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Points for Use of Registered Trademarks

1. Preamble

"First filed, first registered" principle is adopted in our trademark registration system. A trademark may be filed for registration even if it has not been used. However, the function and registration purpose of a trademark is not only to obtain trademark right but also to make consumers connect trademark with goods or services and identify source and quality of trademarks. Trademark Law gives the first applicant propriety. If the trademark owner just monopolizes the trademark without use, this will prevent other trademarks from being registered and cause loss of trademark function and values against legislative purpose of trademark law.

To use trademarks is so important. Trademark use is defined in Article 6 of the Trademark Law. Article 57 of the same Law specifies how trademark users should use the registered trademark. Any trademark will be revoked if it has not been put into use for 3 years or is used partially or with change or addition. In the wake of booming information and different transaction modes and promotions, use of trademark becomes varied. This Points is to remind trademark owners to legally use registered trademarks and to maintain their validity. As to use of certification marks, collective trademarks and collective marks, please refer to "Examination Guidelines for Certification Marks, Collective Trademarks and Collective Marks".

2. Definition and forms of trademark use

Article 6 of the Trademark Law stipulates "The use of a trademark referred to in this Law shall denote the use of the trademark on goods, services or relevant articles or through a two-dimensional graphic picture, digital visual and audio form, electronic media or other media that suffices to make relevant consumers recognize it as a trademark, for marketing purpose." According to the provision, the so-called "use of trademark" shall meet two requirements, 1) subjectively the user is for marketing purpose; and 2) objectively relevant consumers must identify it as a trademark. The fact proving use by the trademark owner shall conform to commercial trading practice (Para. 3, Article 59 of the Trademark Law). Trademarks may be used on goods, services or relevant articles or through a two-dimensional graphic picture, digital visual and audio form, electronic media or other media that suffices to make relevant consumers recognize it as a trademark.

2.1 Use on goods

Use of trademarks on goods refers to use on goods, packages, containers, labels, descriptive literatures, price lists, catalogues, relevant articles or documents or through a two-dimensional graphic picture, digital visual and audio form, electronic media or other media to promote the goods. Trademark may be promoted through media like magazines, TV commercials, in addition to use on goods, packages or containers. It is acceptable for medicine traders to use trademarks on tablet, package, ingredient description, poster, leaflet etc. or through network, TV, broadcast, newspapers, electronic signboard or launch.

2.2 Use on services

Use of trademarks on services refers to use the trademark on relevant articles or documents relating to the services through a two-dimensional graphic picture, digital visual and audio form, electronic media or other media to promote the services. For instance, restaurant owners may use trademarks on signboards, uniforms, plates, menus, price lists, business cards and other relevant articles or through network, TV commercials, broadcast, newspapers, electronic signboards or trade fairs to promote the services. Department stores or large groceries may use trademarks on signboards, introduction boards inside stores, uniforms, windows, stands, shopping carts, shopping baskets, shopping bags, cashiers, receipts, product catalogues and other relevant articles or documents or through network, TV commercials, broadcast, newspapers, electronic signboards or production promotion and sales activities. A trademark used on goods or packages/containers shall not be deemed to be used on services.

Use of a trademark on services refers to providing services to the public, not for the trademark owner itself. For example, a trademark is registered for use on “acting as an agent for import and export” but the trademark will not be deemed to be used legally if its owner uses the trademark on import and export for its own goods.

3. Judgement on use of registered trademark

Trademark owner acquires a trademark right on the designated goods or services granted for registration (Para. 1, Article 29 of the Trademark Law). Determination on use of a trademark rests upon whether its owner actually uses the trademark for marketing purpose and whether it can make relevant consumers recognize it as a trademark so as to be distinguished from others goods or services.

3.1 Users

3.1.1 Trademark owner

In principle, registered trademark should be used by its owner. The so-called “trademark owner” can be a company, a business or a natural person (Article 2 of the Trademark Law). If a trademark is owned by a representative of a company, the trademark may be used by the company under the representative’s authorization so that the trademark may be deemed to be used by the representative (the proviso of Item 2, Para. 1, Article 57 of the Trademark Law). As to a business without partnership, its owner should be the responsible person so that use of a trademark registered in the name of the business or its responsible person by the business or its responsible person may be accepted.

3.1.2 Licensed user

A registered trademark may be used by any person authorized by the trademark owner, like licensee. A trademark legally licensed to another person for use may be deemed to be legally used. In other words, a registered trademark used by a licensed user may be

deemed to be legally used; a trademark used without authorization will not be deemed to be legally used.

According to Article 34 of the Trademark Law, a license recordation shall be revoked if the licensee violates the provision of Paragraph 4 of Article 33 and fails to correct within a specified time limit. Trademark license shall be recorded with this Office and unrecorded license shall have no locus standi against third parties. However, trademark use is a matter of judgement on facts. Trademark may be deemed to be legally used as long as the licensed user does use the trademark, even though the trademark license is not recorded with this Office.

3.2 Used objects

According to the Trademark Law, the used objects refer to the registered trademark and the designated goods or services. Therefore, the events for trademark use prescribed in Article 57 of the Trademark Law focus on the registered trademark and the designated goods or services.

