the EUIPO, the USPTO relies more heavily on categorical judicial rules and proof of use rather than sector-norm analysis.²¹⁶ These differences confirm that substantive examination remains fragmented and office-specific.²¹⁷ The US system therefore illustrates how harmonization at the level of statutory recognition does not eliminate divergence in examination practice.²¹⁸

Chapter 5: Substantive Examination of NTMs in Selected Asian Jurisdictions

5.1. Introduction

This chapter examines the substantive examination of NTMs in Japan, China, and Singapore. All three jurisdictions have amended their trademark statutes to accommodate non-traditional signs, often following international developments and WIPO harmonization efforts.²¹⁹ At the

²⁰⁹ *TrafFix Devices* (n 79)

²¹⁰ Dogan and Lemley, 'Grounding Trademark Law' (n 184) 92 1669–1701; Morris (n 67).

²¹¹ Lemley, 'The Modern Lanham Act' (n 89) 1719–1724.

²¹² McKenna, 'Testing Modern Trademark Law's' (n 104) 96–101.

²¹³ Beebe (n 2), 'The Semiotic Analysis of Trademark Law' 688–692.

²¹⁴ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7.

²¹⁵ McKenna, 'The Normative Foundations of Trademark Law' (n 24) 1894–1898.

²¹⁶ Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454.

²¹⁷ Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176; Dinwoodie and Janis, 'The drivers of trademark law reform' (n 31) 1; Burrell and Handler (n 42) 51.

²¹⁸ Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16); Frankel and Gervais, *Advanced Introduction* (n 31) 89–94.

²¹⁹ Christopher Heath (ed), *Intellectual Property Law in Asia* (Kluwer 2003).

level of legislation, therefore, convergence appears significant.²²⁰ However, examination practice reveals marked divergence in the application of distinctiveness, functionality, and evidentiary standards.²²¹

This chapter argues that examination outcomes are shaped less by statutory wording than by office-specific administrative priorities, including efficiency, evidentiary caution, and competition concerns.²²² By focusing on examination guidelines and administrative practice rather than appellate case law, the chapter demonstrates that fragmentation persists at the examination stage.²²³

5.2. Japan: Formal Openness and Structured Examination

5.2.1. Legal Framework and Guidelines

Japan amended its Trademark Act in 2015 to permit the registration of colour, sound, motion, hologram, and position marks.²²⁴ The reform in 2014 was widely described as a significant expansion of protectable subject matter and as aligning Japan with international practice.²²⁵

Formally, Article 2 of the Japanese Trademark Act now adopts a broad definition capable of encompassing non-traditional signs.²²⁶ In practice, however, examination at the JPO is guided by detailed Examination Guidelines that emphasize strict assessment of distinctiveness.²²⁷ The Guidelines caution that consumers are not ordinarily accustomed to perceiving colours, shapes,

²²⁰ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19); Jane Ginsburg and Irene Calboli, 'Part One: International Aspects of Trademark Protection: Historical Perspectives and Current Developments' in *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) 15-21.

²²¹ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 3-9.

²²² Haochen Sun, 'Protecting Non-Traditional Trademarks in China: New Opportunities and Challenges' in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018) 185-200; Antons, 'Legal Culture and History of Law in Asia' (n 273); Kung Chung Liu, 'Limitations of Trademark Rights in Major Asian Jurisdictions' in Haochen Sun and Barton Beebe (eds), *Charting Limitations on Trademark Rights* (OUP 2023); Heath and Sanders (n 16).

²²³ Susy Frankel, 'The Challenge of Global Convergence' in Irene Calboli and Jane Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) 54-60.

²²⁴ Japan Trademark Act 1959 (as amended 2015), art 2(1).

²²⁵ Tessensohn, 'Expanding the realm of the senses' (n 13).

²²⁶ Japan Trademark Act (n 224) art 2.

²²⁷ *Christian Louboutin SAS v Commissioner of the Japan Patent Office* (2022 (Gyo Ke) 10051, IP High Court, 30 January 2023); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 12-18.

or positions as indicators of origin.²²⁸ This presumption mirrors broader East Asian administrative caution and embeds institutional scepticism at the examination level.²²⁹

5.2.2. Distinctiveness and Evidence

In practice, the JPO applies a high threshold for inherent distinctiveness in relation to NTMs.²³⁰ Shape and colour marks are frequently refused on the basis that they are perceived as decorative or functional features rather than source identifiers.²³¹ Applicants therefore commonly rely on acquired distinctiveness.²³²

The JPO requires substantial evidence demonstrating that the relevant public associates the sign exclusively with a single undertaking.²³³ Such evidence typically includes long-term and continuous use, advertising materials, and market data.²³⁴ Because the Guidelines do not specify quantitative thresholds, evidentiary sufficiency depends heavily on examiner assessment.²³⁵ Scholars have noted that this structured but cautious approach reflects a preference for legal certainty and market clarity over expansive trademark protection.²³⁶ Thus, despite statutory openness, administrative practice restricts the practical accessibility of NTMs.²³⁷

²²⁸ *LIFULL Co Ltd v Commissioner of the Japan Patent Office* (Reiwa 1 (Gyo Ke) 10119, IP High Court, 11 March 2020); John Tessensohn, ‘Orange is the new black—IP High Court of Japan and single colour trade marks’ (2021) 16 (9) *J Intell Prop L & Prac* 974–987.

²²⁹ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 12–18; Liu, ‘Limitations of Trademark Rights’ (n 222); Heath and Sanders (n 16).

²³⁰ Elnur Karimov, ‘Non-traditional trade marks in the European Union and Japan: is there an inflating trade mark balloon?’ (2022) 17(2) *J Intell Prop L & Prac* 132–148; *Intellectual Property High Court*, Reiwa 1 (Gyo-Ke) No 10147 (23 June 2020); Tessensohn, ‘Orange is the new black’ (n 228) 974–987.

²³¹ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

²³² *Tombow Pencil Co Ltd*, Notification of Acceptance for colour only trademark, JPO Application No 2015 29914 (Notification of Acceptance, 28 February 2017).

²³³ Japan Patent Office, Examination Guidelines for Trademarks (April 2024) Part II.

²³⁴ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 59–66; *Intellectual Property High Court* (2022 (Gyo-Ke) 10062, 24 January 2023).

²³⁵ *The “Maglite” Shape Case* (2005 (Gyo-Ke) 10001, IP High Court, 29 June 2005); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 14–16.

²³⁶ Karimov (n 230) 132–148; Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37) 633–639.

²³⁷ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 115–121; *The Coca Cola Company v Commissioner of the Japan Patent Office* (2007 (Gyo Ke) 10215, IP High Court, 29 May 2008; Heath and Sanders (n 16).

