

(Translation)

Examination Guidelines on Distinctiveness of Trademarks

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1. Preface

The main function of a trademark is to identify the source of goods or services. If a sign cannot identify and distinguish goods or services, it does not have the trademark function and the registration thereof cannot be approved. Distinctiveness is a requirement for registration of a trademark. However, the existence or degree of distinctiveness of a trademark often changes with the actual use of the trademark and the passage of time. In particular, in view of today's ever-changing marketing methods and rapid development in digital media technology, the type and manner of use of a trademark change continuously, which greatly affect the determination of its distinctiveness. Whether a sign is distinctive may be determined on different basis in different cases because of the different nature of goods or services. Therefore, the results are often considered inconsistent. Likewise, the guidelines for determination of whether a trademark has acquired distinctiveness through use must vary with the strength of evidence of use, the extent to which competitors in the same trade must use the trademark and the extent to which the consumers of relevant goods or services may be in contact with the trademark. Thus, these Guidelines are formulated to establish objective examination criteria and facilitate consistent judgments.

When a sign is used to denote the shape, quality, function or other characteristics of goods or services, consumers may merely consider it as a means to convey the information about the goods or services. If such sign must be used by competitors in the same trade, it certainly cannot be exclusively used by a particular operator. For a sign commonly used by operators for particular goods or services or a name customarily used by operators to denote certain goods or services, consumers will consider it a mark commonly used for general goods or services or a name of the goods or services. Under such circumstances, the sign/name does not function to identify the source and differs from a trademark, which is used to identify and distinguish the source of goods or services. The aforementioned are specific examples of trademarks that are not distinctive (Article 29 of the Trademark Act). These Guidelines will define the applicability of relevant provisions and provide the

basis for examination of the distinctiveness of trademarks¹.

2. Meaning of Distinctiveness

The distinctiveness of a trademark relates to how it denotes the source of goods or services and distinguishes such goods or services from those of others. Therefore, determination of distinctiveness must be made based on the relationship between the trademark and the designated goods or services, rather than on the trademark alone.

The distinctiveness of a trademark includes inherent distinctiveness and acquired distinctiveness. The former is inherent in the trademark itself and is not acquired through use, while the latter refers to the situation in which a sign is not distinctive by itself, but the use of the trademark on the market makes relevant consumers recognize it as a sign identifying the source of the goods or services; in other words, it acquires distinctiveness. In addition to the original meaning, such trademark also creates a new meaning that can identify the source. Therefore, acquired distinctiveness is also called secondary meaning. The details are as follows:

2.1 Signs having inherent distinctiveness


A sign used for specific goods or services is deemed inherently distinctive when, for consumers, such sign serves to identify the source of the goods or services rather than to convey the information about the goods or services themselves or about their contents. From the perspective of competition, if other bona fide competitors would not need to use the sign to denote the goods or services themselves or explain the quality, function or other features of such goods or services, the sign is inherently distinctive. Trademarks having inherent distinctiveness may be divided into coined trademarks, arbitrary trademarks and suggestive trademarks according to the degree of distinctiveness.

¹ The Main Points for Examination of Distinctiveness of Trademarks published by the National Bureau of Standards of the Ministry of Economic Affairs on November 22, 1997 will no longer be applicable after these Guidelines take effect.

2.1.1 Coined signs

A "coined sign" is an original creation through the use of intellect rather than an application of any existing words, phrases, or things. A coined sign has no specific, existing meaning, and is created to distinguish the source of relevant goods or services. Because of the originality, a coined sign does not convey to consumers any information about the goods or services, but only serves to identify and distinguish the source. Therefore, a coined trademark has the strongest distinctiveness. From the perspective of competition, the grant of exclusive right to this type of sign will not affect fair competition because it is not a sign that competitors must or may use to denote the goods or services or make relevant explanations. Therefore, such sign is registrable.

Approved cases:

- "GOOGLE" for search engine services
- "震旦" ("Aurora") for transmission services by telecommunications weighted networks
- "普騰" ("Proton") for television sets and stereo sets
-  for cars and passenger cars

2.1.2 Arbitrary signs

An "arbitrary sign" consists of any existing words, phrases, or things which are completely irrelevant to the designated goods or services or their quality, function or other features. Because this type of sign does not convey the information about the designated goods or services, it is not meant to describe the goods or services. Rather, consumers will simply consider it a sign identifying and distinguishing the source. From the perspective of competition, the grant of exclusive right to this type of sign will not affect fair competition because competitors in the same trade do not need to use such words, phrases or things since they are completely irrelevant to the designated goods or services. Therefore, such sign is registrable.

Approved cases:

- "蘋果 APPLE," "黑莓 BlackBerry" for computers and data processors.
- "風信子" ("Hyacinth") for cups, bowls and dishes.
- "向日葵" ("Sunflowers") for solar collectors.
- "春天" ("Spring") for restaurant and hotel services



- for tiles, floor tiles and wall tiles.



- for clothing.

2.1.3 Suggestive signs

A "suggestive trademark" refers, by use of metaphor or simile, to the quality, function, or anything related to the ingredients or nature, of the goods. Such sign is easy to remember, but is not necessarily or commonly used by competitors to describe goods or services. A suggestive description differs from direct description of goods or services. When the former is used, consumers must exercise certain level of imagination, thought, feeling or inference in order to understand the connection between the sign and the goods or services. This type of sign is not necessarily or naturally chosen by competitors to describe the features of the goods or services because there are other more directly descriptive words or devices available. Therefore, the grant of exclusive right to this type of sign will not affect fair competition and such sign is registrable.

Approved cases:

- "快譯通" ("Quick Translation Understandable") for electronic dictionaries.
- "一匙靈" ("One Spoon Effective") for laundry detergents in powder

form.

- "克潮靈" ("Resisting Humidity Effective") for dehumidifying agents.
- "靠得住" ("Reliable") for sanitary napkins.
- "足爽" ("Foot Refreshing") for medicated ointment for H.K. feet.



- for chairs, rocking chairs, desks and chairs.

2.2 Signs having no inherent distinctiveness

A descriptive sign relating to the descriptions of goods or services, a generic mark or name denoting the designated goods or services, or any other sign that cannot identify and distinguish the source is deemed a sign having no inherent distinctiveness.

2.2.1 Descriptive signs

A descriptive sign directly and obviously describes the quality, function, or anything related to the ingredients or place of origin, of goods or services. Such sign is easy to be regarded as a description of the goods or services rather than a sign identifying the source. The expression "descriptive of goods or services" means that when a sign, as commonly understood in the society, is descriptive of the goods or services themselves or is closely related to such description, it is not registrable, even if such sign is not commonly used by general providers of those goods or services. Examples include "燒烤" ("B.B.Q.") for restaurant services, "記憶" ("Memory") for pillows and mattresses, "霜降" ("Shimfuri") for meat products, "HID" ("High Intensity Discharge") for car lamps, etc. Besides, a term or sign that is often used by businesses to signify the excellent quality of goods or services or a description of the features popular among consumers is also deemed a descriptive sign, for instance, the gold medal device, 頂級 ("Superb"), 極品 ("Highest Grade"), 特優 ("Exceptionally Good"), 良品 ("Quality Goods"), 正宗 ("Original"), 鮮 ("Fresh"), 低脂 ("Low-Fat"), deluxe, best, top, extra, fresh, light, etc.

From the perspective of competition, it is highly possible that competitors in

the same trade will need to use such sign during the course of trade. If anyone is granted the right to exclude another's use, it will affect fair competition. Therefore, such sign can be registered only if there is evidence that it has acquired distinctiveness through use.

Disapproved cases:

- "植物素材" ("Plant Material") for lotions and essential oils.
- "推理式" ("Inference-style") for reference books and test question collections.
- "機能補給" ("Energy Supply") for drinks.

If a sign describes the important features of goods or services such as nature, quality or place of origin but such description is not true, it may confuse consumers and affect their wish to make the purchase. Such situation falls under the provisions that "a trademark may not be registered if it is likely to mislead the public with respect to the nature, quality, or place of origin of the designated goods or services." (Subparagraph 8 of Paragraph 1 of Article 30 of the Trademark Act) For instance, "LEATHER" for furniture made of synthetic leather will easily cause relevant consumers to purchase the furniture on the wrong assumption that it is made of leather; "梨山" (pronounced "Li-Shan") for fruits that do not originate from Li-Shan may cause consumers to purchase the fruits because they mistakenly believe that they come from Li-Shan. In consideration of consumers' rights and interests, such sign is not registrable.

If the description of a sign is not true but is unlikely to cause confusion about the nature, quality or place of origin of the goods or services and will not affect consumers' desire to purchase, such sign is deemed an arbitrary trademark. For instance, "LEATHER" for non-alcohol drinks will not cause consumers to believe that the drinks are made of leather; and "北極" ("North Pole") for bananas will not cause consumers to misidentify the bananas as originating from the North Pole. Both are arbitrary trademarks and can be registered.

A suggestive trademark is inherently distinctive, while a descriptive sign is not. A descriptive sign cannot be registered unless there is evidence that the sign has acquired distinctiveness. The distinction between the two types of trademarks is significant in law. However, it is not easy to distinguish between "direct description" and "suggestive description." The crucial factor for determination is whether the grant of registration of a trademark without any proof of its acquired distinctiveness is fair to other competitors. In different cases, the following factors may be considered:

(1) Level of imagination that consumers must exercise

A descriptive sign directly and clearly conveys the quality, function, characteristics and content of goods or services. Therefore, consumers can understand that such sign is descriptive of the goods or services without any imagination or thought. As to a suggestive trademark, consumers need more imagination and thought to understand its connection with the goods or services.

(2) Definition in dictionaries

The definition of a word or phrase provided in dictionaries is commonly accepted by the general public. Therefore, the definition of a sign in dictionaries may serve as the basis to determine the level of descriptiveness of such sign in the eye of the general public.

(3) Use in newspapers and magazines or on the Internet

The consumers' perception of specific terms, phrases or things can be understood with reference to the use in widely-circulated newspapers or magazines. Today, the Internet is a commonly used tool for transmitting information, and the amount of information available on the Internet exceeds that provided by the traditional media. Thus, the use of the term, phrase or thing on the Internet may be taken into consideration when examining a case. However, as the Internet is an environment freely accessible to the public, the accuracy and objectivity of the information thereon maybe

questionable, and such information must be cautiously employed.

(4) Competitors' need to use


How likely the competitors may need to use the same term, phrase or thing to describe the quality, function or other features of the designated goods or services is also one of the important factors that distinguishes a descriptive trademark from a suggestive trademark. In general, the more a sign is directly and obviously descriptive of goods or services, the higher the likelihood of the competitors in the same trade would need to use it. In such a case, the sign is deemed a descriptive sign. When the description provided by a sign is indirect and unobvious, competitors would less likely need to use it and such sign is deemed a suggestive trademark.

2.2.2 Generic marks or names

A generic mark is a sign that is commonly used by businesses in respect of specific goods or services, while a generic name is a name that is commonly used by businesses to denote the goods or services. A generic name also includes the shortened forms, acronyms and common nicknames. For relevant consumers, a generic mark or name is used by general businesses to denote or indicate the goods or services themselves and does not serve to identify the source. For example, "revolving neon light in red, blue and white" is a generic mark for hair salons; "開心果" ("Kai Xin Guo") is a common nickname for pistachios; "阿拉比卡 Arabica" is a variety of coffee tree. These marks or names cannot serve as the basis for identifying the source and are not registrable; otherwise, the exclusive right may affect fair competition or be used to initiate a suit to interfere with another's use of the same term.

Disapproved cases:


- "樓蘭磚" ("Loulan Tiles"), a kind of faux old brick, is a generic name for certain ceramic tiles and floor tiles.
- "雪花石" ("Snowflake Stone"), a kind of stone, is a generic name for certain artificial stone and natural stone.

- "TAPAS," a traditional Spanish bar or a Spanish dish to accompany wine, is a generic name for certain restaurant, beerhouse or pub services.
-  refers to prescription drugs that are prescribed by doctors and dispensed by pharmacists, and is a generic mark for medicine.

2.2.3 Other signs having no inherent distinctiveness

As indicated in these Guidelines, any single letters (4.2.1), model numbers (4.2.4), simple Arabic numbers (4.3), simple lines or basic geometrical patterns (4.4.1), ornamental patterns (4.4.2), surnames (4.6.1), combinations of titles and surnames (4.8.3), company names (4.9.1), domain names (4.9.4), common religious divinities, terms or signs (4.10), slogans (4.11.1), or common greetings, auspicious phrases or popular terms and idioms (4.11.2) cannot serve to denote source, are deemed signs having no distinctiveness and are not registrable.

