

Trademark Act

- Enacted and Promulgated on May 6, 1930 by the Government
- Enforced on Jan. 1, 1931
- Amended and Promulgated on Nov. 23, 1935 by the Government
- Promulgated on Oct. 19, 1940 by the Government
- Amended and Promulgated on Oct. 24, 1958 by the Presidential Order
- Amended and Promulgated on July 4, 1972 by Presidential Order
- Amended and Promulgated on Jan. 26, 1983 by Presidential Order
- Amended and Promulgated on Nov. 29, 1985 by Presidential Order
- Amended and Promulgated on May 26, 1989 by Presidential Order
- Amended and Promulgated on Dec. 22, 1993 by Presidential Order
- Article 4, 5, 23, 25, 34, 37, 61 and 79 Amended and Promulgated on May 7, 1997 by Presidential Order, and Enforced on Nov. 1, 1998
- Article 77-1 and 79 Amended and Promulgated on May 29, 2002 by Presidential Order
- Amended and Promulgated on May 28, 2003 by Presidential Order, and Enforced on Nov. 28, 2003
- Article 4 and 94 Amended and Promulgated on August 25, 2010 by Presidential Order, and Enforced on September 12, 2010
- Passed on May 31, 2011 by the Legislative Yuan, and Amended and Promulgated on June 29, 2011 by Presidential Order, and Enforced on July 1, 2012
- Article 98 Amended and Promulgated on Nov. 30, 2016 by Presidential Order, and Enforced on Dec. 15, 2016

TABLE OF CONTENTS

Chapter I General Provisions

- Article 1 Purpose of this Act
- Article 2 Registration for protection
- Article 3 Competent Authority and Registrar Office
- Article 4 Admission of foreign application
- Article 5 Use of trademark
- Article 6 Appointment of trademark agent
- Article 7 Application for registration of jointly owned trademark
- Article 8 Inadmissibility of application; restoration to *status quo ante*
- Article 9 Date to be based on
- Article 10 Service by publication
- Article 11 Trademark Gazette
- Article 12 Trademark Register
- Article 13 E-filing
- Article 14 Assignment of examiner
- Article 15 Disposition in writing
- Article 16 Calculation of period
- Article 17 Provisions applied *mutatis mutandis*

Chapter II Trademark

Section I Application for Registration

- Article 18 Signs of which trademark may consist; distinctiveness
- Article 19 Application for trademark registration; date of filing
- Article 20 Right of priority; same treatment for certain categories of persons as for nationals of ROC

- Article 21 Right of exhibition priority
- Article 22 Filing on same date
- Article 23 Prohibition and exception of amendment to trademark reproduction and designated goods or services
- Article 24 Change to application
- Article 25 Correction of application
- Article 26 Division of application
- Article 27 Transfer of application
- Article 28 Limitation and exception of disposition of right derived from application for registration of jointly owned trademark

Section II Examination and Acceptance

- Article 29 Grounds for refusal of registration: devoid of distinctiveness; disclaimer
- Article 30 Other grounds for refusal of registration
- Article 31 Disposition of refusal; time limit on request of restriction of goods or services, amendment to reproduction without substantial change, division and disclaimer
- Article 32 Disposition of acceptance; payment of registration fee; relief measure of failure to pay

Section III Trademark Rights

- Article 33 Right conferred by registered trademark and duration of registration
- Article 34 Renewal of registration
- Article 35 Right in registered trademark
- Article 36 Limits on effect of registered trademark

- Article 37 Division of registration
- Article 38 Change and correction of registration; time limit on division and restriction
- Article 39 Recordal of license in the Register
- Article 40 Recordal of sub-license in the Register
- Article 41 Removal of license from the Register
- Article 42 Recordal of transfer in the Register
- Article 43 Addition to appropriate and distinguishing indication
- Article 44 Recordal of pledge in the Register
- Article 45 Abandonment of registration
- Article 46 Disposition of right of jointly owned trademark
- Article 47 Extinguishment of registration

Section IV Opposition

- Article 48 Grounds for opposition and time limit on filing
- Article 49 Opposition procedure
- Article 50 Provisions govern in opposition
- Article 51 Avoidance of examiner in opposition
- Article 52 Invariance of concerned party in opposition
- Article 53 Withdraw of opposition
- Article 54 Effect of sustained opposition
- Article 55 Cancellation of some goods or services
- Article 56 *Ne bis in idem*

Section V Invalidation

- Article 57 Grounds for invalidation; proof of use of earlier trademark
- Article 58 Time limit on filing invalidation and exception
- Article 59 Invalidation procedure

Article 60 Effect of sustained invalidation

Article 61 *Ne bis in idem*

Article 62 Provisions applied *mutatis mutandis* to invalidation

Section VI Revocation

Article 63 Grounds for revocation; revocation of some goods or services

Article 64 Identity of trademark

Article 65 Revocation procedure

Article 66 Provisions govern in invalidation

Article 67 Provisions applied *mutatis mutandis* to revocation

Section VII Infringement Remedies

Article 68 Infringement of registered trademark

Article 69 Exclusion, prevention and damages of infringement; time limit to demand damages

Article 70 Acts deemed infringement

Article 71 Calculation of damages

Article 72 Request for detention

Article 73 Revocation of detention

Article 74 Release of security

Article 75 Suspension of release upon Customs' own initiative

Article 76 Provision of information of suspected articles upon request

Article 77 Request to Customs on taking samples of suspected articles

Article 78 Regulations prescribed by Customs

Article 79 Formation of specialized tribunal

Chapter III Certification Mark, Collective Membership Mark and

Collective Trademark

Article 80 Definitions of certification mark and geographical certification mark

Article 81 Applicant of certification mark

Article 82 Requirements of application for registration of certification mark

Article 83 Use of certification mark

Article 84 Special provisions for geographical certification mark

Article 85 Definition of collective membership mark

Article 86 Requirements of application for registration of collective membership mark

Article 87 Use of collective membership mark

Article 88 Definition of collective trademark and geographical collective trademark

Article 89 Requirements of application for registration of collective trademark

Article 90 Use of collective trademark

Article 91 Provisions applied *mutatis mutandis* to geographical collective trademark

Article 92 Limitation of transfer, license and pledge

Article 93 Special provisions for grounds for revocation

Article 94 Provisions applied *mutatis mutandis* to certification mark, collective membership mark and collective trademark

Chapter IV Penal Provisions

Article 95 Penalty for trademark or collective trademark infringement

- Article 96 Penalty for certification mark infringement
- Article 97 Penalty for sale or intent of sale of infringing article
- Article 98 Independent confiscation
- Article 99 Right to sue of group other than juridical person

Chapter V Supplementary Provisions

- Article 100 Transitional provision for service mark
- Article 101 Transitional provision for abolishment of associated registration system
- Article 102 Transitional provision for abolishment of defensive registration system
- Article 103 Special provision for three-year period of non-use
- Article 104 Trademark fees
- Article 105 Transitional provision for abolishment of paying registration fees by two installments
- Article 106 Transitional provisions for opposition and invalidation
- Article 107 Transitional provisions for revocation
- Article 108 Special provision for date of filing
- Article 109 Special provisions for date of priority
- Article 110 Enforcement Rules
- Article 111 Date of enforcement

Chapter I General Provisions

Article 1 Purpose of this Act

This Act is enacted for protection of the rights of trademark, certification mark, collective membership mark, collective trademark and the interests of consumers, maintenance of fair competition, and promotion of development of the industry and commerce.

Article 2 Registration for protection

Any person who wishes to obtain the rights of trademark, certification mark, collective membership mark, or collective trademark shall apply for registration therefor in accordance with this Act.

Article 3 Competent Authority and Registrar Office

The Competent Authority of this Act is the Ministry of Economic Affairs (hereinafter as the MOEA).

Trademark affairs shall be administered under a registrar office appointed by the MOEA.

Article 4 Admission of foreign application

An application for trademark registration, filed by a national of a country other than the Republic of China (ROC), may be inadmissible if such country does not accede to any international treaty for protection of trademarks, to which the ROC accedes, or does not conclude with the ROC any treaty or agreement for reciprocal protection of trademarks, or does not admit applications for trademark registration filed by nationals of the ROC.

