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TIPLO Outstanding work on Litigation Case (2016.9)

Example work 1

<p>Name and brief description of case/portfolio:</p>	<p>一台灣製鞋公司及其經銷商，未經客戶即美商商標權人之同意或授權，擅自委託中國大陸工廠生產仿冒使用近似於客戶在台灣註冊商標之運動鞋，然後輸入來台灣，由其經銷商在各大賣場銷售。客戶先對該經銷商之負責人及賣場負責人提出違反商標法之刑事告訴，遽遭不起訴處分確定後，客戶再向智慧財產法院對該台灣製鞋公司、其經銷商及兩家公司之負責人（以下合稱：侵權人）提出商標侵害之民事訴訟，該院第一、二審判決上開兩家公司及其負責人侵害客戶之商標權，而侵權人不服，已向最高法院提起上訴，目前正由最高法院審理中。</p> <p>A Taiwanese shoe manufacturer and its distributor, without the prior consent or due authorization from our client, a US-based sport shoe maker, entrusted a factory in China to manufacture sports shoes bearing a mark similar to the client's Taiwanese registered trademark and imported the subject sports shoes into Taiwan for sale by its distributor in the shopping malls in Taiwan. The client first filed a criminal complaint asserting Trademark Act violation against the responsible person of the distributor and the shopping mall involved, respectively. However, the prosecutor did not indict the two responsible persons and the non-indictment decision then became final. After that, the client further initiated a civil action with the IP Court to assert trademark infringement against the Taiwanese shoe manufacturer, the distributor, and the respective responsible person thereof (hereinafter collectively referred to as the "infringers"). The IP Court adjudicated on this civil case in the first and second instances by establishing the occurrence of trademark infringement by the infringers. The IP Court's adjudication dissatisfied the infringers and thus the infringers appealed this case to the Supreme Court and the appeal is now pending at the Supreme Court.</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 C. C. Liu, Attorney-at-Law and Certified Patent Attorney T. T. Wu, Attorney-at-Law and Certified Patent Attorney</p>
<p>Other IP firms</p>	<p>N/A</p>

involved:	
Date(s)	<p>刑事案件：</p> <p>2012.11：警方取締賣場及經銷商處，查扣運動鞋仿品數量達 2600 多雙，並移送刑事偵查機關偵辦。</p> <p>2013.05：收受不起訴處分。</p> <p>2013.07：收受發回續偵通知。</p> <p>2014.01：收受不起訴處分。</p> <p>2014.03：收受高檢署駁回客戶之再議聲請。</p> <p>2014.06：收受法院駁回客戶之交付審判聲請（不起訴處分確定）。</p> <p>民事訴訟：</p> <p>2014.09：向智財法院起訴請求排除侵害及損害賠償。</p> <p>2015.06：智財法院第一審判決商標權人全部勝訴。</p> <p>2016.05：智財法院第二審判決駁回侵權人之上訴。</p> <p>2016.06：侵權人向最高法院提起上訴中。</p> <p>Criminal Case:</p> <p>2012.11: A raid action initiated by the police on the premises of the shopping mall involved and distributor with 2,600 and more pairs of counterfeit sports shoes seized and this case being referred to the relevant prosecutors office for investigation.</p> <p>2013.05: A non-indictment decision received.</p> <p>2013.07: A notice received with respect to this case remanded back to the prosecutors office for reinvestigation.</p> <p>2014.01: A non-indictment decision received.</p> <p>2014.03: Taiwan High Prosecutors Office's decision received that dismissed the client's request for reconsideration of the non-indictment decision.</p> <p>2014.06: Court's ruling received that denied the client's request for setting the case for trial (non-indictment decision being finalized).</p> <p>Civil Case:</p> <p>2014.09: A civil action initiated with the IP Court for seeking infringement removal and claiming damages.</p> <p>2015.06: IP Court's first-instance decision rendered in favor of the client in all aspects</p> <p>2016.05: IP Court's second-instance decision rendered to dismiss the infringers' appeal.</p> <p>2016.06: Infringers appealing this case to the Supreme Court.</p>
Why was it important?	<p>1. 按客戶在台灣擁有系爭第 751720 號  商標及第 1287752 號  商標，指定使用在運動鞋等商品，屬著名商標。侵權人於客戶系爭商標申請或註冊之後，始申請及註冊取得第 1370394 號  (NITIAU) 商標權，且侵權人並未依其註冊商標使用，其實際使用於運動鞋上之圖樣，整體上凸顯 N 圖樣，與客戶系爭商標構成近似，客戶依違反商標法提起刑事告訴，刑事偵查機關認定無構成商標近似及侵權人有註冊取得上述 NITIAU 商標權，故無犯罪故意，而為不起訴之處分，經客戶聲請再議等以為救濟，最後仍不起訴處分確</p>



定。


2. 嗣客戶向專辦 IP 爭議事件之智財法院對侵權人提起排除侵害及損害賠償之民事訴訟，主要爭點：

- 侵權人實際使用於運動鞋上之圖樣與客戶系爭商標是否構成近似，並有致相關消費者產生混淆誤認之虞？
- 侵權人有無故意或過失？
- 請求侵權人負損害賠償責任是否有理由？得請求之損害賠償金額為何？

智財法院不受刑事訴訟調查證據及認定事實之拘束，且不採信侵權人答辯其實際使用於運動鞋上之圖樣具有同一性，其係善意註冊，並依其註冊商標使用，故無故意或過失等語，智財法院第一、二審均判決認定侵權人實際使用於系爭運動鞋商品上之圖樣，與客戶系爭商標構成近似，並有致消費者混淆誤認之虞，且認定侵權人具有故意或過失，而為客戶勝訴之判決。

3. 商標權人對侵權人提起違反商標法之刑事告訴，係向各地方法院檢察署提起，各地檢署檢察官並非專辦 IP 案件，且刑事案件就主觀要件之認定嚴格，依本件案例可知，縱經刑事案件敗訴後，商標權人可依個案向有處理 IP 爭議經驗之智財法院對侵權人提起民事訴訟，仍有機會取得勝訴判決。

1. The client owns and holds the Taiwanese registrations for the “” mark under Reg. No. 751720 and the “” mark under Reg. No. 1287752 (hereinafter the “subject marks”), which are designated for used on sports shoes and amount to well-known trademarks.

The infringers successfully applied and registered the “” mark (hereinafter the “NITIAU mark”) under Reg. No. 1370394 after the subject marks’ applications and registrations. Moreover, the mark used by the infringers on their sports shoes (hereinafter the “NITIAU shoes”) was not exactly the same with the registered NITIAU mark. The mark used on the NITIAU shoes as a whole bore resemblance to the client’s subject marks due to its “N” device that stands out as the most conspicuous part, for which the client filed a criminal complaint asserting Trademark Act violation. The prosecutors office did not indict the infringers on the grounds that the mark used on the NITIAU shoes was not similar to the client’s subject marks and the infringers did not hold the intent for infringement due to the successful registration of the NITIAU mark. The non-indictment, however, still became final after the client’s requests for reconsideration of said decision and for setting the case for trial.

