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TIPLO Outstanding work on Litigation Case (2018.11)

Example work 1

Name and brief description of case/portfolio:

一、奧地利之溶胞型纖維素纖維產品製造商（客戶）為蒐集證據以對一台灣纖維素纖維產品製造商提起侵害專利權之民事訴訟，於起訴前向智慧財產法院聲請證據保全，主張：

1. 台灣製造商製造纖維素產品所使用之方法(下稱：系爭方法)及該方法所製得之產品(下稱：系爭產品)有侵害專利權

2. 系爭產品及系爭方法，並非通常方法所能取得，且極易變更或湮滅，有滅失或礙難使用之虞；

3. 系爭方法及系爭產品為系爭專利有無受侵害或侵害之虞之重要證據，且該證據均在被告支配範圍，聲請人取得具有相當困難性，且日後確有可能滅失或礙難使用之虞。故確定該證據之現狀有法律上利益存在且有必要。

並請求就系爭產品為取樣，並就系爭方法為照相及攝影。

二、法院認為我方已提出可即時調查之證據，已釋明有確認現狀之法律上利益且有必要，故准予證據保全。

1. An Austria-based manufacturer of lyocell cellulose fiber filament product (TIPLO's client) filed a motion with the Taiwan IP Court for evidence perpetuation in order to gather evidence to initiate a civil action asserting patent infringement against a Taiwan-based manufacturer of cellulose fiber product (the "Taiwanese manufacturer"). Our client claims that:

(1) The manufacturing process the Taiwanese manufacturer uses to manufacture its cellulose product (hereinafter the "process in dispute") and the product manufactured by the said process (hereinafter the "product in dispute") infringe upon our client's patent;

(2) The "product in dispute" and the "process in dispute" are not accessible through common methods and are extremely changeable or destroyable and thus they are likely to be destroyed or their use may be difficult;

(3) The "product in dispute" and the "process in dispute" amount to the important evidence for determining whether our client's patent is infringed or is likely to be infringed. Also, they are within the scope controllable by the Taiwanese manufacturer; thus, the movant (namely our client) has difficulty to a considerable extent in having access to them and they are likely to be destroyed or their use may

	<p>be difficult in the future, for which the movant sees the legal interests and the necessity in ascertaining the status quo of the “product in dispute” and the “process in dispute” as evidence. Our client also requested for sampling the product in dispute and photographing and videotaping the process in dispute. 2. The IP Court granted our client’s motion for evidence perpetuation on the ground that our client has produced the evidence which can be submitted immediately and has made preliminary showing on the legal interests and the necessity of ascertaining the status quo of that evidence.</p>
IP advisers from your firm involved:	<p>陳和貴律師 楊益昇律師 H. G. Chen, Attorney-at-Law and Certified Patent Attorney Y. S. Yang, Attorney-at-Law</p>
Other IP firms involved:	N/A
Date(s)	<p>19 Sep. 2017: 向法院聲請證據保全 13 Oct. 2017: 法院開庭調查 30 Oct. 2017: 法院裁定准予證據保全 10 Nov. 2018: 法院執行證據保全。 Timeline: -- 2017.9.19: Motion for evidence perpetuation filed with the IP Court. 2017.10.13: A hearing held for investigation. 2017.10.30: Motion granted by the IP Court. 2018.11.10: Evidence perpetuation to be enforced.</p>
Why was it important?	<p>因侵權人內部是否有使用專利方法來製造產品，通常無法藉由侵權人所販賣之產品來進行逆向工程得知，也無法透過市場取得相關證據，因此，對於證明侵權人有使用專利方法之證據，建議利用專利法第 99 條規定(按：該條規定，專利所製成之物在該製造方法申請專利前，為國內外未見者，他人製造相同之物，推定為以該專利方法所製造)，在起訴前聲請證據保全，以確保後續之本案訴訟獲得有利之訴訟優勢。 In most circumstances, reverse engineering on a suspected infringer’s product(s) cannot find out whether or not the infringer uses another’s patented manufacturing process to manufacture his/her product(s), and relevant evidence is not accessible on market. Hence, Article 99 of the Taiwan Patent Act is a suggested legal basis (which stipulates that where an article produced following a manufacturing process is still unknown within and outside of this country before the filing of a patent application for the manufacturing process, another article identical thereto made by another person shall be presumed to have been produced following the said manufacturing process.) to prove a suspected infringer’s use of another’s patented manufacturing process; that is, it is suggested to file for evidence perpetuation before initiating a patent infringement action so as to secure an advantageous position in the action to be initiated.</p>

Example work 2

Name and brief description of case/portfolio:

本所客戶（韓國公司）發現在台灣有仿冒其註冊商標圖樣之商品（以下稱：系爭仿品），且系爭仿品係由本案被告（台灣人）所經營之大陸公司，在大陸仿冒客戶之註冊商標圖樣，再將系爭仿品販賣予台灣法院認定屬不知情之一家台灣公司，供該台灣公司組裝、銷售含有系爭仿品之商品予他人。

客戶對被告提起違反商標法之刑事告訴，經檢察官提起公訴後，客戶對被告提起刑事附帶民事訴訟，主張被告侵害商標權，請求排除侵害及損害賠償。另外，上述向被告公司購買系爭仿品之台灣公司，對被告提起刑法詐欺取財之刑事告訴，該案經檢察官併至本案一併審判。本案地方法院刑事庭認定，被告為該大陸公司之實際負責人，系爭仿品進口台灣之前，已貼有仿冒客戶之商標標貼，且被告對此仿冒標貼乙事，係屬知情。又在本案案發後，被告亦出具聲明書給該台灣公司，證明所販售之商品為客戶商品，法官因而認定被告對所販賣給該台灣公司之商品係屬仿品亦屬知情，故判處被告涉犯刑法及商標法等罪，處有期徒刑 7 個月；未扣案仿品 261 台沒收；未扣案之被告犯罪所得美金 66,800 元沒收，如於全部或一部不能沒收或不宜執行沒收時，追徵其價額。

至於客戶提起之刑事附帶民事訴訟部分，該院認定客戶主張本件侵權行為之「結果地」在台灣，故該院有管轄權，且應適用台灣法律。法院並認定被告故意侵害客戶之商標權，判決被告不得使用相同或近似於本所客戶之商標商品。關於損害賠償金額之計算，該院認定應以被告販售系爭仿品之平均零售單價，乘以法定範圍內之 300 倍，總計新台幣 2,274,000 元及利息。

Our client (a Korean company) found counterfeit products bearing its registered trademark in Taiwan (hereinafter the "infringing products"). The defendant of this case (a Taiwanese national) first, in the name of a Chinese company he runs, used on the infringing products an imitated mark of our client's registered trademark in China and then sold the infringing products to a Taiwanese company which did not know the infringing occurrence as determined by the court of Taiwan, and the Taiwanese company further assembled and sold to other people the products that contained the infringing products.

For the foregoing infringing conducts, our client filed a criminal complaint asserting violation of Taiwan Trademark Act against the defendant and successfully had the defendant indicted by the prosecutor. After that, our client further initiated an incidental action to assert trademark infringement and seek infringement removal and claim damages against the defendant. In addition, the above mentioned Taiwanese company that purchased the infringing products with the defendant also filed a criminal complaint against the defendant for the act of obtaining property by fraud as provided by the Taiwan Criminal Code. The criminal case filed by the said Taiwanese company was consolidated with this case by the prosecutor for trial.

