

**ESSENCE OF THE NEW TAIWAN TRADEMARK LAW – KEY ISSUES ONLY !**

**1. GENERAL RULES**

Applicable law: Trademark Act  
(most recent amendment promulgated June 29, 2011 to come into force as of July 1, 2012)

Agency in charge: Taiwan Intellectual Property Office, Ministry of Economic Affairs (TIPO)

(1) Trademark protection upon registration

(2) Classification of Goods/Services

- ① The Nice Classification (10<sup>th</sup> edition) is adopted.
- ② Similarity/dissimilarity of goods or services shall be determined without regard to classification of goods or services.
- ③ “Retail and wholesale of specific goods” is classified into class 35.
- ④ From February 1, 2011, official fees for trademark registration will be charged according to the number of items of goods and specific goods for retail and wholesale.

(3) Trademark

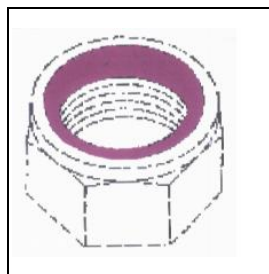
① Registrable trademark types: trademarks, certification marks, collective membership marks and collective trademarks.

② Protectable subject matter: Any sign with distinctiveness, which may, in particular, consist of words, devices, symbols, colors, three-dimensional shapes, motions, holograms, sounds, or any combination thereof.

③ Non-conventional trademarks (referring to “Examination Standards for Non-Conventional Trademarks”)

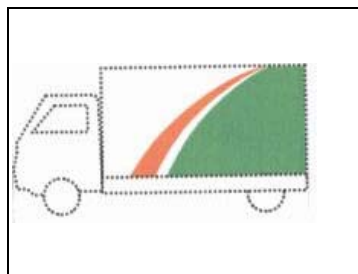
※ Color trademarks: to identify source by color/s