2. Further, the client initiated a civil action with the IP Court (specializing in handling and hearing IP-related disputes) to seek infringement removal and claim damages. The main disputed issues of this civil case were:

- Whether the mark used by the infringers on the NITIAU shoes was similar to the subject marks and whether it caused confusion with the subject marks among relevant consumers?
- Whether the infringers commit infringement out of intent or by

	<p>negligence?</p> <ul style="list-style-type: none"> ● Whether it is a well-grounded claim against the infringers for paying damages and what is the claimable amount of damages? <p>Without being subject to the investigation result and determinations made in the criminal proceedings and without taking the infringers' defensive arguments that the mark used on the NITIAU shoes has sameness with the registered NITIAU mark, that the registration of the NITIAU mark is a bona fide one, that they use the registered NITIAU mark on the shoes so they did not commit infringement either out of intent or by negligence, the IP Court rendered the first-instance and second-instance judgments in favor of the client by establishing and affirming the similarity between the mark used on the NITIAU shoes and the client's subject marks, the likelihood of confusion among consumers, and also the infringers' infringement out of intention or by negligence. The client has a prevailing victory in this civil case.</p> <p>3. The client filed the criminal complaint asserting Trademark Act violation with the district prosecutors office, but the district prosecutors office is not specialized in handling IP-related cases and subjective conditions have been more strictly examined and determined in criminal cases. This case provides an example that a trademark owner still has favorable chance of acquiring a favorable judgment by initiating a civil action with the IP Court which is more specialized in IP-related disputes, even if he/she loses a criminal case in respect of trademark disputes.</p>
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Example work 2

<p>Name and brief description of case/portfolio:</p>	<p>本件商標權人「OO 公司」之「富蘭克林」商標經臺灣經濟部智慧財產局 2000 年 12 月 1 日註冊公告，指定使用於第 36 類(財務與投資顧問服務、共同基金投資服務等)。嗣本所客戶於 2001 年設立「台北富蘭德林諮詢有限公司」，並分別於 2003 年 5 月 16 日及同年 12 月 1 日取得第 179811 號及第 189050 號「富蘭德林」商標核准註冊生效，分別指定使用於第 35 類(工商管理協助、企業管理顧問等)、第 41 類(各種書刊、雜誌等)。「OO 公司」以其商標權受侵害為由，起訴請求「台北富蘭德林諮詢有限公司」變更公司名稱，並請求本所客戶不得使用或授權他人使用「富蘭德林」，或其他近似於「富蘭克林」的商標，於同一或類似於「富蘭克林」商標之商品或服務。</p> <p>法院認為兩造之商標的整體外觀、讀音、觀念均有差異，屬近似程度不高的商標。而「富蘭克林」商標指定使用之第 36 類商品或服務與第 179811 號「富蘭德林」商標指定使用於第 35 類商品或服務，二者雖均屬財務管理服務，屬類似之服務，但因「富蘭克林」商標係使用於境外基金商品，而本所客戶主要業務是從事台商的企業顧問諮詢服務，兩商標行銷管道已有區別，類似之程度不高；至於第 189050 號「富蘭德林」商標所指定使用之第 41 類商品，則與「富蘭克林」商標指定的商品及服務全無關聯。且兩造之商標已經併存相當之時間，均為相關消費者所熟悉，並無混淆誤認之虞，基於上述理由，法院認</p>
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定本所客戶使用「富蘭德林」商標並無構成原告所主張的商標法的 70 條第 1 款減損「富蘭克林」商標識別性的情形。

另外，法院認為本所客戶「台北富蘭德林諮詢有限公司」的公司名稱特取部分「台北富蘭德林」與「富蘭克林」文字不相同，並不構成違反該公司設立時(86 年)商標法第 65 條之規定，故該請求本所客戶變更公司名稱之主張為無理由。

基於以上分析，本所客戶獲得全部勝訴判決，目前對造上訴二審審理中。


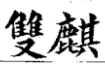

In the trademark dispute, Company X owns and holds the Taiwanese registration for the four Chinese characters mark “富蘭克林” (hereinafter “Company X’s mark”). The registration of the subject mark was published on December 1, 2000 and the mark is designated for use on products/services under Class 36 (finance and investment consulting services, and mutual fund investment services, etc.). Our client has incorporated the company, 台北富蘭德林諮詢有限公司 (registered English company name: Friendly Consulting and Trading Ltd.) since 2001 and has also successfully registered the four Chinese characters mark “富蘭德林” under Reg. No. 179811 and Reg. No. 189050 on May 16, 2003 and December 1, 2003, respectively, (hereinafter the “marks in dispute”) which are designated for use on products/services under Class 35 (commercial and industrial management assistance and enterprise management consulting, etc.) and Class 41 (books and magazines, etc.). Company X initiated a civil action with IP Court to assert trademark infringement against the client, claiming in the action that the client should change the Chinese company name “台北富蘭德林諮詢有限公司” and also that the client should not use or authorize any other person to use the marks in dispute (namely, the four Chinese characters mark “富蘭德林”) or any other mark similar to them on any products or services identical or similar to the designated products or services of the marks in dispute.

In this civil action, the IP Court determined that Company X’s mark and the marks in dispute are not similar to a high extent because of their difference in appearance, pronunciation, and concept. The IP Court made the foregoing determination based on the reasoning: (1) The marketing channels of Company X’s mark and the marks in dispute are different because Company X’s mark is used in relation to offshore fund products, while the client is mainly engaged in the business of providing consulting services to Taiwan-based enterprises that run business in China, even though the respective designated products/services of Company X’s mark (Class 36) and the mark in dispute under Reg. No. 179811 (Class 35) are both covered under the category of financial management services and thus are similar, (2) the designated provides/services of the mark in dispute under Reg. No. 189050 (Class 41) are irrelevant to those of Company X’s mark, and (3) Company X’s mark and the client’s marks in dispute have been coexisting for a certain period of time and also have been respectively well-known to relevant consumers, and thus there should be no occurrence of confusion existing

	<p>between Company X's mark and the client's marks in dispute. Based on the foregoing reasoning, the IP Court determined that the client's use of the four Chinese characters mark “富蘭德林” does not dilute the distinctiveness of Company X's mark “富蘭克林” as claimed by Company X in accordance with the 1st subparagraph of Article 70 of the Taiwan Trademark Act.</p> <p>In addition, the IP Court also held that the specific part, “台北富蘭德林” of the Chinese company name “台北富蘭德林諮詢有限公司” is different from Company X's mark “富蘭克林”, and thus the client's use of the said Chinese company name does not constitute violation of Article 65 of the Taiwan Trademark Act (amended in 1997) applicable at the time when the client's company was incorporated. Therefore, it is groundless for Company X to demand for the client's change of the Chinese company name.</p> <p>The client wins this civil case in all aspects. Thus, Company X appeals this case to the second instance, and the appeal is now pending.</p>
IP advisers from your firm involved:	<p>陳和貴律師 蘇芳儀律師 莊敬文律師 H. G. Chen, Attorney-at-Law and Certified Patent Attorney Bonnie Su, Attorney-at-Law Win Chuang, Attorney-at-Law</p>
Other IP firms involved:	N/A
Date(s)	<p>103.12.29 起訴 104.5.12 第一次開庭 105.1.12 第五次開庭(言詞辯論) 105.2.3 宣判 2014.12.29: Civil action initiated. 2015.5.12: 1st hearing held. 2016.1.12: 5th hearing held (oral argument sessions). 2016.2.3: Adjudication</p>
Why was it important?	<p>1. 再次重申關於公司名稱之擬制商標侵害案件，著名商標權人請求排除侵害的公司名稱必須同時違反該公司設立時之商標法及現行商標法關於「公司名稱」擬制商標侵害之規定，才能准予著名商標權人請求他方變更公司名稱。此外，如果他人公司設立登記時，據以主張之著名商標尚未成達著名程度，或他人並非以相同之商標文字作為公司名稱，商標權人不得請求他人變更公司名稱。</p> <p>2. 法官雖指出兩造商標所指定使用之商品或服務構成類似，但認為類似程度不高，行銷管道不同，消費族群不同，消費者仍足以區別兩造商標所表徵之商品或服務的來源。因此，本案見解認為實際交易市場上並無發生混淆誤認之可能。</p> <p>With respect to trademark infringement by company name, the request filed by the owner of a well-known trademark for any other company's change of company name will be granted when and only when the alleged infringing company name of the company involved,</p>

	<p>against which the owner seeks infringement removal, violates the provisions with respect to trademark infringement by “company name” of Taiwan Trademark Act applicable at the time when the said company was incorporated and also the same Act currently applicable.</p> <p>However, the owner of a well-known trademark will have no legal basis to request for company name change by any other person if the alleged well-known trademark had not been well-known enough at the time when the said other person’s company was established or if the said other person does not use the words identical to those of the well-known trademark as company name.</p> <p>Notwithstanding the judge’s holding that the respective designated products or services of Company X’s mark and the marks in dispute are similar, the judge sees a lesser degree of similarity because of the differences between Company X’s mark and the marks in dispute in their respective marketing channels and consumers, and thus relevant consumers are able to distinguish the respective origins of the products or services provided under Company X’s mark and the marks in dispute. Therefore, the court ruled that there is no such occurrence of confusion on market.</p>
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Example work 3