Article 5 Use of trademark

“Use of a trademark” means any of the following act, in the course of trade, where such trademark is capable of being recognized by relevant consumers as a trademark:

(1) to apply a trademark to goods or packaging or containers thereof;

(2) to possess, display, sell, export, or import the goods referred to in the preceding subparagraph;

(3) to apply a trademark to articles relating to the provision of services; or

(4) to apply a trademark to commercial documents or advertisements relating to goods or services.

The preceding paragraph shall also apply to acts performed by digital audio-visual means, through electronic media, on the Internet, or through other media.

Article 6 Appointment of trademark agent

An applicant, holder or other interested person may appoint a trademark agent to apply for trademark registration and related affairs. Those who have no domicile or business establishment in the territory of the ROC shall appoint a trademark agent to apply for trademark registration and related affairs.

A trademark agent shall have a domicile in the ROC.

Article 7 Application for registration of jointly owned trademark

When there are two or more persons who wish to jointly own a

trademark, the application shall be filed in the names of all the joint applicants. The joint applicants may also elect one of them to represent all the joint applicants in the process of application for registration and related affairs, and receive relevant documents on their behalf.

In the absence of electing a representative referred to in the preceding paragraph, the Registrar Office shall assign the first-listed joint applicant in the application as the person to be served upon and shall give the subsequent joint applicants a notice of such service matters.

Article 8 Inadmissibility of application; restoration to *status quo ante*

Unless otherwise prescribed in this Act, an application or other proceedings of trademark shall be inadmissible if an applicant, holder or other interested person thereof has failed to comply within the statutory period, to conform to legal formality that cannot be amended, or to conform to legal formality which is not amended within the period specified in a notice. However, if the failure to conform to legal formality which is not amended within the specified period has been amended before the disposition is rendered, such application or proceeding shall still be admissible.

Where an applicant, holder or other interested person has failed to comply within the statutory period by reason of an act of God or any event not attributable to such applicant, holder or interested person, he/she may request for restoration to the *status quo ante*, within thirty days from the day following the date on which the cause vanishes, by submitting a written statement to the Registrar Office clarifying the reason. No request for restoration to the *status quo ante* may be made

upon the failure to comply within the statutory period for more than one year.

When requesting for restoration to the *status quo ante*, the omitted act that should have been done within the statutory period shall be completed together with the request for restoration.

The preceding two paragraphs shall not apply to the failure to comply within the period prescribed in Paragraph 3 of Article 32.

Article 9 Date to be based on

The date of application and other proceedings of trademark shall be based on the date of receipt of the written documents or articles at the Registrar Office. The date of those via postal service shall be based on the postmarked date of the place of origin.

Unless otherwise proved by the concerned party, the date of those whose postmarked date appears to be ambiguous will be based on the date of receipt at the Registrar Office.

Article 10 Service by publication

Where a disposition or any other document cannot be served, such disposition or document shall be published in the Trademark Gazette and shall be deemed having been duly served in thirty days from the day following the date of publication.

Article 11 Trademark Gazette

The Registrar Office shall publish and circulate the Trademark Gazette, in which registered trademarks and relevant particulars shall be entered.

The Trademark Gazette referred to in the preceding paragraph may be published and circulated by electronic means; the date of commencement thereof shall be prescribed by the Registrar Office.

Article 12 Trademark Register

The Registrar Office shall maintain the Trademark Register, in which the trademark registrations, changes to trademark rights and all other particulars prescribed by acts or regulations shall be entered and made available to the public.

The Trademark Register referred to in the preceding paragraph may be produced by electronic means.

Article 13 E-filing

Application and other proceedings of trademark may be transmitted by electronic means; the implementing regulations thereof shall be prescribed by the Competent Authority.

Article 14 Assignment of examiner

The Registrar Office shall assign examiner(s) to conduct the examination of applications for registration, oppositions to registration, invalidations and revocations of registration of trademark.

The qualification of examiner referred to in the preceding paragraph shall be prescribed by law.

Article 15 Disposition in writing

The Registrar Office shall render a written disposition on examination referred to in paragraph 1 of the preceding article, in which

the reason is stated, and serve the said disposition to the applicant or the person who requested for opposition, invalidation or revocation.

The disposition referred to in the preceding paragraph shall bear the name(s) of the examiner(s).

Article 16 Calculation of period

For the purpose of calculation of a period, except those referred to in Paragraph 1 of Article 33, Paragraph 4 of Article 75, and Article 103, the first day does not count.

Article 17 Provisions applied *mutatis mutandis*

The provisions of this Chapter with respect to trademarks shall apply *mutatis mutandis* to certification marks, collective membership marks, and collective trademarks.

Chapter II Trademark

Section I Application for Registration

Article 18 Signs of which trademark may consist; distinctiveness

A trademark shall refer to any sign with distinctiveness, which may, in particular, consist of words, designs, symbols, colors, three-dimensional shapes, motions, holograms, sounds, or any combination thereof.

The term “distinctiveness” used in the preceding paragraph refers to the character of a sign capable of being recognized by relevant consumers as an indication of the source of goods or services and distinguishing goods or services of one undertaking from those of other

undertakings.

Article 19 Application for trademark registration; date of filing

An application for trademark registration shall be made to the Registrar Office by filing an application containing (the name and address of) the applicant, a reproduction of the trademark, and the list of designated goods or services.

The date of filing of an application for trademark registration is the date on which an application referred to in the preceding paragraph is furnished to the Registrar Office.

A reproduction of the trademark shall be represented in a manner that is clear, precise, self-contained, objective, durable, easily accessible and intelligible.

An application for trademark registration shall relate to a single trademark, and may designate goods or services classified in two or more classes.

Classification of goods or services referred to in the preceding paragraph shall be prescribed by the Enforcement Rules of this Act.

The classification of goods or services referred to in the preceding paragraph shall not constrain the determination of similarity of goods or services.

Article 20 Right of priority; same treatment for certain categories of persons as for nationals of ROC

An applicant who has duly filed an application for trademark registration in a country which has reciprocal recognition of priority rights with the ROC, or filed such application with a member of the

World Trade Organization (WTO), may claim a right of priority, for the purposes of registering the same trademark in the ROC for some or all the same goods or services, within six months from the day following the date of filing of the first such application.

An applicant of a foreign country which is not a member of the WTO nor a country having reciprocal recognition of priority rights with the ROC, may claim a right of priority pursuant to the preceding paragraph if he/she is domiciled or has a business establishment in the territory of a country which has reciprocal recognition of priority rights with the ROC or in the territory of a member of the WTO.

An applicant who claims priority pursuant to paragraph 1 shall submit a written statement to that effect simultaneously with the application which shall set forth the following:

- (1) the date of filing of the first application;
- (2) the country or the member of the WTO in which the first application was made; and
- (3) the application number of the first application.

The applicant shall submit, within three months from the day following the date of filing of the application, a copy of the application certified as admitted by the country or the member of the WTO referred to in the preceding paragraph.

If the statement or the copy of the application is not submitted pursuant to Subparagraph 1 or Subparagraph 2 of Paragraph 3 or the preceding paragraph, the priority claim shall be deemed not having been made.

If an application is filed with a claim of priority, the date of priority shall count as the date of filing.

If an application is filed with a claim of multiple priorities, the date of each priority shall count as the date of filing of goods or services in respect of such priority.

Article 21 Right of exhibition priority

If an applicant of an application for trademark registration has displayed goods or services under the trademark applied for, at an international exhibition which was held or officially recognized by the Government of the ROC, and if such applicant files the application within a period of six months from the day following the date of the first display of such goods or services, the date of the first display shall count as the date of filing of the application.

The preceding article shall apply *mutatis mutandis* to applications filed with a claim of exhibition priority under the preceding paragraph.

Article 22 Filing on same date

If two or more applications for trademark registration relating to identical or similar trademarks which designate identical or similar goods or services are filed separately by different applicants on the same date of which time precedence cannot be determined, and hence there exists a likelihood of confusion on relevant consumers, all of such applicants shall reach an agreement on the precedence by consultations among the applicants. Where no agreement is reached in the consultations, lots shall be casted for deciding precedence.

