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Examination guidelines on non-conventional trademarks take effect

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Introduction

The new Trademark Act took effect on July 1 2012. It involves changes to several systems, including:

- amendments to disclaimer provisions;
- expansion of the scope of protection of non-conventional trademarks;
- deletion of the two-instalment payment system; and
- new provisions regarding exclusive and non-exclusive licences.

Other supporting measures have been successively introduced, including amendments to:

- the Enforcement Rules of the Trademark Act;
- the Examination Guidelines; and
- the Regulations of Trademark Government Fees.

The Intellectual Property Office recently promulgated the Examination Guidelines on Non-conventional Trademarks based on the original Examination Guidelines on Three-Dimensional, Colour and Sound Trademarks. The new guidelines took effect on July 1 2012 and outline the definition and examination procedures for non-conventional trademarks (ie, three-dimensional, colour, sound, motion, hologram, position, scent, tactile and taste trademarks).

Major amendments

Scope of non-conventional trademarks

Non-conventional trademarks are not confined to colour, three-dimensional, motion, hologram and sound trademarks expressly specified in the law. Where a sign is discernible by smell, touch or taste, and complies with the distinctive requirements of a trademark, it may be filed for registration as a trademark and entitled to protection under the act.

Trademark drawing, description and samples

When filing an application for registering a non-conventional trademark the applicant must, in addition to a drawing of the trademark, submit a description and samples that faithfully depict the relevant mark so as to establish the scope of trademark rights and facilitate examination. The description and sample(s) must be consistent with, and refer to, the drawing of the trademark.

Three-dimensional trademarks

A three-dimensional trademark may consist of a maximum of six perspective drawings in different views, which together constitute the drawing of the trademark.

When the non-distinctive or functional portion of a trademark is depicted in solid lines rather than dotted lines - such that disputes in respect of the scope of trademark rights of the entire trademark are likely to occur - a disclaimer must be made. Alternatively, the non-distinctive or functional portion must be amended to be depicted in dotted lines.

Functional description for colour trademarks

The term 'functional colour' refers to colours required for intended purposes or technological effect, or that will affect the cost or quality of the goods or services when applied to the designated goods or

services. Under such circumstances, colours are deemed to be functional and may not be granted registration - for example, the colour black for solar collectors.

Sound trademarks

Sound trademarks relating to music should be represented by a musical score or numerical musical score, while non-musical sound trademarks may be depicted by written descriptions.

A functional description for sound trademarks must be provided.

When sound trademarks are indispensable to the application or intended uses of certain goods or services, or will affect the cost and quality of good or services, they are deemed to be functional and may not be granted registration - for example, the sound of camera flashlights in connection with cameras.

Motion trademarks

A 'motion trademark' refers to a sequence of moving images which have the function of identifying the source of goods or services. A motion trademark aims to protect the overall commercial impression established by such moving images. The moving images as a whole - rather than any word, device or symbol occurring during the process of movement - acquire the trademark rights. If trademark protection is sought for any word or device of a motion trademark, a separate application for registration of such word or device as a general word trademark or device trademark should be filed.

The drawing of a motion trademark should consist of a maximum of six static graphic images.

A description of the trademark should state, in sequence, the continual changes of the moving graphic images, because the drawing of a motion trademark cannot be represented by sequential actions. It should also specify the number of static graphic images that constitute the motion trademark.

An application for registering a motion trademark should include a sample (or samples) of the trademark (ie, an electronic carrier recording moving images of the trademark), in a format that complies with the public notice of the competent trademark authority.

Hologram trademarks

A 'hologram trademark' is the use of a hologram as a sign. The hologram itself should be capable of identifying the source of goods or services.

A hologram trademark drawing is the perspective drawing of the hologram. For a hologram with one single view, a perspective drawing thereof is required. For a hologram with variable images because of different views, a maximum of four perspective drawings in different views should be submitted in order to represent completely the hologram trademark.

In principle, the key issues for examination of hologram trademarks are no different from those of conventional two-dimensional trademarks. Nevertheless, considering that holograms are used mostly for anti-counterfeiting purposes, the registration of a hologram must establish that consumers will regard such a hologram as an indicator of the source of goods or services, rather than as an anti-counterfeiting label or a decoration of goods.

General provisions regarding other non-conventional trademarks

The relevant provisions of the guidelines should apply, with the necessary alterations, to the drawings, descriptions and samples when for scent, tactile or taste trademarks.

As non-conventional trademarks may now be entitled to protection under the Trademark Act, rights holders should evaluate whether their trademarks would qualify for such protection in Taiwan and, if so, file applications accordingly.

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