<p>Name and brief description of case/portfolio:</p>	<p>(商標授權合約終止後請求損害賠償事)</p> <p>客戶為第 00193832 號「雙麒及圖 UNICORN」商標之商標權人，另經客戶之關係企業同意後，由客戶將上開商標以及客戶關係企業取得之第 00393309 號「龍馬獸圖」商標一併授權予○○公司使用，因此客戶與○○公司於 2010 年 8 月 31 日簽署商標授權合約，授權期間自 2011 年 6 月 1 日起至 2016 年 5 月 31 日止，授權使用範圍為內衣褲成衣商品。此外，經客戶要求後，第三人△△同意就○○公司履行系爭商標授權合約範圍內擔任○○公司之連帶保證人。</p> <div style="text-align: center;">  <p>第 00193832 號  「雙麒及圖 UNICORN」商標</p> </div> <div style="text-align: center;">  <p>第 00393309 號 「龍馬獸圖」商標</p> </div> <p>唯因○○公司於授權期間內違反系爭商標授權合約內之條款，客戶因此於 2013 年 3 月 30 日委託本所寄發律師函予○○公司表示終止商標授權合約，另於 2015 年 3 月 30 日委託本所對○○公司以及第三人△△提起民事訴訟，主張因可歸責於○○公司之因素而終止商標授權合約後，因此致客戶於合約終止後喪失對○○公司收取剩餘三年授權權利金即新</p>
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台幣 378 萬元之利益，而客戶暫先就新台幣 100 萬元之範圍內請求○○公司以及第三人△△對客戶負損害賠償賠償責任。

法院認為○○公司於商標授權期間有違反商標授權合約第 11-2 條第(1)、(2)項、第 4-9 條、第 5 條、第 7-3 條(即業績未達標準、未結算營業額以及超額權利金、未提供銷售業務資料、商品包裝設計未經客戶審核)之情事，而客戶因○○公司有上開違約情事而終止系爭商標授權合約，導致客戶自 102 年 6 月起連續 3 年度喪失對○○公司收取最低權利金之利益達 378 萬元，此屬於客戶之所失利益，故○○公司以及第三人△△當應對客戶負賠償責任，並判決○○公司以及第三人△△應給付新台幣 100 萬元予客戶。

(Claim for damages after termination of a trademark license agreement)

Our client owns the Taiwanese registration for the trademark consisting of two Chinese characters “雙麒”, “UNICORN” and two lions device under Reg. No. 00193832 (as shown below, hereinafter the “subject mark”). After obtaining its affiliate’s consent, the client granted a license to Company X for the company to use both the subject mark and the affiliate’s registered unicorn device mark under Reg. No. 00393309 (as shown below, hereinafter the “subject device mark”), for which license the client executed a trademark license agreement with company X on August 31, 2010. The term of license commenced from June 1, 2011 through May 31, 2016 and the scope of license covered underwear and underpants. Besides, upon the client’s request, a third person agreed to act as the joint guarantor for Company X with respect to its performance of the said trademark license agreement.

Reg. No. 00193832  mark (the subject mark)

Reg. No. 00393309  mark (the subject device mark)

Due to Company X’s breach of the provisions of the said trademark license agreement during the term of license, our firm was retained by the client to issue an attorney letter to Company X on March 30, 2013 to terminate the said trademark license agreement. Further on March 30, 2015, our firm represented the client to initiate a civil action against Company X and the third person, claiming that the client suffered profit loss in an amount of TWD3,780,000, namely the royalties the client had not received from Company X for the remaining three years after termination of the said trademark license agreement due to the reason attributable to Company X. The client temporarily claimed damages in an amount of TWD1 million against Company X and the said third person guarantor.

	<p>The court held that Company X during the term of license breached paragraph (1) and (2) of Article 11-2, Article 4-9, Article 5, and Article 7-3 of the said trademark license agreement (with respect to failure to meet the sales performance standards, non-closed sales amount and excess royalty, and failure to provide sales information, and failure to seek the client's approval of product packaging design), and that the client indeed suffered profit loss caused by the fact that the client terminated the said trademark license agreement due to Company's breach of the said agreement and thus the client had not received the least royalty for three years beginning from June 2013 in an total amount of TWD3,780,000. Based on the foregoing holding, the court determined that Company X and the said third person should be held liable for the client's loss and should pay TWD1 million to the client.</p>
<p>IP advisers from your firm involved:</p>	<p>陳和貴律師 吳宗樞律師 H. G. Chen, Attorney-at-Law and Certified Patent Attorney C. H. Wu, Attorney-at-Law</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2015 年 3 月 30 日：提起民事訴訟。 2015 年 7 月 2 日：進行準備程序。 2015 年 7 月 27 日：進行第一次言詞辯論程序。 2016 年 1 月 11 日：進行第六次言詞辯論程序(辯論終結)。 2016 年 2 月 5 日：宣判。 2015.3.30: Civil action initiated. 2015.7.2: Preparatory proceedings held. 2015.7.27: 1st oral argument sessions held. 2016.1.11: 6th oral argument sessions held (oral argument sessions concluded). 2016.2.5: Adjudication.</p>
<p>Why was it important?</p>	<p>客戶曾委託本所對○○公司負責人提起刑事告訴，主張○○公司於商標授權合約終止後仍繼續使用授權商標，因此有侵害商標權之罪行。惟檢察官經調查後雖認為○○公司於商標授權合約終止後並未繼續使用授權商標，而對○○公司負責人為不起訴處分，但本所嗣後仍幫助客戶於民事上請求○○公司負民事上之損害賠償責任，以取得商標授權合約終止後○○公司原應給付客戶而未給付之授權金。</p> <p>For the above matter, the client had also authorized our firm to file a criminal complaint against the responsible person of Company X for Company X's trademark infringement by continuing using the licensed trademark after termination of the said trademark license agreement. The prosecutor, however, held that Company X did not continue using the licensed trademark after termination of the said trademark license agreement and thus did not indict the responsible person of Company X. Regardless of the unsuccessful criminal complaint, our firm still sought to represent the client to recover its damages in civil aspects by regaining the royalties payable by Company X to the client even after termination of the said agreement.</p>

