

International Comparative Legal Guides



Trade Marks 2020

A practical cross-border insight into trade mark work

Ninth Edition

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority is the Taiwan Intellectual Property Office (TIPO).

1.2 What is the relevant trade mark legislation in your jurisdiction?

The Taiwan Trademark Act was first enacted and promulgated on May 6, 1930.

The current Trademark Act was amended and promulgated on November 30, 2016 and became effective on December 15, 2016.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Any sign with distinctiveness, which may consist of words, designs, symbols, colours, three-dimensional shapes, motions, holograms, sounds or any combination thereof, can be registered as a trade mark.

2.2 What cannot be registered as a trade mark?

There is no sign that would be refused registration in Taiwan so long as it is distinctive enough.

2.3 What information is needed to register a trade mark?

The following information is needed:

- A Power of Attorney.
- Specification of goods/services sought for registration.
- The filing date and application number of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).
- A certified copy of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).
- The date of the first display of the goods or services and the name of the exhibition (if priority is claimed pursuant to the exhibition).

- The exhibition priority document (if priority is claimed pursuant to the exhibition).
- Five (5) prints (not less than 5cm and not exceeding 8cm in length and width) of the mark.

2.4 What is the general procedure for trade mark registration?

The trade mark registration procedure and estimated time are provided below:

- The applicant files the application.
- It takes about nine (9) months to receive an official decision.
- The registration fees must be paid within two (2) months from the day after the approval decision has been received.
- It takes about one (1) month to receive the registration certificate after the payment of the registration fees.

2.5 How is a trade mark adequately represented?

Traditional trade mark: A traditional trade mark should be presented in a two-dimensional still image.

Non-traditional trade marks:

- Three-dimensional trade mark: A three-dimensional trade mark should be presented by views depicting the three-dimensional shape of the trade mark. The applicant shall furnish a description explaining the three-dimensional shape. The reproduction may use broken lines to show the manner, placement or context in which the trade mark is used on the designated goods or services with a description explaining such broken lines.
- Colour trade mark: A colour trade mark does not have to be claimed using an internationally recognised colour code and can be presented by a sample of the colour or colours. The reproduction may use broken lines to show the manner, placement or context in which the colour is, or the colours are, used on the designated goods or services. The matter shown by the broken lines is not a part of the trade mark. The applicant shall furnish a description explaining such broken lines.
- Sound trade mark: A sound trade mark should be represented by a musical notation on a staff, a numeric music score or written explanation.
- Motion trade mark: A motion trade mark can be presented by still images of the varying process of the moving images. The applicant shall furnish a description explaining the movement in sequential order.
- Hologram trade mark: A hologram trade mark can be

presented by the perspective drawing(s) of the hologram. The applicant should provide a description stating the hologram. For a hologram that generates different representations because of different perspective views, the description should include the changes of the different perspective drawings.

- Repeating-pattern trade mark: A repeating-pattern trade mark can be presented by the pattern structure and serial arrangement. Also, the trade mark may be displayed in dotted lines showing the manner, position or context it is used on the designated goods or services; in particular, how the repeating-pattern trade mark is used on a specific portion of goods indicating the actual use should be clearly explained in the trade mark description, however, the dotted lines should not be part of the trade mark.
- Smell trade mark: A smell mark should be presented in written explanation. The applicant may submit product samples, product packages, and articles related to the services provided in actual use, or test papers with the smell, etc., as the specimens of a smell trade mark applied for registration.
- Position trade mark: A position trade mark can be presented by broken lines to show the position where the trade mark is actually applied on the goods or services, and a description clearly describes the trade mark itself and the manner how and the position where the trade mark is used on the goods or services.

2.6 How are goods and services described?

The goods and services are classified according to the Nice Classification system. Most of the class headings will be considered as too broad/indefinite in meaning to be acceptable for registration purposes; it is necessary to specify the goods or services. It is not permissible to claim "all goods in class".

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The measures required to file the non-traditional trade marks are given in question 2.5. In filing an application for registration of other non-traditional trade marks that are not given in question 2.5, the applicant must furnish the reproduction of the proposed trade mark. If the reproduction does not clearly and completely present the trade mark, a description, or even specimen(s) thereof should be provided in order to precisely define the scope of the rights and to enable third parties to ascertain the registered trade mark and its scope of rights according to the publication of the trade mark registration.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations or renewal purposes.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registered in Taiwan can only be protected in Taiwan.

2.10 Who can own a trade mark in your jurisdiction?

Any juridical or natural person, business or group can own a Taiwanese trade mark.

2.11 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use. Generally speaking, it needs at least three (3) years of use and advertising in Taiwan to acquire distinctive character.