Disapproved cases:

-  " " for wallets, leather bags, purses, etc. will easily cause consumers to consider it ornamental pattern on the designated goods and is not distinctive.
- "13" for dry ice cleaners and dry ice cleaner nozzles is a simple number and is not distinctive.
- "分享簡單, 幸福延伸" ("Share simplicity, extend happiness") for cold and hot beverage stores and snack shops is a common advertising slogan and is not distinctive.

2.3 Signs having acquired distinctiveness

A sign that has no inherent distinctiveness is not necessarily unregistrable. If the applicant can prove that such sign, after use on the market, is considered by relevant consumers a sign indicating and distinguishing a particular source, it is deemed to have trademark function and may be registered. As the

distinctiveness of such sign is acquired through use and not inherently invested in the sign, it is called acquired distinctiveness, or "secondary meaning." The "secondary meaning" refers to a meaning which is neither minor nor subordinate, but which occurs after the inherent meaning. When a sign having no inherent distinctiveness has acquired distinctiveness through use, for consumers, such sign has already been transformed into an indicator of the source, and this is how consumers mainly perceive the sign. If a trademark, which is a descriptive sign or any other sign that is devoid of any inherent distinctiveness, has been used by the applicant and has become, in trade, a sign capable of distinguishing the goods or services of the applicant, such sign has acquired "distinctiveness through use" and can be registered as a trademark. (Paragraph 2 of Article 29 of the Trademark Act)

Approved cases:

- "787", a simple number, is not distinctive. However, after the applicant has long used it as a trademark in connection with airplanes and their parts and fittings, aircraft and their parts and fittings, and helicopters and their parts and fittings, such sign has caused a sufficient number of relevant consumers to recognize it as a sign identifying the source of goods and has acquired distinctiveness through use.
- "4810," the height of Mont Blanc, the highest mountain in Europe, is not distinctive. However, after the applicant has long used it as a trademark in connection with fountain pens, ball point pens, pencils, felt pens, etc., and used it extensively in the advertising media, such sign has acquired distinctiveness through use.
- "V50" for cars, trucks and all-purpose RV cars gives an impression that it is the model number of the designated goods and is not inherently distinctive. However, after the applicant has long used it, relevant consumers are able to recognize it as a sign identifying the source of certain goods, so it has acquired distinctiveness.
- "Life should be wasted on beautiful things," which is irrelevant to drinks made from tea leaves or tea, coffee, drinks made from coffee,

cocoa and drinks made from cocoa, ice cream, etc., was not distinctive. However, after the applicant has long used it as a trademark in connection with aforesaid goods and used it extensively in the advertising media, such sign has acquired distinctiveness.



- The pattern is an ornamental pattern. The use of the pattern for department stores, supermarkets, etc., is not inherently distinctive. However, after the applicant has long used it as a trademark in connection with handbags, packaging bags, etc., such sign has acquired distinctiveness.

3. Factors for Determining Distinctiveness

Whether a trademark is distinctive should be determined on the basis of the facts and evidence of each case, the relation between the trademark and the designated goods or services, use by competitors in the same trade, the applicant's method of use and the actual trading situations.

(1) Relation between the trademark and the designated goods or services

To determine whether a trademark is distinctive, the relation between such sign and the designated goods or services should first be understood. When a sign conveys the information about the goods or services to certain extent, consumers will realize that such sign is only descriptive of the goods or services and will not consider it a sign identifying the source. In contrast, when a sign does not convey any information about the goods or services, consumers can easily realize that it serves to identify the source and will regard it a trademark.

For example, since "蘋果" ("Apple") for computer goods is irrelevant to the designated goods, it is distinctive because it identifies and distinguishes the source of specific goods. However, when "apple" is designated for use on apples, and since the term is the name of the designated goods, consumers will not consider it a sign indicating a particular source and the

term "apple" is thus not distinctive.

(2) Use by competitors

A descriptive term, phrase or thing often denotes the quality, function or other features of goods or services, and may also be used by other competitors to describe their own goods or services. The higher the degree of descriptiveness, the greater the possibility of use by competitors in the same trade is. Therefore, frequency of use by competitors in the same trade on the market can be used to determine the degree of descriptiveness of a particular term, phrase or thing. If a certain number of competitors have used a specific term, phrase or thing to describe the goods or services, it can be inferred that such term, phrase or thing is descriptive of the goods or services regardless of whether it is commonly used in the industry. For the sake of public good, a descriptive term, phrase or thing that simply provides information about goods or services should never be limited to exclusive use by a particular party. For the sake of fair competition in the industry, it is also improper for such term, phrase or thing to be monopolized by one party alone, thereby preventing competitors' free use thereof.

When a term, phrase or thing is not used by other competitors, it does not mean that it is not descriptive of the quality, function or other features of goods or services. As long as that the general and direct meaning of such term, phrase or thing as understood by relevant consumers is descriptive of the goods or services, the term, phrase or thing is not distinctive.

(3) Applicant's use and actual trading situations

If a trademark to be registered, as used by the applicant and in actual trading situations, is descriptive of goods or services, relevant consumers will not consider it as a sign indicating a specific source. For example, the indication "一人一鍋" ("One Pot Per Person") on the menu of shabu-shabu restaurants is meant to describe how the food is served and emphasize the safety and good hygiene of such method. Relevant consumers will not

consider such term a sign identifying a specific source.

Whether a trademark is distinctive depends on the perception of relevant local consumers. The so-called "relevant" consumers refer to consumers who have actual experience in purchasing or using the goods or services and potential consumers who may purchase or use such goods or services in the future. For example, as daily essentials are used by the public in their daily life, the relevant consumers should be the general public, while determination in connection to goods or services circulated among professionals should be based on the professionals' point of view. To determine whether a trademark is distinctive, the level of attention exercised by relevant consumers should be taken into consideration. In general, consumers will pay a higher level of attention to more expensive, professional or durable goods, such as luxury goods, high-tech products and medical products, than daily essentials.

4. Examination of Distinctiveness

A trademark may consist of any word, device, symbol, color, sound, three-dimensional shape or any combination thereof. Therefore, the examination of distinctiveness of a trademark should be based on observation of the entire trademark. When a trademark in its entirety is sufficient to cause relevant consumers to recognize it as a sign identifying the source of the goods, it is deemed distinctive even if it contains a non-distinctive element. The guidelines for examination of distinctiveness of common types of trademarks are explained as follows:

4.1 Words/Characters

Whether a word/character used as a sign identifying and distinguishing the source of goods or services is distinctive depends on the meaning thereof and the relationship between such word/character and the designated goods or services. When the word/character is not meant to describe the quality, function or other features of goods or services, or has little meaning in this regard, it should be deemed a word trademark having a higher level of distinctiveness. If the word/characters is a generic name of the designated goods or services, or is directly and obviously descriptive of their quality, function or other features, it is not distinctive.

The developer of new goods or services on the market may create a name for these goods or services. However, if such name is directly and obviously descriptive of the goods or services, it would be improper to grant exclusive right to use it since such name makes it easy for people to understand the nature of the goods or services or the technology involved; other competitors may also need to use such simple, obvious and direct description. Even though such name is created by the applicant first, it should still be deemed descriptive of the goods or services and thus is not distinctive. For example, "影音看屋" (pronounced "Ying-Yin-Kan-Wu"), which means "looking at a house on video," refers to a method of searching for houses of interest, obtaining all the basic information about them and looking at their inside and outside through a video output of them. It is a new kind of service provided by real estate agents. Such term is a simple, obvious and direct description of the service and may also be used by other operators in the trade in connection with services relating to leasing, selling, or purchasing of buildings and real estate. Even though such term was first created and used by the applicant, it should still be deemed descriptive of the designated goods or services and thus not distinctive. Also, the term "photo transport," or "照片傳輸" in Chinese, is a new technique to transmit the graphic files on computers to cameras for viewing. Because the term "photo transport" is a simple, obvious and direct description of the technology and may also be used by other competitors for goods relating to image and graphic transmission, even though it was first created and used by the applicant, it should still be deemed descriptive of the designated goods and thus not distinctive.

When a word/character is descriptive of goods or services, even when no competitor uses it to describe the goods or services, it cannot serve to prove distinctiveness, since the fact that the word/character is descriptive of the goods or services cannot be changed. For example, businesses in the cosmetic industry use "潤活極緻" ("Extremely Nurturing and Revitalizing"), "晶緻煥白" ("Delicate and White"), "鉑金滋養" ("Platinum Nutrition") and "保濕豔光" ("Moisturizing, Gorgeous and Bright") to emphasize the ingredient or effect of the goods. Even when no other competitor uses these terms, they are still deemed directly and obviously descriptive of the goods and consumers do not consider them signs identifying the source of

goods. Therefore, these terms are not distinctive.

4.1.1 Homophones

If a homophone makes such a new and unique impression on consumers that in addition to being descriptive, it serves to identify and distinguish the source of goods or services, it is deemed distinctive.

Approved cases:

- "贏養" (pronounced "Ying-Yang") for milk powder, animal milk, which is a homophone of "營養" ("nutrition").
- "海仙" (pronounced "Hai-Xien") for fish balls, fish paste, scallops, shelled fresh shrimps, shrimp meat, etc., which is a homophone of "海鮮" ("seafood").
- "超奈魔" (pronounced "Chao-Nai-Mo") for lubricant oil additives, which is a homophone of "超耐磨" ("super wear-resistant").



- " (pronounced "Jie-Ran-Bu-Tong") for cleaning rags, mops, brooms, feather dusters, scouring pads, in which the Chinese term "潔然不同" is a homophone of "截然不同" ("absolutely different").
- "Fun 心貼" (in which the Chinese characters are pronounced "Xin-Tie") for adhesive of three-dimensional decorative pictures, stickers, decorative plastic stickers, self-adhesive plastic patches for advertising purpose, etc., which is a homophone of "放心貼" ("Reliable Stickers").

Disapproved cases:

- "珍材食料" (pronounced "Zhen-Cai-Shi-Liao") is a homophone of "真材實料," but differs in meaning from the latter "真材實料," which means genuine material and substantive ingredient. However, as "珍材食料" somehow means precious food material, its use for restaurants and snack bars is still descriptive of the services as provided.

4.1.2 Dialects

To determine the distinctiveness of a trademark consisting of a term or phrase in a dialect that is familiar to local people, the meaning of the term or phrase in the dialect should first be understood, and then the connection between such meaning and the goods or services should be considered. If the trademark, as perceived by consumers, is still a generic name or relevant description of the goods or services or is otherwise not distinctive, it should be disapproved.

Disapproved cases:

- "尚甜 A" means "the sweetest" in Taiwanese and its use in connection with fresh fruits is directly descriptive of their quality and characteristics.
- "飼好豬" means "raising pigs of good quality" in Taiwanese and its use in connection with forage, bean cakes, livestock forage, etc., is descriptive of the quality of the goods.
- "青" means "fresh" in Taiwanese and its use in connection with beer, draught beer, etc., is descriptive of the quality and features of the goods.
- "冰角" in "台灣冰角" means "ice" in Taiwanese and its use in connection with ice, ice cubes and ice for refreshments is a generic name of the goods.

4.1.3 Foreign words

If a foreign word is a generic name or relevant description of the designated goods or services, the word is not distinctive. When a trademark to be registered consists of or contains foreign word(s), the applicant should specify the language and the meaning in Chinese in the column of trademark specimen in the application form. If the language is familiar to local people, such as English, it is easier to determine whether the word concerned is a generic name or relevant description of the goods or services. For a word in a language that is less familiar to local people, even if registration is granted because it is not found to be a generic name

or be descriptive of goods or services, it may still be subject to cancellation by opposition or invalidation proceedings when such word is later found to be unregistrable.

Disapproved cases:

- “Parfum” means perfume in French and its use in connection with perfume goods is a generic name of the goods themselves.
- “職人用” means exclusively for use by professionals and its use in connection with milk, milk liquid, fresh milk, cheese powder, fresh cream, etc., is descriptive of the quality or characteristics of the goods or their users.
- “徳用” means good quality at a bargain price in Japanese, and its use in connection with preserved fruits, chewing gums, tofu, fruit candy, etc., is to indicate the desirable quality and reasonable price of the goods bearing the trademark and is descriptive of the goods.
- “一番鮮” for beer, sodas, vegetable and fruit juice, Siwu drink, etc.: As “一番” means number one in Japanese, “一番鮮” means the freshest and is descriptive of the quality and characteristics of the designated goods.

