



The Trademark Prosecution Review

2024

**Specialist Chapter: How to Develop
an Effective Regional Prosecution
Strategy**

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The first edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

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Specialist Chapter: How to Develop an Effective Regional Prosecution Strategy

Malavika T Vikram, Paramita Nandy Gupta, Nitin Abhishek and Sonu Shaji
De Penning & De Penning

Summary

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IN SUMMARY

This article provides guidelines for developing an effective regional trademark prosecution strategy for the Asia-Pacific region. It sheds light on a few common challenges faced in maintaining a multi-jurisdictional trademark portfolio and provides solutions to avoid them.

DISCUSSION POINTS

- Prerequisites to trademark filing – due diligence
 - National phase applications versus filing through the Madrid Protocol
 - Trademark registration procedure in APAC countries
 - Cost of filing trademark application
 - Periodic audits of trademark portfolio
 - Trademark watch
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REFERENCED IN THIS ARTICLE

- WIPO Global Brand Database
- Indian Trade Marks Act 1999
- Trade Mark Law 2019 of Myanmar

INTRODUCTION

Jeff Bezos once said: "Your brand is what people say about you when you are not in the room."^[1]

This famous quote speaks volumes on the importance of a trademark. The journey from trademark registration to being viewed as a 'brand' is indeed an arduous task that requires thorough planning and strategy in successfully registering the trademark across different jurisdictions. In this article, the focus is on this process in the Asia-Pacific (APAC) region.

PREREQUISITES TO TRADEMARK FILING – DUE DILIGENCE

Trademark Search In The Relevant Classes

It is imperative to conduct due diligence prior to initiating and adopting a trademark. The first step is to conduct thorough trademark searches in the relevant jurisdictions, and there are approximately 40 countries in the APAC region.

A brief search can be conducted on the [WIPO Global Brand Database](#) to ascertain if there are any identical and similar trademarks existing in any jurisdiction in the APAC region. This search is subject to the available digital records and linkage of each jurisdiction to the WIPO Global Brand Database.

Further, prior to initiating trademark searches across multiple jurisdictions, it is essential to identify the key jurisdictions critical to the business model and create a road map by liaising internally with the marketing and sales team.

Translation And Transliteration Of The Trademark In APAC Countries

It is vital to understand the translation and transliteration of the trademark (word mark or composite label marks) in each country as per its colloquial language, to ensure that the word aspect of the proposed trademark does not have a scandalous or derogatory meaning. In a majority of jurisdictions, a word with scandalous or derogatory meaning in the local language is prohibited from registration.

As a corollary, in India, the Trade Marks Act 1999^[2] puts an embargo under absolute grounds for refusal of registration if a trademark “comprises or contains scandalous or obscene matter”.

Instances of some of the trademarks that had to be amended in some countries are as follows.

In view of the foregoing, it is imperative to understand whether a trademark is derogatory, scandalous or has any negative connotation in a particular jurisdiction prior to globalising the trademark. This strategy will by and large prevent formal objections on this ground and circumvent delays in the global launch of products and services.

Trademark Search Reports And Opinion

Based on the aforesaid parameters, it is advisable to conduct detailed trademark searches in various databases and seek opinions on the test of distinctiveness, descriptiveness and negative connotations (if any) attributable to the trademark. This activity should be comprehensively undertaken prior to adoption and use of the trademark in each jurisdiction.

This rationale for detailed trademark search reports and opinions is to help businesses make informed decisions and ensure smooth prosecution of their trademarks across jurisdictions, allowing them to embark upon globalising their brands.

NATIONAL PHASE APPLICATIONS VERSUS FILING THROUGH MADRID PROTOCOL

In all APAC countries, trademark protection can be obtained through registration, by filing an application for registration with the national or regional trademark office and paying the required fees.

The Madrid System has several apparent advantages, namely, facilitating filing a single application in one language to protect the mark in multiple countries, payment of single set of fees and enabling efficient management of the trademark portfolio through a centralised system. However, the Madrid System is not recommended in countries with a unique system of sub-classification. For example, in China, South Korea and Japan, each class of goods and services is further divided into subclasses, with a list of standard items of goods and services and separate group codes. Provisional refusals are issued based on examination of similar group codes; therefore, proprietors of trademarks should refer to the group code system in these jurisdictions^[6] and opt for national filing to protect the trademark.