2.12 How long on average does registration take?

It takes at least one (1) year from filing until registration of a trade mark if there is no objection from the examiner.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

In addition to attorney fees, the official fees (NT\$) for one (1) application in one (1) class are quoted as below:

Filing Fees

Goods

- NT\$3,000.00 if the designated goods are under 20 items; and
- NT\$200.00 for each additional item if over 20 items.

Services

- NT\$3,000.00; and
- NT\$500.00 for each additional retail services of specific goods if there are over five (5) such services in class 35.

Registration Fees

- NT\$2,500.00.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

Except by filing an application in Taiwan, there is no other route to obtaining a registration in Taiwan.

2.15 Is a Power of Attorney needed?

A Power of Attorney (simply signed by an authorised person) is needed.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

2.17 How is priority claimed?

The following documents and information are needed to claim priority pursuant to the corresponding WTO member country's trade mark application:

- Filing date and application number of the corresponding priority application: must be stated at the time of filing the Taiwanese application.

- A certified copy of the corresponding priority application: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the certified copy is not allowed.
- The following documents and information are needed to claim priority pursuant to the exhibition:
- The date of first display of the goods or services and the name of the exhibition: must be stated at the time of filing the Taiwanese application.
- Exhibition priority document: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the priority document is not allowed.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Taiwan recognises collective and certification marks.

A collective trade mark 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 to distinguish goods or services of such member from those of others who are not members.

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 to distinguish the goods or services from those that are not certified. 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 be an applicant for an application for registration of a certification mark.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The principal absolute grounds for refusal of registration are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is identical 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.
- A trade mark which is identical to the portrait or name of Dr. Sun Yat-Sen or of the head of the state.
- A trade mark which is identical 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.
- A trade mark which is identical or similar to the armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organisations or well-known domestic or foreign institutions undertaking business for public interests, and hence being likely to mislead the public.
- A trade mark which is identical 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.

- A trade mark which is contrary to public policy or to accepted principles of morality.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical 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.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers, unless the consent of the proprietor of the said registered trade mark or earlier filed trade mark to the application has been given and is not obviously improper.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark, unless the proprietor of the said well-known trade mark or mark consents to the application.
- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration, unless the proprietor of the said earlier used trade mark consents to the application.
- A trade mark which contains another person's portrait or well-known name, stage name, pseudonym, or alternative name, unless the said person consents to the application.
- A trade mark which contains the name of a well-known juridical person, business or any group, and hence there exists a likelihood of confusion of the relevant public, unless the said juridical person, business or group consents to the application.
- A trade mark which is 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.

3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds refusal can be overcome through argument, acquired distinctiveness through use, and/or obtaining a letter of consent.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

3.4 What is the route of appeal?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the Ministry of Economic Affairs (MOEA) within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

With respect to the examination of an application for trade mark registration, Taiwan adopts "the comprehensive examination system", which means that the trade mark authority *ex officio* examines all grounds for refusal including the grounds regarding conflicting trade marks which involve only private interests.

4.2 Are there ways to overcome a relative grounds objection?

An objection can be overcome by argument, limiting the specification, a letter of consent, and/or invalidating the earlier mark.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

4.4 What is the route of appeal?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the Ministry of Economic Affairs (MOEA) within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The principal grounds for opposition are given as below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.

- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical 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.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone can oppose the registration of a Taiwanese trade mark.

5.3 What is the procedure for opposition?

The procedure is as follows:

- The opposer files the opposition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the opposer to submit supplementary opposition reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The opposition is finalised if no appeal is filed.

6 Registration

6.1 What happens when a trade mark is granted registration?

The registration fees must be paid within two months from the day after the approval decision has been received. The trade mark will be registered and published after payment of the registration fees, and a registration certificate will then be issued.

6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights in Taiwan commence from the date of registration.

6.3 What is the term of a trade mark?

The term of a trade mark is ten (10) years.

6.4 How is a trade mark renewed?

Renewal will be granted upon filing of a renewal application and payment of the official fees.

In addition to attorney fees, the official fee for one (1) application for renewal of one (1) registration in one (1) class is NT\$4,000.00.

The renewal application shall be made within six (6) months before the expiration of its period. However, it is allowed to pay twice the official fees for renewal within six (6) months after the expiration of the period.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

An assignment of a trade mark shall be recorded with the TIPO.

For recordal of assignment, the following documents are needed:

- A Power of Attorney of the Assignee: to be simply signed by an authorised person; and
- A Deed of Assignment signed by the parties (a copy of the assignment is acceptable).