Single-color mark



vs

Multi-color mark

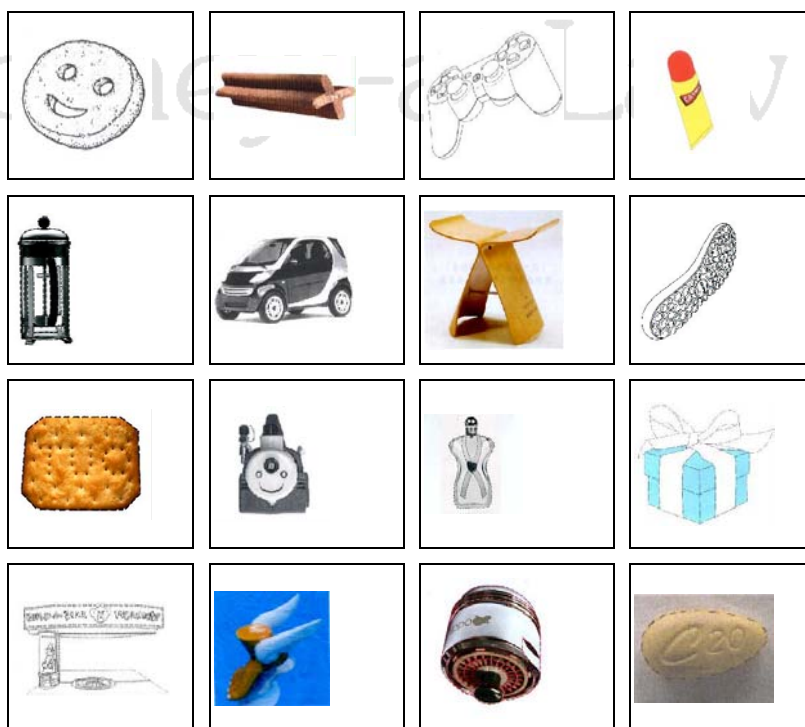


\* Representation of the proposed mark submitted upon filing

The proposed mark shall be truly represented by

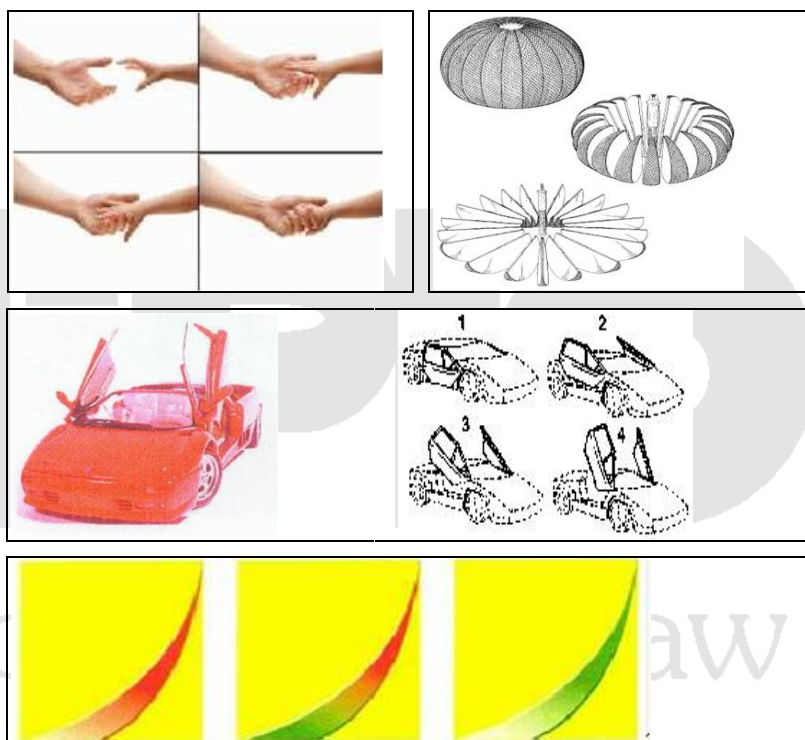
- \* Color/s designated
- \* Broken lines to show the manner, placement or context in which the color is or the colors are used on the designated goods or services
- \* Color/s defined by International Color Table

※ Three-dimensional trademarks: to identify source by shapes with length, width and height



- \* Representation of the proposed mark submitted upon filing  
The proposed mark shall be truthfully represented by
  - \* not more than six views depicting the 3-D shapes
  - \* broken lines to show the manner, placement or context in which the three-dimensional shape is used on the designated goods or services

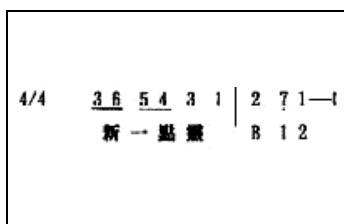
※ Motion Trademarks: to identify source by serial motions



- \* Representation of the proposed mark submitted upon filing  
The proposed mark shall be truly represented by
  - \* a series of not more than six still images depicting the movement
  - \* Description explaining the movement in the sequential order
  - \* electronic data carrier that contains the stored representation of the trademark

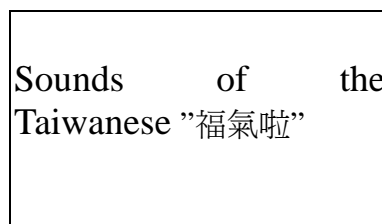
※ Sound marks: to identify source by sound

Musical



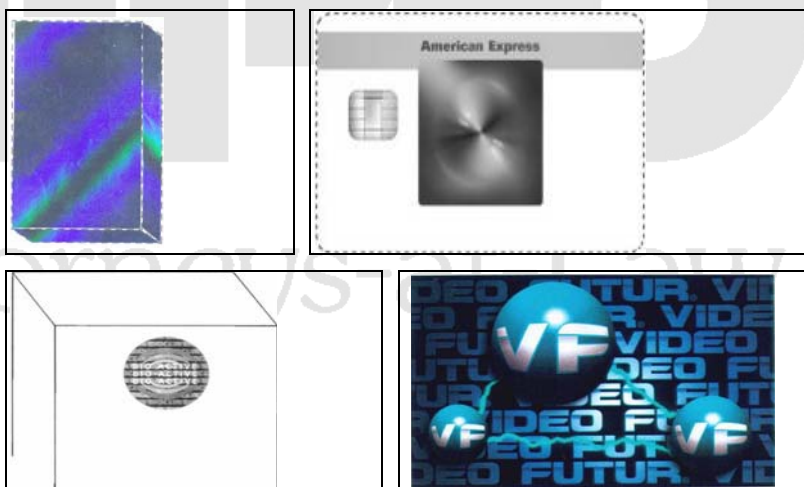
vs

Non-musical



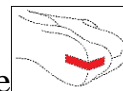
- \* Representation of the proposed mark submitted upon filing:  
The proposed mark shall be truthfully represented by
  - \* a staff or description of the sound
  - \* electronic data carrier that contains the stored representation of the trademark

※ Hologram marks: to identify source by hologram/s (a technique for recording 3-D images)



- \* Representation of the proposed mark submitted upon filing  
The proposed mark shall be truly represented by
  - \* not more than four views of the trademark capturing the holographic effect in its entirety
  - \* Where the images change according to the angle at which the hologram is viewed, the description shall contain the explanation of the changes of the images.