Of all the APAC countries, Taiwan, Myanmar and the Pacific Island nations (Fiji, Kiribati, Papua New Guinea, Samoa, Solomon Islands, Tonga, Tuvalu, and Vanuatu) are not signatories to the Madrid Protocol. Samoa^[7] is the only Pacific Island nation that is signatory to the Madrid Protocol.

Hence, the decision to apply for a trademark registration through a national application or through the Madrid System will depend on the jurisdictions involved. It is advisable to do

preliminary research before filing a blanket international registration application for all APAC countries.

TRADEMARK REGISTRATION PROCEDURE IN APAC COUNTRIES

Trademarks can be registered in approximately 18–24 months in northern Asian countries, such as China, Japan, South Korea and Taiwan, and in Association of Southeast Asian Nations countries, including Singapore, Malaysia, Thailand, the Philippines, Vietnam, Indonesia, Cambodia, Laos, Brunei and Myanmar, as well as in India and Sri Lanka. However, it takes longer to obtain registration in, for example, Afghanistan, Bangladesh, Bhutan, Kiribati, Nepal, Solomon Islands, Timor-Leste, Tuvalu and Yemen. This is mainly due to the lack of digitisation in the administrative mechanism in the respective trademark offices.

The filing requirements and procedures vary in several jurisdictions, and for a better understanding we list the procedural differences between Indonesia, Myanmar, Nepal, the Philippines and Vietnam below.

Country	Procedures
Indonesia	Under the new trademark law in Indonesia, enacted in 2016, after the filing stage, all trademark applications are first published. Once the application is published, within a period of three months, any third party may oppose the trademark application. At the end of three months, the application enters the substantive examination stage. Thereafter, it may proceed to be registered. ^[8]
Myanmar	Myanmar did not have any trademark statute or procedure for registration until 2019. Prior to 2019, all trademarks were registered without going through the process of examination, publication and opposition. The Trade Mark Law (2019) came into force on 1 April 2023. The Ministry of Commerce had announced a “soft opening period” for the partial implementation of the new law starting from 1 October 2020. During this period, the Ministry has been accepting applications for re-registration of trademarks that had been previously registered via declarations of ownership filed with the Office of Registration of Deeds, and assigned the application numbers for each re-registration application. ^[9] In the grand opening, the applications filed to date

	<p>during the soft opening will be allotted a filing date.</p>
Nepal	<p>The applicant is required to submit an application for trademark registration. Thereafter, the application is examined.</p> <p>After examination, if it is found registrable, the Department of Industries (the Department) shall register the trademark in the name of applicant and issue a certificate. The department then publishes the registered trademark. A statement with respect to the renewal or cancellation of registration is also published for the benefit of the general public. Any person may oppose a trademark against the statement published by the department within 35 days of such publication.</p> <p>To register trademarks owned by foreign entities, it is mandatory for the applicant to provide a certified or notarised copy of a valid trademark registration certificate from its home country or some other jurisdiction. This certificate from a foreign jurisdiction should be for the same mark, in the same class, and it should be in the name of the same applicant.</p>
Philippines	<p>Once a trademark is registered in Philippines, proof of use should be submitted within three years of the filing date of application. Proof of use need not be filed before the registration.^[10] The registration will be cancelled if proof of use is not filed within the stipulated time.</p> <p>A registrant is required to prove continuous use of the mark by filing cogent evidence between the fifth and sixth year anniversary of the registration date.</p>
Vietnam	<p>In Vietnam, trademark registrations are subject to the first-to-file principle. Therefore, trademarks can only be protected exclusively through registration, except for well-known trademarks.</p>

From the date on which the trademark application is received by the National Office of Intellectual Property of Vietnam (IPVN), the same shall be examined in the following order:

- a trademark registration application shall have its formality examination done within one month of the filing date; and
- a trademark application shall be published within two months of it passing the formality check. The application is open for opposition and comment from third parties.