7.2 Are there different types of assignment?

A partial assignment is possible for certain goods or services and a trade mark can be assigned with or without goodwill.

7.3 Can an individual register the licensing of a trade mark?

A licence of a trade mark shall be recorded with the TIPO.

A licence agreement is no longer required for filing a licence application if the application is filed by the registrant.

A copy of the licence agreement signed by the parties is acceptable if the licence application is filed by the licensee.

7.4 Are there different types of licence?

A registered trade mark 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.

7.5 Can a trade mark licensee sue for infringement?

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

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence.

7.7 Can an individual register a security interest under a trade mark?

A creation, change, or extinguishment of a security interest made by a trade mark right-holder shall be recorded with the TIPO.

A description of the security interest signed by the parties is acceptable.

7.8 Are there different types of security interest?

There are no different types of security interest.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The principal grounds for revocation are provided below:

- Where the trade mark is altered by the proprietor in different forms from those by which it was registered or supplemented with additional notes whereby the trade mark is identical or similar to another person's registered trade mark in relation to goods or services which are identical or similar to those for which another person's registered trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- Where the trade mark 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.
- Where the trade mark has become the generic mark or term, or common shape for the designated goods or services.

8.2 What is the procedure for revocation of a trade mark?

The procedure is as follows:

- The petitioner files a revocation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the petitioner to submit supplementary revocation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The revocation is finalised if no appeal is filed.

8.3 Who can commence revocation proceedings?

Anyone can commence revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

The main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The trade mark is not used in a form as registered but it should be considered genuine use because its identity remains the same according to general social concept.

8.5 What is the route of appeal from a decision of revocation?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The principal grounds for invalidation are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical 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.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

9.2 What is the procedure for invalidation of a trade mark?

The procedure is as follows:

- The petitioner files an invalidation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.

- The TIPO notifies the petitioner to submit supplementary invalidation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The invalidation is finalised if no appeal is filed.

9.3 Who can commence invalidation proceedings?

Only an interested party can commence invalidation proceedings.

9.4 What grounds of defence can be raised to an invalidation action?

The main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The cited mark is not well-known in Taiwan in the case that the invalidation action is based on the well-known status of the cited mark.
- The disputed mark is not filed in bad faith.
- The disputed mark is inherently distinctive or has acquired distinctiveness through use.

9.5 What is the route of appeal from a decision of invalidity?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The Taiwan Intellectual Property Court (the Taiwan IP Court) has jurisdiction over all IP-related actions in Taiwan. In the event of trade mark infringement, a trade mark right-holder may initiate a civil action against a suspected trade mark infringer with the Taiwan IP Court to seek infringement removal and damages. Alternatively, the trade mark right-holder may file a criminal complaint for violation of the Taiwan Trademark Act against the suspected infringer with the district prosecutor's office that has jurisdiction in the place where the suspected infringer has his/her domicile or where he/she commits the violation of the Taiwan Trademark Act. The trade mark right-holder may initiate an incidental civil action during the trial proceedings after the prosecutor's indictment. Under the Intellectual Property Case Adjudication Act, the judge will hear and decide on the criminal action and the incidental civil action at the same time.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

In Taiwan, instead of the pre-trial discovery regime adopted in the US and Europe, the preparatory proceedings should go first before the parties in a civil action with respect to a trade mark infringement, to present their arguments on substantive issues in the oral argument sessions, after the civil action moves to the proceedings at the district court. The preparatory proceedings usually take around five (5) to eight (8) months, during which period the judge first examines if the required procedural formalities are met, and the parties submit their respective arguments or move for investigation on evidence. The judge compiles and lists the disputed issues on the case.

In a criminal action in regard to a trade mark infringement, the court issues a notice requesting the court appearance of the defendant and the prosecutor (or complainant) for preparatory proceedings, and the judge compiles the important issues on the substantive issues and evidence presented by the parties, provides opinions with respect to the admissibility of evidence presented by the parties, and decides to deny/accept motion(s) for investigation on evidence. The preparatory proceedings for a criminal action take around three (3) to five (5) months.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary injunctions and final injunctions are available in Taiwan.

