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TIPLo Outstanding work on Litigation Case (2015.9)

Example work 1

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| Name and brief description of case/portfolio: | <p>一德國大型工業機具製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本大型工業機具製造商（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）。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）。舉發人不服而向法院起訴，目前正由智慧財產法院審理中。</p> <p>A German maker of large-size industrial machines sought for the invalidation of a Taiwanese patent owned by a Japanese corporation, a large-size industrial machine maker as well and a client of TIPLo's. Taiwan IPO decided the invalidation sought for groundless upholding the validity of our client's patent in issue. The German challenger took an appeal and the Appeal Board let stand Taiwan IPO's decision. The matter is now pending decision by the IP Court on the administrative action initiated by challenger.</p> |
| IP advisers from your firm involved: | <p>林志剛律師/專利師 高山峰專利師 廖文慈律師/專利師 吳偉汾工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Charles S.F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney W. F. WU, Patent Engineer</p> |
| Other IP firms involved: | N/A |
| Date(s) | <p>2011.07：被提起舉發 2011.09：被舉發答辯 2013.02：辦理面詢 2013.03：舉發補充理由 2013.07：被舉發答辯 2013.11：被舉發答辯 2014.03：舉發補充理由 2014.06：智慧局作成舉發不成立之處分 2015.02：訴願會駁回訴願 2015.05：向智慧法院起訴</p> |

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| | <p><u>Timeline (yy.mm)</u></p> <p>2011.07: Challenger filed invalidation request. 2011.09: Patentee filed answer. 2013.02: Patentee interviewed by Taiwan IPO examiner. 2013.03: Challenger filed first statement of supplemental reasons for seeking invalidation. 2013.07: Patentee filed response statement. 2013.11: Patentee filed a second response statement. 2014.03: Challenger filed a second statement of supplemental reasons for seeking invalidation. 2014.06: Taiwan IPO issued decision holding the invalidation sought for groundless. 2015.02: Appeal Board dismissed challenger's appeal. 2015.05: Challenger initiated administrative action in the IP Court.</p> |
| <p>Why was it important?</p> | <p>1、系爭專利係關於一海水處理方法及裝置之發明專利，舉發人針對全部請求項提出舉發。於智慧財產局期間雙方並申請面詢。智慧財產局早先原公開心證表示本案應不具新穎性及進步性，惟經由本所於面詢時向審查委員詳細說明系爭專利與諸舉發證據之的差異，並多次提出答辯理由說明，最後審查委員完全接受本所之論點，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被舉發人之訴願（本所客戶勝訴）。</p> <p>2、本案之爭點在於舉發證據雖然揭露「裝置最終出口(排放至海洋)之 pH 值」係大於 6.5 之數值，然該數值乃單純為了對應中國之海水排放數值，而非舉發證據之發明人為獲致裝置小型化所研究分析而獲得之最佳數據，是否可因為單純數值恰巧相同即可證明係爭專利不具新穎性及進步性？過去我國智慧局長久以來存有上述錯誤的思考邏輯，導致舉發人可任意憑藉舉發證據所揭露之數據資料，而不論該數值之所以界定所存在的技術思想，即可成功撤銷他人之專利。本案審理之初，審查委員亦抱持相同的見解，然經由本所律師的論理說明，導正了審查委員於邏輯上的盲點，最終為本所客戶取得勝訴。</p> <p>1. The patent in issue is an invention patent on certain seawater treatment method and device. The German maker challenged every claim of the patent. In the proceeding, both parties requested to communicate to the examiner face-to-face. Before our interview with the examiner on behalf of our client, Taiwan IPO openly expressed the patent in issue might be considered lack of novelty and inventive step. We successfully pointed out and explained in detail to the belief of the examiner during the interview the difference between the patent in issue and the evidence cited by the challenger and reiterated our defence in the written statements that followed. The German maker's invalidation attempt thus failed and on its appeal, the Appeal Board let stand Taiwan IPO's decision holding the invalidation sought for groundless.</p> <p>2. The focus of our argument is the patented device's pH value at the end of the discharge (i.e. at the exit to the ocean). Much as the invention cited specifies the cited patent has a pH value of 6.5, said value is in fact given in consideration of the pH value of seawater</p> |

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| | <p>discharge standard required by the Chinese government. In other words, it is not the optimal value attained in the course of the research and analysis performed by the inventor with a view to downsizing the device. The question is then: Does the concurrence of the pH value specified in the patent in issue with that of the cited invention indisputably justify the allegation that the patent in issue lacks novelty and inventive step? Taiwan IPO has been questioned for its logic and reasoning for invalidating a patent by reason of the numeric value disclosed in the cited prior art without looking into the technical concept leading to the definition of the numeric value cited. In this invalidation case, the Taiwan IPO examiner in charge had initially given the challenger's argument a good thought by reason of the cited pH value but we successfully argued to overturn the above questionable logic and reasoning and reverse his opinion and our client's patent in issue stands.</p> |
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Example work 2

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| <p>Name and brief description of case/portfolio:</p> | <p>一台灣之自行車製造商，先後二次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同一件發明專利(N01,N02)。智慧局就 N01 案審定舉發成立(本所客戶敗訴)。然經本所客戶向經濟部訴願審議委員會提起訴願，訴願會撤銷智慧局的審定(本所客戶勝訴)，智慧法院亦維持訴願會的決定而駁回起訴(本所客戶勝訴)。該舉發人嗣後提出第二件舉發案(N02 案)，經智慧局審理，亦作成舉發不成立之處分(本所客戶勝訴)。</p> <p>A Taiwanese maker of bicycles twice challenged (hereinafter "challenge #1 and challenge #2" respectively) and twice in vain the same patent owned by a Japanese corporation in the same trade. In challenge #1, the patent at issue was invalidated. The patentee appealed and the Appeal Board vacated Taiwan IPO's invalidation decision. The challenger brought the matter to the IP Court and the IP Court upheld the Appeal Board's decision. The challenger thereafter filed a second request for invalidation of the same patent, which request was considered groundless and dismissed.</p> |
| <p>IP advisers from your firm involved:</p> | <p>林志剛律師/專利師 高山峰專利師 廖文慈律師/專利師 詹皓安工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Charles S.F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney ZHAN Hao-An, Patent Engineer</p> |
| <p>Other IP firms involved:</p> | <p>N/A</p> |
| <p>Date(s)</p> | <p>2008.8：被提起舉發(N01 案) 2008.10：提答辯理由(一)(N01 案) 2010.11：提補充理由(N01 案) 2011.02：提答辯理由(二)(N01 案) 2011.11：智慧局審定舉發成立(N01 案)</p> |