5.3. China: Formal Recognition and Restrictive Administration

5.3.1. Legal Recognition and Administrative Logic

China amended its Trademark Law in 2013 to recognise sound marks and other non-traditional signs.²³⁸ The amended Article 8 adopts a broad definition similar to international standards.²³⁹ CNIPA Examination Guidelines confirm that non-traditional signs are admissible in principle.²⁴⁰ However, examination practice remains restrictive, particularly concerning distinctiveness and functionality.²⁴¹

CNIPA examiners frequently emphasise that a mark must be immediately capable of distinguishing goods or services.²⁴² This interpretation narrows the space for inherent distinctiveness in the case of unconventional signs.²⁴³ Scholars attribute this restrictive tendency partly to administrative pressures, including high application volumes and concerns with maintaining market order.²⁴⁴ Examination practice therefore reflects institutional management considerations alongside doctrinal analysis.²⁴⁵

5.3.2. Evidence and Consumer Perception

Although Chinese law permits registration based on acquired distinctiveness, reliance on this route is demanding.²⁴⁶ Examiners often require extensive and geographically widespread evidence demonstrating consumer recognition across relevant markets.²⁴⁷ For NTMs,

²³⁸ PRC Trademark Law 1982 (as amended 2013), art 8.

²³⁹ *ibid.*

²⁴⁰ China National Intellectual Property Administration, Trademark Examination and Review Guidelines (2017, rev edn).

²⁴¹ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 115-121; Liu, 'Limitations of Trademark Rights' (n 222).

²⁴² Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15); *Beijing Qihoo Technology Co Ltd v Trademark Review and Adjudication Board (TRAB)* (2018) Beijing High People's Court, Jing Xing Zhong No. 1386 (the '360' Sound Mark Case); Haochen Sun, 'Case 9: The "360" Sound Mark Case' in Kung Chung Liu (ed), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019) 115-121; CNIPA, Trademark Examination and Review Guidelines (n 240).

²⁴³ Danny Friedmann, 'The bottle is the message: only the distinctive survive as 3D Community trade marks' (2015) 10 J Intell Prop L & Prac 35; Sun, 'Case 9: The "360" Sound Mark Case' (n 242) 119-120.

²⁴⁴ Paul Kossof, *Chinese Trademark Law: The New Chinese Trademark Law of 2014* (CAP 2014) 13-40; Peter Yu, 'The Rise and Decline of the Intellectual Property Powers' (2012) 34 Campbell L Rev 525; Sun, 'Protecting Non-Traditional Trademarks in China' (n 222) 185-200; Heath and Sanders (n 16).

²⁴⁵ *ibid.*

²⁴⁶ Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34-61; IP Key, Study on Chinese Trade Mark Law: Assessment of the impact of the reform of China's trade mark law — Final Report (Rouse/IP Key 2019); PRC Trademark Law (n 238) art 11(2); *Supreme People's Court* (2017) Zui Gao Fa Xing Zai No. 34 (Guiding Case No. 114).

²⁴⁷ Susan Mok, 'What Do the New Trademark Examination Guidelines in China Mean for Brand Protection?' China Law & Practice (4 March 2022) accessed 19 March 2026

assembling such evidence is particularly difficult.²⁴⁸ As a result, acquired distinctiveness plays a limited practical role in securing registration of non-traditional signs.²⁴⁹

Commentators observe that CNIPA practice prioritises administrative certainty and competition control over flexible adaptation to branding innovation.²⁵⁰ The gap between formal legal acceptance and examination outcomes is therefore pronounced.²⁵¹

5.4. Singapore: Pragmatic Openness and Evidentiary Discipline

5.4.1. Legal Framework and Guidance

Singapore's Trade Marks Act adopts a broad and technology-neutral definition of a trademark.²⁵² The legislation does not exclude non-traditional signs and permits registration of colour, shape, and sound marks.²⁵³ IPOS Examination Guidelines expressly acknowledge the admissibility of such signs.²⁵⁴

Singapore is frequently cited in comparative scholarship as an example of regulatory openness within Asia.²⁵⁵ Nevertheless, IPOS practice emphasises precise representation and strict compliance with distinctiveness requirements.²⁵⁶ Particular scrutiny is applied where a sign overlaps with product design or aesthetic features.²⁵⁷

<https://www.chinalawandpractice.com/2022/03/04/what-do-the-new-trademark-examination-guidelines-in-china-mean-for-brand-protection/>; CNIPA, *Trademark Examination and Review Guidelines* (n 240); *Zippo Manufacturing Company v Trademark Review and Adjudication Board (TRAB)* (2016) Beijing High People's Court, Jing Xing Zhong No 165 (the Zippo Lighter Case).

²⁴⁸ Peter Ganea, Danny Friedmann, Jyh An Lee and Douglas Clark, *Intellectual Property Law in China* (2nd edn, Kluwer 2021); *Hermès International v Trademark Review and Adjudication Board (TRAB)* (2011) Beijing High People's Court, Gao Xing Zhong Zi No 329 (the Birkin and Kelly Bag Shape Case).

²⁴⁹ Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61.

²⁵⁰ Sun, 'Protecting Non-Traditional Trademarks in China' (n 222); Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61; Heath and Sanders (n 16).

²⁵¹ Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37); Sun, 'Protecting Non-Traditional Trademarks in China' (n 222).

²⁵² Singapore Trade Marks Act (Cap 332, 2005 Rev Ed) s 2(1).

²⁵³ *ibid.*

²⁵⁴ Intellectual Property Office of Singapore (IPOS), *Trade Marks Work Manual* (IPOS, 2022).

²⁵⁵ Irene Calboli, 'Comparative Legal Analysis and Intellectual Property Law: A Guide for Research' in *Handbook of Intellectual Property Research* (OUP 2021) ch 3; Lin Lin (NUS), 'Regulating FinTech: The Case of Singapore' (NUS Law Working Paper 2019/028); Dato' Abdul Latif Bin Haji Abu Seman, Hank Lim and Shahriza Bahari, 'Regulatory Coherence: The Contrasting Cases of Malaysia and Singapore' in D Gill and P Intal Jr (eds), *The Development of Regulatory Management Systems in East Asia: Country Studies* (ERIA Research Project Report 2015-4, ERIA 2016) 393–430.

²⁵⁶ *Staywell Hospitality Pty. Ltd v Starwood Hotels & Resorts Worldwide Inc* [2019] SGCA 39; IPOS, *Trade Marks Work Manual* (n 254); Loy Wee Loon Ng, *Law of Intellectual Property in Singapore* (Sweet & Maxwell, 3rd ed, 2021) ch 21 (Representation/Procedure).

²⁵⁷ *Société des Produits Nestlé SA v Petra Foods Ltd* [2016] SGCA 64.

5.4.2. Distinctiveness, Evidence and Competition

As in Japan and China, NTMs in Singapore often depend on acquired distinctiveness.²⁵⁸ IPOS requires persuasive evidence that consumers perceive the sign as a trademark rather than as a functional or decorative element.²⁵⁹ The assessment of such evidence involves significant examiner discretion.²⁶⁰

Competition considerations are implicitly present, especially where exclusive rights might restrict access to desirable product features.²⁶¹ Although Singapore's system is comparatively streamlined and commercially oriented, examination outcomes remain conservative in practice.²⁶² This demonstrates that formal flexibility does not eliminate administrative caution.²⁶³

5.5. Comparative Observations

Across Japan, China, and Singapore, a consistent structural pattern emerges.²⁶⁴ Each jurisdiction formally recognizes NTMs through broad statutory definitions aligned with international standards.²⁶⁵ Yet examination practice imposes high thresholds for inherent distinctiveness and demanding evidentiary requirements for acquired distinctiveness.²⁶⁶ These thresholds are shaped by national administrative cultures, evidentiary preferences, and competition policy concerns rather than by international harmonization norms.²⁶⁷

Compared to the EU and US systems, Asian offices exhibit similar caution but operationalize it differently: Japan through structured guidelines, China through restrictive interpretation and

²⁵⁸ LWL Ng (n 256) ch 21; Singapore Trade Marks Act (n 252) s 7(2); *Staywell Hospitality Group Pty. Ltd v Starwood Hotels & Resorts Worldwide Inc and others* [2014] 1 SLR 911 (SGCA).