4.1.3.1 Compound words

To determine whether a foreign compound word consisting of two descriptive words is distinctive, the entire compound word must be taken into account. If such compound word digresses from the descriptive meaning of the original words, thus giving consumers an impression different from the mere description of goods or services and thus serving to identify the source, it is deemed distinctive.

The local general consumers do not have as good a grasp of a foreign language as the native speakers thereof, and they are usually not familiar with the common usage of the language. Therefore, in principle, determination of the distinctiveness of a compound word should be based on relevant local consumers' comprehension. Generally speaking, if the

combination of two descriptive words resulting in no change to the original descriptive meanings of the words, that compound word is not distinctive. For example, when two words are combined without special change in grammar or meaning, such compound word will have the original descriptive meaning and is not distinctive.

Disapproved cases:

- "SCREENWIPE" is the combination of "SCREEN" and "WIPE." As a whole, the compound word does not create any meaning other than "screen wiping articles." Therefore, the use of the compound word on TV or computer screen wiping cloth is directly descriptive of the goods.
- "Nanofibre" is the combination of "nano" and "fibre." As a whole, the compound word means "nano fiber." Therefore, its use in connection with lurex, cotton yarn, artificial cotton yarn, acrylic yarn, etc., is descriptive of the material of the goods.
- "Flexhose," the combination of "flex" and "hose," means "flexible hose," and its use in connection with pipe joints, water pipe joints, three-way pipe joints, etc., is a generic name of the goods.

4.1.3.2 Words having several meanings

If a foreign word has several meanings, as long as any of the meanings is descriptive of, or is a generic name of, goods or services, it is not distinctive. For example, while "cell" can mean a small compartment, a single room usually for one person, one of the compartments of a honeycomb, a device for conducting electric current by chemical action, a battery, or a cellular phone, its use on batteries is a generic name of the designated goods and is not distinctive.

4.1.3.3 Incorrect spelling and customary spelling

If a foreign word comes from incorrect spelling of a generic name or description of the designated goods or services, and if the incorrect spelling only involves such minor change that consumers can still recognize it as

the generic name or description, such incorrect spelling is still deemed non-distinctive. For example, "MILLENIUM" and "MILENNIUM" are both incorrect spellings of MILLENNIUM; therefore, the use of such word on champagne and brandy will cause the public to associate it with "MILLENNIUM" (year 2000) and such word is descriptive of the vintage of the goods.

A common shortened form that replaces descriptive word(s) is not distinctive, either. For example, "TECH" is the customary spelling of "TECHNOLOGY"; "XTRA" is the customary spelling of "EXTRA"; "E", a shortened form for "ELECTRONIC", often refers to provision of goods or services involving electronics or electronic technology or by electronic means (i.e., online or on the Internet). When the entirety of a trademark containing this kind of word is descriptive of the designated goods or services, the trademark should be disapproved, for instance, "Hi-Tech" for clocks, watches, and wrist watches; "XTRA-SAFE" for transparent safety glass and reinforced glass; "e-book" for electronic books, electronic memory cards, electronic dictionaries, electronic notebooks, etc.

4.2 Letters



4.2.1 Single letters

Normally, a single, unadorned letter is unlikely to attract consumers' attention. Even if consumers do notice it, they will not consider it a sign that identifies and distinguishes the source of goods or services. Therefore, in principle, a single, unadorned letter is not distinctive, and will not acquire distinctiveness because of addition of simple decorative frame or border. However, if a letter is specially designed or combined with other distinctive elements so that the entire letter can identify and distinguish the source, it is distinctive.



A single, unadorned letter used on goods or services may be descriptive of the goods or services. For example, "A" for all kinds of goods signifies the best

quality; "S," "M," "L" or "F" signifies the sizes of clothes; "C" in connection to computer software refers to a programming language; "g" for various goods signifies a unit of weight.

Disapproved cases:

-  for welding rods, welding wires and welding bars
-  for massage devices and slimming devices

Approved cases:

-  for travel trunks, wallets and backpacks: Because "D" is stylized and digresses from the image of the usual single letter, it can identify and distinguish the source and is distinctive.
-  for cosmetics and body cleaners: Because "Z" is combined with another distinctive device, the trademark as a whole is distinctive.

4.2.2 Two or more letters

A sign consisting of two or more letters is in principle distinctive and registrable as long as it is not descriptive or a generic name of the designated goods or services.

Approved cases:

- "SR" for herbal beverage preparations and mouth fresheners
- "SYM" for motorcycles and their parts and fittings

Disapproved case:

- "XXL" means extra large or extra, extra large. When it is used in connection with knee protectors and elbow protectors, consumers will regard it indication of the size of the designated goods or description of the extra large size of the goods, rather than a sign identifying and distinguishing the source.

4.2.3 Acronyms

Where a sign consisting of a combination of letters is a generic name of goods or services used in the trade, or an acronym describing the quality, function or other characteristics of the goods or services, it is not distinctive no matter how many letters it consists of.

Disapproved cases:

- "TFT" is an acronym of Thin-Film Transistor, and its use in connection with computer liquid crystal displays, LCD TVs, liquid crystal displays, etc., is descriptive of the material of the designated goods.
- "DIY" means Do It Yourself and its use in connection with snack bars, ice and fruit shops, restaurants, etc., means self-service, so it is descriptive of the designated services.
- "ABM" is an acronym of "Agaricus blazei Murrill" (a scientific name of Agaricus), and its use in connection with nutritional supplements, nutritional supplemental capsules and mushroom capsules is descriptive of the ingredients of the designated goods.

4.2.4 Combinations of letters and numbers

In general, a combination of letters and numbers will give consumers the impression that it refers to the specification, type or other particulars of goods or services. For example, "4WD" for cars, which means four-wheel transmission, "MP3" for music players, which means third-generation MPEG compressed format of sound file, and "512MB" for memory sticks, which signifies memory capacity, all refer to the specifications of the goods and thus are descriptive of the goods and not distinctive. However, if a combination consisting of letters and numbers can be determined to be not descriptive of the specification, type or such other details of the designated goods or services, the combination may be registered as a trademark. Otherwise, the applicant should be required to submit materials relating to how the trademark is used and explain its use in the industry to facilitate the determination of whether it is distinctive.

Disapproved cases:

- "3C," which stands for computer, communication and consumer electronics, is an acronym and its use in connection with computers is descriptive of the goods themselves.
- "RCA123A," which refers to the specification of rechargeable lithium batteries commonly used in the industry, is descriptive of the specification of the designated goods, "batteries."
- "LU-933" for automatic cutting and boarder edging machines gives the impression that it refers to the model number of those goods. Further, the applicant failed to provide any use material. Therefore, the trademark was disapproved on the grounds of non-distinctiveness.
- "KX-3" for paint spraying guns, compressed air dust-blowing guns, painting machines, etc., gives the impression that it refers to the model number of those goods; moreover, as shown in the product catalogues and promotional materials provided by the applicant, the trademark is used to refer to a type. Therefore, the trademark was disapproved on the grounds of non-distinctiveness.

Approved case:

- "SKII" for cosmetics: Because cosmetics manufacturers normally do not use the specification or a model number to identify the goods and because "SKII" is not descriptive of other goods, the trademark is distinctive.

4.3 Numbers

Although a simple number is not excluded from the scope of registrable trademark, under common practice, numbers are often used in labeling in many fields to indicate production date (1996.01.01), size (24 for shoes, 185/65 for tires), quantity (130 for pop-up tissues), year (1950 for wine), telephone area code (0800, 0204), time (8-10, 24/7), power (115 for horsepower of engines or cars), memory transmission speed (266, 333, 550, 667), type of nickel-chromium-barium stainless steel (316), etc. Therefore, general consumers will not normally consider a number a sign identifying and


distinguishing the source. In principle, a simple number is not distinctive. However, when examining a number represented by Chinese character, the examination principles regarding words/characters should be applied.

When a number is stylized or is used to imply the designated goods or services or their quality, function or other characteristics in such a way that it digresses from the original meaning of a simple number and serves to identify and distinguish the source, it is distinctive.


Disapproved cases:

- "315" for yamaimo (also known as Chinese yam) powder and mixed cereal fiber powder gives the impression of a simple number, instead of a sign identifying the source; thus, it is not distinctive.



-  for leather bags, leather trunks, handbags, purses, etc.: Although it is placed against a black circle device, the simple number "57" still gives the impression of a simple number rather than a sign identifying the source. Therefore, it is not distinctive.

Approved cases:

- As , which is a stylized design of "333," is not descriptive of sodas, carbonated fruit juice, carbonated water, soda water, etc., it is distinctive.
- "566" sounds similar to "烏溜溜" ("black and shiny," pronounced Wu-Liu-Liu). Its use in connection with shampoo powder and shampoo implies that the products will leave the hair black, smooth and silky, so the trademark is distinctive.

4.4 Devices


A device is a common form of trademark and is usually distinctive. However, when a simple line, basic geometrical device or ornamental pattern is placed on articles relating to goods or services, normally it is not considered a sign identifying and distinguishing the source of goods or services and is not

distinctive. When a device is descriptive of, or is a generic mark of, the designated goods or services, it is not distinctive, either.

4.4.1 Simple lines or basic geometrical patterns

When a simple line or geometrical pattern is used on goods or services, usually it is unlikely to attract consumers' attention. Even if consumers notice it, they will not consider it a sign identifying and distinguishing the source of goods or services. Therefore, such simple line or geometrical pattern is not distinctive.

Disapproved case:


-  is a simple line and its use in connection with leather bags, backpacks, fanny packs, rucksacks, clothing, jackets, rain coats, swimsuits, beach suits, T shirts, etc., cannot serve to identify the source. Therefore, it is not distinctive.

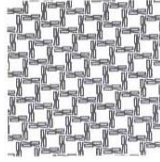
4.4.2 Ornamental patterns

A device consisting of various continuous and infinitely extendible patterns, natural objects such as flowers and grass, or geometrical shapes is likely to be considered an ornamental pattern of goods or the background or ornamental pattern of goods packaging. Normally, such device is not used as a sign that identifies and distinguishes the source of goods or services, and thus is not distinctive.

Disapproved cases:



-  for plates gives the impression that it is an ornamental pattern on the plates rather than a sign identifying the source. Therefore, it is not distinctive.



- for girdles, mufflers, hats and gloves gives the impression that it is an ornamental pattern on the goods rather than a sign identifying the source. Therefore, it is not distinctive.



- for bed spreads and bed sheets gives the impression that it is a pattern design on the goods rather than a sign identifying the source. Therefore, it is not distinctive.



- for agricultural chemicals, insecticides, and weedicides: Since the use materials submitted show that the pattern is the background of the goods packaging, it is not distinctive.



4.4.3 Images of goods

The shape of goods or a device showing important features of goods is descriptive of the goods themselves. Even if such shape or device has long been used, it cannot acquire distinctiveness. In contrast, if a shape or device is specially designed so that it digresses from the mere description of the goods and serves to identify and distinguish the source, it is distinctive.




When a trademark, containing a device or a picture of appearance of goods or a device that is very resemblant to the important features of the shape of goods, especially a device that is apparently lack of designing idea, is applied for registration but the entire trademark is distinctive, if the inclusion of that element in the trademark does not give rise to doubts as to the scope of the trademark rights, such application for registration can be

accepted without any disclaimer.

Disapproved cases:

-  for book satchels refers to the shape of the goods and thus is descriptive of the goods.
-  面膜達人 for cosmetics refers to the shape of the facial masks and thus is descriptive of the goods.

Approved cases:

- Because  for aquatic products (alive), crabs, crabs (alive), etc., digresses from the original shape of crabs, it is no longer descriptive of the goods and is thus distinctive.
- As the special personified design, , is no longer the simple image of a key and digresses from the mere description of the goods, its use on locks, door bolts, keys, springs, screws, hinges, key rings, etc., is distinctive.
-  for pull screws, nuts, caps, wing-style nuts, square nuts, triangle nuts, etc.: Because the screw device of the trademark is specially designed and is divided into two parts, it is distinctive and can be registered.

