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## TIPLo Outstanding work on Litigation Case (2019~2022)

### Example work 1

<b>Name and brief description of case/portfolio:</b>	<p>一中國電子商務集團(本所客戶)之「語音的功能控制方法和裝置」發明專利被某一匿名之公司申請舉發,要求撤銷專利權。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)。舉發人並放棄訴願之救濟途徑,全案確定。</p> <p>A company challenged anonymously the validity of a patent on a voice control method and device, which patent is owned by our client, an E-commerce group based in the PRC. Taiwan IPO dismissed the invalidation action request, which dismissal became conclusive and final with no dispute from the anonymous challenger and our client's patent stands still.</p>
<b>IP advisers from your firm involved:</b>	<p>林志剛 律師/專利師 廖文慈 律師/專利師 陳佑慈 專利師</p> <p>J. K. Lin, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney CHEN You-Tse, Certified Patent Attorney</p>
<b>Other IP firms involved:</b>	<p>N/A</p>
<b>Date(s)</b>	<p>2019.07: 被提起舉發 2019.09: 提呈被舉發答辯(一) 2022.01: 舉發人提補充理由(一) 2022.03: 提呈被舉發答辯(二) 2022.05: 智慧局作成舉發不成立之審定</p> <p>Timeline: -- Jul. 2019: Challenger filed the request for invalidation action. Sep. 2019: Client answered with a written statement filed, Statement (I). Jan. 2022: Challenger supplemented reasons (I) for its request for invalidation action. Mar. 2022: Client presented written statement (II) in response. May 2022: Taiwan IPO decided and denied the invalidation action request.</p>
<b>Why was it important?</b>	<p>1. 系爭專利係關於一「語音的功能控制方法和裝置」發明專利,舉發人針對全部請求項提出舉發。但系爭專利於其他國家並未被提</p>

出舉發，故研判係爭專利之台灣市場對舉發人而言，極具重要性。

2. 本案之技術涉及一語音的功能控制方法，藉由 3 個重要步驟的執行，能夠實現在以語音助理做為使用者進行語音互動的統一入口的同時，又能準確快速的完成使用者需要的功能，解決先前技術執行結果較差的問題。

3. 於本案件中，由於系爭專利的技術特徵顯然已被證據 1、2 之組合所揭露，因此本所的策略係藉由更正請求項迴避引證所揭露的技術特徵，且使系爭專利的區別技術特徵更加凸顯，故專利權人於舉發程序中提出更正請求項之申請。智慧局認為更正事項均未超出申請時說明書、申請專利範圍或圖式所揭露範圍，且更正後請求項 1-22 仍能達成更正前之發明目的，故未導致實質擴大或變更公告時之申請專利範圍，而准許更正。

4. 另一方面，由於電腦軟體專利於進步性的判斷較其他領域之技術具特殊性，因此，本所即以此為核心並強調系爭專利相較於引證案具有無法預期的功效，作為進步性的答辯重點。

5. 本案審理過程中，經濟部智慧財產局於 2021 年 7 月通過新版「電腦軟體審查基準」，新版基準就電腦軟體專利之進步性的判斷亦進行一些新規定，本案雖係適用系爭專利公告時的舊基準，但審查委員亦以新版基準之精神作出對專利權人有利之認定。智慧局於 2022 年 5 月作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後未向經濟部訴願審議委員會提起訴願，本案因而確定（本所客戶勝訴）。

1. The patent in issue is an invention on a voice control method and device. The challenger has targeted each of the claims of the patent which has been challenged nowhere else in the world. It is therefore believed that the relevant market in Taiwan is extremely important to the challenger.

2. The voice control method claimed of our client's patent features a crucial three-step procedure the execution of which enables the voice assistant to accurately, rapidly complete the task at the user's command while operating as the general portal for the user to conduct voice interaction thereby delivering better results over prior arts

3. In this case, as obviously the technical feature of the patent challenged has been disclosed by the combination of prior arts 1 and 2 cited, we recommended and successfully assisted our client in amending the claim challenged during the proceeding. With the amendment, the patent not only bypasses the technical feature disclosed by the prior arts but also has its distinctive technical feature highlighted as a whole. The Taiwan IPO granted the amendment sought for holding that (a) the amendment as proposed stretches nothing in excess of the scope of the disclosure made in the specification, the claim and/or the drawings, (b) the post-amendment claims 1 through 22 can serve still the original purpose the invention is intended to serve, and (c) the scope of the patent as was at the time of its publication is neither substantially broadened nor changed as a result of the

	<p>amendment proposed.</p> <p>4. Also, building on the fact that the inventive step test of a computer software patent is distinctively characterized as opposed to the same test of arts of other technical fields, we emphasized the unexpected performance of the patent challenged to defend its inventive step over the cited prior arts.</p> <p>5. During the proceeding of the challenge of our client's patent, the Taiwan IPO announced (in July 2021) to put in place the latest revision to the Examination Guidelines for Computer Software Patent Applications, which revision provides, among others, additional tests with respect to the inventive step requirement. For this case, the Examination Guidelines applicable at the time of the filing of the patent application should be adopted but the examiner tested the invalidation action request by reference to the spirit of the new amendment and determined the challenge in favour of the patentee.</p> <p>The challenged was held untenable and dismissed by the Taiwan IPO in May 2022 and our client's patent stands. The challenger did not dispute the dismissal, meaning Taiwan IPO's decision is conclusive and final and our client's patent stands.</p>
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## Example work 2

<p><b>Name and brief description of case/portfolio:</b></p>	<p>一台灣玻璃加熱爐具製造商，向經濟部智慧財產局申請舉發要求撤銷一芬蘭玻璃加熱爐具製造商（本所客戶）之發明專利（N01案）。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後復向智慧財產法院起訴，智慧財產法院判決駁回起訴（本所客戶勝訴）。舉發人復向最高行政法院提起上訴，日前亦被最高行政法院駁回上訴（本所客戶勝訴），全案確定。</p> <p>該台灣玻璃加熱爐具製造商同時又針對同一件專利案提出第二次舉發（N02案），案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後復向智慧財產法院起訴，智慧財產法院判決駁回起訴（本所客戶勝訴）。舉發人復向最高行政法院提起上訴，目前在最高行政法院審理中。該台灣玻璃加熱爐具製造商同時又提出第三次舉發（N03案），案件由經濟部智慧財產局審理中。</p> <p>A Taiwanese glass cookware maker sought for the invalidation of an invention patent owned by a Finnish fellow member in the industry (hereinafter "Case 1"). We represented the patentee in Case 1 and successfully defended the validity of the patent</p>
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	<p>challenged. The challenger appealed and the MOEA Appeal Board upholding Taiwan IPO's decision dismissed challenger's appeal. The challenger then brought the matter to the IP Court but in vain. The challenger appealed to the SAC where the IP Court's decision is sustained and Taiwan IPO's decision dismissing challenger's invalidation action request became conclusive and final.</p> <p>The challenger at the same time sought for the invalidation of another claim of the same patent ("Case 2"), which invalidation action request was dismissed as well. The challenger appealed and the MOEA Appeal Board dismissed the appeal. The challenger then filed administrative action only to see its action dismissed by the IP Court. The challenger appealed its case to the SAC and the appeal is pending the SAC's decision. In the meantime, the challenger filed a third request seeking to have still another claim of the same patent owned by our client invalidated ("Case 3") and the invalidation action request is pending decision by the Taiwan IPO.</p>
<b>IP advisers from your firm involved:</b>	<p>林志剛 律師/專利師 廖文慈 律師/專利師 黃鐘模 專利代理人 J. K. Lin, Attorney-at-Law / Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney HUANG Zhong-Mo, Patent Attorney</p>
<b>Other IP firms involved:</b>	N/A
<b>Date(s)</b>	<p>2014.05 : 被提起舉發(N01) 2014.06 : 提呈被舉發答辯(一)(N01) 2014.11 : 舉發人提補充理由(一)(N01) 2015.11 : 提呈被舉發答辯(二)(N01) 2016.07 : 舉發人提補充理由(二)(N01) 2016.08 : 提呈被舉發答辯(三)(N01) 2016.12 : 舉發人提補充理由(三)(N01) 2016.12 : 提呈被舉發答辯(四)(N01) 2017.06 : 審定舉發不成立(N01) 2017.12 : 訴願被駁回(N01) 2018.01 : 舉發人向智慧法院起訴(N01) 2018.06 : 智慧法院第一次開庭(N01) 2018.06 : 智慧法院第二次開庭(N01) 2018.07 : 智慧法院駁回起訴(N01) 2018.08 : 舉發人向最高行政法院提起上訴(N01) 2018.08 : 被提起舉發(N02) 2018.12 : 提呈被舉發答辯(一)(N02) 2019.07 : 提呈被舉發答辯(二)(N02) 2019.08 : 審定舉發不成立(N02) 2019.01 : 訴願被駁回(N02) 2020.02 : 最高行政法院駁回上訴(N01) 2020.02 : 舉發人向智慧法院起訴(N02)</p>