Article 23 Prohibition and exception of amendment to trademark reproduction and designated goods or services

No amendments shall be made to the reproduction of a trademark and the designated goods or services thereof after an application for trademark registration has been filed, unless such amendment is a restriction of designated goods or services or an amendment to the reproduction of a trademark which does not substantially change such trademark.

Article 24 Change to application

Changes to the name or address of the applicant, the trademark agent, or any other particulars in an application for registration shall be made by filing a request therefor with the Registrar Office.

Article 25 Correction of application

The following errors in the particulars of an application for trademark registration may be corrected upon request or *ex officio*:

- (1) errors in the name or address of the applicant;
- (2) errors of wording or of copying; or
- (3) any other obvious mistakes.

The correction referred to in the preceding paragraph shall not affect the identity of the trademark or broaden the scope of the designated goods or services.

Article 26 Division of application

An applicant may request the Registrar Office to divide an application for registration into two or more applications by distributing

the designated goods or services included in the original application among divisional applications which shall preserve the filing date of the original application.

Article 27 Transfer of application

The rights derived from an application for trademark registration may be transferred to another person.

Article 28 Limitation and exception of disposition of right derived from application for registration of jointly owned trademark

Any transfer of the right derived from an application for registration of a jointly owned trademark or the share of a joint applicant in such trademark shall have the consent of all joint applicants, unless such right or share is transferred by succession, compulsory execution, a judgment of the court or operation of other law.

Any abandonment of the right derived from an application for registration of a jointly owned trademark shall have the consent of all joint applicants, unless in the case that a joint applicant abandons his/her own share in such trademark.

The share abandoned by a joint applicant referred to in the preceding paragraph shall be distributed among the remaining joint applicants in proportion to each one's share.

The preceding paragraph shall apply *mutatis mutandis* to cases where a joint applicant dies with no successor or ceases to exist with no assumer.

Any restriction or division of the designated goods or services of an

application for registration of a jointly owned trademark shall have the consent of all joint applicants.

Section II Examination and Acceptance

Article 29 Grounds for refusal of registration: devoid of distinctiveness; disclaimer

A trademark shall not be registered if it is devoid of distinctiveness in any of the following:

(1) consisting exclusively of a description of the quality, intended purpose, material, place of origin, or relevant characteristics of the designated goods or services;

(2) consisting exclusively of the generic mark or term for the designated goods or services; or

(3) consisting exclusively of other signs which are devoid of any distinctiveness.

Subparagraph 1 or 3 of the preceding paragraph shall not apply if the trademark has been used by the applicant and has become, in trade, a sign capable of distinguishing the goods or services of the applicant.

Where the reproduction of a trademark contains an element which is not distinctive, and where the inclusion of that element in the trademark could give rise to doubts as to the scope of the trademark rights, the applicant shall state that he/she disclaims any exclusive right to such element. Such trademark without disclaimer shall not be registered.

Article 30 Other grounds for refusal of registration

A trademark shall not be registered in any of the following:

(1) being exclusively necessary for the goods or services to be functional;

(2) being identical with or similar to the national flag, national emblem, national seal, military flags, military insignia, official seals, or medals of the ROC, or the state flags of foreign countries, or the armorial bearings, national seals or other state emblems of foreign countries communicated by any member of the WTO under Paragraph 3 of Article 6*ter* of the Paris Convention;

(3) being identical with the portrait or name of Dr. Sun Yat-Sen or of the head of the state;

(4) being identical with or similar to the mark of a government agency of the ROC or an official exhibition held thereby, or the medal or certificate awarded thereby;

(5) being identical with or similar to the armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations or well-known domestic or foreign institutions undertaking businesses for public interests, and hence being likely to mislead the public;

(6) being identical with or similar to official signs and hallmarks indicating control and warranty adopted by the domestic or foreign countries, and being designated to the identical or similar goods or services;

(7) being contrary to public policy or to accepted principles of morality;

(8) being likely to mislead the public as to the nature, quality, or

place of origin of the goods or services;

(9) being identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and being designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits;

(10) being identical with or similar to another person's registered trademark or earlier filed trademark and to be applied for goods or services identical with or similar to those for which the registered trademark is protected or the earlier filed trademark is designated, and hence there exists a likelihood of confusion on relevant consumers, unless the consent of the proprietor of the said registered trademark or earlier filed trademark to the application has been given and is not obviously improper;

(11) being identical with or similar to another person's well-known trademark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark or mark, unless the proprietor of the said well-known trademark or mark consents to the application;

(12) being identical with or similar to another person's earlier used trademark and to be applied for goods or services identical with or similar to those for which the earlier used trademark is applied, where the applicant with the intent to imitate the earlier used trademark, being aware of the existence of the earlier used trademark due to contractual,

regional, or business connections, or any other relationship with the proprietor of the earlier used trademark, files the application for registration, unless the proprietor of the said earlier used trademark consents to the application;

(13) containing another person's portrait or well-known name, stage name, pseudonym, or alternative name, unless the said person consents to the application;

(14) containing the name of a well-known juridical person, business or any group, and hence there exists a likelihood of confusion on the relevant public, unless the said juridical person, business or group consents to the application; or

(15) being an infringement of another person's copyright, patent right, or any other right, where a final judgment of the court has been rendered, unless the said person consents to the application.

The determination of a geographical indication, well-known trademark/mark, and earlier used trademark as prescribed in Subparagraph 9 and Subparagraphs 11 to 14, respectively, of the preceding paragraph shall be based on the facts at the time of filing.

Subparagraphs 4, 5 and 9 of Paragraph 1 of this Article shall not apply if the applicant is a government agency or related institution.

Paragraph 3 of the preceding article shall apply *mutatis mutandis* to the ground for refusal prescribed in Subparagraph 1 of Paragraph 1.

Article 31 Disposition of refusal; time limit on request of restriction of goods or services, amendment to reproduction without substantial change, division and disclaimer

An application for trademark registration shall be refused if it is held,

after examination, that under Paragraph 1 or 3 of Article 29, Paragraph 1 or 4 of the preceding paragraph, or Paragraph 3 of Article 65, the trademark shall not be registered.

Before rendering a disposition of refusal pursuant to the preceding paragraph, a written notice stating grounds for refusal shall be given to the applicant, who may submit his/her opinion on the intended refusal within the prescribed period.

Any restriction of the designated goods or services, amendment to the reproduction of a trademark which does not substantially change such trademark, division of an application for registration, or disclaimer shall be requested before the disposition of refusal is rendered.

Article 32 Disposition of acceptance; payment of registration fee; relief measure of failure to pay

An application for trademark registration shall be accepted if, after examination, none of the grounds for refusal prescribed in Paragraph 1 of the preceding article is found to exist.

A trademark been accepted for registration shall be published for registration and a trademark certificate shall be issued, provided that the registration fee has been paid by the applicant within two months from the day following the date of the service of the disposition. Where the said fee remains unpaid by the end of the prescribed period, a trademark shall not be published for registration.

Where an applicant has unintentionally failed to pay the fee within the period prescribed in the preceding paragraph, the applicant may pay double within six months from the day following the date on which the prescribed period expires, in which case the Registrar Office will publish

the registration. However, this shall not be applied if an application for trademark registration filed or rights of a trademark obtained by a third party during such period would be affected.

Section III Trademark Rights

Article 33 Right conferred by registered trademark and duration of registration

The proprietor of a registered trademark shall have the exclusive right of the trademark for a period of ten years from the date of publication of registration.

The period of the trademark right may be renewed, and the duration of each renewal period shall be ten years.

Article 34 Renewal of registration

A request for renewal of the trademark right shall be made, and the renewal fee paid, within six months before the expiry of the period of the trademark right; failing this, the request may be made and the fee paid in double within such further period of six months from the day following the date of expiry of the period of the trademark right.

Renewal referred to in the preceding paragraph shall take effect from the day following the date of expiry of the previous period of the trademark right.

Article 35 Right in registered trademark

The proprietor of a registered trademark has the exclusive right in the trademark in relation to the designated goods or services.

