HARMONIZATION OF TRADEMARK LAW IN ASEAN: CHALLENGES AND PROGRESS

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Abstract

Legal harmonization is essential as the need to exchange goods, trade, and services between and among countries becomes more liberized. Aiming towards a common legal framework with shared characteristics to minimize disparities in regional legal fields, the Association of Southeast Asian Nations (ASEAN) is determined to build a legal structure capable of regulating key issues affecting that common goal. Cooperation related to intellectual property (IP) issues has seen steady growth, influencing the development of each nation's IP systems and the region's overall socioeconomic progress. In the field of trademarks, businesses have faced difficulties with procedures and related policies due to the differences in trademark regulations between countries, particularly in the protection of non-traditional trademarks, since the protection regimes of different countries vary. Therefore, research on the issue and the suggestion of viable solutions are necessary. Based on ASEAN's common spirit of eliminating differences in national laws, this article aims to identify challenges and propose recommendations for harmonizing trademark law in ASEAN.

Keywords: *legal harmonization, legal reform, trademark, non-traditional trademark, intellectual property law, ASEAN*

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The Association of Southeast Asian Nations (ASEAN) was established with the participation of 10 member countries. The organization aims to promote economic and social activities and cooperation in various fields. The establishment of the ASEAN Economic Community (AEC) marked a significant step towards a comprehensive regional integration of Southeast Asian economies.[1]

Intellectual property (IP) plays a crucial role in achieving the goals for the AEC's development in the ASEAN Intellectual Property Rights Action Plan 2016-2025, which identifies trademarks as a noteworthy element with specific actions outlined. Furthermore, the ASEAN Framework Agreement on Intellectual Property Cooperation, signed by nine ASEAN members, regulates the trademark system. This agreement reflects member States' commitment to establishing a trademark legal framework applicable both regionally and internationally. As WTO members, ASEAN States must follow the Agreement on Trade-Related Aspects of Intellectual Property

1 Hoa, T. T. Q. & Nguyen, T. H. T. (2016, February 19). *Cộng đồng kinh tế ASEAN: Mức độ hội nhập so với Liên minh châu Âu và những vấn đề còn tồn tại.* Cổng thông tin điện tử Bộ Tài chính [trans: *ASEAN Economic Community: Level of integration compared to the European Union and remaining issues.* Ministry of Finance Electronic Information Portal]. https://mof.gov.vn/webcenter/portal/vclvcstc/pages_r/l/chi-tiet-tin?dDocName=MOF151605

Rights (TRIPS) standards, which set minimum IP rules while allowing national flexibility.

Trademarks play a key role in commerce by helping consumers identify and differentiate goods and services.[2] Recognizing the significance of trademark rights in IP law, in addition to strategic planning and development initiatives, several ASEAN member States have acceded to the Madrid Protocol to safeguard the trademark rights operating across different territories. The key benefits of Madrid Protocol accession primarily concern trademark protection and increased public cost recovery.[3] Initial actions have facilitated the development of a regional trademark legal framework, demonstrating a commitment to common development goals. However, the ASEAN lacks a common framework for regulations, necessitating reliance on individual national regulations. Although the Madrid Protocol offers a widely used trademark system, not all ASEAN members participate.[4] As each ASEAN member has its own legal framework for trademarks, there are certain differences in the determination of which trademarks can be recognized for protection. The lack of uniformity in determining a clear standard for trademarks stems from many causes, but all lead to issues related to the lack of clarity in the law and legal guarantees.

In the current integration process and on the path to realizing the economic development goals of the ASEAN community, the lack of a complete legal framework sufficient to serve as a basis for development will be an obstacle to trade and investment. As such, a unified standard to determine which trademarks can be registered in the ASEAN region is necessary to achieve common development goals. This article aims to identify several factors that hinder the harmonization of labeling laws in ASEAN through an analysis of the current legal frameworks of ASEAN countries, thus proposing potential solutions to achieve the goal of harmonizing regional IP laws in general and trademark laws in particular.

1. Understanding trademark law and its harmonization in ASEAN

1.1. Trademark in international intellectual property law

Article 15 of TRIPS provides several forms, including personal names, letters, numerals, figurative elements, and combinations of colors, as well as any combination of such signs, that are considered for trademark protection. TRIPS explains this provision does not automatically eliminate other forms of trademarks if these forms still comply with the 1967 Paris Convention.

