

NOT JUST LOGOS ANYMORE: HOW FAR CAN TRADEMARK LAW GO IN MALAYSIA?

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Trademarks have long served as a cornerstone of brand identity, traditionally encompassing words, logos, and symbols. In a world where consumers remember how something sounds, feels, or even smells, the traditional trademark is insufficient. Brands today are turning to the senses - protecting jingles, packaging shapes, motion graphics, and even signature colours. These unconventional assets, known as non-traditional trademarks ("**NTMs**"), are reshaping intellectual property law. Malaysia's Trademarks Act 2019 ("**TMA 2019**") opened the door, but how far have we really stepped through?

This article walks through the concept of NTMs, offering illustrative examples from around the world - both celebrated and contested. It also considers how Malaysia, through the TMA 2019, is laying the groundwork to embrace these forms of intellectual property.

What are Non-Traditional Trademarks?

Close your eyes and think of a brand - not by its logo, but by the chime you hear when a computer starts up, the scent that hits you when you unbox a product, or the shape of a bottle that needs no label. These are all examples of NTMs - marks that appeal to the senses and distinguish goods or services in ways that words cannot. While traditional trademarks rely on visual symbols like names and logos, NTMs engage sound, motion, colour, shape, position, and even smell.

Let's explore each category through real-world examples that showcase both successful registrations and legal hurdles.

• Sound marks

A sound mark relates to the auditory element of branding and can consist of any recognisable sound associated with a good or service. Take, for example, Nokia ringtone that became so synonymous with the brand that it was successfully registered as a sound mark in multiple jurisdictions, including the European Union (EU) and the United States (US). Similarly, the iconic lion's roar of Metro Goldwyn Mayer has also been granted trademark protection in the US.

However, not all attempts to register sound marks are successful. In 1994, Harley-Davidson attempted to trademark the distinct "potato-potato" exhaust sound of its

V-twin engine failed to overcome the hurdles of functionality and distinctiveness. This was met with fierce opposition from 9 other competitors, who argued that similar V-Twin engines naturally produced comparable sounds. After facing opposition proceedings, Harley-Davidson ultimately abandoned the application.

• Shape marks

A shape mark protects the three-dimensional form of goods or their packaging, allowing businesses to secure rights over distinctive product shapes. Lindt's chocolate bunny, wrapped in gold foil with a red ribbon, is one such example that enjoys protection in EU.

However, shapes can be debatable. Despite widespread consumer recognition, Nestlé's attempt to register the shape of its four-fingered KitKat chocolate bar shape in the United Kingdom (UK) and EU fell short. The application faced opposition from Cadbury (now Mondelez). The UK Court of Appeal found that while a significant portion of the public recognised the KitKat shape, Nestlé failed to demonstrate that consumers identified the shape alone - rather than other brand elements - to identify the commercial origin of the goods.¹ The verdict goes against a 2016 EU General Court ruling, which, while denying Nestlé a registered trade mark throughout the EU, did find that the bar had acquired "distinctive character through use" specifically in the UK.² and in some EU countries.

The case illustrates the high threshold for registering shape marks, particularly the need to prove that the shape alone, without reliance on other branding, serves as a badge of origin.

• Colour marks

A colour mark allows for the protection of a specific colour, either as part of the packaging or when applied directly to the goods. A prominent example would be Tiffany & Co.'s robin egg blue which is widely associated with luxury.

Cadbury's efforts to protect its iconic purple colour (Pantone 2685C) highlight both success and setback in colour trademark registration. Cadbury filed three separate trademark applications in the UK, each describing the colour's use in slightly different way. The first application (Mark 362), which described the colour purple as "applied to the whole visible surface of the packaging of the goods", was accepted by the UKIPO. However, the second (Mark 361) and third applications (Mark 822), which used broader phrase such as "applied to the packaging of goods" or provided no specific limitation, were rejected. On appeal, the UK High Court upheld Cadbury's appeal for Mark 822, holding that the description was sufficiently clear and conceptually distinct as a single, identifiable mark. The Court rejected the broader terms of Mark 361, holding that the description of "applied to the packaging of goods" was too vague and open-ended, which could allow for too many variations.³

The decision highlights the need for clear and precise trademark descriptions to ensure legal certainty, particularly for NTMs like colour marks.

¹ *Société des Produits Nestlé S.A. v Cadbury UK Ltd* [2017] EWCA Civ 358

² *Case T-112/13 Nestlé v OHIM* [2016]

³ *Cadbury UK Ltd v Société des Produits Nestlé SA (Comptroller-General of Patents, Designs and Trade Marks intervening)* [2022] EWHC 1671 (Ch)

• Motion marks

A motion mark protects moving images or sequences of motion that are used as branding tools, often serving as a dynamic way to capture consumer attention. A standout example is Lamborghini's successful registration of the distinctive movement of its car door. The iconic scissor doors, which open vertically, passed the distinctiveness test and were granted trademark protection in both the EU and the US.

However, not all attempts at registering motion marks have been successful. For instances, KCT GmbH & Co. KG sought to register a motion mark depicting the opening and closing of vehicle windows for expedition vehicles. The EUIPO's Board of Appeal confirmed the refusal of the application, stating that the motion represented a functional process and lacked distinctiveness. The Board emphasised that such movements are commonly used to demonstrate the functionality of products and are not perceived as indicators of the origin of goods or services.