The criminal division of the district court in charge of this case determined as follows. As the actual responsible person of the Chinese company, the defendant knew about use of the imitated mark because the infringing products had already carried the imitated

	<p>mark before importation into Taiwan. Further, after this case was uncovered, the defendant also issued a written statement to the said Taiwanese company to prove that the products he sold were our client's products. Based on the foregoing, the judge determined that the defendant clearly knew about the products sold to the said Taiwanese company being counterfeit, and thus sentenced the defendant to 7-month imprisonment for his violation of the Taiwan Criminal Code and Taiwan Trademark Act and the 261 infringing products should be confiscated. Also, the defendant's illegal proceeds in an amount of USD66,800 gained by the defendant from committing the offense should be confiscated. Where the illegal proceeds cannot be executed in whole or in part or unfit to be executed, value thereof shall be collected from the defendant.</p> <p>As to the incidental civil action, the district court held that the place of the consequence of the infringement occurrence is Taiwan and thus the district court of Taiwan has jurisdiction over this case and Taiwan laws are applicable to this case. The district court sustained the defendant's intentional infringement upon our client's trademark rights, deciding that the defendant shall never use any mark identical or similar to our client's trademark. As to the calculation of damages claimed, the district court held that the damages should be in an amount of TWD2,274,000, which is calculated by having the average unit selling price of each infringing product multiplied by a multiplier of 300.</p>
<p>IP advisers from your firm involved:</p>	<p>陳和貴律師 劉中城律師 吳婷婷律師 H. G. CHEN, Attorney-at-Law and Certified Patent Attorney Chung-Cheng LIU, Attorney-at-Law and Certified Patent Attorney Ting-Ting WU, Attorney-at-Law and Certified Patent Attorney</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2015.3.21：本所第一次開庭。 2015.10.19：本案被告被檢察官提起公訴 2015.11.23：本所客戶對本案被告提起刑事附帶民事訴訟 2016.06：向本案被告購買系爭仿品之台灣公司對本案被告提起刑法詐欺取財之刑事告訴。 2016.07.05：檢察官起訴本案被告涉犯刑法詐欺取財罪，將該案併至本案一併審判。 2018.08.24：本案地方法院刑事判決 2018.8.27：本案地方法院刑事附帶民事判決 Timeline: -- 2015.3.21: 1st hearing attended by our firm. 2015.10.19: Defendant indicted. 2015.11.23: An incidental civil action initiated by our client against the defendant. 2016.06: A criminal complaint filed against defendant by the Taiwanese company for his offense of obtaining property by fraud as provided by the Taiwan Criminal Code.</p>

	<p>2016.07.05: Criminal complaint of fraud consolidated with this case for trial.</p> <p>2018.08.24: A criminal judgment rendered by the district court on this case.</p> <p>2018.8.27: A judgment rendered on the incidental civil action by the district court.</p>
<p>Why was it important?</p>	<p>本案被告經營一家大陸公司，其利用其公司在大陸仿冒客戶之商標標貼，然後將系爭仿品販賣給台灣公司。本案被告仿冒標貼之行為在大陸，則權利人可否在台灣對被告提起刑事告訴及民事訴訟？本所提出台灣最高法院及智慧財產法院之見解認為，如被告犯罪之結果地或侵權行為之損害結果發生地在台灣，或仿品係在台灣市場流通者，台灣法院可審理相關之民、刑事案件。另外，因本案卷證資料繁多，審理耗時，經本所詳細審閱資料，並積極為客戶主張及提出足以證明被告犯罪及侵權之證據，讓客戶在刑事及刑事附帶民事訴訟上獲得勝訴及合理賠償。</p> <p>The defendant of this case ran a Chinese company and took advantage of the Chinese company to imitate our client's trademark and used the imitated mark on the infringing products and further sold these infringing products to the Taiwanese company. As the place where the defendant imitated our client's registered trademark was in China, whether the trademark proprietor can file a criminal complaint and incidental civil action against the defendant in Taiwan rises as an issue of this case. Our firm presented the following Taiwan Supreme Court's and the Taiwan IP Court's holdings: If the place of the consequence of the defendant's offense is or the damages of the infringement occur in Taiwan, or if the infringing products are commercially available in Taiwan, Taiwan court has the jurisdiction to try such civil and criminal cases. Moreover, even though this case involves piles of files and evidences gathered and the trial has taken a lot of time, our firm has been thoroughly reviewing relevant files and information to actively assert and present evidence against the defendant to prove his infringement, so that our client can win the criminal case and incidental civil action and have its damages reasonably recovered.</p>

Example work 3

<p>Name and brief description of case/portfolio:</p>	<p>(商標侵權刑事訴訟事)</p> <p>客戶在日本為「A」商標之商標權人，惟「A」商標在台灣已經於 2002 年由○○公司搶先註冊並於數年後轉讓予關係企業○○公司。○○公司除取得「A」商標之外，並向經濟部國貿局註冊與客戶英文公司名稱相同之進出口廠商名稱、抄襲客戶產品之包裝盒、條碼後銷售、出口同種類之產品。另據客戶表示○○公司對外宣稱係客戶之授權廠商，得使用客戶之商標、包裝盒，致台灣以及海外市場之相關消費者誤認○○公司銷售之低價產品與客戶產品相同。</p> <p>鑒於○○公司完全抄襲客戶產品包裝盒(包括「A」商標以及「B」圖樣)、條碼，客戶因此委託本所在台灣註冊「B」圖樣為商標後，對○○公司負責人△△提起侵害「B」商標以及偽造私文書(條碼)之刑事告訴，檢</p>
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察官嗣後對△△為起訴之處分。

第一審法院認為(1)商品條碼於日常生活中隨處可見，因此被告△△辯稱不知商品條碼之作用與功能云云，係不足採信、(2)關於被告△△未得客戶同意使用相同「B」商標之行為，被告△△雖主張有「善意先使用」之適用，惟由被告△△並無日本相關背景、客戶最早於1984年即使用「A」字樣、被告△△嗣後將○○公司英文名稱改成與客戶英文公司名稱相同、被告△△印製之包裝盒與客戶極為相似、「B」商標圖案非屬一般日常生活可見之圖案等情判斷，被告△△顯然基於攀附客戶之商譽而抄襲包裝盒圖樣、文字，因此並無主張善意先使用之餘地、(3)被告2013年起為犯罪行為，應論以接續犯之一罪，從重論以行使偽造私文書(條碼)罪，處有期陸月，如易科罰金，以新臺幣參千元折算壹日，扣案之包裝盒以及包裝盒內產品均為沒收。

被告△△以及檢察官均對第一審判決提起上訴。第二審法院維持第一審判決宣告罪刑之部分並駁回雙方上訴，但就第一審判決沒收之部分為撤銷，改諭知僅沒收仿造條碼、商標之包裝盒，並認為包裝盒內之產品因未使用「B」商標圖案並無侵害商標權之情事而應為發還。就第二審判決沒收部分之認定，本所認為包裝盒內之產品仍應適用刑法沒收規定予以沒收，因此請求檢察官上訴最高法院。

最高法院駁回檢察官之上訴，維持第二審法院判決，即僅沒收仿造條碼、商標之包裝盒，而不沒收包裝盒內之產品。最高法院判決意旨略為：(一)刑法沒收新制於104年12月30日修正公布，並自105年7月1日開始施行...而上開刑法沒收規定修正公布後，商標法第98條亦於105年11月30日修正公布，並自105年12月2日施行，從而修正後之商標法第98條，即屬刑法第38條第2項後段所稱之「特別規定」，自應優先適用。...原判決基此以附表所列包裝盒既印有仿冒之系爭商標，自屬侵害商標權之物品，本於「特別法優於普通法」原則，依商標法第98條之規定予以沒收，自無判決不適用法則之違誤。(二)又刑法第38條第2項關於供犯罪所用之物、犯罪預備之物或犯罪所生之物，屬於犯罪行為人者，得沒收之規定，既非屬義務沒收，則原審就印有系爭商標圖樣之包裝盒內之油封產品，認係可與包裝盒分離而獨立，非屬侵害商標權之物，經衡酌後而未依刑法第38條第2項規定以供犯罪所用之物或犯罪預備之物宣告沒收，縱未說明理由，亦無判決不載理由之違法。(三)依物之性質除有難以析離或依一般社會通念應整體視為合一而無法獨立存在之情況外，如沒收之客體顯然可分或分離後不影響該沒收物之實質效用或其法律效力時，法院自得就個別情況予以或不予宣告沒收。

(Criminal lawsuit of trademark infringement)

The Client is the proprietor of mark A in Japan, while a Taiwan-based Company X had already outflanked the Client in registering mark A in Taiwan since 2002 and further assigned the mark to its affiliate Company Y several years later. In addition to holding the Taiwanese registration of mark A, Company Y also successfully applied with the Bureau of Foreign Trade under the Ministry of Economic Affairs for registering itself as an importer and exporter by the English corporate name identical to that of the Client. Moreover, Company Y also imitated the packaging box and barcode of the Client's products and used such packaging box and barcode

onto the product same with that of the Client for sale and export. Also according to the Client, Company Y declared to the public that it is the authorized distributor of the Client and is duly authorized to use the Client's trademark(s) and packaging box. Such false statements caused the relevant consumers in Taiwan and international market to mistakenly believe that the product(s) sold by Company Y at lower price(s) is (are) identical to the Client's products.

In view of Company Y's imitation of the Client's packaging box (bearing the mark A and device B) and barcode, the Client authorized our firm to apply for registering device B as a trademark (mark B) in Taiwan and further to file a criminal complaint against Company Y's responsible person for infringement upon mark B and private document (barcode) forgery, for which the prosecutor indicted Company Y's responsible person (defendant) after investigation.