- (i) A preliminary injunction is granted if the claimant can show that an injunction is necessary to prevent material harm or imminent danger or other similar circumstances. The factors generally considered by the court to determine whether a preliminary injunction is warranted include (a) likelihood of success on the merits of the case, (b) if the claimant would suffer irreparable harm in the absence of an injunction, (c) balance of interests between both parties, and (d) impact on the public interest.
- (ii) Final injunctions are typically granted if the claimant is successful at trial in establishing that (a) the trade mark is infringed (trade mark similarity and likelihood of confusion), and (b) the defendant is currently engaging in infringing activities or is likely to engage in infringing activities in the future.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party in a civil action may move the court to order the opposing party to produce documentary evidence in the opposing party's possession. The motion must specify the relationship between such documentary evidence and the disputed fact to be proved, as well as the legal ground for the opposing party's duty to produce such documents or materials. Under Article 344 of the Code of Civil Procedure, a party has the duty to disclose: (a) documents to which such party has made reference in the course of the proceedings; (b) documents whose delivery or inspection the other party may require, pursuant to applicable laws; (c) documents which were prepared for the interest of the other party; (d) commercial accounting books; and (e) documents which were made in respect of matters relating to the action (the party may refuse to produce such documents on grounds of privacy or trade secrets).

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In a criminal action for trade mark infringement, in principle, arguments or written statements made out of court by any person other than the defendant of an action cannot be taken as evidence, unless they are made by such a person being cross-examined in court. Any person who testifies by providing arguments or written statements before the judge should be ordered to make an affidavit, and any false statements given by such a person will be considered perjury, as defined by the Taiwan Criminal Code. In a civil action for trade mark infringement, either party may introduce a desired witness(es) or produce evidence in written form and also move for the judge to conduct a necessary examination of the witness(es) or conduct such examination himself/herself after informing the judge.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

No; Article 16 of the Taiwan Intellectual Property Case Adjudication Act requires that the court may not suspend or stay the proceedings pending resolution of validity by the TIPO or the Administrative Court.

10.7 After what period is a claim for trade mark infringement time-barred?

The damages claim for trade mark infringement is time-barred after a two-year period from the time when the trade mark owner becomes aware of the infringement and the infringer, or a 10-year period from the time when the infringement takes place, whichever expires earlier.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities for trade mark infringement in Taiwan.

Any person who commits any of the following acts, in the course of trade and without the consent of the proprietor of a registered trade mark or collective trade mark, shall be liable to imprisonment for a period not exceeding three (3) years and/or a fine not exceeding NT\$200,000.00:

- (1) using a trade mark which is identical to the registered trade mark or collective trade mark in relation to goods or services which are identical to those for which it is registered;
- (2) using a trade mark which is identical to the registered trade mark or collective trade mark and used in relation to goods or services similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers; or
- (3) using a trade mark which is similar to the registered trade mark or collective trade mark and used in relation to goods or services identical or similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers. (Article 95 of the Trademark Act.)

Any person who knowingly sells or, due to an intent to sell,

possesses, displays, exports, or imports infringing goods shall be liable to imprisonment for a period not exceeding one year and/or a fine not exceeding NT\$50,000.00; the same penalties shall also apply to acts performed through electronic media or on the Internet. (Article 97 of the Trademark Act.)

10.9 If so, who can pursue a criminal prosecution?

The trade mark right-holder and/or the exclusive licensee can bring a criminal action against the infringer(s).

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The inappropriate issuance of warning letters by any trade mark right-holder to any other persons, alleging that his/her competitors have infringed his/her trade mark right, constitutes improper use of a trade mark right, which violates Article 25 of the Taiwan Fair Trade Act. Any violator of the Taiwan Fair Trade Act by the act of improperly using his/her trade mark right, and thus impeding fair competition, shall be ordered by the competent authority to cease therefrom, rectify its conduct or take the necessary corrective action within the time prescribed in the order. In addition, the competent authority may impose on such violator an administrative penalty of not less than NT\$50,000.00 and not more than NT\$25 million.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A suspected trade mark infringer may allege non-infringement by raising the following grounds as a defence: (1) the allegedly infringed mark should be cancelled or revoked; (2) the allegedly infringing mark is not identical or similar to the allegedly infringed mark and is unlikely to cause confusion; (3) the allegedly infringing mark is not used as a trade mark; or (4) the allegedly infringing mark is not used for marketing purposes.

11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to a non-infringement allegation, the suspected infringer may assert that:

- (1) he/she properly uses the mark in dispute and should be free from the capacity of the allegedly infringed trade mark right in the following circumstances: (i) he/she indicates 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, but does not use the mark in dispute as a trade mark; (ii) he/she uses the mark in dispute where it is necessary for the goods or services to be functional; (iii) he/she uses, with *bona fide* intent and prior to the filing date of the registered trade mark, an identical or similar mark on goods or services identical or similar to those for which the registered trade mark is protected, provided that the use is only on the original goods or services and the proprietor of the registered trade mark is entitled to request the party who uses the trade mark to add an appropriate and distinguishing indication; or (iv)

goods have been put on the domestic or foreign market under a registered trade mark by the proprietor or with the proprietor's consent, and the proprietor is not entitled to claim trade mark rights on such goods, unless such claim is to prevent the condition of the goods having been changed or impaired after they have been put on the market, and unless there exist other legitimate reasons (Article 36 of the Trademark Act);

- (2) no damages should be awarded because the suspected infringer lacks the subjective intention or negligence on which an award of damages must be based; or
- (3) the plaintiff's claim for damages was time-barred (see the answer to question 10.7).

