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Trademarks

Taiwan Issues Examination Guidelines on Non-Conventional Trademarks

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Taiwan's new Trademark Act has been in effect since July 1, 2012. As the Act involved changes to several conventions including the expansion of the scope of protection for non-conventional trademarks, amendments to the disclaimer provisions, deletion of the two-installment payment system and addition of new provisions regarding exclusive and non-exclusive licenses, other supporting measures had also been successively introduced in order to facilitate compliance.

These measures included amendments to:

- The Enforcement Rules of the Trademark Act (see "New Enforcement Rules for the Taiwan Trademark Act" [26 WIPR 15, 11/1/12]);
- The Examination Guidelines; and
- The Standards of Trademark Fees.

The Taiwan Intellectual Property Office (TIPO) also promulgated recently the Examination Guidelines on Non-Conventional Trademarks based on the original Examination Guidelines on Three-Dimensional, Color and Sound Trademarks. The new guidelines sets out the definition of and examination procedures for non-conventional trademarks, i.e. 3D, color, sound, motion, hologram, position, scent, tactile and taste trademarks. The guidelines also took effect on July 1, 2012, and the major provisions are outlined as follows.

Scope of Non-Conventional Trademarks Specified

Non-conventional trademarks are not restricted to color, three-dimensional, motion, hologram and sound trademarks which are expressly mentioned in the law. Where a sign can be made known 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 Trademark Act.

Submission of Drawings, Descriptions and Samples

When filing an application for registering a non-conventional trademark, the applicant must, in addition to any drawings of the trademark, submit a description and samples of the trademark which faithfully depict the relevant mark, so as to establish the scope of the trademark rights and to facilitate examination thereof. These are to supplement the drawings of the relevant trademark in assisting examination. Therefore, a trademark description and the trademark sample(s) must be consistent with and refer to the drawings of the trademark.

Three-Dimensional Trademarks

- It is specified that a 3D trademark may consist of a maximum of six perspective drawings from different views, which altogether constitute the drawing of the trademark.

- When the non-distinctive or functional portion of a trademark is depicted with solid 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 with dotted lines.

Functional Colors Defined

The term “functional color” refers to colors that are required for specific purposes or technological effects or that will affect the cost or quality of the goods or services when applied on the designated goods or services. Under such circumstances, the colors are deemed to be functional and may not be granted registration, for example, the color black for solar collectors.

Sound Trademarks

- The guidelines specify that sound trademarks using music should be represented by a musical score or numerical musical score, while non-music sound trademarks may be depicted by written descriptions.
- Functional sounds have been defined. When sounds are indispensable for the applications or the intended uses of certain goods or services, or will affect the cost and quality of goods or services, they are deemed to be functional and may not be granted registration as a trademark; for example, the sound of a camera flashlight in connection with cameras.

Filing and Examination Provisions Regarding Motion and Hologram Trademarks

Motion Trademarks

- A motion trademark refers to a sequence of moving images, which have the function of identifying the source of goods or services. The subject matter that a motion trademark aims to protect is the overall commercial impression established by such moving images. In other words, the moving images as a whole, rather than any word, device, or symbol displayed during the process of such motion, acquire the trademark rights. If any word or device of a motion trademark is desired to acquire trademark rights, a separate application for registration of such word or device as a general word or device trademark should be filed.
- The drawing for a motion trademark must consist of a maximum of six static graphic images.
- A description of the trademark should state, in sequence, the continual change in the moving graphic images because the drawing of a motion trademark cannot present 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, i.e. an electronic carrier or medium recording the 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 where the hologram is used as a sign and the hologram by itself is capable of identifying the source of goods or services.
- A drawing of a hologram trademark should consist the perspective drawing of the hologram. For a hologram having one single view, a perspective drawing thereof is required. For a hologram having variable images (from different angles), a maximum of four perspective drawings of the

hologram from the different views should be submitted in order to completely represent the hologram trademark.

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

General Provisions Regarding Other Non-Conventional Trademarks

In the examination of positional trademarks, smell trademarks, tactile trademarks or taste trademarks, it is specified that the relevant provisions of the guidelines should apply *mutatis mutandis* to the drawings, descriptions and samples of relevant trademarks.

In view of the fact that non-conventional marks as mentioned above have become subject matters entitled to protection under the Trademark Act, it is advisable that trademark right holders first evaluate whether it is feasible to protect their trademarks in Taiwan, and if so, then file appropriate applications accordingly.