2 ZICO. (2016, July). *ASEAN Insiders*. ZICO. https://zico.group/wp-content/uploads/resources/asean_insiders/ASEAN_Insiders-IP-Trademarks.pdf

3 The ASEAN-Australia-New Zealand Free Trade Area [AANZFTA]. (2018). *The Madrid Protocol: A single trademark registration supports regional economic integration*, pp. 2-4. https://aanzfta.asean.org/uploads/2016/05/Case-Study-Report_Madrid-Protocol-Accession-and-Implementation-final-16Aug2018.pdf

4 Myanmar is the only ASEAN member State that has not yet become member of the Madrid Protocol.

However, the Paris Convention does not define the concept of trademark.[5] Article 15.1 of TRIPS can be seen as a crucial provision defining trademarks and a suggestion for countries to regulate their IP law.

The World Intellectual Property Organization (WIPO) adopts a different approach since it defines trademarks as a unique identifier for brands, products, or services. It can be a word, a design, or a combination of things such as colors and shapes. These trademarks can be registered for legal protection and come in all sorts of forms, from letters, numbers, pictures, to 3D designs.[6] According to the Paris Convention, trademarks belong to the objects of the protection of industrial property, along with patents, utility models, industrial designs, service marks, trade names, indications of source, and appellations of origin.[7] In addition to "trademark", some other terms can be used interchangeably in certain situations, such as "mark", "brand", or "logo". Although these terms can be used interchangeably with "trademark", they have subtle differences.[8]

Beyond the definition from WIPO, trademarks are not limited to the forms defined by WIPO but also include scents, sounds, or other elements that can help distinguish between products, services, or brands. Under ASEAN guidelines, only perceptible signs that can distinguish between products or services qualify as trademarks. This recognition shall be made through human senses, including sight, hearing, smell, touch, and taste.[9] In this document, "trademarks" are divided into two groups: visually and non-visually perceptible signs. Visually perceptible signs are primarily signs that can be seen by the sense of sight. This group accounts for the majority of registered trademarks and is divided into five subgroups, including:

(i) Two-dimensional signs (2D signs) are perceptible signs applied to or displayed on product surfaces, packaging, or other materials related to goods or services available on markets, which can be seen or read easily by words, letters, digits, numerals, ideograms, slogans, figurative signs, or mixed from those elements signs;[10]

(ii) A color would need to be defined by a specific shape or have clear outlines. Combinations of two or more colors require a defined shape or

5 Zhan, Q. (2016). The international registration of non-traditional trademarks: Compliance with the TRIPS Agreement and the Paris Convention. *World Trade Review*, *16*(1), 111-140. https://doi.org/10.1017/S1474745616000392

6 Full text: "A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights."

7 Article 1.2 of the Paris Convention: "The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition."

8 Aadmrk Intellectual Property. (2019, April 13). *Dubai trademark register Dubai trademark office*. Aadmrk. https://aadmrkip.com/listed-in-yellow-page/

9 ASEAN Secretariat. (2020). *Common guidelines for the substantive examination of trademarks* (2nd ed.). The Association of Southeast Asian Nations, p. 13. https://asean.org/wp-content/uploads/2021/08/ASEAN-Common-Guidelines-for-the-Substantive-Examination-of-Trademarks-Second-Edition-2020.pdf

10 *Ibid*, pp. 14-15.

outline, or a consistent and predetermined arrangement. For example, a specific combination of silver, copper, and black applied in defined positions and proportions on electrochemical cells or batteries was recognized as a valid trademark;[11]

(iii) Three-dimensional signs (3D signs) include three groups: shapes of devices adjoined to the product; shapes of containers, wrapping, packaging,…[12] and shapes embodied in the product or a part thereof. However, not all of the shapes embodied can be recognized as trademarks, like KitKat, resulting in the brand losing its trademark;[13]

(iv) Movement (motion) signs and holograms, like a short video clip or film, can be used to set apart goods or services. This is often seen in visual advertising and public communication. For instance, a video of Nokia with a specific description provided in the ASEAN Guidelines or a short introductory video featuring the roaring lion of MGM can also be trademarked;

(v) Position marks are primarily known as unique locations associated with a particular brand, not the design element itself. However, positions play the crucial function of the products, which can lead to interfering with the trade market and industry, and cannot be trademarked.[14] For example, the three stripes of Adidas or checkerboard patterns on Vans sneakers were trademarked.[15]

Unlike visually perceptible signs, non-visually perceptible signs must be represented by using a generally available format or technology and may be supplemented by verbal descriptions to be trademarked. Non-visually perceptible signs are divided into the following groups based on the sense they appeal to:

(i) Signs perceptible by the sense of hearing must be accurately represented in musical notation or graphics. For example, the jingle of McDonald's was trademarked for musical sound;

(ii) Signs perceptible by the sense of smell lack specific regulations for recognizing trademarks, for these signs pose significant challenges and obstacles. In ASEAN, these signs would primarily not be accepted.[16] However, there are some examples of successful scent trademarks, including

11 Article 9.3.6 of the Trademark Guidelines: "A colour mark is a trademark that consists exclusively of a single colour without contour or a combination of colours without contours. What is protected is the shade of colour(s) and, in the case of more than one colour, the systematic arrangement of the colours in a predetermined and uniform way."