Subsequently, the court of the first instance found defendant guilty of use and forgery of private documents (barcode) and thus imposed on him a sentence of six-month imprisonment, which may be commuted to a fine payment calculated at the rate of TWD3,000 per day, and the seized packaging boxes and products contained therein should be all confiscated. The court also found that these criminal acts having done by defendant since 2013 should legally constitute one offense and defendant should be considered a consecutive offender. The court imposed the sentence based on the following holding and reasoning.

(1) Since product barcode is commonly seen in ordinary life, defendant's defensive argument is inadmissible that he did not know the function and purpose of product barcode;

(2) Defendant asserted the applicability of "prior use with bona fide" in regard to his use of the Client's mark B without seeking the Client's prior consent. Nevertheless, defendant's intent was obvious that he took a free ride on the Client's business reputation by imitating the packaging box and wording of the Client's products because (a) nothing in defendant's personal background pertained to Japan, (b) as opposed to the Client's first use of its mark A early in 1984, defendant subsequently changed Company Y's English corporate name to another one identical to that of the Client, (c) the packaging box printed by defendant was extremely similar to that of the Client, and (d) the device of mark B is not commonly seen in ordinary life. Based on the foregoing, the court ruled that it is groundless for defendant to assert his bona fide prior use of mark B. Both defendant and the prosecutor took an appeal from the first-instance judgment. The superior court affirmed defendant's offense sustained and also the sentence imposed on defendant in the first-instance judgment and also dismissed the appeals filed by defendant and the prosecutor, except that the superior court vacated the decision of confiscation and advised that only the forged barcode and packaging boxes but not the products should be confiscated because the products contained in the packaging boxes did not bear mark B and thus these products did not involve the occurrence of trademark infringement and should be returned

	<p>accordingly.</p> <p>With respect to the superior court's decision concerning confiscation, our firm represented the Client to request the prosecutor to appeal this case to the Supreme Court on the ground that the products contained in the packaging boxes should be confiscated according to the Taiwan Criminal Code provisions with respect to confiscation.</p> <p>The Supreme Court dismissed the prosecutor's appeal and affirmed the superior court's decision concerning confiscation; that is, the infringing barcode and the infringing packaging boxes should be confiscated, except for the products contained in the infringing packaging boxes. The Supreme Court judgment is summarized as follows: (1) The amended provisions of the Criminal Code governing confiscation were amended and promulgated on December 30, 2015 and further enforced as of July 1, 2016. ... After that, Article 98 of the Taiwan Trademark Act was also amended and promulgated on November 30, 2009 and has been enforced since December 2, 2016. After its amendment, Article 98 of the Taiwan Trademark Act is the "special provision" as defined by the second part of the second paragraph of Article 38 of the Taiwan Criminal Code, and thus it shall prevail for application. ... As the packaging boxes listed in the attached annex bear an infringing mark of mark B, the packaging boxes should be deemed as infringing ones. In this regard, the superior court acts upon the principle that "special provisions are superior to general provisions" to confiscate the packaging boxes in accordance with Article 98 of the Taiwan Trademark Act, and therefore, the superior court did not err in applying the provisions. (2) Moreover, the second paragraph of Article 38 of the Criminal Code provides that a thing used in the commission of or preparation for the commission of an offense or a thing derived from or acquired through the commission of an offense may be confiscated if it belongs to the offender. What the cited provision stipulates is not mandatory confiscation. In this regard, the superior court held that the products contained in the sealed packaging boxes can be separable from the packaging boxes that bear the infringing mark and thus do not amount to infringing products. Even though the superior court failed to provide detailed reasoning on why it did not confiscate the products contained in the packaging boxes as a thing used in the commission of or preparation for the commission of an offense as defined by the second paragraph of Article 38 of the Criminal Code, the superior court did not contravene the laws by failing to specify reasons. (3) Except for the circumstances that an object of a crime, in terms of its nature, cannot be separable from another or is integral to another and cannot exist by itself in accordance with regular social beliefs, the court may or may not confiscate the object of a crime on a case-by-case basis, if the object to be confiscated is obviously separable from another or its substantive effects or legal binding force will not be affected after its separation from another.</p>
<p>IP advisers from your firm involved:</p>	<p>陳和貴律師 吳宗樺律師 H. G. Chen, Attorney-at-Law and Certified Patent Attorney</p>

	C. H. Wu, Attorney-at-Law
Other IP firms involved:	N/A
Date(s)	<p>2015年5月19日：檢察官起訴。 2015年7月15日：第一審進行準備程序。 2016年3月7日：第一審準備程序終結。 2016年5月12日：第一審進行第一次審理程序。 2016年11月21日：第一審進行第四次審理程序。 2016年12月15日：第一審宣判。 2017年3月2日：第二審進行準備程序。 2017年3月29日：第二審準備程序終結。 2017年4月20日：第二審進行審理程序。 2017年5月4日：第二審宣判。 2017年6月1日：檢察官對第二審判決提起上訴。 2018年5月3日：第三審宣判。</p> <p>2015.5.19: Indictment brought by prosecutor. 2015.7.15: Preparatory hearing held in the first instance proceedings. 2016.3.7: Preparatory procedure concluded in the first instance proceedings. 2016.5.12: 1st trial hearing held in the first instance proceedings. 2016.11.21: 4th trial hearing held in the first instance proceedings. 2016.12.15: Adjudication of the first instance proceedings. 2017.3.2: Preparatory hearing held in the second instance proceedings. 2017.3.29: Preparatory procedure concluded. 2017.4.20: Trial hearing held in the second instance proceedings. 2017.5.4: Adjudication of the second instance proceedings. 2017.6.1: Appeal filed by prosecutor against second instance judgment. 2018.5.3: Adjudication of the third instance proceedings.</p>
Why was it important?	<p>客戶之「A」商標在台灣已經被搶先註冊，並且罹於提起異議以及評定之法定期間。惟客戶仍可以透過註冊「B」商標後，委託本所對該侵權行為人提起刑事告訴，並另於提起附帶民事訴訟時請求損害賠償。本案牽涉一法律適用問題，即商標法第 98 條沒收規定於 2016 年 12 月 2 日施行之後，如非屬侵害商標權之物品，但該物品性質上係供犯罪所用之物時，是否仍應適用刑法沒收規定將該等物品予以沒收。由於商標法規定修正後，尚無前例可循，本所具狀請求檢察官上訴後，最高法院就該等法律適用問題如何認定，受到各級法院注目。</p> <p>Even though the Client's mark A had already been registered by a Taiwanese company and the prescription for the Client's filing an opposition and invalidation request had both lapsed, the Client still successfully registered its mark B to have a basis to file a criminal complaint against the infringer and also additionally initiated an incidental civil action to claim damages.</p> <p>After enforcement of the amended Article 98 of the Taiwan Trademark Act on December 2, 2016, an issue of law provisions application arises, that is, whether or not an object in a crime which does not infringe upon a registered trademark but is used for</p>

	commission of an offense should still be confiscated according to the Criminal Code provisions concerning confiscation. Since there has been no relevant precedents to be followed after the enforcement of the amended 98 of Trademark Act, the Supreme Court's determination on law provisions application (either the provisions of Criminal Code or the Trademark Act) has aroused much public concern after our firm requested for the prosecutor's taking an appeal from the superior court's judgment.
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Example work 4

Name and brief description of case/portfolio:	<p>一德國自行車製造商，向經濟部智慧財產局申請舉發要求撤銷一日本自行車製造商（本所客戶）之發明專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。</p> <p>A German bicycles maker sought for invalidation of an invention patent owned by a Japanese manufacturer in the same trade. We represented the Japanese patentee in the Taiwan IPO and successfully defended the patent challenged. The German challenger appealed and the Ministry of Economic Affairs upheld Taiwan IPO's decision and our client's patent remains valid in good standing.</p>
IP advisers from your firm involved:	<p>林志剛律師/專利師 廖文慈律師/專利師 涂神溢專利師 李明彥工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney TU Shen-Yi, Certified Patent Attorney LI Ming-Yen, Patent Engineer</p>
Other IP firms involved:	N/A
Date(s)	<p>2014.03：被提起舉發 2014.07：提呈被舉發答辯(一) 2014.10：舉發人提補充理由(一) 2015.05：舉發人提補充理由(二) 2015.09：提呈被舉發答辯(二) 2015.10：舉發人提補充理由(三) 2016.02：提呈被舉發答辯(三) 2016.07：舉發人提補充理由(四) 2017.04：提呈被舉發答辯(四) 2017.06：第一次辦理面詢 2017.06：舉發人提補充理由(五) 2017.07：提呈被舉發答辯(五) 2017.09：舉發人提補充理由(六) 2017.10：第二次辦理面詢 2017.11：提呈被舉發答辯(六)</p>

