



Please rest assured that Taiwan IPO and our firm have been maintaining normal operation as the coronavirus pandemic spreads throughout the world.

When faced with the severe global health crisis triggered by the pandemic, please take good care of your health and stay healthy.

TIPLO News

NOVEMBER 2020 (E252)

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 Comparison and analysis of invention patents applications filed with Taiwan IPO and under the PCT in 2019**
- 02 Relaxation of design patent legislation to avail digital industry**
- 03 Prior consent is required for registering a famous stage name as a trademark**
- 04 Taiwan takes home seven R&D 100 Awards**

E201020Y1

- 01 Comparison and analysis of invention patents applications filed with Taiwan IPO and under the PCT in 2019**

Taiwan IPO issued the comparative analysis of invention patent applications received by Taiwan IPO and under the PCT (Patent Cooperation Treaty) in 2019. The analysis reveals that the numbers of invention patent applications filed with Taiwan IPO for the past three years have been rising to 45,650 cases in 2019, experiencing a year-on-year increase of 2.6%, and likewise, the PCT applications have been seeing the similar sustained growth for ten years to rise to an estimated number of 265,800 cases in 2019, marking a 5.2% rise from the previous year.

The analysis by nationality demonstrates a sustained growth in the numbers of both domestic and foreign applications for the past three years. In 2019 alone, invention patent applications filed by resident applicants amounted to 18,294 cases, comprising 40.1% of the total applications, while the other 59.9%, in the number of 27,356 cases, were contributed by non-resident applicants, most of which were filed by Japanese applicants that surpassed those from the US and China. Japan, the US, and China all saw their respective growth in the number of applications. As for the nationality of

the applicants of the PCT applications, China took the lead to claim the top honor by a leap of 10.6% to be followed by the US and Japan.

In addition, a breakdown by technological field shows that patents relating to semiconductor have made up the most invention patent applications filed with Taiwan IPO for the past five years, accounting for 11.6% of all applications filed in 2019. The category of semiconductor patents was trailed by the categories of computing technology, electromechanical energy devices, and optics. As for the PCT applications, the category of computing technology topped the ranking to be ahead of the categories of digital communication and electromechanical energy devices, and the categories of semiconductor and optics ranked 9th and 10th, respectively.

All major filing countries (regions), except for Germany and Hong Kong, filed invention patent applications for the category of semiconductor among the top three technological fields, and Japan, the US, and South Korea filed the most applications for semiconductor. On the other hand, Taiwan, China, and Hong Kong filed the most invention applications for computing technology, while Germany, for organic precision chemistry.

For the PCT applications, all major countries, except for Germany, filed for computing technology, while it was China and South Korea that submitted the most applications for digital communication patents, while computing technology was the top target for the US filings, and electromechanical energy devices for Japan and transportation for Germany, which shows a prioritized technological fields very different from that of Taiwan. (Released 2020.10.20)

/CCS

E201019Y1

02 Relaxation of design patent legislation to avail digital industry

As reported in the Taiwan IPO's news release, to keep abreast with the development of the emerging technologies and the promotion of digital innovation, Taiwan IPO reviewed the design patent legal regime and published the amendment to part of "Chapter III: Substantive Examination of Design Patents of the Examination Guidelines for Patents" on September 29, 2020, which has taken effect as of November 1, 2020. The amendment lifts the restriction that design patents for computer generated icon (CGI) and graphical user interface (GUI) must be applied to physical articles and also relaxes the requirements for disclosure of a design patent application, which makes design patent protection more comprehensive and accessible to software businesses.

Taiwan IPO has been receiving nearly 8,000 applications for design patents every year. Prior to this amendment, software businesses or designers should specify a certain physical article, such as, screen, a display, or smartphone, to which their proposed CGIs or GUIs were applied, in order to acquire design patent protection for such CGIs or GUIs. With the development of emerging technologies, however, graphic designs are no longer necessarily represented on such traditional physical products including display devices, as graphic designs can also be projected in the air or represented among us through VR/AR gadgets.

Moreover, it is a fact that designers of graphics are usually software developers, instead of manufacturers of such hardware equipment or products as screens, displays, or smartphones. To these designers, graphic designs are part of the software that can generally be applied to all kinds of digital products. Under such concept, the scope of protection should not be limited to the designs that are applied

to certain physical articles. In view of the foregoing, this amendment removes the aforesaid restriction and enlarges the scope of protection to graphic designs that are applied to non-physical software or apps, such as, computer program products, so as to stay current with the technological development and the actual needs in the industry.

In addition to the provisions governing graphic designs, this amendment also relaxes the requirements relating to the disclosure of descriptions and drawings and the regulations governing divisional applications and also specifically and clearly adds buildings and internal designs as the subject matters eligible for patent protection.