4.4.4 Devices relating to the description of goods commonly used in the industry


Some industries frequently use certain devices on the packaging of their goods. For example, a dairy cattle device is often seen on

the packaging of dairy products in Class 29, a tea leaf device on the packaging of tea beverages in Class 30, a pet device on the packaging of animal feeds in Class 31 and a fruit device on the packaging of juice in Class 32. These devices are frequently used by the relevant industries to refer to the content, nature or function of the goods. Therefore, a mere picture of specific objects or a realistic, non-stylized drawing of the real objects gives the impression that it is simply descriptive of the goods and does not serve to identify and distinguish the source.


When an applicant applies for registration of a trademark which includes a picture of a specific object that is frequently used in the industry or a device that resembles the real object, but which in its entirety is distinctive, the inclusion of that element in the trademark could give rise to doubts as to the scope of the trademark rights, the applicant shall state that he/she disclaims any exclusive right to such element; if the device is so complicated that it is difficult to disclaim the individual parts, the trademark can be registered only when the applicant disclaims any exclusive right to all the words and devices other than X.

Disapproved cases:

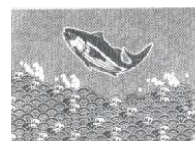


- The tea-oil camellia device  is commonly used on the packaging of tea oil, and its use in connection with edible oil, edible fat, and tea oil is descriptive of the designated goods.



- The ginseng and leaves device  is commonly used on the packaging of ginseng goods, and its use in

connection with ginseng tea is descriptive of the ingredient of the goods.



- The device of fish leaping out of sea is commonly used on the packaging of marine products, and its use in connection with sliced katsuobushi, shredded katsuobushi, dried fish products, fish balls, etc. is descriptive of aquatic products or marine products.

Approved case:



- 松村燻之味 for stewed chicken wings, chicken claws, chicken or duck legs, duck livers, etc.: Because the poultry device in the trademark is stylized and far from similar to the real object, the trademark is distinctive and can be registered.

4.5 Geographic designations or other signs indicating a geographic origin

A geographic designation refers to the name of a geographic region on earth, including man-made divisions such as country, province, county, city and street, and natural landforms such as ocean, river, lake, mountain and desert. If a map, the contour of a specific geographic region or any other sign represents a particular geographic region to general consumers, the examination principles regarding geographic designations should apply to the examination of distinctiveness thereof.

4.5.1 Descriptive geographic designations


When a geographic designation that is familiar to consumers is not famous for the production of certain goods or the provision of certain services and merely indicates a geographic location, its use in connection with goods or services will give the impression that it describes the connection between the

goods or services and that geographic region, i.e., indicating the place of manufacture, place of production or place of design of goods, the business source of goods or services, or the place of provision of services. Such geographic designation is not a sign identifying the source. For example, a country or big city is often the place where all kinds of goods and services are provided, gathered, traded or exchanged, so the use of the name of a country or big city on goods or services will make consumers regard it as being descriptive of the goods or services and thus is not distinctive. If a geographic designation to be registered is famous for the production of certain goods or the provision of certain services, consumers will be more likely to associate such designation with the place of origin and to regard it as being descriptive of the place of production.

Disapproved cases:

- "花東" (pronounced "Hua-Dong") is a famous rice-producing region, and will cause relevant consumers to think that the rice products originate from that region. Because the rice goods designated for the trademark indeed originate from that region, the trademark is descriptive of the place of origin.
- "南陽街" ("Nan-Yang Street") is a famous cram school street. The use of such name on cram school services will cause relevant consumers to think that the cram school services are provided on that street, and is descriptive of the place of provision of services.



-  is the contour of Taiwan, so its use in connection with mixed plant beverages, herbal tea, etc., will cause consumers to think that the designated goods originate from Taiwan, and is descriptive of the place of origin.

4.5.2 Arbitrary geographic designations

If a geographic designation has no connection with the designated goods or services at all and consumers will not consider it as indication of the place of origin of goods or the place of provision of services, or as description of the

connection between the goods or services and that place, such use is deemed arbitrary use of a geographic designation and is distinctive.

Approved cases:

- 玉山 ("Jade Mountain") is the highest mountain in Taiwan and in northeast Asia. As the consumers perceive it, the name has nothing to do with banking services and no association between them can be established. Therefore, such trademark makes arbitrary use of a geographic designation and is distinctive.
- "北極" ("North Pole") is located in the Arctic Ocean, where no land is available and no industrial production is conducted. The use of the term on paints and coatings will not cause consumers to believe that these goods are produced in that region. Such trademark makes arbitrary use of a geographic designation and is distinctive.
- "撒哈拉" ("Sahara") is the name of a famous desert where the weather condition is harsh and has few production activities except for mining. The use of the geographic designation on juice and aerated water will not cause consumers to believe that the designated goods are produced in that region. Such trademark makes arbitrary use of a geographic designation and is distinctive.

4.5.3 Old and rare geographic designations

When an old geographic designation no longer serves to identify a geographic source because of non-use for a long time, consumers will not associate it with the origin of the goods or services, and it is distinctive. However, some old geographic designations are still used or familiar to the public even though the places have been officially renamed, such as Ceylon (currently known as Sri Lanka), Leningrad (currently known as Saint Petersburg), 滬尾 (pronounced "Hu-Wei", old name for Danshui), 艋舺 (pronounced "Meng-Jia", old name for Wan-Hua), 漢城 (Seoul, currently known as "首爾"). Although these names are old geographic designations, for consumers, the geographic association is strong and they still can serve to indicate the geographic source of the goods. Therefore, the examination principles

regarding general geographic designations should apply to the determination of the distinctiveness of these terms. As to a rare geographic designation that has no geographic association for consumers, because it does not serve to identify a geographic origin, it is distinctive.

Approved case:

- "林鳳營" (pronounced "Lin-Feng-Ying") is a rare geographic designation and is not recognized by general consumers as such. Therefore, its use in connection with milk and goat milk is distinctive.

Disapproved cases:

- "諸羅" (pronounced "Zhu-Luo") is the old name for Jiayi County, but today some people still know that it refers to Jiayi County. Therefore, its use in connection with preserved meat and smoked meat will easily cause consumers to regard it as being descriptive of the origin of the designated goods.
- "打狗" (pronounced "Takao") is the old name of Kaohsiung, but today the public still knows that it refers to Kaohsiung. Therefore, its use in connection with candy, chocolate, moon cakes, biscuits, green bean cakes, etc. will easily cause consumers to regard it as being descriptive of the origin of the designated goods.

4.5.4 Combinations of words/characters containing a geographic designation

If a combination consisting of a geographic designation and other words/characters digresses from the description of connection between the goods or services and that geographic region, it is distinctive. If the combination in its entirety is still descriptive of the goods or services, it is not distinctive.

Approved case:

- "巴黎男孩 PARIS BOYS" for clothes: As "巴黎" ("Paris") is a city famous for its fashion industry, the use of "巴黎" on clothes would fall

under the grounds for refusal on being descriptive of the place of origin goods or being likely to mislead the public as to the place of origin of the goods. However, as "巴黎男孩 PARIS BOYS" as a whole digresses from the geographic association of Paris but implies fashion or fashion-conscious men, it is distinctive.

Disapproved case:

- "東京本舖" ("Tokyo Ben-Pu") for toast, cake and bread: As "本舖" ("Ben-Pu") means the founder store, the combination of "東京" ("Tokyo") and "本舖" on the aforesaid goods will easily cause consumers to consider that these goods or the manufacture techniques come from Tokyo. Since "東京本舖" as a whole does not digress from the indication of a geographical region, it is still descriptive of the designated goods.

4.5.5. Geographical certification marks or geographical collective trademarks

Where the application for registration of a geographic designation or a sign denoting a geographic source complies with relevant requirements, it may be registered as a geographic certification mark or a geographic collective trademark. The requirements for and examination of such applications are subject to the Examination Guidelines on Certification Marks, Collective Trademarks and Collective Membership Marks formulated by this Office.

4.6 Surnames, names and portraits

When a surname, name or portrait is used as a trademark, because the protection for personality right of a natural person is involved in addition to the distinctiveness issue, special attention must be paid to the examination thereof.

4.6.1 Surnames

A surname used on goods or services is usually the principal's surname rather than a sign identifying the source. When other competitors use the same surname, relevant consumers will be unable to identify the source by such surname. From the perspective of competition, different competitors in the

same trade having the same surname should be free to use their own surname, regardless of when they enter the market. In principle, use of a surname as a trademark is not distinctive. Such trademark can be registered only if there is evidence that it has acquired distinctiveness. Terms and phrases consisting of a surname in combination with "氏" ("clan" or "family," pronounced "Shi"), "家" ("family," pronounced "Jia") or "記" ("store," pronounced "Ji") still have the implication of a surname and are not different from use of the surname itself; hence, the principle for determination of distinctiveness should apply. If a surname in combination with other words/characters digresses from the meaning of a mere surname, it is registrable.

Disapproved cases:

- "羅氏" ("Luo Clan") for snack bars is use of a mere surname and is not distinctive.
- "翡翠張" ("Jade Zhang") for emerald, gemstones, jade and jewelry mainly refers to a surname and thus is not distinctive.
- "周氏泡菜" ("Zhou's kimchi") for kimchi does not digress from the meaning of a mere surname and thus is not distinctive.

Approved cases:

- "鬍鬚張" ("Bearded Zhang") for fast food stores and restaurant services: Although "張" is a surname, "鬍鬚張" denotes a Mr. Zhang with a large beard. Such imagery digresses from the meaning of the surname itself and is distinctive.
- "黑面蔡" ("Black-Face Cai") for juice and star fruit juice products: Although "蔡" is a surname, "黑面蔡" denotes a Mr. Cai with dark skin. Such imagery digresses from the meaning of the mere surname itself and is distinctive.

4.6.2 Names


In principle, names are distinctive. As long as the name to be registered is not the well-known name, stage name, pseudonym, or alternative name of

another person (Subparagraph 13 of Paragraph 1 of Article 30 of the Trademark Act) and does not apply to other grounds for refusal, it is in principle registrable. When a name is expressed in a signature form, the examination principles regarding names apply to determination of its distinctiveness.

Approved cases:

- "陳耀寬" (pronounced "Chen Yao-Kuan") for cosmetics, body cleansers, perfumed soaps, bath gels, etc.



- , which is the signature form of a name, for barbecue, meat cubes, meat floss, jerky, thin sliced meat, sausages, etc.

When the name of a famous person in history may be related to the content of the goods or services, it will easily cause relevant consumers to make an association and regard it as being descriptive of the goods or services. For example, "唐太宗" (an emperor of the Tang Dynasty) or "莊子" ("Zhuang-Zi") for VCDs in Class 9 or books in Class 16 will easily cause the public to consider that the VCDs or books include stories about "唐太宗" or "莊子" or their life (Subparagraph 1 of Paragraph 1 of Article 29 of the Trademark Act); therefore, the application for registration should be refused. Where the general public can associate the alias or title of a famous person in history with that specific person, the examination principles regarding the person's name apply to the examination of distinctiveness thereof.

The vivid image of a famous person in history can often serve the purpose of moral education. If its use in connection with the designated goods or services results in a disrespectful or offensive association which will disturb public order or good customs, the trademark is not registrable. (Subparagraph 7 of Paragraph 1 of Article 30 of the Trademark Act)

4.6.3 Portraits

Portraits are highly distinctive. When the applicant applies for registration

of his/her own portrait as a trademark, such application, in principle, should be granted.

An application for registration of another person's portrait as a trademark falls under the ground for refusal (Subparagraph 13 of Paragraph 1 of Article 30 of the Trademark Act), which aims to protect an individual's portrait right. However, the provision does not apply if the person is deceased. The "another person's portrait" is not limited to a famous work and includes a portrait that is expressed in a cartoon or other artistic forms as long as the person portrayed can be identified. However, the application of this article may be precluded when the applicant provides a letter of consent issued by that person.

Approved cases:



- for cyber shopping and retail of various foods: As the applicant is the owner of the portrait right, the application was granted.



- for medicine for humans and nutritional supplements: The owner of the portrait right has agreed the application to register her portrait and her name "林秋香" as a trademark.

Both portrait and name serve to identify a specific person. Therefore, the examination of portraits of famous people in history should be subject to the examination principles regarding the names of famous people in history (Article 4.6.2 herein).