12 ASEAN Secretariat. (2020*), supra* note 9, pp. 25-29.

13 Marchi, S. (2020, December 15). *Chocolate wars: To trademark or not to trademark?*. HFG Law & Intellectual Property. https://www.hfgip.com/news/chocolate-wars-trademark-or-not-trademark

14 ASEAN Secretariat. (2020*), supra* note 9, p. 34.

15 ASEAN-Australia-New Zealand Free Trade Area (AANZFTA) Economic Cooperation Support Program (AECSP) (16 Aug 2018). *The Madrid Protocol: A single trademark registration supports regional economic integration — A Case Study: The Madrid Protocol: Protecting brands globally,* AANZFTA. https://aanzfta.asean.org/.../Case-Study-Report_Madrid-Protocol-Accession-and-Implementation-final-16Aug2018.pdf

16 IPHUB Asia. (n.d.). *What can be registered as a trademark?*. IPHUB Asia. https://iphub.asia/non-traditional-trademarks-that-can-be-registered-in-singapore-and-southeast-asia/

Grendene's "scent of bubble gum" or Le Vian Corp's "scent of chocolate";[17]

(iii) Similar to scent trademarks, signs perceptible by the sense of taste cannot be depicted through ASEAN Common Guidelines for the Substantive Examination of Trademarks.[18] Consequently, the document concludes that taste trademarks are not possible;

(iv) Signs perceptible by the sense of touch can distinguish products and services, especially for visually impaired people. These marks can be graphically represented if they are physical features of the product, packaging, or service-related objects. In such cases, 3D trademark rules apply.

1.2. Non-traditional trademarks and regulations in Southeast Asia

Recent developments have introduced various other forms of trademarks, including taste, touch, sound, movement, or position marks.[19] Based on the two categories discussed above, non-traditional trademarks are more likely to fall under non-visually perceptible signs rather than visually perceptible signs with representation. Within ASEAN, several countries have acknowledged non-traditional trademarks to varying degrees.[20]

In Singapore, the 1998 Trademarks Act (1998 TMA) applies to both traditional and non-traditional trademarks and establishes the requirements and processes for registering trademarks beyond traditional trademarks. Article 7 of the 1998 TMA does not preclude trademark registration applications if the mark meets the conditions referred to in Article 2.1 and other requirements. The 1998 TMA provides a list of signs that include: letters, words, names, signatures, numerals, devices, brands, headings, labels, tickets, shapes, colors, aspects of packaging, or any combination thereof. Besides, a trademark is defined as any sign capable of being represented graphically and distinguishing goods or services. This definition indicates that the scope of identifying trademarks under the 1998 TMA is very broad. In general, Singapore's regulations appear to emphasize the distinctiveness of trademarks. The additional requirements outlined in this provision also reflect a focus on trademark distinctiveness. Furthermore, unregistered trademarks in Singapore can still be protected through the common law action of "passing off" if the trademark owner can demonstrate their reputation and goodwill.[21] This is considered to be quite risky and challenging. However, it can also be seen as a provision that provides protection for unregistered or non-trademarked signs, as long as the owner can provide evidence in accordance with the legal requirements.

17 Samuels, J. R. (2018, May 29). *An unforgettable smell*. Harness, Dickey & Pierce, P.L.C. https://www.harnessip.com/blog/2018/05/29/an-unforgettable-smell/

18 ASEAN Secretariat. (2020), *supra* note 9.

19 Carapeto, R. (2016). A reflection about the introduction of non-traditional trademarks. *Waseda Bulletin of Comparative Law*, *34*, 25-60. https://ssrn.com/abstract=3802205

20 European Innovation Council & SMEs Executive Agency (EIC & SMEEA). (2020a). *Guide to trademark protection in South-East Asia*. European Commission. https://data.europa.eu/doi/10.2826/413400

21 *Ibid*; Intellectual Property Office of Singapore (IPOS). (2022). *Trade marks infopack*. IPOS, p.7. https://isomer-user-content.by.gov.sg/61/d19a8611-cf44-4b24-9a45-7f7a2975df9b/trade-marks-infopack.pdf