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| | <p>2012.08：訴願會撤銷原處分(N01 案) 2013.04：智慧法院駁回起訴(N01 案) 2013.11：被提起舉發(N02 案) 2013.12：提答辯理由（一）(N02 案) 2014.12：提答辯理由（二）(N02 案) 2015.04：智慧局審定舉發不成立(N02 案)</p> <p><u>Timeline (yy.mm)</u></p> <p>2008.08: Challenger filed challenge #1. 2008.10: Patentee filed answer to challenge #1. 2010.11: Challenger filed statement of supplemental reasons for challenge #1. 2011.02: Patentee filed second response statement to challenge #1. 2011.11: Taiwan IPO issued decision on challenge #1 upholding the invalidation sought for. 2012.08: On patentee's appeal, Appeal Board vacated Taiwan IPO's decision on challenge #1. 2013.04 IP Court dismissed challenger's action. 2013.11 Challenger filed challenge #2. 2013.12 Patentee filed answer to challenge #2. 2014.12 Patentee filed second response statement to challenge #2. 2015.04 Taiwan IPO issued decision upholding the good standing of the patent in issue.</p> |
| <p>Why was it important?</p> | <p>1、系爭專利係關於一自行車用鏈輪之發明專利。舉發人於 EPO 同時亦針對系爭專利之 EPO 對應案提出舉發，顯見本件專利之重要。智慧局雖然作成舉發成立的處分，但本所成功的於訴願階段為客戶取得逆轉勝，推翻的舉發成立的結果。此種逆轉勝之結果在目前我國訴願成功之機率不到 1 成的情況下，相當罕見。而即便舉發人嗣後向智慧法院起訴，智慧法院仍然駁回其起訴。舉發人隨後又搜集其他舉發證據，針對系爭專利再提出第二件舉發案，同樣亦遭智慧局審定舉發不成立</p> <p>2、本案之爭點在於雖然諸舉發證據與系爭專利均屬自行車用鏈輪，技術領域係屬相同，然而，諸舉發證據其各自之設計所能達成之功效與系爭專利並不相同，甚至係相互矛盾，該領域具有通常知識者實難以產生將之加以組合以完成系爭專利的動機。本所成功的說服訴願會接受上述觀點，為客戶取得逆轉勝。</p> <p>1. The patent in issue is an invention of certain bicycle chain wheel. The challenger also sought for the invalidation of the corresponding EPO patent, which fact manifests the patent in issue being a core invention. Taiwan IPO decided to invalidate our client's patent but we successfully appealed the decision. The relevant statistics shows the patentee has the odds of less than 10% in reversing Taiwan IPO's invalidation decisions by appeal. The challenger brought the case to the IP Court and its action was dismissed on the merits. Citing another prior art, the challenger sought for invalidation of our client's patent in issue a second time but in vain.</p> <p>2. The key to our success in convincing the Appeal Board is the</p> |

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| | <p>difference between the attainable effectiveness of the cited prior arts each and that of our client's patent in issue. Much as all of the prior arts cited are, technically speaking, patents on the invention of certain bicycle chain wheel as well, due to the above difference or even incompatibility, it is not easy for any an average person skilful in the art to have the motive to initiate the combination to come up with the invention in issue.</p> |
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Example work 3

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| Name and brief description of case/portfolio: | <p>一日本之製藥公司製造商向經濟部智慧財產局申請舉發要求撤銷另一日本之化學原料製造商（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）。</p> <p>A Japanese pharmaceutical company sought for invalidation of a Taiwanese patent held by a Japanese manufacturer of chemical materials who is a client of TiPLO's. Taiwan IPO decided holding the invalidation sought for groundless and our client's patent in issue stands.</p> |
| IP advisers from your firm involved: | <p>林志剛律師/專利師 高山峰專利師 廖文慈律師/專利師 張麗卿工程師</p> <p>J.K. LIN, Attorney-at-Law / Certified Patent Attorney Charles S.F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney Alice L.C. ZHANG, Patent Engineer</p> |
| Other IP firms involved: | N/A |
| Date(s) | <p>2014.07：被提起舉發 2014.09：提呈被舉發答辯（一） 2015.07：智慧局作成舉發不成立之處分</p> <p><u>Timeline (yy.mm)</u></p> <p>2014.07: Challenger filed invalidation request. 2014.09: Patentee filed answer. 2010.11: Taiwan IPO decided holding the invalidation sought for groundless.</p> |
| Why was it important? | <p>系爭專利係關於一化合物的晶型以及製法之發明專利。舉發人於日本同時亦針對系爭專利之日本對應案提出舉發，顯見本件專利之重要。舉發人共提出 10 件舉發證據，但本所成功的反駁多件屬於實驗結果類型之舉發證據的證據能力，使智慧財產局於系爭專利被提起舉發之一年內即作成舉發不成立之處分，成功且迅速的為客戶完整的維持其專利的有效性。</p> <p>The patent in issue is an invention of the crystal form and the method of preparing certain compound. The Japanese challenger also sought for invalidation of the corresponding Japanese patent by JIPO, which fact manifests the importance of the patent in issue. The challenger cited a total of ten prior arts for the invalidation sought for. We successfully overturned the evidentiary power of the majority of them which are typically experimental. Taking our argument on the merits, Taiwan IPO quickly issued its decision</p> |

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| | within just one year holding the invalidation sought for groundless and upholding our client's patent valid in good standing. |
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Example work 4