4.6.4 Names of well-known characters in books, movies, play, etc.

For consumers, the name of any well-known character in a book, movie, play, etc., such as Lin Dai-Yu and Jia Bao-Yu in *Dream of the Red Chamber*,

Song Jiang in *Water Margin*, Tang San-Zan and Sun Wu-Kong in *The Journey to the West* and Scarlet O'Hara in *Gone with the Wind*, refers to that specific character only. The use of such name in connection with posters, photographs, figurines, movies, video tapes, CDs, books, costumes, TV programs, and stage performance will easily cause relevant consumers to regard it as descriptive of the content of the goods or services and thus is usually not distinctive.

Fictional characters in currently popular novels, movies, TV programs or stage plays often become well-known as a result of the circulation or dissemination of the works. If the name of such fictional character has created a vivid impression in the minds of consumers and are thus capable of identifying the source, such name is distinctive, and the copyright owner or any party with the copyright owner's consent can apply to register it as a trademark. Any trademark application filed by a person who is not the copyright owner or does not have the copyright owner's consent may confuse consumers with respect to the source or dilute the distinctiveness of the name, and is not registrable. (Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act)

4.7 Titles of well-known books, stories, plays, movies, songs or musical works, etc.

For consumers, the name of a well-known book, story, play, movie, song or musical work, etc. refers to that specific work only. When such name is used in connection with audio tapes and video tapes in Class 9, books in Class 16, toys in Class 28, retail of books and video tapes in Class 35, TV broadcasting and radio broadcasting in Class 38, or production and distribution of programs, movie films, audio tapes and CDs and publication of books and magazines in Class 41, it will easily cause relevant consumers to regard it as being descriptive of the content of the goods or services and thus is usually not distinctive.

For example: Use of Legend of the White Snake (白蛇傳), Bao Zheng (包青天), *The Journey to the West* (西遊記), *Jane Eyre* and *The Lady of the Camellias*, which are well-known folk stories, novels and plays, on stage plays, movies, TV programs, radio programs, movie films, video tapes and LDs; or use of "Silent Night" and Beethoven's 5th Symphony, which are well-known song and musical

work, respectively, on records and sound tapes is not distinctive because the connection between the titles of those works and their content are deeply rooted in the minds of the public. Use of these titles in connection with the above-mentioned goods or services will make consumers associate them with the particular works and regard the trademarks as being descriptive of the content of relevant goods or services.

Video games are often based on adaptation of well-known novels or stories. Therefore, the use of the title of a well-known novel or story for video game cartridges, magnetic cards and CDs in Class 9, toys in Class 28, online games in Class 41 and computer programming in Class 42 will give the impression that it is descriptive of the content of the goods or services, and thus is not distinctive.

Disapproved cases:

- "The Wizard of Oz," which is a well-known children's story, for magnetic data carriers recording computer game programs, optical data carriers recording computer games, computer programs, electronic games adapted with computers, TV video games, etc., gives the impression that it is descriptive of the content of the goods.
- "The Journey to the West," which is a well-known folk tale in China, for cassette tapes for computer programs, TV video games, etc., gives the impression that it is descriptive of the content of the game programs recorded in the magnetic tapes and of the TV video games.

Popular books, movies, plays, etc., often become well-known as a result of the dissemination of the works. In particular, nowadays a popular book or drama is often adapted into a movie, and a box office hit often has many tie-in products. If, after extensive use, the title of a work has created a vivid impression in the minds of consumers and is capable of denoting the source, it is distinctive. Under such circumstances, the copyright owner or a party with the copyright owner's consent can apply to register such title as a trademark. Any application filed by a party who is not the copyright owner or does not have the

copyright owner's consent may confuse consumers with respect to the source or dilute the distinctiveness of the mark, and is unregistrable. (Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act)

The use of common literal descriptions of the content of a book, magazine, film, TV program or radio program as a trademark in connection with these goods will give the impression that it is descriptive of the content thereof. Moreover, other authors may also need to use the same or similar descriptions as the title of a book or magazine. Therefore, it is inappropriate for one party to register such descriptions for exclusive use.

Disapproved cases:

- "五行生肖姓名學" (*"Fortune-telling with Names Based on Five Elements and Chinese Horoscope"*) or "顛覆姓名學" (*"Unorthodox Fortune-telling with Names"*) for books and magazines will give the impression that it is descriptive of the content of the goods.
- "空間大改造" (*"Space Reform"*) for magazines and books gives the impression that it is descriptive of the subject or content of a magazine or book.

The title of a work is normally used to denote a particular work, rather than a specific business source. For example, because the title of a book is used to denote a particular literary work, consumers will not associate it with a particular business source; such title is not distinctive because it does not identify and distinguish the source. In practice, some applicants apply to register the title of a work as a trademark in connection with books. Although such trademark registration may be granted because the actual use of the trademark cannot be known when the case is examined, it is still not trademark use if the trademark owner only uses it as the title of the work after it is registered.

As for periodical publications such as magazines and newspapers, or a series of works that are released under the same title such as comic books or TV drama, because the content of the works differs and consumers may use the

same title to identify them as works originating from the same source, their titles are, in principle, distinctive. For example, as each volume of the comic book entitled "老夫子" ("Master Q") or "澀女郎" ("Pink Lady") is a separate and complete creation but with the same characters, consumers can use the title to identify the series. Hence, the use of the title as a trademark is distinctive.

If any of the two or more titles/subtitles of a book is used on a series of works for the promotion thereof and has digressed from its function as the title of the book and created an independent business impression that enables consumers to recognize it as a sign for the series, the title/subtitle is distinctive. When judging whether the title of a book creates an independent business impression, whether the title is used in different font, color or size or used separately from other titles of the book should be considered. For example, there are seven volumes in the book series entitled "Harry Potter" and each volume features the title "Harry Potter" in a larger font and special design and separated from other subtitles; as the common title of the works, it is used to promote the series. Thus, the title has become a sign denoting that book series, and is distinctive.

4.8 Titles of individuals

A title is used to address a person, including respectful forms of addressing ordinary people such as Mr. (Mister), Mrs., Ms, and Miss, which are deemed non self-laudatory titles, and respectful forms of addressing professionals such as 醫生 (medical doctor), 博士(doctor), 職人(shokunin, Japanese for "professional"), 達人 (tatsujin, Japanese for "expert"), 高手 (expert), 專家(expert), 〇〇王 (xx King), 師傅 (master), 師父(master), 大師(maestro), Master, Doctor or Dr., which are deemed self-laudatory titles.

4.8.1 Non self-laudatory titles of individuals

For a trademark to be registered that consists of the name of goods or services or literal description in conjunction with any non self-laudatory title such as Mr. and Miss, if it creates a personified effect that is enough to make the trademark digress from the concept of a pure name of goods or services, it is

distinctive. In contrast, if such combination is still descriptive of the goods or services as it does not create any personified effect and does not digress from the descriptive function of the goods, it is not distinctive. For example, "美麗小姐" ("Miss Beauty") for cosmetics, clothing and accessories, or "健康先生" ("Mr. Health") for medicine for human, nutritional supplements, etc., is not distinctive as it still gives the impression that it refers to a beautiful lady or a healthy gentleman.

- Approved cases:
"MR. Antislip 防滑先生" for retail of construction materials: Although "防滑" (anti-slip) is descriptive of the feature of construction materials, the personified effect of "防滑先生" (Mr. Antislip) makes it a suggestive term that implies the antislip feature of the construction material, and thus is distinctive.
- "Mr. CARE" for hospitals, dental clinics and dental medical services: "Care" is what is generally required of quality medical services, and suggests the quality or feature of the medical services provided; thus, the trademark is distinctive.

4.8.2 Self-laudatory titles of individuals

A self-laudatory title used along or in combination with the name or literal description of goods or services gives the impression that it promotes the goods or services by denoting the quality or professionalism, is deemed descriptive of the goods or services, and is not distinctive.

Disapproved cases:

- "健康博士" ("Doctor Health") for provision of health planning consultation services for others gives the impression that it is a self-laudatory term used by health experts, and thus is descriptive of the designated services.
- "料理職人" ("Cuisine Professional") for cooked fruits and vegetables, instant prepared seafood packs, vegetable soup, ready-to-eat

seafood soup, etc.: As "職人" (shokunin) means professional, use of such term as a trademark on the aforesaid goods gives the impression that the goods are prepared and provided by professional cooks; thus, such term is descriptive of the goods.

- "租屋達人" ("House Leasing Expert") for leasing of real estate gives the impression that the service provider is an expert in house rental services; thus, the term is descriptive of the services.
- "空調高手" ("Air-conditioning Expert") for air conditioners, ventilation machines, air cleaners, air purifiers, cold and hot air conditioners, etc., gives the impression that it describes the quality of the goods and the professionalism of the manufacturer; thus, it is descriptive of the goods.
- "去皮專家" ("Peeling Expert") for vegetable and fruit peeling machines is descriptive of the goods.
- "字彙王" ("Vocabulary King") for dictionaries and handouts gives the impression that it refers to the extensive vocabulary in the goods; thus, it is descriptive of the goods.
- "好師傅" ("Good Master") for leather shoes, sandals and sneakers gives the impression that it refers to the quality of the goods; thus, it is descriptive of the goods.
- "高山茶師父" ("High Mountain Tea Master") for tea, black tea, green tea, etc., gives the impression that it refers to the quality of the goods and the professionalism of the manufacturer; thus, it is descriptive of the goods.
- "紙巾大師 WIPES MASTER" for facial tissue, paper towels, cosmetic puff, wipes, etc., gives the impression that the manufacturer is a tissue expert; thus, it is descriptive of the goods.

"世家" ("a family with generations of...") refers to not only a family which has been powerful or enjoyed a high social rank for generations, but also a family business which has thrived for generations, which has the implication of quality and professionalism. The term is similar to a self-laudatory title and thus is subject to the same examination criteria.

Disapproved cases:

- "饅頭世家" ("Steamed Bun Family") for pies, steamed buns, onion cakes, etc., gives the impression that the production method comes from one's ancestors; thus, it is descriptive of the goods.
- "砂鍋世家" ("Casserole Family") for restaurants and snack bars gives the impression of high-quality or professional casserole foods; thus, it is descriptive of the goods.

4.8.3 Combinations of titles and surnames

In a combination of a title and a surname, the emphasis is still on the surname, and its distinctiveness should be determined on the basis of the guidelines for examination of surnames (see Article 4.6.1).

Disapproved case:

- "許醫師" ("Dr. Xu") for Chinese medicine, western medicine and medical nutritional goods: As the Chinese character "許" (pronounced "Xu") is a surname, its combination with the term "醫師" ("doctor") still refers to a surname and thus is not distinctive.

4.9 Names of companies, stores (shops), groups, organizations and institutes and domain names

In practice, there are many applications for registration of the name of a company, firm, group, organization, institute or domain name as a trademark. Determination of distinctiveness of such name depends on the nature of the name:

4.9.1 Names of companies

As generally understood, a company name usually denotes the business entity, i.e. the goods manufacturer or the services provider. A company name is normally placed next to the company's address and telephone number. In addition, a company usually uses a trademark that may be either identical to its company name or a part thereof on goods or services in a conspicuous manner as the sign identifying the source of the goods or services. Although both

company name and trademark serve to identify the source, from consumers' perspective, one identifies the business entity while the other identifies the source of goods or services. Therefore, they are still different in the function and purpose of identification. As the source of general goods or services is identified by a trademark rather than a company name, the full name of a company, in principle, has no trademark distinctiveness. If a trademark incorporates a simple company name as a part thereof but is distinctive in its entirety, the trademark is registrable only when a disclaimer of the company name is made. However, if the applicant is able to provide relevant materials to prove that the company name is used as a trademark and such use can make general consumers recognize it as a sign identifying the source, such company name is registrable.

Many businesses use part of their company names as their respective trademarks. A registered trademark incorporating part of a company name is, in principle, distinctive. When a trademark to be registered is the full name of a company and a part of the company name is specially designed so that the entire trademark digresses from the concept of a business entity, this shows that the applicant has the intention of using the name as a trademark and that consumers can recognize that sign as a trademark. Such a trademark is distinctive and registrable with a disclaimer of exclusive use of the non-distinctive part.

Where the reproduction of a trademark contains an element which is not distinctive,

The applicant shall state that he/she disclaims any exclusive right to the element, which is not distinctive and gives rise to doubts as to the scope of the trademark rights, before the acceptance of registration.

