

## When Should a Descriptive Mark Be Allowed for Registration?

*For trademark applicants venturing into the vibrant and ever-evolving markets of Vietnam and China, the acquisition of a profound understanding of the prevailing practices in examining trademarks classified as descriptive takes on a paramount significance. In these dynamic landscapes, where competition thrives and consumer demands constantly evolve, the fate of a trademark hinges on its ability to stand out amidst a sea of descriptive terms. A nuanced comprehension of the examination process becomes instrumental in charting a successful course, enabling applicants to navigate the intricacies of registrability and maximize the potential of their trademarks. Failure to grasp the intricacies of descriptive marks' assessment may not only impede registration prospects but also lead to missed opportunities and potential obstacles in establishing a distinctive brand presence. As such, investing the time and effort to comprehend the current practices and nuances of examining descriptive trademarks becomes an imperative step in achieving success and gaining a competitive edge in these bustling markets.*

### Descriptive marks in China

In a recent opinion release, the Chinese Supreme People's Court (**SPC**) emphasized that the distinctiveness of an English mark should be determined based on the understanding of the relevant Chinese public regarding the designated goods or services. This determination requires comprehensive consideration of factors such as the overall composition and meaning of the logo, as well as the degree of association between the trademark and the goods or services. Taking the mark "BIODERMA" as an example, it comprises the root words "BIO" and "DERMA". Considering the general level of English comprehension among the relevant Chinese public, "BIODERMA" would not be commonly understood as "biological skin". Therefore, the mark exhibits distinctiveness when applied to goods such as "*pharmaceutical preparations, pharmaceutical preparations for skin care, and pharmaceutical preparations for skin disease*".


While it is agreed that the consideration of trademarks that may be deemed descriptive of the designated goods and/or services within the overall context, not a few are surprised by the open approach adopted by the SPC in handling descriptive marks. Specifically, the mark "**BIODERMA**" comprises the root words "BIO" and "DERMA" which individually describe the goods such as "*pharmaceutical preparations, pharmaceutical preparations for skin care, and pharmaceutical preparations for skin disease.*" Consequently, these descriptive words, even when combined as "BIODERMA", should be deemed ineligible for trademark status. In other words, "BIODERMA" should still be considered descriptive of the aforementioned goods.

As a widely accepted principle, the judgment of trademark registrability should be based on its nature and the goods/services it aims to protect. This ensures fair use for the relevant public within a specific industry. Consider the potential consequences if a third party were to use the word "BIODERMA" as a descriptive term on a product label, while that same descriptive word has been registered as a trademark by its owner. Furthermore, if such a trend of trademarking descriptive words were legally adopted, it could lead to the use of unusual descriptive English words for trademark purposes. For instance, would a term like "PURECOOL" be eligible for non-alcoholic beverages, based on the argument that "fresh" is more widely known in China than "pure"?


It is believed that trademarks serve the purpose of promoting fair competition and preventing unfair advantage. Allowing the registration of a descriptive mark, like "BIODERMA", without demonstrating its acquired distinctiveness through use, could potentially grant the trademark owner an unwarranted monopoly over a term that should be accessible for fair use by competitors. Granting exclusive rights to descriptive terms may impede innovation and restrict other businesses from accurately describing their products or services.

### Descriptive marks in Vietnam

The IP Office of Vietnam (**IP VIETNAM**) follows a stringent and rigorous examination approach when it comes to alleged descriptive marks. Interestingly, IP VIETNAM may consider marks that are more "suggestive" rather than purely "descriptive" as descriptive marks. To illustrate this, let's look at a few examples of trademark cases.

No.	Trademark	Class	Application No.	Refusal	Remarks
1	<b>FINISHCOAT</b>	02 ( <i>paints</i> )	4-2001-00650	Refused on descriptive ground	The applicant filed a response, by IP VIETNAM continued its rejection
2	<b>ICYPURE</b>	32 ( <i>non-alcoholic beverages</i> )	4-2011-09415	<i>Ditto</i>	<i>Ditto</i>
3	<b>ACTIVE 5</b>	05 ( <i>soap, cosmetics</i> )	4-2010-06600	<i>Ditto</i>	<i>Ditto</i>
4	 <b>tytanium</b>	06 ( <i>Metal hinges, metal rails, metal box latches, metal screws, metal small furniture wheels</i> )	4-2012-17320	<i>Ditto</i>	<i>Ditto</i> . See more remarks below (*)



(\*) Please note that the word “tytanium” in the mark “ tytanium” is a coined name and not the English word “TITANIUM”. Furthermore, the mark “tytanium, device” has been accepted for registration in Belarus, China, the Czech Republic, Lithuania, Russia, and Ukraine without being deemed descriptive. However, IP VIETNAM maintains its position of rejecting the mark.

### The line between descriptive and suggestive marks

A suggestive mark may easily be deemed descriptive in non-speaking countries, especially, when those marks are examined by non-fluent English examiners. Distinguishing between these two categories of marks is a complex task, as the line between them can be subtle and challenging to discern. However, from a professional standpoint, we have dedicated our efforts to exploring and shedding light on this contentious issue in our article titled “[Trademark Refusal in Vietnam, Laos and Cambodia: The Fine Line Between Descriptive and Suggestive](#)”.

### The necessity of adopting a cautious approach when examining descriptive marks

Every coin has two sides. However, in our opinion, a mark must fulfil its functions while taking into account that we are living in a flat world. A mark in China does not mean that it is accessible by one Chinese people. It should be accessible by all people living and working in China. The general public has a reasonable expectation that descriptive terms will remain available for use by all competitors in an industry. Granting exclusive rights to descriptive marks could disrupt consumer expectations and limit the ability of other businesses to accurately communicate the nature of their products or services. Requiring evidence of secondary meaning protects the interests of the public by ensuring that descriptive terms remain accessible to all industry participants, fostering fair competition and promoting the free flow of information.

A more suitable approach would, in our opinion, be to allow the registration of a descriptive mark, provided that the trademark owner fulfills the obligation of proving that their mark has acquired secondary meaning through use. Requiring evidence of secondary meaning ensures that trademark protection is granted only to those who have genuinely established a distinct association with the descriptive term.

While adopting a more lenient approach in assessing the distinctiveness of marks containing descriptive elements is believed to pave the way for trademark applicants, it is crucial to recognize the potential adverse effects of granting registration without demonstrating inherent distinctiveness through actual use. By requiring evidence of secondary meaning, we strike a balance between protecting fair competition, preventing consumer confusion, promoting creativity, and preserving consumer expectations. This approach ensures that descriptive marks are carefully judged, protecting the rights of both trademark owners and the public at large.

In the realm of intellectual property rights and trademark ownership, the debate surrounding the registration of descriptive marks persists. At KENFOX IP & Law Office, we understand the intricacies of navigating the

trademark landscape, particularly in distinguishing between inherently distinctive and descriptive marks. Our dedication lies in providing comprehensive IP services that empower clients to make informed decisions for the registration and protection of their valuable trademarks. With our expertise and commitment to staying at the forefront of industry developments, we guide clients through the complexities of descriptive mark registration, ensuring effective navigation of this critical aspect of their intellectual property strategy.

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