	<p>2021.05 : 智慧法院駁回起訴(N02) 2021.07 : 舉發人向最高行政法院提起上訴(N02) 2021.12 : 被提起舉發(N03) 2021.03 : 提呈被舉發答辯(一) (N03) 2021.04 : 提呈被舉發答辯(二) (N03) Timeline: -- May 2014: Challenger filed invalidation action request. (Case 1) Jun. 2014: Patentee presented response statement (I). (Case 1) Nov. 2014: Challenger presented supplemental statement of reasons (I) for seeking the invalidation. (Case 1) Nov. 2015: Patentee presented response statement (II). (Case 1) Jul. 2016: Challenger presented supplemental statement (II). (Case 1) Aug. 2016: Patentee presented response statement (III). (Case 1) Dec. 2016: Challenger presented supplemental statement (III). (Case 1) Dec. 2016: Patentee filed response statement (IV). (Case 1) Jun. 2017: Invalidation action request held untenable and dismissed. (Case 1) Dec. 2017: Appeal dismissed. (Case 1) Jan. 2018: Challenger initiated administrative action. (Case 1) Jun. 2018: IP Court held 1<sup>st</sup> hearing. (Case 1) Jun. 2018: IP Court held 2<sup>nd</sup> hearing. (Case 1) Jul. 2018: Challenger's administrative action held untenable and dismissed. (Case 1) Aug. 2018: Challenger appealed to the SAC. (Case 1) Aug. 2018: Challenger filed a second invalidation action request. (Case 2) Dec. 2018: Patentee presented response statement (I). (Case 2) Jul. 2019: Patentee presented response statement (II). (Case 2) Aug. 2019: Invalidation action request held untenable and dismissed and challenger appealed. (Case 2). Jan. 2020: Challenger's appeal dismissed. (Case 2) Feb. 2020: Challenger's appeal to the SAC dismissed. (Case 1) Feb. 2020: Challenger brought the matter to the IP Court. (Case 2) May 2021: Challenger's action dismissed by the IP Court. (Case 2) Jul. 2021: Challenger appealed IP Court's decision to the SAC. (Case 2) De. 2021: Challenger filed a third invalidation action request. (Case 3) Mar. 2022: Patentee presented response statement (I). (Case 3) Apr. 2022: Patentee presented response statement (II).</p>
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	(Case 3)
<p><b>Why was it important?</b></p>	<p>1. 系爭專利係關於一加熱液晶玻璃的方法及裝置之發明專利，舉發人於 2014 年、2018、2021 年先後申請三次舉發（N01 案、N02 案、N03 案）。由於本案亦涉及侵權糾紛，故雙方對本案之成敗均極為重視。且本案件（N01 案、N02 案）二度被智慧局評選為年度經典案例。</p> <p>2. 本案之攻防重點在於證據組合之動機的有無。由於舉發人所提出之數個證據分別各自揭露系爭專利之部分技術特徵，因此我方客戶防禦的重心在於主張各證據間不具有組合之動機。</p> <p>3. 由於舉發人不斷的檢索前案，其於 N01 案、N02 案、N03 案所提出之證據均不相同，且新的證據又與系爭專利的技術內容又更為雷同，故本所的策略係詳細分析各個引證案的內容，進而主張各個引證案於「所欲解決的問題」不相同、「功能或作用」不相同、且各個引證案間存在反向教示，據此論述各證據間不具有組合之動機。</p> <p>4. 智慧法院於 N01 案審理過程中，法院罕見的在一個月內即舉行準備程序庭及言詞辯論庭，並隨即於次月即宣判舉發人敗訴（本所客戶勝訴）。顯見本所之答辯理由至為充分，且答辯方針亦即為正確，使法官迅速的形成為我方客戶的心證。而智慧法院於 N02 案判決中，就「反向教示」的適用，同意本所的主張，並進一步的作出經典的闡明，即當相關引證中已明確記載或實質隱含有關排除申請專利之發明的教示或建議，包含引證中已揭露申請專利之發明的相關技術特徵係無法結合者，或基於引證所揭露之技術內容，該發明所屬技術領域中具有通常知識者將被勸阻而不會依循該等技術內容所採的途徑者，則難謂該發明所屬技術領域中具有通常知識者有動機能結合該等引證之技術內容。</p> <p>5. 此外，法院於 N02 判決中亦贊同本所的主張，揭示「判斷進步性應以申請專利之發明的整體為對象，不得僅因複數引證結合後已完整揭露該發明之全部技術特徵，即認定該發明為單純拼湊，必須考量結合後之發明的各技術特徵與功能上有無相互作用。</p> <p>6. N02 案於舉發階段、智慧法院審理階段，皆由本所客戶取得勝訴。但舉發人向最高行政法院提起上訴，目前仍於最高行政法院審理中。舉發人同時亦提出 N03 舉發案，目前在智慧局審理中。</p> <p>1. The patent in issue is an invention on the method and device of heating liquid crystal glass. The challenger sought for invalidation of the patent three times: the first time in 2014 (“Case 1”), the second in 2018 (“Case 2) and the third in 2021 (Case 3). The challenger has disputed the standing of the patent in defence in the patent infringement action the patentee initiated against it. In short, the standing of the patent will decide who is to win the patent infringement lawsuit. The Taiwan IPO has twice selected this invalidation matter (Case 1, Case 2) as an example work of the year.</p> <p>2. The key to the attack and defence lies in the existence of</p>

the motive to combine the cited prior arts. As the prior arts cited by the challenger each disclose a different part the technical features of the patent being challenged, the defence shall focus on demonstrating that no person skilled in the art would be motivated by any of the cited prior arts to combine them.

3. To challenge the standing of the patent, the challenger continuously searched for different prior arts to present and so the prior arts presented in one case do not overlap with those presented in another. Moreover, in terms of technical content, those presented later are closer to the patent than those presented earlier. As such, we strategized the defence to highlight the differences that characterize the patent from the prior arts based on a detailed analytical look at the prior arts each, including the problems targeted to solve, functions, effects, the teach-away by and among the prior arts, to reason out the conclusion that no person would be motivated to combine the prior arts.

4. In the administrative action initiated by the challenger in Case 1, the IP Court held the preparatory hearing followed by the oral argument session during the same month and decided to dismiss the action in the following month (upholding Taiwan IPO's decision sustaining our client's patent), which is fairly rare. Obviously, the IP Court considered tenable the argument we presented for the patentee in response to the invalidation action to quickly find to uphold Taiwan IPO's decision whereby our client's patent sustains in good standing.

In the Case 2 administrative action, the IP Court admitted the statement we presented on the teach-away issue and gave this quintessential elucidation: Where the cited prior art clearly indicates or substantially implicates any teaching or recommendation to exclude the invention patent claimed, including the teaching that it is impossible to combine the technical features of the inventions claimed as disclosed in the prior arts or, in consideration of the technical art disclosed in the cited prior art, a PHOSITA of the technical field of the invention claimed will be advised to not adopt the way as adopted by the technical content disclosed by the prior art, it would be far-fetched to deduce that that a PHOSITA of the technical field to which the invention claimed belongs will have the motive to combine the technical content of the prior arts.

5. The IP Court admitted as well our argument presented in Case 2. The IP Court reasoning its decision elucidates that the invention claimed as a whole must be looked at for the purpose of an inventive step test, and that no conclusion may be drawn to hold the invention a mere combination of prior arts on account of all of its technical features having been disclosed in full by the combination of multiple prior arts without considering the interaction, if any, by and among the technical features and functions of the prior arts combined.

	6. Our client, the patentee prevailed in both of the invalidation action and the administrative action in Case 2. The challenger took an appeal to the SAC, which appeal is pending examination and decision. In the meantime, the challenger filed a third request for invalidation action (Case 3) which is now pending Taiwan IPO's decision.
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### Example work 3

<b>Name and brief description of case/portfolio:</b>	<p>一個台灣的化工材料製造商，向經濟部智慧財產局申請舉發要求撤銷另一奧地利的化工材料製造商（本所客戶）之專利(N01)。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會仍維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。舉發人嗣後復向智慧財產法院起訴，智慧財產法院判決駁回起訴（本所客戶勝訴）。舉發人復向最高行政法院提起上訴，日前亦被最高行政法院駁回上訴（本所客戶勝訴），全案確定。</p> <p>同一位舉發人繼而提出第二次舉發（N02 案），目前於智慧局審理中。</p> <p>A Taiwanese manufacturer of chemical materials sought for the invalidation of the patent owned by an Austrian fellow member in the trade (N01). We represented the patentee in the proceeding in the Taiwan IPO and successfully helped the client defend the valid good standing of the patent challenged. The challenger appealed but in vain. The challenger then filed administrative action only to see its action dismissed by the IP Court. The challenger took an appeal to the SAC which appeal was dismissed by the SAC. That is, the Taiwan IPO's decision dismissing the invalidation action request is conclusive and final and our client's patent challenged is sustained valid in good standing.</p> <p>The challenger has, in fact, sought for again the invalidation of our client's patent, which invalidation action request is pending Taiwan IPO's examination and decision. (Case 2)</p>
<b>IP advisers from your firm involved:</b>	<p>林志剛 律師/專利師 楊益昇 律師/專利代理人 廖文慈 律師/專利師 柯宥騏 專利師</p> <p>J. K. LIN, Attorney-at-Law / Certified Patent Attorney Y. S. YANG, Attorney-at-Law / Certified Patent Agent Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney KE You-Qi, Certified Patent Attorney</p>
<b>Other IP firms involved:</b>	N/A
<b>Date(s)</b>	<p>2018.10：被提起舉發(N01) 2019.04：提呈被舉發答辯(一) (N01) 2019.06：舉發人提補充理由(N01)</p>



	<p>2019.09：提呈被舉發答辯(二) (N01)          2019.10：審定舉發不成立(N01)          2020.05：訴願被駁回(N01)          2020.08：智慧法院駁回起訴(N01)          2021.03：被提起舉發(N02)          2022.03：最高行政法院駁回上訴(N01)          Timeline: --</p> <p>Oct. 2018: Challenger filed invalidation action request. (Case 1)          Apr. 2019: Patentee presented response statement (I). (Case 1)          Jun. 2019: Challenger presented supplemental statement. (Case 1)          Sep. 2019: Patentee presented response statement (II). (Case 1)          Oct. 2019: Challenger's invalidation action request held untenable and dismissed and challenger appealed. (Case 1)          May 2020: Challenger's appeal dismissed and challenger brought the matter to the IP Court. (Case 1)          Aug. 2020: The IP Court dismissed challenger's action and challenger took an appeal to the SAC. (Case 1)          Mar. 2021: Challenger filed a second invalidation action request. (Case 2)          Mar. 2022: Challenger's appeal dismissed by the SAC. (Case 1)</p>
<p><b>Why was it important?</b></p>	<p>1. 系爭專利係關於一製造纖維素纖維的方法之發明專利，該件專利同時有民事侵權訴訟繫屬。舉發人對係爭專利先後提出二次舉發申請（N01 案、N02 案），本案件亦被智慧局評選為年度經典案例。</p> <p>2. 系爭專利權人於侵權訴訟進行中申請更正請求項，智慧局亦准予更正，然舉發人認為該更正已構成實質變更申請專利範圍而應不准予更正，故提出舉發申請(N01 案)。</p> <p>3. 由於倘若本案不進行更正則無法迴避先前技術，將導致專利不具進步性，因此如果爭論更正的適法性即相當重要。也因為如此，舉發人始於舉發案中選擇集中攻勢於「更正應否准許」乙點的戰略模式，而不同時爭執系爭專利之進步性欠缺的問題，此種戰略模式實屬罕見。</p> <p>4. 本案爭執的重點在於系爭專利權之原請求項係記載為「A 及／或 B 具有分子量為.....」，更正為「A 具有分子量為.....」，舉發人主張該更正顯然構成擴大原申請專利範圍。本所精準的指出舉發人邏輯上的錯誤，並詳列說明書之各處記載，以證明系爭專利刪除「及／或 B」並未減損發明整體之目的，且仍然可獲致系爭專利原本所能達成之功效。智慧局最終仍審定舉發不成立。N01 案於訴願階段及智慧法院、最高行政法院審理階段皆由本所客戶取得勝訴，全案確定。</p>

5. 由於舉發人於 N01 案敗訴，故舉發人繼而又提起新舉發案（N02 案），該案目前於智慧局審理中，並已進行過一次的面詢審理。舉發人於 N02 案主張的無效理由包含系爭專利違反明確性要件、據以實施要件、新穎性要件、進步性要件。因此，N02 案攻防的重點相當多面，包含選擇發明的新穎性要件、進步性、以及化學專利的申請專利範圍解釋問題等。

1. The patent challenged is an invention patent on the method of fabricating cellulose fiber and is the patent-at-issue in a patent infringement litigation pending decision by the IP&C Court. The challenger (and the respondent in that litigation) twice sought for invalidation of the patent (hereinafter “Case 1”, “Case 2” respectively). This case is also selected by the Taiwan IPO as an example work of the year.

2. During the litigation, the patentee sought to amend the patent and the amendment was granted as proposed. The challenger alleging that the amendment proposed by the patentee should’ve been denied for it constitutes a substantive change of the scope of the patent. (Case 1)

3. Without the amendment sought for by patentee and granted by the Taiwan IPO, the patent in dispute will inevitably run into the scope of relevant prior arts to be determined lack of inventive step. Accordingly, the acceptability of the amendment sought for by the patentee is a core issue. As such, the challenger aimed at Taiwan IPO’s grant of the amendment as the target of attack in the invalidation action instead of questioning the inventive step of the patent. This strategy put to practice by the challenger is, frankly speaking, quite uncommon.