²⁵⁹ Loy Wee Loon Ng, 'Trade Marks, Language and Culture: The Concept of Distinctiveness and Publici Juris' (2009) Singapore JLS 508; IPOS, Evidence of Distinctiveness Acquired Through Use (Trade Marks Work Manual (n 254); Lim Siau Wen and Teo Xuan Lang, 'The Role of Acquired Distinctiveness in the Marks-Similarity Analysis' (2022) SAL Prac 9.

²⁶⁰ Tan (n 13); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

²⁶¹ *Nation Fittings (M) Sdn Bhd v Oyster Tec plc* [2006] 1 SLR(R) 712 (SGHC); LWL Ng (n 256) ch 21.

²⁶² Susanna Leong, 'International exhaustion in Singapore: broad interpretation of "put on the market", yet offer for sale excluded' in Kung Chung Liu (ed), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019) 111; Liu, 'Limitations of Trademark Rights' (n 222).

²⁶³ *ibid*; Graeme Dinwoodie, 'Trade Mark Law as a Normative Project' (2023) Singapore JLS 305.

²⁶⁴ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 1–11.

²⁶⁵ Ganea and others (ed), *Intellectual Property Law in China* (n 248); Tessensohn, 'Expanding the realm of the senses' (n 13); LWL Ng (n 256) ch 21.

²⁶⁶ Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61; LWL Ng (n 256) ch 21.

²⁶⁷ Adams and Scardamaglia (n 7) 37–58; Calboli, 'Non-traditional trademarks as barriers' (n 7) 1–17; Frakes and Wasserman (n 14) 1807–1853; Cane and Conaghan (n 3); Assaf-Zakharov (n 8).

administrative control, and Singapore through pragmatic evidentiary discipline.²⁶⁸ The divergence confirms that substantive examination remains office-specific.²⁶⁹ For applicants seeking multi-jurisdictional protection, this fragmentation reduces predictability and increases compliance costs.²⁷⁰

Chapter 6: Comparative Analysis of Examiner Approaches

6.1. Purpose and Method of Comparison

This chapter undertakes a comparative analysis of the examination practices of the EUIPO, the USPTO, and selected Asian trademark offices with respect to NTMs. The analysis focuses on how trademark examiners apply registrability standards in practice. This approach reflects the premise developed in earlier chapters that examination outcomes are shaped primarily by administrative interpretation and evidentiary assessment.²⁷¹

The comparison is structured around three core dimensions that recur across all jurisdictions examined: the assessment of distinctiveness, the treatment of evidence and acquired distinctiveness, and the application of functionality and competition concerns.²⁷² This chapter demonstrates that, despite formal convergence at the level of legal recognition, substantive examination practices remain fragmented and office-specific.²⁷³

6.2. Formal Convergence and Practical Divergence

Across the EU, the US, and the selected Asian jurisdictions, trademark law formally recognizes that non-traditional signs may function as trademarks.²⁷⁴ This convergence is reflected in broad statutory definitions of trademarks and in the removal of categorical exclusions for non-traditional subject matter.²⁷⁵ International instruments such as the TRIPS Agreement and WIPO initiatives have contributed to this shared legal language.²⁷⁶

²⁶⁸ Tessensohn, 'Expanding the realm of the senses' (n 13) 909–914; Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61; Tan (n 13).

²⁶⁹ Heath (ed), *Intellectual Property Law in Asia* (n 219) ch 1; Heath and Sanders (n 16).

²⁷⁰ Calboli, 'Non-traditional trademarks as barriers' (n 7) 1–17; Tessensohn, 'Expanding the realm of the senses' (n 13) 909–914.

²⁷¹ Heath (ed), *Intellectual Property Law in Asia* (n 219) intro and chs 1–3.

²⁷² Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2).

²⁷³ Christoph Antons, 'Legal Culture and History of Law in Asia' in Christopher Heath (ed), *Intellectual Property Law in Asia* ch 2 (Kluwer 2003).

²⁷⁴ TRIPS Agreement (n 3) art 15(1).

²⁷⁵ Kur and Senftleben, *European Trade Mark Law* (n 51); Merges, (n 128) 288–294.

²⁷⁶ TRIPS Agreement (n 3) art 15(1). WIPO guidance on trademarks and international registration WIPO, WIPO Intellectual Property Handbook: Policy, Law and Use (WIPO Publication No 489(E) 2004) ch on trademarks;

However, this convergence operates largely at a formal level.²⁷⁷ As shown in Chapters 3 to 5, examination practice reveals significant divergence in how registrability standards are operationalized.²⁷⁸ Identical or similar NTMs may be accepted in one jurisdiction and refused in another, not because of differences in legal texts, but because of differences in examiner assumptions, evidentiary expectations, and institutional priorities.²⁷⁹ This divergence illustrates the limited reach of international harmonization in trademark law.²⁸⁰

6.3. Distinctiveness: Divergent Thresholds under a Shared Concept

Distinctiveness is a core requirement across all jurisdictions examined, yet its practical assessment varies significantly.²⁸¹ In the EU, the EUIPO applies the “departure from sector norms” test, requiring non-traditional signs to differ substantially from market expectations in order to be inherently distinctive.²⁸² This test embeds a strong presumption against distinctiveness for NTMs and places considerable weight on examiner judgment.²⁸³

By contrast, US examination practice adopts categorical rules that exclude certain NTMs—most notably product design—from inherent distinctiveness altogether.²⁸⁴ This approach reflects a different regulatory strategy, favouring clear *ex-ante* rules over contextual assessment.²⁸⁵ While this may enhance predictability within the US system, it also narrows the scope for recognizing non-traditional branding strategies.²⁸⁶

WIPO, Guide to the International Registration of Marks under the Madrid Agreement and Protocol (Madrid Guide 2024); Calboli and Senfleben (eds), *The Protection of Non-Traditional Trademarks* (n 95).

²⁷⁷ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 1-2; Kur and Dreier, *European Intellectual Property Law* (n 1) chs 2, 4 and 7.

²⁷⁸ See Chapters 3–5 above.

²⁷⁹ Gangjee (n 4) 59–88; Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

²⁸⁰ Dinwoodie and Janis, *Trademark Law and Theory* (n 3) 3-41, 42-64, 65-94, 95-148, 151-176; Heath and Sanders (n 16); Frankel and Gervais, *Advanced Introduction* (n 31) 89–94.