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| Name and brief description of case/portfolio: | <p>一日本自行車製造商（本所客戶），向經濟部智慧財產局申請舉發要求撤銷另一德國自行製造商之專利。案件由經濟部智慧財產局審理中後作成舉發成立的處分（本所客戶勝訴）。被舉發人復向經濟部訴願審議委員會提出訴願，亦遭訴願決定駁回訴願（本所客戶勝訴）。舉發人不服而向智慧法院起訴，亦被智慧法院駁回起訴（本所客戶勝訴）。舉發人復向最高行政法院提起上訴，亦被最高行政法院駁回上訴，全案由本所客戶獲得最終勝訴。被舉發人無任何再提出上訴之機會。</p> <p>A Japanese maker of bicycles (client of TiPLO's) sought for invalidation of a Taiwanese patent held by a German member in the same trade. Taiwan IPO decided to invalidate the patent. Having appealed in vain, the German patentee brought the matter to the IP Court and the IP Court dismissed the action. The German patentee then took an appeal to the Supreme Administrative Court which appeal was dismissed. Our client <i>won</i> every instance of the proceedings and the invalidation of the patent challenged became final with binding effects.</p> |
| IP advisers from your firm involved: | <p>高山峰專利師 廖文慈律師/專利師 蔡爾修專利師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Charles S.F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney Er-Xiou TSAI, Patent Engineer</p> |
| Other IP firms involved: | N/A |
| Date(s) | <p>2008.06：提起舉發 2011.10：被舉發人第一次申請更正申請專利範圍 2012.01：提補充理由（一） 2012.04：舉行面詢 2012.06：提補充理由（二） 2012.08：被舉發人第二次申請更正申請專利範圍 2013.08：智慧局審定舉發成立 2014.02：經濟部訴願審議委員駁回訴願 2014.04：被舉發人向智慧財產法院起訴 2014.07.01：智慧財產法院舉行準備程序 2014.07.24：智慧財產法院舉行言詞辯論 2014.08.07：智慧財產法院駁回原告起訴 2015.05.21：最高行政法院駁回原告上訴</p> <p><u>Timeline (yy.mm)</u></p> <p>2008.06: Client filed request for invalidation. 2011.10: Patentee filed first request for amending claims of the patent in issue. 2012.01: Client filed statement (I) of reasons for seeking the</p> |

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| | <p>invalidation.</p> <p>2012.04: Client answered Taiwan IPO's interview.</p> <p>2012.06: Client filed statement (II) of reasons for seeking the invalidation.</p> <p>2012.08: Patentee filed second request for amending claims of the patent in issue.</p> <p>2013.08: Taiwan IPO issued decision invalidating the patent in issue.</p> <p>2014.02: Appeal Board dismissed patentee's appeal taken from Taiwan IPO's invalidation decision.</p> <p>2014.04: Patentee initiated action with the IP Court.</p> <p>2014.07.01: Preparatory session in the IP Court.</p> <p>2014.07.24: Oral session in the IP Court.</p> <p>2014.08.07: IP Court dismissed patentee's action.</p> <p>2015.05.21: Supreme Administrative Court dismissed patentee's appeal taken from the IP Court's dismissal of its action.</p> |
| <p>Why was it important?</p> | <p>系爭專利係關於一自行車用之傳動鏈之發明專利，本所為客戶提出舉發後，被舉發人於 2011 年提出第一次更正申請專利範圍之申請，限縮申請專利範圍。惟於本所繼續為客戶提出補充理由並申請面詢向智慧局之審查委員當面解釋說明相關之技術問題後，在審查委員之強力要求下，迫使被舉發人二度大幅限縮申請專利範圍，再度提出更正申請專利範圍之申請，但即便如此，智慧局最終仍認定系爭專利不具進步性而審定舉發成立。被舉發人復向經濟部訴願審議委員會提出訴願，亦遭訴願決定駁回訴願。被舉發人其後向智慧法院起訴，智慧法院仍認為原處分及訴願決定作成舉發成立之審定並無違誤之處，因此駁回起訴。被舉發人遂向最高行政法院提出上訴，亦被最高行政法院駁回上訴，被舉發人無任何再提出救濟之機會。全案由本所客戶獲得最終勝訴。</p> <p>The patent in issue is an invention of certain bicycle chain. We filled on behalf of our client a request seeking invalidation of the patent. In response, patentee filed in 2011 a request for narrowing down the scope of claims of the patent in issue. We followed by supplementing the reasons for seeking the invalidation and requesting for an interview to explain to the examiner face-to-face the technical issues concerned. After the interview, on the examiner's unyielding advice, patentee sought to narrow down the patent claims again. Nevertheless, the patent in issue was invalidated on account of lack of inventive step. Patentee appealed and the Appeal Board dismissed the appeal. Patentee then brought the matter to the IP Court. The IP Court dismissed patentee's action letting stand Taiwan IPO's invalidation decision as well the Appeal Board's decision upholding Taiwan IPO's decision. Patentee took an appeal to the Supreme Administrative Court but in vain and Taiwan IPO's invalidation of the patent in issue thus became final with binding effects.</p> |

Example work 5

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| Name and brief description of case/portfolio: | <p>一台灣之電連接器製造商向經濟部智慧財產局申請舉發要求撤銷一日本電連接器製造商之發明專利。智慧局審定舉發不成立（本所客戶勝訴）。</p> <p>A Taiwanese maker of electrical connectors challenged but in vain certain invention patent owned by a Japanese corporation, a fellow member of the trade and a client of TiPLO's.</p> |
| IP advisers from your firm involved: | <p>林志剛律師/專利師 高山峰專利師 廖文慈律師/專利師 賴舜田工程師 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Charles S.F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney Shun-Tian LAI, Patent Engineer</p> |
| Other IP firms involved: | <p>N/A</p> |
| Date(s) | <p>2013.08：被提起舉發 2013.10：提答辯理由（一） 2014.01：提補充理由 2014.04：提答辯理由（二） 2014.08：智慧局審定舉發不成立</p> <p><u>Timeline (yy.mm)</u></p> <p>2013.08: Challenger filed invalidation request. 2013.10 Patentee filed answer. 2014.01 Challenger supplemented a statement of reasons for seeking invalidation. 2014.04 Patentee filed a response statement. 2014.08 Taiwan IPO issued decision holding the invalidation sought for groundless.</p> |
| Why was it important? | <p>本案係一電路基板用電連接器之發明專利，在本所成功的答辯策略進行下，使智慧局在舉發人提起舉發的一年內，即作成舉發不成立之處分，於實務上甚為罕見。本所成功且迅速的為客戶完整的維持專利的有效性。</p> <p>The patent in issue is an invention patent on certain electrical connector for use by PCBs. We successfully defended our client's patent which stands intact with Taiwan IPO issuing the decision holding the challenge groundless in just one year and such speediness is rare in practice.</p> |