Example work 4

<p>Name and brief description of case/portfolio:</p>	<p>(證據保全)</p> <p>客戶為系爭發明專利之專利權人，專利權期間自 2013 年 1 月 1 日起至 2025 年 11 月 20 日止。客戶就系爭專利於 2005 年 11 月 21 日向經濟部智慧財產局提出專利申請後，即開始製造使用系爭專利之產品並銷售予位於中國之第三人。惟因第三人自 2012 年 11 月起即停止對客戶訂貨及購買產品，經客戶自行調查後發現第三人改向○○公司訂購 A 產品。此外，客戶由○○公司之中國代理商處取得 A 產品後，經過自行評估認為 A 產品屬侵害系爭專利之產品。</p> <p>為向法院釋明 A 產品後認為屬侵害系爭專利之產品，客戶委託本所於台灣找尋適當之鑑定人進行專利侵害鑑定，經鑑定人鑑定後出具 A 產品侵害系爭專利之專利侵害鑑定報告。</p> <p>客戶同時對○○公司寄發警告函，主張○○公司有涉嫌侵害系爭專利之情事等語，惟○○公司回函表示該公司確有在台灣生產 A 產品並販賣予在中國之第三人，但該公司在中國並無代理商，因此客戶所謂由○○公司中國代理商處取得之 A 產品屬於仿品，同時亦拒絕提出 A 產品予第三公正機關進行專利侵害鑑定。</p> <p>鑑於客戶對○○公司提起民事侵害專利權訴訟後，因 A 產品之銷售對象位於中國，法院難以命第三人提出 A 產品，因此○○公司勢必繼續爭執客戶取得 A 產品之真實性、否認侵害事實及範圍、拒絕提出全部或部分 A 產品以及相關文書銷售資料，致難以證明侵害專利權之事實以及損害賠償範圍，客戶因此委託本所向智慧財產法院聲請證據保全。</p> <p>第一審法院以鑑定人出具之專利侵害鑑定報告說明不夠完全為由，駁回客戶證據保全之聲請。惟經本所代客戶向第二審提起抗告，並同時(1)請求鑑定人提出補充說明，(2)由本所加強說明本件難以用通常方法取得 A 產品、A 產品有滅失或礙難使用之虞、保全 A 產品有時間上之急迫性、就確定 A 產品銷售情況之現狀有法律上利益且有必要等事由後，第二審法院准許客戶為保全證據之聲請。</p> <p>(Perpetuation of evidence)</p> <p>The client owns the invention patent with the patent term thereof beginning from January 1, 2013 through November 20, 2025 (hereinafter the "subject patent"). After filing a patent application for the subject patent with the Taiwan IPO on November 21, 2005, the client had practiced the subject patent to manufacture products for sale to a third person in China. The said third person, however, had stopped ordering and purchasing products with the client since November 2012, which caused the client to voluntarily conducted investigation on this matter and found that the said third person turned to Company X to purchase product A. Further, the client obtained a sample of product A from the Chinese distributor of Company X to conduct evaluation thereon and concluded that</p>
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	<p>product A infringed upon the subject patent.</p> <p>For substantiating to the court the alleged infringement upon the subject patent, the client retained our firm's services to find an appropriate institutional expert for identifying the existence and non-existence of the alleged patent infringement, and the institutional expert issued a patent infringement analysis report identifying and confirming the existence of the alleged infringement by product A upon the subject patent.</p> <p>The client issued a cease and desist letter to Company X, indicating therein that Company X was suspected of infringing upon the subject patent. Company X made a formal reply that they indeed manufactured product A in Taiwan and sold it to a third person in China, but they had no authorized distributor in China, and in this regard, the sample the client obtained from the so-called Chinese distributor of Company X was a counterfeit instead; Company A also refused to provide product A for the third impartial institutional expert to conduct patent infringement analysis.</p> <p>The client thus planned to initiate a civil action asserting patent infringement against Company X. There is, however, a difficulty lying in the fact that product A is manufactured for sale in China and thus the Taiwan court does not have legal basis to order the said third person to produce product A; in this regard, it is predictable that Company X keeps challenging the authenticity of product A obtained by the client and further denying the alleged patent infringement and the scope of infringement and also refusing to provide product A and relevant document or information in whole or in part. The foregoing makes it difficult to prove the occurrence of the alleged infringement and the amount of damages, and thus the client authorized our firm to file a motion with the IP Court for having the evidence perpetuated.</p> <p>The court of the first instance rejected the client's motion for evidence perpetuation on the ground that the submitted patent infringement analysis report provided no complete explanations. Our firm represented the client to file an interlocutory appeal in the second instance proceedings. At the same time, for successfully having the evidence perpetuation motion granted, our firm also (1) requested the institutional expert to provide supplemental explanations and (2) emphasized to the court, for the difficulty in obtaining product A in usual ways, the likelihood that product A may be destroyed or its use in court may be difficult, the urgency in time, and also the legal interests in ascertaining the status quo of product A with respect to its sale, so that the court of the second instance granted the motion.</p>
<p>IP advisers from your firm involved:</p>	<p>陳和貴律師 楊益昇律師 吳宗樺律師 H. G. Chen, Attorney-at-Law and Certified Patent Attorney Y. S. Yang, Attorney-at-Law</p>

	C. H. Wu, Attorney-at-Law
Other IP firms involved:	N/A
Date(s)	2016年4月25日：聲請保全證據。 2016年5月5日：第一審法院駁回聲請。 2016年5月27日：提起抗告。 2016年7月25日：第二審法院廢棄原裁定，准許保全證據之聲請。 2016.4.25: Motion for perpetuation of evidence filed. 2016.5.5: Motion denied by the court of the first instance. 2016.5.27: Interlocutory appeal filed. 2016.7.25: Motion for perpetuation of evidence granted by the court of the second instance.
Why was it important?	客戶無法透過市場取得證據且難以說明目前取得證據之來源，因此侵權人將來於本案訴訟中勢必爭執證據是否具有證明力。本所幫助客戶於起訴前尋找適當之鑑定人出具專利侵害之鑑定報告並聲請證據保全，以確保後續本案訴訟取得有利之訴訟或談判優勢。 Due to the facts that the client could not obtain the necessary evidence on the market and it was difficult to explain about the source from which the client obtained the evidence, the infringer would necessarily challenge the admissibility of the evidence submitted by the client in the proceedings. In this case, our firm successfully assisted the client in finding an appropriate institutional expert to issue a patent infringement analysis and filing a motion for evidence perpetuation in the pre-action proceeding, so as to put the client in the strategically favorable position both in the action and also in negotiation.

Example work 5

Name and brief description of case/portfolio:	一日本大型工業運輸及儲存機具製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本大型運輸、儲存工業機具製造商（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）。舉發人嗣後向經濟部訴願審議委員會提起訴願，目前正由經濟部訴願審議委員會審理中。 A Japanese manufacturer of large-size industrial moving and storing machinery sought for invalidation of a Taiwanese patent owned by a fellow member in the trade based in Japan as well (and our client). Taiwan IPO decided and held the invalidation sought for untenable. The invalidation requester appealed the decision to the Appeal Board, Ministry of Economic Affairs, which appeal is pending decision by the Appeal Board.
IP advisers from your firm involved:	林志剛律師/專利師 高山峰專利師 廖文慈律師/專利師 李盈德工程師 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 LI Ying-Der, Patent Engineer
Other IP firms	N/A

involved:	
Date(s)	<p>2014.09：被提起舉發 2014.11：被舉發答辯&申請更正 2015.09：對造提舉發補充理由 2015.11：被舉發補充答辯 2016.01：對造提舉發補充理由 2016.03：被舉發補充答辯 2016.07：智慧局作成舉發不成立之處分</p> <p><u>Timeline (yy.mm):</u> 2014.09: Request for invalidation filed. 2014.11: Patentee filed answer and a request for amendment. 2015.09: Invalidation requester supplemented reasons for seeking invalidation. 2015.11: Patentee filed written response. 2016.01: Invalidation requester presented a second statement of reasons for seeking invalidation. 2016.03: Patentee filed written response. 2016.07: Taiwan IPO decision issued holding the invalidation sought for untenable.</p>
Why was it important?	<p>1.系爭專利係關於一高架行走車系統（即搬運裝置）之發明專利。系爭專利之專利權人與舉發人係工業運輸及儲存機具業界之競爭廠商，製造舉發人於極為相近的時間內先後對本所客戶之二件不同的專利提出舉發，經本所答辯後，智慧局就二件舉發案均作成舉發不成立的處分，成功的為客戶於該技術領域維持獨占的權利。</p> <p>2.本案之舉發人提共出 12 項舉發證據。本案之爭點在於系爭專利請求項 1 中所界定之「設置於行走軌道下方的第 1 物品載置台（下部緩衝區）」之技術特徵是否已被諸引證案之組合揭露而不具進步性。由於系爭專利之技術發展至今已相當密集，因此諸舉發證據與系爭專利於技術內容上之差異相當小。但本所詳細解釋諸舉發證據與系爭專利於其各自之設計之區別及所能達成之功效上之差異，使審查委員充分理解彼此之差異。本所更提出若舉發人要舉出十多件引證案才能否定系爭專利的進步性，更足見系爭專利並非顯而易知，確實具進步性。</p> <p>3.此外，本所客戶於本案中為了迴避前案而進行申請專利範圍減縮式的更正。鑒於該更正之方式極為複雜，舉發人極力辯稱該更正已變更申請專利範圍之實質而不應准予更正。但是本所詳細的指出舉發人之主張錯誤之處，使智慧局最終作出准予更正之處分，使本所客戶成功的迴避前案。</p> <p>4.最終本所成功的說服智慧局，為客戶取得勝訴。</p> <p>1. The patent in issue is an invention on certain aerial moving car system (i.e. a moving device). Patentee and the invalidation requesters are competitors in the industry of manufacture of industrial moving and storing equipment. Invalidation requester in fact has sought for invalidation of two of the Taiwanese patents owned by patentee (our client) respectively, with one invalidation action followed shortly by the other, and both invalidations sought for were held untenable.</p> <p>2. Invalidation requester presented a total of 12 pieces of evidence.</p>

