

# 商標功能性與識別性之關聯性研究 ——從智慧財產法院107年度民商 上易字第3號民事判決談起

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## 摘 要

商標須具備識別性之要求，乃為保障公共利益，並讓商標不受不正當權利所壟斷。至於商標不須具備功能性之消極要件，則為避免功能性之商品設計或特徵取得永久的商標保護，且有礙同業之公平競爭和社會進步。然商標識別性與功能性之關聯性為何？首先，如智慧財產法院（以下簡稱「智財法院」）在 107 年度民商上易字第 3 號民事判決（以下簡稱「本案」）所稱：「當特定型式之功能性配件，可以發揮識別性作用時，即屬於商標使用之性質。」此外，亦有論者謂：「一旦一標識具備功能性，即使其具有先天識別性，或者其具有後天識別性，但其仍不受商標法所保護。」換言之，商標識別性與功能性兩者是否相互排斥，就此爭點亦頗耐人尋味。特別是這關乎在商標註冊階段，系爭商標能否加以註冊？又於商標註冊、生效後，這仍與系

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爭商標之權利，是否及於其他侵權之商標？甚至使用系爭商標，是否構成異議、評定之事由。而本文之論點將從分析本案做基礎，並結合我國、美國理論及實務之見解，提出不管是現行法之解釋，抑或是智財法院之判決，都應將具有功能性之標識，排除在商標權之保護外，且我國傳統、非傳統商標關於功能性判斷之因素，應明文訂定在審查基準中等建議，如此不僅得以確保本法維護市場公平競爭之立法目的，更能夠提供未來實務針對判斷識別性及功能性之明確標準。

**關鍵詞：**商標、識別性、功能性、先天識別性、後天識別性

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# **A Study on the Relationships between Distinctiveness and Functionality — The Taiwan Intellectual Property Court’s 2018 Decision Min-Shang-Shang-Yi-Zi-3**

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## Abstract

Distinctiveness is a requirement for trademark registrations, for protecting public interests, and for creating trademarks without unfair rights monopolizations. Furthermore, trademark registration can — without being a requirement of functionality — attempt to avoid gaining trademark rights protections for functional goods designs or characters and hinder other competitors’ fair competition and social progressions. However, what is the relationship between trademark distinctiveness and functionality? First, the Intellectual Property Court (hereafter called the IP

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Court) claimed, with regard to the 2018 Min-Shang-Shang-Yi-Zi-3 case (hereafter called this case), that, when distinctiveness functions are displayed by specific types of functional accessories, they should belong to the uses of trademarks. Moreover, there are still arguments that functionality is expressed through a mark, which even has an inherent distinctiveness or secondary meaning and that this mark cannot be protected by a trademark act. In other words, an interesting issue is to further investigate whether trademark distinctiveness and functionality are in conflict with each other. In particular, trademark distinctiveness and functionality are related to the question of whether a trademark can be registered during the stage of trademark registration. Furthermore, trademark distinctiveness and functionality are also concerned with whether there are trademark infringements and whether the uses of a trademark constitute opposition or invalidation. The arguments of this article are based on this case and the combined theories and practices of Taiwan and the United States and include to make suggestions that marks with functionalities cannot be protected by trademark rights regulated by the current laws and made by the IP Court. Moreover, judgments of traditional and non-traditional trademarks' functionalities in Taiwan should be ruled in examination guidelines. Thus, it attempts to maintain the legislative purpose of Taiwan Trademark Act regarding fair competition in markets and provide clear judgments concerning distinctiveness and functionalities for Taiwanese practices.

**Keywords:** Trademark, Distinctiveness, Functionality, Inherent Distinctiveness, Secondary Meaning