4. The key issue in dispute is the reading of the claim in question: the original text reads “...A and/or B has a molecular mass of...” and the post-amendment text reads “...A has a molecular mass of ....” The challenger alleged asserting that the amendment obviously broadened the original scope of the claim. In response, we nailed the logical fallacies in the challenger’s allegations and detailed a list of the relevant text of the specification of the patent to prove that the proposed removal of “...and/or B...” from the specification does not in any way undermine the purpose of the invention as a whole and nor does it compromise the original intended performance and effects of the patent. The defence we presented won Taiwan IPO’s dismissal of the challenger’s invalidation action request for our client. The challenger brought an appeal to the SAC without success. Our client’s patent having weathered through the proceeding of the challenger’s invalidation attempt in the Taiwan IPO, administration action in the IP Court and appeal to the SAC in Case 1 stands still with

5. With its initial invalidation attempt failed (Case 1), the

	<p>challenger filed a second invalidation action request (Case 2), which request is pending Taiwan IPO's decision with one interview conducted as of today. In the Case 2 invalidation action, the challenger has attacked clarity, workability of embodiment, non-obviousness and inventive step of our client's patent. That is, the means of attack and defence to present in Case 2 involves the novelty issue, inventive step issue, and the construction of the scope of patent claimed on a chemical invention.</p>
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#### Example work 4

<p><b>Name and brief description of case/portfolio</b></p>	<p>(專利侵權民事訴訟事)</p> <p>本所客戶(一半導體設備製造商)為台灣 A 發明專利(方法專利)之專利權人，客戶發現 X 公司在台灣販賣之產品侵害客戶台灣 A 發明專利，雖曾寄發警告函予 X 公司，但 X 公司質疑 A 發明專利之可專利性，故置之不理。故本所客戶先向法院聲請於第三人處(侵權產品所在地)進行證據保全獲准，嗣第三人依法院之命令，提出侵權產品之訂單及操作手冊等資料。嗣本所客戶對 X 公司提起訴訟。</p> <p>X 公司於訴訟中主張 A 發明專利欠缺進步性，且不構成侵權。第一審法院認為：</p> <p>(1)A 發明專利具有進步性 (2)根據證據保全資料，判定侵權產品落入 A 發明專利之文義範圍。 (3)損害賠償之計算部分：</p> <p>本所客戶係依「因侵害行為所得之利益」作為損害計算方式。法院確認侵權產品之總銷售金額後，以財政部所核定之同業利潤標準之毛利率計算銷售毛利，並認為 A 發明專利所實現之方法，是影響半導體廠商購買系爭產品意願之重要因素，故判定 A 發明專利對於系爭產品之技術貢獻度為 35%。並以「毛利 X 35%」作為「侵權行為所得之利益」。而因 X 公司收到本所客戶律師函通知後仍繼續侵權，故針對 X 公司收到律師函後所發生之「侵權行為所得之利益」，以 1.5 倍計算懲罰性賠償。</p> <p>(Patent infringement litigation with damages claimed)</p> <p>Client, a maker of semi-conductor fabricating equipment, owns the process patent at issue in Taiwan ("Patent A"). Upon information of possible infringement of Patent A by the product distributed in Taiwan by another company ("Company X"), Client issued a cease and desist letter to Company X. Company X questioning the patentability of Patent A ignored the cease and desist letter received. Client filed a motion seeking perpetuation of evidence to be performed at the premises of a third party (where the</p>
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	<p>accused product was placed and held). The third party acting in compliance with the ruling granting Client's said motion produced copies of purchase orders and operation manuals, etc. in connection with the accused product. Client then sued Company X alleging infringement of its Patent A with a claim for damages.</p> <p>Company X challenged the inventive step of Patent A during the proceedings and maintained the accused product was non-infringing.</p> <p>Findings made by the Court of the first instance:</p> <p>(1) Patent A fulfills the inventive step patentability requirement.</p> <p>(2) According to the materials obtained from the third party as a result of performance of perpetuation of evidence, the accused product reads on the scope of patent of Patent A.</p> <p>(3) Calculation of damages claimable and claimed: Client opted for the profit earned by Company X from the infringing acts and activities for the base to calculate the claimable amount of damages. The Court assessed the gross profit earned by Company X based on the value verified of Company X's sales of the accused product and according to the gross profit rates of the trade approved by the Ministry of Finance. The Court further holds the patented process in issue is an important factor to semi-conductor suppliers contemplated on purchasing the accused product. The Court therefore determined 35% for the weight of Patent A's contribution to the technology involved in the accused product and adopted the same ratio of the above gross profit for the profit earned by Company X from the infringement. Further, as Company X in fact continued to carry on the infringement after receiving the cease and desist letter from Client, a sum of the profit earned by Company X from the infringement after its receipt of the cease and desist letter multiplied by 1.5 was calculated punitive damages against Company.</p>
<b>IP advisers from your firm involved</b>	<p>陳和貴 律師/專利師 楊益昇 律師/專利代理人 H. G. CHEN, Attorney-at-Law / Certified Patent Attorney Y. S. YANG, Attorney-at-Law / Certified Patent Agent</p>
<b>Other IP firms involved</b>	<p>N/A</p>
<b>Date(s)</b>	<p>2019年2月1日：提起民事訴訟。 2020年3月19日：法官作出專利範圍解釋。 2020年10月20日：第一審進行第一次言詞辯論程序。 2021年5月11日：第一審進行第四次言詞辯論程序。 2021年6月24日：法官公開心證表示A專利有效，且產品構成侵權，並諭知進入損害賠償調查。</p>

	<p>2022 年 7 月 5 日：第一審進行第十次言詞辯論程序(辯論終結)。</p> <p>2022 年 7 月 29 日：第一審宣判(本所客戶部分勝訴)。</p> <p>Timeline (yy-mm-dd):</p> <p>2019-02-01: Patent infringement action filed.</p> <p>2020-03-19: Scope of patent construed and determined by Judge.</p> <p>2020-10-20: 1<sup>st</sup> oral session conducted.</p> <p>2021-05-11: 4<sup>th</sup> oral session conducted.</p> <p>2021-06-24: Patent A's valid standing sustained; accused product held infringing; taking of evidence for calculating damages commenced.</p> <p>2022-07-05: 10<sup>th</sup> (and the final) oral session conducted; oral sessions closed.</p> <p>2022-07-29: Decision in conclusion of the first-instance proceedings announced (with Client winning the case.)</p>
<p><b>Why was it important?</b></p>	<p>1. 法官於本件中針對 A 發明專利請求項之用語作出解釋，而法官所為之解釋、均與我方相同。這也奠定了本所客戶勝訴之基礎。</p> <p>2. 本件案情繁雜，耗時甚久。而 X 公司除於本程序中提出專利無效抗辯外，也向智慧局提出舉發，但在本所強力答辯下，成功地協助客戶取得勝訴判決，也間接維護了客戶在市場上之競爭地位。</p> <p>1. Interpretation of the terms used to specify the claim(s) of Patent A by the judge matches that we presented on behalf of Client and said accordance hinges the success of Client's action.</p> <p>2. Due to the complexity involved in the case, the proceedings in the court of first instance took a considerable amount of time to come to an end. In addition to the validity challenge presented in the litigation, Company X sought for Taiwan IPO's invalidation of the patent. We successfully defended Client's patent right for Client to win the lawsuit, which win solidify the safeguard of Client's competitive edge.</p>

### Example work 5

<p><b>Name and brief description of case/porfolio</b></p>	<p>(請求排除侵害民事訴訟)</p> <p>米其林公司出版米其林指南，經由其評審員於各地體驗餐飲服務後，將推薦的餐廳彙整，撰寫評論與心得收錄於米其林指南中，供消費大眾參考。</p> <p>惟 ISOSEI 日式餐廳(瑞慧日式餐飲股份有限公司)對米其林前開行為，以其妨害所有權及人格權為由，提起訴訟請求預先排除侵害，即請求法院命米其林不得指派評審員前往其餐廳用餐，以及不得</p>
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	<p>於米其林指南提及該餐廳。 (Civil action initiated for infringement removal)</p> <p>Our client, Manufacture Française des Pneumatiques Michelin (the defendant of this case, hereinafter referred to as “Michelin”) has been publishing the MICHELIN Guide, in which Michelin includes and consolidates Michelin inspectors’ dining experiences in the restaurants inspected worldwide and provides reviews on them as a guide for consumers’ reference.</p> <p>With respect to Michelin’s aforesaid act, the plaintiff, Iosei, a Japanese food restaurant (Chinese name: 瑞慧日式餐飲股份有限公司) initiated a civil action against Michelin on the ground that Michelin infringes upon its proprietary rights and personality right, to seek removal of infringement in advance by a court order granted to enjoining Michelin from dispatching its inspectors to dine at Iosei’s restaurant and referring to Iosei’s restaurant in the MICHELIN Guide.</p>
<b>IP advisers from your firm involved</b>	<p>陳和貴 律師/專利師 楊益昇 律師/專利代理人 蘇芳儀 律師/專利代理人 H. G. CHEN, Attorney-at-Law / Certified Patent Attorney Y. S. YANG, Attorney-at-Law / Certified Patent Agent Bonnie Su, Attorney-at-Law / Certified Patent Agent</p>
<b>Other IP firms involved</b>	N/A
<b>Date(s)</b>	<p>第一審判決日期 2021 年 11 月 5 日 First instance judgment rendered on November 5, 2021</p>
<b>Why was it important?</b>	<p>本案判斷重點在於 ISOSEI 餐廳之人格權、商譽及所有權是否受侵害，第一審法院認依據下述，均無構成侵害之虞：</p> <ol style="list-style-type: none"> <li>1. 言論自由為人民之基本權利，且原告經營 ISOSEI 餐廳，其所提供之餐飲服務乃可受公評之事，且縱然米其林指南未來將 ISOSEI 列入推薦，亦屬正面的意見評論，難認對其商譽有損害。</li> <li>2. 米其林指南對原告之營業自由及自我實現並無影響，原告是否要遵從米其林之標準，由其自己決定，米其林指南之內容對原告並無物理或法律上的強制力。</li> <li>3. 原告聲請事前限制被告派評審員，向原告提出用餐要約，屬濫用權利： 權利之行使不得違反公共利益或以損害他人為主要目的，被告派評審員前往用餐之目的，係為蒐集撰寫米其林指南、發表意見所需要的資料及親自體驗餐飲，乃被告行使言論自由權利所必要，如前所述，其匿名用餐對原告商譽、營業自由與自我實現均無損害，原告本件訴訟請求事前禁止米其林派評審員用餐，主要的目的係為限制米其林指南的言論自由，也會限制被告評審員提出要約之自由，係以損害他人為主要目的，為濫用權利，其請求不應准許。</li> <li>4. 被告派評審員至 ISOSEI 餐廳用餐，僅短暫停留於餐廳，並未破</li> </ol>

壞原告餐廳設備，也無妨礙餐廳對店面之占有，故對其並不構成任何所有權或占有之侵害之虞。

The issue whether Iosei's personality rights, goodwill, and proprietary rights are infringed should be examined as a key issue for making a court decision. Based on the following reasoning and holding, the judge determined no likelihood of infringement alleged against Michelin in the first-instance proceedings.