3.2.1 Design

A trademark owner shall be considered using his registered trademark where the actually-used trademark is different from the registered trademark but its identity remains according to general social concept (Para. 1, Article 58 of the Trademark Law). The so-called “identify” refers to a trademark actually used is slightly different the design originally registered but essentially its characteristic remains the same and they bring consumers the same impression.

3.2.1.1 Design with identity

In actual use, change of size, proportion, script/typeface or arrangement of a trademark design still can be identified. To judge identity, examination should be made case by case according to general social concept and consumers’ knowledge. The following (1) to (3) may be deemed to be used:

(1) change of arrangement

registered design

亞都

actually-used design

亞
都

(2) change of script/typeface

a. registered design

香草集

actually-used design

香草集

b. registered design

BABY CARE

actually-used design

baby care

(3) change of subsidiary portion

registered design



actually-used design

BSM

(4) change of colors

A trademark owner should use its trademark in the colors originally registered. If a trademark in black actually used in colors may be deemed to be used as long as its characteristic essentially remains the same according to general social concept and consumers' knowledge. However, a color trademark design will not be deemed to be used if change of color cause loss of identity according to general social concept and consumers' knowledge.

a. registered design

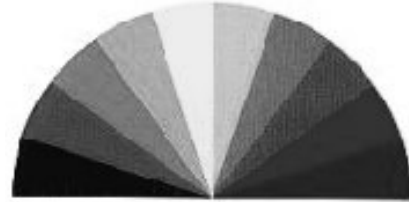
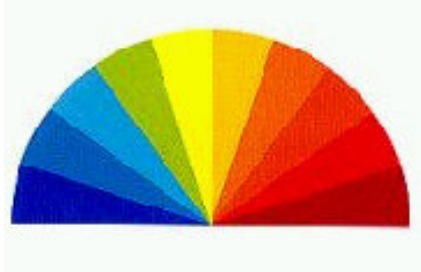


actually-used design



b. registered design

actually-used design

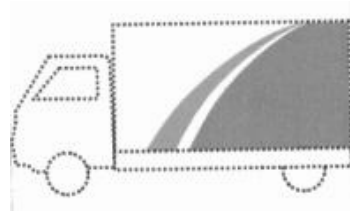
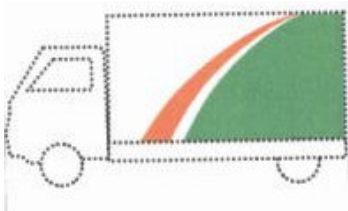


(5) change of colors of color designs

Since color is the main distinctive feature for color designs, change of colors will cause loss of identity.

registered design

actually-used design



3.2.1.2 Design partially used

In actual use, trademark should be used as a whole. Use of partial design will not be deemed as to be used.

registered design

actually-used design



If the registrant intended to use a part of its trademark, the part should be filed alone according to the Trademark Law. Exporters should file an application for the foreign word/s alone though a trademark consisting of Chinese characters and the foreign word/s has been registered; otherwise, use of the foreign word/s alone could cause revocation of the registered trademark in accordance with Item 2, Para. 1, Article 57 of the Trademark Law.

registered design

actually-used design



(2) To use the trademark partially and separately

If the design of a registered trademark is a combination of Chinese characters and foreign words, use of the Chinese characters or foreign words separately on different articles like packages and containers, will not be deemed to be used.

3.2.2 Goods or Services

A trademark registration will be revoked if without justifiable reasons, the trademark has not been put into use for three years or has been continuously suspended from use for three years according to Item 2, Para. 1, Article 57 of the Trademark Law. Para. 4 of the same Article provides that where the fact and the reason only exist in respect of the partial goods or services designated for use by the registered trademark, revocation of the registration may be done to that partial goods or services. Therefore, a registered trademark should be actually used on goods or services originally designated.

For example:

- (1) Actual use on compact will be deemed to be used on cosmetics (originally registered).
- (2) Actual use on veterinary medicines will be deemed to be used on medicines (originally registered).
- (3) Actual use on credit issuance services will be deemed to be used on banking services (originally registered).
- (4) Actual use on pharmaceutic services will not be deemed to be used on pathology inspection services (originally registered).

To examine whether use of a trademark on free gift is acceptable, actual use for sales purpose and consumers' knowledge should be based.

If a trademark used on free gift is simply for promotion not for the free gift and relevant consumers do not consider it as a trademark for free gift, this is not use of trademark on

free gift.

3.3. Expiry

The period of a trademark right acquired by the owner shall be ten years as of the date of publication of the registration (Article 27 of the Trademark Law). The period of a trademark right may be applied for renewal and each renewal of the period of exclusive use shall be ten years. However, a trademark after registration should be used according to law; a trademark will be revoked in accordance with Item 2, Para. 1, Article 57 of the Trademark Law if without justifiable reasons it has not been used for 3 years or has been suspended from use for 3 years.

The so-called “justifiable reasons” in Item 1, Para. 2, Article 57 of the Trademark Law refers to events unable to resist:

- (1) A trademark is used on medicines which cannot launch before examination by the agency in charge;
- (2) A trademark is used on liquor made in China;
- (3) break-off of transportation, shortage of materials or disasters;

A trademark owner may not claim justifiable reason because of distraint of a registered trademark.