Unless otherwise prescribed in Article 36 of this Act, consent of the proprietor of a registered trademark shall be required in any of the following:

(1) using a trademark which is identical with the registered trademark in relation to goods or services which are identical with those for which it is registered;

(2) using a trademark which is identical with the registered trademark and used in relation to goods or services similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers; or

(3) using a trademark which is similar to the registered trademark and used in relation to goods or services identical with or similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.

A trademark may, if registered, be displayed with the words “registered trademark” or the internationally used symbol for registration (the letter R enclosed within a circle).

Article 36 Limits on effect of registered trademark

A registered trademark shall not entitle the proprietor to prohibit a third party from:

(1) indicating his/her own name, or the term, shape, quality, nature, characteristic, intended purpose, place of origin, or any other description in relation to his/her own goods or services, in accordance with honest practices in industrial or commercial matters and not using it as a trademark;

(2) using where it is necessary for the goods or services to be

functional; or

(3) using *bona fide*, prior to the filing date of the registered trademark, an identical or similar trademark on goods or services identical with or similar to those for which the registered trademark is protected, provided that the use is only on the original goods or services; the proprietor of the registered trademark is entitled to request the party who use the trademark to add an appropriate and distinguishing indication.

Where goods have been put on the domestic or foreign market under a registered trademark by the proprietor or with his consent, the proprietor is not entitled to claim trademark rights on such goods, unless such claim is to prevent the condition of the goods been changed or impaired after they have been put on the market or there exist other legitimate reasons.

Article 37 Division of registration

The proprietor of a registered trademark may request the Registrar Office to divide the registration into two or more registrations by distributing the designated goods or services included in the original registration among divisional registrations.

Article 38 Change and correction of registration; time limit on division and restriction

No amendments shall be made to the reproduction of a trademark and the designated goods or services thereof after the trademark has been registered, unless such amendment is a restriction of designated goods or services.

Articles 24 and 25 shall apply *mutatis mutandis* to any change or correction of the particulars of a trademark registration.

If an opposition, invalidation or revocation has been entered at the Registrar Office against a registered trademark, any division of the registration or restriction of the designated goods or services shall be requested before the disposition of such opposition, invalidation or revocation is rendered.

Article 39 Recordal of license in the Register

A registered trademark may be licensed by the proprietor, exclusively or non-exclusively, for all or some of the designated goods or services for which it is registered and for a particular locality.

A license referred to in the preceding paragraph shall have no *locus standi* against any third party unless it is entered in the Register by the Registrar Office.

If the trademark right have been transferred after the license is entered in the Register, the transferee is still bound by the licensing contract.

If the recordal of an exclusive license is requested by the proprietor of a registered trademark after a non-exclusive license is entered in the Register, such non-exclusive license shall not be affected.

An exclusive licensee is entitled, within the scope of the license, to exclude the proprietor and any third party from using the registered trademark.

Unless otherwise prescribed in a licensing contract, an exclusive licensee is entitled, within the scope of the license, to bring infringement proceedings in his/her own name.

Article 40 Recordal of sub-license in the Register

Unless otherwise prescribed in a licensing contract, an exclusive licensee is entitled, within the scope of the license, to sub-license the registered trademark to another person.

A non-exclusive licensee shall not sub-license the registered trademark to another person, unless the proprietor or the exclusive licensee consents to the sub-license.

A sub-license shall have no *locus standi* against any third party unless it is entered in the Register by the Registrar Office.

Article 41 Removal of license from the Register

Before the expiry of the period of a license, a concerned or an interested party may, by submitting relevant evidence, request the Registrar Office to remove the license from the Register under any of the following:

(1) both the proprietor of the registered trademark and the licensee agree to terminate the license; such request shall also apply to the sub-license;

(2) where the licensing contract expressly prescribes that either the proprietor or the licensee may terminate the license at any time, the concerned party declares the termination;

(3) due to the licensee's breaching the licensing contract, the proprietor gives such licensee a notice of rescinding or terminating the licensing contract, and the licensee shows no objection thereto; or

(4) there is other relevant evidence capable of establishing that the license no longer exists.

Article 42 Recordal of transfer in the Register

A transfer of trademark right shall have no *locus standi* against any third party unless it is entered in the Register by the Registrar Office.

Article 43 Addition to appropriate and distinguishing indication

If, due to a transfer of trademark right, two or more proprietors use an identical trademark on similar goods or services or similar trademarks on identical or similar goods or services, and hence there exists a likelihood of confusion on relevant consumers, each proprietor shall add an appropriate and distinguishing indication while using his/her own trademark.

Article 44 Recordal of pledge in the Register

An establishment, change, or extinguishment of a pledge made by the proprietor of a registered trademark shall have no *locus standi* against any third party unless it is entered in the Register by the Registrar Office.

Where a proprietor establishes multiple pledges on his/her trademark right for the purpose of securing multiple creditors' rights, the ranks of these pledges shall be determined according to the order of the recordal in the Register.

A pledgee in respect of right in a registered trademark shall not use such trademark unless otherwise licensed by the proprietor thereof.

Article 45 Abandonment of registration

The proprietor of a registered trademark may abandon his/her

trademark right. However, if a license or a pledge has been entered in the Register, the proprietor shall get the consent of the licensee or pledgee.

The abandonment referred to in the preceding paragraph shall be made in writing to the Registrar Office.

Article 46 Disposition of right of jointly owned trademark

Any license, sub-license, transfer, abandonment of, or establishment of pledge on the right in a jointly owned trademark or any transfer of or establishment of pledge on the share in a jointly owned trademark shall have the consent of all joint proprietors, unless such right or share is transferred by succession, compulsory execution, a judgment of the court or operation of other law.

The *proviso* to Paragraph 2 of Article 28 and Paragraph 3 of same Article shall apply *mutatis mutandis* to a joint proprietor's abandonment of his/her share.

Where a joint proprietor dies with no successor or ceases to exist with no assumer, Paragraph 4 of Article 28 shall apply *mutatis mutandis* to the distribution of such joint proprietor's share.

Paragraph 5 of Article 28 shall apply *mutatis mutandis* to a restriction or division of the designated goods or services of a jointly owned registered trademark.

Article 47 Extinguishment of registration

Right of a registered trademark shall become extinguished under any of the following:

- (1) where the right is not renewed pursuant to Article 34, such right

shall become extinguished from the day following the date of expiry of the period of such right.

(2) where the proprietor of such trademark dies with no successor, such right shall become extinguished from the day following the date of death of such proprietor; or

(3) where the right is abandoned pursuant to Article 45, such right shall become extinguished from the date of receipt of a written statement on the abandonment at the Registrar Office.

Section IV Opposition

Article 48 Grounds for opposition and time limit on filing

Any person may file an opposition to registration of a trademark with the Registrar Office within three months from the day following the date of publication of registration on the grounds that such registration falls under Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65.

The opposition referred to in the preceding paragraph may be filed for some of the designated goods or services of the registered trademark.

An opposition shall be filed against a single registered trademark.

Article 49 Opposition procedure

Any person who opposes a registered trademark shall file an opposition stating the facts and grounds along with a copy thereof. Any attachments to the opposition shall also be enclosed with the copy.

The Registrar Office shall serve the copy on the proprietor of

opposed trademark, who may submit a statement of defense to the opposition within the prescribed period; where the proprietor submits the statement of defense, the Registrar Office shall serve a copy of the statement on the opponent, who may submit his/her opinion on the statement of the proprietor within the prescribed period.

Where the statement or opinion submitted pursuant to the preceding paragraph is likely to delay the proceedings, or where the facts and evidence are sufficiently clear, the Registrar Office may conduct opposition proceedings directly without giving the opposite party a notice to submit a statement of defense or opinion.

Article 50 Provisions govern in opposition

With respect to the grounds for an opposition to a registered trademark, the provisions in effect at the time of the said trademark publication of registration shall govern, unless otherwise prescribed in Paragraph 1 and Paragraph 3 of Article 106.

Article 51 Avoidance of examiner in opposition

An opposition to a trademark shall be examined by an examiner, who did not participate in the examination of the application for registration of the opposed trademark.

