

[NON-DISTINCTIVE PARTS OF TRADEMARK THAT DO NOT REQUIRE DISCLAIMER MADE FOR TRADEMARK APPLICATION IN TAIWAN]

It is expressly stipulated under Article 29 of the prevailing Taiwan Trademark Act that when an applicant files a trademark registration with the inclusion of a non-distinctive part, which could give rise to doubts as to the scope of trademark rights, the applicant should state a disclaimer when filing the registration. Otherwise, the trademark will not be registrable. If a trademark contains a part which is clearly not distinctive, and is not likely to cause doubts about the scope of a trademark, it is not necessary for the applicant to disclaim the exclusive right of the trademark for the non-distinctive part.

In Taiwan, a non-distinctive part trademark may include descriptive words, graphs, generic names, and marks. Since there are numerous types of goods and services for trademark registration, the Taiwan Intellectual Property Office (TIPO) published a guide in 2012, titled “List of examples for trademark parts that do not require a disclaimer.” This list is used to help applicants and examiners decide which trademark parts do not need to be disclaimed. With the increase in trademark filings, TIPO has acquired more and more examples of these types of trademark. As such, TIPO has recently updated the list and published it on June 5, 2018. For easy reference, trademark parts from the updated list are summarized into 13 categories below.

No.	Trademark Parts	Examples ^a
1	Generic names for goods/services	Bank, yogurt, pizza, steak, coffee, cosmetics
2	Words signifying the quality, purpose, material, place of origin, or relevant characteristics for goods/services	Antique, bio, classic, delicious, handmade, luxury, natural, organic ^b , homemade, nano ^c , premium quality, water-proof
3	Descriptive words for advertising oneself	Dr., doctor, master, expert, specialist
4	Relevant words for design of goods/services	Aesthetics, art, brand, collection, craft, system, creation, design, series, style, product
5	Manner/aspect of services provision	Digital, e-commerce, eshop, expo, internet, link, marketing, media, net,

		online, wifi
6	Geographical names	Taiwan, Made in Taiwan, Paris
7	Year and time	EST, since, established, 24H
8	Words signifying the types of corporation	Co., Ltd, Corp., Corporation, Inc., LLC
9	Words signifying the combination of entities, enterprise, business, organization, and their natures/types	Alliance, association, business, communication, construction, development, enterprise, foundation, express, global, group, holding, industry, technology, tour
10	Words signifying the provider of goods/services, the words of shop or place	Academic, boutique, shop, center, clinic, club, college, farm, food court, gallery, hotel, hub, mall, mart, outlet, ranch ^c , square, studio
11	Religious signs and folk belief signs or terms	Eight trigrams, Taichi figure, swastika; amen, hallelujah, namo amitabha
12	Generic marks	Caduceus symbol, medical cross symbol, Rx prescription sign
13	Combination of above (descriptive, non-distinctive words and combination of use)	Quality + geographic name or process + goods (e.g. high quality woolun tea, natural handmade soap) ; ingredients + goods (e.g. herbal cream)

Remarks:

- a) The complete contents can be found in TIPO's website.
- b) A trademark that contains the term "organic" can only be used for organic agricultural products or their processed products, or retail services thereof, and these products must have been certified by a competent authority.
- c) A trademark that contains the term "nano" is restricted for the use of designated goods/services in connection with nano processes.
- d) A trademark that contains the term "ranch" can only be used for goods/services of food and catering, tourist ranch, leisure farm, etc., and must obtain the ranch approval

Simply put, the applicant is not required to make a disclaimer on the trademark parts published in the "List of examples for trademark parts that do not require a disclaimer" by TIPO. In addition, TIPO has provided examples of words or terms that do not require a disclaimer, with respect to Class 1 to 45 of Nice Classification. If there are any doubts about whether to disclaim, TIPO would inform the applicant and provide further explanation.