Example work 6

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| Name and brief description of case/portfolio: | <p>(承上案例)客戶與侵權人之本案訴訟，目前經智慧財產法院第一審判決侵權人敗訴，除命侵權人應停止侵害，及銷毀假處分實施所查扣之原料及半成品外，並命侵權人賠償新台幣 1300 萬元之賠償金。</p> <p>(Further to the case as profiled above) With respect to the main action initiated by the client against the accused, the IP Court decided against the accused, demanding that the accused cease the infringement, destroy the materials and semi-finished products seized subject to the provisional injunction executed, and pay damages in an amount of TWD13,000,000.</p> <p>侵權人於本件訴訟中提出先前技術主張系爭專利有應撤銷之事由，並抗辯僅有販賣金屬零件，並未販賣成品，故無侵權行為。</p> <p>During the proceeding of this action, the accused had once presented prior arts to challenge the validity of the patent in issue and denied the infringement alleged against it by arguing that it simply sold metal parts, not finished products.</p> <p>智慧財產法院於審酌後，認為侵權人主張之先前技術，無法使系爭專利不具進步性。在侵權判斷時，則根據在證據保全時所拍攝之成品照片及查扣之半成品，認為該成品有侵害專利權。並以侵權人之出口報單上有關產品名稱之記載，認定侵權人在臺灣有製造及販賣侵權產品之行為，並認為侵權人有關僅販賣金屬零件之抗辯不可採。最後法院以侵權人出口報單上所記載之產品數量，及客戶主張之產品單價計算損害賠償。</p> <p>The IP Court examined this case and held that the prior arts presented by the accused did not negate the non-obviousness of the patent in issue. Also, the IP Court determined the existence of the alleged infringement based on the pictures of the finished products taken during the proceeding of evidence preservation and the seized semi-finished products. In accordance with the descriptions with respect to product designation in the accused's export declaration document, the IP Court determined that the accused was engaged in the act of manufacturing and selling the accused product in Taiwan and that the accused's argument about its sale of only the metal parts should not be admissible. The IP Court also calculated the amount of awarded damages based on the quantity indicated in the export declaration document and the unit price asserted by the client.</p> <p>法院於本件亦有闡述申請專利範圍解釋之原則，即：倘申請專利範圍之用語非為熟習該項技術者所認知或瞭解者，則應優先參酌說明書及圖式之定義，或依其中所載發明目的、發明所欲解決之問題、功效等理解該用語之意義，因說明書及圖式係用以揭露並輔助說明發明之內容，解釋申請專利範圍時，理應按說明書及圖式以理解申請專利之發明內容。倘由說明書及圖式內容，對申請專利範圍用語之意義尚有疑義，則可由專利申請階段至專利權維護過程之歷史檔案（內部證據），可探求專利專責機關所准予專利權範圍為何，並禁止專利權人反覆其詞，致使專利權範圍呈現浮動不明而有礙公益，是發明專利之權利範圍自應受到前揭內部證據之限制。惟若由前述說明書、圖式等內部證據仍無法明確解釋專利權之範圍，始得參酌前揭內部證據以外之證據（即外部證據）為解釋。換言之，倘依內部證據解釋申請專利範圍，</p> |
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| | <p>已足使申請專利範圍清楚明確，即無考慮外部證據或其他解釋原則之必要。</p> <p>By operation of the rules of construing the patent claims, according to the court, if the person skilled in the ordinary art do not know or understand the language used in the patent claims, the definition(s) provided in the specification and drawing(s) should be first taken as reference. Alternatively, the purpose, the intended solution and use of the subject invention as set forth in the specification and drawing(s) may help in understanding the meaning of the language used in the patent claims because the specification and drawing(s) are to disclose and describe the content of the subject invention. Thus, patent claims should be construed in accordance with the specification and the drawing(s) for understanding the content of the subject invention. However, if the meaning of the language used in the patent claims remains questionable, the file history from patent prosecution to patent right maintenance (intrinsic evidence) may be taken into account to determine and know the patent claims approved by the patent agency, in which case, the patentee would be barred from change or reverse his/her previously expressed standing since such change or reversion would accordingly cause the scope of patent right to be indefinite and thus impede public interests. Therefore, it is reasonable that the scope of patent right for the subject invention should be subject to the intrinsic evidence. Further, if the scope of patent claims still cannot be determined by reference to the above-mentioned intrinsic evidence, including specification and drawing(s), the patent claims should be construed by reference to the evidence or rules other than the aforesaid intrinsic evidence (namely, extrinsic evidence). In other words, it would be unnecessary to take into consideration the extrinsic evidence or other rules if the intrinsic evidence is sufficient enough to definitely construe the patent claims.</p> |
| IP advisers from your firm involved: | H. G. Chen, Attorney-at-Law and Certified Patent Attorney Y. S. Yang, Attorney-at-Law |
| Other IP firms involved: | N/A |
| Date(s) | <p>Timeline: --</p> <p>22 Aug. 2013: Civil action initiated.</p> <p>23 Oct. 2013: The first court hearing held.</p> <p>05 Dec. 2014: The 10th court hearing held (Oral argument session concluded).</p> <p>31 Dec. 2014: Judgment rendered.</p> |
| Why was it important? | <p>本件法院認定侵權人有製造及販賣侵權品之依據在於證據保全中取得侵權物品。因此，對於難以透過市場上公開取得之證據或無法說明來源之證據，建議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。</p> <p>Based on the accused product obtained in the proceeding of evidence preservation, the IP Court determined that the accused indeed manufactured and sold the accused product. Therefore, it is suggested that a motion seeking preservation of evidence which is hardly accessible on market or whose origin cannot be explained should be filed before initiation of a civil action, so as to ensure the</p> |

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| | client's superior position in the main action. |
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Example work 7