	<p>The challenge focused on whether or not the technical feature of the no. 1 article carrier installed under the moving rail (in the lower buffer part) as defined in claim 1 of the patent is readily disclosed by the cited arts combined and hence lacks inventive step. In light of the intensive successful results of relevant technical development, in terms of technical content, the cited arts each could be very narrowly different from the patent in issue. We nevertheless hinged our defense on the logic of design and the performance projected to achieve to convince the examiner of the technical distinction between our client's patent in issue and each of the cited prior arts. We also pointed out if it takes some dozen of cited prior arts combined to challenge the inventive step of the patent in issue, the patent in issue is obviously non-obvious.</p> <p>3. Further, on our advice, the patentee voluntarily requested for amending the patent with a view to securing it as a design-around patent. Due to the complexity of the amendment proposed, invalidation requester argued against a grant of our client's request for the amendment alleging that the amendment as proposed would substantially change the scope of claim. By detailing invalidation requester's mistaken belief, we successfully persuaded Taiwan IPO to grant the amendment sought for by our client and the patent in issue as amended sustains.</p>
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Example work 6

<p>Name and brief description of case/portfolio:</p>	<p>一日本大型工業運輸及儲存機具製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本大型運輸、儲存工業機具製造商（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）。舉發人已放棄向經濟部訴願審議委員會提起訴願，全案舉發不成立確定。</p> <p>A Japanese manufacturer of large-size industrial-purpose moving and storing machinery sought for invalidation of a Taiwanese patent owned by a fellow member in the trade based in Japan as well (and our client). The Taiwan IPO held the invalidation sought for untenable and the decision is final and binding as invalidation requester did not appeal the decision to the Appeal Board, Ministry of Economic Affairs.</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 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 LAI Shun-Tian, Patent Engineer</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2014.10：被提起舉發 2014.12：被舉發答辯&申請更正 2015.07：對造提舉發補充理由 2015.08：被舉發補充答辯 2015.09：對造提舉發補充理由</p>

	<p>2016.06：智慧局作成舉發不成立之處分 Timeline (yy.mm): 2014.10: Request for invalidation filed. 2014.12: Patentee filed answer and a request for amendment. 2015.07: Invalidation requester supplemented reasons for seeking invalidation. 2015.08: Patentee filed written response. 2015.09: Invalidation requester supplemented a second statement of reasons for seeking invalidation. 2016.06: Taiwan IPO's decision issued holding the invalidation sought for untenable.</p>
<p>Why was it important?</p>	<p>1.系爭專利係關於一高架行走車系統（即搬運裝置）之發明專利。系爭專利之專利權人與舉發人係工業運輸及儲存機具業界之競爭廠商，舉發人於極為相近的時間內先後對本所客戶之二件不同的專利提出舉發，經本所答辯後，智慧局就二件舉發案均作成舉發不成立的處分，成功的為客戶於該技術領域維持獨占的權利。</p> <p>2.本案之舉發人提共出 10 項舉發證據。本案之爭點在於系爭專利請求項 3（即新請求項 1）中所界定之「空架緩衝部是從行走軌道觀看，位在較上述進料口高的位置」、及「相對於行走軌道的行走方向，是在與上述進料口大致相同的位置，配置上述空架緩衝部」之二項技術特徵的結合而所能達成使空架行走車的行走方向的移動及升降台的升降方向的移動作成為必要最小限度，藉此可更容易且迅速地交接物品之功效，是否已被諸引證案之組合揭露而不具進步性。由於系爭專利之技術發展至今已相當密集，因此諸舉發證據與系爭專利於技術內容上之差異相當小。但本所詳細解釋諸舉發證據與系爭專利於其各自之設計之區別及所能達成之功效上之差異，成功的說服智慧局接受上述觀點，為客戶取得勝訴。</p> <p>1. The patent in issue is an invention on certain aerial moving car system (i.e. a moving device). Patentee and the invalidation requesters are competitors in the industry of manufacture of industrial moving and storing machinery. Invalidation requester in fact has filed two requests for invalidation one shortly after the other seeking invalidation of two of the Taiwanese patents owned by patentee, our client. Taking our statement presented in defense of our client's patent in issue, Taiwan IPO found both invalidations sought for by invalidation requestor untenable and our client's exclusive patent right sustains.</p> <p>2. Invalidation requester presented a total of 10 pieces of evidence. The challenge focused on whether or not the two technical features of (a) "the aerial buffer part as viewed from the rail sits at a position higher than the above feed inlet" and (b) "as relative to the direction of the way of the rail lies at substantially the same position as the above feed inlet" as defined in claim 3 (or post-amendment claim 1) of the patent both are readily disclosed by the cited arts combined and hence lacks inventive step in consideration of the function to be achieved by the combination of the said two technical features, which is to minimize to the extent possible the moving of the car along the way of the rail and the ascending/descending movement of the lift so to facilitate easy speedy exchange of the article(s) being moved. In light of the intensive</p>

	<p>successful results of relevant technical development, in terms of technical content, the cited arts each could be very narrowly different from the patent in issue. We nevertheless hinged our defense on the logic of design and the performance projected to achieve to convince the examiner of the technical distinction between our client's patent in issue and each of the cited prior arts. We also pointed out that if it takes some dozen of cited prior arts combined to challenge the inventive step of the patent in issue, the patent in issue is obviously non-obvious and inventive indeed.</p>
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Example work 7

<p>Name and brief description of case/portfolio:</p>	<p>一台灣自行車製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本自行製造商（本所客戶）之專利（N01）。案件由經濟部智慧財產局審理後作成舉發不成立的處分（本所客戶勝訴）。舉發人並放棄訴願。另一位舉發人又對相同之專利提出舉發（N02），目前正在智慧財產局審理中。</p> <p>A Taiwanese maker of bicycles sought for invalidation of a Taiwanese patent owned by a Japanese competitor (and our client) in the trade. Taiwan IPO held the invalidation sought for untenable ("N01 invalidation action") and our client's patent challenged stands. The invalidation requester did not appeal Taiwan IPO's above decision. The same patent was then challenged by another invalidation requester ("N02 invalidation action"), which invalidation action is pending decision by the Taiwan IPO.</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 李嘉宏組長 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 LI Jia-Hong, Senior Patent Engineer</p>
<p>Other IP firms involved:</p>	<p>N/A</p>
<p>Date(s)</p>	<p>2014.09：被提起舉發（N01） 2014.12：提呈被舉發答辯（N01） 2015.07：對造提補充理由（N01） 2015.10：提呈被舉發補充答辯（N01） 2016.05：智慧局作成舉發不成立之處分（N01） 2016.08：被提起舉發（N02）</p> <p><u>Timeline (yy.mm):</u> 2014.09: N01 invalidation action filed. 2014.12: Patentee presented answer to the invalidation sought for. 2015.07: Invalidation requester supplemented reasons for seeking the invalidation. 2015.10: Patentee presented written response. 2016.05: Taiwan IPO issued decision holding the invalidation sought for untenable. 2016.08: N02 invalidation action filed (by another invalidation requester).</p>

Why was it important?

系爭專利係關於一「自行車制動墊片」之發明專利。舉發人共提出 8 件舉發證據，但本所成功的反駁多件舉發證據的證據能力，有效的縮減了須進行答辯的對象及範圍。

本案之爭點在於諸舉發證據是否已揭露系爭專利之：「其中該第一寬度被定尺寸成始得該冷卻板件只有相應於該第一邊緣區段的端部才能被插入要安裝該自行車制動墊片的自行車制動卡鉗內，且該第二寬度被定尺寸成可防止該第二邊緣區段被插入該自行車制動卡鉗內」及「該冷卻板件與該多個熱散逸翼片成整體地形成為單一整體元件而在二者之間無任何的接縫或中斷」之技術特徵？本所詳盡的分析系爭專利與諸舉發證據於技術特徵上及所欲解決問題上之差異，使審查委員清楚的理解諸引證案與系爭專利之差別，並仔細的分析為何熟悉該項技術者不具將諸舉發證據加以組合以完成系爭專利之動機，且上開主張完全被智慧局接受，進而作成舉發不成立之處分。

於智慧局就作成舉發不成立之處分後（N01）相隔不到一個月，又被另一位舉發人提出舉發（N02），顯見本件專利相當重要。而 N02 正在智慧局審理中。

The patent in issue is an invention on bicycle active washer. The invalidation requester cited a total of 8 prior arts in the proceeding. We successfully disputed their evidentiary power and had them stricken one after another thereby effectively narrowing down the scope of the challenge.