According to Article 4.1 of the 2011 Brunei Trademark Act, trademarks are defined as visually perceptible signs capable of being represented graphically to distinguish goods and services. This provision indirectly excludes non-visually perceptible signs, which fall into non-traditional trademarks.[22] However, in 2017, the Brunei Darussalam Intellectual Property Office (BruIPO) introduced changes, including to Article 4.1. The word "visually" was removed from Article 4.1, implying that the remaining provisions of Article 4.1 refer to perceptible signs in general, including both visually and non-visually perceptible signs. This can be interpreted as non-traditional marks also being recognized under Brunei's new regulations. Article 4 is closely linked to the recognition of trademarks as defined in Article 6. Meeting the definition under Article 4 can be considered a prerequisite for determining whether signs can be trademarked. Similar to Singapore's regulations, the emphasis is placed on the distinctiveness between goods and services, alongside other provisions. Furthermore, Brunei's regulations on well-known trademarks differ from those in Singapore. Brunei does not have a specific definition for these trademarks and instead refers to the provisions of the Paris Convention or the WIPO.[23]

Article 3.1 of the 2019 Malaysian Trademark Act does not distinguish between visually and non-visually perceptible signs, but only provides general provisions for signs that can be graphically represented and are capable of distinguishing between different goods and services. This Malaysian regulation clearly shows no distinction between trademarks, but the general requirements in Article 3.1 must be met to be considered for trademarking. As mentioned above, Malaysia also requires the clear representation of non-visually perceptible signs, which is considered to be quite difficult.

Prior to the amendment, Thai regulations only referred to forms considered visually perceptible signs, including devices, logos, names, words, phrases, letters, numerals, signatures, combinations of colors, figurative elements, and combinations thereof. Until the amendment, this provision listed sound in the definition of mark. Considering non-traditional marks alone, Thailand has accepted a combination of color marks, figurative and shape marks, and sound. Sound is the first and currently only non-visually perceptible sign form recognized by Thailand,[24] required to comply with strict representation requirements.

Article 2 of the 2016 Indonesian Law on Marks and Geographical Indications shares similarities with the Thai regulations. It recognizes sound as the only form of non-visually perceptible signs that can be trademarked. In

22 EIC & SMEEA (2020a), *supra* note 20.
23 Part II of the Brunei Trademark Act.
24 Paeruang, S. (2020). *Problems of non-traditional trademarks protection under Thai law: A case study of motion and multimedia marks* (Ref. 25636201040034HNB) [Master's thesis, Thammasat University]. Thammasat University Library, pp. 59-61. https://ethesisarchive.library.tu.ac.th/thesis/2020/TU_2020_6201040034_14016_13900.pdf

addition, other forms of non-traditional trademarks are listed, including 3D shapes, colors, holograms, or combinations.

In general, Vietnamese law has permitted the protection of sound trademarks. Specifically, according to the provisions of Article 72 of the 2005 IP Law of Vietnam, a mark is only protected when it meets the conditions prescribed by this law. As stated by the amendments made in 2022, Vietnamese IP law has permitted the protection of sound trademarks when the sound is represented graphically. This regulation indicates that, although it remains narrow and restricted, it fundamentally represents one of Vietnam's initial efforts to adapt to the international treaties it has joined regarding the protection of non-traditional trademarks.. Besides, it can be seen that holograms are still listed in the group protected by Vietnamese IP law. However, this provision does not mention other types, such as motion or position marks, which are still visually perceptible signs. The provisions of Article 72 only list a few traditional marks in the form of visually perceptible signs, while neglecting other important forms.[25]

The remaining countries, including Cambodia, Myanmar, Laos, and the Philippines, do not currently recognize protection for non-traditional trademarks. Cambodia stipulates that only visually perceptible signs are considered for trademark protection. However, Article 2.a of the 2002 Law Concerning Marks, Trade Names and Acts of Unfair Competition of Cambodia provides general provisions on existence and visibility. On this basis, it can be understood that visible non-traditional marks such as colors, holograms, position, or motion marks can be registered under Cambodian law. However, practice shows that non-traditional trademarks are still subject to certain limitations. Accordingly, color marks must consist of at least two colors, and motion marks do not seem to be recognized as they are not distinctive.[26]

Similarly, Article 2.j of the 2019 Myanmar Trademark Law also recognizes colors if they are a combination of two or more colors. However, other forms, such as motion or holograms, are not mentioned in this provision. Myanmar's trademark regulations are also limited to visible marks, and, through enumeration, Myanmar also inadvertently limits and overlooks some visible marks belonging to non-traditional trademarks. According to this provision, only colors can be considered non-traditional trademarks when combined.