Article 52 Invariance of concerned party in opposition

A transfer of the right of a trademark of which the opposition proceedings is underway does not influence the said opposition proceedings.

A transferee of trademark right referred to in the preceding

paragraph may declare to assume the position of the opposed party in the opposition proceedings.

Article 53 Withdraw of opposition

An opponent may withdraw his/her opposition to a registered trademark before the disposition of such opposition is rendered.

An opponent who withdrew his/her opposition to a registered trademark shall not file an opposition once more or invalidation against such opposed trademark based on the same facts, evidence and grounds as those in the withdrawn opposition.

Article 54 Effect of sustained opposition

Where an opposition to a registered trademark is sustained, the registration of the opposed trademark shall be cancelled.

Article 55 Cancellation of some goods or services

Where grounds for cancellation referred to in the preceding article exist in respect of some of the designated goods or services of the registered trademark, the registration may only be cancelled in respect of those goods or services.

Article 56 *Ne bis in idem*

Where a disposition of the opposition to a registered trademark became final, no one shall file any invalidation against such opposed trademark based on the same facts, evidence and grounds as those in the opposition.

Section V Invalidation

Article 57 Grounds for invalidation; proof of use of earlier trademark

An interested party may file invalidation with the Registrar Office, or a trademark examiner may submit a proposal to the Registrar Office for invalidation, against a trademark registration on the grounds that such registration falls under Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65.

A person who file an invalidation with the Registrar Office against a trademark registration on the grounds that such registration falls under Subparagraph 10 of Paragraph 1 of Article 30 shall furnish proof that, during the period of three years preceding the date of request for invalidation, the earlier trademark has been used in connection with the goods or services in respect of which it is registered and which he/she cites as justification for his/her request, or that there are proper reasons for non-use, provided the earlier trademark has at that date been registered for not less than three years.

The proof of use furnished pursuant to the preceding paragraph shall be capable of establishing the genuine use of the trademark in accordance with general commercial practices.

Article 58 Time limit on filing invalidation and exception

No invalidation shall be filed, or no proposal for an invalidation shall be submitted, against a trademark registration on the grounds that such registration falls under Subparagraph 1 or 3 of Paragraph 1 of Article 29, any of Subparagraphs 9 through 15 of Paragraph 1 of Article 30, or Paragraph 3 of Article 65 if the registration has at that date been

published for not less than five years.

The period referred to in the preceding paragraph shall not apply to the invalidation against a trademark registration on the grounds that such registration falls under Subparagraph 9 or 11 of Paragraph 1 of Article 30 if the registration was applied for in bad faith.

Article 59 Invalidation procedure

An examination on an invalidation shall be conducted by an invalidation panel consisting of three or more examiners assigned by the head of the Registrar Office.

Article 60 Effect of sustained invalidation

Where an invalidation against a registered trademark is sustained, such registration shall be cancelled. However, if the circumstance on which the trademark is not registrable no longer exists, a disposition to overrule such invalidation may be rendered upon considering the need for proportionality between the interests of the public and the interests of the concerned parties.

Article 61 *Ne bis in idem*

Where a disposition of an invalidation against a registered trademark was rendered, no one shall file another invalidation against such trademark based on the same facts, evidence and grounds as those in the earlier invalidation.

Article 62 Provisions applied *mutatis mutandis* to invalidation

Paragraphs 2 and 3 of Article 48, Articles 49 through 53, and Article

55 shall apply *mutatis mutandis* to an invalidation of a registered trademark.

Section VI Revocation

Article 63 Grounds for revocation; revocation of some goods or services

The Registrar Office shall, *ex officio* or by request, revoke the registration of a trademark if such trademark is in any of the following:

(1) where the trademark is altered by the proprietor in different forms in which it was registered or supplemented with additional notes whereby the trademark is identical with or similar to another person's registered trademark in relation to goods or services which are identical with or similar to those for which another person's registered trademark is designated, and hence there exists a likelihood of confusion on relevant consumers;

(2) where the trademark has not yet been put to use or such use has been suspended for a continuous period of not less than three years without proper reasons for non-use, unless the trademark has been put to use by a licensee;

(3) where no appropriate and distinguishing indication is added pursuant to Article 43, unless the indication has been added and hence there does not exist any likelihood of confusion before the disposition of revocation rendered by the Registrar Office;

(4) where the trademark has become the generic mark or term, or common shape for the designated goods or services; or

(5) where, in consequence of the actual use of the trademark, such

trademark is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.

The registered trademark shall also be revoked in the case where the proprietor of such trademark who, knowingly or with reasonable grounds to know, shows no objection to the conduct as prescribed in Subparagraph 1 of preceding paragraph by a licensee.

The trademark registration shall not be revoked on the ground prescribed in Subparagraph 2 of Paragraph 1 if such use as referred to in that subparagraph was commenced or resumed before the revocation is requested, unless any such commencement or resumption of use within the period of three months before the revocation is requested was because the proprietor became aware that the revocation might be requested.

Where grounds for revocation exist in respect of some of the designated goods or services of the registered trademark, the registration may be revoked in respect of those goods or services.

Article 64 Identity of trademark

Actual use of a registered trademark by the proprietor in a form differing in elements which do not affect the identity of the trademark according to general concepts in the society shall constitute use of the registered trademark.

Article 65 Revocation procedure

The Registrar Office shall serve a copy of the request for revocation on the proprietor of a registered trademark, who may submit a statement of defense against the revocation within the prescribed period;

where the proprietor submits the statement of defense, the Registrar Office shall serve a copy of the statement on the opposite party, who may submit his/her opinion on the statement of the proprietor within the prescribed period. A request for revocation may be dismissed directly if it is devoid of any concrete facts and evidence or based on obviously groundless claims.

Where a copy of the request for revocation against a registered trademark on the ground prescribed in Subparagraph 2 of Paragraph 1 of Article 63 has been served on the proprietor of such trademark, such proprietor shall furnish proof of his/her use. Such registration may be revoked directly if the proprietor fails to submit a statement of defense within the prescribed period.

Where the trademark registration was revoked on the ground prescribed in Subparagraph 1 of Paragraph 1 of Article 63, a trademark which is identical with or similar to the revoked trademark in relation to goods or services which are identical with or similar to those for which the revoked trademark is designated shall not be applied for registration by the former proprietor of the revoked trademark or transferred or licensed to such former proprietor within three years from the day following the date of revocation; the aforementioned shall also apply to the circumstance that the trademark right has been abandoned before the disposition of revocation rendered by the Registrar Office.

Article 66 Provisions govern in invalidation

With respect to the grounds for revocation against a registered trademark, the provisions in effect at the time of the revocation was requested shall govern.

Article 67 Provisions applied *mutatis mutandis* to revocation

Paragraphs 2 and 3 of Articles 48, Paragraphs 1 and 3 of Article 49, Article 52 and Article 53 shall apply *mutatis mutandis* to the examination of revocation.

Paragraphs 2 and 3 of Article 57 shall apply *mutatis mutandis* to a revocation on the ground prescribed in Subparagraph 1 of Paragraph 1 of Article 63.

Paragraph 3 of Article 57 shall apply *mutatis mutandis* to the circumstance that a proprietor of a revoked trademark furnishes proof of use pursuant to Paragraph 2 of Article 65.

Section VII Infringement Remedies

Article 68 Infringement of registered trademark

Any of the following act, in the course of trade and without consent of the proprietor of a registered trademark, constitutes infringement of the right of such trademark:

(1) using a trademark which is identical with the registered trademark in relation to goods or services which are identical with those for which it is registered;

(2) using a trademark which is identical with the registered trademark and used in relation to goods or services similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers; or

(3) using a trademark which is similar to the registered trademark and used in relation to goods or services identical with or similar to

those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.

Article 69 Exclusion, prevention and damages of infringement; time limit to demand damages

A proprietor of a registered trademark is entitled to demand a person who infringes or is likely to infringe the trademark right to stop or prevent such infringement.

When making a demand pursuant to Paragraph 1, the proprietor is entitled to demand for destruction of infringing articles and the materials or implements used in infringing the trademark. However, the court may order other dispositions as it considers necessary after taking into account the need for proportionality between the seriousness of the infringement and the interests of third parties.

