

(Translation)

## Examination Guidelines on Non-Traditional Trademarks

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## **1. Preface**

Due to the diversification of commercial activities and the rapid changes in mass media and advertising designs, traditional trademarks no longer satisfy market demands. To protect trademark rights and interests and to prevent unfair competition, three-dimensional, single color, and sound trademarks were added to the Trademark Act that became effective on November 28, 2003. The Examination Guidelines on Three-Dimensional, Color and Sound Trademarks was then elaborated. Indeed, new types of trademarks have grown to be widely accepted internationally. To cope with this international trend and to protect traders' efforts in operating their businesses, the Trademark Act, which was amended and promulgated on 29 June 2011 (hereinafter the "Act"), prescribes that any sign capable of being recognized as an indication of the source of goods or services is entitled to protection under the Act, and also gives examples as consisting of words, designs, symbols, colors, three-dimensional shapes, motions, holograms, sounds, or any combination thereof (Article 18 of the Trademark Act). Because the subject matters entitled to protection under the Act are not confined to those expressly listed, the Examination Guidelines on Three-Dimensional, Color and Sound Trademarks is renamed to the Examination Guidelines on Non-Traditional Trademarks (hereinafter the "Guidelines"), in which additional provisions are formulated.

Any sign capable of being recognized as an indication of the source of goods or services is entitled to protection under the Act. Non-traditional trademarks are not limited to color, three-dimensional, motion, hologram and sound trademarks as specified in the Act. Any other signs that are perceptible by scent, tactile and taste and comply with the distinctive requirement of the Act may be filed for registration as trademarks and be granted protection under the Act. However, in examination practices, the chance for different types of non-traditional trademarks to be successfully registered varies. For instance, because scent, tactile and taste trademarks are not visually perceptible, technical problems need to be overcome, i.e., in a manner that the reproduction of a trademark represented is clear, precise, self-contained, objective, durable, easily accessible and intelligible, or in a manner that the written description or specimens of a trademark can assist in defining the

scope of the trademark rights and enabling third parties (in particular, competitors) to know exactly the registered trademark and the scope of the trademark rights. So far, new types of trademarks which have successfully acquired protection around the world are rare. Therefore, the Guidelines deal only with the non-traditional trademarks expressly specified in the Act. Also, repeating-pattern trademarks that are commonly seen in practice and controversial scent trademarks are further explained in dedicated sections. As for other non-traditional trademarks that may be filed for registration, they are discussed in a separate section.

Examples cited in the Guidelines include both domestic and foreign trademark registrations. To adapt to the provisions of these Guidelines, the descriptions of the trademarks shown in the cited examples may not be exactly the same as the ones that are actually registered.

## **2. Non-traditional trademarks**

From the perspective of trademark development history, trademarks in the early stage consist solely of words, designs, symbols or any combination thereof; in filing for registration of a trademark, the trademark should be clearly and completely represented by its reproduction. Along with the booming development of commercial activities and fierce competition in the market, different marketing approaches have been applied to market goods or services in order to gain the loyalties of consumers. For instance, the special shape of goods, the trade dress of packaging or containers, sounds or colors are efficient tools to make consumers recognize and purchase goods. Accordingly, three-dimensional, sound and color trademarks have been gradually developed. Today, even motion images and holograms can also be used as signs that identify goods or services. These new types of trademarks developed recently are different from traditional trademarks in form. In filing an application for registration of any of these new types of trademarks, in addition to a reproduction, a description and specimen(s) of the trademark should also be furnished to faithfully reflect the trademark. While many issues related to these types of trademarks are discussed at an international level, the term "non-traditional trademarks," as opposed to traditional trademarks, is commonly used worldwide. Therefore, the Guidelines also adopt the term.

The main issues regarding the examination of non-traditional trademarks include the method of representations, the distinctiveness and the non-functionality of the trademark, which are explained below:

## **2.1 Reproduction, description and specimen of a trademark**

The reproduction, description and specimen of a trademark are meant to give a clear representation thereof. The reproduction of a trademark, which consists of a graphic representation and word, aims to convey a clear, self-contained and objective picture of the trademark so as to define the scope of the claimed rights. Therefore, the Trademark Act clearly prescribes that a reproduction of a trademark shall be represented in a manner that is clear, precise, self-contained, objective, durable, easily accessible and intelligible (Paragraph 3, Article 19 of the Trademark Act). As noted, the reproduction of a trademark is shown in a two-dimensional still image. In filing an application for a non-traditional trademark, even though the applicant has tried his/her best in presenting the trademark in a format complying with the provisions of the Trademark Act, it is likely that the reproduction of the trademark would not be exactly identical to the trademark actually used. For instance, in the case of musical sound trademarks in which the reproduction of the trademarks is represented by musical notation on a stave, it may comply with the requirement of the clear, self-contained and objective representation, but it would still be inadequate since sound trademarks are identified through audio means; therefore, a written explanation of the sound (a description of the trademark) and an electronic data carrier that stores such stored sound (a specimen of the trademark) must be furnished when filing the application. In filing an application for registration of a non-traditional trademark, in addition to the reproduction of the trademark, the applicant is generally required to furnish a description of the trademark and specimen(s) thereof in order to faithfully present such trademark, as well as to ascertain the scope of trademark rights and facilitate its examination (Rules 14 to 18 of the Enforcement Rules of the Trademark Act). The description and the specimen(s) of a trademark are to supplement the reproduction of the mark and to assist in the trademark examination. Therefore, the description and specimen(s) of a trademark must be consistent with the reproduction of the trademark.

### **2.1.1. Reproduction**

The reproduction of a trademark, which presents the trademark graphically, should be included in the application form and is also a requirement for acquiring a filing date (Paragraphs 1 and 2, Articles 19 of the Trademark Act). In filing an application for a traditional trademark, one reproduction of the trademark is sufficient to clearly and completely present the trademarks. In filing an application for a non-traditional trademark, such as three-dimensional shapes with different perspective views, motion trademarks with a series of images depicting the movement, or holograms with views of the trademark capturing the holographic effect in its entirety, more than two perspective drawings or images might be needed to satisfy the said requirement. In those cases, the reproduction of the trademark consists of multiple perspective views or multiple still images.

Additionally, the reproduction of a trademark may also use broken lines to show the manner, placement or context in which the trademark is used on the designated goods or services in order to clearly and precisely show the trademark (Paragraph 2, Rule 13 of the Enforcement Rules of the Trademark Act), such as indication of a trademark on the specific position of the designated goods by broken lines (see examples in Section 10 of the Guidelines) or indication of how the colors or repeating patterns are applied on certain goods (see examples in Sections 2.1.2, 4.2.2 and 8.2.1 of the Guidelines). In addition, the functional element of a trademark may also be depicted in broken lines in the reproduction. For example, in the case of a cleaning sponge box for shoes in which the hook on the top of the box and the indent of the box have hanging and grasping function, the applicant may depict the functional element of the trademark in broken lines in the reproduction.

When the reproduction of a trademark uses broken lines to depict the manner, placement or context in which the trademark is used on the designated goods or services or the functional elements of the trademark, the portion depicted in broken lines is not deemed part of the trademark. In determining whether the entire trademark is likely to confuse consumers, the portion in broken lines should not be considered, nor is the disclaimer system applicable.



Where the non-distinctive or functional element of a trademark is depicted in solid lines rather than broken lines, and is likely to cause doubts over the scope of trademark rights if the trademark as a whole is deemed distinctive, a disclaimer of such element must be made or the non-distinctive or functional element should be amended to be depicted in broken lines. For instance, in the case of a three-dimensional shape in solid lines that is normally used by traders (such as a trademark containing a thin-neck wine bottle and a round body for grape wines), when the trademark as a whole is distinctive but the non-distinctive three-dimensional shape thereof is still likely to arise disputes over the scope of trademark rights, a disclaimer should be made or such non-distinctive shape should be amended to be depicted in broken lines.

#### **2.1.2. Description**

A description refers to the explanation of the trademark itself and the manner in which the trademark is used on the goods or services (Paragraph 3, Rule 13 of the Enforcement Rules of the Trademark Act). The description of a trademark is used to supplement the reproduction of the trademark in order to faithfully present the trademark. In the case of a trademark consisting of sequential images, the description of the trademark describes how the trademark is used on the designated goods. Similarly, in the case of a motion trademark, as the trademark contains moving images but the reproduction thereof is a still image, the description of the trademark should describe the varying process of the trademark to supplement the sequential movements that cannot be represented by the reproduction. It should be particularly noted that if sound marks, for instance, cannot be represented by musical notation on a stave or a numerical musical score, the reproduction of the trademark may use written description of the sound (see Rule 18 of the Enforcement Rules of the Trademark Act). Likewise, some non-traditional trademarks that are not visually perceptible, such as scent trademarks, may also use the written description as the trademark reproduction.

The description of a trademark mainly describes, in writing, the trademark in a clear and detailed manner. In the case of a non-traditional trademark, the description

of the trademark should state the type of the trademark, for instance, "the trademark is a three-dimensional trademark...." and "the trademark is a sound trademark...." The description may also explain how the trademark is used in connection with relevant goods or services in order to precisely show the trademark.

Example:



Description: The trademark is a color trademark, in which the shape of the object depicted in broken lines is not part of the trademark; the trademark consists of the colors copper and black applied on a cylinder object with the upper portion in copper and the lower portion in black.

### 2.1.3. Specimen

A specimen refers to the sample of the trademark. For instance, in the case of a hologram trademark, the specimen of the trademark would be a hologram image produced by laser technology. In the case of a sound trademark or a motion trademark, a specimen refers to the electronic data carrier that contains the trademark, such as CD or DVD (Paragraph 4, Rule 13 of the Enforcement Rules of the Trademark Act). The trademark specimen supplements the reproduction and description of the trademark. In the case of a motion trademark or a sound trademark, the applicant must furnish a specimen of the trademark that shows exactly all composing elements in details in order to facilitate the examination (Paragraph 2 of Rule 16 and Paragraph 3 of Rule 18, the Enforcement Rules of the Trademark Act). As for other types of non-traditional trademarks, the applicant may also be required to furnish specimens of the trademark, if necessary. For instance, specimens of the trademark are required for a hologram where the hologram will vary because of different perspective views. To exactly show how the scent is applied on goods or

their packaging containers, or articles relating to the services, it would be better to furnish the specimen of the trademark for examination.

## **2.2 Distinctiveness**

A trademark can be registered only if it functions as an indicator of the source of goods or services. The same requirement applies to non-traditional trademarks. Indeed, the criteria for determination of distinctiveness apply to all types of trademarks (Article 18 and Paragraph 1, Article 29 of the Trademark Act). However, in the case of non-traditional trademarks such as color, three-dimensional, motion, hologram or sound trademarks, relevant consumers usually consider the signs as ornamental colors, the shapes of goods themselves or their packaging, the shapes providing the utilitarian functionality or the ornamental shapes of goods, anti-counterfeit labels or any other means for marketing the goods or services. Thus, consumers are less likely to immediately perceive the trademarks as the indication of the source of the goods or services at first. Although TIPO has elaborated the Examination Guidelines on Distinctiveness of Trademarks, the examination of non-traditional trademarks and the determination of distinctiveness of these trademarks should be first subject to this Guidelines. As for proving that non-traditional trademarks have acquired distinctiveness, the provision and establishment of evidence therefor are still subject to the Examination Guidelines on Distinctiveness of Trademarks (see Section 5 of the Examination Guidelines on Distinctiveness of Trademarks).