• Position marks

A position mark refers to trademarks where protection is claimed for the specific placement of a mark on a product, distinguishing it from others. A well-known example is the successful registration of the red sole of Christian Louboutin shoes in the EU, which was recognised for the specific positioning of the red colour on the sole.

However, position marks are not always successful. In 2024, Loro Piana filed a position trademark for a decorative feature on its footwear. The mark consisted of a band, knot, ribbon, and two metal pendants positioned near the tongue of the shoe. The application was refused by the EUIPO on the ground that the mark was too common and purely decorative, failing to distinguish Loro Piana's products from others in the footwear industry.

• Scent marks

A scent mark protects a particular smell that is uniquely linked to goods or services. For instances, Hasbro succeeded in registering the nostalgic scent of Play-Doh in the U.S., described as a *"unique scent formed through the combination of a sweet, slightly musky, vanilla-like fragrance, with slight overtones of cherry, and the natural smell of a salted, wheat-based dough"*.

In contrast, the registration of well-known fragrances has faced challenges. For example, Chanel No. 5, arguably one of the most iconic fragrances in the world, was denied registration in the UK. The Court held that the scent was intrinsic to the very nature of the product, with primary purpose of a perfume being to deliver fragrance. As such, it could not function independently as a trademark.

All the cases above reflect the difficulties in registering NTMs that are functional, not sufficiently distinctive, or described too vaguely.

The Malaysian Landscape

• The Trademarks Act 2019

In Malaysia, trademarks are governed by TMA 2019, which came into force on 27 December 2019. The TMA 2019 replaced the previous Trade Marks Act 1976 ("**TMA 1976**"), introducing several key changes to the trademark landscape in Malaysia.

One of the significant changes under the TMA 2019 was the introduction of the concept of a "sign", replacing the narrower definition of a "mark". This effectively broadened the scope of registrable trademarks to include "any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof". The inclusion of protections for NTMs under the TMA 2019 reflects a growing recognition of the need to safeguard distinctive brand features beyond conventional logos and slogans.

Since the enactment of the TMA 2019, 39 non-traditional marks have been successfully registered in Malaysia. An example of a successful non-traditional trademark registration is Maybank's registration of its 3D "Tiger Head Device" shape mark across different classes of goods. Other examples include the registration of a position mark by All Star C.V., which features the placement of design elements on a shoe, and a sound mark by Lazada. These examples illustrate how brand owners are actively using the broader protection afforded by the TMA 2019 to safeguard non-conventional aspects of their brand identity.

• Key Challenges

While the TMA 2019 has broadened the definition of registrable trademarks, successfully registering these marks remains a challenging process. Several key hurdles continue to limit the widespread registration of NTMs in Malaysia.

The primary challenge lies in proving distinctiveness. Under Section 23(1)(a) of the TMA 2019, a trademark must be capable of distinguishing the goods or services of one undertaking from those of others. For conventional marks, this is often straightforward, but for NTMs, it can be far more difficult. Applicants must provide compelling evidence that consumers perceive the non-traditional feature as an indicator of origin, rather than merely a decorative, functional, or generic element. For instances, a sound must be one that consumers immediately associate with a particular product or service, not just any generic tune.

Another major hurdle stems from Section 24 of the TMA 2019, which prohibits registration of signs that consist exclusively of the shape or other characteristics necessary to achieve a technical result or that give substantial value to the goods. For instances, a shape may be objected as functional or generic unless it can be shown to be uniquely associated with the brand.

Although the TMA 2019 allows for a broader range of signs, it retains the requirement that trademarks must be capable of being represented graphically. The

representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. This poses particular challenges for NTMs, especially scents which are notoriously difficult to graphically represent in a way that meets these standards. Failing to provide a sufficiently clear and precise representation can lead to rejection of the application at the outset.

Looking Ahead

In the coming years, it is expected that NTMs will become more commonplace as businesses increasingly seek to protect their evolving brand identities. Malaysia's inclusion of NTMs under the TMA 2019 signals its readiness to join the global movement toward recognising innovative brand elements. As Malaysia continues to embrace the protection of NTMs under the TMA 2019, it is anticipated that more businesses will seek to register distinctive elements beyond conventional brand names and logos.

For businesses considering registering NTMs in Malaysia, several practical steps can help enhance the prospects of success:

- **Early Planning and Strategy:** Identify early on which elements of your branding - whether shape, sound, colour, scent, motion, or positioning - are truly distinctive and capable of serving as an indicator of origin.
- **Clear and Precise Representation:** Ensure that the representation of the non-traditional mark meets the graphic representation requirement.
- **Evidence of Distinctiveness:** Gather and preserve strong evidence that the NTM has acquired distinctiveness through use. This could include market surveys, advertising materials, sales data, and media recognition demonstrating that the relevant public associates the mark with your business.
- **Avoid Functional Features:** Be mindful that purely functional aspects are unlikely to be registrable. For example, if the shape, sound, or motion is dictated by a technical function, it may face objections.

As the Malaysian IP landscape continues to evolve, NTMs will play an increasingly important role in how businesses distinguish themselves. Those who invest early in securing protection for innovative brand elements will not only safeguard their competitive edge but also position themselves at the forefront of a dynamic and modern branding environment. The future of trademark protection in Malaysia is expanding - and for forward-thinking businesses, the opportunities are as limitless as their creativity.

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