12 Relief

12.1 What remedies are available for trade mark infringement?

In Taiwan's IP protection regime, filing a criminal complaint for violation of the Taiwan Trademark Act is one of the remedies available to a trade mark right-holder. Seized counterfeit items will be confiscated and destroyed after the judge confirms and sustains, by a decision, the occurrence of a violation of the Taiwan Trademark Act. A civil action serves as another remedy, by which a trade mark right-holder may seek injunction, removal of infringement, compensation, and destruction of seized counterfeits.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

For initiating a civil action regarding trade mark infringement, the plaintiff should first pay litigation expenses to the court, and the losing party should bear the litigation expenses upon conclusion of the case. In other words, the winning party may request the losing party to bear litigation expenses. Where the parties each win the case in part, the court may, at its discretion, order the parties to bear the litigation expenses in a certain proportion or a particular party alone to bear them, or order both parties to bear litigation expenses that have been incurred by them respectively. In addition, the parties each should bear their attorney's fee incurred by them respectively, unless the court determines that the losing party should bear the attorney's fee incurred in the third-instance proceedings.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In the criminal aspect of the trade mark infringement action, the complainant may seek an appeal as well, by filing a motion with the prosecutor's office for the prosecutor to take an appeal if he/she finds the judgment unjustifiable. The second-instance judgment will, however, be the final judgment with binding effects on the criminal cases of trade mark infringement. That is to say, neither the prosecutor nor the defendant will be allowed to bring the criminal case to a third-instance trial. In the civil action, either party may appeal the district court judgment to the High Court should they find the judgment unjustifiable. The matter may be brought to the Supreme Court – the court of third instance – if the value of claim meets the NT\$1.65 million

threshold. An appeal taken to the Supreme Court must be based on a point of law.

13.2 In what circumstances can new evidence be added at the appeal stage?

The parties in a trade mark infringement action may present arguments, materials and/or introduce (new) evidence in due course during the relevant proceedings, or the court may deny those presented by reason of obstruction of proceedings. Furthermore, as the third-instance court is to examine judicial and only judicial issues, neither party is to present a new argument or introduce evidence of any kind during the third-instance proceedings.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The trade mark right-holder or its authorised agent may file the request for recording its registered trade mark(s) with the Customs Authority, with the material on the key points to identify a counterfeit. The Customs Authority will withhold the shipment of suspected counterfeits declared for export or import based on the relevant recordation data. The Customs Authority shall give a notice to the right-holder of the said trade mark and the importer/exporter, and specify a period for the right-holder to come to the Customs Authority to identify the existence/non-existence of an infringement and furnish proof of the infringement, and also for the importer/exporter to furnish proof of non-infringement. It should be noted that the Customs Authority's request for an authenticity examination must be answered in a working day from receiving a notice from the Customs Authority, and the assessment report confirming the shipment to be counterfeit, issued by the right-holder or its authorised agent, should be provided to the Customs Authority within three working days (an additional three-working-day extension is allowed). If the result of the authenticity examination performed by the trade mark right-holder (or its authorised agent) shows that the sample examined is counterfeit and the importer/exporter is unable to produce the authorisation letter or any evidence of non-infringement, the shipment will be detained.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks that are commonly known to the public are eligible for right protection under the Taiwan Fair Trade Act in the case that they are used in the same or similar manner so as to cause confusion with the goods or service of another (Article 22 of the Fair Trade Act). Advertisements published in Taiwan, and figures with respect to sales volume and market share, etc., for the past two (2) to three (3) years, shall be presented if seeking Fair Trade Act protection.