The proprietor is entitled to demand the infringer who knowingly, or with reasonable grounds to know, infringed such trademark rights to pay the proprietor damages.

The rights to demand referred to in the preceding paragraph shall become extinguished if not exercised within two years from the date on which the proprietor become aware of the damage and the person liable for damages. This right shall also become extinguished if it is not exercised within ten years from the time of infringement.

Article 70 Acts deemed infringement

Any of the following acts, without consent of the proprietor of a registered trademark, shall be deemed infringement of the right of such trademark:

(1) knowingly using a trademark which is identical with or similar to another person's well-known registered trademark, and hence there exists a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark;

(2) knowingly using words contained in another person's well-known registered trademark as the name of a company, business, group or domain or any other name that identifies a business entity, and hence there exists a likelihood of confusion on relevant consumers or a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark; or

(3) manufacturing, possessing, displaying, selling, exporting or importing labels, tags, packaging or containers that have not been applied in relation to goods or services, or articles that have not been applied in relation to services, knowing that such articles would likely infringe trademark rights as prescribed in Article 68.

Article 71 Calculation of damages

Damages demanded by the proprietor of a registered trademark may be calculated according to any of the following:

(1) the method provided in Article 216 of the Civil Code; the proprietor is entitled to demand damages based on the amount of the balance derived by subtracting the profit earned through using the trademark after infringement from the profit normally expected through using the same trademark, if no method of proof can be furnished to prove the damage suffered;

(2) the profit earned by the infringer as a result of trademark infringement; if no proof on costs or necessary expenses can be

furnished by the infringer, the total amount of income from selling the infringing goods shall be presumed to be the amount of profit;

(3) the amount not more than 1,500 times of the unit retail price of the infringing goods; if over 1,500 pieces of infringing goods were found, the amount of damages shall be a lump sum of the market value of the infringing goods; or

(4) the equivalent amount of royalty that may be collected from using the trademark under licensing.

A court may, at its discretion, reduce the amount of damages referred to in the preceding paragraph if such amount is apparently unequal.

Article 72 Request for detention

A proprietor of a registered trademark may request Customs to detain articles that are suspected of infringing the rights in the trademark.

Any request referred to in the preceding paragraph shall be made in writing, accompanied by a statement of the facts of the infringement and a security in an amount equivalent to the duty-paid price of the imported articles or the F.O.B. price of the exported articles, assessed by Customs, or equivalent assurance.

Customs shall immediately give a notice to the person who requested to detain articles once the request for detention is admitted; if suspected articles are detained because the request conforms to the preceding paragraph, Customs shall give a notice to the person who requested to detain articles and the owner of detained articles in writing.

The owner of detained articles may request Customs to revoke the

detention on provision of a security equivalent to two times of the security referred to in the Paragraph 2 or equivalent assurance while following the procedures in accordance with applicable Customs Regulations on import and export articles clearance.

Where the person who requested to detain articles is awarded a final judgment of the court stating that the detained articles have infringed trademark rights, the owner of detained articles shall be liable for all relevant expenses incurred as a result of the delay of containers, warehousing, loading, and unloading of the detained articles.

Article 73 Revocation of detention

Customs shall revoke the detention if any of the following exists:

(1) within a period of twelve days after the person who requested to detain articles has been served notice of admission of the request, Customs has not been informed that proceedings claiming that the detained articles are infringing articles pursuant to Article 69 have been initiated by the person who requested to detain articles;

(2) a final ruling of the court which dismisses the litigation initiated by the person who requested to detain articles claiming that the detained articles are infringing article;

(3) a final judgment of the court which holds that the detained articles do not infringe trademark rights;

(4) the person who requested to detain articles requests for revocation of the detention; or

(5) the circumstance in accordance with Paragraph 4 of the preceding article.

The period as prescribed in Subparagraph 1 of the preceding

paragraph may be extended by another twelve days by Customs in appropriate cases.

If the detention is revoked pursuant to Paragraph 1, Customs shall follow the procedures in accordance with applicable Customs Regulations on import and export articles clearance.

Where the detention is revoked pursuant to Subparagraphs 1 to 4 of Paragraph 1, the person who requested to detain articles shall be liable for all relevant expenses incurred as a result of the delay of containers, warehousing, loading, and unloading of the detained articles.

Article 74 Release of security

If a final judgment of the court holds that the detained articles do not infringe trademark rights, the person who requested to detain articles shall compensate the owner of detained articles for injury caused to them through wrongful detention of articles or provision of a security as prescribed in Paragraph 4 of Article 72.

The person who requested to detain articles shall enjoy the same right as a pledgee in relation to the security as prescribed in Paragraph 4 of Article 72. The owner of detained articles shall enjoy the same right as a pledgee in relation to the security as prescribed in Paragraph 2 of Article 72. However, all relevant expenses incurred as a result of the delay of containers, warehousing, loading, and unloading of the detained articles as prescribed in Paragraph 4 of the preceding article and Paragraph 5 of Article 72 shall be paid prior to compensate the person who requested to detain articles or the owner of detained articles for injury.

Customs shall release the security as prescribed in Paragraph 2 of

Article 72 upon request by the person who requested to detain articles in any of the following:

(1) where the security is no longer required as the person who requested to detain articles has either obtained a final judgment in his/her favor or reached a settlement with the owner of detained articles;

(2) where the person who requested to detain articles proves that the owner of detained articles has been notified but failed to exercise his/her rights within twenty days or more after the detention is revoked on the grounds prescribed in Subparagraphs 1 through 4 of Paragraph 1 of the preceding article and hence there is injury caused to them through wrongful detention, or after such owner obtained a final judgment in his/her favor; or

(3) where the owner of detained articles agrees to release the security.

Customs shall release the security as prescribed in Paragraph 4 of Article 72 upon request by the owner of detained articles in any of the following:

(1) where the security is no longer required as either after the detention is revoked on the grounds prescribed in Subparagraphs 1 through 4 of Paragraph 1 of the preceding article or such owner has reached a settlement with the person who requested to detain articles;

(2) where such owner proves that the person who requested to detain articles has been notified but failed to exercise his/her rights within twenty days or more after the person who requested to detain articles has obtained a final judgment in his/her favor; or

(3) where the person who requested to detain articles agrees to

release the security.

Article 75 Suspension of release upon Customs' own initiative

Where Customs acts upon its own initiative and finds that imported or exported articles in respect of which it has acquired *prima facie* evidence that a trademark right is likely to be infringed, Customs shall give a notice to the proprietor of the trademark and the importer/exporter.

In giving the notice referred to in the preceding paragraph, Customs shall specify a period for the proprietor of the trademark to come to the customs to identify the infringement and furnish proof of infringement, and Customs shall also specify a period for the importer/exporter to furnish proof of non-infringement. However, the period may be extended once only at the request of the proprietor of the trademark or the importer/exporter to Customs in writing, stating legitimate reasons for failure to furnish proof.

If proof of infringement has been furnished by the proprietor of the trademark and proof of non-infringement has not been furnished by the importer/exporter pursuant to the preceding paragraph, Customs may suspend the release of such articles.

If proof of infringement has been furnished by the proprietor of the trademark and proof of non-infringement has been furnished by the importer/exporter pursuant to Paragraph 2, Customs shall give a notice to the proprietor that he/she may, within three working days after the notice is given, request for detention pursuant to Paragraph 1 of Article 72.

If the proprietor did not, within the period prescribed in the

preceding paragraph, request for detention pursuant to Paragraph 1 of Article 72, Customs may release the articles after retaining a representative sample.

Article 76 Provision of information of suspected articles upon request

Without prejudice to the protection of confidential information of detained articles, Customs may allow the inspection of detained articles upon request by the person who requested to detain articles or the owner of detained articles referred to in Article 72 or the proprietor of the trademark or importer/exporter referred to in the preceding article.

After Customs detained suspected articles pursuant to Paragraph 3 of Article 72 or suspended the release of such articles pursuant to Paragraph 3 of the preceding article, Customs shall inform the proprietor of the trademark, at his/her request, of the names and addresses of the import/exporter, the consignor/consignee, and the quantity of the suspected articles.