This amendment to the Guidelines is expected to allow applicants to file patent applications more easily and flexibly and also obtain more comprehensive protection for their designs. Taiwan IPO hopes to assist the industry to keep innovative and enhance competitiveness of the industry and further to realize the vision of “Digital Nation, Smart Island” through gradual review and update of IPR legal regime. (Released 2020.10.19)

/CCS

E201004Y2

03 Prior consent is required for registering a famous stage name as a trademark

A man surnamed Lin (hereinafter referred to as “Lin”) successfully trademarked a stylized logo of “Blackmamba” (hereinafter referred to as the “mark in dispute”) in April 2016 and designated it to be used on apparel, T-shirts, and outerwear. Kobe Inc. filed an opposition action with Taiwan IPO against the registration of the mark in dispute and successfully had it cancelled, which caused Lin to file an administrative appeal but the administrative appeal was denied. Lin further initiated an action with the Taiwan IP Court but lost this case. Thus, Lin went further to appeal this case to the Supreme Administrative Court. The Supreme Administrative Court, however, overruled Lin’s appeal.

According to the IP Court judgment, Kobe Bryant, the famous American professional basketball player, who had a nickname “Black Mamba” for being known for his ability to move as aggressively, rapidly, and agilely on the court as a black mamba, the venomous snake from Africa, whose speed is nearly unmatched. Kobe Bryant has been called or referred to by the nickname “Black Mamba” by his fans, in his official FB fanpage or major sports media since a time between June 2010 through April 2016. “Black Mamba” is Kobe Bryant’s nickname, alternative name, as well as stage name that has aroused Taiwanese consumers’ (audience’s) much attention, and in this regard, any labeling including “Black Mamba” would cause Taiwanese consumers to believe that any products bearing “Black Mamba” are related to Kobe Bryant.

The IP Court judgment also stated that “Black Mamba” had already been Kobe Bryant’s stage name well-known to Taiwanese consumers before Lin filed the trademark application for the mark in dispute. Under this circumstance, Lin’s acts of applying for trademark registration for the mark in dispute without Kobe Bryant’s prior consent and obtaining economic benefits by using the mark in dispute in commercial activities have impaired the moral right and economic right of Kobe Bryant and form the unregistrable grounds as provided by the Trademark Act. In this regard, Taiwan IPO’s decision to cancel the registration of the mark in dispute did not contravene the laws, and the administrative decision was not erroneous to keep the opposition decision unchanged. Therefore, Lin’s request for revocation of Taiwan IPO’s

opposition decision and the administrative decision is groundless and should be dismissed accordingly.

The Supreme Administrative Court made a ruling to sustain the IP Court's judgment and dismissed Lin's appeal. (Released 2020.10.04)

/CCS

E201006Y8

E201006Z8

04 Taiwan takes home seven R&D 100 Awards

Widely recognized as the "Oscars of Innovation", the R&D 100 Awards announced the winners for 2020. The research institutions supported and governed by the Ministry of Economic Affairs won six awards, marking the 13th consecutive year in which Taiwanese technologies and products are identified as technologically significant winners.

Supported by the Technology Development Programs of the Department of Industrial Technology and the Industrial Energy Technology Program of the Bureau of Energy, the technologies singled out as winners include the Industrial Technology Research Institute's "Dye-sensitized Cell as Energy Source of Sensors (D-EOS)", "Networked Amid Epoxy Polymer Electrolyte for Solid State Lithium-Ion Batteries (NAEPE)", and "A Smart-Care Solution for Chronic Wounds (iSCare)", the Metal Industries Research and Development Center's "Continuously Rotating Wind Turbine UAV Inspection System" and "Controllable Hydro-Reactive Magnesium Alloy", and the Institute for Information Industry's "Production Decision Support System with Digital Twins Solution for Bicycle Industry (PDSS)". These winners have been working with Formosa Plastics Corp., CPC Corporation, Taiwan, Amita Technologies, Inc., and Gus Technology for trial production of these technologies.

This year, only 16 of 100 awards went to entrants outside the US, and 7 of those went to the teams from Taiwan, and 5 to Japan, which means Taiwan's capacity in technological development and innovation is highly visible to and recognized by the world. In particular, the Industrial Technology Research Institute of Taiwan has collected 44 R&D 100 awards for thirteen years in a row, and 90% of their winning technologies have been applied and transferred to the industry to create new value. (Released 2020.10.06)

/CCS



台灣國際專利法律事務所

TAIPEI MAIN OFFICE
7th Floor We Sheng Building,
No.125, Nanking East Rd. Sec.2,
P.O.BOX 39-243, Taipei 10409, Taiwan
Tel: 886-2-2507-2811 • Fax: 886-2-2508-3711
E-mail: tiplo@tiplo.com.tw
Website: www.tiplo.com.tw

TOKYO LIAISON OFFICE
No.506 Lions Mansion ,
13-11, Shinjuku 2-Chome,
Shinjuku-ku, Tokyo 160-0022, Japan
Tel: 81-3-3354-3033 • Fax: 81-3-3354-3010