15.2 To what extent does a company name offer protection from use by a third party?

No company may use a company name identical to that of

another company. Where two companies' names contain any word that may specify their different business categories, such company names shall not be considered identical to each other. A company name can be used exclusively by its owner once it has been approved by, and registered at, the competent authority. Anyone can initiate a civil action with the court, or file a complaint with the Fair Trade Commission, against the use of his/her company name by a third party in the same or similar manner without his/her prior consent to seek remedy and protection, by asserting the third party's violation of the Fair Trade Act.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Registered trade marks are eligible for protection under the Trademark Act. In addition, Fair Trade Act protection is conferred on unregistered trade marks, containers, packaging, or appearance of goods or any other symbol that represents the goods of any person. An enterprise may be held in violation of the Taiwan Fair Trade Act for any deceptive or obviously unfair conduct that is able to affect trading order by taking a free ride on any other person's goodwill, such as the act of using the appearance of goods that is identical or similar to that of another recognised by relevant enterprises or consumers and thus causing confusion, or by the act of plagiarising any other person's book title that is able to affect trading order.

16 Domain Names

16.1 Who can own a domain name?

Anyone can own a domain name after completing the due course of registration.

16.2 How is a domain name registered?

A registrant may apply to the Registrar, such as the Taiwan Network Information Center (TWNIC), to register the domain name he/she selects and to pay the annuity.

16.3 What protection does a domain name afford *per se*?

No one may repeat the registration of any registered domain names. According to the "Domain Name Dispute Resolution Policy" passed by the TWNIC, in the following three circumstances, a complaint should be sustained and the TWNIC Registry Administrator should cancel or transfer a registered domain name to the complainant after the dispute-resolution provider decides in favour of the complainant:

- (1) The domain name in dispute is identical or confusingly similar to the complainant's trade mark(s).
- (2) The registrant of the domain name in dispute has no rights or legitimate interests in the domain name in dispute.
- (3) The registrant has registered or used the domain name in dispute in bad faith.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

TWNIC deals with the disputes with respect to or arising from the country code top level domain names (ccTLDs) ending with ".tw".

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Taiwan, domain name dispute may be brought to the court for resolution by initiating a lawsuit. In addition to a lawsuit, there is another expedited procedure for dispute resolution by having domain name dispute handled by a dispute-resolution provider which is an organisation or institution approved and recognised by TWNIC, such as, Science & Technology Law Institute or Taipei Bar Association, which will select qualified panellists to handle domain name disputes according to the “Domain Name Dispute Resolution Policy” as mentioned in question 16.3.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

A third-party may present to the Taiwan IPO a written statement of comments on another’s trade mark application for the examiner to further look into and determine the registrability of the proposed mark. To fill in the lack of official working guidelines, a newly prescribed Directions for Trademark Application Third-party Opinions was implemented as of 20 June 2019.

Highlights of the Directions:

- Any third party may, with or without identifying itself, present written comments on the trade mark application filed by another.
- The examiner shall investigate and determine whether or not the evidence presented by the third-party is workable as valid proof against the registrability of the proposed mark. Furthermore, the examiner must duly accord the applicant an opportunity to express his or her comments on the evidence presented by the third party or the third-party allegations cannot be taken as the factual basis to deny approval of the registration of the proposed mark.
- The examiner is not required to answer the third-party written comments received or keep the third party informed of the conclusion of the examination of the application.
- The third party may oppose or seek invalidation of the approval of registration of the proposed mark if it finds it unacceptable that the proposed mark is approved of registration in conclusion of the examination.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. **Integrity of identity of a mark and defining trade mark use based on the actual use of a mark on designated goods/services** (*Supreme Administrative Court precedent decision of 22 March 2019, case no. 108-Pan-Zi no. 133 [2019]*).

Facts

Company S, a Taiwanese company, successfully obtained Taiwan IPO’s grant of its application (filed on 6 December 1993) for registering its **Apple** mark designated to be used on preserved fruit, candies, cookies, confectionary, bread and cakes. The registration was, however, challenged on 25 September 2014 by a foreign company seeking revocation of the registration

pursuant to subparagraph 2, paragraph one, Article 63 of the Trademark Act (for, as the foreign company alleged, the mark was never put to use for three consecutive years after it was duly registered or has been in a state of non-use for three consecutive years). On 8 October 2015, Taiwan IPO revoked the registration. Company S appealed the revocation decision which appeal was dismissed on 3 February 2016. On the administrative action initiated by Company S, the High Administrative Court (HAC) holds that Company S has used the mark in issue on cake products and other designated goods, and it revokes both the dismissal of Company S’s appeal and Taiwan IPO’s revocation decision. The case was brought by the foreign company to the Supreme Administrative Court (SAC).

Disputed issues

Company S has the mark in issue put to use on and only on cake products. Does said status of use of the mark account for valid use of the mark on the other designated goods as a whole? In other words, how should the valid use of a registered mark on the specification be defined when subparagraph 2, paragraph one, Article 63 of the Trademark Act is allegedly invoked to operate?