Disapproved case:

- "馥立股份有限公司" ("Fu-Li Co., Ltd.") for cosmetics and skin care products is not distinctive.

Approved cases:

The logo for ARISTO Technology Corp. features the word "ARISTO" in a bold, yellow, sans-serif font.

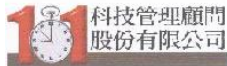
葛飛科技股份有限公司
ARISTO Technology Corp.

- for webpage design, agency of importing network lines and apparatus, and retail of network lines and apparatus: As the entire trademark is distinctive, the application for registration is acceptable after the applicant state that he/she disclaims any exclusive right to the company names of the applicant in Chinese and English "葛飛科技股份有限公司" and "ARISTO Technology Corp."



TRANSCENDENCE
先驗文化事業股份有限公司

- for publication and issuance of various books, publications, magazines and literature: As the entire trademark is distinctive, the application for registration is acceptable after the applicant state that he/she disclaims any exclusive right to the company name of the applicant "先驗文化事業股份有限公司".



- for employment agency, manpower intermediary services, recruitment of personnel for others and personnel recruitment services: "101 科技管理顧問股份有限公司" is a company name, in which "101" is separated from the remaining parts, "0" is stylized into a stop watch device and "1" is emphasized in red, thus giving the impression that the sign is used as a trademark. "科技管理顧問股份有限公司" is a description of the type of business and the organization of the company which does not give rise to doubts as to the scope of the trademark rights. The application for registration is acceptable without any disclaimer.

4.9.2 Names of stores (shops)

Names of stores come in various forms and do not have a consistent appearance. Unless a term indicating the nature as a store is used, such as "行" (pronounced "Hang"), "號" (pronounced "Hao") and "商行" (pronounced "Shang-Hang"), it is impossible to know the name of a store as such. This makes store name different from company name as the latter indicates the type of the company and is thus easier to identify. Article 27 of the Business

Registration Act provides, "A business may use the name of its statutory representative or other name as its business name, but not a name which is likely to mislead the public into associating it with a government agency or a public welfare organization. If a business uses the surname or full name of one of its partners and intends to continue using it when the partner leaves, it shall obtain his/her consent to such use." Therefore, a business name has not fixed form.

Generally speaking, a store mainly provides services; the common forms of which include retail of books, stationery, daily essentials and foods, snack shops, restaurants, civil engineering contracting, interior decoration, etc. and the business scope of a store sometimes overlaps with the scope of the services designated for its trademark. For example, when a store provides restaurant services, travel services or interior decoration services, it normally uses its name on signboards, billboards, or business materials (uniforms, paper napkins or packaging bags), thus giving the impression that it is a sign identifying the source of the services. Thus, such name is capable of denoting and distinguishing the source and is distinctive.

It is not common for a product manufacturer to register its name as a trademark. The use of a store's name on goods normally means that such name relates to those goods and services. For example, publications are the product of "publication services" and as such are often labeled with the name of the store concerned; in respect of retail services in connection with baked bread and bakery goods sold at a bakery, the name of the relevant store is often labeled on the packaging boxes of the goods as a sign that denotes and distinguishes the source. Under the circumstances, the relevant goods usually do not bear another, different trademark, and consumers are used to using this type of store name as a sign identifying the source. Such name is thus distinctive.

In practice, the name of a store is registrable without any disclaimer, because a non-distinctive term such as "商行" (pronounced "Shang-Hang"), "商

號" ("Shang-Hao") or "書局" (meaning "Bookstore") is exclusively descriptive of the business of the applicant, has been used in business extensively, and does not give rise to doubts as to the scope of the trademark rights in principle.

Approved cases:


- An application for registration of "里仁書局" ("Li-Ren Bookstore") for publication of books is acceptable without any disclaimer as "書局" ("Bookstore") is a description of the type of business.
- An application for registration of "梅園餐廳 MAY GARDEN RESTAURANT" for restaurants, cold and hot beverage stores, snack shops, etc., is acceptable without any disclaimer as "餐廳 RESTAURANT" is a description of the type of business.

4.9.3 Names of groups, organizations and institutes

A group, organization or institute may use its name on goods or services, for example, the farmers' association of a county or city may use its name on agricultural products, or an educational institute may use its name on educational services. The use of the name of an association or foundation on the goods or services provided in accordance with or for the fulfillment of its objectives is meant to enable the public to identify the provider of those goods or services, and the general public also grows accustomed to using the name of a group, organization or institute as a sign identifying the source. Because the name of a group, organization or institute is an indivisible whole, if such name is sufficient to identify and distinguish the source of certain goods or services, it is deemed distinctive, and a disclaimer of any non-distinctive part is not necessary. However, it is quite common to use a name that describes the nature of a group or an organization as a trademark, such as "跆拳道協會" ("Taekwondo Association") and "救難協會" ("Rescue Association"). When there is doubt about the uniqueness of such name, the applicant should be requested to provide the article of association or other documents relating to its establishment and the determination should be based on relevant legal provisions.

Approved cases:



-  for salt, sauces, vinegar, condiments, spices, etc.
- "國立屏東科技大學" ("National Pingtung Technology University") for publication and issuance of various books, publications, magazines and literature, inquiries of various books, publications and literature, translation of various books, publications, magazines and literature, instruction of knowledge or technology, etc.
- "國立陽明大學" ("National Yangming University") for educational services, instruction of knowledge and technology, individual proficiency and qualification test in skill and academic domains, vocational training services, etc.
- "時代基金會" ("Epoch Foundation") for conducting of various workshops, lectures, meetings, discussions, etc.

4.9.4 Domain names

A domain name, which is a name of the link to a specific website on the Internet, serves to replace the corresponding but difficult-to-remember IP address, and is a level structure. For example, "udn.com", "www.studioclassroom.com", and "www.twnic.net.tw" are the domain names of United Daily News Network, Studio Classroom, and Taiwan Network Information Center, respectively.

For example, www.twnic.net.tw has four levels. The first level, "tw," is a country code and indicates the geographic location of the website; the second level, "net," is the generic name and indicates the type of organization or individual that owns the website; the third level, "twnic," is the registered name of the applicant, Taiwan Network Information Center; and the fourth level, "www," is the hostname and indicates the network services provided by the host. The country code (tw), the type of organization (net) and the name of host (www) are shared by different domain names. It is the registered name of the applicant, twnic, that distinguishes the domain name from others.

Country codes, such as "tw," "cn," and "jp," and generic names, such as

"com," "org," "edu," "net," "game," "club," "biz," and "idv," are often used at the top level of a domain name, while "www" and "ftp" are often placed at the beginning of a domain name. However, as the use of domain names becomes more open, the forms of domain names become increasingly diverse. For example, ".travel" is used for travel services; ".brandname" is used for the name of a brand; city names, such as ".nyc (New York City)," ".berline" and ".paris," are used as top-level domain names. Sometimes, a domain name may contain words or characters other than Roman letters, such as "中文.tw," a generic domain name for Chinese websites. Regardless of whether it provides link to a specific website, a trademark in the form of a domain name, as commonly used and understood, gives the impression that it is merely a link to a certain website rather than a sign identifying the source of goods or services. Therefore, a domain name which does not involve special design, in principle, is not distinctive. However, such application for registration is acceptable if the applicant can provide relevant evidence that the domain name is used as a trademark, for instance, display of the domain name in a conspicuous part of the applicant's website, thus making relevant consumers recognize it as a sign identifying and distinguishing the source or the goods or services. (Paragraph 2 of Article 29 of the Trademark Act) Under such circumstances, the domain name as a whole acquires distinctiveness, and no disclaimer of exclusive use of the non-distinctive part is required.

If a specially designed domain name digresses from the meaning of a domain name and if relevant evidence shows that the applicant has the intention of using it as a trademark and that consumers are able to recognize it as such, it is deemed distinctive. The registration of such domain name may be granted after the applicant disclaims the exclusive use of the non-distinctive part.



Disapproved cases:

- "www.tocin.com.tw" and "WWW.ITEMBAY.COM.TW," which are plain domain names and not distinctive.
- "http://www.izzue.com": As "http" stands for hypertext transfer protocol, its combination with "www.izzue.com" becomes a website

address. It still gives the impression of a link to a specific website and thus is not distinctive.

Approved cases:



-  for book and periodical editing, interior design, computer animation design and production, etc.: As the word "HEYHOLE" is enlarged and encircled by a swirl device, such special design gives the impression that the sign is used as a trademark. Hence, the application for registration is acceptable without any disclaimer as ".com.tw" is shared by different domain names to indicate the country code and the type of business organization.
-  for electronic books, personal digital assistants, computer conversation aids, electronic dictionaries, etc.: The word "KOOOK" is enlarged, and "000" is in a face device and highlighted in color. Because of this special design, the device gives the impression that the sign is used as a trademark. Hence, the application for registration is acceptable without any disclaimer as ".COM.TW" shared by different domain names to indicate the country code and the type of business organization.

The public knows that ".com" in a domain name refers to a business organization such as company or store. The combination of descriptive words or a generic name of the designated goods or services and ".com" still gives the impression that it is descriptive of the goods or services.

Disapproved cases:

- "TICKETS.COM" for provision of transportation reservation services via global computer network: Because "TICKETS" means "a certificate or token showing that a fare or admission fee has been paid," the trademark still gives the impression that it is descriptive of the content of the designated services.
- "GAMES.COM" for retail of toys, entertainment and travel articles: As

"GAMES" means activities involving skill, knowledge or chance, the trademark still gives the impression that it is descriptive of the content of services.




4.10 Common religious divinities, terms and signs

A common religious divinity, term or sign is a device, character or phrase that is commonly used in folk customs and religious ceremonies and has specific meanings. Its use in connection with goods or services will give the impression that it is merely a general prayer or decorative character(s) and pattern, and cannot serve to identify and distinguish the source. For example, the use of the statute of a deity or Buddha, the device of Tai Ji (太極), the Eight Diagrams (八卦), the swastika, the figure similar to the word "回", or other device or character(s) commonly used in religious context, or a religious term such as halleluiah and a-men as a trademark, in principle, is not distinctive. However, if its use in connection with goods or services will give the impression that it no longer conveys a religious meaning, it is deemed distinctive and may be granted registration.

Statutes of a deity or Buddha, spells, mantras, text from religious books or the name of the Buddha mostly have auspicious meaning, are prayers to deities or Buddha, or are meant as communication with the nether world. For example, "三童子" (pronounced "San-Tong-Zi"), "福祿壽" (pronounced "Fu-Lu-Shou") and "財子壽" (pronounced "Cai-Zi-Shou") relate to wishes for good fortune, prosperity and long life. The devices of "五鬼" ("Five Ghosts"), "白虎" ("White Tiger"), "天狗" ("Tian-Gou"), "人形" ("Human Figure") or "銅錢" ("Copper Coins"), which are often seen on joss paper, represent different functions. Their use in connection with golden joss paper and silver joss paper and joss paper for other purposes, joss sticks, etc., is normally descriptive of the function or other features of the goods. Besides, such characters and devices are frequently used by the relevant industries and should not be claimed by one party alone. Even if they have been used for a long time, they can hardly acquire distinctiveness. In addition, "刈金" ("Yi-Jin"), "福金" ("Fu-Jin"), "壽金" ("Shou-Jin"), "天金" ("Tian-Jin") and "尺金" ("Chi-Jin"), which are generic names of joss paper for different

purposes, are not registrable.

Disapproved cases:

-  for glasses and optical lenses gives the impression that it is a general decorative pattern and is not distinctive.
-  (the device of the Eight Diagram and Tai Ji) is deemed able to block evil spirits in folk customs, and its use in connection with joss burners and incinerators for burning incense sticks and joss paper is descriptive of the function of the designated goods as it implies that they can block evil spirits.
-  is a general device of Buddha, and its use in connection with joss sticks is descriptive of the use of the goods, i.e. for sacrifice or worship.
- "福德金" (pronounced "Fu-De-Jin") for joss paper and paper shoe-shaped gold ingots for religious ceremonies, etc.: As "福德正神" ("Fu-De God") is also known as "土地公" (the land god), such trademark gives the impression that it is descriptive of the use of the goods in connection to Fu-De God.