1. Freedom of speech is people's fundamental right. Iosei runs a restaurant and the dining services provided thereby are subject to public evaluation as a matter of course. As such, even if Michelin includes Iosei's restaurant and recommends it in the MICHELIN Guide in the future, Iosei's restaurant will be introduced in positive reviews and comments in the MICHELIN Guide. Hence, it is baseless to sustain the existence of harm to Iosei's goodwill.

2. The MICHELIN Guide does not affect Iosei's freedom of business and self-actualization, and it is within Iosei's sole discretion to decide whether or not to follow the MICHELIN Guide's criteria. The MICHELIN Guide has no compulsion on Iosei both in physical or legal aspects.

3. Iosei abuses its rights by requesting for restraining Michelin, in advance, from dispatching inspectors to make an offer of dining at Iosei's restaurant:

Rights cannot be exercised for the main purpose of violating public interests or damaging the others. Michelin dispatches its inspectors, if any, to dine at restaurants in order to collect relevant information required for making and presenting restaurant reviews in the MICHELIN Guide and to experience dining services in person, which is necessary for Michelin to exercise its freedom of speech. As elucidated in the foregoing, the Michelin inspectors' act of dining anonymously at Iosei's restaurant will cause no harm to Iosei's goodwill, freedom of business, and self-actualization. In this regard, in this civil action, Iosei's request for prohibiting Michelin, in advance, from dispatching its inspectors from dining at Iosei's restaurant is mainly to restrain Michelin's freedom of speech and also to restrict the Michelin inspectors' freedom of making offers. That is to say, Iosei makes this request for causing harm to other people and thus forms abuse of rights, and therefore, this request should not be granted.

4. If Michelin sends any of its inspectors to Iosei's restaurant for dining, the inspector will stop in at the restaurant without damaging any equipment there and without impeding Iosei's possession of the restaurant. Thus, Michelin will not constitute any likelihood of infringement upon Iosei's proprietary rights or possession.

### Example work 6

**Name and brief description of case / portfolio**

(專利侵權民事訴訟事)

本所客戶為台灣 A 發明專利之專利權人，客戶發現 X 公司在台灣販賣、使用之包裝飲用水產品侵害客戶台灣 A 發明專利，因此寄發警告函予 X 公司。X 公司以下列三點理由主張未侵害 A 發明專利：(1)A 發明專利不具有新穎性及進步性、(2)X 公司產品並未落入 A 發明專利之文義範圍、(3)X 公司產品係透過第三人自日本 Y 公司之關係企業購入，由於本所客戶與日本 Y 公司共有日本 B 發明專利(A 專利之日本對應案)，而台灣 A 發明專利亦主張日本 B 發明專利之優先權，因此 X 公司自日本 Y 公司關係企業購入之產品，是經日本 Y 公司授權銷售，而有國際耗盡原則之適用。本所客戶認為日本 Y 公司並非台灣 A 發明專利之專利權人或共有人，台灣 A 發明專利亦非日本 Y 公司授權本所客戶申請，且侵權產品並非本所客戶於日本所製造、銷售，故無權利耗盡之適用，因此對 X 公司提起訴訟。

第一審法院認為(1)A 發明專利具有新穎性及進步性、(2)X 公司產品落入 A 發明專利之文義範圍、(3)日本專利法雖規定專利權之共有人未得其他共有人同意仍能實施專利權，故在未經本所客戶同意之情況下，日本 Y 公司仍能獨自實施日本 B 發明專利，但本所客戶與日本 Y 公司既然共有日本 B 發明專利，應有經濟上或法律上之關係，且本所客戶與日本 Y 公司間未另有契約為特別約定之情況下，則應認定本所客戶與日本 Y 公司均同意彼此實施日本 B 發明專利。經法院函詢日本 Y 公司後發現，X 公司之產品確係日本 Y 公司之關係企業所銷售，因此該等產品有國際權利耗盡原則之適用。

本所客戶不服第一審判決並提起上訴，主張本所客戶並未就日本 Y 公司以及關係企業所生產及銷售之產品取得任何報酬，因此並無國際權利耗盡原則之適用。訴訟進行中，本所客戶與 X 公司達成和解。

A civil case arising from patent infringement:

Our client is the patentee of the Taiwanese invention patent at issue ("Patent A"). Our client issued a cease and desist letter to a local company ("Company X") upon information of Company X having been selling, using certain bottled water product which infringes upon Patent A. In response to said letter, Company X asserted non-infringement alleging the following in defense :

- (a) Patent A lacks novelty and non-obviousness.
- (b) The product being accused did not fall into the literal scope of Patent A.
- (c) The accused product was purchased (through a third party) from the affiliate of Company Y, a company based in Japan. Company Y and our client co-own Patent B in Japan, which is the Japanese corresponding patent of Patent A and the application for the latter was filed with priority claim based on Patent B. The accused product purchased from the affiliate of Company Y is accordingly duly authorized product. By operation of the rule of



	<p>exhaustion of right, therefore, the accused product is non-infringing.</p> <p>Our client sued Company X alleging patent infringement considering that Company Y holds no share of any kind in Patent A and the application for Patent A was not filed under Company Y's authorization plus the accused product was not fabricated, distributed in Japan by our client, namely owner of Patent A in Taiwan hence the rule of exhaustion of right is not invoked to operate.</p> <p>The court of first instance adjudicated the case and held as follows.</p> <p>(1) Patent A is non-obvious and fulfills the inventiveness requirement.</p> <p>(2) The accused product of Company X indeed falls into the literal scope of Patent A.</p> <p>(3) Under the Japan Patent Act, the co-owner of a patent is free to practice the patent owned on its own without obtaining prior consent from the other co-owner(s) and this is why Company Y could practice Patent B without claimant's (our client's) prior consent. Notwithstanding, given their sharing the ownership of Patent B, there must exist relationship economic and/or legal in nature by and between claimant (our client) and Company Y. Absent any relevant separate arrangement between them, it should be found that claimant and Company Y have met their minds on their respective practice of Patent B. According to Company Y's reply to the court's request for information, the accused product of Company X was indeed distributed by the affiliate of Company Y. In view of the foregoing, the rule of exhaustion of right applies.</p> <p>Our client appealed stating that it has received no remuneration of any kind from Company Y or its affiliate by reason of their fabrication and/or distribution of the accused product and so the rule of exhaustion of right does not operate. The proceeding of this civil case concluded with an in-court settlement consummated by the parties.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>陳和貴 律師/專利師 楊益昇 律師/專利代理人 吳宗樞 律師/專利代理人 H. G. CHEN, Attorney-at-Law / Certified Patent Attorney Y. S. YANG, Attorney-at-Law / Certified Patent Agent C. H. WU, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A.</p>
<p><b>Date(s)</b></p>	<p>2019年10月30日：提起民事訴訟。 2020年2月24日：第一審進行第一次準備程序。 2020年3月9日：第一審進行第一次言詞辯論程序。 2020年10月20日：第一審進行第五次言詞辯論程序(辯論終結)。 2020年12月1日：第一審宣判。</p>

	<p>2020 年 12 月 28 日：聲明上訴。          2020 年 4 月 22 日：第二審做成和解筆錄。          2019-10-30: Civil action filed.          2020-02-24: Preparatory proceeding in the court of first instance commenced.          2020-03-09: 1<sup>st</sup> oral session in the court of first instance.          2020-10-20: 5<sup>th</sup> oral session (and the summation) in the court of first instance.          2020-12-01: Announced the decision rendered by the court of first instance.          2020-12-28: Client filed the statement of appeal.          2020-04-22: In-court settlement reached by and between the parties and transcribed on the record.</p>
<p><b>Why was it important?</b></p>	<p>1. 法院對於 A 發明專利之專利範圍解釋，有效性及侵權之判斷，均與本所主張相同。          2. 雖然一審法院認為本件系爭產品有國際耗盡原則之適用而判決本所客戶敗訴，但本所推測一審法院之見解似與最高法院之見解不符，且一審法院對於 A 發明專利之專利範圍解釋、專利有效性及侵權之判斷，均有利於本所客戶，故 X 公司仍與本所客戶在第二審時達成和解。</p> <p>1. The scope of Patent A and the validity issue and the infringement alleged were construed, adjudicated and decided by the court as we presented during the proceeding.          2. Much as the court of first instance holds the operability of the rule of exhaustion of right in its favor, in view of          (i) the finding the accused product being non-infringing by operation of the rule of exhaustion of right made by the court of first instance appearing to be incompatible with the relevant opinion held by the supreme court; and          (i) the court's construction of the scope of Patent A and findings pertaining to the validity and the infringement claimed being favorable to our client,          Company X agreed to settle the dispute with our client before the proceeding in the superior court ended.</p>

**Example work 7**

<p><b>Name and brief description of case/portfolio</b></p>	<p>原告(即客戶)為世界著名製造玩具積木之丹麥公司，而被告主要進口及銷售玩具積木(包括客戶積木及其他品牌積木)及其他商品之台灣商號。</p> <p>被告並非原告之代理商或授權經銷商，其未經原告同意，使用原告商標貼紙於仿襲原告玩具積木貨車造型之實體貨車上，及特賣會招牌上，同時在被告的臉書網頁及 YOUTUBE 宣傳該實體貨車為「行動 XX(原告商標)貨車」及特賣會之訊息，並在特賣會之門口凸顯標示「XX(原告商標)積木特賣會」之布條，銷售被告之商品。</p> <p>原告於 2020.5 間向智慧財產法院(現在之智慧財產及商業法院)依商標法及公平交易法相關規定，對被告提起民事訴訟請求排除侵害及損害賠償，而被告爭執其行為不構成侵權因有商標權利耗盡原則之適用。因此，法官依法先就被告之行為是否構成侵權做成中間判決。</p> <p>The plaintiff (TIPLO's client) is a Denmark-based company globally renowned for making toy bricks, and the defendant is a Taiwanese toy dealer mainly engaged in importing and selling toy bricks (including the toy bricks of the plaintiff and of other brands) and other products.</p> <p>The defendant who is neither the plaintiff's authorized agent nor distributor, without the plaintiff's prior consent, had been using the stickers bearing the plaintiff's trademarks on the real truck, which was an imitation of the plaintiff's toy truck, and also on the signboard of its sale events, advertising the information with respect to its sale events and the said truck on its FB fan page and on the YOUTUBE as the "Mobile XX (<i>the plaintiff's trademark</i>) Truck", and hanging an advertising banner reading "Sale Event for XX (<i>the plaintiff's trademark</i>) Toy Bricks Products" at the entrance of the sale events to sell its products.</p> <p>In May 2020, the plaintiff acted upon the Trademark Act and Fair Trade Act of Taiwan to initiate a civil action with the Intellectual Property Court (now, the Intellectual Property and Commercial Court) to seek infringement removal and claim damages against the defendant. The defendant argued no trademark infringement by asserting the applicability of right exhaustion doctrine in this civil case, and hence, the judge made an interlocutory judgment on the issue about whether the defendant's act constitutes infringement.</p>
<p><b>IP advisers from our firm</b></p>	<p>陳和貴 律師/專利師 吳婷婷 律師/專利師 蘇芳儀 律師/專利代理人 H. G. CHEN, Attorney-at-Law / Certified Patent Attorney TING TING WU, Attorney-at-Law / Certified Patent Attorney BONNIE SU, Attorney-at-Law / Certified Patent Agent</p>