²⁸¹ *Philips Electronics* (n 122); Beebe, ‘*The Semiotic Analysis of Trademark Law*’ (n 2) 676–680; McKenna, ‘Teaching Trademark Theory’ (n 163) 845-855.

²⁸² Ilanah Fhima, ‘What is a Significant Departure from the Norm? Assessing the Inherent Distinctiveness of 3D Shape Marks’ (2022) 17 J Intell Prop L & Prac 993; EUIPO, ‘A Hatching Chick Takes (and Fails) the Significant Departure Test’ (EUIPO Law — Recent Case-Law, 26 June 2024) accessed 19 March 2026 <<https://www.euiipo.europa.eu/en/law/recent-case-law/a-hatching-chick-takes-and-fails-the-significant-departure-test>>.

²⁸³ Fhima and Gangjee, *The Confusion Test in European Trade Mark Law* (n 142) 178–183; EUIPO, Guidelines for Examination, Part B (n 5).

²⁸⁴ *Wal-Mart* (n 86); Jennifer Barwinski, ‘Trade Dress: Should Only the Secondary Meaning Trade Dress Standard Apply to Product Packaging? Or Should Courts Continue to Use the Inherently Distinctive Standard?’ (2004) 8 *Marq Intell Prop L Rev* 119.

²⁸⁵ McKenna, ‘The Normative Foundations of Trademark Law’ (n 24).

²⁸⁶ Graeme Dinwoodie, ‘The Death of Ontology: A Teleological Approach to Trademark Law’ (1999) 84 Iowa L Rev 611.

In the selected Asian jurisdictions, examination practice similarly reflects scepticism toward inherent distinctiveness, but without the same doctrinal articulation.²⁸⁷ Examiners in Japan, Singapore and, China frequently relies on assumptions about consumer habits and market norms, often refusing NTMs on the ground that they are perceived as decorative or functional.²⁸⁸ The absence of clear, articulated thresholds further increases the role of examiner discretion.²⁸⁹

Taken together, these approaches demonstrate that distinctiveness operates as a flexible concept in theory but as a restrictive filter in practice.²⁹⁰ Although the language of distinctiveness is shared, its application is shaped by office-specific understandings of consumer perception and market structure.²⁹¹

6.4. Evidence and Acquired Distinctiveness as Administrative Filters

Where inherent distinctiveness cannot be established, all jurisdictions examined allow applicants to rely on acquired distinctiveness.²⁹² In principle, this mechanism offers a pathway to registration for NTMs that gain source-identifying meaning through use.²⁹³ In practice, however, evidentiary requirements function as a major barrier.²⁹⁴

The EUIPO imposes a particularly demanding evidentiary burden, requiring proof of acquired distinctiveness across the EU.²⁹⁵ Although the CJEU has clarified that separate evidence for

²⁸⁷ Tan (n 13); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

²⁸⁸ JPO, Examination Guidelines for Trademarks (n 233); CNIPA, *Trademark Examination and Review Guidelines* (n 240); IPOS, Trade Marks Work Manual (n 254); Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95); International Trademark Association (INTA), China Case Law Annual Review (May 2025) <<https://www.inta.org/>> accessed 25 February 2026; TM5/INTA, Second TM5–INTA Joint Workshop on Examination Practices for Non-Traditional Trademarks (Japan Presentation, 2018) <<https://tmfive.org/the-second-tm5-inta-joint-workshop-of-the-examination-practices-on-non-traditional-trademarks/>> accessed 19 March 2026; Intellectual Property Office of Singapore (IPOS), Annual Report 2024 (IPOS 2024) <<https://www.ipos.gov.sg/>> accessed 25 February 2026.

²⁸⁹ Dinwoodie, ‘The Death of Ontology’ (n 286); McKenna, ‘The Normative Foundations of Trademark Law’ (n 24); Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

²⁹⁰ Merges, (n 128) 288–294; Rebecca Tushnet, ‘Registering Disagreement: Registration in Modern American Trademark Law’ (2017) 130 Harv L Rev 867; Morris (n 67).

²⁹¹ *ibid.*

²⁹² EUTMR (n 107) art 7(3); Lanham Act (n 168) §1052(f); Japan Trademark Act (n 224) art 3(2); PRC Trademark Law (n 238) art 11(2); Singapore Trade Marks Act (n 252) s 7(2).

²⁹³ *Qualitex Co* (n 82); *Nestlé SA v Mondelez UK* (n 68).

²⁹⁴ Porangaba (n 140).

²⁹⁵ EUTMR (n 107) art 7(3); *August Storck KG v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-25/05 P) [2006] ECR I-5719, ECLI:EU:C:2006:422 [83]–[86]; *Chocoladefabriken Lindt & Sprüngli AG v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-98/11 P) ECLI:EU:C:2012:307.

each MS is not required, the overall standard remains high and difficult to satisfy.²⁹⁶ This territorial requirement reflects the unitary nature of the EU trademark but significantly limits the practical availability of acquired distinctiveness for NTMs.²⁹⁷

In the US, the evidentiary focus is different but equally restrictive.²⁹⁸ The USPTO places strong emphasis on actual use in commerce and on proof of secondary meaning under Section 2(f) of the Lanham Act.²⁹⁹ While this approach aligns with US trademark theory, it grants examiners broad discretion in evaluating evidence and creates uncertainty for applicants.³⁰⁰

Asian trademark offices similarly require substantial evidence of consumer recognition, often demanding long-term, exclusive use.³⁰¹ In China, evidentiary requirements are applied conservatively, with limited guidance on what constitutes sufficient proof.³⁰² This reinforces the filtering function of examination practice and limits access to trademark protection for NTMs.³⁰³

Across all jurisdictions, evidentiary assessment emerges as a critical point of administrative power.³⁰⁴ Although framed as neutral fact-finding, evidence evaluation allows trademark offices to shape substantive outcomes and control the expansion of trademark protection.³⁰⁵

²⁹⁶ *Nestlé SA v Mondelez UK* (n 68); Porangaba (n 140).

²⁹⁷ Fhima and Gangjee, *The Confusion Test in European Trade Mark Law* (n 142); Porangaba (n 140).

²⁹⁸ Lanham Act (n 168) § 1052(f); USPTO TMEP (n 174) §1212; Tushnet, 'Registering Disagreement' (n 290); Beebe, *The Semiotic Analysis of Trademark Law* (n 2).

²⁹⁹ *Wal-Mart Stores* (n 86); Tushnet, 'Registering Disagreement' (n 290); Beebe, *The Semiotic Analysis of Trademark Law* (n 2).

³⁰⁰ Dogan and Lemley, 'Grounding Trademark Law' (n 184) 92 1703–1708.

³⁰¹ Yoshiyuki Tamura, 'Three-dimensional shape of Coca-Cola bottles registrable: acquired distinctiveness evidenced by questionnaire in Japan' in Kung Chung Liu (ed), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2021) ch 9; Haijun Jin, 'Market Survey Recently Recognised as a Persuasive Tool to Solve Trademark Disputes in China' in *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019) ch 6; Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (3rd edn, Academy Publishing 2014).