Trademark applications in Vietnam undergo a subsequent examination to determine their eligibility for registration on substantive grounds. The outcome of this examination is typically available within nine to 12 months of the date of the decision to accept the trademark application. To explain further, once the substantive examination is completed, if a trademark application satisfies the necessary criteria, the IPVN will issue a decision expressing the intention to grant a certificate of trademark registration. At this point, the applicant will be required to pay the fees for the granting and publication of the registration.

If the application has been opposed, the substantive examination report is issued at the same time irrespective of a pending opposition. A substantive examination is carried out by examiners of the IPVN within six months of the date of publication. Therefore, there may be a situation where the applicant is required to contest the opposition and also respond to the substantive examination report, simultaneously.

Previously, Vietnam's trademark law stated that a mark that had been expired for less than five years could still be cited as a citation to refuse protection for a similar or

identical trademark with a later filing date. However, a recent amendment stated that expired marks cannot be the reason for refusing present trademark registrations.-
[11]

While the procedure or steps for registration remain more or less the same in most countries, the broad steps are mentioned below.

Filing And Formality Check

A trademark application is first evaluated on a preliminary level, wherein the examiner checks for compliance with the basic formality requirements, such as payment of the applicable fee, submission of documents in the prescribed format, adequate stamping requirements wherever applicable, proper classification of the goods and services under the applicable trademark classes and appropriate goods or service description, etc.

Examination Of Application

The mark is then evaluated on merit on two grounds, broadly classified as the absolute and relative grounds of refusal. If an objection is raised, the applicant will be given a certain period of time to respond with an argument or alternative proposal. The statutory time to respond to the refusal letter varies from one country to another – usually 30 to 90 days' time is given for responding, and extensions may be available.

Absolute Grounds Of Refusal

Absolute grounds of refusal are often the first threshold that a mark passes through in its journey towards registration. These grounds test a mark on the fundamental requirements stipulated under the applicable laws. The absolute grounds of refusal are largely similar in most jurisdictions and cover the tests of whether the mark is:

- distinctive;
- descriptive of the goods and services for which it is applied;
- customary in the language or trade;
- likely to deceive the public or cause confusion;
- composed of scandalous or obscene matter or is it likely to hurt the religious sentiments of any class;
- composed of prohibited emblems or names, etc.

The absolute grounds of refusal are designed to maintain the sanctity of the trademark system by ensuring that marks adhere to the basic requirements stipulated under governing legislation.

Distinctiveness And Non-descriptiveness Of A Mark

As the trademark is a crucial instrument of connection between a business and its customers, the primary test of a strong mark is its ability to individualise the goods or services of the owner of the trademark from those of others. There is no exhaustive method to evaluate distinctiveness of a mark, and different categories of marks may attract different standards or levels of distinctiveness. For example, establishing the distinctiveness of a

composite mark comprising phonetic and figurative elements may be easier than that of a colour mark or a two letter mark. Based on the distinctiveness level, trademarks are broadly classified into the following categories, ranging from the strongest to weakest.

- **Coined marks:** these are the marks that were originally created or invented, do not have any dictionary meaning in the relevant language and were never used until the applicant coined it as its trademark. Although a coined mark may suffer initial setbacks (eg, additional investment towards its creation, higher marketing investment, a longer time in building market recognition, and confusion or uncertainty on the consumers' part in pronunciation of a coined, unfamiliar term), adopting a coined mark paves the way in building a brand's independent recognition and reputation, especially in the long term.
- **Arbitrary marks:** an arbitrary mark is one that consists of existing word(s) unrelated to the goods and services offered under the trademark. Arbitrary marks come with the advantage of easier recollection value.
- **Suggestive marks:** a suggestive mark is one that suggests the kind, quality, quantity, nature, purpose or other characteristic of the goods and service without bearing any direct or immediate reference to the goods and services in question.
- **Descriptive marks:** a descriptive mark is one that clearly describes the kind, quantity, quality, intended purpose or any other characteristic of the goods or service. Given the ability of descriptive marks to impart immediate information about the goods and services, it might be highly alluring to adopt these marks; however, these marks lack individuality and would not be able to function as source indicators.
- **Generic marks:** at the lowest rung of the distinctiveness spectrum are generic marks, which are commonly accepted terms or indications used in the particular trade to connote the goods and services in question. These marks are the weakest and are not granted registration.