The N01 invalidation action alleges this technical feature of the patent in issue is readily disclosed by Evidences : "...the cooling plate having a first width adjacent to the first edge section and a second width which is greater than the first width, wherein the first width is dimensioned such that only the end of the cooling plate corresponding to the first edge section can be inserted into a bicycle brake caliper to which the bicycle brake pad is to be installed and the second width is dimensioned to prevent the second edge section from being inserted into the bicycle brake calliper...." and ".....wherein the heat dissipation section includes a plurality of heat dissipating fins, the cooling plate and the heat dissipating fins being unitarily formed as a single monolithic element with no seams or interruptions there between...". We presented a detailed analytical comparison between the technical features and the problems to be solved by them of the patent in issue and those of the cited prior arts each to bring to light the distinction between the patent in issue and the cited prior arts. We also analyzed why a person skilful in the art would not be motivated to combine the cited prior arts to accomplish the patent in issue. Taiwan IPO taking our above defense as a whole held the N01 invalidation action untenable.

In less than one month after Taiwan IPO issued the above *Invalidation Untenable* decision, the patent in issue is under challenge again by another invalidation requestor (N02 invalidation action). Obviously, the patent in issue is an important invention in the industry. The N02 invalidation action is pending decision by the Taiwan IPO.

Example work 8

Name and brief description of case/portfolio:	<p>一德國之液晶材料製造商向經濟部智慧財產局申請舉發要求撤銷一德國公司之發明專利。智慧局審定舉發不成立（本所客戶勝訴）。</p> <p>A German maker of liquid crystal materials sought for the invalidation of a Taiwanese invention patent owned by a German company who is our client. The Taiwan IPO held the invalidation sought for untenable 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 Amy L.C. Chang, Patent Engineer</p>
Other IP firms involved:	<p>N/A</p>
Date(s)	<p>2015.04：被提起舉發 2015.05：提答辯理由&更正 2016.04：智慧局審定舉發不成立</p> <p><u>Timeline (yy.mm):</u> 2015.04: Invalidation action filed. 2015.05: Patentee presented answer and requested for amendment. 2016.04: Taiwan IPO issued decision holding the invalidation sought for untenable.</p>
Why was it important?	<p>本案係一液晶材料之發明專利，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（按：通常需 2~3 年）。本所成功且迅速的為客戶完整的維持專利的有效性。</p> <p>本案之爭點在於系爭專利所能達成之下述功效：「HR 下降較小、具有正性介電各向異性（高$\Delta\epsilon$）、具有高透明點、具有低黏度 γ_1、具有較高的彈性係數比（k_{33}/k_{11}）」等，是否係熟悉該項技術者依據證據 2、證據 3 所能預期？本所清楚的分析系爭專利與證據 2、證據 3 及其實施例於技術特徵上及所欲解決問題上之差異，並明確的指出證據 2、證據 3 為何無法達成本案所能獲致之功效。因此，審查委員清楚的理解諸引證案與系爭專利之差別，且智慧局認定舉發不成立理由，亦幾乎係全部援引本所之主張。顯見本所於被舉發答辯書中之陳述極具參考價值，促使審查委員決定於一年內即作成舉發不成立之處分。</p> <p>The patent in issue is an invention of certain liquid crystal material. We successfully won for our client an <i>Invalidation Untenable</i> decision issued by the Taiwan IPO within just one year after the invalidation action was filed while it normally takes 2~3 years for the Taiwan IPO to decide on an invalidation action. Further, our client's patent in issue stands intact.</p> <p>The focus of the challenge is whether or not a person skilful in the art may, based on Evidence 2 and Evidence 3, anticipate to accomplish such</p>

	<p>performance proposed to achieve by the patent in issue as is specified that " lower voltage holding ratio (HR), positive dielectric anisotropy (higher $\Delta\epsilon$), higher clearing point, lower viscosity γ_1, and a higher ratio of the elastic constants k_{33}/k_{11} etc." We presented a lucid analysis comparing the technical features of the patent in issue and the problems proposed to be resolved by them at work and those of Evidence 2 and Evidence 3, which comparison manifests that neither of Evidence 2 and Evidence 3 when put into practice is able to attain the same result as proposed and achieved by our client's patent. Given the established difference between the patent and the evidences, the invalidation sought for is held untenable. What is significant is that the Taiwan IPO has reasoned its decision based almost entirely on our statements presented to defend our client's patent, which fact attests the value of our strategy and statements presented as a whole as workable reference for the Taiwan IPO to be able to quickly decide on the invalidation in less than a year.</p>
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Example work 9

<p>Name and brief description of case/portfolio:</p>	<p>Trademark Opposition 帥浮錶 系爭商標：FWATCH 註冊號數：1505750 類別：35 指定服務：代理國內外廠商各種產品之經銷；代理進出口服務；網路拍賣；郵購；網路購物；錶零售批發；鐘零售批發；文教用品零售批發；皮包零售批發；皮件零售批發。 商標權人：瑞寰實業有限公司 商標異議人：瑞士商史華曲股份有限公司（本所客戶） 據以異議商標：swatch 帥浮錶 Disputed TM: FWATCH Reg. No.: 1505750 Class: 35 Designated Goods: Dealerships of various products for local/foreign manufacturers/traders; import and export agencies; network auctioneering, mail orders, on-line shopping; retail and wholesale of watches and clocks; retail and whole sale of stationary; retail and wholesale of leather bags and leather articles Registrant: Yardstick Enterprise Co., Ltd. Opposer: Swatch AG(Swatch SA)(Swatch Ltd) Cited Trademark: swatch</p>
<p>IP advisers from your firm involved:</p>	<p>異議人對商標權人所有之註冊第 1505750 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，向經濟部提起訴願，案經經濟部審理後，認定二造商標相衝突，而為「原處分關於異議不成立之部分撤銷，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</p>

	<p>訴願，本案系爭商標因而遭撤銷註冊確定。</p> <p>The Opposer filed an opposition against TM Reg. No. 1505750 owned by the Registrant. The Intellectual Property Office (IPO) considering no conflict between the two parties' trademarks made an Opposition Unfounded Decision. In disagreement with the decision, the Opposer then filed an administrative appeal with the Ministry of Economic Affairs (MOEA). The MOEA after examination rendered an appeal decision determining conflict between the two parties' trademarks and deciding that "the opposition unfounded decision should be revoked and an appropriate decision should be made instead". The IPO following the appeal decision rendered a fresh decision to determine conflict between the two parties' trademarks and to cancel the disputed trademark. As the Registrant failed to institute an appeal, the disputed trademark registration was cancelled and the cancellation has become 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 Attorney Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Attorney</p>
Other IP firms involved:	N/A
Date(s)	<p>2012.05 – 提出異議 2013.07 – 智慧財產局為異議不成立之處分 2013.09 – 提起訴願 2014.01 – 經濟部為「原處分關於異議不成立之部分撤銷，由原處分機關另為適法之處分」之訴願決定 2014.04 – 智慧財產局為系爭商標之註冊應予撤銷之處分 2015.02 – 撤銷註冊公告 May 2012 – Opposition filed July 2013 – Opposition Unfounded Decision made by the IPO September 2013 – Administrative appeal filed January 2014 – Administrative decision made by the MOEA to revoke the opposition unfounded decision and to order the original deciding agency (IPO) to make an appropriate decision instead April 2014 – Decision made by the IPO to cancel the disputed trademark registration February 2015 – Cancellation published</p>
Why was it important?	<p>由字母「s」與不具識別性之「watch」所結合之據爭商標「swatch」可否排斥他人註冊其他字母與「watch」結合之商標於其著名之鐘錶相關商品/服務，甚至不類似之商品/服務？</p> <p>智慧財產局原處分認為，據爭商標固已達著名商標之程度，且系爭商標指定使用之錶零售批發、鐘零售批發等部分服務，與據爭商標註冊及使用之各種鐘錶及其組件等商品構成類似，惟考量兩造商標整體文字組合之設計有明顯差異，二者近似程度極低，足以使消費者辨識其來自不同之來源或產製主體，系爭商標並無使相關消費者產生混淆誤認之虞，亦無減損據爭商標之識別性或信譽之虞，而為異議不成立之</p>

