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TIPLO News

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This news mail distributed in Japanese and English from time to time provides updates on the development of law in Taiwan with focus on intellectual property rights law. For more information about the status of intellectual property right protection and practice in Taiwan, please visit our website www.tiplo.com.tw

Topics in this issue

- 01** TIPO releases Taiwanese patent information regarding Covid-19 clinical trial drugs
- 02** Taiwan IPO launches “Fast Track” trademark examination mechanism on May 1, 2020
- 03** Local well-known bookstore, Eslite loses trademark infringement lawsuit against Champion Moving Company

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01 TIPO releases Taiwanese patent information regarding Covid-19 clinical trial drugs

The WHO has announced that the COVID-19 outbreak should be characterized as a global pandemic since March 11, 2020. After that, all sectors around the world are in the race for developing drugs that might work against Covid-19 pandemic. By comparing with the US clinical trial database, Taiwan IPO has verified the Taiwanese patent database to arrange and sort out the patent status of the Covid-19-related clinical trial drugs in Taiwan and compiled and released such information for public reference so as to avoid any potential patent disputes.

Based on the information pertaining to the Covid-19-related clinical trials currently registered in the US clinical trial database (<https://clinicaltrials.gov/>), Taiwan IPO sorts out and lists the relevant clinical trial drugs, including small molecule drugs and therapeutic proteins, and categorizes them into three levels of patent status as follows in accordance with their original clinical application, domestic drug permit license status, and relevant patent information. Patent information is further classified in accordance with the subject matter of their respective scope of claims, including substance, composition, usages, and preparations.

According to the information released by Taiwan IPO, the Covid-19-related clinical trial drugs fall into the following three levels:

1. drugs which are not registered with Taiwan IPO and most of which have been clinically used for many years, while a few of them are patented in other countries but not in Taiwan;
2. drugs which are registered as Taiwanese patents whose claims do not cover the core substances of major active ingredients (chemical compounds or antibody molecules) but involve specific salts, related compound preparation or applications or preparation methods of active ingredients;
3. drugs which are registered as Taiwanese patents whose claims contain core patents of major active ingredients

As explained by Taiwan IPO, subparagraph 2, paragraph 1 of Article 59 of the Patent Act of Taiwan shall apply in this circumstance that the effects of invention patent right shall not extend to the necessary acts of exploiting the invention for research or experimental purpose(s). Therefore, the experimental acts in a lab will not constitute infringement. It is legally acceptable to research and develop the drugs designing around those whose claims do not contain core patents of major active ingredients. (March 2020)

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E200320Y2

02 Taiwan IPO launches “Fast Track” trademark examination mechanism on May 1, 2020

Taiwan IPO introduces the “Fast Track” trademark examination mechanism to encourage e-filing applications and expedite registration application examination. As of May 1, 2020, the applicants whose payment of the required statutory fees and whose documents meet the following requirements at the time of filing will be eligible

to have their applications go into examination two months earlier than others:

- (1) Electronic applications;
- (2) Applications for plain trademarks, excluding non-traditional trademarks, certification marks, collective membership marks, and collective trademarks;
- (3) The names of all designated goods or services of the proposed mark are exactly the same as the reference names provided in Taiwan IPO's e-filing system;
- (4) The required fees are paid through a designated bank account, over the counter by an electronic payment sheet in printout form, or on eATM;
- (5) A power of attorney should be presented if there is a duly authorized agent.

Applications meeting the above procedural requirements will be prioritized for examination, and it is expected that the applicants of such applications will know the result of examination approximately 1.5 months earlier than the current average first action pendency, which will speed up these applicants' business expansion and deployment by use of their registered trademarks.

For instance, in case of an application filed on May 1, 2020 under the Fast Track mechanism, the time of having the application submitted for examination will be the same with that of a general trademark registration application filed on March 1, 2020; it will be submitted for examination about 2 months earlier. However, it is noticeable that the "first-to-file" and "first-to-register" rule still apply under this new mechanism; that is, the earlier applications will still be registered first and thus expel the later ones.

The applications eligible for the new mechanism will be indicated as "Fast-Track" cases in a detailed form of Taiwan IPO's trademark search system about one month after e-filing and the status of these applications will be shown as well. (March 2020)
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E200313Y2

03 Local well-known bookstore, Eslite loses trademark infringement lawsuit against Champion Moving Company

Eslite Corporation (hereinafter "Eslite") sued Champion Moving Company (including another company whose Chinese company name is 誠品優質包裝有限公司; hereinafter "Champion"), which is engaged in the business of packaging and moving, for trademark infringement to demand that Champion and responsible person thereof, Chen, shall pay TWD5 million in damages and also that Champion shall be enjoined from using the two Chinese characters "誠品" as trademark or company name. This matter was brought to the IP Court for the first instance proceedings and the IP Court rendered a judgment against Eslite. This case is appealable.

Eslite indicates that they have been devoted to brand management and development for its brand name "誠品" for thirty years since its incorporation in January 1989. Under this brand name, they have developed their scope of business covering bookstore, gallery, exhibition, culture and creation, catering, living, and further expanded to include cargo packaging, loading and unloading, cargo delivery, logistics, etc.. Years of brand management and development have made the two Chinese characters mark "誠品" a well-known trademark the Taiwan. In this regard,

Champion acts of using the “誠品” mark, using the two Chinese characters “誠品” as part of its company name without Eslite’s prior consent, and claiming itself as the “Eslite in moving service industry” and bragging about its “ambition for becoming the ‘Eslite in moving service industry’ ” on its website and Facebook fan page for promotion purposes would form confusion on consumers and thus infringe upon Eslite’s trademark right.

The IP Court, however, does not sustain the likelihood of confusion asserted by Eslite on the ground that the “packaging” and “transporting” services provided by Champion amount to the acts of packing furniture and appliance and transporting them in different stages of moving process, which are different from general services of cargo delivery and packaging, and hence, there is not likelihood of confusion.

The IP Court holds that Champion’s descriptions in Chinese (literally meaning “We, Champion Moving Company, the Eslite among the moving services...under the name of ‘Eslite’. We have the ambition to become ‘the Eslite among the moving services’ as reflected by our English company name, ‘Champion.’”) posted on its FB fan page demonstrate its intent to lead in the industry without intentionally taking a free ride on Eslite’s business reputation nor misleading consumers into believing that Champion is related to Eslite as a franchisee, chain store, or as a group company of Eslite.

The IP Court also held that the evidence produced by Eslite can only prove its “誠品” mark being well recognized in the industry of culture and creation, in specific markets or by specific groups of consumers; the evidence is insufficient to substantiate that the “誠品” mark is so commonly well known among general consumers that it achieves a high degree of fame. Based on the foregoing reasoning, the IP Court ruled against Eslite by a first instance judgment. The case is appealable. (March 2020)

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