Reasoning

- The identity of the mark means the integrity of the mark is recognised by the consumer under general concepts of the society when the mark which in actual use may be in a form differing in a certain way from itself as registered, yet still bears, with no substantial change of any kind, the identified key features of itself as registered. In the case, the SAC concurs with the lower court on the finding that the registered mark in issue as practically used on cake products by Company S bears no change of any kind to its identified key features; that is, the mark in actual use and the mark as registered are one and the same so said actual use of the mark constitutes use of the registered mark.
- Further, the HAC holds that Company S has used the mark in issue on cake products, one of the goods covered by the specification of the mark, which actual use may be held as the use of the mark on the other items of the goods designated such as *preserved fruit, candies, cookies, confectionary* and *bread* products, even in the absence of proof of actual use of the mark on such items, as each of them are of the same nature as and extensively similar to cake products.
- However, the SAC holds that none of *preserved fruit, candies, cookies, and confectionary* products are products of the same kind as cake products as they each have their own maker, vendor, distribution access and consumer group and cannot be determined literally as goods of the same kind. Furthermore, cake products and bread products may be made by the same maker and their distribution access may be substantially overlapped. They are still, however, not products of the same kind. Therefore, the fact of the mark in issue having been used on cake products does not automatically lead to establish that the mark has been used on preserved fruit, candies, cookies, confectionary, and bread products.
- In conclusion, the SAC finds that none of *preserved fruit, candies, cookies, confectionary* and *bread* products are products of the same kind as cake products on which the use of the mark in issue has been established by evidence. Accordingly, the SAC revoked the lower court’s decision in part pertaining to the use of the mark on cake products as being used as well on the other items of the specification

of the mark, none of which are of the same nature as cake products.

- The Hershey Company wins a trade mark battle against Taiwan Kaiser Foods Industrial Co., Ltd. in Taiwan (*Interim decision entered 21 March 2019 by IP Court in the second instance, case 106-Min-Gong-Shang-Zi no. 5*)





Facts

The Hershey Company (“Hershey”) sued Taiwan Kaiser Foods Industrial Co., Ltd. (“Taiwan Kaiser”) alleging trade mark infringement and Fair Trade Act violations claiming for damages. The IP Court decided in favour of Taiwan Kaiser in conclusion of the first instance proceedings in September 2017. Hershey appealed. In conclusion of its adjudication of the trade mark infringement and Fair Trade Act violations alleged, the IP Court entered an interim decision during the proceeding on the appeal, which decision would be the basis to adjudicate and determine the damages claimable. The IP Court in the second instance finds the KAISER mark and the KAISER’S mark as used on the chocolate products made and sold by Taiwan Kaiser both are infringing upon the HERSHEY’S mark, HERSHEY’S mark and  mark owned by Hershey.

Reasons

According to the IP Court’s reasoning of the interim decision entered:

- The parties’ products in issue are both chocolate products, are both generally distributed at convenience stores, general stores and are both sold at a generally affordable price.
- For the product in issue No. 1-1 and No. 1-2, the device the packaging bag of one product bears is similar to that depicted on the packaging bag of the other. When viewed overall as a whole, products in issue No. 1-1 and No. 1-2 have similar packaging and bear similar trade marks (as shown in the table below). In addition, for the product in issue No. 2-1 and No. 2-2, their respective word mark, KAISER’S and HERSHEY’S both are depicted in capital letters and bold type in similar word length with no special artistic design. Also, they both end with an ‘S’. Likewise, KAISER’S and HERSHEY’S are similar when viewed as a whole (as shown in the table below).
- Since its establishment in 1894, Hershey has been using the HERSHEY’S mark on its products sold around the world with its use of the same mark in Taiwan beginning in 1974. Taiwan Kaiser has used its KAISER’S mark after it was incorporated in 1977. It therefore may be reasonably found that Taiwan Kaiser has knowledge of the HERSHEY’S mark being used by Hershey, and this clearly manifests Taiwan Kaiser has not used its KAISER’S mark in good faith as alleged.
- Hershey presented evidence proving existence of consumer confusion and mistaken belief.
- In Conclusion, the IP Court, in the second instance, finds that the marks owned by the parties respectively are relatively similar and they have the same specification. Taiwan Kaiser’s good faith asserted is questionable plus consumer confusion and mistaken belief indeed exists. Taiwan Kaiser is therefore held to have acted in violation of the Trademark Act.

Product in issue No. 1-1	Product in issue No. 1-2
 Hershey’s (Hershey’s Kisses chocolates)	 Taiwan Kaiser (Kaiser’s chocolates in bite-sized pieces)
Product in issue No. 2-1	Product in issue No. 2-2
 Hershey (milk chocolate bar)	 Taiwan Kaiser (milk chocolate bar)

17.3 Are there any significant developments expected in the next year?

The trade mark authority of Taiwan has drafted the amendments on partial provisions of the Taiwan Trademark Act. Highlights of the draft amendments are summarised as follows.