<p><b>Date(s)</b></p>	<p>智慧財產及商業法院 109 年度民商訴字第 27 號民事中間判決 (裁判日期：2021.02.19) <i>Interlocutory judgment rendered by the Taiwan Intellectual Property and Commercial Court under docket (109) Min-Shang-Su-Zi No. 27 [2020] (Rendered on February 19, 2021)</i></p>
<p><b>Why was it important?</b></p>	<p>「商標權利耗盡」原則之適用標準，限於平行輸入之「真品本體」，至於銷售平行輸入之「真品本體」以外，利用商標權人註冊商標之宣傳廣告行為，仍應取得商標權人之同意或授權，並無上開原則之適用。</p> <p>理由：</p> <ol style="list-style-type: none"> <li>1. 被告使用原告商標貼紙在系爭貨車及特賣會之招牌上的行為，使消費者與原告商標所表彰之商品或服務產生聯想，構成商標使用。被告使用原告商標貼紙縱為真品，就該貼紙本身，原告不得主張商標權，但被告基於行銷玩具商品之目的而使用原告商標貼紙，被告將原告商標貼紙作為指示自己商品或服務來源之廣告物件，已將該貼紙轉化作為其行銷玩具商品相關之廣告，非單純交易流通貼紙商品。基於衡平消費消費者之市場自由競爭利益與維護商標權人合法權益，被告上開使用原告商標貼紙(已成為一廣告物件)之行為，仍應得原告之同意，故被告的辯稱不可採。</li> <li>2. 被告並非原告之經銷商或代理商，且被告銷售之商品，除原告積木商品外，亦包括其他玩具商品。被告在特賣會場，凸顯使用原告商標，卻未使用被告店名作為表彰商品或服務來源之標識，則被告使用原告商標之行為，已逾越純粹做為商品或服務本身說明之用意，不構成合理使用。因此，被告利用原告商標貼紙於貨車車體或店面招牌之行為，侵害原告商標權，同時，亦使原告商標所表彰原告商品來源關連性受到淡化，而有損原告商標權之識別性之虞，視為侵害商標權。</li> <li>3. 原告之商標享有極佳商譽，為原告長期努力經營值得保護之投資成果，被告之行為顯係利用原告商標之著名度，而有不當攀附原告長期投入行銷商標所享有之商譽，進而爭取交易機會；及被告使用原告商標作為銷售玩具商品之廣告，實屬高度抄襲原告之知名表徵，節省其行銷成本，乃不當利用原告長期努力之成果以行銷自己商品，榨取原告之努力成果，足以影響交易秩序之顯失公平行為，違反公平交易法之規定。</li> </ol> <p><b>Trademark rights are exhausted only for parallel imported “genuine products per se”. As such, except for sale of parallel imported “genuine products per se”, the act of using any trademark proprietor’s registered trademark(s) for advertising should still be subject to the trademark proprietor’s prior consent or authorization with no basis to assert trademark right exhaustion.</b></p> <p>Reasoning:</p>

1. The defendant's use of the stickers bearing the plaintiff's trademarks on the said truck and on the signboard of the sale events constitutes trademark use because the use of the plaintiff's trademarks has caused consumers to form association with the products or services represented by the plaintiff's trademarks. Even if the said stickers are genuine ones, the plaintiff should not assert its trademark right to the stickers because the trademark rights on the stickers are exhausted. Nevertheless, the stickers used by the defendant for marketing its products should be considered as advertising articles that designate the source of its products or services; that is to say, the defendant had already turned the stickers into advertisement for marketing its toy products, instead of making the stickers simply as products for transaction. As such, for seeking a balance between the interest of free competition on market and trademark proprietor's legal rights and interest, the court found that the defendant should not use the said stickers being considered as advertising articles without the consent of the plaintiff. Therefore, the defendant's defensive argument is inadmissible.

2. Moreover, the defendant, being neither the plaintiff's authorized distributor nor agent, sold not only the plaintiff's toy bricks products but also the toys of other brands. And it used the plaintiff's trademarks at the sale events in a prominent manner without using its own store name as a sign that represented the source of the products or services it offered and sold. The foregoing facts explains that the defendant's use of the plaintiff's trademarks runs out of the scope of use for simply describing the products or services the defendant provided as alleged by itself, and therefore, such use does not amount to fair use of trademark. The court sustained the defendant's infringement upon the plaintiff trademark rights, and in the meantime, by diluting the relevance between the plaintiff's products and its trademark as a source of its products, and thus leading to the likelihood of reducing the distinctiveness of the plaintiff's trademarks.

3. In addition, the plaintiff has extraordinary fine reputation for its trademarks, which comes from the plaintiff's long-term efforts and investments and deserves protection. As opposed to the plaintiff's continued investment, the defendant, by taking advantage of the eminence of the plaintiff's trademarks, improperly took a free ride on the business reputation the plaintiff has been building up for its trademarks, so as to seek business opportunities. Furthermore, the defendant's act forms imitation of the plaintiff's well-known symbol (*namely, trade dress*) to a high extent, so as to save marketing cost. By doing so, the defendant improperly took advantage of the outcome of the plaintiff's long-term efforts to promote its products and thus exploited the outcome of the plaintiff's efforts, which forms the obviously unfair conduct that is able to affect the trading order

	and hence violate the Fair Trade Act.
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**Example work 8**

<p><b>Name and brief description of case/porfolio</b></p>	<p>(商標侵權民事訴訟)</p> <p>客戶在日本為「A」商標之創用人及商標權人，指定使用於「運動、服飾用品」等商品，且在台灣亦在相同商品類別就「A」商標取得註冊。但於韓國，在相同商品類別上圖樣高度近似於「A」之商標「B」，則由與客戶無任何關係之某韓國公司取得註冊。</p> <p>被告 1 為被告 2 (公司) 之代表人，被告 2 除了直接向前揭韓國公司購買並輸入上有「B」商標之運動、服飾用品於我國銷售，並以「B」商標之圖樣行銷前揭商品外，被告 1 並聲稱被告 3 於台灣就「代理進出口服務、櫥窗設計」等服務上取得「B」商標之註冊，而被告 3 及被告 4 授權被告 1 (被告 2) 得於台灣使用「B」註冊商標。</p> <p>關於被告 1 及 2 部分，法院認為：(1) 被告 2 販售、使用之商標圖樣「B」，與「A」商標有致生混淆誤認之虞，構成商標權侵害。(2) 被告 3 及被告 4 授權予被告 1 之授權範圍並不包括「A」商標，被告 2 並無進口、銷售高度近似於「A」商標之商品之權利；被告 2 未經客戶同意或授權，自該韓國公司進口使用「B」商標之運動、服飾用品於我國銷售，無法主張有合法權源，亦不可向客戶主張商標權之權利耗盡。(3) 客戶得依法請求被告 2 不得再為商標權侵害行為，且因被告 2 有侵權故意，客戶得向其請求損害賠償，被告 1 亦應負連帶賠償之責。</p> <p>(Civil Action for Trademark Infringement)</p> <p>Our client creates and owns the trademark “A” in Japan with the trademark designated to be used on “sporting articles and apparel products” (hereinafter referred to as “Mark A”) and also has Mark A duly registered in Taiwan for designated use on the same categories of products. In Korea, nevertheless, a Korean company that is not affiliated with the client registers another trademark B that is highly similar to Mark A for use on the products of the same categories (hereinafter referred to as “Mark B”).</p> <p>Defendant 1 is the legal representative of the company, defendant 2. Defendant 2 had not only purchased and imported directly from the aforesaid Korean company the sporting articles and apparel products bearing Mark B for sale in Taiwan, but also marketed these products under Mark B. Moreover, Defendant 1 alleged that Defendant 3 had</p>
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	<p>successfully registered Mark B for services for “agency of importing and exporting and window display designing” in Taiwan, and that Defendant 3 and Defendant 4 duly authorized Defendant 1 (Defendant 2) to use Mark B in Taiwan.</p> <p>With respect to Defendant 1 and Defendant 2, the judge provided the following reasoning and holding:</p> <p>(a) Defendant 2 committed trademark infringement by selling the products bearing Mark B and using Mark B which was likely to cause confusion with Mark A;</p> <p>(b) The scope of Defendant 3’s and Defendant 4’s authorization for Defendant 1’s use of Mark B did not include the use of Mark A, and thus Defendant 2 did not have the right to import and sell the products bearing a mark highly similar to Mark A; also, Defendant 2 had no legal basis to claim that it had legitimate source of right for importing from the said Korean company the sporting articles and apparel products bearing Mark B for sale in Taiwan nor to assert exhaustion the client’s trademark rights; and</p> <p>(c) The client is entitled to request according to the laws that Defendant 2 should never repeat its trademark infringement and may claim damages against Defendant 2 for Defendant 2’s intention for infringement, while Defendant 1 shall be held jointly and severally liable for the damages claimed.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>劉中城 律師/專利師 洪振豪 律師/專利代理人 CHUNG-CHEN LIU, Attorney-at-Law / Certified Patent Attorney CHENG-HAO HUNG, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A</p>
<p><b>Date(s)</b></p>	<p>2020年9月17日：客戶起訴。 2020年11月13日：第一次調解。 2021年3月15日：第一次開庭（準備程序）。 2021年4月13日：第二次調解。 2021年9月23日：第二次開庭（準備程序）。 2021年11月5日：第三次開庭（準備程序）。 2022年1月19日：第四次開庭（言詞辯論）。 2022年3月9日：第五次開庭（言詞辯論）。 2022年4月27日：宣判。 2022年7月27日：裁定駁回被告1及被告2之上訴確定。 2020-09-17: A civil action initiated by the client 2020-11-13: The 1<sup>st</sup> mediation conducted 2021-03-15: The 1<sup>st</sup> hearing held (for preparatory proceedings) 2021-04-13: The 2<sup>nd</sup> mediation conducted 2021-09-23: The 2<sup>nd</sup> hearing held (for preparatory proceedings) 2021.11.05: The 3<sup>rd</sup> hearing held (for preparatory</p>