Proprietors of trademarks are permitted to use the data obtained on the basis of preceding paragraph solely for the purpose of investigating and bringing legal actions concerning alleged infringements of their trademark rights without disclosing such data to any third party.

Article 77 Request to Customs on taking samples of suspected articles

When identifying the infringement pursuant to Paragraph 2 of Article 75, the proprietor of the trademark may request Customs to take samples of suspected articles and hand them over or send them to such proprietor for identification by providing a security in an amount equivalent to 120 percent of the duty-paid price of the imported articles

and relevant duties and taxes or the F.O.B. price of the exported articles and relevant duties and taxes, assessed by Customs, provided that it is necessary to take samples for identification, as well as such proprietor has undertaken in writing not to infringe the legitimate interests of the importer/exporter and not to use the samples for unjustifiable purposes.

The amount of the security referred to in the preceding paragraph shall not be less than NT\$3,000.

If such proprietor does not return the requested samples within the period for furnishing proof of infringement prescribed in Paragraph 2 of Article 75, or if the samples returned are not the same as the original ones or are defective, Customs shall hold the security to compensate the importer/exporter for injury caused to them.

The importer/exporter of samples of articles shall enjoy the same right as a pledgee in relation to the security held as prescribed in preceding paragraph.

Article 78 Regulations prescribed by Customs

The regulations governing the request for detention, revocation of a detention, payment, provision and release procedures for a security or assurance, required documents and other matters to be followed as prescribed in Articles 72 to 74 shall be prescribed by the Competent Authority coordinating with the Ministry of Finance.

The regulations governing the procedures, the required documents, and other related matters as to Customs' implementing measures for protecting rights of trademarks, the proprietor's request for inspection of detained articles, for related data of the infringing articles and for samples of suspected articles as prescribed in Articles 75 to 77 shall be

prescribed by the Ministry of Finance.

Article 79 Formation of specialized tribunal

A court may form specialized tribunal(s) or assign specific staff members to take charge of trademark litigation cases.

Chapter III Certification Mark, Collective Membership Mark and Collective Trademark

Article 80 Definitions of certification mark and geographical certification mark

A certification mark is a sign that serves to certify a particular quality, accuracy, material, mode of manufacture, place of origin or other matters of another person's goods or services by the proprietor of the certification mark and distinguish the goods or services from those that are not certified.

Where the certification mark referred to in the preceding paragraph serves to certify a place of origin, the goods or services from that geographical region shall have a given quality, reputation or other characteristic. An applicant may file an application for registration of a sign which contains such geographical name or is capable of indicating such geographical region as a geographical certification mark.

The Competent Authority shall coordinate with the central government authorities in charge of end enterprises in order to provide guidance and grants to industries that are in difficulties, industries that are on the verge of being in difficulties and traditional industries, to help them raise their productivity and the quality of their products; and to

help them establish industry-specific certification marks to certify their products as made in Taiwan.

The regulations governing the identification, provision of guidance, objects and standards and duration of provision of grants, and other matters to be followed shall be prescribed by the Competent Authority in consultation with each central government authority in charge of end enterprises. If necessary, fees charged in connection with the certification mark may be waived.

Article 81 Applicant of certification mark

Only a juridical person, a group or a government agency which is competent to certify another person's goods or services shall be eligible to apply for registration of a certification mark.

An applicant referred to in the preceding paragraph who carries on a business of goods or services of the kind certified shall not file an application for registration of a certification mark.

Article 82 Requirements of application for registration of certification mark

Any person who applies to register a certification mark shall submit documents proving such person's capability to certify another person's goods or services, regulations governing the use of the certification mark, and a declaration that such person does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified.

If there is any doubt about the representativeness of the applicant of an application for registration of a geographical certification mark, the

Registrar Office may consult and seek advice from the central government authorities in charge of business related to such goods or services.

A foreign juridical person, group or government agency, who files an application for registration of a geographical certification mark, shall submit documents of proof of such geographical certification mark being protected in the name and country of origin of such applicant.

The regulations governing the use of the certification mark referred to in Paragraph 1 shall specify the following:

- (1) the characteristics to be certified by the certification mark;
- (2) the condition on the use of the certification mark;
- (3) the method of managing and supervising the use of the certification mark; and
- (4) the procedures for applying to use the certification mark and resolving disputes thereof.

The Registrar Office shall publish the registration of the certification mark along with regulations governing the use of such mark; any amendment of such regulations after registration is not effective unless the amended regulations are accepted and published by the Registrar Office.

Article 83 Use of certification mark

“Use of a certification mark” means the use of such mark by any person who is allowed by the proprietor of such mark in accordance with the conditions prescribed in the regulations governing the use of such mark.

Article 84 Special provisions for geographical certification mark

Subparagraph 1 of Paragraph 1 and Paragraph 3 of Article 29 shall not apply to the name of place of origin in a geographical certification mark.

A registered geographical certification mark shall not entitle the proprietor to prohibit a third party from indicating place of origin in relation to his/her own goods or services, in accordance with honest practices in industrial or commercial matters.

Article 85 Definition of collective membership mark

A collective membership mark is a sign that serves to identify the membership of members in an association, society or any other group which is a juridical person and distinguish such members from those who are not members.

Article 86 Requirements of application for registration of collective membership mark

An application for registration of a collective membership mark shall be made to the Registrar Office by filing an application containing relevant matters and the regulations governing the use of the collective membership mark.

The regulations governing the use of the collective membership mark referred to in Paragraph 1 shall specify the following:

- (1) the qualification of the members,
- (2) the condition on the use of the collective membership mark;
- (3) the method of managing and supervising the use of the collective membership mark; and

(4) the provisions against any violation of the regulations.

Article 87 Use of collective membership mark

“Use of a collective membership mark” means the use of such mark by any member to identify his/her membership in a group in accordance with the conditions prescribed in the regulations governing the use of such mark.

Article 88 Definition of collective trademark and geographical collective trademark

A collective trademark is a sign that serves to indicate goods or services of a member in an association, society or any other group which is a juridical person and distinguish goods or services of such member from those of others who are not members.

Where the collective trademark referred to in the preceding paragraph serves to indicate a specific place of origin of goods or services of a member, such goods or services from that geographical region shall have a given quality, reputation or other characteristic. An applicant may file an application for registration of a sign which contains such geographical name or is capable of indicating such geographical region as a geographical collective trademark.

Article 89 Requirements of application for registration of collective trademark

An application for registration of a collective trademark shall be made to the Registrar Office by filing an application designating goods or services and the regulations governing the use of the collective

trademark.

The regulations governing the use of the collective trademark referred to in Paragraph 1 shall specify the following:

- (1) the qualification of the members,
- (2) the condition on the use of the collective trademark;
- (3) the method of managing and supervising the use of the collective trademark; and
- (4) the provisions against any violation of the regulations.

In addition to the matters which shall be specified referred to in the preceding paragraph, the regulations governing the use of the geographical collective trademark shall also specify that any person from the corresponding geographical region whose goods or services and qualifications comply with the conditions contained in such regulations may be allowed to become a member of the group by the proprietor of the geographical collective trademark.

The Registrar Office shall publish the registration of the collective trademark along with regulations governing the use of such mark; any amendment of such regulations after registration is not effective unless the amended regulations are accepted and published by the Registrar Office.

Article 90 Use of collective trademark

“Use of a collective trademark” means the use of such mark by the group or any of its members in accordance with the conditions prescribed in the regulations governing the use of such mark.

Article 91 Provisions applied *mutatis mutandis* to geographical

collective trademark

Paragraph 2 and Paragraph 3 of Article 82 and Article 84 shall apply *mutatis mutandis* to geographical collective trademarks.

Article 92 Limitation of transfer, license and pledge

The right of a certification mark, collective membership mark or collective trademark shall not be transferred, licensed, or be the subject of a pledge, unless such transfer or license is unlikely to injure the interests of consumers or contravene fair competition and has been accepted by the Registrar Office.

