

This article was published in the *International Law Office IP Newsletter* on August 22, 2016.

Intellectual Property, Taiwan

IP Court accepts market survey to determine 3D trademark distinctiveness

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Distinctiveness is a requirement for trademark registration. The distinctiveness of a trademark includes inherent distinctiveness and acquired distinctiveness. Inherent distinctiveness is inherent in the trademark itself and is not acquired through use. Acquired distinctiveness refers to the situation in which a sign is not distinctive by itself, but the use of the trademark on the market allows relevant consumers to recognise it as a sign identifying the source of the goods or services; in other words, it acquires distinctiveness. In addition to the original meaning, such a trademark also creates a new meaning that can identify the source.

The key issue is how to determine whether a trademark is distinctive enough for protection.

The main function of a trademark is to identify the source of goods or services. If a sign cannot identify and distinguish goods or services, it does not have a trademark function and its registration cannot be approved. Distinctiveness is a requirement for trademark registration. However, the existence or degree of distinctiveness often changes with actual use of the mark over time. In particular, with today's ever-changing marketing methods and rapid development in digital media technology, the type and manner of use of a trademark change continuously, which greatly affects the determination of its distinctiveness. Whether a sign is distinctive may be determined on a different basis in different cases because of the varying nature of goods or services. Results are therefore often considered inconsistent. Likewise, the guidelines for determination of whether a trademark has acquired distinctiveness through use vary with:

- the strength of evidence of use;
- the extent to which competitors in the same trade use the trademark; and
- the extent to which the consumers of relevant goods or services may be in contact with the trademark.

The Examination Guidelines on Distinctiveness of Trademarks stipulated by the Intellectual Property Office are formulated to establish objective examination criteria and facilitate consistent judgments. According to the guidelines, market surveys may be cited to support distinctiveness. Nonetheless, the market survey has probative value only if it is professional, impartial and objective. When a trademark applicant chooses to conduct a market survey by itself but lacks the expertise:

- the sampling is often not representative;
- the questionnaire usually contains leading questions; and
- the people conducting the market survey or interview often lack professional training and ability.

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

The IP Court recently took a market survey submitted by a trademark applicant into consideration when determining whether a three-dimensional (3D) trademark was distinctive enough for registration. After reviewing the credibility of market survey companies and organisations, survey methodology, the design

of the questionnaires and the correlation between content and conclusion, as well as evidence of use, the IP Court held that the 3D trademark should be granted registration.

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