3.4 Area

A trademark after registration is deemed to be used if it is used on the designated goods or services in Taiwan. However, a registered trademark will be deemed to be used even though the products are not sold in Taiwan under the following situations:

3.4.1 For export

According to Para. 2, Article 58 of the Trademark Law, a registered trademark used on goods or articles for export should be deemed to be used.

Besides, trademark for OEM or ODM may be deemed to be used.

3.4.2 For network

Use of a registered trademark through network shall meet Article 6 of the Trademark Law. The following elements should be considered:

- (1) Consumers do visit the website or make purchase through the website.
- (2) The trademark owner provides services or engages in business activities in Taiwan.
- (3) Address and phone numbers in Taiwan are shown on the trademark owner’s website.

(4) The goods or services may be legally delivered in Taiwan and the price is in NT dollars.

Purchase orders, invoices and product catalogues may be acceptable.

3.5 Evidences

3.5.1 Showing trademarks

Acceptable use evidences are samples, photos, packages, containers, purchase orders for signboards, receipts for interior decoration, contracts, shipping documents, ads, catalogues, posters, leaflets or documents or papers or photos for services bearing the trademark together with invoices, receipts or ads.

Use evidences for three-dimensional trademark, color trademark, sound trademark are almost the same as plane trademark and presentation of three-dimension, colors and sound should be clearly made.

3.5.2 Indicating dates and users

Registered trademark, dates and users should be shown on use evidences like magazines, catalogues, posters, invoices, shipping documents.

3.5.3 Meeting marketing situation

Use evidences for a registered trademark shall conform to commercial trading practice (Para. 3, Article 59 of the Trademark Law).

The following local newspapers advertisements should not be acceptable because they are not for sales purpose according to general social concept and market situation.

中華民國○○年○月○日 星期○ ○ ○ 時報

	<p>Ann</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>潔莉安</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>JOY</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>MSE</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>
<p>妙欣</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>I&Q</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>愛之船</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>馨韻</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>Sinda</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>
<p>海拉斯</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>捷莉</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>蒂華納</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>Rose</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>美樂思</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>
<p>Lady</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>蒂華納</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>PHOENIX</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>仙蒂 Sandy</p> <p>衣服、襯衫、 內衣、睡衣、 裙子、褲子、 西裝、領帶、 鞋子、襪子、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、 襪子、圍巾、</p>	<p>○○○服飾 股份有限公司</p> <p>台北市○ 路○巷 ○號○樓</p>

Use evidences of licensee users are acceptable (the proviso of Item 2, Para. 1, Article 57 of the Trademark Law).

4. Events resulting in revocation of registered trademarks

Trademark owner should continuously and legally uses a trademark after registration. A trademark registration will be revoked if having the following events:

4.1 Non-use for 3 years

For trademark revocation cases, the trademark owner should take the burden of proof.

4.2 Use with change and addition

Change or addition of words, devices and colors of a registered trademark will be revoked in accordance with Item 1, Para. 1, Article 57 of the Trademark Law if it is likely to cause confusion and misidentification to relevant consumers in regard to source or manufacturer of the goods it represents. For example:

(1)

registered design



changed design



the cited trademark design



(2)

registered design



changed design



the cited trademark design



4.3 Generic term

According to Item 4, Para. 1, Article 57 of the Trademark Law, a registered trademark will be revoked where the trademark has become a commonly-used mark, name or shape of the designated goods or services. To prevent a registered trademark from becoming a generic term, trademark should be used with the goods or shown with ® beside.

For example: “貓眼” has become a generic term on various reflectors for road

貓眼

4.4 Likely to cause the public to misidentify nature, quality or place of origin of goods

According to Item 5, Para. 1, Article 57 of the Trademark Law, a trademark will be revoked where the trademark in actual use is likely to cause the public to misidentify or to have a mistaken belief in nature, quality or place of origin of the goods or services. For example:



5. Others

5.1 Use not like trademarks

5.1.1 Full title of company name

Use of full title of the company name on goods, package or relating articles or documents is not use of trademark.

5.1.2 Decorative patterns

A decorative pattern cannot make relevant consumers recognize it as a trademark. Use of a trademark connects with the usage and labeled position of traders.

Relevant consumers' knowledge is one of the important element. Extendable decorative patterns for bags are consequently distinctive through long-term and extensive use and has become registrable.

5.2 Use of registered trademarks with disclaimers

If a registered trademark design derives from plain words which have been disclaimed, it will not be deemed as to be used if the design originally registered is not actually used.

For example:

(1) registered design

actually-used design



(2) registered design

Café

actually-used design



5.3 Registered trademarks for short-life products

According to Article 26 of the Trademark Law, if the registration fees are to be paid in two installments, the second installment of the registration fees should be paid within the last three months before the expiration of the third year counting from the date of publication for registration. Failure to pay the second installment of registration fees within the period referred to in the preceding Paragraph, the trademark right will be distinguished. For a short-life trademark, the owner may disregard the second installment of registration fees.