處分。惟經濟部訴願決定認為，兩造商標圖樣相較，二者主要識別之外文「FWATCH」與「swatch」均為一外文字母加上「WATCH」之單字，於觀念上同樣予人外文字母與「WATCH」結合之印象，易予人有同一系列商標之聯想，應屬構成近似之商標，系爭商標指定使用之「錶零售批發；鐘零售批發」服務與據爭商標所使用及註冊之「各種鐘錶、石英錶及其組件」等商品相較，前者指定之服務即在於提供後者商品之批發販售，依一般社會通念及市場交易情形，應屬構成類似之商品/服務，考量據爭商標經異議人持續多年廣泛使用已為我國一般消費者所普遍認知而達高度著名商標之程度，自予消費者深刻印象，應具有相當高之識別性，他人稍有攀附即有發生混淆之虞，系爭商標註冊於「錶零售批發；鐘零售批發」服務，應有致相關消費者混淆誤認之虞；又，衡酌據爭商標為高度著名之商標、二造商標近似程度、據爭商標具相當高之識別性，以及據爭商標之中文名稱「帥奇錶」，商標權人除以與該中文相近之「帥浮錶」作為系爭商標之中文，復與據爭商標相同均以一外文字母結合「WATCH」作為其圖樣之外文，而可據以推論商標權人有使人將系爭商標與據爭商標產生聯想之意圖等因素綜合判斷，商標權人以系爭商標註冊於「代理國內外廠商各種產品之經銷、代理進出口服務、網路拍賣、郵購、網路購物、文教用品零售批發、皮包零售批發、皮件零售批發」服務，將使異議人長久以來所經營之「swatch」等商標不會在社會大眾心中留下單一聯想或獨特性之印象，而有使據爭商標之識別性遭受稀釋或弱化之虞，因而為「原處分關於異議不成立之部分撤銷，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，以相同理由認定系爭商標指定使用之所有服務，均有不得註冊事由，而為系爭商標之註冊應予撤銷之處分。

The main issue for the instant case is that the cited TM “swatch” combining “s” with the non-distinctive “watch” may prevent the trademarks combining other alphabets with “watch” from being registered by others on goods/services relative to timepieces, even dissimilar goods/services.

The IPO in the opposition unfounded decision considered that the cited trademarks are famous and the designated “retail and wholesale of watches and clocks” of the disputed trademark are similar to “various kinds of clocks and watches, and parts thereof” etc. of the cited trademarks; however, the two parties’ trademark entireties are impressively different in design formation so that the level of similarity is low; consumers are able to identify the sources or manufacturers; the disputed trademark would not cause confusion and misidentification to relevant consumers nor dilute the cited trademark distinctiveness or reputation. However, the MOEA in administrative appeal decision reasoned, comparing the two parties’ trademarks, both are designs of an English alphabet plus “WATCH”; conceptually the same “WATCH” could bring the public to associate them with a series of trademarks; they should be considered similar trademarks; comparing the designated “retail and wholesale of watches and clocks” of the disputed trademark with “various kinds of clocks and watches, watches equipped with a quartz and parts thereof etc.” where the cited trademarks are used,

	<p>services of the former are for wholesale and retail of the goods of the latter; according to general idea of society and marketing situation, they should be deemed similar goods/services; in view that the cited trademarks through the Opposer's long-term and extensive use have become acquainted to local consuming public and such impressive trademarks should be quite distinctive; any free-ride will bring confusion; the registration of "retail and wholesale of watches and clocks" of the disputed trademark should be likely to cause confusion and misidentification to relevant public or consumers; considering the cited "SWATCH" trademarks are very famous, the two parties' trademarks are closely similar, the cited trademarks are highly distinctive and the disputed trademark comprising the similar "帥浮錶" and "FWATCH" inferably could be associated with the Chinese version "帥奇錶" and "SWATCH" of the cited trademarks, the disputed trademark registered on "dealerships of various products for local/foreign manufacturers/traders; import and export agencies; network auctioneering, mail orders, on-line shopping; retail and whole sale of stationary; retail and wholesale of leather bags and leather articles" will keep the public from associating "swatch" trademark with a certain single source or unique characteristic, so as to dilute or weaken the cited trademark distinctiveness. Following the MOEA's ruling "the Opposition Unfounded Decision is revoked and the original deciding agency should render an appropriate decision instead, the IPO made a decision based on the same reasoning that the registration for all the designated services of the disputed trademark has unregistrable event and should be cancelled.</p>
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Example work 10

<p>Name and brief description of case/portfolio:</p>	<p>Trademark Revocation</p> <p>系爭商標： </p> <p>註冊號數：1105472</p> <p>類別：3</p> <p>指定商品：香水（香料）、古龍水、化妝品、面霜、乳液、護唇膏、化妝水、體香劑、花露水、美髮水、洗髮精、沐浴乳、潔面乳、漱口水、牙膏、按摩油、按摩霜、眼霜、護手霜、護足霜、潤髮乳、香精油、香皂、定型液、檸檬香精油、薰衣草香精油、玫瑰香精油、茉莉香精油、檀香香精油、茶樹香精油、尤加利精油、薄荷精油、鼠尾草精油。</p> <p>商標權人：愛比森國際股份有限公司</p> <p>申請廢止人：西班牙商史塔迪瓦利西班牙股份有限公司</p> <p>Disputed TM: </p> <p>Reg. No.: 1105472</p> <p>Class: 3</p> <p>Designated Goods: Perfume (spice), cologne, cosmetic, face cream, cream, lip balm, lotion, deodorant, eau de toilette, hair lotion, shampoo, shower gel, facial cleanser, mouthwash, toothpaste,</p>
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	<p>massage oil, massage cream, eye cream, hand cream, foot care cream, conditioner, essential oil, soaps, fixatives, lemon essential oil, lavender essential oil, rose essential oil, jasmine essential oil, sandalwood essential oil, tea tree essential oil, eucalyptus oil, peppermint essential oil, sage oil Registrant: Apiserum International Corporation Petitioner: Stradivarius Espana, S.A</p>
IP advisers from your firm involved:	<p>商標權人前手於 2003 年 11 月 3 日以系爭商標圖樣指定使用於第 3 類之香水（香料）、古龍水、化妝品等商品申請註冊，經智慧財產局核准列為註冊第 1105472 號商標。申請廢止人於 2014 年 11 月 13 日以系爭商標有註冊後無正當事由迄未使用或繼續停止使用已滿 3 年之情形，申請廢止其註冊，商標權人雖提出使用證據，主張其有持續使用系爭商標之事實，惟智慧財產局認定，其提出之使用證據顯示，其上標示之系爭商標係用以表彰他人銷售之商品，並非表彰商標權人之商品，因而為廢止系爭商標註冊之處分。</p> <p>The predecessor of the Registrant on November 3, 2003 filed an application for registration of the disputed trademark designating for use on perfume (spice), cologne, cosmetic etc. in class 3 and was approved registration as No. 1105472 by the IPO. The Petitioner on November 13, 2014 filed a revocation petition against the disputed trademark based on that the disputed trademark has not been put into use or has been suspended from use for three years, without any justifiable reasons. The trademark owner did submit evidence alleging extensive use of the disputed trademark. However, the Intellectual Property Office (IPO) made a decision to revoke the disputed trademark registration reasoning that the disputed trademark labeled is to identify the goods sold by another person, not the disputed trademark owner.</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 Attorney Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Attorney</p>
Other IP firms involved:	N/A
Date(s)	<p>2014.11 – 申請廢止 2016.07 – 智慧財產局為系爭商標之註冊應予廢止之處分 November 2014 – Revocation petition filed July 2016 – Revocation Decision to revoke the disputed trademark registration made by the IPO</p>
Why was it important?	<p>註冊他人已在國外使用之商標，且進口該商標商品來台銷售時，在相關文宣、網站上宣傳該商品係原裝進口，並自稱為該商品之經銷商，而在相關文宣、網站上標示註冊商標，得否認定有使用註冊商標之事實？</p> <p>智慧財產局認為，商標權人提出之發票，為德商·龐貝士公司 (Bombastus-Werke AG) 所開立，發票上標示之系爭商標圖樣及「Bombastus」之標識，應係用以表彰德商·龐貝士公司銷售之商品；產品簡介資料係介紹「德國龐貝士」公司歷史及其產製之朝鮮薊蔬菜</p>