	<p>2017.11：審定舉發不成立 2018.08：訴願被駁回 Mar. 2014: Invalidation action filed. Jul. 2014: Patentee filed response statement (I). Oct. 2014: Invalidation requester presented supplemental statement (I) alleging reasons for the invalidation being sought for. May 2015: Invalidation requester presented supplemental statement (II). Sept. 2015: Patentee filed response statement (II). Oct. 2015: Invalidation requester presented supplemental statement (III). Feb. 2016: Patentee filed response statement (III). Jul. 2016: Invalidation requester presented supplemental statement (IV). Apr. 2017: Patentee filed response statement (IV). Jun. 2017: First interview at Taiwan IPO. Jun. 2017: Invalidation requester presented supplemental statement (V). Jul. 2017: Patentee filed response statement (V). Sep. 2017: Invalidation requester presented supplemental statement (VI). Oct. 2017: Second interview at Taiwan IPO. Nov. 2017: Patentee filed response statement (VI). Nov. 2017: Invalidation action dismissed. Aug. 2018: Invalidation requester's appeal dismissed.</p>
<p>Why was it important?</p>	<p>1.系爭專利係關於一自行車液壓制動器致動裝置之發明專利，舉發人針對全部請求項提出舉發，自 2014 年申請舉發後，前後共提出六次補充理由，被舉發人亦提出二次更正申請專利範圍之申請，智慧局亦舉行二次面詢程序，雙方極盡攻防之能事，顯見本件舉發之複雜性。 2.本案之舉發人於美國、德國亦同時對系爭專利之各該國對應案質疑其專利的有效性，益顯見本案之重要性。 3.案件由經濟部智慧財產局作成舉發不成立之處分（本所客戶勝訴）。被舉發人嗣後雖不服智慧局之處分而向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回被舉發人之訴願（本所客戶勝訴）。</p> <p>1. The subject patent is an invention on the actuating device of bicycle-used hydraulic brake. The challenger of the subject patent seeking to invalidate each and all of the claims of the patent presented a total of six supplemental statements to the Taiwan IPO since the invalidation action was filed in 2014. In response, the patentee twice amended the scope of claim of the patent changed and the Taiwan IPO conducted two interviews during the proceeding. The one-after-another attacks and defence presented by the challenger and the patentee during the proceeding manifest the extent of complexity involved. 2. As the same German bicycles maker at the same time challenged the validity of the corresponding US and German patents of the subject patent, the outcome of the invalidation action in the Taiwan IPO will materially impact the validity of the subject patent worldwide.</p>

	3. The German bicycles maker appealed Taiwan IPO's dismissal of its invalidation. The MOEA Appeal Board dismissed the appeal letting stand Taiwan IPO's decision and our client's patent remains valid in good standing.
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Example work 5

Name and brief description of case/portfolio:	<p>一日本市佔率極高之文具用品製造商（本所客戶），向經濟部智慧財產局申請舉發，要求撤銷另一日本文具用品製造商之發明專利。案件由經濟部智慧財產局審理後，作成舉發成立之處分（本所客戶勝訴）。被舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回被舉發人之訴願（本所客戶勝訴）。被舉發人嗣後復向智慧財產法院起訴，經歷二次開庭審理後，被舉發人感受到本案敗訴的可能性極高，因此於日本向舉發人（本所客戶）提出和解之要求，雙方乃於日本達成和解。</p> <p>A Japanese stationery maker whose products take a remarkable share in the Japanese market (and who is a client of TiPLO) sought for the invalidation of a patent owned by a Japanese fellow member of the trade. We represented the challenger in the Taiwan IPO and successfully had the patent invalidated. The patentee appealed Taiwan IPO's decision and the MOEA Appeal Board dismissed the appeal letting stand Taiwan IPO's decision. The patentee then brought the matter to the IP Court only to realize after two hearings were held that it would lose the action after all. As such, the patentee proposed and entered into an agreement with the challenger under the law of Japan where the challenger agreed to and did duly withdraw the invalidation action in the Taiwan IPO.</p>
IP advisers from your firm involved:	<p>林志剛律師/專利師 廖文慈律師/專利師 高文欽工程師/主任 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney GAU Win-Chin, Patent Engineer / Chief of Sec. JP11, TiPLO Patent Department</p>
Other IP firms involved:	N/A
Date(s)	<p>2015.12：提起舉發 2016.03：被舉發人提呈答辯書（一） 2016.10：提呈舉發補充理由 2017.01：被舉發人提呈答辯書（二） 2017.02：智慧局作成舉發成立之處分 2017.08：訴願會駁回訴願 2017.09：被舉發人向智慧法院起訴 2017.11：智慧法院第一次開庭 2018.02：智慧法院第二次開庭 2018.05：達成和解 Dec. 2015: Invalidation action filed. Mar. 2016: Patentee filed response statement (I).</p>

	<p>Oct. 2016: Invalidation requester supplemented reasons for the invalidation being sought for. Jan. 2017: Patentee filed response statement (II). Feb. 2017: Taiwan IPO decided on the invalidation action and the patent challenged is invalidated. Aug. 2017: MOEA Appeal Board dismissed patentee's appeal. Sep. 2017: Patentee initiated administrative action in the IP Court. Nov. 2017: First court hearing held. Feb. 2018: Second court hearing held. May 2018: Patentee and the challenger signed the agreement under the law of Japan.</p>
<p>Why was it important?</p>	<p>1.系爭專利係關於一書寫工具之發明專利，本案之舉發人（本所客戶）於日本亦與被舉發人進行專利侵權訴訟，並同時亦於美國、韓國、中國均對該系爭專利之各該國對應案提出情報提供，因此本所客戶對本案之成敗極為重視。假若本所客戶能於台灣成功的撤銷系爭專利，將相當有利於新產品於台灣市場之佈局，取得獨佔的地位，亦對於其他國家之相關訴訟有正面的幫助。</p> <p>2.本案之爭點在於系爭專利之書寫工具的摩擦體的技術特徵是否已被諸舉發證據所揭露？熟悉該項技術者究竟有無將數舉發證據加以組合之可能性？</p> <p>3.本案智慧局之審查時程亦相當罕見，極為快速的於 1 年半內即作出舉發成立之處分，且訴願會亦於 4 個月內即駁回被舉發人之訴願，顯見舉發理由甚為充足，且本所擬定之攻擊方針亦至為正確。</p> <p>4.雖然被舉發人向智慧法院起訴，歷經二次開庭後，被舉發人深感仍無勝訴之可能性，因此於日本與本所客戶達成和解。</p> <p>1. The patent in issue is an invention on writing instrument. The challenger of the patent (and client of TiPLO) and the patentee were the parties to a patent infringement lawsuit in Japan where the patent in dispute is the patent challenged. During the proceeding of said patent infringement lawsuit in Japan, the client (namely the claimant) filed information with the USPTO, the KIPO and the SIPO challenging the validity of the local corresponding patents of the patent in dispute. As such, whether or not the invalidation action in Taiwan would turn out successful is of extreme importance to the client. Winning the invalidation sought for will not only clear the way for the client to launch all new products to come but also help solidify the client's position in the lawsuit in Japan as well as in the invalidation sought for of the corresponding patents in relevant countries.</p> <p>2. To solve the dispute at hand is to answer these two questions: Is the technical feature of the friction structure of the patent in dispute claimed on the writing instrument readily disclosed by the prior arts cited? Is it possible for a person skilful in the art to combine the cited prior arts to achieve the patent in issue?</p> <p>3. It took only 18 months for Taiwan IPO to decide on this month and less than 4 months for the MOEA Appeal Board to deny the patentee's appeal, which efficiency is fairly uncommon. The main reason accounting for the speedy decision is the tenable solid grounds and attack we presented on behalf of our client against the patentability of the patent challenged.</p>

	4. The patentee decided to sue the Taiwan IPO only to realize after the IP Court held two hearings that it had little chance to win the lawsuit and so proposed and sign a settlement agreement with our client in Japan.
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Example work 6