	<p>proceedings) 2022.01.19: The 4<sup>th</sup> hearing held (for oral argument sessions) 2022.03.09: The 5<sup>th</sup> hearing held (for oral argument sessions) 2022.04.27: Adjudication 2022.07.27: A final ruling made to dismiss Defendant 1's and Defendant 2's appeal</p>
<p><b>Why was it important?</b></p>	<p>本案牽涉到真品平行輸入概念之釐清。亦即，當韓國高度近似於「A」商標圖樣之「B」註冊商標權人非客戶，且被告 1 及被告 2 無法證明客戶與該韓國公司有何授權商標使用或出於同源之關聯性時，該韓國公司於市場上第一次販售使用「B」商標圖樣之運動、服飾用品時，其商標權固已耗盡，但該耗盡之效力並不影響客戶於我國就「A」商標享有之商標權。從而，被告 2 既自韓國輸入並於台灣銷售「B」商標商品，客戶之商標權並未耗盡，仍得對之主張商標權侵害。</p> <p>This civil case relates with the concept regarding parallel imported genuine products. In this case, Mark B was highly similar to Mark A and the Korean proprietor of Mark B was not the client. Moreover, Defendant 1 and Defendant 2 could not prove the existence of trademark licensing between the client and the said Korean company for trademark use or the existence of source relevance of Mark A and Mark B. In this regard, when the said Korean company sold the sporting articles and apparel products bearing Mark B on market for the first time, the said company's trademark right to Mark B had been exhausted, while the effect of its trademark right exhaustion did not affect the client's trademark right to Mark A in Taiwan. That is to say, Defendant 2 imported the products bearing Mark B from Korea for sale in Taiwan, but the client's trademark rights were not exhausted, and hence, client still had sufficient basis to assert trademark infringement against the defendants.</p>



**Example work 9**

<p><b>Name and brief description of case/portfolio:</b></p>	<p>案件類型 商標申請案一覆 OA 系爭商標 ARGENTUM 註冊號數 02123686 申請人英商阿根敦藥商有限公司 Type Trademark Application - Response to Office Action Subject TM ARGENTUM Reg. No. 02123686 Applicant Argentum Apothecary Limited</p>
	<p>指定商品/服務</p> <p><b>03</b> 化粧品；化粧品組；護膚用化粧製劑；護膚用面霜；不含藥護膚品；不含藥美容護膚品；化粧用護膚乳霜；護膚乳霜，護膚水，護膚油及護膚製劑；臉部用不含藥乳霜；美容霜；潤膚霜；不含藥潤膚霜；防皺霜；化粧用油；人體用清潔劑；面膜；香水；香皂；洗髮精；非醫療用浴鹽。（本類無優先權）。</p> <p><b>05</b> 含藥面霜；含藥護膚用面霜；含藥護膚品；含藥化粧用護膚乳霜；含藥護膚乳霜，含藥護膚水，含藥護膚油及含藥護膚製劑；臉部用含藥乳霜；含藥潤膚霜；礦泉水浴用鹽；皮膚用藥劑；含藥化粧品；含藥化粧品組；含藥美容護膚品；含藥美容霜。（本類無優先權）。</p> <p><b>35</b> 有關化粧品、化粧品組、護膚品、護膚製劑、護膚霜、面霜、美容霜、防皺霜、化粧用油、人體用清潔劑、面膜、香水、香皂、洗髮精、浴鹽（所有上述商品為含藥及不含藥）之零售服務；有關化粧品、化粧品組、護膚品、護膚製劑、護膚霜、面霜、美容霜、防皺霜、化粧用油、人體用清潔劑、面膜、香水、香皂、洗髮精、浴鹽（所有上述商品為含藥及不含藥）之線上零售服務；有關化粧品、化粧品組、護膚品、護膚製劑、護膚霜、面霜、美容霜、防皺霜、化粧用油、人體用清潔劑、面膜、香水、香皂、洗髮精、浴鹽（所有上述商品為含藥及不含藥）之郵購服務；所有上述服務之諮詢、顧問及資訊服務。（本類無優先權）。</p> <p><b>44</b> 優先權日 1 0 7 0 6 2 5 歐盟：美容院服務；美容諮詢；美容服務；芳香療法服務；臉部美容服務；為人類之美容服務；皮膚保養之美容院服務；皮膚保養服務；所有上述服務之諮詢、顧問及資訊服務。</p> <p><b>Designated Goods/ Services</b></p> <p><b>03</b> Cosmetics; toiletries; cosmetic preparations for skin care; creams for the care of the skin; non-medicated skin care products; non-medicated skin care beauty products; cosmetic skin care creams; skin care creams, lotions, oils and preparations; creams (non-medicated) for the face; beauty creams; skin creams (cosmetic); skin creams (non-medicated); anti-wrinkle cream; oils for cosmetic purposes; cleaning preparations for human body; beauty masks; perfumes; soap; shampoo; bath salts, not for medical purposes.</p> <p><b>05</b> Medicated skin creams; medicated creams for the care of the skin;</p>

medicated skin care products; medicated cosmetic skin care creams; medicated skin care creams, lotions, oils and preparations; creams (medicated) for the face; skin creams (medicated); salts for mineral water baths; pharmaceutical preparations for skin care; medicated cosmetics; medicated toiletries; medicated skin care beauty products; medicated beauty creams.

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Retail services in connection with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid); on-line retail services connected with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid); mail order services connected with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid); consultancy, advisory and information services for or in relation to all of the aforesaid services.

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(Priority date June 25, 2018, European Union) Beauty salon services; beauty consultancy; beauty care services; aromatherapy services; facial beauty care services; beauty care for human beings; skin care salon services; services for the care of the skin; consultancy, advisory and information services for or in relation to all of the aforementioned services.

本所當事人之「ARGENTUM」商標申請案(以下稱「本件商標」)於 2018 年 12 月為智慧財產局審查員發核駁理由先行通知書，謂：

1. 「ARGENTUM」為化學元素「銀」之外文，而銀離子有消毒功能，故本件商標指定使用於化粧品等全部之商品及服務，不具識別性，應不得註冊(依商標法第 29 條第 1 項第 1 款核駁)。

2. 又本件商標與他人註冊在先之「Argent」商標構成近似，且本件商標指定之「購物中心，網路購物，郵購，百貨公司，電視購物；有關化粧品、化粧品組、護膚品、護膚製劑、護膚霜、面霜、美容霜、防皺霜、化粧用油、人體用清潔劑、面膜、香水、香皂、洗髮精、浴鹽(所有上述商品為含藥及不含藥)之郵購服務」服務，亦與上述商標之指定服務構成類似。故本件商標於上述指定商品/服務之註冊申請，有致相關消費者混淆誤認之虞，應不予准許(依商標法第 30 條第 1 項第 10 款核駁)。

就上述核駁理由先行通知書，本所的對應如下：

1. 就商標法第 30 條第 1 項第 10 款部分：本所與審查員溝通後，將「有關化粧品、化粧品組、護膚品、護膚製劑、護膚霜、面霜、美容霜、防皺霜、化粧用油、人體用清潔劑、面膜、香水、香皂、洗髮精、浴鹽（所有上述商品為含藥及不含藥）之郵購服務」移列於「3519 特定商品零售批發組群」，從而將上述服務排除於商標法第 30 條第 1 項第 10 款之適用範圍外；其餘衝突服務（購物中心，網路購物，郵購，百貨公司，電視購物）則經當事人指示減縮。經上述處理後，本件商標已無商標法第 30 條第 1 項第 10 款之適用。

2. 就商標法第 29 條第 1 項第 1 款部分：本所於 2019 年 6 月、2020 年 9 月先後提交二次意見書，並提呈大量使用證據進行答辯，終使審查員認定本件商標具先天識別性，而於 2021 年為核准註冊之審定。

#### Case Brief

Regarding the application for the subject TM “ARGENTUM”, the IPO in the official letter dated December 2018 reasoned:

1. “ARGENTUM” is a chemical element “silver” in Latin and has bactericidal function. Such a term designating for use on the designated goods or services in connection with cosmetics does not possess distinctiveness and should not be granted registration (Item 1, Para. 1, Article 29 of the Trademark Law).

2. The subject trademark is similar to TM “Argent” priorly registered by another person, and the designated “shopping malls, network shopping, mail order, department stores, TV shopping; mail order services connected with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid)” are similar to the designated services of the cited trademark. Therefore, the subject trademark filed for registration on the said services is likely to cause confusion and misidentification to relevant consumers and should not be registrable (Item 10, Para. 1, Article 30 of the Trademark Law).

Our response:

1. Item 10, Para. 1, Article 30 of the Trademark Law:

After persuading the Examiner that “mail order services connected with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid)” should be re-classified into Subclass 3519 titling “retailing and wholesales of specified products” to which Item 10, Para. 1, Article 30 of the Trademark Law shall not apply anymore; and deleting “shopping malls, network

	<p>shopping, mail order, department stores, TV shopping” from the specification of services, the subject trademark is not violative of Item 10, Para. 1, Article 30 of the Trademark Law.</p> <p>2. Item 1, Para. 1, Article 29 of the Trademark Law:</p> <p>The Applicant respectively submitted two arguments in June 2019 and September 2020 with ample use proof, and the Examiner finally was convinced that the subject trademark is inherently distinctive and made an approval decision in January 2021.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>林志剛 律師／專利師 黃闡億 律師／專利代理人 J. K. LIN, Attorney-at-Law / Certified Patent Attorney CHEGN-YI HUANG, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A</p>
<p><b>Date(s)</b></p>	<p>2018/12/10 核駁先行通知。 2019/06/21 本所申覆意見。 2020/04/27 公文函（仍認定有不得註冊事由）。 2020/09/01 本所補充意見。 2021/01/15 核准審定。 2021/02/16 註冊公告。 2018.12.10 First objection raised by the IPO 2019.06.21 Response 2020.04.27 Official letter (for other unregistrable event) 2020.09.01 Supplemental argument 2021.01.15 Approval decision 2021.02.16 Publication for registration</p>
<p><b>Why was it important?</b></p>	<p>1. 就商標法第 30 條第 1 項第 10 款部分：</p> <p>由於商標之近似程度較高，故本所評估在類似商品上，答辯的成功機率不高。惟經本所積極與審查員溝通後，以移列服務組群之方式，使「有關化粧品、化粧品組.....之郵購服務」等與當事人之營業直接相關之服務，得被排除於類似商品/服務之認定範圍外，而有取得註冊之可能。足見在涉及混淆誤認之虞的案件裡，除直接就商標不近似、商品/服務不類似為答辯外，有時更可以透過移列商品所屬組群之方式，排除混淆誤認之虞之認定。</p> <p>2. 就商標法第 29 條第 1 項第 1 款部分：</p> <p>查本件商標在經營上確實有強調商品中銀離子成分的消毒作用，故初步判斷要證明先天識別性並不容易，但 2019 年 6 月本所第一次提交意見書時，由於本件商標在台使用證據並不多，僅有數家台灣媒體報導以及網路賣場網頁等資料，故在意見書中，本所仍以本件商標之「ARGENTUM」文字為罕見外文、且已在諸多國家取得註冊等主張先天識別性之答辯為主要論點，並輔以本件商標之市場使用情形，以加強論證本件商標具識別性。</p>

2020 年，審查員通知本件商標經審查後仍認為無識別性，應予以核駁。本所將其情事通知當事人後，得知本件商標品牌正於該年與台灣代理商簽約而正式引入台灣市場，且於 2019 年度該品牌對台已達到約新台幣 200 萬元的銷售額。於是本所乃於 2020 年 9 月再次補充意見，於理由書中，除詳細說明本件商標於台灣之銷售情形外，亦將本件商標實際標示於產品及實體店面之圖片，放大於理由書中，再次強調本件商標於實際使用時確實是作為商標使用，絕無可能使消費者認為是說明文字。

