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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