Under the 2023 Laotian trademark law, a mark is defined as any

25 ASEAN Secretariat (2020). *ASEAN Common Guidelines for the Substantive Examination of Trademarks* (2nd ed.). Jakarta: ASEAN Secretariat, available at: https://asean.org/wp-content/uploads/2021/08/ASEAN-Common-Guidelines-for-the-Substantive-Examination-of-Trademarks-Second-Edition-2020.pdf; Anh, L. T. N. (2023). Bảo hộ nhãn hiệu âm thanh tại Việt Nam - Vì sao gặp khó? [trans: Sound trademark protection in Vietnam - Why is it difficult?]. *Vietnam Journal of Science, Technology and Engineering*, (6). https://vjol.info.vn/index.php/khcn/article/download/80375/68416/

26 KENFOX. (2023). *Trademark Related Matters in Cambodia*. KENFOX. https://kenfoxlaw.com/our-practice/our-practice-in-cambodia/trademark-related-matters-in-cambodia

sign that can be used to distinguish between goods and services, includes words, personal names, letters, numerals, figurative elements, shapes, three-dimensional pictures, motion pictures, or product packaging, and combinations of colors, as well as any combination of such signs. According to this regulation, Laos currently does not accept non-visually perceptible signs. For visually perceptible signs falling under non-traditional trademarks, Laos currently only accepts 3D, motion, and color combinations. This means that Laos will not accept trademark protection for single colors.

Similar to the aforementioned provisions, the Philippines' 2023 Rules and Regulations on Trademarks, Service Marks, Tradenames, and Marked or Stamped Containers only grant protection to visible signs, excluding non-visual ones. However, Rule 100 on marks does not specify the visually perceptible signs that can be used. This implies that non-traditional trademarks like color, 3D, position, and motion marks can be registered if they meet the distinctiveness requirement defined by the IP code. This is further affirmed by the IP Philippines draft, which acknowledges that these marks are registrable as long as they acquire distinctiveness.[27]

In general, ASEAN countries recognize trademark protection for non-traditional marks. However, the level and scope of recognition vary from country to country. Singapore, Malaysia, and Brunei only provide a basic framework with features that can be flexible to adapt to technological developments. Indonesia, Thailand, and Vietnam, on the other hand, have chosen to gradually expand their regulations by first recognizing sound marks, a non-visually perceptible mark. Countries like Laos, Cambodia, and Myanmar have chosen to list the permitted forms of trademarks and do not make any amendments or additions to other forms. This is not only a limitation for non-visually perceptible signs but also overlooks other visually perceptible signs, essentially failing to keep pace with technological developments without changes in legal regulations. As for the Philippines, while it does not use a list of permitted forms, it limits protection to visually perceptible signs. However, the Philippines is also considered to provide broader protection for non-traditional, visually perceptible marks than other jurisdictions that restrict protection solely to traditional visually perceptible signs.[28]

In addition, ASEAN countries also recognize the application of the first-to-file[29] principle to trademark applications. However, there are reports that

27 Lucero, H. D. (2023, February 15). *New trademark rules for protecting non-traditional marks, mandating online transactions take effect*. Intellectual Property Office of the Philippines. https://www.ipophil.gov.ph/news/new-trademark-rules-for-protecting-non-traditional-marks-embraces-full-digitalization/

28 Corral, C. (2023), *Philippines practice update: Changes to non-traditional and well-known marks*. ROUSE. https://rouse.com/insights/news/2023/philippines-practice-update-changes-to-non-traditional-and-well-known-marks

29 Which means that the first person to file a trademark application in a particular South-East Asia country will own that right in that country once the registration is granted.

Malaysia uses the first-to-use principle in certain cases,[30] while the Philippines uses the term "prior use" to protect cases that may fall under the first-to-use principle.[31] Basically, both Malaysia and the Philippines have a similar principle to the other ASEAN countries and operate the first-to-file principle in their national laws.

To protect unregistered trademarks, some ASEAN countries have their own protection mechanisms against passing off. For example, in Singapore, to sue for passing off, the plaintiff must show (i) goodwill of their business as of the date the defendant launched the passing off mark; (ii) the passing off mark must be confusingly similar to the plaintiff's mark; and (iii) damage must have occurred.[32] In Malaysia, passing off is also applicable to registered marks. In a case between a British biscuit manufacturer and a Malaysian company that passed off the British company's mark, the court found confusing similarity between the marks "ChipsMore" and "ChipsPlus", along with reputation and damage, to establish infringement by the Malaysian company's use of the passing off mark.[33]