Name and brief description of case/portfolio:	<p>一台灣玻璃加熱爐具製造商，向經濟部智慧財產局申請舉發要求撤銷一芬蘭玻璃加熱爐具製造商（本所客戶）之發明專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後復向智慧財產法院起訴，智慧財產法院判決駁回起訴（本所客戶勝訴）。舉發人目前已向最高行政法院提起上訴。</p> <p>A Taiwanese glass cookware maker sought for the invalidation of an invention patent owned by a Finnish company who is also a glass cookware manufacturer. We represented the patentee in the invalidation action and successfully sustained the validity of the patent challenged. The challenger appealed and the MOEA Appeal Board upholding Taiwan IPO's decision dismissed the appeal. The challenger then sued the Taiwan IPO but in vain and the matter is currently pending decision by the Supreme Administrative Court on the challenger's appeal.</p>
IP advisers from your firm involved:	<p>林志剛律師/專利師 廖文慈律師/專利師 黃鐘模專利代理人 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney HUANG Zhong-Mo, Patent Attorney</p>
Other IP firms involved:	N/A
Date(s)	<p>2014.05：被提起舉發 2014.06：提呈被舉發答辯（一） 2014.11：舉發人提補充理由（一） 2015.11：提呈被舉發答辯（二） 2016.07：舉發人提補充理由（二） 2016.08：提呈被舉發答辯（三） 2016.12：舉發人提補充理由（三） 2016.12：提呈被舉發答辯（四） 2017.06：審定舉發不成立 2017.12：訴願被駁回 2018.01：舉發人向智慧法院起訴 2018.06：智慧法院第一次開庭 2018.06：智慧法院第二次開庭 2018.07：智慧法院駁回起訴 2018.08：舉發人向最高行政法院提起上訴</p>

	<p>May 2014: Invalidation action filed. Jun. 2014: Patentee filed response statement (I). Nov. 2014: Invalidation requester presented supplemental statement (I) alleging reasons for the invalidation being sought for. Nov. 2015: Patentee filed response statement (II). Jul. 2016: Invalidation requester presented supplemental statement (II) Aug. 2016: Patentee filed response statement (III). Dec. 2016: Invalidation requester presented supplemental statement (III) Dec. 2016: Patentee filed response statement (IV). Jun. 2017: Request for invalidation dismissed. Dec. 2017: Appeal dismissed. Jan. 2018: Invalidation requester initiated administrative action in the IP Court. Jun. 2018: First court hearing held. Jun. 2018: Second court hearing held. Jul. 2018: Action dismissed. Aug. 2018: Invalidation requester appealed IP Court decision.</p>
<p>Why was it important?</p>	<p>1. 系爭專利係關於一加熱玻璃的方法及裝置之發明專利，舉發人針對全部請求項提出舉發，自 2014 年申請舉發後，前後共提出四次理由，被舉發人（本所客戶）亦提出四次答辯。由於本案亦涉及侵權糾紛，故雙方對本案之成敗均極為重視。</p> <p>2. 本案之攻防重點在於證據組合之動機的有無。由於舉發人所提出之數個證據分別各自揭露系爭專利之部分技術特徵，因此我方客戶防禦的重心在於主張各證據間不具有組合之動機。</p> <p>3. 案件由經濟部智慧財產局作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後雖不服智慧局之處分而向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。</p> <p>4. 於智慧法院審理過程中，法院罕見的在一個月內即舉行準備程序庭及言詞辯論庭，並隨即於次月即宣判舉發人敗訴（本所客戶勝訴）。顯見本所之答辯理由至為充分，且答辯方針亦即為正確，使法官迅速的形成立有利我方客戶的心證。</p> <p>1. The patent in issue is an invention on the method and device of heating glass. The challenger aiming to strike all of the claims of the patent presented a total of four written statements throughout the proceeding since 2014. We presented four written statements in response on behalf of the patentee. Whether the patent challenged should stand or be invalidated will decide who shall prevail in the patentee's patent infringement action against the challenger.</p> <p>2. The key to the attack and defence lies in the existence of the motive to combine the cited prior arts. As the prior arts cited by the challenger each disclose a different part the technical features of the patent being challenged, the defence shall focus on demonstrating that no person skilled in the art would be motivated by any of the cited prior arts to combine them.</p> <p>3. The Taiwan IPO found the invalidation being sought for untenable after looking into the statements presented. The</p>

	<p>challenger appealed only to see its appealed dismissed by the MOEA Appeal Board. That is, Taiwan IPO's decision is let stand and the patent challenged remains valid in good standing.</p> <p>4. In the administrative action the challenger brought against the Taiwan IPO, the IP Court conducted in the same month the preparatory proceeding and the oral argument session both, which is rare in practice. Moreover, IP Court decided on the action letting stand Taiwan IPO's decision (sustaining our client's patent) in the month that followed. Obviously, the IP Court considered the argument presented by Taiwan IPO based on the statements presented by the patentee in response to the invalidation tenable to quickly find to uphold Taiwan IPO's decision on the invalidation action and our client's patent in issue remains valid in good standing.</p>
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Example work 7

<p>Name and brief description of case/portfolio:</p>	<p>一美國的通訊設備之製造商，向經濟部智慧財產局申請舉發要求撤銷一日本通訊設備製造商（本所客戶）之專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後放棄向智慧財產法院起訴。</p> <p>A US telecommunication equipment manufacturer filed a request with the Taiwan IPO seeking invalidation of a patent owned by a Japanese fellow member of the trade who is a client of TiPLO. Taiwan IPO dismissed the invalidation action thereby sustaining our client's patent. The challenger appealed and the MOEA Appeal Board upholding Taiwan IPO's decision dismissed the appeal and the client's patent in issue stands still valid in good standing. The challenge proceeded no further.</p>
<p>IP advisers from your firm involved:</p>	<p>林志剛律師/專利師 廖文慈律師/專利師 蘇福長專利工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney SU Fu-Chang, Patent Engineer</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2013.01：被提起舉發 2013.04：提呈被舉發答辯(一)及申請更正申請專利範圍 2013.11：舉發人提補充理由書(一) 2014.01：提呈被舉發答辯(二) 2014.02：舉發人提補充理由書(二) 2014.04：提呈被舉發答辯(三) 2014.05：舉發人提補充理由書(三) 2014.09：提呈被舉發答辯(四) 2015.01：舉發人提補充理由書(四) 2015.05：提呈被舉發答辯(五)</p>

	<p>2015.06：舉發人提補充理由書(五) 2015.07：舉發人提補充理由書(六) 2015.11：提呈被舉發答辯(六)及申請更正申請專利範圍 2015.12：舉發人提補充理由書(七) 2016.04：提呈被舉發答辯(七) 2016.05：辦理面詢 2016.09：提呈被舉發答辯(八) 2016.09：辦理面詢 2016.10：舉發人提補充理由書(八) 2016.11：提呈被舉發答辯(九) 2017.06：審定舉發不成立 2018.03：訴願被駁回 Jan. 2013: Invalidation action filed. Apr. 2013: Patentee filed response statement (I) and a request for amending scope of the patent being challenged. Nov. 2013: Invalidation requester presented written statement (I) alleging reasons why the patent should be invalidated. Jan. 2014: Patentee filed response statement (II). Feb. 2014: Invalidation requester presented written statement (II). Apr. 2014: Patentee filed response statement (III). May 2014: Invalidation requester presented written statement (III). Sep. 2014: Patent tee filed response statement (IV). Jan. 2015: Invalidation requester presented written statement (IV). May 2015: Patentee filed response statement (V). Jun. 2015: Invalidation requester presented written statement (V). July 2015: Invalidation requester presented written statement (VI). Nov. 2015: Patentee filed response statement (VI) and a request for amending the scope of the patent. Dec. 2015: Invalidation requester presented written statement (VII). Apr. 2016: Patentee filed response statement (VII). May 2016: Taiwan IPO conducted an interview. Sep. 2016: Patentee filed response statement (VIII). Sep. 2016: Taiwan IPO conducted a second interview. Oct. 2016: Invalidation requester presented written statement (VIII). Nov. 2016: Sept. 2016: Patentee filed response statement (IX). Jun. 2017: Invalidation action dismissed. Mar. 2018: Invalidation requester's appeal dismissed.</p>
<p>Why was it important?</p>	<p>1. 系爭專利係關於一信號調變裝置之發明專利，舉發人提出 11 個證據，針對全部請求項共 64 項提出舉發，主張系爭專利不具新穎性及進步性，且說明書之記載有不明確致熟悉該項技術者無法據以實施的問題。 2. 由於涉案請求項高達 64 項，亦多達 11 個舉發證據，本案舉發人及被舉發人雙方各自均提出 9 份理由書及答辯書，智慧局亦罕見的進行二次面詢，耗時 4 年才作成舉發不成立之審定，顯見本案案情至為複雜。 3. 本所首先於程序上先指出其中 2 個證據的公開日期晚於系爭案之優先權日，不具證據適格。另外，於實體上明確性及進步性的部分亦</p>