³⁰² IP Key (n 246); Danny Friedmann, 'Trade Marks and Related Rights' in Peter Ganeva and others (eds), *Intellectual Property Law in China* (2nd edn, Kluwer 2021).

³⁰³ Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61.

³⁰⁴ James Mellor and others, *Kerly's Law of Trade Marks and Trade Names* (16th edn, Sweet & Maxwell 2017); Jake Linford, 'Democratizing access to survey evidence of distinctiveness' in Graeme Dinwoodie and Mark Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar 2021) 225–249; Janis and Dinwoodie, 'Confusion Over Use' (n 26).

³⁰⁵ Lemley, 'The Modern Lanham Act' (n 89) 1719–1724; Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16); Janis and Dinwoodie, 'Confusion Over Use' (n 26).

6.5. Functionality and Competition as Cross-Cutting Constraints

Functionality constitutes a further point of convergence in principle and divergence in practice.³⁰⁶ All jurisdictions examined recognize that trademark protection should not extend to functional product features.³⁰⁷ This shared commitment reflects underlying competition concerns and the need to preserve market access.³⁰⁸

In the EU, functionality exclusions under Article 7(1)(e) EUTMR are mandatory and applied strictly by the EUIPO.³⁰⁹ Examiners frequently rely on technical documentation and prior design or patent protection to identify functional characteristics.³¹⁰ This approach prioritizes competition policy but also limits the scope for protecting non-traditional signs that overlap with product design.³¹¹

US examination practice similarly applies functionality doctrine strictly, particularly where a feature is covered by a utility patent.³¹² The Supreme Court's emphasis on competition in cases such as *TrafFix* has strongly influenced USPTO practice.³¹³ While this provides doctrinal clarity, it further constrains the registrability of NTMs.³¹⁴

In Asia, functionality concerns are often less explicitly articulated but no less influential.³¹⁵ Examiners frequently refuse NTMs that are perceived to confer a competitive advantage, even where functionality is not expressly invoked.³¹⁶ This implicit reliance on competition policy underscores the regulatory role of trademark offices.³¹⁷

³⁰⁶ Kur and Senftleben, *European Trade Mark Law* (n 51) 206–210; *Philips Electronics* (n 122).

³⁰⁷ Merges, (n 128) 288–294; TRIPS Agreement, art 15(1); Lionel and Sherman (eds), *Intellectual Property Law* (n 1) 883–889.

³⁰⁸ Bone (n 23) 580–586.

³⁰⁹ EUTMR (n 107) art 7(1)(e); *Hauck GmbH & Co KG v Stokke A/S and Others* (Case C-205/13) ECLI:EU:C:2014:2233.

³¹⁰ Ilanah Fhima, 'Functionality in Europe: When Do Trade Marks Achieve a Technical Result?' (2020) 110 *Trade Mark Rep* 659; *Lego Juris* (n 152).

³¹¹ Estelle Derclaye and Loy Wee Loon Ng, 'Relationship between Trademark Law and Copyright/Design Law: Trademark Protection for Ornamental Shapes?' in Irene Calboli and Jane Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) 421–435.

³¹² Harold Weinberg, 'Trademark Law, Functional Design Features, and the Trouble with *TrafFix*' (2001) 9 *J Intell Prop L*; Fhima, 'Functionality in Europe' (n 310).

³¹³ *TrafFix Devices* (n 79).

³¹⁴ Dogan and Lemley, 'Grounding Trademark Law' (n 184) 1669–1701; Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2).

³¹⁵ Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 190–198; Haochen Sun and Barton Beebe (ed), *Charting Limitations on Trademark Rights* (OUP 2023).

³¹⁶ Gangjee (n 4) 59–88; Heath and Sanders (n 16).

³¹⁷ Yu (n 244).

6.6. Examiner Discretion and Administrative Culture

A central finding of this comparative analysis is the pervasive role of examiner discretion.

³¹⁸ Across all jurisdictions examined, trademark examiners act as gatekeepers who translate abstract legal standards into concrete decisions.³¹⁹ Although guidelines and manuals aim to structure this discretion, they do not eliminate it.³²⁰

Differences in administrative culture further shape examination outcomes.³²¹ The EUIPO emphasizes consistency and legal certainty across a large internal market, resulting in cautious and standardized examination.³²² The USPTO prioritizes use-based assessment and competition concerns, leading to categorical exclusions and strong evidentiary demands.³²³ Asian trademark offices, operating under different institutional constraints, often adopt conservative examination practices that prioritize administrative efficiency.³²⁴

These differences demonstrate that examination practice is not merely a technical application of law, but a form of regulatory governance.³²⁵ Trademark offices actively shape the boundaries of trademark protection through examination, even in the absence of explicit policy mandates.³²⁶

Chapter 7: Practical Implications for Trademark Applicants

7.1. Legal Uncertainty and Strategic Risk

Although NTMs are formally recognized across the EU, the US, and major Asian jurisdictions, applicants face substantial uncertainty at the examination stage.³²⁷

³¹⁸ Frankel, 'The Challenge of Global Convergence' (n 223) 62-67.

³¹⁹ Frakes and Wasserman (n 14)1807-1853; Lemley and Sampat (n 19)817-827.

³²⁰ *ibid.*

³²¹ Frakes and Wasserman (n 14)1807-1853; Robert Baldwin, Martin Cave and Martin Lodge, *Understanding Regulation: theory, strategy, and practice* (2nd edn, OUP 2012) 86-94.

³²² Kur and Senftleben, *European Trade Mark Law* (n 51) 82-89.

³²³ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7; Frakes and Wasserman (n 14)1807-1853; McCarthy (n 33).

³²⁴ Sun, 'Protecting Non-Traditional Trademarks in China' (n 222) 185-200; Frakes and Wasserman (n 14)1807-1853; Baldwin, Cave and Lodge, (n 321) 86-94; Friedmann, 'Trade Marks and Related Rights' (n 302).

³²⁵ Lemley, 'The Modern Lanham Act' (n 89) 1719-1724; Edouard Treppoz and Jane Ginsburg, 'Territoriality and Supranationality: Judicial and Legislative Competence in International Trademark Disputes' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) 126-141.

³²⁶ Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95); Frakes and Wasserman (n 14)1807-1853; Lemley and Sampat (n 19)817-827.

³²⁷ Lisa Ramsey, 'Protectable Trademark Subject Matter in Common Law Countries and the Problem with Flexibility' in Irene Calboli and Jane Ginsburg (eds), *The Cambridge Handbook of International and Comparative*

The divergence in distinctiveness standards means that a sign considered registrable in one jurisdiction may be refused in another despite identical commercial use.³²⁸ Such inconsistencies complicate global branding strategies and weaken the predictability that international trademark harmonization was intended to promote.³²⁹

The territorial requirement for proving acquired distinctiveness in the EU, for example, creates a particularly high evidentiary burden for applicants seeking unitary protection.³³⁰ Even where substantial market recognition exists in several MSs, the absence of comprehensive territorial evidence may result in refusal.³³¹ In the US, the strict separation between product design and product packaging, combined with the insistence on secondary meaning for configuration marks, introduces a categorical barrier not replicated elsewhere.³³² Applicants must therefore tailor evidentiary submissions to jurisdiction-specific doctrines rather than relying on a harmonized evidentiary strategy.³³³ In China, the conservative interpretation of inherent distinctiveness and demanding proof of consumer recognition further increases the risk of refusal for unconventional marks.³³⁴ Singapore, while comparatively flexible, maintains rigorous evidentiary scrutiny that similarly requires jurisdiction-specific preparation.³³⁵

The cumulative effect is that multinational applicants must design parallel registration strategies rather than a unified global approach.³³⁶ This fragmentation increases transaction

Trademark Law (CUP 2020) ch 11; Martin Senftleben, 'Signs Eligible for Trademark Protection in the European Union: Dysfunctional Incentives and a Functionality Dilemma' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) ch 12.