於呈遞第二次意見書後，本所電詢審查員，得知審查員綜合審酌上述第一、二次意見書之所有證據資料後，認定本件商標應具先天識別性，而得准予註冊。

由上可知，商標的使用證據除可用以證明後天識別性外，亦可以透過論述技巧，將使用證據同時用於論證商標的先天識別性，以增進商標申請案的核准成功率。

3. 另外，本所於網路蒐集使用資料時，發現本件商標之台灣代理商有將「ARGENTUM」翻譯為「歐臻廷」並實際使用之情事。經本所通知後，當事人旋即委託本所另就中、英文結合之「歐臻廷 ARGENTUM」提出申請，並順利就該商標取得註冊保護，可見透過商標代理人的積極通知，可以有效避免國外品牌之中文名稱遭他人搶註的麻煩情況，對於維護該品牌於中文市場的商業價值，十分有裨益。此外，經本所於另案陳述意見後，審查員亦接受「歐臻廷 ARGENTUM」與他人先註冊之「Argent」商標並非近似商標，而使當事人得就原本「ARGENTUM」商標與該商標衝突之「購物中心，網路購物，郵購，百貨公司，電視購物」服務取得註冊保護，進而保留了其多角化經營之可能性，可以說是一舉兩得。

1. Item 10, Para. 1, Article 30 of the Trademark Law:

Even though the chance to successfully register the disputed trademark which is closely similar to the cited trademark designating for use on similar goods/services is not high, the Applicant was making every effort to persuade the Examiner to re-classify “mail order services connected with cosmetics, toiletries, skin care products, skin care preparations, skin creams, face creams, beauty creams, anti-wrinkle creams, oils for cosmetic purposes, cleaning preparations for human body, beauty masks, perfumes, soaps, shampoos, bath salts, (medicated and non-medicated versions of all the aforesaid)” into another Subclass not directly relative and similar to the services of the cited trademark to acquire registration, which means to exclude being considered likely to cause confusion and misidentification, the response may focus on dissimilarity of trademarks and goods/services, and re-classifying of goods/services would work sometimes.

2. Item 1, Para. 1, Article 29 of the Trademark Law:

It is quite hard to evidence that the disputed trademark is inherently distinctive because silver’s bactericidal function of “ARGENTUM” products has been specifically highlighted. However, the response we

	<p>made in June 2019 mainly focused on the uncommon word “ARGENTUM” and world-wide registrations with actual use proof at marketplace to claim inherent distinctiveness, despite there are only some local media reports and on-line shopping for use in Taiwan.</p> <p>In early 2020, the Examiner sent an official letter stating that the disputed trademark after reviewing still is not distinctive and should be rejected. The Applicant being notified expressed that they already signed a contract with a local agent and launched the disputed trademark in the same year and the 2019 sales figure in Taiwan reached two million NT dollars. In September 2020, the Applicant further submitted a supplemental argument to explain sales of the disputed trademarked goods in Taiwan and to show in photos use of the disputed trademark on products and physical stores, so that the disputed trademark actually is used as a trademark and consumers would not think it is descriptive.</p> <p>After examining all the evidence/materials lodged by the Applicant, the disputed trademark is determined inherently distinctive and registrable.</p> <p>Given the above, trademark use proof may evidence acquired distinctiveness as well as inherent distinctiveness through debating skills, to enhance chances of trademark registrability.</p> <p>3. Our internet searches reveal the Applicant’s local agent is using “歐臻廷” as the Chinese version for “ARGENTUM”. Then another trademark application for “歐臻廷 ARGENTUM” was filed under the Applicant instruction following our suggestion and thereafter registered smoothly. Our prompt action does effectively protect the Chinese version of client’s brand from being pirated as well as its commercial value in Chinese market. Further, the Examiner also accepted our argument for the dissimilarity between TM “歐臻廷 ARGENTUM” and TM “AGENT” priorly registered by another person and granted the registration to the conflicting “shopping malls, network shopping, mail order, department stores, TV shopping”.</p>
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### Example work 10

<b>Name and brief description of case/portfolio:</b>	<p>案件類型 商標申請案—覆 OA 系爭商標 PRINCIPLE POWER 註冊號數 02201443 申請人美商原理電力公司 Type Trademark Application - Response to Office Action Subject TM PRINCIPLE POWER Reg. No. 02201443 Applicant Principle Power, Inc.</p>
	<p>指定商品/服務 07 風力渦輪機及風力渦輪機之葉片、葉轂；風力渦輪機之機械式控制裝置；</p>

風車塔及支柱，風車支架；風力渦輪機使用之機器底座。

37

風力發電廠、風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構之施工及修繕；風力發電廠、風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的施工諮詢。

40

發電；風力能源生產之諮詢服務。

42

具有多個風力渦輪機平台的離岸海上風力發電廠的設計和開發，每個平台都配備一個用於發電的風力渦輪機支撐結構和風力渦輪機；風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的設計和開發。

Designated Goods/ Services

07

Wind turbines and blades, blade hubs for wind turbines; mechanical control device for wind turbines; windmill tower and pillar, windmill bracket; machine base for wind turbine.

37

Construction and maintenance of wind farms, wind turbines, wind turbine platforms, and wind turbine support structures; construction consultation of wind farms, wind turbines, wind turbine platforms, and wind turbine support structures.

40


Generation of electrical power; Consulting services in the field of wind energy production.

42

Design and development of offshore wind farms having multiple wind turbine platforms each outfitted with a wind turbine support structure and a wind turbine, for the generation of power; design and development of wind turbines, wind turbine platforms, and wind turbine support structures.

本所當事人之「PRINCIPLE POWER」商標申請案（以下稱「本件商標」）於 2020 年 10 月為智慧財產局審查員發核駁理由先行通知書，謂：

1. 本件商標與他人註冊在先之「Principal」等商標（以下稱「引據商標 1」）構成近似，且指定於第 7 類之「風力渦輪機之機械式控制裝置」商品，與上述商標指定使用之「光電感應器」商品，構成類似。

2. 又本件商標與他人註冊在先之「Principal」等商標（以下稱「引據商標 2」）亦構成近似，且指定於第 42 類之「風力發電廠、風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的設計和開發」服務，與上述商標之「不動產經營管理」等服務，構成類似。

故本件商標於上述指定商品/服務之註冊申請，有致相關消費者混淆誤認之虞，應不予准許（依商標法第 30 條第 1 項第 10 款核駁）。

	<p>惟經本所申覆意見後，審查員乃同意本件商標之「風力渦輪機之機械式控制裝置」商品，與引據商標 1 之「光電感應器」並非類似商品，且本件商標之「風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的設計和開發」商品，與引據商標 2 之「不動產經營管理」亦非類似服務；另外，本件商標之「風力發電廠的設計和開發」服務，經修改為「具有多個風力渦輪機平台的離岸海上風力發電廠的設計和開發，每個平台都配備一個用於發電的風力渦輪機支撐結構和風力渦輪機」後，亦與引據商標 2 之「不動產經營管理」不構成類似服務。最後，本件商標在未減縮任何商品/服務的情形下，於 2021 年 11 月獲准註冊。</p> <p><b>Case Brief</b></p> <p>Regarding the application for the disputed TM “PRINCIPLE POWER”, the IPO in the official letter dated October 2020 stated that the disputed trademark filed for registration on the above designated goods/services is likely to cause confusion and misidentification to relevant consumers and should be rejected (in accordance with Item 10, Para. 1, Article 30 of the Trademark Law):</p> <ol style="list-style-type: none"> <li>1. The disputed trademark is similar to TM “Principal” priorly registered by another person (1st cited trademark), and the designated “mechanical control device for wind turbines” in class 7 is similar to “photoelectric sensor” of the cited trademark.</li> <li>2. The disputed trademark is similar to another TM “Principal,” priorly registered by a third person (2nd cited trademark), and the designated “design and development of wind farms, wind turbines, wind turbine platforms, and wind turbine support structures” in class 42 are similar to “real estate management” of the cited trademark.</li> </ol> <p>After reviewing our response, the Examiner accepted the dissimilarity between the designated “mechanical control device for wind turbines” in class 7 of the disputed trademark and “photoelectric sensor” of the 1st cited trademark, and the dissimilarity between the designated “design and development of wind turbines, wind turbine platforms, and wind turbine support structures” in class 42 of the disputed trademark and “real estate management” of the 2nd cited trademark. Further, after amending “design and development of wind farms” to become “design and development of offshore wind farms having multiple wind turbine platforms each outfitted with a wind turbine support structure and a wind turbine, for the generation of power”, there is no similarity to “real estate management” of the 2nd cited trademark anymore. The disputed trademark without any reduction of goods/services was approved registration in November 2021.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>林志剛 律師／專利師 黃闡億 律師／專利代理人 J. K. LIN, Attorney-at-Law / Certified Patent Attorney CHEGN-YI HUANG, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A</p>



<p><b>Date(s)</b></p>	<p>2020/10/16 核駁先行通知。 2020/05/18 本所申覆意見。 2021/11/18 核准審定。 2021/02/01 註冊公告。2020.10.16 First objection raised by the IPO 2020.05.18 Response 2021.11.18 Approval decision 2021.02.01 Publication for registration</p>
<p><b>Why was it important?</b></p>	<p>本件商標與引據商標 1、2 之近似程度頗高，故本所於申覆理由時，將答辯重心擺在雙方商標之指定商品/服務不類似上。</p> <p>其中，本件商標指定之「風力渦輪機之機械式控制裝置」與引據商標 1 指定在先之「光電感應器」，雖依智慧財產局所編訂之「商品及服務分類暨相互檢索參考資料」屬於類似商品，惟經本所援引案情類似之最高行政法院判決及異議審定書之見解後，已說服審查員二者並非類似商品。由此可見，在混淆誤認之虞的案件中，相較於認定標準較為主觀的「商標近似程度」，在「商品/服務是否類似」這塊，實務見解對於審查員的判斷應有較大影響。故而在此類案件，答辯時能否充分運用類似案情之實務見解以說服審查員，實為商標申請是否能成功的關鍵因素。</p> <p>又本件商標指定之「風力發電廠、風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的設計和開發」服務，與引據商標 2 所指定之「不動產經營管理」等服務亦屬須相互檢索之類似服務。就此，本所於申覆理由時，以較大篇幅詳述二者於性質、產業別、服務提供者、行銷管道、消費客群等因素之不同之處，強力主張二者並非類似服務。審查員審查後，旋即同意本件商標於「風力渦輪機、風力渦輪機平台和風力渦輪機支撐結構的設計和開發」等服務，與「不動產經營管理」並非類似服務；又雖「風力發電廠的設計和開發」仍被認為與「不動產經營管理」構成類似服務，惟經本所與當事人及審查員溝通該服務之性質後，審查員亦同意該服務名稱修改為「具有多個風力渦輪機平台的離岸海上風力發電廠的設計和開發，每個平台都配備一個用於發電的風力渦輪機支撐結構和風力渦輪機」後，可獲准註冊。由此可知，在二造商標之商品/服務性質差異較明顯時，可以透過答辯技巧來克服混淆誤認之虞之認定；又由此亦可知，修正商品/服務名稱除係因應審查員要求外，亦有積極排除混淆誤認之虞之認定的作用，故而在類似案件，除減縮商品/服務或進行答辯，亦可視案情考慮是否能採取修正商品/服務名稱之策略，進而增加商標申請之成功機率。In view of the close similarity to the cited trademarks, the focus of our response is the dissimilarity of their designated goods/services:</p> <p>The designated “mechanical control device for wind turbines” in class 7 of the disputed trademark and “photoelectric sensor” of the 1st cited trademark are deemed similar according to the “Classification and Cross-searching Referential Materials for Goods and Services” published by the IPO. However, after TIPLo made a case research and found and cited several similar cases of the Supreme Administrative Court and the IPO, the Examiner was convinced to overturn the viewpoint of similarity between the two parties’ goods, which indicates that “similarity of goods/services” is more influential</p>