Thus, adopting a coined or arbitrary mark is clearly advantageous from the perspective of building a multi-jurisdictional brand portfolio, as the chances of such a mark facing objection is much lower compared to the other categories of marks. The acceptance of a mark as being distinctive and non-descriptive, in one or more jurisdictions, may have persuasive value in other jurisdictions where the mark faces objections under similar grounds of refusal, and the applicant may strategise the order of filing in different jurisdictions accordingly.

Relative Grounds Of Refusal

Relative grounds of refusal evaluate a mark with respect to the prior rights of other third-party marks, to eliminate a likelihood of confusion among the public. Below are few effective strategies and other relevant factors concerning the relative grounds of refusal.

- **Analysis of various factors:** an objection based on relative grounds can be overcome based on a comprehensive analysis of factors such as: the degree of identity or similarity between the marks; the nature of the goods or services; the extent to which the rival goods or services are similar or identical to one another; the commonality of trade channels, the end point of sales, target consumers, the mode of purchase and the price of goods or services; and the nature of consumers, their level of sophistication, the extent of their fastidiousness and the deliberation exerted behind a purchase.

- Rules of comparison of marks: in overcoming the objections based on relative grounds, the two most commonly invoked rules are the rule of anti-dissection of trademarks and the rule of identifying the dominant feature of marks. While the rule of anti-dissection of marks requires the marks to be compared in their entirety without being split into individual components, the second rule of determining the dominant feature allows the rival marks to be broken down into parts to identify the dominant element based on which a consumer recalls these marks. Both the rules are based on the reasoning that an average, reasonably prudent buyer is not expected to remember every detail in a mark, but rather the mental impression that a mark creates in its totality.
- Consistency in legal positions: while building a multi-jurisdictional brand portfolio, it is essential to maintain consistency in the legal grounds and submissions relied upon across jurisdictions. In today's highly competitive environment businesses are keen on expanding their brand's footprint across multiple jurisdictions, and it is not uncommon for a mark to face a conflict or challenge from a common entity's prior registered or pending application in more than one jurisdiction. In these situations, it is important that the applicant focuses on building their strategies of attack and defence from a holistic perspective, taking into account the multiple jurisdictions of interest, rather than focusing on the hurdles faced in each jurisdiction from an isolated standpoint. Lack of foresightedness and understanding has often caused applicants to unwittingly take contradictory legal positions in different proceedings or countries that later may prove fatal to the applications in the long run. In addition to defending the trademark, an applicant can also explore the possibilities of peaceful worldwide coexistence with conflicting trademarks.
- Goods and service description (differences in): another aspect that proves to be crucial in overcoming hurdles based on relative grounds is clarity in the specification of goods and services. Often, the conflicting marks cited by the examiner may relate to entirely different categories of goods and services despite falling under the same trademark class. It is well accepted that the trademark classification is merely a tool for administrative convenience and cannot be solely relied on to determine substantive issues in the registration process. Conflicting goods cannot be held similar merely for the reason that they fall under the same class. For example, Class 03 of the NICE system of classification covers cosmetic preparations as well as substances for laundry use. The proprietor of a trademark cannot enjoy monopoly over the mark for the entire class of goods, when the mark is used only for some goods falling under the class.

Publication And Oppositions

A third party wishing to oppose the registration of a trademark should file their grounds of opposition within the opposition period. The opposition period in APAC countries usually ranges from one month to four months from the date of publication. For example, it is 30 days in the Philippines, two months in Singapore and Malaysia, three months in Brunei and four months in India.

Opposition Procedure

If the mark is opposed by a third party, a separate opposition procedure is often followed, which varies in every jurisdiction. Evidence is placed on record and hearings are held to

determine the fate of registration of the mark. The time required to obtain an outcome of the opposition proceeding differs from one country to another and depends on various factors, such as agency backlog, the level of digitisation and the functioning of the judiciary in the concerned jurisdiction.