³²⁸ Fhima and Gangjee, *The Confusion Test in European Trade Mark Law* (n 142)1–33; Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) 381–390; Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 3–9, 59–66, 132–138.

³²⁹ Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176; Susy Frankel, 'Global Intellectual Property: Transition and Coherence Through Rules of Interpretation' in Niklas Bruun, Graeme Dinwoodie, Marianne Levin and Ansgar Ohly (eds), *Transition and Coherence in Intellectual Property Law* (CUP 2020) chapter 6; Heath and Sanders (n 16).

³³⁰ Fhima and Gangjee, *The Confusion Test in European Trade Mark Law* (n 142)1–33; Fhima, 'Rethinking Distinctiveness of Shape Trade Marks' (n 7); Łukasz Żelechowski, 'How Unitary is the EU Trade Mark? Territorial Aspects of Acquired Distinctiveness' (2020) 51 (4) IIC 468–498.

³³¹ *Nestlé SA v Mondelez UK* (n 68); Żelechowski (n 330); EUIPO Guidelines, Part B, Chapter 6 (n 5).

³³² McKenna, 'Teaching Trademark Theory' (n 163) 845–855; McCarthy (n 33); *Wal-Mart Stores* (n 86); *Two Pesos, Inc v Taco Cabana, Inc* 505 US 763 (1992).

³³³ Ramsey, 'Protectable Trademark Subject Matter' (n 327) ch 11.

³³⁴ Sun, 'Protecting Non-Traditional Trademarks in China' (n 222) 185–200.

³³⁵ Tan (n 13); *Nestlé SA v Petra Foods* (n 257).

³³⁶ Frankel, 'The Challenge of Global Convergence' (n 223) 54–60; Graeme Dinwoodie, 'International and Comparative Dimensions' (Part II) in Graeme Dinwoodie and Mark Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar 2008).

costs, legal fees, and evidentiary burdens, particularly for small and medium-sized enterprises seeking to protect innovative branding elements.³³⁷

7.2. Administrative Discretion and Substantive Control

Divergent examination practices also reveal the central role of administrative discretion in shaping substantive trademark protection.³³⁸ Although statutory definitions of trademarks are broadly aligned across jurisdictions, the practical meaning of distinctiveness is determined through examiner evaluation.³³⁹

The assessment of consumer perception, especially in the context of NTMs, often depends on qualitative judgment rather than fixed legal criteria.³⁴⁰ Evidentiary sufficiency in acquired distinctiveness claims illustrates this dynamic particularly clearly.³⁴¹ Because most statutes do not specify quantitative thresholds for proving secondary meaning, examiners retain substantial leeway in evaluating surveys, sales figures, and advertising evidence.³⁴² This discretion allows trademark offices to regulate the expansion of trademark protection indirectly through evidentiary standards.³⁴³

Functionality doctrine similarly operates as an administrative filter influenced by competition policy considerations.³⁴⁴ Where product features overlap with design or technical elements, examiners may interpret functionality broadly in order to preserve market freedom.³⁴⁵ While such caution may be normatively defensible, it demonstrates that examination practice serves regulatory objectives beyond the mere application of statutory text.³⁴⁶ The result is that

³³⁷ Beebe and Fromer, 'Are We Running Out of Trademarks?' (n 38) 1045.

³³⁸ Lemley, 'The Modern Lanham Act' (n 89) 1719–1724; LWL Ng (n 256) ch 21.

³³⁹ Tushnet, 'Registering Disagreement' (n 290); McCarthy (n 33); Tan (n 13).

³⁴⁰ McKenna, 'The Normative Foundations of Trademark Law' (n 24); Sun and Beebe (eds), *Charting Limitations on Trademark Rights* (n 315); Sheff (n 24).

³⁴¹ Calboli, 'Non-traditional trademarks as barriers' (n 7) 1–17; Porangaba (n 140).

³⁴² Merges, (n 128) 288–294; McKenna, 'Testing Modern Trademark Law's' (n 104) 94–100; McKenna, 'Teaching Trademark Theory' (n 163) 845–855; LWL Ng (n 256) ch 21.

³⁴³ Lemley, 'The Modern Lanham Act' (n 89) 1719–1724; Frankel, 'The Challenge of Global Convergence' (n 223) 62–67; Kossof (n 244) 13–40; Adams and Scardamaglia (n 7); Merges, (n 128) 288–294.

³⁴⁴ Valentina Bonomo and Paola Magnani, 'Non-Distinctive Uses of a Trademark: The CJEU's "Function Theory" (and Its Adoption by Italian Courts) – Future Prospects in Light of EU Trademark Law' (2022) 53 IIC 685; Kur and Senftleben, *European Trade Mark Law* (n 51) 206–210; McKenna, 'The Normative Foundations of Trademark Law' (n 24) 1901–1908.

³⁴⁵ Bone (n 23) 560–575; Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 190–198.

³⁴⁶ Frankel and Gervais, *Advanced Introduction* (n 31) 89–94; Adams and Scardamaglia (n 7).

substantive trademark protection is shaped as much by institutional culture and policy orientation as by formal legal doctrine.³⁴⁷

7.3. Limits of International Harmonization

The practical consequences of divergence expose the limits of international harmonization in trademark law.³⁴⁸ International agreements and WIPO initiatives have promoted broad definitions of registrable subject matter, creating the appearance of convergence.³⁴⁹ However, these instruments provide only abstract standards for distinctiveness and functionality, leaving implementation to national offices.³⁵⁰ The persistence of divergent examination thresholds confirms that harmonization operates primarily at the level of legislative language rather than administrative practice.³⁵¹

For applicants, this gap undermines the expectation that global trademark protection can be secured through uniform criteria.³⁵² Instead, harmonization functions as a framework within which national offices continue to exercise autonomous interpretive authority.³⁵³

The case of NTMs illustrates this tension particularly clearly because such marks sit at the margins of traditional trademark doctrine.³⁵⁴ Where legal categories are indeterminate, administrative bodies gain greater influence over outcomes.³⁵⁵ This structural reality challenges assumptions that international coordination alone can deliver substantive consistency.³⁵⁶ It also raises broader questions about the accountability and transparency of examination practices in shaping the scope of intellectual property rights.³⁵⁷

³⁴⁷ Antons, 'Legal Culture and History of Law in Asia' (n 273); Frakes and Wasserman (n 14) 1807–1853; Baldwin, Cave and Lodge, (n 321) 86–94; Litman (n 23).