For the general public, religion is not only a faith, but also a spiritual ballast and a stabilizing power on the society. Images of deities and religious terms or signs often convey the meaning of holiness and solemnity. If their use in connection with goods or services causes demeaning or negative associations, thus impairing public order or good customs, they are unregistrable. (Subparagraph 7 of Paragraph 1 of Article 30 of the Trademark Act)

4.11 Slogans, proverbs, new terms and technical terms

As for registration of a slogan, proverb, new term or technical terms as a trademark, the main points for determination of distinctiveness differ as explicated below:

4.11.1 Slogans

A slogan is a phrase or sentence used to advertise services or goods. It is usually short, concise and easy to remember. A slogan is normally used to express the ideas of a business or the features of its goods or services. A business also uses an original slogan to attract consumers' attention and to create the image of its products. General consumers are able to recognize a slogan as relating to the source of certain goods or services only after such slogan has been substantially used. Under the circumstances, such slogan serves to identify the source and is distinctive. With the exception of a highly distinctive slogan or a sign containing such slogan, which enables consumers to immediately recognize it as a sign identifying the source, the registration of a slogan cannot be granted unless there is proof that it has acquired distinctiveness.

If a sign merely provides information about goods or services, or is meant for self-promotion, it is descriptive of the goods or services and should be disapproved pursuant to Subparagraph 1 of Paragraph 1 of Article 29 of the Trademark Act. A non-descriptive sign that is merely for promotion should be disapproved pursuant to Subparagraph 3 of Paragraph 1 of Article 29 of the Trademark Act on account of non-distinctiveness. Normally, a sign containing a distinctive literal mark has higher distinctiveness; however, if such sign as a whole is descriptive of the goods or services, it is still not distinctive.

Disapproved cases:

- "水是最好的藥" ("Water is the best medicine") for aerated water, carbonated water, mineral water, spring water, and distilled water gives the impression that it is an advertisement slogan indicating the advantages of drinking water and is not distinctive.
- "幫助您找到更好的解決辦法" ("Help you find a better solution") for education, provision of training, and conducting of sports and cultural activities: Because the development of one's ability to solve problems is one of the important functions of education and training, such slogan is

descriptive of the services provided.

Approved cases:

- "有青，我就是世界" ("Fresh, I am the world") for beer is accepted for trademark registration after the applicant proved that the slogan has acquired distinctiveness through use.
- "不在辦公室，也能辦公事" ("Not in the office, but do office work") for mobile phone communication transmission, telecommunications transmission by weighted networks, telecommunications connection services on the Internet, etc. is accepted for trademark registration after the applicant proved that the slogan has acquired distinctiveness through use.

4.11.2 Conventional greeting phrases, auspicious phrases, popular terms and idioms

As understood by consumers, conventional greetings or auspicious phrases such as "百年好合" (pronounced "Bai-Nian-Hao-He"), "事事如意" (pronounced "Shi-Shi-Ru-Yi"), "大吉大利" (pronounced "Da-Ji-Da-Li") and "招財進寶" (pronounced "Zhao-Cai-Jin-Bao") or popular terms such as "好人卡" ("Nice-guy Card"), "台客" (pronounced "Tai-Ke"), "夯" (pronounced "Hang"), "火紅" (pronounced "Huo-Hong"), "樂活" ("LOHAS"), "KUSO" and "ORZ," either are commonly used phrases or refer to trendy new concepts, and will not be considered as a sign identifying and distinguishing the source of goods or services. Such terms are not distinctive and should be disapproved pursuant to Subparagraph 3 of Paragraph 1 of Article 29 of the Trademark Act. If a greeting, auspicious phrase or popular term is descriptive of the quality, function or other features of goods or services, it should be disapproved pursuant to Subparagraph 1 of Paragraph 1 of Article 29 of the Trademark Act. For example, a greeting or auspicious phrase for cards is often descriptive of the use of the cards.

The form and use of daily language change all the time, and existing terms can acquire new meanings or abbreviations may refer to specific concepts in connection with the important issues of different times. For example, with the

current emphasis on environmental protection, “綠色(Green)” has acquired a new meaning, and relevant abbreviations such as “Enviro,” “Eco” and “Bio” are often used with other words to imply connection with environment and ecology. Use of such words on goods or services relating to environment or ecology is descriptive and thus not distinctive. However, if the combination of such words and other words as a whole is no longer related to environment and ecology or creates a special meaning, it is deemed distinctive.

Disapproved case:

- "Green Cable" for wires and cables: As it refers to lead-free environmental-friendly wires and cables that comply with the EU directives on RoHS, it is descriptive of the material and quality of the goods.

Approved case:

- "ENVIROTAINER" for storage containers and freezing cabinets: As "TAINER" is meaningless, its combination with "ENVIRO," in its entirety, is not related to environment, ecology or the designated goods. Such trademark is distinctive.

Commonly used idioms which express established concepts, usually are not taken as a sign identifying the source, and are not distinctive. However, the use of the specific meaning of an idiom in connection with goods or services may be descriptive of the goods or services, or may be indirectly descriptive of the relevant features of the goods or services by means of metaphor or simile. In case of the former, the application for registration should be refused (Subparagraph 1 of Paragraph 1 of Article 29 of the Trademark Act), while the latter is deemed distinctive. For a newly coined phrase that imitates an idiom but is less original, the examination of its distinctiveness should be subject to the same principles as those for an idiom.

Disapproved cases:



- is a common device containing the auspicious phrase "招財進寶" (pronounced "Zhao-Cai-Jin-Bao"). Its use on milk, goat milk, condensed milk and coconut milk will not cause the general public to consider it as a sign identifying and distinguishing the source; therefore, it is not distinctive.
- "開運吉祥" (pronounced "Kai-Yun-Ji-Xiang") for picking an auspicious date, aspect astrology, geomantic omen, divination, etc. is a laudatory term for promotion of the services provided and is not distinctive.

4.11.3 Names of new products and technology

When the applicant wishes to register the name of goods or technology that he/she first created as a trademark, such name should be deemed distinctive if it is not descriptive of the content or important features of the goods or technology. For example, "MACINTOSH" is the name of operation system for APPLE personal computers; because macintosh means waterproof cloth, waterproof coat or raincoat, it is not descriptive of personal computers and is distinctive. If a name is directly and obviously descriptive of goods or technology and thus will easily make people understand the content of the goods or technology, and if other businesses may also need to use this simple, obvious and direct term to denote relevant goods or services, no party should be given the exclusive right to use such name and, according to Subparagraph 3 of Paragraph 1 of Article 29 of the Trademark Act, its registration should be refused on account of being descriptive of the goods or services. If the application for registration of such name or technical term is filed after it has become commonly used in the industry, it should be refused pursuant to Subparagraph 2 of Paragraph 1 of Article 29 of the Trademark Act.

4.12 Place names

Along with the tendency toward retail of goods in large warehouse complexes and the highly professional way in which goods are produced, a business often uses the names of goods or services in combination with a place

name, such as 世界 (world), 廣場(plaza), 旗艦店(flagship), 王國(kingdom), 天地(land), 中心(center), 屋(house), 家(home), 館(hall), 城(city), 坊(pronounced "Fang"), 工場(workshop), 工房(working house), 本鋪(pronounced "Ben-Pu," from Japanese "honbo"), "world," "land" and "mall" to emphasize the variety or specialization of the goods and services provided. Such use is in principle non-distinctive.

If the combination of a place name and the description of goods or services gives impression that it is descriptive of the goods or services, it is not distinctive. For example, "納豆本鋪" ("Natto Ben-Pu") for drinks and sports drinks made of natto gives the impression that it is descriptive of the ingredient of the goods, so it is not distinctive. However, if such combination creates a meaning other than description of the good or services, it is deemed distinctive.

Disapproved cases:

- "玩具天地 TOY LAND" for toys and electronic video games: As "玩具" (TOY) is the name of the goods, its combination with "天地" (LAND) gives the impression that it is descriptive of the goods or services.
- "蜜餞屋" ("Preserved fruit house") for preserved fruits gives the impression that it is descriptive of the goods.
- "窗簾世界 CURTAIN WORLD" for retail of curtains and their accessories: As "窗簾" (CURTAIN) is the name of goods, its combination with "世界" (WORLD) gives the impression of a curtain specialty store and is descriptive of the services.
- "精品暢貨中心 outlet world" for shopping malls denotes that the shopping malls specialize in off-season brand-name products, and is descriptive of the content of the services.

Approved cases:

- "Fun-World" for TV video games, coin-operated electronic video games, video games and virtual reality video games: The foreign word "Fun" means interesting and enjoyable and describes the effect of the products. Therefore, "Fun-World" is not directly and obviously

descriptive of the designated goods and is distinctive.

- "甜世界" ("Sweet World") for distribution and retail of fruits and vegetables: As "甜" ("sweet") is a popular feature of vegetables and fruits, its combination with "世界" suggests the provision of sweet vegetables and fruits. The trademark in its entirety is not directly and obviously descriptive of the designated services and is distinctive.
- "彩色世界" ("Colorful World") for cosmetics, hair perm lotions, hair dyes, etc.: As the variety of colors is one of the features of said goods, the combination of "彩色" and "世界" suggests that these goods have many attractive colors and is distinctive.

4.13 Trademarks in special forms

Unlike conventional trademarks that consist of words, devices or symbols, trademarks in special forms such as color, three-dimensional shape, motion, hologram and sound trademarks are often considered by consumers as either the ornamental color of the goods, the goods themselves, a functional or ornamental shape of the goods, a security label or any other promoting measures of goods or services, rather than a sign indicating the source of goods or services. The guidelines for determination of distinctiveness of trademarks in special forms, in principle, are the same as those for other types of trademarks. In other words, when a trademark in special form is recognized by consumers as a sign that distinguishes the source of goods or services, it is distinctive. The determination and examination of distinctiveness of trademarks in special forms should be subject to the "Examination Guidelines on Non-traditional Trademarks".

5. Provision and Establishment of Evidence

The applicant of a non-distinctive trademark must provide evidence to prove that the trademark has acquired distinctiveness through use (Paragraph 2 of Article 29 of the Trademark Act). The determination of distinctiveness acquired through use is based on the recognition of local consumers. Thus, the evidence provided by the applicant should be mainly materials relating to domestic use. If materials relating to foreign use are provided, they are acceptable only if relevant local consumers have

knowledge of such use in the foreign country.

5.1 Evidence of acquired distinctiveness

In principle, the more obvious the descriptiveness of words/characters or the non-distinctiveness of a sign, the less likely consumers will consider it a trademark identifying the source. Under such circumstances, the applicant needs to make relevant consumers recognize it as a trademark by using more relevant materials or media. Therefore, the amount of evidence required depends on the circumstances of each case. The following materials may serve as evidence of acquired distinctiveness of a trademark to be registered:

- (1) The manner of use of the trademark, the length of time of such use and the use by competitors in the same trade

The trademark to be registered and the trademark actually used should be the same. In actual use, the size, scale or font of a trademark may change to comply with the packaging of goods. If such change does not alter the sameness of the trademark, materials relating to such use may serve as the evidence of use. A trademark sought to be registered should not only be a description of the goods or services and should serve to indicate the source.

When a trademark is used not alone but in combination with another trademark, materials showing such combination use may serve as evidence of use relating to the trademark to be registered, but the trademark is registrable only if it is distinctive by itself without the other trademark. When a trademark to be registered is usually used together with another trademark, more evidence of use is usually needed to prove its distinctiveness. For example, "焦點亮白" ("focused brightening and whitening") for body-care and beauty cosmetics, etc., as the evidence provided by the applicant all related to the combination use of "焦點亮白" with "歐蕾" or "OLAY," objectively speaking, the term gives the impression that it is a general advertising phrase describing the function of the goods

and the main distinctive part that identifies the source of goods is still "歐蕾" or "OLAY." Therefore, "焦點亮白" has not acquired distinctiveness from such combination use. As for the combination use of the phrase "鑽石恆久遠 一顆永流傳" ("A Diamond is Forever") and "DE BEERS," because the extensive evidence of long-term use is sufficient to prove that independent use of "鑽石恆久遠 一顆永流傳" can cause consumers to recognize it as a sign identifying a specific source, such phrase has acquired distinctiveness through use.

Evidence should indicate the time of trademark use. The longer the trademark has been used, the more likely relevant consumers will associate the trademark with the applicant. Nevertheless, in view of the booming of electronic media and the Internet and the fast transmission of information today, a trademark may also acquire distinctiveness in a short period of time through extensive and intensive use.