※ Other non-conventional Trademarks:



- \* Position trademarks: to indicate the position, like
- \* Trademarks of odor, senses of touch and taste are registrable marks under the current Trademark Act.

## **2. FILING PROCEDURE**

### (1) Required documents

- ① Written application (with applicant, trademark specimen and designated goods or services specified and provided therein);
- ② Power of Attorney (Neither notarized nor legalized)

### (2) Filing

- ① Multi-class application acceptable
- ② More than one applicant for one application acceptable
- ③ Priority claim

\* A priority claim may be made within 6 months counted from the day following the date of filing of the first application in a country which has reciprocal recognition of priority rights with Taiwan (ROC) or is a member of the WTO to the filing date.

\* A priority claim may be made in respect of some or all the same goods or services

\* A priority claim may be made for a mark that has been exhibited in at an international exhibition which was held or officially recognized by the Taiwan Government in connection with the designated goods or services within six months from the date the goods or services first displayed.

- ④ e-filing acceptable

## **3. EXAMINATION**

### (1) Examination shall be conducted on procedural and substantive matters.

- ① Procedural matters: whether the necessary specifications are

indicated and contained in the written application and the specification of the designated goods/services

② Substantive matters: whether a proposed mark should be held unregistrable (e.g. it is not distinctive or it is identical with or similar to another person's registered mark designated to be used on the same or similar goods or it is identical with or similar to another person's well-known mark or symbol)

(2) Correction and Change

① The following errors in the particulars of a trademark registration application may be corrected upon request:

- (1) errors in the name or address of the applicant;
- (2) errors of wording or of copying; or
- (3) any other obvious mistakes.

The correction referred to in the preceding paragraph shall not affect the identity of the trademark or broaden the scope of the designated goods or services.

② No amendments shall be made in the representation of the trademark and the designated goods or services thereof after an application for trademark registration has been filed, unless such amendment is a restriction of designated goods or services or an amendment to the representation of the trademark which does not substantially change such trademark.

(3) Preliminary notice of rejection

① Before rendering a rejection decision, TIPO will issue to the applicant a written notice stating grounds for the rejection. In such case, the applicant may file a written statement of opinion within the prescribed period which is one month for those who have a domicile, residence or business establishment in the territory of Taiwan (ROC) and for those who do not, two months. TIPO may allow extension on request with reasons given.

② Co-existence Agreement

The owner of a mark identical with or similar to another person's prior mark registered or proposed pending approval of registration ("prior mark") on the same or similar goods or services may seeking registration of his/her mark must obtain a signed Co-existence Agreement of the owner or applicant of the prior mark.

\* If, after providing his/her signed Co-existence Agreement, the owner or applicant of the prior mark wishes to seek registration of a mark (if any) which may be held confusingly similar to the mark proposed for registration under the Co-existence Agreement shall also obtain the owner or applicant of the later mark.

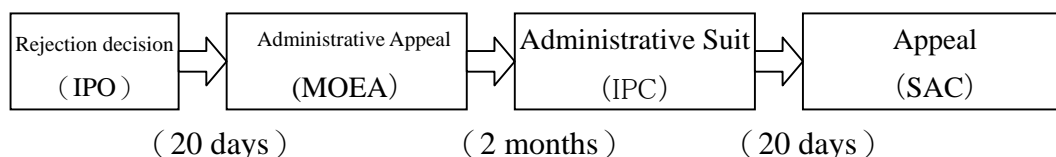
\* TIPO will reject the signed Co-existence Agreement if the content of the agreement presented is in obvious contravention of law, for example, the mark/specification being proposed for registration is identical with the prior mark/specification, or the owner of the prior registered mark is enjoined by the court from making disposition of the mark.

### ③ Disclaimer

\* The non-distinctive portion (if any) of a proposed mark which may give rise to disputes over the scope of the trademark right shall be disclaimed

\* The applicant is not required to disclaim the non-distinctive portion of his/her proposed mark (if any) which is unlikely to give rise to disputes over the scope of the trademark right, such as generic term(s) or words descriptive in nature.

### (4) Administrative remedies against rejection decision



#### **4. REGISTRATION AND RENEWAL**

(1) TIPO will publish the mark approved for registration upon receipt of the registration fee within two months after serving the approval decision.