## **2.3. Functionality**

The shape of goods or the packaging providing functionality not only improves the entire technology of the relevant industry, but also brings convenience to the society. Granting a functional design to one single party would cause permanent monopoly in the market and this, in the long run, would adversely affect fair competition and technology progress in the market. On the other hand, no protection of a functional design may impair the culture of innovation. To balance between encouragement for innovation and maintenance of public interests, the Patent Act grants protection to functional goods for a limited term. After elapse of the term, the invention is in the public domain and can be freely used by anyone. The Trademark Act mainly aims to protect signs that can identify the source of goods or services.

Under the Act, signs can acquire permanent protection through the renewal process without time limitation. However, if the functional design or feature of goods can be registrable as a trademark, such permanent protection will impede fair competition among competitors and social progress. To avoid occurrence of the above circumstances, a trademark shall not be registered if it is exclusively necessary for the goods or services to be functional (Subparagraph 1, Paragraph 1, Article 30 of the Trademark Act).

The term "functionality" means the design or the feature of specific goods or services (such as shape of goods, packaging of goods, sound, color or scent), which is either indispensable for the use or intended purpose of the goods or services, or affects the cost or quality of the goods or services. The concept of functionality includes utilitarian functionality and aesthetic functionality. The former refers to the features of goods that are necessary to achieve the intended purpose or technology results of these goods and also to the features of goods produced by cheaper or simple manufacturing methods. The latter refers to features with less utilitarian functionality. Although these features cannot increase the performance of the goods or services or reduce the cost thereof, they obviously have other competitive advantages that should be used jointly by competitors rather than anyone. For example, in the case of outboard motors, while the color black cannot increase the performance of the motors, it is still functional because the color black is easy to coordinate with any boat colors and also reduces the size of the motors; in the case of orange-flavored medicines, the orange flavor does not improve the efficiency of the medicine but masks the undesired taste of the medicines. The above cases are both examples of aesthetic functionality.

The concept of aesthetic functionality is often confused with the ornamental matter of goods or services. In fact, both concepts are different and must be distinguished from each other. Aesthetic functionality means that the specific features are needed in order to achieve certain purposes, while the ornamental matter is used for decoration only. In the case of a trademark with aesthetic functionality, the trademark application will be refused because it is exclusively necessary for the goods

or services to be functional (Paragraph 1, Article 30 of the Trademark Act), whereas in the case of a trademark with ornamental matter, the trademark application will be refused on the ground that it consists exclusively of other signs which are devoid of any distinctiveness (Subparagraph 3, Paragraph 1, Article 29 of the Trademark Act). Where a trademark with aesthetic functionality has become an identifiable sign through the applicant's use, in consideration of public interests, the applicant may not claim acquired distinctiveness. Even though such trademark has been registered for over five years, it may still be subject to cancellation if it is proved to be essential to perform the functions of the goods or services. In the case of a trademark with ornamental matter of goods or services, it may be accepted for registration if it has acquired distinctiveness through use (Paragraph 2, Article 29 of the Trademark Act). In view of the difference between aesthetic functionality and the ornamental matter of goods or services, in determining if a trademark has aesthetic functionality, one should particularly note whether or not the use of such trademark will create any specific competitive advantages so as to ensure the final determination in compliance with the functionality principle and to avoid misidentifying an ornamental sign as having aesthetical functionality.

Distinctiveness and functionality should be determined separately. When the functional design or feature of products is monopolized through patent protection and further has acquired distinctiveness, it is still not registrable as a trademark because of functionality. When a product design or feature is not functional but lacks inherent distinctiveness, it can be registered as a trademark only after there is proof showing acquired distinctiveness. Therefore, in examining a trademark application, distinctiveness and functionality of the trademark should be examined separately. Nevertheless, any doubts over the distinctiveness and functionality issues should notify the applicant concurrently for further explanations.

The following sections deal with examples and practices for the examination of different types of non-traditional trademarks specified in the Act.

### **3. Three-dimensional trademarks**

#### **3.1 Definition**

A three-dimensional trademark is a sign with three-dimensional shape that has length, width, and height in three dimensions and enables consumers to distinguish the different sources of goods or services. A three-dimensional trademark may include the following:

- (1) Shape of goods;
- (2) Shape of the packaging or container of goods;
- (3) Signs with three-dimensional shape (other than three-dimensional shapes of goods or packaging or container of goods);
- (4) Decor of the place where services are provided.

#### **3.2 Examination of three-dimensional trademarks**

##### **3.2.1 Reproduction**

The reproduction of the three-dimensional trademark shall consist of views depicting the three-dimensional shape of the trademark. As noted, a three-dimensional shape is six-sided. In a simple three-dimensional trademark, one drawing of the trademark in one single perspective view may be sufficient if it depicts all features of the three-dimensional shape. If the appearance of a three-dimensional trademark varies along with different views, a maximum of six drawings of the trademark in different perspective views may be furnished (Paragraph 1, Rule 15 of the Enforcement Rules of the Trademark Act). After a trademark is registered, the trademark examiner may request the applicant to submit additional perspective drawings in different views if necessary. Alternatively, the applicant can take the initiative to furnish additional drawings, provided that the number of additional drawings is limited to six drawings and the drawings cannot enlarge the scope of protection granted to the original three-dimensional shape. If the additional drawings of the trademark in other views reflect features that are not contained in the original trademark reproduction, as the trademark shown in the additional drawings is not the same as that shown in the original reproduction, it would violate the provision that no

changes should be made in the proposed trademark after an application has been filed (Article 23 of the Trademark Act).

To clearly and precisely show a three-dimensional trademark, the reproduction may use broken lines to show the manner, placement or context in which the three-dimensional shape is used on the designated goods or services (Paragraph 2, Rule 15 of the Enforcement Rules of the Trademark Act). For instance, in the case of a three-dimensional trademark consisting of the configuration of a car radiator grill, the configuration of the car may be depicted in broken lines in the reproduction to show the placement where the trademark is actually applied on the goods (see examples in Section 3.2.2 of the Guidelines). In addition, the functional element of a trademark, which cannot be granted trademark rights, may also be depicted in broken lines and is not part of the trademark. Thus, determination of the likelihood of confusion need not take into account the element, and no disclaimer of the element is needed.

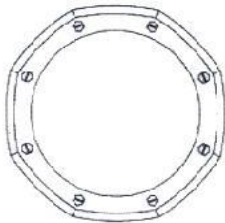
If a trademark contains any non-distinctive or functional elements in solid lines rather than in broken lines, when the trademark as a whole is deemed distinctive but the non-distinctive or functional elements would raise disputes over the scope of trademark rights, either a disclaimer of those elements must be made or the non-distinctive or functional elements should be amended and depicted in broken lines. In the case of a trademark consisting of the configuration of a cylinder jam bottle in solid lines, in which the configuration is commonly used by relevant traders, the trademark as a whole is deemed distinctive, but granting of the trademark rights to the non-distinctive three-dimensional shape will raise disputes. Consequently, a disclaimer of the configuration must be made or the configuration should be amended and depicted in broken lines.

### **3.2.2 Description**

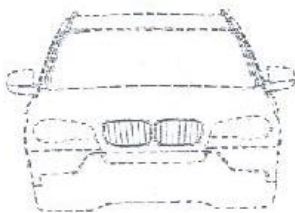
The applicant shall furnish a description explaining the three-dimensional shape (Paragraph 3, Rule 15 of the Enforcement Rules of the Trademark Act). The

reproduction may use broken lines to show the manner, placement or context in which the trademark is used on the designated goods or services with a description explaining such broken lines (Paragraph 2, Rule 13 of the Enforcement Rules of the Trademark Act).

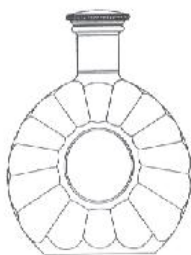
Examples:



Description: The trademark is three-dimensional, as shown in the reproduction, and consists of an octagonal frame, in which the external rim of the frame is in a slightly round shape, the center of the frame is hollow, and the internal rim of the frame is in a round shape. The top of the frame is flat and has eight angles, with each angle having a hexagon screw and a groove at the center of each hexagon screw.



Description: The trademark is three-dimensional, as shown in the reproduction, and consists of the configuration of two kidney-shaped radiator grilles in the head of the car. The shape of the car depicted in broken lines is not part of the trademark.





Description: The trademark is three-dimensional and consists of the oval shape of a wine bottle, in which the front and back sides of the bottle have a recessed portion at the center, the front and back rims have a shell-like design, the oval-shaped bottom of the bottle is flat, and a round bottle mouth and neck connect to the body.

If the proposed three-dimensional trademark contains any word, design or symbol, the description shall also state these elements (Paragraph 3, Rule 15 of the Enforcement Rules of the Trademark Act).

Examples:



Description: The trademark is three-dimensional, as shown in the reproduction, and consists of silk-like wavy lines and the stylized letter "D."



Description: The trademark is three-dimensional, as shown in the reproduction, and consists of the configuration of a perfume or cologne bottle and cap. The bottle is transparent, and a red, black and green poppy is engraved inside the bottle, and the word "KENZO" is displayed on the bottle mouth.



● Description: The trademark is three-dimensional and consists of the configuration of a gourd-shaped glass bottle with an engraved cap, in which the front face of the bottle displays "HENNESSY", "XO" and a unique embossed pattern.

Where a three-dimensional trademark contains a non-distinctive or functional portion depicted in solid lines, thus likely to give rise to doubts as to the scope of trademark rights, no registration will be accepted to such trademark if no disclaimer is made (Paragraph 3 of Articles 29 and Paragraph 4 of Article 30 of the Trademark Act). In filing an application for registration of a three-dimensional trademark, the portion to be disclaimed should be precisely stated in writing. For instance, a description states that "the trademark is three-dimensional, as shown in the reproduction, and consists of the three-dimensional shape of a cock on a car roof, in which no claim is made to the exclusive right to use the shape of the car apart from the trademark as shown," together with a declaration that "no claim is made to the exclusive right to use the shape of the car apart from the trademark as shown." If the said three-dimensional shape that should be disclaimed for exclusive use is depicted in broken lines, no disclaimer is required; any amendment to the reproduction of a trademark depicted in broken lines furnished by the applicant does not substantially change the trademark and will not affect its filing date (Subparagraph 4, Paragraph 1 of Rule 24 of the Enforcement Rules of the Trademark Act).

Examples:



Description: The trademark is a composite mark of three-dimensional and color elements. It consists of the configuration of a flat and vertical column-shaped purple container, in which the cap of the container is black and the body is designed in a unique curve with the one-fourth portion from the top or from the bottom bulging out as opposed to the recessed portion in the middle. A silver-white label is placed on the one-fourth portion from the top of the front side and also on the portion in the middle, and that label in the middle displays the word "LISTERINE" in black uppercase letters, inside a frame design. The shape of the bottle in broken lines is not part of the trademark.

The description of a trademark and its reproduction consisting of different perspective drawings must be consistent and can be cross-referenced. If the three-dimensional shape as shown in the description of a trademark is different from the one shown in the reproduction, the reproduction of the trademark should prevail. Meanwhile, the applicant will be notified to make an amendment within a specified time limit.

### **3.2.3 Distinctiveness**

Like other types of trademarks, a three-dimensional trademark can be registered only if it is distinctive enough to identify the source of goods or services, thus enabling consumers to distinguish these goods or services from those of others.

When compared to traditional two-dimensional trademarks, a three-dimensional shape is more difficult for the applicant to demonstrate its distinctiveness. Specifically, when a three-dimensional shape consists of the shape of goods themselves or their packaging/container, because of its close link or connection to the goods, consumers would normally recognize such shape as the functional or ornamental feature of the goods, and would less likely consider it as a source indicator. Therefore, the distinctiveness of three-dimensional shapes is more difficult to demonstrate than that of two-dimensional trademarks.