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| <p>Name and brief description of case/portfolio:</p> | <p>(承上案例)客戶與侵權人之本案訴訟，目前經智慧財產法院第一審判決侵權人敗訴，除命侵權人應停止侵害，及銷毀假處分實施所查扣之原料及半成品外，並命侵權人賠償新台幣 1300 萬元之賠償金。</p> <p>(Further to the case as profiled above) With respect to the main action initiated by the client against the accused, the IP Court decided against the accused, demanding that the accused cease the infringement, destroy the materials and semi-finished products seized subject to the provisional injunction executed, and pay damages in an amount of TWD13,000,000.</p> <p>侵權人於本件訴訟中提出先前技術主張系爭專利有應撤銷之事由，並抗辯僅有販賣金屬零件，並未販賣成品，故無侵權行為。</p> <p>During the proceeding of this action, the accused had once presented prior arts to challenge the validity of the patent in issue and denied the infringement alleged against it by arguing that it simply sold metal parts, not finished products.</p> <p>智慧財產法院於審酌後，認為侵權人主張之先前技術，無法使系爭專利不具進步性。在侵權判斷時，則根據在證據保全時所拍攝之成品照片及查扣之半成品，認為該成品有侵害專利權。並以侵權人之出口報單上有關產品名稱之記載，認定侵權人在臺灣有製造及販賣侵權產品之行為，並認為侵權人有關僅販賣金屬零件之抗辯不可採。最後法院以侵權人出口報單上所記載之產品數量，及客戶主張之產品單價計算損害賠償。</p> <p>The IP Court examined this case and held that the prior arts presented by the accused did not negate the non-obviousness of the patent in issue. Also, the IP Court determined the existence of the alleged infringement based on the pictures of the finished products taken during the proceeding of evidence preservation and the seized semi-finished products. In accordance with the descriptions with respect to product designation in the accused's export declaration document, the IP Court determined that the accused was engaged in the act of manufacturing and selling the accused product in Taiwan and that the accused's argument about its sale of only the metal parts should not be admissible. The IP Court also calculated the amount of awarded damages based on the quantity indicated in the export declaration document and the unit price asserted by the client.</p> <p>法院於本件亦有闡述申請專利範圍解釋之原則，即：倘申請專利範圍之用語非為熟習該項技術者所認知或瞭解者，則應優先參酌說明書及圖式之定義，或依其中所載發明目的、發明所欲解決之問題、功效等理解該用語之意義，因說明書及圖式係用以揭露並輔助說明發明之內容，解釋申請專利範圍時，理應按說明書及圖式以理解申請專利之發明內容。倘由說明書及圖式內容，對申請專利範圍用語之意義尚有疑義，則可由專利申請階段至專利權維護過程之歷史檔案（內部證據），</p> |
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| | <p>可探求專利專責機關所准予專利權範圍為何，並禁止專利權人反覆其詞，致使專利權範圍呈現浮動不明而有礙公益，是發明專利之權利範圍自應受到前揭內部證據之限制。惟若由前述說明書、圖式等內部證據仍無法明確解釋專利權之範圍，始得參酌前揭內部證據以外之證據（即外部證據）為解釋。換言之，倘依內部證據解釋申請專利範圍，已足使申請專利範圍清楚明確，即無考慮外部證據或其他解釋原則之必要。</p> <p>By operation of the rules of construing the patent claims, according to the court, if the person skilled in the ordinary art do not know or understand the language used in the patent claims, the definition(s) provided in the specification and drawing(s) should be first taken as reference. Alternatively, the purpose, the intended solution and use of the subject invention as set forth in the specification and drawing(s) may help in understanding the meaning of the language used in the patent claims because the specification and drawing(s) are to disclose and describe the content of the subject invention. Thus, patent claims should be construed in accordance with the specification and the drawing(s) for understanding the content of the subject invention. However, if the meaning of the language used in the patent claims remains questionable, the file history from patent prosecution to patent right maintenance (intrinsic evidence) may be taken into account to determine and know the patent claims approved by the patent agency, in which case, the patentee would be barred from change or reverse his/her previously expressed standing since such change or reversion would accordingly cause the scope of patent right to be indefinite and thus impede public interests. Therefore, it is reasonable that the scope of patent right for the subject invention should be subject to the intrinsic evidence. Further, if the scope of patent claims still cannot be determined by reference to the above-mentioned intrinsic evidence, including specification and drawing(s), the patent claims should be construed by reference to the evidence or rules other than the aforesaid intrinsic evidence (namely, extrinsic evidence). In other words, it would be unnecessary to take into consideration the extrinsic evidence or other rules if the intrinsic evidence is sufficient enough to definitely construe the patent claims.</p> |
| IP advisers from your firm involved: | H. G. Chen, Attorney-at-Law and Certified Patent Attorney Y. S. Yang, Attorney-at-Law |
| Other IP firms involved: | N/A |
| Date(s) | <p>Timeline: --</p> <p>22 Aug. 2013: Civil action initiated.</p> <p>23 Oct. 2013: The first court hearing held.</p> <p>05 Dec. 2014: The 10th court hearing held (Oral argument session concluded).</p> <p>31 Dec. 2014: Judgment rendered.</p> |
| Why was it important? | <p>本件法院認定侵權人有製造及販賣侵權品之依據在於證據保全中取得侵權物品。因此，對於難以透過市場上公開取得之證據或無法說明來源之證據，建議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。</p> |

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| | Based on the accused product obtained in the proceeding of evidence preservation, the IP Court determined that the accused indeed manufactured and sold the accused product. Therefore, it is suggested that a motion seeking preservation of evidence which is hardly accessible on market or whose origin cannot be explained should be filed before initiation of a civil action, so as to ensure the client's superior position in the main action. |
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Example work 8

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| <p>Name and brief description of case/portfolio:</p> | <p>Trademark Opposition</p> <p style="text-align: center;"></p> <p>系爭商標： 註冊號數：1585597 類別：14 指定商品：貴金屬及其合金，由金、銀、白金或貴重寶石、半貴重寶石製首飾，貴重金屬帽飾品，貴重金屬鞋飾品，貴重金屬徽章，服飾用人造寶石；珠寶；手鐲、別針飾品、戒指、耳環、項鍊、胸針、袖扣、領帶別針及領帶夾；寶石；錶、鐘、計時器及精密計時儀器。 商標權人：美商古魯丁尼公司 商標異議人：瑞士商亞米茄股份有限公司(Omega SA)(Omega AG)(Omega Ltd.) (本所客戶)</p> <p>據以異議商標：</p> <p>Trademark Opposition</p> <p>Synopsis</p> <p>Disputed TM: </p> <p>Reg. No.: 1585597 Class: 14 Designated Goods: Precious metals and their alloys; ornaments, precious metal decorations for hats, precious metal decoration for shoes, precious metal badges, artificial gems for clothing all made of gold, silver platinum or precious stones, semi precious stones; jewelry; bracelets, pins, rings, earring, necklaces, brooches, cufflinks, tie pins and tie clip; precious stones; horological, timekeeper and chronometric instruments Applicant: Guru Denim Inc. Opposer: OMEGA SA (OMEGA AG) (OMEGA LTD.)</p> <p>Cited Trademark: </p> |
| <p>IP advisers from your firm involved:</p> | <p>異議人對商標權人所有之註冊第 1585597 號商標提出異議，智慧財產局認為二造商標並不衝突，而為異議不成立之處分，案經異議人向經濟部提起訴願後，遭經濟部為訴願駁回之決定，異議人遂向智慧財產法院提起行政訴訟，經智慧財產法院審理後，認定二造商標相衝突，而為原處分及訴願決定撤銷、系爭商標應予撤銷之判決，商標權人雖不服該判決向最高行政法院提起上訴，惟遭最高行政法院裁定駁回，因此本案異議人勝訴確定。</p> |

