

A Study on the U.S. Functionality Doctrine of Three-Dimensional Trademark—Also Comment on the Examination Practice in Taiwan

Student: Sheng-Chi Teng

Advisor : Dr. Chiung-Hui Shao

Co-advisor: Dr. Shang-Jyh Liu

Institute of Technology Law

National Chiao Tung University

ABSTRACT

What is capable of identifying the source of goods (services) and of distinguishing the goods (services) of others is no longer limited to traditional word marks. Three-dimensional shapes or configurations of goods, packaging, containers, and designs also function as source identifying and distinguishing marks. Taiwan's Trademark Act was amended on May 28, 2003 and three-dimensional marks, color marks, and sound marks were introduced into it as three new types of trademarks. As one type of trademarks, a three-dimensional shape of goods or packaging must possess distinctiveness before being registered as a trademark. It must comply with other requirements that apply to traditional trademarks as well. Moreover, if the three-dimensional shape is indispensable for performing the intended functions, then the trademark application shall be rejected. This is the so-called "functionality doctrine," which has been enacted in the Trademark Act. In other words, a functional three-dimensional shape of goods or packaging shall not be registered as a trademark, regardless of its distinctiveness.

This study will discuss from comparative legal perspectives the "functionality doctrine" and its enactment in Taiwan. Besides, this paper will categorize and analyze the rejections of three-dimensional trademark applications, reviewing whether any problems exist in the three-dimensional trademark examination practice in Taiwan.

There are six chapters in this study. Chapter I is "Introduction," stating the motivation, the purpose, the scope, the methods, and the structure of this study.

Chapter II is “Introduction of the Mark Protection in the U.S.,” describing the protection for traditional marks, trade dress, and three-dimensional marks. Chapter III is “The U.S. Functionality Doctrine,” discussing from the U.S. cases and the Lanham Act the rationales of the doctrine, the meaning of “functionality,” and how to determine a feature of a product qualifies as “functional.” Chapter IV is “The Protection of Three-Dimensional Trademark and the Functionality Doctrine in Taiwan,” illustrating the protection for three-dimensional trademarks and the functionality doctrine in Taiwan. Chapter V is “Comment on the Examination Practice in Taiwan,” categorizing relevant rejections of three-dimensional trademark applications and commenting on the actual and potential problems in the examination practice. Chapter VI is “Conclusion.”

Keywords: three-dimensional trademark, trade dress, functionality, functionality doctrine, examination practice