In addition to consumers' recognition, the features of goods must also be considered. If it is common for the goods to be available in a wide variety of designs,

such as toy figures, lights and clothing, consumers will often regard the shapes of these goods as ornaments of the goods rather than as signs identifying the source of the goods. The features of goods also affect the degree of attention consumers would pay when selecting these goods. Generally speaking, consumers focus on goods that are more expensive or professional, or on durable goods such as high technology products and medical products. In consequence, their attention to the three-dimensional shapes of these products will be relatively increased, and so the possibility of the shapes serving as a source indicator is greater. Cheap daily goods or non-durable goods, on the contrary, such as soaps, receive a lower degree of attention from consumers. The three-dimensional shapes of such products can hardly serve as a source indicator unless they are so unique or eye-catching that they easily leave an impression in the minds of consumers and are recognized as a sign that distinguishes source of the goods or services. Otherwise, the shapes are not distinctive.

The use of a three-dimensional shape by the relevant industry is also an important factor to be considered. If three-dimensional shapes are too commonly adopted by relevant traders in the industry, they are incapable of functioning to distinguish a specific source and thus, do not fulfill the requirement of distinctiveness.

#### (1) Shape of goods

Generally speaking, the shape of goods is always the design to achieve the functionality of the goods, while the special shape of goods is always ornamental design that makes the goods more attractive. Therefore, consumers will not consider the shape of goods as a source indicator of the goods, and such shape is not inherently distinctive. The shape of goods can be registered as a trademark only after there is proof showing acquired distinctiveness through use.

Example:



Description: The trademark is three-dimensional and consists of the

three-dimensional configuration of the applicant's car with special contour.

If the shape of goods is so unusual, is distinctively different from the shape commonly adopted by the industry, exceeds consumers' expectations, and gives a deep impression, such difference serves primarily as an indicator of the source of the goods rather than a mere functional or ornamental design. Then, the shape is inherently distinctive. In some categories of goods, it is common that goods are available in a wide variety of shapes, such as toys in Class 28, jewelry in Class 14 and lights and lamps in Class 11. Therefore, the shape of these goods, even though it is different from the shape commonly used by the relevant industries, can hardly become inherently distinctive since it is easily regarded by consumers as a change or an ornamentation of the shape of the goods rather than a source indicator.

(2) Shape of the packaging or container of goods

When compared to the shape of goods themselves, the shape of the packaging or container of goods is often more inherently distinctive. However, the shape of the packaging of the goods is deemed distinctive only if it distinctively differs from the shape commonly seen, gives a deep impression to consumers and can serve as a source indicator. That is to say, a trademark consisting merely of the shape of the packaging/container of goods that is commonly used in the relevant consumer market cannot serve as a source indicator of the goods and is not distinctive. The registration of such trademark must first prove the existence of acquired distinctiveness thereof (Paragraph 2, Article 29 of the Trademark Act).


Example:



Description: The trademark is three-dimensional. In the trademark, the center of the bottle is in a cylinder with 12 rectangle-like patterns on the lower portion of

the bottle, thus making the bottle have a beautiful curve, and the bottom of the bottle has a crescent-shaped wreath surrounded.

- (3) Signs with three-dimensional shape (other than three-dimensional shapes of goods or of packaging/container of goods)

Signs with three-dimensional shape (other than three-dimensional shapes of goods or of the packaging/container of goods) refer to any three-dimensional shapes that are not related to the goods or to their packaging/container. If a three-dimensional shape is closely related to the goods or services, such as the sign " mounted on the hood of Mercedes-Benz automobile, uncle McDonald in front of McDonald stores, and a bun-shaped toy figure in front of Dingtaifeng stores, the distinctiveness thereof is determined by the same criteria that would apply to two-dimensional trademarks. In other words, signs with three-dimensional shape are deemed to be distinctive as long as according to the marketing modes and practices adopted by today's industries, the relevant consumers are able to recognize the three-dimensional shapes used on goods or services as a source indicator, instead of an ornament or a background design, and also the signs are sufficient to cause the consumers to perceive them as the ones indicating specific goods or services and distinguishing them from those of others. When a three-dimensional shape is not closely related to the goods or services, consumers will normally not regard it as a source indicator. For instance, when ornamental three-dimensional toy figures or action figures are merely used to promote goods or services, because toy figures are available in a variety of styles, they can be registered as a trademark only after there is proof showing acquired distinctiveness.

- (4) Decor of the place where services are provided

The decor of the place where services are performed is the external decoration of the place of business. The criteria for determining the distinctiveness of the decor is the same as those applying to the shape of the packaging/container of goods. An application for registration of a decor frequently used shall be rejected because it is devoid of distinctiveness (Subparagraph 3, Paragraph 1, Article 29 of the Trademark Act). A decor can be granted registration only after there is proof of its acquired distinctiveness

(Paragraph 2, Article 29 of the Trademark Act). However, when the appearance or decor of the place where services are provided is exceptional and makes a deep impression on the public and it has been associated with a specific business source at the time of filing, thus functioning as a source indicator, it should have trademark distinctiveness.

Example:



Description: The trademark is three-dimensional and consists of the configuration of the multi-sectioned 101 supertall skyscraper and a group of shorter buildings. In the supertall skyscraper, the floors from the 27<sup>th</sup> to the 90<sup>th</sup> are composed of 8 independent sections with each section comprising 8 floors, in which the top floor of each section leans outward at 7° and rises upward in a flower shape. The appearance of the skyscraper is in the shape of bamboo sections with cloud-like metal protrusions adorned on the four corners of each section and a Ruyi (如意) device at the center of each face of every section. To echo the core theme of "financial center", "a square-hole ancient coin" covering the height of about 4 floors-is adorned across the facades from the 24<sup>th</sup> floor to the 27<sup>th</sup> floor of the skyscraper. The light-through awnings on the tops of the group buildings in the mark are in the shape of Chinese Ruyi (如意).

#### 3.2.3.1 Descriptive three-dimensional shapes

When a three-dimensional shape consists of a description of the quality, use, raw material or relevant features of the designated goods or services, it does not serve as a sign capable of being recognized by relevant consumers as an indication of the source of goods or services and thus, cannot be registered (Subparagraph 1, Paragraph 1, Article 29 of the Trademark Act). For instance, the three-dimensional shape of a tooth or an eye used on dentist or ophthalmic signboards would not be

granted registration because it is descriptive of tooth or eye medical services provided by the clinic.

#### 3.2.3.2 Generic three-dimensional shapes

When a generic three-dimensional shape is commonly used for specific goods or services by relevant traders and becomes well-known to the public and the industry, it cannot serve as a source indicator for consumers. Therefore, such shape should not be registered because acquisition of its exclusive rights by anyone would affect fair competition (Subparagraph 2, Paragraph 1, Article 29 of the Trademark Act). Examples of three-dimensional shapes that are commonly adopted by relevant industries include the shape of a generic bottle used for wines, in which it has a thin neck and round body; the shape of a generic cylindrical bottle for jam or pickles; the shape of a rectangular cigarette pack for cigarette; and a heart shape for chocolate or candies.

Since the exclusive use of a generic three-dimensional shape by a single party would severely affect fair competition, this type of shapes cannot be granted registration by the showing of acquired distinctiveness (Paragraph 2, Article 29 of the Trademark Act).

#### 3.2.3.3 Other three-dimensional shapes which are devoid of any distinctiveness

A simple geometric shape or the decor or the furnishing of the place where the services are performed, according to consumers' recognition, does not function to identify the source of goods or services. For instance, general decor used for restaurant services and a beckoning cat (referring to bringing money) used for retail services are both examples of non-distinctiveness.

#### 3.2.4 Functionality

If a three-dimensional shape is indispensable for the use or the intended purpose of the goods or services or affects their cost or quality, it is deemed functional. When a functional three-dimensional shape has competitive advantages over the



same categories of goods or services, to make general traders freely use it for fair competition, no one is allowed to acquire the registration of the shape as a trademark for permanent exclusive. However, the creator may acquire protection of such shape for certain period of time pursuant to the Patent Act. Even if a functional three-dimensional shape is exclusively used during the patent term, thus having the function of identifying the source of goods, it may not be registered (Subparagraph 1, Paragraph 1, Article 30 of the Trademark Act).

In respect of functionality, the following factors should be considered:

- (1) Whether the shape is essential to the use or the intended purpose of the goods

The phrase "the shape being essential to the use or the intended purpose of the goods" means that the shape is needed to perform the intended purpose of the goods and no other alternative shape is available. For example, a car wheel can only be of circular shape; therefore, a circular configuration cannot be registered as a trademark for car wheels because it would confer an exclusive right to one single party. Similarly, a sewing needle must have a sharp point at one end and an oval hole at the other end for a thread to go through. Such shape is indispensable for a sewing needle to perform the intended function of sewing or mending clothes. An application for registration of such a shape would have to be rejected because a monopoly by one single party would severely affect fair competition.

- (2) Whether the shape is essential to achieve a particular technical effect

When a three-dimensional shape is essential to achieve a certain kind of technical effect, it means that the feature of the shape is only designed for a particular technical purpose. For example, the shape of vanes in a fan is indispensable to generate a special air flow effect; therefore, an applicant cannot register the shape of vanes for fans. If the granting of trademark rights to a three-dimensional shape that can achieve a particular technical effect would restrict other competitors' use of that shape and impede fair competition, even if an alternative shape that can achieve the same effect is available, the fact that such shape is functional still cannot be overcome.

The issue of whether a three-dimensional shape is indispensable for achieving a technical effect may be evaluated by taking into account, among other criteria, whether an invention patent or a utility model patent has been obtained for the shape. This is because the existence of the invention or new utility model patent rights may indicate that the shape has a practical function, and thus may serve as *prima facie* evidence of the fact that the shape is indispensable for achieving a technical effect. Even though the invention or utility model patent expires, such expiration does not affect determination of whether such shape is functional. Additionally, if the applicant has emphasized in its advertising or promotional activities that the three-dimensional shape is functional or is indispensable for achieving some kind of effect, and such statement is not exaggerated for advertising purpose, this fact may also be used as supporting evidence when judging whether the three-dimensional shape is indispensable for achieving some kind of effect. In addition, advertisements and reports containing matters identical or similar to that particular shape or technical features carried in the publications of any competitors or the industry may also serve as reference for determination of functionality.

- (3) Whether the shape results from easier manufacturing or lower costs, or leads to better end results.

If a shape results from easier manufacturing or lower costs, or leads to better end results, the registration of the shape as a three-dimensional trademark, which will confer on the applicant the trademark rights, would result in unfair competition and materially affect public benefits, because other competitors, in order not to infringe the trademark, will have to increase their manufacturing costs or adopt a comparatively difficult or inferior method of manufacturing other shapes, which will cause a waste of social and economic resources. Such a shape cannot be registered because it is functional. The shape of cookies extruded or cut during the manufacturing process, such as circular or rectangular shape, is an example.

## **4. Color trademarks**

### **4.1 Definition**

A color trademark is a sign simply consisting of one single color or multiple colors.

The single color or color combinations thereof has/have the function to indicate the source of goods or services. As a composite trademark comprised of color(s) coupled with word(s), design(s), or symbol(s) does not identify the source of goods or services by colors, it is deemed a design or word trademark rather than a color trademark.

## **4.2 Examination of color trademarks**

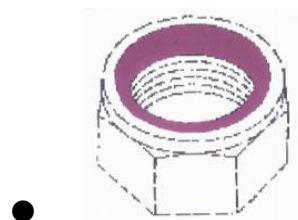
### **4.2.1 Reproduction**

The reproduction of the color trademark shall consist of a sample of the color or colors. The reproduction may use broken lines to show the manner, placement or context in which the color is or the colors are used on the designated goods or services (Paragraph 1, Rule 14 of the Enforcement Rules of the Trademark Act). The matter shown by broken lines is not a part of the trademark. The applicant shall furnish a description explaining such broken lines (Paragraph 2, Rule 13 of the Enforcement Rules of the Trademark Act).