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| | <p>Summary</p> <p>The Opposer filed an opposition against TM “” Reg. No. 1585597 owned by the Applicant. The Intellectual Property Office (IPO) considering no conflict between the two parties’ trademarks made an Opposition Unfounded Decision. The Opposer then instituted an administrative appeal with the Ministry of Economic Affairs (MOEA). After the MOEA dismissed the administrative appeal, the Opposer brought up an administrative suit with the Intellectual Property Court (IPC). The IPC after examination rendered a judgement determining similarity between the two parties’ trademarks, revoking of the original decision and administrative appeal decision, and canceling of the disputed trademark. In disagreement with the judgement, the Applicant initiated an appeal with the Supreme Administrative Court (SAC). The SAC dismissed the appeal. This case has become finalized.</p> |
| IP advisers from your firm involved: | <p>林志剛律師/專利師 楊憲祖律師/專利代理人 黃闡億律師/專利代理人 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S.T. YANG, Attorney-at-Law / Certified Patent Agent Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Agent</p> |
| Other IP firms involved: | N/A |
| Date(s) | <p>2012.07—提出異議 2014.02—智慧財產局為異議不成立之處分 2014.04—提起訴願 2014.07—經濟部為訴願駁回之決定 2014.09—提起行政訴訟 2015.04—智慧財產法院為原處分及訴願決定撤銷、系爭商標應予撤銷之判決 2015.05—提起上訴 2015.08—最高行政法院為上訴駁回之裁定</p> <p>Calendar July 2012 – Opposition filed February 2014 – Opposition Unfounded Decision made by the IPO April 2014 – Administrative appeal filed July 2014 – Administrative appeal dismissed by the MOEA September 2014 – Administrative suit filed April 2015 – Judgement made by the IPC to revoke the original decision and the administrative appeal decision and to cancel the disputed trademark May 2015 – Appeal filed August 2015 – Judgement made by the SAC to dismiss the appeal</p> |
| Why was it important? | <p>本案爭點為系爭商標是否與據以異議商標構成近似，且有致相關消費者產生混淆誤認之虞？</p> <p>智慧財產局認為，本案據以異議商標固著名於鐘錶等相關商品，惟系爭商標係由一英文「U」字母設計而成，外觀予人印象亦類似於日文「ひ」字；而據以異議商標則由希臘符號「Ω」及其英文發音「OMEGA」上下所組成，二造商</p> |

標近似程度低，各具相當識別性，且系爭商標於西元 2002 年起即使用於牛仔褲等服飾商品，陸續於其他國家獲准註冊，該服飾商品並於台灣等地行銷、廣告，得認商標權人並無利用或攀附據以異議商標之信譽情事，系爭商標之申請註冊應非出於惡意，系爭商標應無與據以異議商標產生混淆誤認之虞，而為異議不成立之處分。經濟部於訴願決定亦持相同理由，為訴願駁回之決定。惟智慧財產法院認為，系爭商標之外觀形似據以異議商標之「Ω」符號部分之倒影，加以商品之擺置方向或使用狀態，未必呈現正向之商標圖樣，則當系爭商標倒置情況下，適與消費者對據以異議商標留存之主要部分「Ω」之印象相似，致使系爭商標與據以異議商標極近似，且相較於據以異議商標之市場強度，系爭商標之強度顯不及據以異議商標，二者又指定使用於同一或類似之錶、鐘、計時器等商品，二造商標商品之行銷場所亦有重疊，雖商標權人非出於積極之惡意使用、申請系爭商標，惟考量上開各項因素，系爭商標應有致相關消費者產生混淆誤認之虞，不應准許其註冊，而為原處分及訴願決定撤銷、系爭商標應予撤銷之判決。商標權人雖不服該判決向最高行政法院提起上訴，惟最高行政法院認其上訴理由未具體表明原判決有何違背法令之處，而以裁定駁回其上訴。


Main Issue

The main issue for the instant case is whether or not the disputed trademark is similar to the cited trademark and it is likely to cause confusion to relevant consumers.


The IPO in the Opposition Unfounded Decision reasoned that the cited trademark is known for timepieces and related products, however, the disputed TM “U (device)” Reg. No. 01585597 is composed of “U”, alike the Japanese character “ウ” while the cited trademark is a composition of the Greek symbol “Ω” and “OMEGA” arranged in two lines; the level of similarity is low; they are respectively distinctive; the disputed trademark has been used on jeans since 2002 and registered consecutively in other countries; the trademarked clothing is marketed and promoted in Taiwan so that there is no free-ride on the cited trademark; the disputed trademark was not filed out of bad faith; the disputed trademark and the cited trademark would not cause confusion and misidentification. Holding the same ground, the MOEA dismissed the administrative appeal filed by the Opposer. However, the IPC opined that the disputed trademark is like Ω device of the cited trademark placed in opposite direction; the disputed trademark could be presented or viewed in opposite direction depending on how the products are displayed in marketplace; under such situation, the disputed trademark will bring consumers similar impression to Ω device of the cited trademark so as to constitute close similarity between the disputed trademark and the cited trademark; since the disputed trademark is less famous than the cited trademark and both trademarks are designated for use on the same or similar watches, clocks, chronometric instruments overlapped in sales places, in view of above factors, the disputed trademark is likely to cause confusion and misidentification to relevant consumers and should not be

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| | granted registration, even though it was not filed out of bad faith by the Applicant; therefore, the original decision and the administrative appeal decision should be revoked and the disputed trademark should be cancelled. In disagreement with the judgement, the Applicant initiated an appeal with the SAC but the appeal was dismissed on basis of not substantially explaining how the IPC's judgement is unlawfully constituted. |
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Example work 9