³⁴⁸ Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16); Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454.

³⁴⁹ Gervais (n 33) 232–236; Calboli and Ginsburg, 'Introduction' in *The Cambridge Handbook* (n 37) 3–10.

³⁵⁰ Bonomo and Magnani (n 344); Frakes and Wasserman (n 14) 1807–1853.

³⁵¹ Haochen Sun, Can Louis Vuitton Dance with HiPhone? Rethinking the Idea of Social Justice in Intellectual Property Law (2012) 15 U Pa J L & Soc Change 389; Frankel and Gervais, *Advanced Introduction* (n 31) 89–94.

³⁵² Gangjee (n 4) 59–88.

³⁵³ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 1; Frankel, 'The Challenge of Global Convergence' (n 223) 62–67.

³⁵⁴ Anemaet, (n 365); Beebe, 'The Semiotic Analysis of Trademark Law' (n 2) 690–695.

³⁵⁵ Merges, (n 128) 288–294; LWL Ng (n 256) ch 21.

³⁵⁶ Kur, 'Trade Marks Function, Don't They?' (n 25) 453–454; Frankel, 'The Challenge of Global Convergence' (n 223) 62–67.

³⁵⁷ Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454; Cane and Conaghan (n 3).

7.4. Implications for Future Reform

If legal certainty is to be strengthened, greater transparency in evidentiary assessment and clearer articulation of distinctiveness thresholds would be required.³⁵⁸ Comparative dialogue among trademark offices could reduce unnecessary divergence while preserving legitimate competition concerns.³⁵⁹ At the same time, excessive rigidity may risk stifling innovation in branding and marketing practices.³⁶⁰

A balanced approach would recognize that NTMs require contextual evaluation while ensuring that administrative discretion remains reviewable and principled.³⁶¹ Ultimately, the experience of NTMs demonstrates that harmonisation without convergence in examination practice provides only partial predictability.³⁶²

The fragmentation observed across the EU, the US, and Asia therefore supports the central hypothesis of this thesis: substantive examination remains office-specific, and this divergence carries significant practical consequences for trademark applicants.³⁶³

Chapter 8: Conclusion

This thesis has examined the substantive examination of NTMs across the EU, the US, and selected Asian jurisdictions, and has demonstrated that formal legal convergence masks persistent practical divergence.³⁶⁴ Although modern trademark statutes broadly recognize

³⁵⁸ Lionel and Sherman (eds), *Intellectual Property Law* (n 1) 893–898; Andrew Griffiths, ‘Brands and Corporate Power’ (2018) *J Corp L Stud* 75–112.

³⁵⁹ Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37) 680–684; Irene Calboli, ‘Regional Trademark Protection: Comparing Regional Organizations in Europe, Africa, South East Asia, and South America’ in Calboli I and Ginsburg JC (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP 2020) 103–125.

³⁶⁰ Bone (n 23) 582–586; Luminita Olteanu, ‘The “trade-mark-law-and-innovation” trap: why it would be wise to conceptualize innovation outside the realms of dilution protection’ (2022) *17 J Intell Prop L & Prac* 659, 659–673.

³⁶¹ Griffiths (n 358) 88–104; Dinwoodie, ‘The Architecture of the International Intellectual Property System’ (n 16).

³⁶² Junji Nakagawa, ‘Harmonization of Intellectual Property Rights’ in *International Harmonization of Economic Regulation* (International Economic Law Series, OUP 2011) 137–168, 150–160; Frankel, ‘The Challenge of Global Convergence’ (n 223) 62–67; Frankel and Gervais, *Advanced Introduction* (n 31) 89–94.

³⁶³ Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37) 684–690; Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19) 8–12; Gangjee (n 4) 59–88.

³⁶⁴ Dinwoodie and Janis, ‘The drivers of trademark law reform’ (n 31) 1, 4–6; Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37).

colours, shapes, sounds, and other unconventional signs, the practical accessibility of such protection depends on how examination standards are applied.³⁶⁵

The comparative analysis shows that distinctiveness, functionality, and evidentiary assessment operate as administrative filters that vary significantly across offices.³⁶⁶ These differences are not incidental; they reflect deeper institutional priorities and regulatory cultures within each trademark system.³⁶⁷

In the EU, examination practice is shaped by the objective of ensuring uniformity across a multi-state internal market, which encourages structured and cautious application of distinctiveness and functionality rules.³⁶⁸ The territorial dimension of acquired distinctiveness, in particular, illustrates how the unitary structure of the EU trademark can transform a formally available doctrine into a demanding evidentiary hurdle.³⁶⁹ As scholars have observed, this model prioritizes market integration and competition concerns over expansive recognition of unconventional branding strategies.³⁷⁰

The US presents a different but equally restrictive pattern.³⁷¹ While US trademark law is often described as flexible, its categorical denial of inherent distinctiveness for product design and its strong reliance on secondary meaning embed structural constraints at the examination stage.³⁷²

The central role of use in commerce and evidentiary proof further reinforces a gatekeeping model in which examiners exercise substantial discretion.³⁷³ This approach reflects a long-

³⁶⁵ Gangjee (n 4); Lotte Anemaet, 'The Public Domain Is Under Pressure – Why We Should Not Rely on Empirical Data When Assessing Trademark Distinctiveness' (2016) 47 IIC 303–335.

³⁶⁶ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) 381–390; McKenna, '(Dys)Functionality' (n 77) 843–848.

³⁶⁷ Dinwoodie, 'Trade Mark Law as a Normative Project' (n 263); Cane and Conaghan (n 3).

³⁶⁸ Kur, 'Trade Marks Function, Don't They?' (n 25) 434–454; Kur, 'Fundamental concerns in the harmonization' (n 101) 151–176.

³⁶⁹ Porangaba (n 140); Żelechowski (n 330) 468–498.

³⁷⁰ Calboli, 'Hands Off' in *The Protection of Non-Traditional Trademarks* (n 69) 341–364; Lemley, 'The Modern Lanham Act' (n 89).

³⁷¹ Beebe, 'The Semiotic Analysis of Trademark Law' (n 2); Dinwoodie and Janis, *Trademark Law and Theory* (n 3).

³⁷² McKenna, 'Teaching Trademark Theory' (n 163) 845–855; *Wal-Mart Stores* (n 86); Tushnet, 'Registering Disagreement' (n 290); McCarthy (n 33).