Article 93 Special provisions for grounds for revocation

The Registrar Office may, upon a request by any person or *ex officio*, revoke the registration of a certification mark, collective membership mark or collective trademark if:

(1) the certification mark is used by the proprietor of such mark as a trademark;

(2) the proprietor of the certification mark carries on a business of goods or services of the kind certified;

(3) the proprietor of the certification mark is no longer competent to certify another person's goods or services to which the registration certification mark is designated;

(4) the proprietor of the certification mark discriminates against those who apply for certification;

(5) the proprietor of such trademark or mark transfers, licenses, or establishes a pledge on the right of such trademark or mark which falls under the preceding article;

(6) the proprietor of such trademark or mark does not manage or supervise the use pursuant to the regulations governing the use; or

(7) the proprietor of such trademark or mark uses such trademark or mark improperly that is likely to cause damage to others or the public.

The revocation shall also apply in the case where the proprietor of the registered certification mark, collective membership mark or collective trademark who, knowingly or with reasonable grounds to know, shows no objection to the conduct as prescribed in the preceding paragraph by a licensee.

Article 94 Provisions applied *mutatis mutandis* to certification mark, collective membership mark and collective trademark

Unless otherwise prescribed in this Chapter, the provisions of this Act in relation to a trademark shall apply *mutatis mutandis* to a certification mark, collective membership mark or collective trademark.

Chapter IV Penal Provisions

Article 95 Penalty for trademark or collective trademark infringement

Any person who commits any of the following acts, in the course of trade and without the consent of the proprietor of a registered trademark or collective trademark, shall be liable to imprisonment for a period not exceeding three years and/or a fine not exceeding NT\$200,000:

(1) using a trademark which is identical with the registered trademark or collective trademark in relation to goods or services which are identical with those for which it is registered;

(2) using a trademark which is identical with the registered trademark or collective trademark and used in relation to goods or services similar to those for which the registered trademark or collective trademark is designated, and hence there exists a likelihood of confusion on relevant consumers; or

(3) using a trademark which is similar to the registered trademark or collective trademark and used in relation to goods or services identical with or similar to those for which the registered trademark or collective trademark is designated, and hence there exists a likelihood of confusion on relevant consumers.

Article 96 Penalty for certification mark infringement

Any person who, in the course of trade and without the consent of the proprietor of a registered certification mark, uses a mark which is identical with or similar to the registered certification mark and used in relation to goods or services identical with or similar to those for which the registered certification mark is designated, and hence is likely to mislead relevant consumers shall be liable to imprisonment for a period not exceeding three years and/or a fine not exceeding NT\$200,000.

Penalties referred to in the preceding paragraph shall also apply to any person who sells or, due to an intent to sell, manufactures, possesses, displays labels, packaging, containers, or other articles to which a sign identical with or similar to another person's registered certification mark is applied, knowing that such articles would likely infringe rights of such certification mark as prescribed in the preceding paragraph.

Article 97 Penalty for sale or intent of sale of infringing article

Any person who knowingly sells or, due to an intent to sell, possesses, displays, exports, or imports another person's goods referred to in the preceding two articles shall be liable to imprisonment for a period not exceeding one year and/or a fine not exceeding NT\$50,000; same penalties shall also apply to acts performed through electronic media or on the Internet.

Article 98 Independent confiscation

All articles or documents that constitute infringement of rights in trademark, certification mark, or collective trademark shall be confiscated, regardless of whether such articles or documents belong to the offender.

Article 99 Right to sue of group other than juridical person

An unrecognized foreign juridical person or group may file a complaint, initiate a private prosecution, or institute a civil suit in respect of matters governed by this Act. Same rights shall also be entitled by a domestic group which is not a juridical person and has acquired rights to a certification mark.

Chapter V Supplementary Provisions**Article 100 Transitional provision for service mark**

A service mark which was already registered prior to the enforcement of the articles of this Act amended on April 29, 2003 shall be deemed a trademark from the date of enforcement.

Article 101 Transitional provision for abolishment of associated registration system

An associated trademark, associated service mark, associated collective membership mark or associated certification mark which was already registered prior to the enforcement of the articles of this Act amended on April 29, 2003 shall be deemed an independent registered trademark or mark from the date of enforcement; the period of right in such trademark or mark shall be the same as which originally granted.

Article 102 Transitional provision for abolishment of defensive registration system

With respect to a defensive trademark, defensive service mark, defensive collective membership mark or defensive certification mark which is already registered before the enforcement of the articles of this Act amended on April 29, 2003, the provisions in effect at the time of publication of registration of the said trademark or mark shall govern; rights of such trademark or mark shall be extinguished after the period of such rights expired, unless the proprietor of such trademark or mark applies for changing such trademark or mark into an independent one before expiration.

Article 103 Special provision for three-year period of non-use

With respect to the trademark or mark which has been changed into an independent one pursuant to the preceding article, the three-year period as prescribed in Subparagraph 2 of Paragraph 1 of Article 63 shall commence from the date of change.

Article 104 Trademark fees

Any person who files an application for registration, requests for renewal, recordal of change, opposition, invalidation, revocation or any other proceedings under this Act shall pay the required fees of filing, registration, renewal, recordal of change, opposition, invalidation or revocation.

Standards of Trademark Fees referred to in the preceding paragraph shall be prescribed by the Competent Authority.

Article 105 Transitional provision for abolishment of paying registration fees by two installments

For those who chose to pay registration fees by two installments and already paid the first installment prior to the enforcement of the articles of this Act amended on May 31, 2011, the second installment shall be paid pursuant to the provisions in effect before the amendment.

Article 106 Transitional provisions for opposition and invalidation

Registration of a trademark, against which an opposition or invalidation had been admitted but the disposition thereof had not been rendered prior to the enforcement of the articles of this Act amended on May 31, 2011, shall be cancelled only if such registration falls under the provisions of cancellation in effect both at the time of registration and after the enforcement of the amendment to this Act; the proceedings thereof shall follow the provisions in effect after the said enforcement. However, proceedings which had legally commenced prior to the said enforcement shall not be affected.

Paragraph 2 and 3 of Article 57 shall not apply to an invalidation which had been admitted but the disposition thereof had not been rendered prior to the enforcement of the articles of this Act amended on May 31, 2011.

A trademark, certification mark, or collective membership mark, which was registered prior to the enforcement of the articles of this Act amended on May 31, 2011 and against which an opposition or invalidation was filed or submitted in a proposal after the said enforcement, shall be cancelled only if such trademark or mark falls under provisions of cancellation in effect both at the time of registration and after the said enforcement.

Article 107 Transitional provisions for revocation

A revocation, of which the disposition had not been rendered prior to the enforcement of the articles of this Act amended on May 31, 2011, shall be processed pursuant to the provisions in effect after the said enforcement. However, proceedings that had legally commenced prior to the said enforcement shall not be affected.

Paragraph 2 of Article 57 applicable *mutatis mutandis* to Paragraph 2 of Article 67 shall not apply to a revocation which had been admitted but the disposition thereof had not been rendered prior to the enforcement of the articles of this Act amended on May 31, 2011.

Article 108 Special provision for date of filing

With respect to an application for registering a motion, hologram, or any combination thereof as a trademark which was filed prior to the enforcement of the articles of this Act amended on May 31, 2011, the

date of the said enforcement shall be deemed the filing date of such application.

Article 109 Special provisions for date of priority

With respect to an application for registering a motion, hologram, or any combination thereof as a trademark with a priority claim, if the date of filing of the first such application in a country which has reciprocal recognition of priority rights with the ROC or with a member of the WTO was prior to the enforcement of the articles of this Act amended on May 31, 2011, the date of the said enforcement shall be deemed the priority date of such application.

With respect to an application with a claim of exhibition priority, if the date of the first display of goods or services under the trademark applied for, at an international exhibition which was held or officially recognized by the Government of the ROC, was prior to the enforcement of the articles of this Act amended on May 31, 2011, the date of the said enforcement shall be deemed the date of exhibition priority of such application.

Article 110 Enforcement Rules

The Enforcement Rules of this Act shall be prescribed by the competent authority.

Article 111 Date of enforcement

The date of enforcement of this Act shall be decided by the Executive Yuan.