### **4.2.2 Description**

The applicant shall furnish a description indicating the color or colors by a term(s) recognized by the public and the manner in which it is/they are used on the designated goods or services (Paragraph 2, Rule 14 of the Enforcement Rules of the Trademark Act).

Examples:



Description: The color trademark consists of the color purple applied on the non-metal inner circle of a nut, as shown in the reproduction. The portion in broken lines is not part of the trademark.



Description: As shown in the reproduction, the color trademark consists of a combination of two green-based color bands and three blue-based color bands, i.e., light green, green, dark blue, light blue and blue in the ratios of 20%, 10%, 15%, 5% and 50% from left to right, which are maintained at a fixed sequence and ratio and vary along with the size of relevant goods and the available space.

To precisely define the color(s) sought to be protected and enable third parties (in particular, competitors) to accurately know the registered trademark and the scope of rights thereof, in particular, in the case of an application for registration of one-color trademarks, the applicant may be notified to furnish an international color code to precisely show the color to be registered, whereby color difference of such trademark resulting from scan, file transfer, etc. may be avoided. The applicant may also refer to an international color identification system to describe the color(s), which will facilitate the determination of distinctiveness of the proposed color trademark and the scope of rights as claimed. An example is provided as follows: "As shown in the reproduction, the color trademark in this case consists of the color green (Pantone 348C) used on the lid of a box for the designated goods. The shape of the box depicted in broken lines is not part of the trademark."

#### **4.2.3 Distinctiveness**

Like other types of trademarks, a color trademark can be registered only if it is distinctive enough to identify the source of the goods or services and thus, enables consumers to distinguish these goods or services from those of others.

A color trademark, in particular a single-color trademark, is often perceived as an ornament by consumers. Therefore, a color trademark is never inherently distinctive. When a trademark consisting of multiple colors is unique in the colors used or the ratios of the colors, it would be more inherently distinctive than a single color. If a trademark consisting of a combination of multiple colors is inherently distinctive and

can be recognized by consumers as an indicator of the source of goods or services, it can be registered without showing acquired distinctiveness. Indisputably, it would be more difficult for a trademark consisting of multiple colors to be inherently distinctive than a general design trademark. A multiple-color trademark can be registered only if there is proof of acquired distinctiveness.

It is easier to prove the distinctiveness of a color trademark if the applicant particularly emphasizes in advertising or marketing campaigns the specific color. For example, the expressions such as "please identify this unique color," "please look for this attractive color," "look for the orange box" or "unique color" are all used to educate consumers to consider the specific color(s) as a source indicator of the goods or services. Additionally, the extent and the duration of use of the color(s) on the designated goods or services, the sales status, the advertising expenditures, and the consumer surveys are also factors for determining whether the color is distinctive or not. Generally, it would be more difficult for a single color to have acquired distinctiveness through use than a multiple-color trademark unless the applicant can prove that such a single color trademark for specific goods or services is exceptionally special.

#### 4.2.3.1 Descriptive colors

A color trademark shall not be registered if it consists exclusively of a description of the quality, intended purpose, material, place of origin, or relevant characteristics of the designated goods or services and is not capable of being recognized by relevant consumers as an indication of the source of goods or services (Subparagraph 1, Paragraph 1, Article 29 of the Trademark Act). For example, a color is not registrable if it is a description of the flavor of goods, such as the color red for tomato or strawberry flavor, the color yellow for lemon flavor, and the color green for mint flavor. Therefore, an application for registration of the color red, the color yellow or the color green in connection with tomato-flavored, strawberry-flavored or lemon-flavored or mint-flavored goods would not be granted registration. Also, an application for registration of the color black, brown or gold on hair dyes would not be granted registration because such colors are descriptive of the dyed hair.

#### 4.2.3.2 Generic colors

Generic colors, including colors that are commonly seen by the public due to common use by relevant traders and the natural colors of goods, should not be allowed for registration as trademarks (Subparagraph 2, Paragraph 1, Article 29 of the Trademark Act). For example, "the color red" for fire extinguishers is not registrable because such a color is a generic color for extinguishers; the color white for milk products is not registrable because this is the natural color of milk; and the color brown for ropes or straw mats is not registrable because this is the natural color of hemp ropes or mats.

As the exclusive use of a generic color trademark by a single party would seriously affect fair competition, the trademark cannot be accepted for registration through the showing of acquired distinctiveness (Paragraph 2, Article 29 of the Trademark Act).

#### 4.2.3.3 Other colors which are devoid of any distinctiveness

Colors are often combined with word(s), symbol(s) or design(s) to be applied on relevant goods or services. Consumers are less likely to consider colors alone as a source indicator of the goods or services without considering the words, symbols or designs. As the color of goods or their packaging often has ornamental or aesthetic function, it cannot be deemed distinctive just because it is seldom used by traders. In the case of dental floss that emphasizes cleaning and refreshing, even if the color white is often used for dental floss and the color black is not customarily or commonly used by relevant traders, the color black for dental floss is deemed to have no inherent distinctiveness because such a color is exactly the color of the goods themselves and consumers will not consider the color alone as a source indicator of the goods (Subparagraph 3, Paragraph 1, Article 29 of the Trademark Act).

#### 4.2.4 Functionality

The term "functional color" refers to the color that is required to achieve the intended purpose or the technical result of, or that affects the cost or quality of, the designated goods or services. For example, in the cases of the color black used for solar energy collectors and the color silver used for building heat-insulating panels, as

the color black is easy to absorb heat and the color silver can reflect the sun light and reduce the energy absorption rate of the goods, each of the color is necessary to perform the function of solar energy collectors or building heat-insulating panels. Therefore, these colors cannot be registered due to public interests. Additionally, some colors may be deemed functional if they represent specific meanings according to the general ideas prevailing in society. For example, an application for registration of the color red or orange for traffic warning devices is deemed functional and should not be granted registration because the color red or orange is commonly used as an indicator of danger or warning. In the floral industry, the color also plays an important role and communicates specific business atmospheres and messages such as elegance, joy, bereavement, and Halloween. This kind of function will extend to the packaging of goods as used or the articles relating to the services (Subparagraph 1, Paragraph 1, Article 30 of the Trademark Act)..

## **5. Sound trademarks**

### **5.1 Definition**

A sound trademark is a sign that consists mainly of sound and identifies the source of goods or services through audio means. A sound trademark may contain music (e.g., a series of tones or a small part of a song) or non-music matters (e.g., narrator's voice or roar of a lion), and the sound by itself is capable of identifying the source of goods or services.

### **5.2 Examination of sound trademarks**

#### **5.2.1 Reproduction**

A sound trademark consisting of music elements should be represented by a musical notation on a stave or a numeric music score. Where a sound trademark consisting of non-music elements cannot be represented by a musical notation on a stave or a numeric music score, the reproduction shall clearly and completely explain of the sound to cover all features of the trademark (Paragraph 1, Rule 18 of the Enforcement Rules of the Trademark Act). For example, "the trademark is a sound trademark consisting of "福氣啦" (pronounced "ho-ki-la") spoken out by human voice in Taiwanese"; "the trademark is a sound trademark consisting of "你累了嗎" (pronounced "ni-lei-le-ma") spoken out verbally; or "the trademark is a sound

trademark and consists of the famous Tarzan yell which is made up of a series of approximately ten sounds, alternating between the chest and falsetto registers of the voice, as follows: 1) a semi-long sound in the chest register, 2) a short sound up an interval of one octave plus a fifth from the preceding sound, 3) a short sound down a Major 3<sup>rd</sup> from the preceding sound, 4) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 5) a long sound down one octave plus a Major 3<sup>rd</sup> from the preceding sound, 6) a short sound up one octave from the preceding sound, 7) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 8) a short sound down a Major 3<sup>rd</sup> from the preceding sound, 9) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 10) a long sound down an octave plus a fifth from the preceding sound." For a sound trademark consisting of both music and non-music matters, the reproduction of the trademark must show the music matters, and any narrator's statement or other non-music matters contained in the trademark are described in the description thereof.

### 5.2.2 Description and specimen

Where the reproduction is a musical notation on a staff or a numerical musical score, the applicant shall furnish a written description of the trademark (Paragraph 2, Rule 18 of the Enforcement Rules of the Trademark Act). For a trademark solely comprising a musical tone such as "INTEL Sound Mark", the trademark can be clearly and completely represented by its reproduction, so the description of the trademark just simply states that "the proposed trademark is a sound trademark that consists of five successive tones, i.e. D Flat, D Flat, G Flat, D Flat and A Flat." When a trademark, in addition to musical tone and lyrics, contains statements by a narrator or other features, the trademark description should state the same. In the case of TM "Enrich your life 國泰世華銀行," the reproduction of the trademark is a musical score, and the description states that "the proposed trademark is a sound trademark consisting of musical notes that are sung with the words 'ENRICH YOUR LIFE' in multiple parts singing by male voice." In the case of TM "萬應白花油之歌," the reproduction of the trademark is a musical score, and the description states that "the proposed trademark is a sound trademark consisting of musical notes and words chanted in children's voice, in which the words are '我有一位好朋友,隨時隨地關心我,啦啦啦啦萬應白花油;提神醒腦頭不痛,(口白:白花油!被蚊蟲咬一口,不怕腫,yeah!)



啦啦啦啦萬應白花油." ("I have a good friend who always cares about me, la la la la Wang-Yin White Flower Embrocation; keep you awake and no more headache (narration: White Flower Embrocation! No more fear of swelling even bitten by mosquitoes or insects, yeah!) la la la la Wang-Yin White Flower Embrocation")

Example:

●



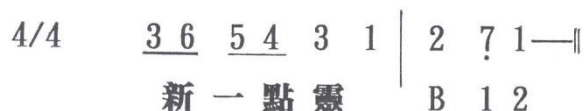
Description: The trademark is a sound mark that consists of five successive tones, i.e. D Flat, D Flat, G Flat, D Flat and A Flat."

●



Description: The trademark is a sound mark of a five-note tune comprising the notes A (one beat), G (one and a half beats), G (half beat), D (one beat), and C (one beat), accompanied by the lyrics "好湯在康寶."

●



Description: The trademark is a sound mark, as recorded in the CD attached to the application, and is a tune comprising the notes E, A, G, F, E, C, D, B and C, accompanied by the lyrics "新一點靈 B12."

When a sound trademark cannot be represented by a musical notation on a stave or a numeric music score, the applicant should clearly describe the trademark in words that is similar to a trademark description. In the context, the trademark description is no more required. In preparing an application form, in particular, an electronic application, the applicant may fill in the trademark description the lines: "The description of the trademark may refer to its written description and audio file".

A sound trademark is perceptible through audio means. Even if a musical sound trademark can be clearly and completely represented by a musical notation on a stave or a numeric music score, the examination of the trademark would be easier when the sound trademark can be directly heard. For a sound trademark containing non-music matters, a specimen of the sound should be furnished. The applicant should furnish an electronic data carrier bearing such sound, which conforms to the format published by the Registrar Office (Paragraph 3, Rule 18 of the Enforcement Rules of the Trademark Act).

The reproduction of a trademark is meant to determine the scope of the trademark rights. Meanwhile, the description of a trademark (in the nature of music) and the specimen of a trademark are both used to supplement the reproduction so as to define the scope of the trademark rights. Therefore, the description and specimen of a trademark must correspond to its reproduction. In filing an application, the applicant must notice if the reproduction and the description of the trademark can precisely show the content of the trademark sought to be protected.