(2) Late payment of registration fee acceptable: Failing to pay the registration fee within the above time period, the applicant may pay double the amount of the registration fee within six months from the day following the expiration of the above time period and the registration of the mark will be published accordingly.

(3) Registration fee must be paid in lump sum.

(4) Trademark term: The owner of a registered mark will have the exclusive right of the trademark for a term of ten years from the publication date.

(5) A request for renewal of trademark right shall be made with the renewal fee paid within six months before the trademark term duly expires. Failing to do so, the trademark owner may request for the renewal by paying double the amount of the renewal fee within six months after the trademark term duly expires.

(6) TIPO will perform no substantive examination of the request for trademark renewal. For the purpose of the renewal, the trademark owner is required to produce only the necessary signed Power of Attorney (neither notarization nor legalization is required) other than the request form.

#### **5. TRADEMARK RIGHT**

The owner of a registered mark holds the exclusive right to use his/her registered mark on the designated goods or services as well as the right to exclude others from using any mark identical with or similar to his/her registered mark on the same or similar goods or services.

#### **6. OTHERS**

(1) Trademark information



Information regarding trademark applications, registrations, status, and decisions on disputes is available for search in Chinese and English on TIPO's website.

(2) Proof of use

① If revocation of a registered mark is sought for based on non-use of the mark for three years, the trademark right holder will be required to produce evidence proving the mark has been put in use within the three years prior to the revocation filing date.

② For the purpose of seeking invalidation of a registered mark under Item 10, Para. 1, Article 30 of the Trademark Act (on the grounds of the mark being identical with or similar to the cited mark registered for use on the same or similar goods/services) or revocation of a registered mark under Item 1, Para. 1, Article 63 of the same Act (on the grounds of the mark having been put to use with unauthorized alteration or addition thereby amounted to a mark identical with or similar to the cited mark registered for use on the same or similar goods or services), where the cited mark has been registered for three years, the challenging party shall produce evidence proving that the cited mark has been put into use within the three years prior to the filing date of the invalidation action or revocation.

(3) Opposition

① Any person may oppose the registration of a mark within three months from the day following the publication date. The opposition may be filed on some of the designated goods or services of the mark.

② Once TIPO's decision on the opposition becomes conclusive and final, no person will be allowed to seek invalidation of the same mark based on the same allegations, the same evidence and the same grounds.

(4) Invalidation Action

① Any interested person may seek invalidation of a registered mark

within five years from the day following the publication date of the mark. (The above time limit does not operate, however, if the registration being challenged was obtained out of bad faith.) The invalidation may be filed on some of the designated goods or services of the registered trademark.

② Once TIPO decides on an invalidation action, no person will be allowed to seek invalidation of the same mark on the same allegations, the same evidence and the same grounds.

#### (5) Trademark License

① The owner of a registered mark may license the mark on an exclusive or non-exclusive basis.

② Recordal of license may be filed on all or some of the designated goods or services and for a designated locality.

③ An exclusive licensee may, to the extent allowed under the license, exclude the owner of the licensed mark and any third party from using the mark.

④ An exclusive licensee may, to the extent allowed under the license, claim trademark infringement against infringers in his/her own name.

⑤ An exclusive licensee may, to the extent allowed under the license, sub-license the registered mark to another person.

⑥ A non-exclusive licensee shall not sub-license the registered mark to another person without the prior consent of the owner of the mark or the exclusive licensee.

⑦ No license/sub-license of a registered mark may be asserted against any third party without being a recordal thereof being filed with TIPO.

#### (6) Protection of well-known marks

According to Item 11, Para. 1, Article 30 of the Trademark Act, no trademark shall be granted registration if it is identical with or similar to another person's well-known mark and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the well-known mark.

(7) Protection of non-registered marks

Item 12, Para. 1, Article 30 of the Trademark Act provides that no registration shall be granted to any mark that is identical with or similar to a mark firstly used by another person on the same or similar goods or services and the existence of that mark is known to the applicant by contract, geographical accessibility, business exchanges or other relationship with that person and the applicant is knowingly proposing that person's mark or a similar mark seeking registration for use on the same or similar goods or services. Therefore, the owner of a non-registered mark may file opposition or invalidation action against the squatter of his/her mark with evidence proving his/her first use of the mark on the same or similar goods/services in Taiwan or any other countries.

(8) Notice or symbol of registration

A registered mark in use maybe displayed with the words "Registered Mark" or the international symbol ® to alert all other persons from acting in violation of the mark.