	<p>成功的說服審查委員。智慧財產局最終作成全部請求項舉發不成立之處分，本所客戶獲得全面勝利。</p> <p>4. 舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後放棄向智慧財產法院起訴。</p> <p>1. The patent in issue is the invention on a signal adjusting device. The challenger cited a total of 11 prior arts with a view to striking all of the 64 claims of the patent. In the proceeding, the invalidation requester attacked the non-obviousness and inventive step as well as the specification of the patent challenged alleging that no person skilled in the art is able to reduce the patent claimed by reading the specification which is vague and unclear.</p> <p>2. Given the complexity of the case with as many as 64 patent claims and 11 prior arts involved, the invalidation requestor presented 9 written statements to elaborate the grounds alleged for the invalidation sought for and the patentee presented also 9 written statements in response to defend the patent and Taiwan IPO conducted two interviews for the case (which is rare) and took four years to decide on the case.</p> <p>3. We first had two of the prior arts cited stricken procedurally for both of them were laid open after the prior filing date claimed by the patent challenged. For substantive issues, we successfully convinced the examiner of the patentability and practicability of the patent challenged to vacate all of the allegations presented for the invalidation: all of the 64 claims challenged remain valid in good standing representing an overall victory for the client.</p> <p>4. The challenger aborted the quest against our client's patent after appealing in vain Taiwan IPO's dismissal of its invalidation action.</p>
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Example work 8

<p>Name and brief description of case/portfolio:</p>	<p>一日本半導體裝置製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本半導體裝置製造商（本所客戶）之專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。同時舉發人亦放棄訴願。</p> <p>A Japanese semi-conductors maker sought to invalidate but in vain a Taiwanese patent owned by a Japanese fellow member in the trade whom we represented in said invalidation action. The challenger decided to pursue the invalidation no further after Taiwan IPO denied its request for the invalidation.</p>
<p>IP advisers from your firm involved:</p>	<p>林志剛律師/專利師 廖文慈律師/專利師 吳偉汾工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney WU Wei-Fen, Patent Engineer</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2017.01：被提起舉發 2017.04：提呈被舉發答辯(一)</p>

	<p>2017.11：舉發人提補充理由 2018.01：提呈被舉發答辯(二) 2018.03：審定舉發不成立 Jan. 2017: Invalidation action filed. Apr. 2017: Patentee filed response statement (I). Nov. 2017: Invalidation requester presented supplemental statement. Jan. 2018: Patentee filed response statement (II). Mar. 2018: Invalidation action dismissed.</p>
<p>Why was it important?</p>	<p>1. 系爭專利係關於一半導體裝置之發明專利，舉發人共提出七件舉發證據，顯見其準備至為充分。此外，由於系爭專利同時亦有四件分割案於智慧局審理中，而本案之勝訴與否將牽動其他四件分割案是否亦能獲准專利。</p> <p>2. 在本所與審查委員密切的溝通以掌握審查委員的心證，以正確的擬定答辯方針，並製作系爭專利的模擬作動影片，使審查委員正確的理解系爭專利與數個舉發證據間於技術特徵上的差異，促使智慧局罕見的在一年內即作出舉發不成立的處分。舉發人同時亦放棄訴願，成功的為客戶固守其於業界獨佔的地位。</p> <p>1. The patent challenged is an invention on certain semi-conductor device. The invalidation requester cited a total of seven prior arts to back the invalidation sought for. As the patent challenged had four divisions pending examination in the Taiwan IPO, the outcome of the challenge would be the key to the grant or denial of the four divisions.</p> <p>2. We communicated closely with the examiner for an insight into what he might have in mind so to formulate the strategy to defend the patent for our client. We produced a simulation video for the examiner to get hold of the difference between the technical features of the patent being challenged and those of the cited prior arts each. Our efforts proved successful as the Taiwan IPO eventually held the invalidation sought for untenable in less than a year, which decision is uncommonly quick. Further, with the challenger deciding not to appeal and Taiwan IPO's decision stands final and irrevocable, our client continues to hold a leading market share.</p>

Example work 9

<p>Name and brief description of case/portfolio:</p>	<p>Trademark Application 商標名稱：Sling Fit 註冊號數：01895250 類別：25 指定商品：運動鞋、靴子、越野鞋。 商標權人：美商·諾菲斯服飾公司 Disputed TM: Sling Fit Reg. No.: 01895250 Class: 25 Designated Goods: Sneakers; boots; trail shoes Registrant: The North Face Apparel Corp.</p>
	<p>本所客戶美商·諾菲斯服飾以「Sling Fit」申請商標，智慧財產局於初步審定中指出「Sling」在鞋領域有涼鞋後腳跟綁帶之意，故認為「Sling Fit」是指「後腳跟貼合腳型」，屬不具識別性的說明性文字而欲否准該商標申請案。然而，經本所主動追蹤本件商標在美國申請案進程，發現本件商標係以鞋子內部結構為發想，而非指涉涼鞋後腳跟綁帶；故在依照客戶實際使用需求限縮指定商品項目後，成功說服智慧財產局：當消費者接觸到使用本件商標的運動鞋，會更好奇為何該等不具有後腳跟綁帶的鞋款上竟使用「Sling Fit」一詞，應該該商標具有較高識別性，本件商標最終獲准註冊。</p> <p>The Applicant, The North Face Apparel Corp., filed an application for TM “Sling Fit” designated for use on footwear. After preliminary examination, the Intellectual Property Office (IPO) opined that “sling” in the footwear industry may refer to straps of sandals; “Sling Fit” meaning “straps fitting over the heel”, is descriptive and not distinctive, thus should be rejected. However, the application in the USA reveals that the disputed trademark actually originated from an idea for interior safety design used on footwear. The Applicant after reduction of the designated goods based on actual use situation successfully convinced the IPO: the instant trademark will intrigue consumers’ curiosity why “Sling Fit” is used on “sneakers; boots; trail shoes”, not “sling back” type footwear, and should be deemed distinctive. The disputed trademark was eventually granted registration.</p>
<p>IP advisers from your firm involved</p>	<p>林志剛律師/專利師 楊憲祖律師/專利代理人 陳奐君律師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S. T. YANG, Attorney-at-Law / Patent Agent H. J. Chen, Attorney-at-Law</p>
<p>Other IP firms involved</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2016.12—提出本件商標註冊申請。 2017.05—智慧財產局 OA 通知初步審查結果。 2017.07—回覆智慧財產局 OA。 2017.12—智慧財產局通知商標核准註冊。 2018.02—商標註冊公告。</p>

	<p>December 2016 – Application filed May 2017 – First objection raised by the IPO July 2017 – Response December 2017 – Approval decision issued by the IPO February 2018 – Publication for registration</p>
<p>Why was it important?</p>	<p>商標申請案於初步審查階段遭質疑乃不具識別性的說明文字，倘此時商標尚未實際使用而無法提出具體證據證明後天識別性，該如何克服？</p> <p>在不損及客戶實際使用商標需求的情況下，適時將原本申請的使用商品從「鞋類產品」減縮為「運動鞋、靴子、越野鞋」，證明申請人並無獨占「Sling（鞋跟綁帶）」一詞之意圖；此外，本所藉由網路圖片檢索、媒體報導證實「Sling back」乃時尚產業特定鞋款，從而證明在申請人欲註冊的「運動鞋、靴子、越野鞋」領域中，「Sling」絕非常見字彙，成功說服智慧財產局本件商標並非說明性文字而有識別性。</p> <p>在本件商標申請階段，客戶未提供任何使用證據，亦未說明商標發想由來，但本所主動檢索該商標文字在他國註冊情況，並從 USPTO 紀錄發現客戶曾減縮商標指定註冊範圍，進一步與客戶討論本件商標未來使用規劃，方能替客戶擬定合適的商標申請策略，為客戶權益爭取保障。</p> <p>If a trademark application after preliminary examination is considered descriptive and not distinctive, how to overcome the obstacle without substantial materials for the trademark not being actually used to prove distinctiveness subsequently acquired? The reduction from “footwear” originally designated for application to “sneakers; boots; trail shoes” under the Applicant’s actual use verifies that the Applicant does not seek to monopolize “Sling” at all. The pictures from the internet and media reports indicate that “Sling back” is a fashion type footwear and further support the word “Sling” absolutely is not a common word seen in the industry of “sneakers; boots; trail shoes”, and successfully convince the IPO of the disputed trademark’s non-descriptiveness and distinctiveness.</p> <p>In the very first stage of filing the disputed trademark, the Applicant did not provide any use proof nor explain the design idea. However, after checking the disputed trademark registrations in other countries, the amendment of goods in the USA registration was found. After further discussion with the Applicant for the trademark use, a best strategy for registration was appropriately made to protect the Applicant’s right and interests.</p>