### **5.2.3 Distinctiveness**

Like other types of trademarks, sound trademarks can be registered only if they are distinctive enough to identify the source of goods or services and enable consumers to distinguish these goods or services from those of others. A sound trademark is often used to convey a trader's operation concepts or the features of the goods or services provided, or even serves as a background music to attract consumers' attention. Therefore, consumers often start to link a sound with a specific source only after the sound has been frequently used. Under such circumstances, the sound trademark has the function to denote the source and can then be registered. However, it is also possible that a sound trademark is inherently distinctive. A simple rhythm or a slogan in the form of sound can be registered as a trademark only when it has acquired distinctiveness through use. In the cases of "通信的好鄰居" ("good neighbors for communication") composed of simple musical notes for use on mobile phones and of a common song or lengthy musical composition, in principle they can be accepted for registration only when they are demonstrated to have acquired

distinctiveness (Paragraph 2, Article 29 of the Trademark Act). However, short sounds with high distinctiveness may be considered as inherently distinctive. For instance, in the cases of "Hi life, Hi life 萊爾富" (convenience store) sung aloud by a soprano, a human voice yodeling "YAHOO", and "特力屋" sung in four notes by C major, "Hi life" "萊爾富", "YAHOO" and "特力屋" are highly distinctive, so consumers, when hearing these sounds, will directly perceive them as indicating a specific source; the sounds are inherently distinctive because they have the function to identify the source of the goods or services.

#### 5.2.3.1 Descriptive sounds

A sound cannot be registered if it consists exclusively of a description of the quality, intended purpose, material, place of origin, or relevant characteristics of the designated goods or services and is not capable of being recognized by relevant consumers as an indication of the source of goods or services (Subparagraph 1, Paragraph 1, Article 29 of the Trademark Act). Examples of descriptive sounds include a famous classical music work used for music performance services and the sound of dog barking or the sound of cat meow used for pet articles or pet medical services.

#### 5.2.3.2 Generic sounds

A generic sound refers to a sound commonly used for specific goods or services by traders and is commonly known to the public. A generic sound cannot be perceived as a source indicator by consumers, and should not be granted registration because its exclusive use by anyone affects fair competition (Subparagraph 2, Paragraph 1, Article 29 of the Trademark Act). Some examples are as follows: The "Good Night Song" by the singer Fei Yu-ching is commonly played by department stores to remind customers of the approaching closing time; therefore, such song for department store services would be deemed generic. Similarly, "The Maiden's Prayer" is the sound used by garbage trucks during a collection run; therefore, the music used for cleaning services is deemed a generic sound. The "Wedding March" is the sound commonly used at wedding ceremonies; therefore, the use of the sound for wedding services or wedding cakes would be deemed generic.

#### **5.2.3.3 Other sounds which are devoid of any distinctiveness**

In the main, sounds produced by machine operations are not inherently distinctive (Subparagraph 3, Paragraph 1, Article 29 of the Trademark Act), i.e., the "Ding" sound made when operating cash registers (in connection with retail services), the "Ding" sound upon completion of microwave operation (in connection with microwave ovens), or a mobile phone ringtone (in connection with mobile phones). Similarly, a children's laughter in connection with kindergarten services and the sound of cheering and clapping for conducting of educational or entertainment competitions are not inherently distinctive because the sounds cannot serve as signs for consumers to identify the source. As for general songs or lengthy music compositions, they, in principle, do not have the function to indicate a source, so they can be registered as trademarks only after the showing of acquired distinctiveness.

#### **5.2.4 Functionality**

If a sound is indispensable for performing the use or the intended purpose of, or affects the cost or quality of, certain goods or services, it may not be registered because it is functional (Subparagraph 1, Paragraph 1, Article 30 of the Trademark Act). Examples of functional sound trademarks include sounds produced by machine operations, i.e., the sound of a motorcycle engine for motorcycles or motorcycle engines, and the sound of a camera shutter for cameras. The siren of an ambulance for ambulance transportation and rescue transportation services is deemed functional as it has a warning function; similarly, the "beep" sound of different frequencies used for vehicle transportation is deemed functional as it reminds drivers that the vehicle is moving backward.

### **6. Motion trademarks**

#### **6.1 Definition**

A motion trademark refers to a sequence of moving images, which have the function to identify the source of goods or services. The subject matter protected by a motion trademark is the overall commercial impression established by such moving images. In other words, the trademark rights are granted to the entire moving images,

rather than any word, design, or symbol appearing in the course of change. If any word or design appearing in the course of change of moving images desires to acquire trademark rights, a separate application for registration of such general word or design trademark needs to be filed.

## **6.2 Examination of motion trademarks**

### **6.2.1 Reproduction**

A motion trademark is comprised of sequential images. The reproduction of a motion trademark consists of the still presentation of the varying process of the moving images. Because of the different sequential movements, different number of still drawings may be required. Two to four still drawings are required for simple moving images, while more still drawings are required for complex motion trademarks so as to completely and adequately represent the trademarks. Meanwhile, in order to comply with TIPO's information system and to facilitate its examination, applicants are required to furnish a maximum of six still drawings to present the varying process of moving images.

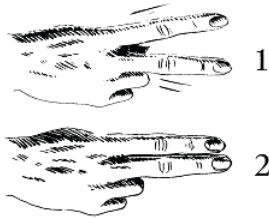
In filing a motion trademark application, the key features of the trademark must be indicated clearly and completely in the attached reproduction. Thereafter, any additional drawings of the motion trademark provided by the applicant should be included in the reproduction furnished at the time of filing and would not affect the filing date thereof. If the still drawings of the motion trademark supplemented thereafter contain any additional features that are not shown in the original reproduction, such trademark is not exactly the same as the one shown in the original trademark reproduction. The above then violates the provision that after a trademark is filed for registration, no substantial change to such trademark should be made (Article 23 of the Trademark Act).

### **6.2.2 Description and specimen**

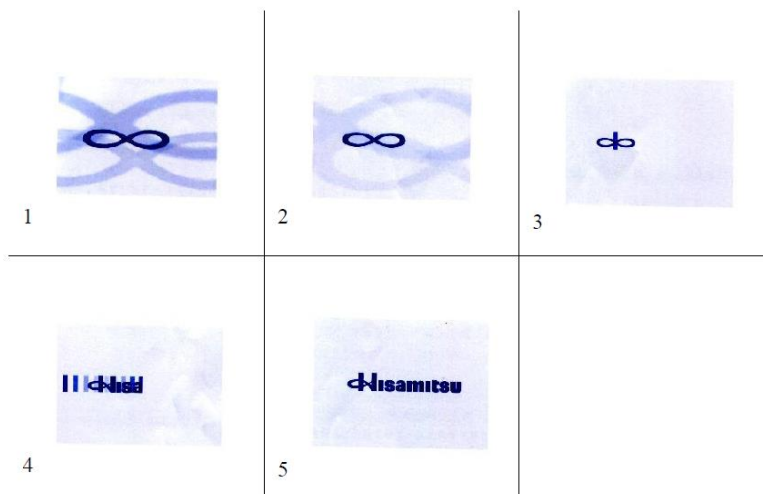
The applicant shall furnish a description explaining the movement in the sequential order (Paragraph 2, Rule 16 of the Enforcement Rules of the Trademark Act). The description must be made in an explicit and detailed manner in order to

supplement the sequential movements of the trademark that cannot be represented by its reproduction. The description should also specifically indicate the number of still drawings constituting the motion trademark.

Examples:



Description: The trademark is a motion trademark, as shown in the reproductions. It consists of two images showing the successive movements of the first finger and the middle finger moving like a pair of scissors.



Description: The trademark is a motion mark, as shown in the reproduction, and consists of five images with blue wording and device. It comprises a sequence of moving images of an "infinity sign" ( $\infty$ ) appearing before viewers, such as 1<sup>st</sup> and 2<sup>nd</sup> images; then, a blue vertical stripe appearing in the middle of "the infinity sign" moves fast to the left and the right of the sign, while "the infinity sign" quickly changes to the stylized word "HISAMITSU" and also, a moving image of a larger infinity sign as the background vanishes from sight, such as 3<sup>rd</sup> to 5<sup>th</sup> images. The grey portion represents the background and is not part of the trademark.

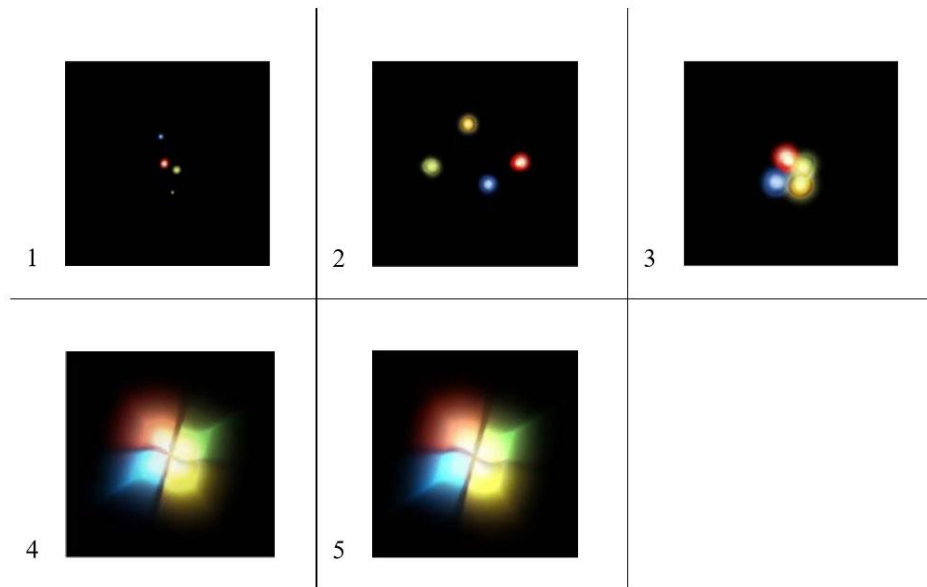
A motion trademark, which refers to the sequential changes of moving images, must be supplemented with specimens in order to show all the elements of moving images in details. Therefore, the applicant should furnish an electronic data carrier carrying such moving images in a format prescribed by the Registrar Office in order to facilitate the examination (Paragraph 2, Rule 16 of the Enforcement Rules of the Trademark Act).

### **6.2.3 Distinctiveness**

Like other types of trademarks, motion trademarks can be registered only if they are distinctive enough to identify the source of goods or services and to enable consumers distinguish these goods or services from those of others.

Sometimes, a motion trademark can take the form of a motion screen picture appearing while an electronic product is switch-on or during the opening of specific software or function, or a motion advertisement from multimedia. As consumers will not directly consider those motion images as signs indicating the source of goods or services, the motion images are not in principle inherently distinctive. However, with time, consumers are able to link these moving images with a source of specific goods or services because of use, and the images are then deemed having acquired distinctiveness as they have the function of serving as a source indicator. As for a motion trademark containing a high distinctive design or word trademark, if consumers, while first encountering it, will not only recognize it as relating to a specific business source, but also consider it as a sign denoting the source of specific goods or services, the motion trademark is deemed inherently distinctive.

Example:



For example: Microsoft Corporation presents an animated sequence of images that have been extensively applied on its computer-related goods and have highly distinctiveness. As Microsoft uses the design trademark to be played on the screen while opening computer software, consumers will directly perceive the moving images as a source indicator of specific goods or services. Therefore, the design trademark is inherently distinctive.

For traditional trademarks, simple geometric patterns or ornamental patterns are often refused for registration for being devoid of any distinctiveness (Subparagraph 3, Paragraph 1, Article 29 of the Trademark Act). On the contrary, where motion trademarks can successfully convey a certain commercial impression through their varying changes and be recognized as trademarks by consumers, they are still deemed as having distinctiveness. For example, a motion trademark consisting of the varying process of a ring of light, in which the ring of light appears from dark to light and finally to dark again, can be granted registration because the varying process of the ring would be easily recognized by consumers as a source indicator.