In case of interruption of trademark use, what should be considered is whether the duration of interruption has an effect on the trademark's acquisition of distinctiveness. For example, if, in the ten-year period of use of a trademark, there were two years in which the trademark was not used, but the sales volume was substantial both before and after the interruption, such interruption does not constitute a factor that adversely affects the acquisition of distinctiveness. In contrast, if the sales volume before the interruption was limited, such interruption may cause a substantial and adverse effect on the acquisition of distinctiveness.

Evidence that no competitor in the same trade uses the trademark to be registered does not necessarily prove that the trademark is distinctive because the determination of distinctiveness of a trademark depends on whether relevant consumers will consider the trademark a sign identifying the source. When a trademark is strongly descriptive of goods or services, even if no competitor in the same trade has ever used an identical or similar trademark, this does not change the descriptive nature of the trademark

and the trademark is still not distinctive.

Use of a trademark by the applicant includes the use by the applicant, its predecessor and licensee. To export or import the goods, to which a trademark applied, where such trademark is capable of being recognized by relevant consumers as a trademark (Subparagraph 2 of Paragraph 1 of Article 5 of the Trademark Act), is considered use by the proprietor of the trademark. Therefore, the use of a trademark on goods for exportation purposes is also deemed the applicant's use of the trademark. However, if all of the applicant's goods are for exportation, it is usually difficult to use the sales volume or sales figures to prove that such trademark has acquired distinctiveness in the domestic market.

(2) Sales volume, sales figures and market share

Generally speaking, the higher the sales volume or sales figures, the greater the number of the consumers who have purchased the applicant's goods or services is and the more substantial their exposure to the trademark is, which makes it more likely that the trademark can serve to identify the applicant's goods or services. Therefore, a large sum of sales volume or sales figures may make up for the disadvantageous factor when the trademark has been in use only for a short period of time. If the sales volume or sales figures include goods or services other than the designated ones or involve use of trademarks other than the trademark to be registered, the applicant should be required to submit the sales volume or sales figures in connection with use of the trademark to be registered on the designated goods or services only.

When sales figures are used as evidence, the nature of the goods should be considered. For example, cheap daily essentials have a larger market and are offered by many suppliers, so consumers will exercise a lower degree of attention while purchasing relevant goods, which makes it more difficult for a non-distinctive sign to acquire distinctiveness in that

market. In contrast, because expensive specialty goods have a smaller market and are provided by a limited number of suppliers, consumers will exercise a higher degree of attention while purchasing them. As a result, it is easier for a trademark to acquire distinctiveness even though the sales figures are the same. When businesses in the financial service industry use the amount of loans or insurance premium as sales volume or sales figures, they tend to exaggerate the extent to which relevant consumers are exposed to the trademark to be registered. Therefore, this is not a proper means to evaluate trademark use, and the number of accounts opened, the number of the insured, the number and locations of branches, etc., will be better evaluation indicators.

The market share of the applicant's goods or services in the market for goods/services of the same category is a crucial factor for reference. Generally speaking, sales volume that makes up a high percentage in the market means a high percentage of relevant consumers that are exposed to the trademark, which in turn means that the trademark is more likely to serve to identify the applicant's goods or services. Market share can also help the determination of the importance of sales volume and sales figures in the market for goods/services of the same category. For example, if limited sales figures represent a large percentage in the market for goods/services of the same category, this may mean that the trademark concerned has already acquired distinctiveness.

- (3) Advertisement volume, advertisement expenses, materials for promotional activities

An advertisement is one of the aspects of trademark use, and is also the most important marketing means today. An advertisement informs the public of the existence of the applicant's trademark and provides information relating to the goods or services. In general, a high advertisement and great advertisement expenses mean that the trademark gets more exposure and is more likely to be noticed, which in turn means

that consumers are more likely to recognize such trademark. The crucial factor for determination of acquired distinctiveness ultimately lies in consumers' recognition. A trademark to be registered is deemed to have acquired distinctiveness only when advertisements have changed its descriptive nature in the minds of consumers and enabled relevant consumers to recognize it as a trademark. Therefore, a high advertisement volume and/or great advertisement expenses do not necessarily guarantee acquired distinctiveness.

The territory where advertisements are distributed or broadcasted is one of the factors of their effect. In principle, the wider the geographical area covered by advertising media such as TV, radio, newspapers and magazines, the greater the number of relevant consumers exposed to the advertisements, and the more likely the trademark to be registered can serve to identify the applicant's goods or services.

The special nature of an industry is also an important factor when considering advertisement expenses. For example, as a company that produces highly specialized products normally notifies the existing or potential clients by means of letter, e-mail or catalogue, it has few or even no advertisement expenses; under such circumstances, advertisement volume and advertisement expenses should play a lesser role in determination of trademark distinctiveness.

When the content of an advertisement includes trademarks other than the trademark to be registered or involves goods or services other than the designated ones, the applicant should be required to provide the advertisement volume or advertisement expenses only in connection with the use of the trademark on the designated goods or services.

(4) Sales territory, market distribution, points of sale or display

In principle, the wider the geographic area where a trademark is used,

the more likely the trademark can serve to identify the applicant's goods or services. If a trademark is only used in a particular region, the number of consumers who can identify the goods or services on which trademark is used will be limited. In other words, when the evidence of use shows that the designated goods or services are available in a large area, have a wide market distribution, and are provided at many points of sale and display, the trademark is likely to be distinctive. Nevertheless, it should be noted that specialized goods or services may be available only at a limited number of points of sale/display. Under such circumstances, the limited materials provided by the applicant should not constitute a disadvantageous factor in the determination of distinctiveness of the trademark concerned.

(5) Registration certificates issued in different countries

Certificates showing that the trademark has been registered in other countries may serve as reference, especially in case of a trademark in a foreign language, as this can help evaluate how native speakers of that language perceive the distinctiveness of the trademark in respect of the designated goods or services and determine whether the word(s) is/are descriptive of the goods or services. However, if a sign has acquired distinctiveness through extensive use in a foreign country but has not been used in the ROC yet, and if the materials relating to its use in that country are not enough to make local consumers recognize the sign as a trademark, the registration information in other countries alone cannot prove that the sign is distinctive in the ROC.

(6) Market survey reports

While a market survey report may prove that a trademark has acquired distinctiveness, it has probative value only if it is professional, impartial and objective. When the applicant chooses to conduct a market survey by itself but lacks the expertise, the sampling is often not representative, the questionnaire usually contains leading questions, and the people conducting the market survey or interview often lack professional training

and ability. As a result, the accuracy and impartiality of the questionnaire are likely to be challenged, which will affect the market survey's value as a reference.

In practice, a report is not likely to be regarded as having probative value because there are often doubts about the professionalism and impartiality. The applicant should carefully evaluate whether to conduct a market survey. In considering the reference value of a market survey report, the following matters should be taken into account:

❶ Credibility of market survey companies or organizations

A report that is prepared by a credible market survey company or organization is usually more professional and more likely to be objective and impartial. If the applicant outsources a consumer survey, it should do its best to choose a reputable professional market survey company or organization. For the purpose of evaluating the credibility of a market survey company or organization, a market survey report should be enclosed with background information of the company or organization, for instance, how long the company or organization has provided market survey services, its business volume, and what market survey reports it has produced.

It should be particularly noted that even if a survey is conducted by a reputable market survey company or organization, the report can serve as a reference only when the survey methodology, the design of the questionnaire and the correlation between the content and the conclusion are professional and impartial.

❷ Survey methodology

A market survey report should indicate the duration, method (for example, by mailing and/or telephone interview) and geographic area of the survey, the subjects, the sampling method, the population and the number of samples, and the method of survey must be reasonable

and meets the purpose of the survey. For example, the basis for sampling of subjects will be different in respect of a trademark used on specialized goods and a trademark used on daily essentials. Relevant consumers refer to people who are actual or potential customers of the goods or services in the same category as the designated goods or services. The subjects should not be limited to a specific group of people who may purchase the applicant's goods or services. In addition, the more representative the samples are, the more value the survey report will have as a reference.

③ Design of questionnaires:

The questionnaire should be designed in accordance with the predetermined objectives. The questions should be related to whether the trademark to be registered is distinctive and should be impartial and objective, not leading.

④ Correlation between content and conclusion:

The contents of a market survey and the results or conclusions must have reasonable correlation.

⑤ Miscellaneous

A market survey report should include the basic information of the subjects for future assessment of whether the report is reliable. In addition, the statistic errors and confidence intervals should be explained in the report.

(7) Other evidence of acquired distinctiveness

A newspaper or magazine report on the trademark to be registered may serve as reference when determining acquired distinctiveness. However, it should be noted that nowadays an advertisement is frequently dressed up as a report. Therefore, special attention must be paid to distinguish between an objective report and an advertisement.

In principle, a certificate issued by a business association, chamber of commerce, a trade union, etc. may serve as reference for determining whether a trademark has acquired distinctiveness. Supporting evidence provided by trading counterparts and so on can also be used as reference materials, provided that it relates to the impression that they get from relevant consumers of the designated goods or services after actual interaction, such as the fact that a significant number of consumers inquire about the applicant's trademark while purchasing goods or services, instead of simply the trading counterparts' own speculation. Moreover, the trading counterpart must be able to remain neutral. If the applicant is in such a position that the trading counterparts' view may be affected, the latter's statement will have less value as reference.

5.2 Determination of acquired distinctiveness

Determination of whether a trademark to be registered has acquired distinctiveness should depend on the evidential materials provided by the applicant, the different nature of the designated goods or services and other factors that may affect the determination, and the actual trading situations in the market. If the evidence shows that the trademark to be registered is actually used as a sign identifying and distinguishing the source of goods or services and a significant number of relevant consumers do consider it as such, the trademark is registrable (Paragraph 2 of Article 29 of the Trademark Act).

6. Other Matters

In the examination of trademark distinctiveness, in addition to the foregoing factors, attention should also be paid to applicability of disapproval clauses, disclaimer of exclusive use, Chinese translation of foreign-language materials, remarks on acquired distinctiveness, etc.

6.1 Applicability of disapproval clauses

A trademark shall not be registered if it is “consisting exclusively of a description of the quality, intended purpose, material, place of origin, or relevant characteristics of the designated goods or services,” “consisting exclusively of the generic mark or term for the designated goods or services,” or “consisting exclusively of other signs which are devoid of any distinctiveness”, as provided in Subparagraph 1, 2, or 3 of Articles 29 of the Trademark Act. The three subparagraphs are separate provisions and their prerequisites are different. Subparagraph 3 is the general provision of other circumstances where a sign is devoid of any distinctiveness. If a trademark is not registrable on account of the circumstances under Subparagraph 1 or 2, it should be refused on the basis of such specific provision. In addition to the circumstances specified in Subparagraph 1 and 2, a slogan, surname, simple line, geometrical device or ornamental device without distinctiveness should be refused pursuant to Subparagraph 3.

A trademark is "descriptive of goods" when it, as generally understood, is directly and obviously descriptive of or is closely related to the shape, quality, function or other features of the goods. A generic name is a name that is commonly used on the same kind of goods by competitors in the same trade. In practice, registration of a trademark that is a generic name commonly used by competitors in the same trade as a name indicting the designated goods or services should be disapproved pursuant to Subparagraph 2, while that of a trademark that is descriptive of the designated goods or services should be disapproved pursuant to Subparagraph 1.

6.2 Disclaimer

If a trademark as a whole is distinctive, but the reproduction of a trademark contains an element which is not distinctive and is functional and gives rise to doubts as to the scope of the trademark rights, to prevent the trademark from being deemed unregistrable because of that portion or any dispute from arising from that portion after the trademark is registered, the application for registration may be accepted if the applicant states that he/she disclaims any exclusive right to such element pursuant to Paragraph 3 of Article 29 of the Trademark Act.

The examination of disclaimer should be subject to TIPO's "Examination Guidelines on Disclaimers" and "Examination Guidelines on Non-traditional Trademarks".

6.3 Chinese translation of foreign-language materials

Article 3 of the Enforcement Rules of the Trademark Act provides that the applications and all relevant documents submitted should be in Chinese, and that certificates or other documents in foreign languages should be accompanied by a full or summary Chinese translation. If the evidential materials provided by the applicant are in a foreign language, the applicant should be required to provide a full or summary Chinese translation.

6.4 Remarks on acquired distinctiveness

For a trademark that is registered on the basis of its acquired distinctiveness, the trademark application and the decision to approve the registration should indicate "Approved pursuant to Paragraph 2 of Article 29 of the Trademark Act," which should also be included in the relevant public notice.