Registration Of The Trademark

Once the trademark is published, and no opposition is filed, it proceeds to registration. A trademark registration usually lasts for 10 years and is renewable for successive 10-year periods.

COST OF FILING TRADEMARK APPLICATION

The cost of registering trademarks varies from country to country. For example, in Thailand, the designated fees for filing an application are based on the number of goods or services. They allow only five goods or services in a class. If the designated goods or services in any class are more than five, the official fees are payable at flat rates instead of per item basis.

In Singapore, there is a cost difference of approximately US\$100–150 based on whether the applicant chooses to file the trademark application manually or online. Further, the cost of filing is lower if the applicant chooses the goods or service description from the pre-approved database of the Intellectual Property Office of Singapore; if the description of the goods or service is not from the pre-approved list, additional charges are payable.

In Indonesia, the fees for applying for a trademark are dependent upon the category of the applicant; if the applicant is a micro or small business, then the charges per class for registering a trademark are lower than the charges applicable to a public limited company.

In countries such as Pakistan and Afghanistan, there is one-time fee chargeable at the time of filing the application, until the application faces opposition. In these countries, the applicant does not have the option to file multi-class applications.^[12]

In some jurisdictions such as China, owing to the further subdivision of NICE classification, the number of classes in which a trademark is to be protected increases, which increases the overall cost. There are more than 700 classifications of goods and services that have been approved by the Chinese government. This classification system has been the result of years of feedback from trademark owners and industry experts. The system is designed to help trademark applicants select a classification for their application as well as to provide a basis for the examiner's search for prior applications.^[13]

PERIODIC AUDITS OF TRADEMARK PORTFOLIO

A robust trademark portfolio requires that the trademark applications, both pending and registered, in multiple jurisdictions be kept updated at all times from a factual and legal standpoint. Periodic audits, at least on an annual basis, bring to the fore any gaps or lacunae in the brand protection that may otherwise go unnoticed. A comprehensive audit not only covers the aspects relating to maintaining the applications but also the actual use of the mark in commerce. Further, a brand audit ensures that any change (eg, recording an ownership change, a new licensing or changes to the specification of goods and services) pertaining to a trademark is recorded in all the jurisdictions where the trademark application is pending registration or has been registered. These audits also provide the applicant the opportunity to review their IP policies, apprise themselves of any relevant changes or

procedural requirements in the legal system and keep up with the changes in view of the emerging situations or market trends of each jurisdiction.

TRADEMARK WATCH

An effective trademark strategy would be incomplete without a trademark watch service, wherein the applicant engages the services of professional IP practitioners in the jurisdictions of business interest to periodically assess the latest trademarks published. These watch services help to identify any potentially conflicting third-party mark. As time is of the essence in all intellectual property matters, timely identification and curbing of third-party conflicting marks lays the foundation of a strong trademark portfolio.

PROTECTION IN THE METAVERSE

Businesses today are increasingly keen on securing and protecting their trademarks in the metaverse. As the APAC region covers some of the most populous nations and considering the increasing growth rate of the millennial population in this region, it is expected that the IP landscape in the APAC region will be greatly influenced by the metaverse in the coming years. Business owners should secure their trademarks not just in the real world, but also in the metaverse to prevent misuse of their rights from pre-emptive or mala fide filings.

CONCLUSION

In putting together an effective multi-jurisdictional brand portfolio, the IP owner needs to factor in multiple important aspects such as: overall and stage-wise budgets, key jurisdictions of interest, timelines for launch of the mark, filing of trademark applications, market investments and future business developments.

Endnotes



Malavika T Vikram
Paramita Nandy Gupta
Nitin Abhishek
Sonu Shaji

malavika.tv@depenning.com
paramita.nandy@depenning.com
nitin.abhishek@depenning.com
sonu.shaji@depenning.com

120 Velachery Main Road, Guindy, Chennai 600 032, Tamil Nadu, India

Tel: +91 44 4221 3444

<https://www.depenning.com>

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