³⁷³ Dogan and Lemley, 'Grounding Trademark Law' (n 184); Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) 381–386.

standing theoretical emphasis on consumer perception and competition, yet it also narrows the pathway to registration for NTMs.³⁷⁴

In Japan, China, and Singapore, legislative amendments have introduced formal openness to non-traditional signs, frequently in response to international developments.³⁷⁵ However, examination practice in these jurisdictions demonstrates consistent administrative caution, particularly in the assessment of inherent distinctiveness and consumer recognition.³⁷⁶ Japanese examination guidelines institutionalize a presumption that consumers do not ordinarily perceive unconventional signs as source indicators, thereby elevating the threshold for protection.³⁷⁷ Chinese practice reveals an additional layer of administrative conservatism shaped by high application volumes and regulatory priorities linked to market order.³⁷⁸ Singapore, though comparatively pragmatic and commercially oriented, likewise maintains rigorous evidentiary scrutiny that limits the practical success of NTMs.³⁷⁹

Across all jurisdictions studied, acquired distinctiveness emerges as both a doctrinal safety valve and a significant practical barrier.³⁸⁰ Because most legal systems refrain from specifying quantitative thresholds for proving secondary meaning, evidentiary sufficiency is largely determined through examiner evaluation.³⁸¹ This dynamic grants trademark offices indirect control over the expansion of trademark protection while preserving the appearance of neutral fact-finding.³⁸² Functionality doctrine operates in a similar manner as a cross-cutting constraint grounded in competition policy.³⁸³

Although framed as a doctrinal rule preventing monopolization of useful product features, its interpretation at the examination stage often reflects broader policy concerns about preserving

³⁷⁴ McKenna, 'The Normative Foundations of Trademark Law' (n 24); Beebe, '*The Semiotic Analysis of Trademark Law*' (n 2).

³⁷⁵ Tessensohn, 'Expanding the realm of the senses' (n 13); Sun, 'Protecting Non-Traditional Trademarks in China' (n 222) 185–200.

³⁷⁶ Qian, 'The Registration of Non-Traditional Trademarks in China' (n 15) 34–61; Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

³⁷⁷ Tessensohn, 'Expanding the realm of the senses' (n 13); Liu, *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (n 19).

³⁷⁸ Sun, 'Protecting Non-Traditional Trademarks in China' (n 222); Friedmann, 'Trade Marks and Related Rights' (n 302).

³⁷⁹ LWL Ng (n 256); Tan (n 13).

³⁸⁰ Gangjee (n 4); Porangaba (n 140).

³⁸¹ Beebe and Fromer (n 38); McKenna, 'Teaching Trademark Theory' (n 163) 845–855.

³⁸² Lemley, 'The Modern Lanham Act' (n 89); Dinwoodie, 'The Architecture of the International Intellectual Property System' (n 16).

³⁸³ McKenna, '(Dys)Functionality' (n 77) 824–828; McKenna, 'Testing Modern Trademark Law's' (n 104) 94–100; Lemley, 'The Modern Lanham Act' (n 89) 1717–1721.

design freedom.³⁸⁴ The cumulative effect of these doctrinal and evidentiary filters is that substantive examination remains office-specific despite formal harmonization efforts.³⁸⁵

International agreements and academic projects promoting convergence have undoubtedly influenced legislative drafting.³⁸⁶ Yet they have not eliminated the discretion inherent in administrative implementation, nor have they standardized evidentiary cultures.³⁸⁷ As comparative scholarship has repeatedly emphasised, harmonization of textual standards does not automatically produce convergence in institutional practice.³⁸⁸ NTMs provide a particularly revealing lens for observing this phenomenon because they sit at the margins of traditional trademark theory.³⁸⁹ Where legal categories are open-ended and policy considerations are prominent, administrative actors inevitably gain interpretive influence.³⁹⁰

This thesis therefore confirms that the examination stage functions as a site of regulatory governance rather than mere technical application of law.³⁹¹ The fragmentation observed across the EU, the US, and Asia undermines legal certainty for applicants seeking multi-jurisdictional protection.³⁹² Multinational enterprises must tailor evidentiary strategies to each office, while smaller firms may face disproportionate costs in attempting to secure protection for innovative branding elements.³⁹³ The promise of predictable global trademark protection is thus only partially realized in practice.³⁹⁴ At the same time, the persistence of divergence should not be understood solely as a failure of harmonization.³⁹⁵

Trademark law remains deeply embedded in local economic structures, administrative traditions, and conceptions of competition policy.³⁹⁶ Differences in examination practice

³⁸⁴ Morris (n 67); Dreyfuss (n 91); Merges, (n 128) 288–294.

³⁸⁵ Gangjee (n 4); Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37).

³⁸⁶ Gervais (n 33) 257–260; Frankel, ‘The Challenge of Global Convergence’ (n 223) 54–60.

³⁸⁷ Dinwoodie, ‘The Architecture of the International Intellectual Property System’ (n 16); Frakes and Wasserman (n 14) 1807–1853; Antons, ‘Legal Culture and History of Law in Asia’ (n 273).

³⁸⁸ Frankel, ‘The Challenge of Global Convergence’ (n 223) 54–60; Dinwoodie and Janis, ‘The drivers of trademark law reform’ (n 31) 1, 4–5.

³⁸⁹ Gangjee (n 4); Senftleben, ‘The Trademark Tower of Babel’ (n 68).

³⁹⁰ Merges, (n 128); Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2).

³⁹¹ Frakes and Wasserman (n 14) 1807–1853; Dinwoodie, ‘The Architecture of the International Intellectual Property System’ (n 16).

³⁹² Beebe and Fromer, ‘Are We Running Out of Trademarks?’ (n 38); Gangjee (n 4).

³⁹³ Adams and Scardamaglia (n 7); Porangaba (n 140).

³⁹⁴ Dinwoodie and Janis, *Trademarks and Unfair Competition* (n 2) ch 7; Frankel, ‘The Challenge of Global Convergence’ (n 223) 62–67.

³⁹⁵ Cane and Conaghan (n 3); Nakagawa, (n 362) 137–168.

³⁹⁶ Antons, ‘Legal Culture and History of Law in Asia’ (n 273); Baldwin, Cave and Lodge, (n 321) 86–94; Frakes and Wasserman (n 14) 1807–1853.

therefore reflect legitimate institutional choices as well as structural constraints.³⁹⁷ The challenge for future reform lies not in eliminating all divergence, but in increasing transparency and accountability in evidentiary assessment and policy reasoning.³⁹⁸ Greater comparative dialogue among trademark offices could reduce unnecessary inconsistencies while preserving room for context-sensitive judgment.³⁹⁹

Ultimately, this thesis demonstrates that harmonization at the level of formal recognition does not guarantee convergence in substantive outcomes.⁴⁰⁰ The examination of NTMs across major jurisdictions reveals the structural limits of international coordination in trademark law and confirms the central hypothesis advanced at the outset: substantive examination remains fragmented and shaped by office-specific priorities, with significant consequences for legal certainty and market actors.⁴⁰¹

³⁹⁷ Tushnet, 'Reforming trademark registration' (n 20) 77, 82–85, 9–11; Frankel, 'The Challenge of Global Convergence' (n 223) 62–67.

³⁹⁸ Assaf-Zakharov (n 8); Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37); McKenna, 'The Normative Foundations of Trademark Law' (n 24) 1890–1894.

³⁹⁹ Calboli and Senftleben (eds), *The Protection of Non-Traditional Trademarks* (n 95) 341–350; Dinwoodie, 'The International Intellectual Property System' (n 19) 61.

⁴⁰⁰ Dinwoodie and Janis, *Trademark Law and Theory* (n 3); Gangjee (n 4) 59–88; Heath and Sanders (n 16).

⁴⁰¹ Calboli and Ginsburg (eds), *The Cambridge Handbook* (n 37) 684–690; Gangjee (n 4).

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