2. Challenges of trademark harmonization in ASEAN

2.1. Drivers of trademark harmonization in ASEAN

The necessity of harmonizing trademark laws in ASEAN arises from the fact that commercial activities can face numerous obstacles. For example, some countries, like Singapore, allow the registration of sound trademarks, while others, like Laos, do not. A Singaporean business that wants to expand its market to Laos and needs sound trademark protection may encounter obstacles when Laos does not currently recognize sound trademarks. Along with that is the issue of registration and protection time, separate procedures in each country that differ, and many other requirements and regulations. For example, the fastest time for trademark registration in ASEAN is recorded as two months, and the slowest is up to 3 years.[34] However, the registration process can be streamlined if ASEAN countries join the Madrid Protocol. In fact, 9 out of 10 ASEAN members, except Myanmar, have acceded to the Madrid Protocol, which remains an important international practice. This system offers a convenient, centralized, and cost-effective way to register and manage trademarks globally with a single international trademark application seeking protection in up to 131 countries.[35] Under the recently

30 EIC & SMEEA. (2020b). *Malaysia IP Country Factsheet*. European Commission. https://data.europa.eu/doi/10.2826/372367

31 Lawyers Online PH. (2023, June 12). *Trademarks in the Philippines: Understanding the first-to-file rule and prior use*. Lawyers Online PH. https://www.lawyersonlineph.com/post/trademarks-first-to-file-rule-vs-prior-use-in-ph

32 Singapore Legal Advice. (2023, December 18). *The tort of passing off: Someone has imitated the branding of my business*. Singapore Legal Advice. https://singaporelegaladvice.com/law-articles/tort-passing-someone-imitated-branding-business/

33 European Commission. (n.d.). *Case study 15 – Trademark infringement/'passing off' case in Malaysia*. European Commission. https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/south-east-asia-ip-sme-helpdesk/case-studies/case-study-15-trade-mark-infringement-passing-case-malaysia_en

34 EIC & SMEEA (2020a), *supra* note 20.

35 World Intellectual Property Organization. (n.d.). *Madrid System – The International Trademark System*.

updated Madrid Protocol, filing international applications for non-traditional trademarks in digital format is permitted. This means that sound, motion, and other multimedia marks can be registered using the Madrid Protocol provided the representation is digital. However, the Madrid Protocol only applies to its members. The uneven participation of ASEAN members in this system will create some differences, and the effectiveness of joining the system will not be reflected at the regional level.

Although TRIPS does not specifically mention non-traditional trademarks, it recognizes visible forms of trademarks and ignores non-visually perceptible signs. In the spirit of the open-ended TRIPS provisions, which are the foundation and contain no prohibitive provisions, it can be seen that non-traditional trademarks in general and non-visually perceptible signs in particular will still be recognized by countries without contravening the provisions of TRIPS. In other words, non-traditional trademarks are still protected under TRIPS provisions, as long as they meet the conditions of representation and distinctiveness between different goods and services.[36]

There is an opinion that the use of "any sign" to refer to all signs,[37] including both visible and non-visible, as trademarks, while the subsequent listing is only explanatory. However, if this is correct, then in light of Laotian law, which similarly employs the term in Article 3.9 of the 2023 Law on Trademark and provides a specific list in Article 16, it can be understood that Laos permits the registration of signs possessing a distinctive function, with Article 16 serving merely as illustrative rather than exhaustive. In practice, trademark registration in Laos is only carried out for the forms mentioned in section 2.2.[38] This can have two interpretations. Either the way the term is used differs between TRIPS and national laws, even though they use the same phrase "any sign", or the term "any sign" does not encompass all signs with a distinctive function, leading to the subsequent listing being the primary meaning of the term.

2.2. Key challenges defined

As mentioned above, the primary obstacle lies in the uneven participation of countries in international practices, hindering the establishment of a common platform for development. For instance, Myanmar's non-participation in the Madrid Protocol means that the system is not applicable in Myanmar, adding additional procedures for businesses seeking trademark protection in that country. Alongside the issue of trademark registration procedures, regulations surrounding registered trademarks also come into

WIPO. https://www.wipo.int/web/madrid-system

36 Carapeto (2016), *supra* note 19.

37 Zhan (2016*)*, supra note 5.

38 Ageless IP Attorneys & Consultants. (2022, May 30). *Should you register trademark in Laos in color or in black & white?* . Ageless IP Attorneys & Consultants. https://ageless.com.vn/en/tu-van/should-you-register-trademark-in-laos-in-color-or-in-black-white/

play. While all ASEAN members have joined TRIPS, the understanding and internalization of its provisions vary across nations. The TRIPS does not prohibit members from allowing the registration of non-traditional trademarks, but not all countries agree to permit the registration of this group. The role of TRIPS as a foundational legal framework for countries to build their own laws is positive. However, considering ASEAN's goal of having a legal framework applicable to all members, the TRIPS falls short. Despite the common agreement among ASEAN members in the field of IP (ASEAN Framework Agreement on Intellectual Property Cooperation), this agreement remains general and fails to specify the groups involved, particularly concerning trademarks. Therefore, it is necessary to establish a new legal framework that is more suited to current requirements.