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| <p>Name and brief description of case/portfolio:</p> | <p>系爭商標: </p> <p>註冊號數: 1587753</p> <p>類別: 9, 16, 35, 36, 38, 39, 41, 42</p> <p>註冊人: 開曼群島商·阿里巴巴集團控股有限公司 ALIBABA GROUP HOLDING LIMITED</p> <p>Trademark Application</p> <p>Synopsis</p> <p>Disputed TM: </p> <p>Reg. No.: 1587753</p> <p>Classes: 9, 16, 35, 36, 38, 39, 41, 42</p> <p>Registrant: ALIBABA GROUP HOLDING LIMITED</p> |
| <p>IP advisers from your firm involved:</p> | <p>智慧財產局認為系爭商標「云」即「雲」之簡體字，而與雲端技術結合提供之各種商品或服務習見以「雲」一字結合不同描述文字來表彰，因此不具識別性，以核駁第 0339911 號審定書為核駁之處分。申請人不服，提起訴願，遭經濟部為訴願駁回之處分，申請人遂向智慧財產法院提起行政訴訟。經智慧財產法院審理後認為系爭商標圖樣具有相當識別性，而為訴願決定及原處分均撤銷之判決。本案發回智慧財產局重審後，已獲准商標註冊。</p> <p>Summary</p> <p>The Intellectual Property Office (IPO) in the Rejection Decision No. 339911 opined that "云" is the simplified form of "雲" and such a character is commonly used on goods or services connective with cloud computing, thus should not be distinctive. In disagreement with the decision, the Applicant filed an administrative appeal with the Ministry of Economic Affairs (MOEA) but a dismissal decision was rendered. Then the Applicant brought up an administrative suit with the Intellectual Property Court (IPC). The IPC after examination considered the disputed trademark distinctive and made a judgement to revoke the MOEA's administrative appeal decision and the IPO's original decision. This case was remanded to the IPO for re-examination and the disputed trademark has been 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 黃闡億律師/專利代理人 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S.T. YANG, Attorney-at-Law / Certified Patent Agent</p> |

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| | Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Agent |
| Other IP firms involved: | N/A |
| Date(s) | <p>2011.07 – 申請註冊 2012.04 – 智慧財產局發給核駁理由先行通知書 2012.05 – 提出意見書 2012.06 – 智慧財產局為核駁之審定 2012.07 – 提起訴願 2012.10 – 經濟部為訴願駁回之決定 2012.12 – 提起行政訴訟 2013.06 – 智慧財產法院為訴願決定及原處分均撤銷之判決 2013.05 – 智慧財產局為核准之審定 2013.06 – 繳納註冊費 2013.07 – 公告註冊</p> <p>Calendar July 2011 – Application filed April 2012 – Official letter issued by the IPO May 2012 – Response to the official letter filed June 2012 - Rejection Decision made by the IPO July 2012 – Administrative appeal filed with the MOEA October 2012 – Decision to dismiss the administrative appeal made by the MOEA December 2012 - Administrative suit filed June 2013 – Judgement made by the IPC to revoke the rejection decision and the administrative appeal decision May 2013 – Approval Decision made by the IPO June 2013 – Registration fee paid July 2013 – Registration published</p> |
| Why was it important? | <p>本件爭點：系爭商標是否不具識別性？ 智慧財產法院判決認為系爭商標圖形顯然已具相當識別性，其要點如下：1.申請人另一類似商標「」(Alibaba cloud logo) 亦僅由單一中文字「云」所構成，且指定使用在相同之商品及服務，僅字體設計稍有不同，業經智慧財產局認為具有相當識別性，核准為註冊第1480915號商標。基於行政自我拘束原則，系爭商標自難謂不具識別性。</p> <p>2. 「云」於辭典共有5種解釋，(1)意指「說」(2)表示「如是」或「等等」(3)古詩文用作襯字(4)古「雲」字(5)姓。該等意涵與系爭商標所指定使用之各種商品及服務並無任何關聯性，非指定使用商品或服務本身或其品質、功用或其他特性之說明，並未傳達所指定使用商品或服務的相關資訊，應屬具識別性之任意性標識。</p> <p>3. 系爭商標圖樣是一個經過特殊設計的文字設計圖，其因圖形化之設計，即易予消費者品牌圖案之印象，會將其視為商標，故具相當識別性。</p> <p>4. 單一的中文字「雲」，依一般消費者的理解，乃指天上的雲。在未與任何網路科技相關文字結合使用時，單一的中文字「雲」無法予人寓目印象即意指「雲端科技」之意。</p> <p>Main Issue</p> |

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| | <p>The main issue for the instant case is whether or not the disputed trademark is distinctive.</p> <p>The reasons the IPC considered the disputed trademark is quite distinctive are:</p> <ol style="list-style-type: none"> 1. TM  (Alibaba cloud logo) owned by the Applicant comprising the slightly different Chinese character “云” alone and designating for use on the same goods and services was considered distinctive by the IPO and granted registration as No. 1480915. Based on administrative self-restraint rule, it is hard to say that the disputed trademark is not distinctive. 2. “云” has several definitions in dictionary: 1) say; 2) so or etc.; 3) used in ancient poems; 4) same as “雲”; 5) a surname. These definitions have no connection with the designated goods or services of the disputed trademark. The disputed trademark does not describe quality, utility or other characteristics of the designated goods or services nor convey any idea relative to the designated goods or services, thus should be considered arbitrary. 3. The disputed trademark is a special design of a Chinese character. Such a picturized design is impressive enough to make consumers associate with a trademark and should be quite distinctive. 4. General consumers would think the single Chinese character “雲” refers to cloud. Such a character used alone could not be associated with cloud computing at all. |
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Example work 10