Example work 10

<p>Name and brief description of case/portfolio:</p>	<p>Trademark Opposition 系爭商標：創維 註冊號數：01796696 類別：7、11 指定商品：柑橘榨汁機；電動攪拌機；電動食物攪拌機；電動手持式攪拌機；家庭用榨果汁機；電動絞肉機；非手動胡椒研磨機；電動碎冰機；電動食品加工機；電動刨冰機；家庭用非手動碾磨機；多功能切菜機；電動開罐器；電動磨刀機；電動洗衣機；電動洗碗機；電動燙褲器；電動菜刀磨刀機；吸塵器；吸塵器用袋子；電動清洗地毯機器；蒸氣式清潔機；電動垃圾打碎機；電動割草機；電動剪刀；電動園藝刀具；過濾機；高壓清洗機；金屬加工雷射切割機；電動螺絲起子；電鑽；電鋸；電動手工具；焊接設備；磨刀機；打蠟拋光機；乾洗機；菜屑處理機。(第7類) 加熱裝置，蒸氣產生設備，空氣乾燥設備，通風設備(空調用)，飲水機，衛浴設備；冰箱；蒸汽產生設備；烹調用環；加熱板；電壺；電油炸鍋；飲用水用濾水器；冷凍櫃；電熱器；電暖器；保暖器；烤麵包機；電子鍋；微波爐；電咖啡機；空調用空氣過濾器；空氣淨化用負離子產生機；吹風機；乾衣機；除濕機；增濕機；空氣調節機；電動除濕機；電暖爐；家庭用電熱器及家庭用保暖器；冷凍機；桌上型電風扇；立扇；通風電扇；冷氣機；油及瓦斯烤爐；油及瓦斯暖爐；廚房用點火器；瓦斯點火器；電磁爐；烤箱；電鍋；冷暖氣機；電吹風機；電風扇。(第11類) 商標權人：大陸地區·創維集團有限公司(本所客戶) 異議人：創維電子有限公司</p> <p style="text-align: center;"></p> <p>據以異議商標：「創維電子」(註冊於第7、11、35類)</p> <p>Disputed TM: 創維 Reg. No.: 01796696 Classes: 7、11 Designated Goods: Citrus juicers; stand mixers; electric blenders; electric hand mixers; electric juice extractors for household purposes; electric meat grinders; pepper grinders (not hand-operated); electric ice crushers; electric food processors; electric ice slicers; mills for household purposes (not hand-operated); multichoppers; electric can openers; electric edge sharpeners; electric washing machines; electric dish washers; electric pants pressers; electric knife sharpeners; vacuum cleaners; bags for vacuum cleaners; electric carpet shampooing machines; steam cleaning machines; electric garbage disposers; electric lawn mowers; electric trimmers; electric gardening tools; filtering machines; high pressure washers; metal processing laser cutter; electric screw drivers; electric drills; electric saws; electric power hand tools; soldering apparatus; sharpening machines; wax polishing machines; dry-cleaning (class 7)</p>
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	<p>Heating apparatus, steam generating apparatus, air drying apparatus, ventilating apparatus (air conditioning), drinking fountains, bath installations; refrigerators; steam generating appliances; cooking rings; hot plates; electric kettles; electric deep fryers; filters for drinking water; freezers; heaters; electric radiators; warmers; toasters; electric rice cookers; microwave ovens; coffee makers; air filtering installations; ioniser for treatment of air; hair dryers; clothes dryers; dehumidifiers; humidifiers; air conditioning equipment; electric dehumidifiers; electric furnaces; household heaters and household warmers; refrigerating machines; desk fans; floor fans; ventilating fans; room coolers; oil and gas ranges; oil and gas stoves; lighters for kitchen; gas lighters; induction cookers; ovens; electric cookers; air-conditioners; electric hair dryers; electric fans (class 11)</p> <p>Registrant: Skyworth Group Co., Ltd. (our client) Opposer: Aidea Company</p>  <p>Cited Trademark: 創 維 電 子 (registered in classes 7, 11, 35)</p>
	<p>異議人對商標權人所有註冊之第 01796696 商標提出異議，認為兩造商標皆有中文字「創維」，且兩造商標所指定使用之商品中，有諸多商品所屬分類群組代碼相同，加上據以異議商標指定註冊在第 35 類的「電器用品零售批發、機械器具零售批發、家庭日常用品零售批發」，與系爭商標所指定註冊各項家電產品在銷售管道與銷售場所有關聯，進而主張兩造商標構成混淆誤認之虞。</p> <p>智慧財產局審酌兩造理由後，認定系爭商標與據以異議商標間不存在混淆誤認之虞，作成「異議不成立」處分，該處分並經經濟部駁回異議人訴願而告確定。</p> <p>The Opposer filed an opposition against TM Reg. No. 1796696 based on that the two parties' trademarks contain the same Chinese characters "創維"; some of the designated goods are classified into the sub-classes of the same classes; the designated services "machinery and equipment wholesale and retail; household daily necessities retail and wholesale" of the cited trademark are connective in sales channel with the electrical appliances of the disputed trademark, therefore, the two parties' trademarks would be likely to cause confusion and misidentification.</p> <p>The IPO after reviewing the two parties' reasoning decided that there is no likelihood of confusion and misidentification between the disputed trademark and the cited trademark. Following the decision made by the Ministry of Economic Affairs to dismiss the administrative appeal instituted by the Opposer, this case has become final.</p>
<p>IP advisers from your firm involved</p>	<p>林志剛律師/專利師 楊憲祖律師/專利代理人 陳奐君律師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S. T. YANG, Attorney-at-Law / Patent Agent H. J. Chen, Attorney-at-Law</p>

Other IP firms involved	N/A
Date(s)	<p>2016.12 – 異議人就系爭商標提出異議。 2018.01 – 智慧財產局為異議不成立處分。 2018.07 – 經濟部為「訴願駁回」之訴願決定。 December 2012 – Opposition filed by the Opposer January 2018 – Opposition Unfounded Decision made by the IPO July 2018 – Decision made by the MOEA to dismiss the administrative appeal filed by the Opposer</p>
Why was it important?	<p>兩商標指定使用之商品若屬同一商品分類群組代碼，便可認定屬類似商品？「電器用品零售批發、機械器具零售批發、家庭日常用品零售批發」與「電器商品、家電商品」是否構成類似商品及服務？</p> <p>異議人所列出兩造商標有屬同一分類群組代碼部分是「0729 不屬別類之機械零件」，但其範圍內商品繁雜，無從推論屬該群組之商品俱屬類似，況商品或服務分類係為了便於行政管理及檢索之用，商品或服務類似與否之認定非絕受該分類限制。從而，系爭商標之「過濾機」與據以異議商標指定使用之「馬達用風扇；馬達用冷卻散熱器」並不近似。</p> <p>至於系爭商標所指定用於諸多電器商品，雖與「電器用品零售批發、機械器具零售批發、家庭日常用品零售批發」有低度類似關係，但考量商標權人早在 2002 年即以「創維」二字獲准用於電視機、雷射碟影機等家電商品之商標，但異議人仍得於 2013 年獲准註冊據以異議商標於「電器用品零售批發」服務，可推認家電產品與電氣用品零售批發服務間類似程度非高。再者，商標權人在電視機、冰箱商品較據以異議商標為相關消費者熟悉，有諸多新聞報導資料可憑，足以認定兩造商標並無構成混淆誤認之虞，終獲異議不成立之處分。</p> <p>本件商標爭議中，透過檢視客戶旗下的商標組合（Trademark Portfolio），指出據以異議商標和本所客戶更早註冊「創維」商標能並存的事實，來反駁兩造商標存在混淆誤認之虞的主張；並利用新聞資料庫及大量網路資料證明，本所客戶與系爭商標遠較異議人及據以異議商標更知名，成功鞏固本所客戶權益。</p> <p>Should the goods/services in the same sub-classes designated by two trademarks be considered similar? Whether “machinery and equipment wholesale and retail; household daily necessities retail and wholesale” are similar to “electrical appliances; home appliances”?</p> <p>Some items of the two parties’ goods listed by the Opposer are classified into Sub-class 0729 titled “Machinery parts not belonging to other classes”. However, this sub-class is too broad to list specific items. Besides, the classification of goods or services is for the convenience of administrative management and search purpose; the classification is not absolutely meant to serve as a limitation on the determination of similar goods or services. Therefore, “filtering machines” of the disputed trademark should not be deemed similar to “fan motor” and “cooling radiator for motor” of the cited trademark.</p> <p>Even though the designated electrical appliances are somewhat similar to “machinery and equipment wholesale and retail; household daily necessities retail and wholesale” of the cited</p>