Another issue that arises is the choice of standards for this new legal framework. The regulations of ASEAN countries are different, and not all countries are open to non-traditional perceptible signs, and *vice versa*. This is due to various reasons depending on each country. However, one of them is the uneven technological development among countries, or the development gap between the ASEAN members. For non-visually perceptible signs, specific technologies must be used to identify differences and assess the distinctiveness between the signs that need to be registered and other goods or services. In addition to the technological issue, the requirement for experts to conduct evaluations or those with the authority to make decisions must also be considered. For instance, a Singaporean company aiming to register a unique jingle as a trademark for their business in Laos faces a complex situation since Laos does not allow sound trademark registration. Registering the jingle requires detailed documentation unfamiliar to the trademark office, and the concept itself might be new to Laotian consumers, potentially hindering enforcement. These challenges highlight the complexities some ASEAN countries face in embracing non-traditional trademarks.

Furthermore, there are other challenges related to balancing interests between parties. Some countries will not be able to comply if the standards are too high. If the harmonization is based on the legal framework of an advanced country like Singapore, less developed countries will find it difficult to keep up, creating loopholes in the law. Going back to the example of using technology to identify non-visually perceptible signs, if ASEAN members are required to accept this trademark protection, countries that do not have the technology developed enough to recognize these new signs will face difficulties, leading to either losing control over registered signs or creating a sense of resistance and non-compliance with the common legal framework.

Moreover, the lack of a common definition for "trademark" or "mark" is also an obstacle to harmonizing ASEAN trademark laws. Singapore, Brunei, and Malaysia do not limit trademarks to visible forms but only have general provisions on signs and distinctiveness between different goods and services. Indonesia and Thailand list forms, in which sound marks in the group of non-visually perceptible signs are included. For the remaining countries, some provisions only accept visible signs and list the forms that can be registered for protection, except for the Philippines. The diversity of backgrounds and legal systems among ASEAN member States also poses certain challenges, as different legal systems lead to different perspectives and approaches to law enforcement. As Prof. Christoph Antons notes:

"The problem of harmonizing procedural rules in developing Asia are much more severe than those experienced in Europe and North America, with law in Asia drawn not only from different traditions but also from different colonial periods and with a judiciary that is often struggling to free itself from political influence and from a negative image of being corrupt to some degree."[39]

This is a common challenge faced in various fields when legal harmonization is required. In the field of IP, harmonization is likely to be even more difficult due to its close ties to technology and the varying levels of development of different countries.

3. Strategies to address challenges in trademark harmonization

ASEAN countries have an advantage in that all members are parties to the TRIPS and the majority are parties to the Madrid Protocol. Therefore, the laws of these countries will not be fundamentally different, as they must still comply with the principles and provisions of these regulations. The definition of a trademark is also defined in the TRIPS, however, it is only a fundamental and suggestive framework for member States to adjust their laws to suit their national needs and circumstances, which has led to differences in the definition of trademarks and the recognition of protected trademarks. Specifically, ASEAN countries currently have certain differences while the related regulations are still in compliance with TRIPS. Therefore, ASEAN Member States should have a unified approach to participating in international conventions or international systems, resulting in similar legal frameworks and minimal differences.[40]

Furthermore, the previous commitments made by the ASEAN members are only fundamental, too general, and lack specificity. Thus, it is necessary to have a clear roadmap and short-term goals to achieve the common development goals. The plans outlined in previous meetings should

39 Barizah, N. (2017). The development of ASEAN's intellectual property rights law, from TRIPS compliance to harmonization. *Indonesia Law Review*, 7(1), 95–112. https://doi.org/10.15742/ilrev.v7n1.247

40 Abraham, K. & Purba, A. K. (2018, September 26). *ASEAN proposes Pan-ASEAN trademark system*. Managing IP. https://www.managingip.com/article/2a5c3few8ara54yy9log0/asean-proposes-pan-asean-trademark-system

be concretized step by step, and clear requirements should be set out instead of identifying and referring to the general responsibilities of each country.