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| <p>Name and brief description of case/portfolio:</p> | <p>系爭商標：</p> <p>註冊號數：1514875</p> <p>類別：4</p> <p>指定商品：工業用蠟；棕櫚蠟；石蠟；地蠟；蜂蠟；白蠟；蠟；皮帶用蠟。</p> <p>商標權人：玉暉股份有限公司</p> <p>商標異議人：瑞士商·史華曲集團研究及發展股份有限公司（本所客戶）</p> <p>據以異議商標：MOEBIUS</p> <p>Trademark Opposition Synopsis</p> <p></p> <p>Disputed TM: Reg. No.: 1514875 Class: 4 Designated Goods: Industrial wax; carnauba wax; paraffin; ozokerite; beeswax; white wax, wax; belt wax Applicant: I Fei Co., Ltd. Opposer: The Swatch Group Recherche et Developpement SA (The Swatch Group Forschungs- und Entwicklungs AG) (The Swatch</p> |
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| | Group Research and Development Ltd.) Cited Trademark: MOEBIUS |
| IP advisers from your firm involved: | <p>異議人對商標權人所有之註冊第 1514875 號商標提出異議，智慧財產局認為二造商標並不衝突，而為異議不成立之處分，異議人不服，提起訴願，案經經濟部審理後，認定二造商標相衝突，而為「原處分撤銷，由原處分機關另為適法之處分」之訴願決定，智慧財產局依訴願決定意旨重為處分，認定二造商標相衝突，而為系爭商標之註冊應予撤銷之處分，商標權人未對該處分提起訴願，本案系爭商標因而遭撤銷註冊確定。</p> <p>Summary</p> <p>The Opposer filed an opposition against TM Möbius Reg. No. 1514875 owned by the Applicant. The Intellectual Property Office (IPO) considering no conflict between the two parties' trademarks made an Opposition Unfounded Decision. The Opposer in disagreement with the decision instituted an administrative appeal with the Ministry of Economic Affairs (MOEA). After examination, the MOEA in the administrative appeal decision on basis of the similarity between the two trademarks determined "the original decision is hereby cancelled; the original deciding agency (IPO) should make a proper decision instead". The IPO following the administrative appeal decision made a fresh decision. As the Applicant did not institute an administrative appeal against the decision, cancellation of the disputed trademark is ascertained.</p> |
| IP advisers from your firm involved: | <p>林志剛律師/專利師 楊憲祖律師/專利代理人 黃闡億律師/專利代理人 J.K. LIN, Attorney-at-Law / Certified Patent Attorney Rick S.T. YANG, Attorney-at-Law / Certified Patent Agent Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Agent</p> |
| Other IP firms involved: | N/A |
| Date(s) | <p>2012.07—提出異議 2013.07—智慧財產局為異議不成立之處分 2013.08—提起訴願 2014.02—經濟部為「原處分撤銷，由原處分機關另為適法之處分」之訴願決定 2014.05—智慧財產局為系爭商標之註冊應予撤銷之處分</p> <p>Calendar July 2012 – Opposition filed July 2013 – Opposition Unfounded Decision made by the IPO August 2013 – Administrative appeal filed February 2014 – Administrative appeal decision concluding "the original decision is hereby cancelled; the original deciding agency (IPO) should make a proper decision instead" made by the MOEA May 2014 – Decision to cancel the disputed trademark registration made by the IPO</p> |
| Why was it important? | <p>本案爭點為系爭商標與據以異議商標近似程度如何？二者指定商品是否構成類似？系爭商標有無致相關消費者產生混淆誤認之虞？智慧財產局原處分認為，系爭商標外文「Mobius」之字型外觀略有設</p> |

計，並於外文字母「O」上方置有外觀類似橫列之阿拉伯數字「8」，至據以異議商標外文字型則為印刷字體，兩者予消費者第一印象之外觀字型上寓目有別，雖然構成近似，惟予人之整體印象尚有可區辨之處，又，本件系爭商標所指定使用之「工業用蠟；棕櫚蠟；石蠟；地蠟；蜂蠟；白蠟；蠟；皮帶用蠟」商品，與據以異議商標指定使用之「工業用油及油脂，鐘錶、縫紉機及腳踏車用潤滑油，人造油、天然油、天然油脂、微機械工業用潤滑油」商品相較，前者主要為應用在蠟燭、潤滑劑、蠟筆、紙塗佈劑、地板清潔劑、防水劑、食品包裝材料、電線電纜絕緣及化妝品原料等方面之工業用途上，而後者則主要用於各種類型機械上，主要起潤滑、冷卻、防銹、清潔、密封和緩沖等作用，兩者商品性質用途不同，兩者類似關係之程度極低，系爭商標應無使相關消費者產生混淆誤認之虞，而為異議不成立之處分。惟經濟部訴願決定認為，二造商標均以外文「mo」起首而以「bius」結尾，二者僅有細微差異，且系爭商標外文字母「o」上方所結合之符號「∞」，易使人認為是德文字母「ö」，而「ö」於德文中表示變音字母「oe」，故系爭商標圖樣之讀音即為「moebius」，與據以異議商標之圖樣「MOEBIUS」相同，二造商標近似程度難謂不高，又，二造商標指定使用商品相較，二者原料常有共同之處，如石蠟與潤滑油均屬石油產品，且均具有潤滑之共通功能，在用途、功能、原材料、產製者、行銷管道及場所等因素上具有共同或關聯之處，應屬構成同一或類似之商品，再者，據以異議商標之外文「MOEBIUS」，與其指定之工業用油及油脂等商品無直接關聯，應具相當識別性，他人稍有攀附，即可能產生混淆誤認，因此，系爭商標應有使相關消費者誤認兩造商標商品或服務係來自同一來源或雖不相同但有關聯之來源，而有混淆誤認之虞，因而為「原處分撤銷，由原處分機關另為適法之處分」之訴願決定。智慧財產局遂依訴願決定意旨重為處分，以相同理由認定二造商標相衝突，而為系爭商標之註冊應予撤銷之處分。

Main Issues

The main issues for the instant case are how similar the disputed trademark and the cited trademark are, whether or not the two parties' designated goods are similar, and whether or not it is likely to cause confusion to relevant consumers.

The IPO in the Opposition Unfounded Decision reasoned that the disputed trademark slightly designed contains "∞" above the letter O while the cited trademark is just in plain block letters; they bring different impression in typeface; their entireties can be distinguished; comparing the designated "industrial wax; carnauba wax; paraffin; ozokerite; beeswax; white wax, wax; belt wax" of the disputed trademark with "industrial oils and greases, lubricants for clocks and watches, sewing machines and bicycles, synthetic oil, natural oil, natural grease, lubricants for micromechanic industry" of the cited trademark, the former are for candles, lubricants, floor cleaning, food packaging, wire/cable insulation and cosmetics while the latter are mainly used on machinery for lubricating, cooling, anti-rusting, cleaning, sealing etc., which differ in nature and utility; as the level of similarity between the two parties' trademarks is low, the disputed trademark could not cause confusion and misidentification to relevant consumers. However, the MOEA

opined that both parties' trademarks start with "mo" and end with "bius"; they are slightly different in the middle "e" and typeface; the O with the tiny "∞" on the top looks like the German Ö meaning "oe" in the distance; the sound of the disputed trademark is exactly the same as the cited "MOEBIUS"; it is hard to say that the level of similarity is not high; Comparing the designated goods of the two parties' trademarks, for instance, paraffin and lubricant are from petroleum and have the same function, they have something in common or in connection in nature, utility, usage, material, sales channels and places; they should be considered the same or similar goods; the cited TM "MOEBIUS" not directly connective with "industrial oils and greases" should be quite distinctive; the disputed trademark would cause relevant consumers to misidentify the two parties' goods as those from the same or related source so as to cause confusion and misidentification; therefore, the original decision made by the IPO should be revoked and the original deciding agency (IPO) should render an appropriate decision instead. Following the administrative appeal decision, the IPO made a fresh decision deciding that the two parties' trademarks are conflicting and the disputed trademark registration should be cancelled.

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