汁、草本茶飲等系列商品，文宣上之系爭商標圖樣及「Bombastus」之標識，表彰指示的來源及予消費者之認知為德國龐貝士公司之產品；商標權人公司官網上有關眼霜、口腔保養液、口腔噴劑、牙膏、精華霜等商品圖示，其商品包裝盒、產品標貼上均有系爭商標圖樣及「Bombastus」之標識，搭配網頁上產品簡要說明為「原裝進口」，依一般交易過程，客觀上傳達予消費者之認知觀念，系爭商標應係德商·龐貝士公司所使用用以表彰其商品之識別標識；再輔以商標權人答辯理由中自稱其為德商·龐貝士公司在台之經銷商。據此得認，商標權人僅係代理銷售德商·龐貝士公司之系爭商標商品，將系爭商標用於前述商品之使用人為德商·龐貝士公司；再參酌申請廢止人所提出之網頁資料，得知德商·龐貝士公司以系爭商標標示於產製之商品，台灣有其他業者進口/代購其商品來台販售，是客觀上，消費者所認知之商品產製者及系爭商標之使用人為德商·龐貝士公司，因此，商標權人並無於被申請廢止日前 3 年內有使用系爭商標之事實，智慧財產局因而為系爭商標之註冊應予廢止之處分。

The main issue for the instant case is whether a registered trademark will be deemed as use if it is a trademark owned by another person in other country and the trademark owner claimed he is the local distributor and the registered trademark as well as the wording “imported with original packages” are shown on advertising materials and website.

The IPO opined that the invoice lodged by the disputed trademark owner was issued by a German company, Bombastus-Werke AG, and the disputed trademark design and “Bombastus” on the invoice are to identify the products sold by the German company Bombastus-Werke AG; product introduction is for the history of Bombastus-Werke AG and the products pflanzenextrakt artischocke and herbal drinks series; the way the disputed trademark design and “Bombastus” were shown, to consumers, are to identify the products sold by the German company Bombastus-Werke AG; eye creams, oral preparation, toothpaste and refining creams are sold on the disputed trademark owner’s website; the disputed trademark design and Bombastus are shown on packages and the products with the wording “Imported with original packages”; according to general marketing, consumers objectively will think the disputed trademark is used by Bombastus-Werke AG to identify its goods; the disputed trademark owner in the defense brief stated “Apiserum exactly is Bombastus-Werke AG’s local distributor”; evidently, the disputed trademark owner is just the local distributor for Bombastus-Werke AG’s products bearing the disputed trademark; webpages lodged by the Petitioner prove that the disputed trademark is used by Bombastus-Werke AG on products and the trademarked goods have been exported into Taiwan by other traders; objectively, consumers are able to recognize that the manufacturer of the goods and the user of the trademark is Bombastus-Werke AG; the disputed trademark evidently has not been used or has been suspended from use within three years before the instant revocation petition was filed; the disputed trademark registration should be revoked.

Example work 11

Name and brief description of case/portfolio:

Trademark Application

系爭商標：Knot device (tridimensional)



註冊號數：1776241

類別：3, 18

商標權人：瑞士商·柏蒂·溫妮達股份有限公司
BOTTEGA VENETA SA

系爭商標圖樣使用於「香水」等商品（第 3 類）



系爭商標圖樣使用於「手握式皮包、晚宴手提包」等商品（第 18 類）



Disputed TM: Knot device (tridimensional)



Reg. No.: 1776241
Classes: 3, 18
Registrant: BOTTEGA VENETA SA

The disputed trademark actually used on “perfume” (class 3)



The disputed trademark actually used on “clutch bags, evening handbags” (class 18)





智慧財產局認為系爭商標為一立體繩結所構成，以之作為商標，指定使用於第 3 類「香水，香精，... ..」等商品及第 18 類「行李箱及旅行袋；... ..」等商品，予消費者之認知，1) 通常僅視其為單純用以促銷商品或服務之立體模型，或單純裝飾藝術；2) 雖非商品直接說明，然其圖樣仍為一裝飾圖樣；3) 仍僅視其為單純裝飾造型藝術，因此不具商標識別性，先後核予第 10390716910 號、第 10490166190 號及第 10590137100 號等 3 次核駁理由先行通知書。經商標權人多次檢呈證據資料（本案立體商標圖樣獨創性資料，本案立體商標圖樣世界多國（包括台灣）各報章雜誌廣告宣傳資料，本案立體商標圖樣所表彰商品受眾中、外知名人士青睞及近 10 年間在世界各國（包括台灣）銷售數字資料，本案立體商標圖樣於世界多國申准註冊資料）並陳明系爭商標圖樣實具識別性後，系爭商標圖樣於其實際使用之商品範圍內獲准註冊。

The Intellectual property Office (IPO) considered that the disputed trademark is composed of a 3-D knot; consumers could associate such a design designating for use on “perfumes, perfume extracts” in class 3 and “trunks and traveling bags;” in class 18 with 1) a simple 3-D model for promoting goods or services or a simple decorative art; 2) a decorative pattern, even though it is not directly descriptive; 3) simply a decorative art, thus not distinctive and raised objections three times in Official Letter Nos. 10390716910, 10490166190 and 10590137100. In order to overcome the Examiner’s objections, the trademark owner submitted evidence/materials showing creativeness of the instant trademark, newspapers/magazine advertising materials world-wide (including Taiwan), popularity of the trademarked products and sales figures throughout the world (including Taiwan) and world-wide registrations) and argued that the disputed trademark possesses distinctiveness. Finally, the disputed trademark design was granted registration on the goods actually-used.

IP advisers from your firm involved:

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 Attorney
Cheng-Yi HUANG, Attorney-at-Law / Certified Patent Attorney

Other IP firms involved:	N/A
Date(s)	<p>2014.01 – 申請註冊 2014.08 - 智慧財產局發給第一次核駁理由先行通知書 2014.12 – 提出意見書 2015.03 - 智慧財產局發給第二次核駁理由先行通知書 2015.09 - 提出意見書 2016.02 - 智慧財產局發給第三次核駁理由先行通知書 2016.05 - 智慧財產局發給核准審定書 2016.05 – 繳納註冊費 2016.06 – 公告註冊</p> <p>January 2014 – Application filed August 2014 – First objection raised by the IPO December 2014 – First response March 2015 – Second objection raised by the IPO September 2015 – Second response February 2016 – Third objection raised by the IPO May 2016 – Approval decision issued by the IPO May 2016 – Registration fee paid June 2016 – Publication for registration</p>
Why was it important?	<p>本案爭點：系爭商標是否不具識別性？</p> <p>智慧財產局認為系爭商標實際已於世界各國（包括台灣）大量廣告宣傳、行銷販售並獲准於多國註冊，因此認定系爭商標於第 3 類「香水，淡香水」等商品及第 1 8 類「手提包，肩背包，女用手提包，手握式皮包，晚宴手提包，錢包」等實際使用之商品範圍內已具商標識別性並核准為第 1776241 商標。</p> <p>The main issue for the instant case is whether the disputed trademark is distinctive or not.</p> <p>Taking into account the extensive promotion, distribution world-wide (including Taiwan) and registrations of the disputed trademark, the IPO decided the disputed trademark actually used on “perfumes, eau de perfume” in class 3 and “handbags, shoulder bags, tote bags, clutch bags, evening handbags, purses” in class 18 is distinctive and granted its registration as No. 1776241.</p>

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