Drawing from the Guidelines for Examination of European Union Trademarks at the EUIPO (Guidelines for Examination), it becomes evident that the EU has established its own set of standards for member States to adhere to in defining and protecting trademarks. While not being a legislation, the Guidelines contain general instructions, which have to be adapted to the particularities of a case, and self-imposed rules of conduct adopted by an administrative decision. For instance, Section 4, Article 2.5 specifically addresses sound marks. The Guidelines outline the conditions for identifying sound trademarks and provide clear illustrations for their provisions. Similarly, Section 4 lists trademarks that are not recognized. In line with this, Article 2.9.2 on scent marks states that the EU does not recognize such trademarks due to current technological limitations in clearly distinguishing and determining the distinctiveness of scent marks. Harmonizing trademark laws in ASEAN, while seemingly similar to the EU's approach, is not directly feasible due to inherent differences between the alliances and ASEAN's lack of a dedicated system for developing and maintaining such guidelines. Furthermore, the Guidelines are grounded in the practical experiences of EU regional IP offices. Consequently, they are tailored to the specific business practices and characteristics of Europe. Therefore, the EU's Guidelines should serve as a reference for ASEAN to develop its own, more tailored guidelines for its member States.

An important step towards trademark law harmonization in ASEAN is the Common Guidelines for the Substantive Examination of Trademarks.[41] While non-binding, these Guidelines provide a common reference for examiners, covering distinctiveness, absolute grounds for refusal, non-traditional marks, and similarity assessments. They function as a coordinating tool to reduce disparities in practice and to build examiner capacity, thereby laying the groundwork for deeper legal harmonization and a potential regional trademark system in the future. The ASEAN members could consider adopting a common trademark law that would establish a binding uniform set of rules for registration, enforcement, and dispute resolution across the region. This would provide greater certainty and predictability for businesses operating in multiple ASEAN countries. However, it must be acknowledged that the development gap poses a significant challenge to ASEAN legal harmonization, particularly in the areas of IP and trademark protection in general. This is a rapidly evolving field closely tied to each country's unique characteristics and development trajectory, making it difficult to harmonize

41 ASEAN Secretariat. (2020*), supra* note 9.

this development while ensuring the rights of all members.[42] Moreover, the diversity of legal systems plays a crucial role, as ASEAN countries adhere to various legal frameworks, including civil law, common law, religious law, and customary law. Legal systems are deeply embedded in each country's social and cultural context, necessitating a cautious and well-considered approach to legal harmonization in general. Therefore, the process of establishing a suitable legal framework for all ASEAN members is a long journey with numerous factors to consider. In the context of trademark protection, rather than imposing standards based on a single model country, members could renegotiate to establish criteria that are more readily achievable and aligned with the specific circumstances of each member. Alongside this timeframe, there should be mutual support to enhance cooperation on trademark enforcement by sharing information and best practices among member States, and fostering enabling factors such as technological advancement and specialized training programs to improve the overall expertise and capacity to deal with trademark issues in the region.

Conclusion

Legal harmonization is essential to achieve common development goals. According to the plan agreed upon by member countries, IP has been identified as a key area for ASEAN's common development. In the specific case of trademark protection, while the framework regulations provide some basic principles, they lack specificity or clear guidelines. Looking at the trademark regulations of each member, non-traditional trademarks are allowed for registration with varying degrees of protection. These trademarks include visually and non-visually perceptible signs. Singapore, Brunei, and Malaysia significantly permit the registration of both signs. Thailand, Indonesia, and Vietnam only allow one form of non-visually perceptible sign, the sound trademark, and various forms of visually perceptible signs. The Philippines only permits various forms of visually perceptible signs. The remaining countries, including Cambodia, Laos, and Myanmar, only allow certain forms of visually perceptible signs.

The harmonization of trademark laws among ASEAN countries certainly faces many challenges. The primary challenge lies in the absence of a unified standard for defining trademarks themselves. In addition, due to the uneven development of each economy and jurisdiction in the region, careful consideration is essential when establishing common standards. These standards should be carefully considered in light of the specific

42 Wongburanavart, A. (2022, June). *Cooperation in intellectual property and the ASEAN way: Challenges and opportunities for the ASEAN economic community* (ASEAN Ideas in Progress Working Paper No. 4). Center for International Law, National University of Singapore, pp. 15-17. https://cil.nus.edu.sg/publication/cooperation-in-intellectual-property-and-the-asean-way-challenges-and-opportunities-for-the-asean-economic-community/

circumstances and conditions of each member country. Through a process of review and assessment of feasibility, consensus should be reached, and a more comprehensive legal framework should be established, one that is aligned with long-term objectives. The authors propose that the process of harmonizing trademark laws in ASEAN countries should be carried out gradually. In general, this period should be used for observation, consideration, and cooperation so that less developed countries can gradually achieve compatibility with developed countries to establish a positive legal framework for ASEAN. ●

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Author Contribution

All authors contributed to the study conception and design. All authors read and approved the final manuscript.

Declarations

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