The esination of distinctiveness of a motion trademark must take into account the duration and the complexity of the moving images. Generally speaking, a lengthy film or a film having excessive commercial effect or content is hard to be deemed as having distinctiveness. Additionally, how relevant traders of the goods or services use



a motion image as a trademark for promotion purpose can also be a factor to consider if consumers can recognize it as a trademark.

When motion images consist exclusively of a description of the quality, intended purpose, material, place of origin, or relevant characteristics of the designated goods or services (e.g., a film showing cleaning effect of goods, a motion film showing assembly of goods, and a film showing sports or craftsmanship demonstration) or of moving images commonly used by relevant traders for specific goods or services (e.g., a film showing how to make milk or a film showing a tea garden or coffee garden), the images would not be registered because it is not capable of being recognized by relevant consumers as an indication of the source of goods or services (Subparagraph 1, Paragraph 1 of Article 29 of the Trademark Act).

#### **6.2.4 Functionality**

If the content of motion images is indispensable for the use or the intended purpose, or affects the cost or quality, of goods or services, the motion images are deemed functional. For example, the movement of a clock pendulum used for clocks and the movement of opening and closure of a car door used for cars cannot be granted registration through the showing of acquired distinctiveness.

### **7. Hologram trademarks**

#### **7.1 Definition**

A hologram trademark refers to the use of a hologram as a sign to identify the source of goods or services. A hologram is made up of multiple images on a negative, which are stored via technology designs. The images are three dimensions either in multiple pictures or one picture only, and the color of the pictures varies depending on the different perspectives. A hologram is often used as an anti-counterfeiting label for money notes, credit cards or other valuable products and can also be found on product packaging or ornamentation.

#### **7.2. Examination of hologram trademarks**

### 7.2.1 Reproduction

The reproduction of a hologram trademark consists of the perspective drawing(s) of the hologram. One perspective drawing is required for a hologram that consists merely of one single representation, while a maximum of four perspective drawings are required for a hologram that generates different representations depending on different perspective views. Where a hologram trademark generates different drawings because of different perspective views, those drawings must generate the same commercial impression; otherwise, it would violate the provision that "an application must be limited to only one mark" (Paragraph 4, Article 19 of the Trademark Act). If any of the perspective drawings furnished later on contain any new features not included in the original trademark, the one shown on these drawings is not deemed the same as the trademark originally furnished. The above then violates the provision that after a trademark is filed for registration, no substantial change to such trademark should be made (Article 23 of the Trademark Act).

### 7.2.2 Description and specimen

The reproduction of a hologram trademark simply shows the graphic features of the hologram but cannot exactly represent the hologram effect. Therefore, the applicant should provide a description stating the hologram. For a hologram that generates different representations because of different perspective views, the description should include the changes of the different perspective drawings so as to clearly determine the scope of claimed rights in the proposed hologram trademark. For instance, in the case of a hologram trademark with optical variations because of different views, the description has to state that "the trademark is a hologram trademark, as shown in the reproduction, and generates optical variations along with different perspective views." Where a trademark reproduction has three-dimensional effect or varies depending on different perspective views, the applicant is required to provide a detailed description of the trademark stating the three-dimensional effect or the changes of the perspective drawings.

Example:



Description: The trademark is a hologram trademark, which consists of the blue words "VIDEO FUTURE" on a black background, three floating blue spheres showing the white letters "VF," and blue wavy lines connecting these spheres.

If necessary, the applicant may be notified to furnish trademark specimens. In particular, in the case of a hologram trademark in which different perspective views may result in changes to the hologram, the specimens thereof are required to be furnished to facilitate examination.

### 7.2.3 Distinctiveness

Hologram trademarks are signs with a hologram effect. Unlike traditional two-dimensional trademarks, hologram trademarks are changeable in colors because of hologram technology, or are presented in three dimensions, or even present different representations along with different perspective views. In the main, holograms are subject to the same guidelines as traditional trademarks. Therefore, determination of the distinctiveness of hologram trademarks must follow the Examination Guidelines on Distinctiveness of Trademarks. Where a hologram trademark incorporates any non-distinctive elements, whether conflicts over the scope of trademark rights in such elements are likely to occur and a disclaimer is required must refer to the Examination Guidelines on Disclaimers. As recognized by consumers, a hologram is normally used for security and anti-counterfeiting purposes. Therefore, a hologram can be registered as a trademark only if there is evidence that consumers would consider the hologram as a source indicator, not merely a label for security and anti-counterfeit purpose or an ornamentation of goods.

### 7.2.4 Functionality

As mentioned above, a hologram is a sign with a hologram effect and the examination guidelines therefor are identical with those for traditional two-dimensional trademarks. Therefore, functionality is not the focus for examination of holograms. If disputes arise over the functionality of a hologram, the determination should depend on the definition of functionality (see Section 2.3 of the Guidelines).

## **8 Repeating-pattern trademarks**

### **8.1 Definition**

A repeating-pattern trademark is a mark consisting of a device repeatedly used and extensively applied on goods or packaging or containers thereof; or on the entire or partial surface of objects related to the provision of services or the places where services are provided. The repeating pattern per se has the function of distinguishing the sources of goods or services. A repeating-pattern trademark may be composed of a single element, or a combination of design patterns, numbers, letters or other words.

### **8.2 Examination of repeating-pattern trademarks**

#### **8.2.1 Reproduction**

The reproduction of a repeating-pattern trademark may be created by presenting the element in a repeated manner, or may also use broken lines to show the manner, placement, or context in which the trademark is used on the designated goods or services. In particular, the specific placement where the repeating pattern is used on the goods must be indicated in order to show exactly how the trademark is actually used, and should be detailed in the trademark description. It should be noted that the portion depicted in broken lines is not part of the trademark (Paragraph 2, Rule 13 of the Enforcement Rules of the Trademark Act).

Example:



Description: This is a repeating-pattern trademark of a checkerboard pattern that is applied on the upper and heel of the shoes. The broken lines, which form the outline of the shoes, merely serve to highlight the positions where the checkerboard pattern is used and is not part of the trademark.

In an examination, the use of broken lines to show the manner, placement, or context in which the trademark is used on the designated goods or services is often helpful in determining whether the repeating pattern is distinctive. When the applicant uses a repeating pattern on goods or objects of a similar nature in a similar manner, placement, or context, he/she may take just one of such goods as an example to illustrate how the trademark is applied. For instance, when a repeating pattern is applied to the handle of a table knife, spoon, table fork or other goods of a similar nature, the reproduction thereof may use broken lines to delineate the outline of one of the goods, and the manner and placement of the repeating pattern on the goods. The applicant should also clearly explain in the description how the repeating pattern is applied on other relevant goods. It should be noted that, where the repeating pattern was originally shown on the handle, but is subsequently changed to appear in a different manner, such as on the blade of the knife or head of the spoon, it shall be construed as a substantial change to the trademark reproduction and is not allowed (Article 23 of the Trademark Act).

Example:



Description: This is a repeating-pattern trademark. As illustrated in the application, the trademark consists of a series of diamond-shaped patterns separated by thin

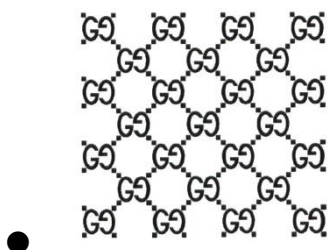
striped lines of green/red/green in the middle. The repeating pattern is used extensively on the entire or part of the goods in unfixed direction or placement.

If the repeating pattern filed for registration is used in various forms on a number of different goods or services, provided there is objective evidence showing that the manner of its use has already been recognized by consumers and generated a commercial impression that they are from the same source, then the applicant may present part of the repeating pattern in a rectangular shape (as depicted above) to show the composition elements and how the elements are arranged, with a detailed explanation in the description. However, if broken lines are used in the original reproduction to depict the manner in which the repeating pattern is used on the designated goods or services, then the applicant may not subsequently represent the mark by depicting the repeating pattern in a rectangular shape. As the latter reproduction is not limited to a particular manner, size, or placement, and may be used on a number of different goods or services, it shall constitute a substantial change to the trademark that is not acceptable (Article 23 of the Trademark Act). Nevertheless, if a rectangular shape is used in the original reproduction, then the applicant may, in a supplemental application, utilize broken lines to show the manner, placement, or context in which the trademark is used on particular goods or services. This should not constitute a substantial change to the trademark.

### 8.2.2 Description

In a repeating-pattern trademark, the repeatedly used element is a feature of the trademark. In the description, it must be duly noted that the subject trademark consists of a repeating-pattern.

Example:



Description: This is a repeating-pattern trademark, as illustrated in the application. The repeating pattern is used extensively on the entire or part of the goods in unfixed direction or placement.

The manner the trademark reproduction is presented must be consistent with the description, with each serving as a reference for the other. If the trademark reproduction utilizes broken lines to illustrate the manner, size, or placement in which the trademark is applied on a particular item, an examination must be undertaken to see if the item stated in the description, and depicted in the reproduction, is consistent with the designated goods or services and if the manner of use of the mark is similar. If the goods or services designated for use by the applicant cannot accurately reflect the scope of rights of the trademark sought to be registered as shown in the reproduction and description, the applicant should be notified to delete the goods or services that cannot be fully covered in said reproduction and description. When the applicant submits an amendment, the scope of the trademark sought to be registered shall not be expanded, as the expansion may cause substantial changes to the trademark (Article 23 of the Trademark Act).

### **8.2.3 Distinctiveness**

Consumers often regard a repeating pattern as ornamental, rather than a sign indicating the source of goods or services. As such, the repeating pattern is devoid of inherent distinctiveness. The applicant should provide evidence to prove that the repeating pattern, through actual use, has become a sign eligible to identify the source of the applicant's goods or services in trade, thereby possessing acquired distinctiveness, and then the repeating pattern can be approved for registration.

However, in certain cases, a repeating pattern filed for trademark registration may be considered to be inherently distinctive. Relevant factors for consideration for each separate case include:

- (1) Whether the repeating pattern is commonly seen or extensively used on the designated goods or services

If there is objective evidence showing that the repeating pattern filed for

registration resembles any device that is commonly seen or extensively used on relevant goods or services, the repeating pattern in question may be deemed to be devoid of inherent distinctiveness. On the other hand, if the repeating pattern filed for registration is unique and extraordinary, it may be considered to be inherently distinctive. It shall be noted, however, that though the applicant may be the only user of the repeating pattern in question, such a fact cannot serve as the decisive factor for determining that the pattern is inherently distinctive. Whether the repeating pattern is distinctive or not is still determined by the manner and evidence for the use of the pattern.

#### (2) Nature of the repeating pattern's element

In a repeating-pattern trademark, the element thereof, while appearing separately, is already considered to be inherently distinctive. For example, for a repeating-pattern trademark consisting of coined or arbitrary wording or of elements with distinctive features, the relevant consumers are more likely to identify and distinguish the source of goods or services based on that repeating pattern; then, the repeating pattern is considered to be inherently distinctive.

#### (3) Industry practice

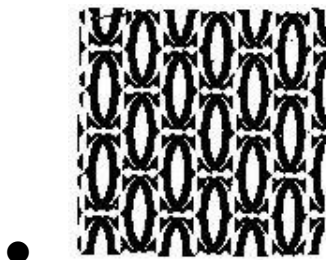
In the determination of whether a repeating pattern is inherently distinctive, industry practices related to the designated goods or services should be taken into account. For example, in some industry practices, a repeating pattern is customarily used on goods or services in an ornamental manner. Thus, relevant consumers often do not regard such pattern as a source indicator of goods or services, and the pattern should be considered to be devoid of inherent distinctiveness. Conversely, in view of the common practices of some industries, relevant consumers have already recognized the repeating pattern mark applied on the goods or services as a source indicator rather than a generic background device. Under the circumstances described above, it may be appropriate for such repeating pattern to be considered to be inherently distinctive.