- The qualifications for a trade mark agent are specified for those who, other than attorneys or representatives, have been licensed to practice matters related to trade marks.
- The competent agency may serve the document(s) electronically.
- Accelerated examination for trade marks is incorporated and the scope thereof is limited to trade mark registration applications.
- Requirements for claiming right of priority and for application for trade mark registration revocation are relaxed.
- The scope of acquired distinctiveness or functions of a trade mark are specified.
- The circumstances of nominative fair use and earlier use with the bona fide use of a trade mark which is not subject to the effect of trade mark right is specified.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In general circumstances of trade mark infringement, the trade mark right-holder may act upon Taiwan Trademark Act to assert trade mark right in civil or criminal aspects. In criminal aspects, the trade mark right-holder may seek a raid action to be initiated by the IPRP Team, which will produce more impeding effects and thus serve as the most common remedial measure for trade mark owners in Taiwan. In addition, civil and criminal lawsuits are subject to different standards sustaining the existence of trade mark infringement. Due to this fact, even if the trade mark right-holder loses the criminal lawsuit, the trade mark right-holder still has a chance to win the civil action to obtain the award of damages if the infringer is held to be infringing trade mark rights by negligence, because criminal judgments have no binding effects on the civil cases involving the same incident (matter/occurrence).



Director, Attorney-at-Law and Patent Attorney, TIPLo Attorneys-at-Law.

Mr. J. K. Lin became the Director of TIPLo in 1997, after TIPLo's founder Mr. M. S. Lin passed away. During the 22-year tenure up to now, J. K. has set out to further streamline the hierarchy of the staff and adopted effective formulae leading to significant quality improvement of TIPLo's patent, trade mark and legal services that accommodate clients' intensifying needs for IPR enforcement. J. K. also devotes his time to many public speaking events targeted at global corporations and international society, addressing issues of IP concerns, unfair competition and others, while following the footsteps of his late father in dedicating to pro bono activities with NGOs such as the Judicial Reform Foundation, the Taiwan International Law Society and the Taiwan Human Rights Committee, among many others. He is currently a council of the APAA Asian Patent Attorneys Association (APAA) and is vice president of the APAA's Taiwan Group and Co-Chairperson, Organizing Committee, 2019 APAA 70th Council Meeting in Taipei.

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Mr. H. G. Chen is the Chief of the Legal Department of TIPLo. He has been practising law in Taiwan for more than 30 years. H. G. has extensive experience in the fields of intellectual property, litigation, unfair competition, dispute resolution and general corporate matters. In the late 1980s, he demonstrated preeminent litigious flair by successfully representing a client in a leading trade dress case in Taiwan before the enactment of the Taiwan Fair Trade Act. He has represented various global corporate clients from Japan, the United States and Europe in patent and trade mark litigation, licensing and negotiation in Taiwan, and this illustrious record has won him a reputation as one of the most successful lawyers in the country. He served as the president of the Taipei Bar Association for the term of May 2005 to November 2006. He was the Director of the Intellectual Property Committee of the Taipei Bar Association (1990–1993) and the Taiwan Bar Association (1993–1995). He is now an executive member of the Board of Directors of the Asian Patent Attorneys Association (APAA), Taiwan Group.

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TIPLo Attorneys-at-Law (also known as Taiwan International Patent & Law Office) was founded in 1965 by M. S. Lin and a group of professional legal and technical associates specialising in intellectual property rights. With over four decades of evolution, TIPLo is now one of the largest and most reliable intellectual property law firms in Taiwan, with diversified expertise to encompass IP as well as general legal services provided by a full-service law firm. TIPLo is currently staffed by over 288 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages. TIPLo mainly consists of three departments, namely the Patent, Trademark and Legal Departments. Our patent engineers and attorneys have an average career length of more than 10 years, with expertise and experience covering a wide range of technical fields including electrical engineering, mechanical engineering, applied chemistry, biochemical engineering, biotechnology, pharmaceuticals, semiconductors, computer technology and other emerging areas. TIPLo

is a leading firm in patent and trade mark prosecution, invalidation and opposition proceedings, infringement assessment and validity appraisal. The proficiency of our Legal Department in IP enforcement, particularly infringement litigation and coordination of police raids, is also highly recognised by law enforcement institutes of all levels and the industry alike, reinforcing TIPLo as one of the most effective law firms representing the interests of its clients.

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