	<p>trademark. However, the disputed trademark owner in 2002 has registered TM “創維” designating for use on TV sets and LCD players, which are home appliances but he cited trademark in 2013 was granted registration on “retail and wholesale of electrical appliance etc.”, which means that the designated goods/services are not very similar. Media reports indicate that the disputed trademark is quite familiarized to relevant consumers in the field relative to TV sets and fridges, and evidently the two parties’ trademarks are not likely to cause confusion and misidentification. An opposition unfounded decision is therefore rendered. After inspecting the client’s trademark portfolio, the allegation of likelihood of confusion and misidentification between the two parties’ trademarks was rigorously and successfully refuted by the co-existence of the disputed trademark registered earlier and the cited trademark, and the disputed trademark is more reputable than the cited trademark.</p>
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Example work 11

<p>Name and brief description of case/portfolio:</p>	<p>Trademark Revocation</p> <p>系爭商標： (天絲及圖) 註冊號數：385582 類別：25 指定商品：各種衣服 商標權人：金峯興業股份有限公司 廢止申請人：奧地利商·蘭琴股份有限公司 (本所客戶) 申請人商標：天絲</p> <p>Disputed TM:  (天絲及圖) Reg. No.: 385582 Class:25 Designated goods: Various kinds of clothing Registrant: Chin-Feng Enterprise Co., Ltd. Petitioner: Lenzing Aktiengesellschaft (our client) Cited TM: 天絲</p> <p>申請人對商標權人所有之註冊第385582號商標提出廢止，智慧財產局認為商標權人提出之各項事證不足證明系爭商標於申請廢止日前三年內已使用於所指定之各種衣服商品上，系爭商標之註冊應予廢止之處分，商標權人不服該處分而提起訴願，后由經濟部訴願審議委員認定原機關處分洵無不合而為訴願駁回，系爭商標因而遭廢止其註冊確定。</p> <p>The Petitioner filed a revocation petition against the disputed TM Reg. No. 385582. The IPO considered the disputed trademark should be revoked in view that the use proof lodged by the disputed trademark owner is unable to evidence that the disputed trademark had been used on the designated various clothing within three years before the revocation petition was filed. In disagreement with the</p>
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	decision, the disputed trademark owner instituted an administrative appeal. The MOEA dismissed the appeal considering that the IPO's decision is not improper. The revocation of the disputed trademark registration was therefore ascertained.
IP advisers from your firm involved:	林志剛律師/專利師 楊憲祖律師/專利代理人 張美婷/法務助理 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S. T. YANG, Attorney-at-Law / Patent Agent Mei-Ting Chang, Paralegal
Other IP firms involved:	N/A
Date(s)	2016.04 – 提出廢止 2017.05 – 智慧財產局為廢止成立之處分 2017.06 – 提起訴願 2017.11 – 訴願駁回 2018.03 – 撤銷註冊公告 April 2016 – Revocation petition filed May 2017 – Revocation founded Decision made by the IPO June 2017 – Administrative appeal filed with the MOEA November 2017 – Administrative appeal dismissed March 2018 – Publication of the revocation
Why was it important?	使用證據是否有效的判斷。 Use proof acceptable or not
	廢止申請人擬取得「天絲」商標之專用權，經智慧財產局以近似系爭商標為由發給核駁先行通知書。 申請人委託調查公司發現商標權人「金峯興業」與「鏗德恩企業股份有限公司」及「達步施企業股份有限公司」互為關係企業，在實際市場上主要是由其關係企業販售所產製之商品，且未發現系爭商標有使用在任何商品上，故而對系爭商標提起廢止申請。 商標權人「金峯興業」知曉後表示雙方早期曾有口頭約定同意廢止申請人使用「天絲」中文兩字且不對此主張商標專用權，要求廢止申請人撤回廢止。期間雖經廢止申請人努力與商標權人「金峯興業」交涉協商，仍無法取得對方善意且合法同意方式。 商標權人「金峯興業」提出在廢止申請前 3 年內之使用證據以圖繼續保有系爭商標之專用權，然部分證據（發票、衣服、網頁）標示非系爭商標整體，不足以作為使用之事證，僅有兩項褲子商品照片顯示標有系爭商標整體圖樣。經申請人再次委託調查公司查證，是否該兩項褲子商品確實標有系爭商標整體圖樣，但於商標權人相關企業所屬專櫃／商店均已無法取得該兩項褲子商品，廢止申請人仍不放棄，最終在購物網站取得商標權人所提呈標示系爭商標之一項商品貨號完全相同之男用短褲，然查驗後，發現只有在褲子口袋布料內面有標示系爭商標。本所認為，就衣服商品而言，廠商不會把商標標示在口袋內面，此有違一般業界標示商標的習慣，該等標示的方式充其量只可認為是標示口袋所使用的布料，而非褲子。 智慧財產局亦認為，商標所有權人「金峯興業」提出各項事證其中商品實物及照片，固可觀出商標權人所送褲子內面之口袋布面上標有系

爭商標，或另於紙製吊牌上印有商標，惟消費者選購商品時，甚少會翻出褲子口袋內面觀看商標，是於褲子內面口袋標示商標之方式，與一般商業使用習慣有異，難謂該種標示方式，足使消費者認識其在表彰商品來源。而紙製吊牌，係處於隨時可加以吊掛、取下之狀態，以上開事證皆無可資佐證使用時期之其他事證，自難認定於申請廢止日前 3 年內已存在。而其他事證（發票、衣服、網頁）僅標示系爭商標中文部分而非系爭商標整體，難以認定且不足證明於申請廢止日前 3 年內已存在或使用系爭商標於所指定之各種衣服商品上，智慧財產局因而為系爭商標之註冊應予廢止之處分。商標所有權人不服處分提出訴願，由經濟部訴願審議委員認定原機關處分洵無不合而為訴願駁回，系爭商標因而遭廢止其註冊確定。

The Petitioner filed an application for TM “天絲” but the IPO issued an office action citing the disputed trademark.

Then the Petitioner commissioned an investigation agency to check use of the disputed trademark and learned that the disputed trademark owner is affiliating with “EDWIN BROTHER CO., LTD.” and “DABUS CO., LTD.” which take charge of distributing products at marketplace. Since the investigation revealed that the disputed trademark was not used on any product, the Petitioner therefore filed a revocation petition against the disputed trademark.

The disputed trademark owner, Chin-Feng Enterprise Co., Ltd., asked the Petitioner to withdraw the revocation because the Petitioner was permitted to use “天絲” trademark without any legal action taken in a verbal agreement between them at an early stage. Despite the Petitioner trying hard to make a deal with the disputed trademark owner, no amicable agreement was reached eventually.

The disputed trademark owner lodged the evidence showing use of the disputed trademark within three years before the revocation petition was filed. However, except photos of two pants labeling the disputed trademark entirety, the invoices, clothing sample and webpages where the disputed trademark entirety does not appear should not be accepted as use proof. A further investigation was conducted to check if the disputed trademark entirety is actually labeled with the two pants. Failed to find the two pants exactly the same as those shown on the photos from the affiliate’s counters/stores, the investigator finally purchased a men’s shorts bearing an item number listed by the disputed trademark owner in their defense. However, the disputed trademark was labeled on the interior side of the pocket. In our opinion, such labeling on clothing does not meet general commercial usage, instead, it is just a way of identifying which brand of fabric the manufacturer used to manufacture the pants.

The IPO in the decision to revoke the disputed trademark registration opined, pants photos do show the disputed trademark on the pocket inside of the pants or the paper tag; however, the consumers when purchasing would scarcely turn the inner side of pants pockets out for inspection of the trademark; to label the trademark inside of pants does not meet general commercial usage; it is hard to say that such labeling will make consumers identify source of goods; the paper tag can be appended/taken at any time;



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no other facts/evidence can verify the use of the disputed trademark within three years before the revocation petition was filed; only the Chinese characters, not the entirety of the disputed trademark, is labeled with other materials (invoices, sample clothing, webpages), which are not convincing enough to prove that the disputed trademark had been used on various clothing within three years before the revocation petition was filed. The disputed trademark owner in disagreement with the IPO's decision brought up an administrative appeal but the MOEA, considering no impropriety of the IPO's decision made a dismissal decision. Revocation of the disputed trademark registration was therefore ascertained.

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