#### (4) Type of goods or services designated for use



The type of goods or services covered by a repeating pattern is also one of the factors for determining if the pattern is inherently distinctive. For example, a repeating pattern used on clothing, bedclothes, furniture, stationery, and curtains is likely to be seen as ornamental, because consumers more or less take aesthetics into consideration when making a decision on buying and using the foregoing goods. However, if the goods or services on which the mark is used on are not purchased or used by consumers for their ornamental features, such as industrial machinery or surgical instruments, the repeating-pattern thereon has a greater chance to be considered inherently distinctive.

Example:



The trademark consists of an ever-extending repeating pattern. The use of such trademark on "cuff links, tie clips, rings, bracelets, earrings, necklaces, brooches, watches, chronometers, clocks, watch straps, watch bracelets, cases for watches and jewelry cases of precious metal" is perceived to be ornamental and insufficient for the relevant consumers to see it as a source indicator, and as such, the mark is devoid of inherent distinctiveness. Nevertheless, after the applicant provided evidence to prove that the trademark has acquired distinctiveness, the trademark in question has been granted registration pursuant to Paragraph 2 of Article 29 of the Trademark Act.



The repetitive element of this trademark is not a device commonly seen or widely used; rather, the trademark is made up a repetition of the stylized wording "Dior." The word "Dior", registered for "perfumed soaps, perfumes, perfumery, essential oils, cosmetics, and hair lotions", does not describe any matter, but is considered an arbitrary word used on the goods or services alone. The relevant consumers will see it as a source indicator. Even when used in a repeating pattern on goods, it shall still be considered to have the function of a source indicator. Therefore, the trademark is inherently distinctive.

#### **8.2.4 Functionality**

If a repeating pattern used on goods or services is found to be indispensable to the use or intended purpose of such goods or services, or to have an impact on the cost or quality of the same, then it shall be deemed functional. For example, a repeating pattern of particular repetitive elements may produce an effect of camouflage or concealment; when designated for use on clothing, the repeating pattern may be considered to be functional. Even if the repeating pattern does not have any practical function, circumstances where there may be "other competitive advantages" shall also be taken into account. For instance, if the repeating pattern provides certain key values to the goods or services by which the values become a decisive factor for consumers in making a purchase decision, and makes the goods or services create a competitive advantage by aesthetic functionality, it is unregistrable (Paragraph 1, Article 30 of the Trademark Act).

## **9 Scent trademarks**

### **9.1 Definition**

A scent trademark, as implied, makes use of a particular scent as a sign, provided that the scent already has the function of indicating the source of goods or services. A scent trademark may be presented via the designated goods themselves or packaging thereof, or the objects related to the provision of services or the places where services are provided. If the scent itself is not used in a functional manner, then it may be registrable.

## **9.2 Examination of scent trademarks**

### **9.2.1 Reproduction and description**

A scent trademark, like a sound trademark, is a type of trademark that cannot be perceived visually. The reproduction of a scent trademark should be presented in a clear, precise, self-contained, objective, durable, easily accessible and intelligible manner (Paragraph 3, Article 19 of the Trademark Act). According to Paragraph 1 of Rule 18 of the Enforcement Rules of the Trademark Act, the reproduction of a scent mark can use a description of the scent in words; that is, the description of the scent mark shall be submitted to replace the trademark reproduction, accompanied by the specimen thereof, to see if the mark complies with the trademark requirements under the Trademark Act. However, unlike a sound trademark which can have the sound stored in an electronic data carrier to assist in the examination and to accurately define its scope of rights, the scent trademark is one of the most challenging non-traditional trademarks to meet the requirement for presenting trademark reproduction.

For the reproduction to be presented in a clear, precise, self-contained, objective, durable, easily accessible and intelligible manner as required (Paragraph 3, Article 19 of the Trademark Act), when preparing a written description of the scent trademark as the reproduction, the applicant should ensure that the information conveyed by the description is in a clear, precise and objective manner to explain the scent filed for registration and in a way that is easily accessible and intelligible to consumers with common knowledge and experience. The description should clearly state that "the trademark is a scent trademark" and also be sufficient for relevant consumers to associate the mark directly with the scent in their memory, and thus further have a clear understanding of how the scent is perceived. Therefore, the analysis results obtained through techniques or equipment such as infrared spectroscopy, chromatographic techniques, vacuum fractional distillation, nuclear magnetic resonance and odor detectors ("electronic nose") are merely analytical information about the substance carrying the scent, rather than the perceptible impression

conveyed by the scent. The use of such analysis results alone as the written description of the mark does not meet the requirement specified in said provision.

A scent trademark is different from a visually-perceptible trademark or sound trademark. A third party cannot understand, directly through body or sense organs, the scent sought to be registered via trademark gazettes, trademark registers, or the official website of the trademark competent authority. Therefore, it is considerably challenging to prepare a written description of a scent trademark to make a third party clearly and precisely understand the essential quality of the scent and further to satisfy the requirement of Paragraph 3 of Article 19 of the Trademark Act. According to consumers' perception, a scent trademark filed for registration can be presented in the following two methods:

#### 9.2.1.1 Description by scents existing in nature

If the scent sought to be registered by the applicant exists in nature and is known to relevant consumers with common knowledge, it will create a similar and common impression. For example, the scent of citrus, lavender or mint is more likely to be associated directly and clearly by relevant consumers with a particular scent in their memory via such written explanations. If a specimen is supplemented for examination and found to be in keeping with the sensory perception of the scent, it should be deemed that the scent sought to be protected has sufficiently captured the essential quality of the scent trademark and therefore complies with Paragraph 3 of Article 19 of the Trademark Act. For example, "this is a scent trademark consisting of the fragrance of rose flower for use on plastic containers for household use."

It should be noted that, if, after reading the applicant's description of the scent, consumers perceive it to be a different one because their subjective cognition or life experience suggests differently, then such circumstances do not comply with Paragraph 3 of Article 19 of the Trademark Act. For example, in the case of the description stating: "This is a scent trademark consisting of the odor of bubble gum", according to the general ideas prevailing in society and the trading situations in the

market, "bubble gum", as perceived by consumers, may smell differently depending on the type of flavor and therefore does not have a particular scent. As such, the above circumstances fall short of the requirements stipulated in Paragraph 3 of Article 19 of the Trademark Act.

If the scent sought to be registered is a mixture of multiple naturally-existing odors, it may smell differently due to different compositions or different proportions thereof. As such, it would be difficult to clearly and precisely explain the essence or scope of rights of the proposed scent trademark even when the applicant clearly states the mixture's various compositions and their proportions involved in creating the mixture or goes so far as to present the detailed chemical formula of the mixture to assist a third party in reproducing and understanding the content of the mixture by use of the same compositions in the same proportions. Ultimately, the result should depend on if the written description of the trademark can objectively and sufficiently convey how a person perceives the scent. When the description of the mark simply states the individual odors, compositions making the scent and their proportions, chemical formulas, etc., and cannot make people associate it directly with the odor they remember and further make them identify and realize the scent sought to be registered, then the requirement of presenting the reproduction of the trademark in a clear, definite, well-contained, objective, durable and easily accessible and intelligent manner is still not satisfied.

For example, the description of a trademark says that "this is a scent trademark having a minty scent by mixture of highly concentrated methyl salicylate (10wt%) and menthol (3wt%).". Although the scent trademark is composed of a mixture of highly concentrated methyl salicylate and menthol as mentioned before, the smell presented is a common "minty scent." For most consumers with common knowledge and experience, they should be able to associate such scent directly with the one in their memory and further clearly identify and understand the perceptive impression of the scent sought to be registered. Moreover, the applicant has objectively stated the compositions and proportions of the mixed minty scent and provided the specimen thereof to assist in examination. Thus, it can be concluded that the requirement of

Paragraph 3 of Article 19 of the Trademark Act is satisfied. However, in most cases, a description of all compositions of the scent and each proportion is not a required condition. Whether or not the written description of a scent itself satisfies the requirement of Paragraph 3 of Article 19 of the Trademark Act mainly depends on if the description makes consumers with common knowledge and experience clearly understand the scent sought to be registered.

#### 9.2.1.2 Description by scents that have particular names in the market

If the scent filed for registration by the applicant cannot be clearly and precisely presented by any smell existing in nature, provided that solid evidence can prove that the scent is associated with a particular name existing in the market commonly known to relevant consumers and creates a similar and common impression and experience for most consumers, that particular name in the market may be used to describe the mark. In this context, the applicant needs to submit advertising or marketing evidence about the actual use in market to certain extent in order to prove that such name has been closely linked to that scent and has been known to relevant consumers with common knowledge. That is, the applicant may use that particular name for the scent to describe its use in connection with relevant goods or services in the written description of the scent mark, accompanied by the trademark specimen, in order to comply with the requirement of Paragraph 3 of Article 19 of the Trademark Act.

#### 9.2.2 Specimen

Though the specimen of a trademark is used to assist in trademark examination, it can never replace the reproduction and description of the mark. As noted, a scent trademark, when actually used, makes use of olfactory perception. Even if a scent mark is presented via a written description, the specimen of the mark must be provided in order to fulfill the requirement of Paragraph 3 of Article 19 of the Trademark Act. An actual specimen of the scent is not required at filing but may be needed during the course of examination in order to facilitate the examination (Paragraph 1, Rule 13 of the Enforcement Rules of the Trademark Act).

A scent trademark should use a written description of the mark as the trademark reproduction, and the specimen thereof must be consistent with the description of the mark. More specifically, the applicant may submit any of the goods that the scent trademark is actually applied, goods packaging, or any objects relating to the provisions of services as the specimen of the mark. If the object that the scent mark is actually used on is in a huge volume or there is any difficulty in providing the same, a test paper accurately reflecting such scent may be submitted as the trademark specimen.

### **9.2.3 Distinctiveness**

Like other types of trademarks, a scent trademark can be registered only if it has distinctiveness. However, if the scent sought to be registered either comes from the goods themselves or the nature of the goods, the scent will be perceived by consumers as the goods rather than a sign indicating the source of specific goods. For example, in the cases of the scents of chocolate or vanilla for bakery goods, they are not distinctive because chocolate or vanilla is an ingredient commonly used to make cake or bread and should be descriptive of the ingredients, compositions and flavors of those goods (Subparagraph 1, Paragraph 1, Article 29 of the Trademark Act). In the case of the scent of rubber for tires, as most tires are made of rubber and the scent of rubber emanates from the tires themselves and is caused by their nature, it is not distinctive because it is a smell commonly used associated with tires (Subparagraph 2, Paragraph 1, Article 29 of the Trademark Act); also, such mark cannot be granted registration by submitting evidence proving its having acquired distinctiveness (Paragraph 2, Article 29 of the Trademark Act). Similar situations may occur when a scent trademark is applied on services. For instance, the scent of coffee as a mark for cafes is not distinctive.

Besides, a scent emanating from goods themselves, packaging containers for goods, or objects relating to provision of services easily allows consumers to consider it as a characteristic of that particular object rather than a sign indicting the source of

goods and services. If the applicant cannot provide evidence proving that, after the applicant's use, the scent has become a sign identifying the source of the applicant's goods or services in trade and has acquired distinctiveness (Paragraph 2, Article 29 of the Trademark Act), it shall be disapproved pursuant to Subparagraph 3, Paragraph 1 of Article 29 of the Trademark Act.

To be capable of identifying the source of goods, the scent needs to be something apart from the nature or an expected characteristic of goods or services, and should be a smell extra added. Accepted examples in foreign jurisdictions include the scent of plumeria blossoms as a mark for embroidery yarn, the scent of cherry as a mark for motor oil and the bitter scent of beer as a mark for darts (game articles). In these cases, the scents are neither the natural smells nor the expected odors of the goods; instead, they are something added to the goods or services in order to be distinguished from similar goods or services provided by other competitors in the same trade.

#### **9.2.4. Functionality**

When a scent sought to be registered is indispensable to the use or intended purpose of the designated goods or services or affects the cost or quality thereof, it has a functional purpose and may not be registered (Subparagraph 1, Paragraph 1 of Article 30). In determining if a scent trademark is functional, the type of goods or services designated for such mark plays an important role. For example, perfumes, aromatic essential oils, air fresheners, and medicinal oils for refreshing, etc., by nature, have the function to provide users with different scents, thus allowing them to feel relaxed or joyful because of the smells they like, or achieving the effect of refreshing. Therefore, a scent used for this type of goods should be utilitarian functional and should not be registered (Subparagraph 1, Paragraph 1 of Article 30).

The operation practice of the industry in connection with the designated goods or services is also another important factor for determining whether the mark is functional, that is, whether or not the scent is closely related to the competitiveness of



goods or services. If the use of a scent for the designated goods or services is commonly used in market trading, the scent not only has no distinctiveness, but also should be considered functional and may not be registered. As noted, a scent that is commonly used in trade normally makes goods more pleasant and attractive. For instance, the scent of lemon for dish washing detergents and other cleaning detergents brings no substantial benefits to the cleaning effect and production costs but is commonly used by the traders of relevant goods. If such scent is monopolized by a single party who would have competitive advantages other than efficacy and cost, it would result in inhibiting fair competition. In conclusion, a scent that is commonly used by the traders of specific goods or services shall be deemed aesthetic functionality and may not be registered (Subparagraph 1, Paragraph 1 of Article 30).

In light of the foregoing, in determining whether the scent trademark sought to be registered is functional, one should first determine if the scent is indispensable to the use or intended purpose of the designated goods or services or affects the cost or quality thereof. If the answer to the above is negative, one should further examine whether the scent provides other real and obvious advantages in competition such that the scent should be kept within the public domain. Supposing such scent is exclusively acquired by a single party, it would result in other competitors to be trapped in disadvantaged situations other than those relating to reputation. In consequence, such scent is considered to be functional.

Some traders in the market use a particular scent on goods, goods packaging, any objects relating to the provision of services or the places where the services are provided to mask the unpleasant and pungent smell of the goods or places or to make the goods or services more attractive by adding the scent and thus allowing consumers to be happier in their choice. This type of scent has the function of masking, but it does not naturally mean that such scent must be "functional" specified under the Trademark Act. For example, in the case of the scent of cherry or other fruits as a mark for fuel oil for cars, the scent of fruits can reduce the pungent odor of oil but does not improve the performance of oil products or reduce the costs, nor is it commonly used by other oil traders; supposing the applicant can provide

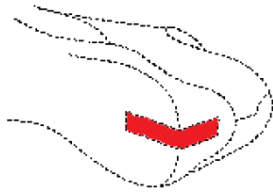
evidence establishing that the scent has acquired distinctiveness and the registration of the scent mark will not bring about an unfavorable impact on the competition order in the market and will not cause other competitors to suffer from competitive disadvantage (except for the ones relating to reputation), such scent will be deemed non-functional.

## **10. Other non-traditional trademarks**

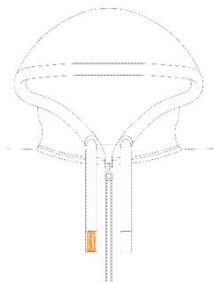
In filing an application for registration of other non-traditional trademarks that are not given in the Guidelines, the applicant must furnish the reproduction of the proposed trademark. If the reproduction does not clearly and completely present the trademark, a description, or even specimen(s) thereof should be provided in order to precisely define the scope of the rights and to enable third parties to ascertain the registered trademark and its scope of rights according to the publication of the trademark registration.

In the case of position trademarks, as traditional two-dimensional word trademarks or design trademarks, color trademarks or three-dimensional trademarks can be indicated on a specific position of certain goods or services, if the specific position is an important feature of the trademark; failure of indication of the word, design, color or three-dimensional shape on that specific position will make the trademark lose the function of being a source indicator. Under such circumstances, the position is considered as a position trademark. For instance, in the case of a red strip indicated at the center of heel of a shoe extending to shoe shank, failure of indication of the red strip on that specific position would lose its distinctiveness. In filing an application for registration of a position trademark, the reproduction of the trademark should use broken lines to show the position where the trademark is actually applied on the goods or services, and a description clearly describes the trademark itself and the manner how and the position where the trademark is used on the goods or services.

Example:



Description: This position trademark consists of a red strip on the center of heel of a shoe extending to shoe shank. The portion in broken lines, which depicts the shape of a shoe, is not part of the trademark.



Description: This is a position trademark and consists of an orange tab with the wording “Superdry 極度乾燥しなさい”, attached to the end of the drawstring on the clothing. The portion in broken lines is not part of the trademark.



Description: This is a position trademark and consists of a combination of red, white and blue stripes on the tail and the rear fuselage of an airplane in a specific manner; the shape of the tail and rear fuselage depicted in broken lines is not part of the trademark.

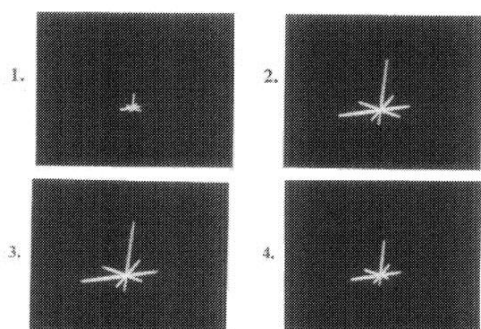
As for how to represent non-visual, perceptible trademarks such as tactile and taste trademarks in a clear, precise, self-contained, objective, durable, easily accessible and intelligible manner or to supplement the reproductions of the

trademarks by a written description and specimens, technical problems may arise during the examination and for the publication. When a taste or tactile sign is used as a source indicator of certain good or services, it is feasible that the reproduction of the trademark is described in writing only. However, how to present the trademark specimen in a manner that can be referenced with the trademark reproduction to ensure the subject matter sought to be protected remains an issue. Before TIPO publishes further detailed regulations governing examination procedures for non-visual perceptible trademarks, the Guidelines are applicable to the trademark reproduction, description and specimen(s). As for the examination of distinctiveness and functionality of non-visual perceptible trademarks, the Guidelines also apply (see Sections 2.2 and 2.3 of the Guidelines).

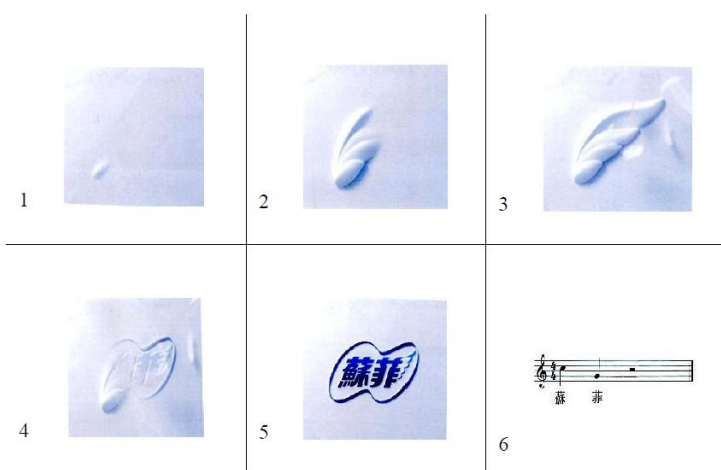
## **11. Non-traditional composite trademarks**

When filing an application for registration of a non-traditional composite trademark, in principle the portion of the trademark that is visually perceptible should be represented in a reproduction; the portion of the trademark that is not visually perceptible should be stated in a description. However, in the case of a sound trademark, in which the non-visually perceptible portion is music element, the sound should be represented by a musical notation on a stave or a numeric music score. Additionally, trademark specimen(s) should be provided based on the type of trademarks to be protected. The Registrar Office may require the applicant to furnish a description and a specimen of the trademark, if it deems necessary to help the examination of the reproduction (Paragraph 1, Rule 13 of the Enforcement Rules of the Trademark Act). In the case of a composite trademark consisting of both sound and motion elements, the reproduction of the trademark has to include a sequence of still images of the motion; and the sound elements together with multiple still images constituting the motion and the varying process of the image should be described in the description of the trademark.

Examples:



Description: The trademark is a composite trademark consisting of sound and motion elements, in which the sound of sharp explosion lasts about two seconds along with a moving starburst image. The trademark is made up of four graphic drawings, which show a moving starburst from small to large and then to small again, as shown in drawing 1 to drawing 4.



Description: The trademark is a composite trademark of sound and motion elements. The moving image consists of a white feather that gradually becomes a wing and finally to the stylized Chinese "蘇菲." In the trademark, one white feather becomes three white feathers, as shown in the 1<sup>st</sup> and the 2<sup>nd</sup> images; a clear wing becomes a blurry wing and the stylized Chinese characters "蘇菲", as shown in the 3<sup>rd</sup> and the 4<sup>th</sup> images; and finally, a clear wing with the Chinese characters "蘇菲" inside appears, accompanied by a female voice chanting "蘇菲" in the rhythm of the music score as the 6<sup>th</sup> image.

As to the distinctiveness and functionality of non-traditional composite trademarks, each composing element of the trademarks should be examined

according to the Guidelines. Where a composite trademark as a whole is distinctive, it has the function to identify the source of goods or services. However, if any portion or composing element thereof is not distinctive and doubts will arise in respect of the scope of the trademark rights, or if any portion or composing elements thereof is functional, such composite trademark can be registered only after a disclaimer is made or the portion or composing element is depicted in broken lines.

## **12. The relationship of non-traditional trademarks to design patents and copyrights**

### **12.1 The relationship to design patents**

Matters that are indispensable for performing the intended function are prohibited from registration, largely because a technical and functional creation should be protected by the patent system and, to foster technological development, the technique can be freely used by anyone after the patent expires. A design patent is the creation of an article in its entire or partial shape, pattern, color, or any combination thereof, which appeals to the eye; it is not a creation that requires techniques. Therefore, the possibility that a new design patent will affect fair competition in the marketplace is lower than a new utility model patent or an invention patent that has a practical function. For this reason, non-traditional trademarks, in particular, three-dimensional shapes, may be protected under both the Trademark Act and the Patent Act. However, it is important to note that to be protected as a trademark, the configuration of an article must function to distinguish the source of goods. In addition, although the acquisition of design patent rights in a three-dimensional shape gives the owner the right to exclude others from using that three-dimensional shape during the patent term, it does not necessarily mean, if the three-dimensional shape is non-distinctive originally, that the shape has acquired distinctiveness. As noted, the distinctiveness of a three-dimensional shape is not a requirement for design patent protection. In other words, a non-distinctive three-dimensional shape may be protected as a design patent for being original, but it may not thus acquire distinctiveness and trademark rights unless the owner of the design patent can prove that the non-distinctive shape of the product, after being used

by the applicant, has become a sign that identifies the applicant's goods in the course of trade, and can be relied upon to distinguish the goods from those of others. In the context, the shape is deemed to have acquired secondary meaning and acquired distinctiveness, and may thus be registered (Paragraph 2, Article 29 of the Trademark Act).

## **12.2 The relationship to copyrights**

The Copyright Act of the Republic of China is enacted to protect the rights and interests of authors with respect to their works, to balance different interests for the common good of society, and to promote the development of national culture (Article 1 of the Copyright Act). It serves purposes distinct from those of the Trademark Act. Works have a wide range of uses, including being a trademark to identify the source of goods or services. Therefore, if a three-dimensional shape, motion image or hologram meets the requirements for protection under both the Trademark Act and the Copyright Act, it may acquire both trademark rights and copyrights.