	<p>than the subjective element "similarity of trademarks" in judging likelihood of confusion and misidentification under present practice. Therefore, one of the keys to successfully acquire trademark registration is to persuade the Examiner by citing other preceding cases under similar situation.</p> <p>Further, the "design and development of wind farms, wind turbines, wind turbine platforms, and wind turbine support structures" in class 42 of the disputed trademark and "real estate management" of the 2nd cited trademark in the subclasses for cross-searching should be deemed similar. After our strong and lengthy argument of the dissimilarity between the two parties' services in view of their difference in nature, industry, service provider, sales channel and customers, the Examiner agreed with the dissimilarity between "design and development of wind turbines, wind turbine platforms, and wind turbine support structures" and "real estate management". Despite "design and development of wind farms" and "real estate management" constitute similarity, the Examiner accepted our explanation for their different nature and the amended wording "design and development of offshore wind farms having multiple wind turbine platforms each outfitted with a wind turbine support structure and a wind turbine, for the generation of power", and approved the disputed trademark registration. Given the above, to overcome the obstacle of being considered likely to cause confusion and misidentification, the distinctly different nature of the two parties' goods/services can be emphasized. To amend the specification of goods/services is a way not only to meet the Examiner's request but also to remove the likelihood of confusion and misidentification. To deal with similar cases, reduction of goods/services or submission of argument, even amendment of goods/services, may enhance chances of success.</p>
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### Example work 11

<p><b>Name and brief description of case/portfolio:</b></p>	<p>商標申請案－覆 OA 商標名稱：諾舒納 註冊號數：02227213 類別：3 指定商品：化妝品；皮膚保養用化妝製劑；肥皂；髮水；洗髮精；化妝用乳液及髮油；皮膚美白霜；洗衣劑；人體用清潔劑；非人體用清潔劑；擦亮劑；研磨劑；香精油；盥洗用製劑；香水；牙膏；線香；人類或動物用除臭劑；空氣芳香劑；彩妝品；卸妝劑；面膜；清潔乳；唇膏；脫毛劑；仿曬製劑（化妝品），曬後製劑（化妝品）；瘦身用化妝品。 商標權人：法商·諾雷娃製藥公司 Trademark Application – Response To Office Action Disputed TM: 諾舒納 Reg. No.: 02227213 Class: 3 Designated Goods: Cosmetics; cosmetic preparations for skin</p>
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	<p>care; soaps; hair lotions; shampoo; lotions and pomades for cosmetic purposes; skin-whitening creams; laundry preparations; cleaning preparations for human body; cleaning preparations other than for human body; polishing preparations; abrasive preparations; essential oils; toiletry preparations; perfumery; dentifrices; incense; deodorants for human beings or for animals; air fragrancing preparations; make-up products; make-up removing preparations; beauty masks; cleansing milks; lipstick; depilatories; sun-tanning preparations (cosmetics), after-sun preparations (cosmetics); cosmetic preparations for slimming purposes</p> <p>Registrant: Noreva Pharma</p>
	<p>本所客戶法商·諾雷娃製藥公司以「諾舒納」申請商標，智慧財產局於初步審定中指出「諾舒納」與「芙舒諾（簡體字）」商標，因國人實際上對於中文橫書讀法究由左至右、抑或由右至左並未趨於一致，據以核駁商標亦可能唱呼為「諾舒芙」，故二造均有相同之「諾舒」構成之識別部分，僅「納」、「芙」之些微差異，商標應屬近似，復指定使用於類似商品。然而，經本所搜索商標資料庫，整理出與本案商標情形類似案例，例如已准許「科舒芙」與「芙舒諾」商標以及「舒諾維」與「康諾舒」商標並存註冊在案。又，經本所查閱相關判決，指出現代橫書中文之閱讀方向為由左至右，已為法院所肯認。故本案商標應無使相關消費者誤認其表彰之來源與據駁商標有關之虞，二商標間並無混淆誤認之虞，本件商標最終獲准註冊。The Applicant, Noreva Pharma (a French corporation), filed an application for TM “諾舒納” with the Intellectual Property Office (IPO). After preliminary examination, the IPO in the official letter stated, the Chinese characters “諾舒納” and the cited TM “芙舒諾（簡體字）” both contain the same “諾舒” because “芙舒諾” could be read from right to left - “諾舒芙” by local people in view of the non-unified reading usage (left-to-right or right-to-left). Since the two trademarks slightly different in “納” and “芙” only are both designated for use on the same or similar goods, they should be deemed as similar.</p> <p>However, according to our thorough research, the IPO’s trademark database reveals some registered trademarks similar to this case, such as the co-existing 科舒芙/芙舒諾 and 舒諾維/康諾舒 trademarks. We further noted, relevant court’s judgements indicate, the left-to-right usage to read horizontally written Chinese has been recognized. Therefore, the disputed trademark could not possibly be misidentified with the cited trademark in regard to the source. There is no likelihood of confusion and misidentification between the two trademarks. Finally, the disputed trademark was granted registration.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>林志剛 律師／專利師 黃闡億 律師／專利代理人 J. K. LIN, Attorney-at-Law / Certified Patent Attorney CHEGN-YI HUANG, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A</p>

<p><b>Date(s)</b></p>	<p>2021/03/23 – 提出本件商標註冊申請。 2021/10/05 – 智慧財產局 OA 通知初步審查結果。 2022/03/25 – 回覆智慧財產局 OA。 2022/05/09 – 智慧財產局通知商標核准註冊。 2022/06/16 – 商標註冊公告。 March 23, 2021 – Application filed October 5, 2021 – First objection raised by the IPO March 25, 2022 – Response May 9, 2022 – Approval decision June 16, 2022 – Publication for registration</p>
<p><b>Why was it important?</b></p>	<p>商標中文橫書，應自左向右唸，還是自右向左唸？</p> <p>本案客戶的商標是「諾舒納」，據駁商標則是「芙舒諾」。據駁商標如果是自右向左唸，則可讀成「諾舒芙」，如此一來，與「諾舒芙」相比較，前二字「諾舒」相同，只有最後一字「納」與「芙」之不同。</p> <p>智慧財產局於初步審定時認為，國人實際上對於中文橫書讀法究由左至右、抑或由右至左並未趨於一致，因此據以核駁商標亦可能唱呼為「諾舒芙」，故二造均有相同之「諾舒」構成之識別部分，僅「納」、「芙」之些微差異，商標應屬近似。</p> <p>在本件商標申請階段，客戶未提供任何使用證據，但本所主動檢索網路圖片及網頁關於本件商標實際使用情況，發現本件商標實際使用時會搭配其英文名稱「NOREVA」一併使用，據駁商標則是會搭配其英文名稱「fossula」一併使用，證實本件商標之唱呼方式為「諾舒納」，據駁商標之唱呼方式「芙舒諾」，使用商標時只有一種唱呼方式，不可能忽左忽右，故二造商標間並無混淆誤認之虞。又經檢索商標資料庫，已有「科舒芙」商標權與「芙舒諾」商標以及「舒諾維」商標與「康諾舒」商標，在同一商品組群取得並存註冊，基於相同法理，本件商標申請案之二商標間應無混淆誤認之虞。根據本所進一步的搜尋、研究，發現有數則法院判決肯認橫書中文由左向右唸已為常態。經本所強且有力的辯駁，智慧財產局最後同意本件商標申請案既無需減縮商品，亦無須向據駁商標之申請人取得並存同意書。本所為客戶向智慧財產局權益爭取保障，最終取得商標註冊。</p> <p>How to read the horizontally written Chinese on a trademark? From left to right, or right to left?</p> <p>The Applicant's trademark is "諾舒納", while the cited trademark consists of "芙舒諾". To read the cited trademark from right to left, it will be "諾舒芙". Comparing "諾舒納" with "諾舒芙", the first two characters "諾舒" are exactly the same and they only differ in the last "納" and "芙".</p> <p>The IPO in the preliminary examination opined, local people actually are not consistent in how to read horizontally written Chinese, right to left or left to right? which is the reason why the</p>

	<p>cited trademark could be read like “諾舒芙”; since the two parties’ trademarks both contain the same prominent “諾舒” and they only differ in “納” and “芙”, they should be considered similar.</p> <p>During the filing proceeding, the Applicant did not provide any use proof. After our searching relevant information on internet carefully and aggressively, we found that the trademark design actually used by the Applicant is the combination of the company name “NOREVA” with the disputed trademark, while the cited TM “芙舒諾” actually appears with TM “fossula”, which means the disputed trademark should be read as “諾舒納”, and the cited trademark, “芙舒諾”. In view of the co-existing 科舒芙/芙舒諾 and 舒諾維/康諾舒 trademark registrations in the same subclasses, there is no likelihood of confusion and misidentification between the two trademarks in the present case on basis of the same law. Our research further reveals that there have been several Court’s judgements acknowledging the fact that the left-to-right manner of reading horizontally-written Chinese has been commonly adopted in our society. Through our strongly fighting for the client’s right and interests, the Applicant at last acquired the trademark registration without reduction of the goods or negotiating with the cited trademark owner for a co-existence agreement.</p>
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**Example work 12**

<p><b>Name and brief description of case/portfolio:</b></p>	<p>商標申請案－覆 OA 商標名稱：ELEVAR 註冊號數：/ 類別：5、42 指定商品： 藥劑，即針對病患之臨床實驗及新型癌症治療藥劑。(第 5 類) 新型癌症療法之研究及開發。(第 42 類) 商標權人：美商·艾洛瓦醫療公司 Trademark Application – Response To Office Action Disputed TM: ELEVAR Reg. No.: / Designated Goods/Services: Class 5: Pharmaceutical preparations, namely, clinical experimental and novel cancer therapeutic pharmaceuticals directed to patients Class 42: Research and development of novel cancer therapeutics Registrant: Elevar Therapeutics, Inc.</p>
	<p>本所客戶美商·艾洛瓦醫療公司以「ELEVAR」申請商標，智慧財產局於初步審定中指出「ELEVAR」與「ELEVA 菁摯」、「ELEVA」、「Eleva (STYLIZED)」近似，復本案指定使用於藥劑商品，引據諸商標指定使用於營養補充品等商品，智慧財產局認為商品有類似</p>

	<p>之虞，二造商標有混淆誤認之虞。然而，經本所查閱藥事法條文及相關判決，指出藥品與營養補充品二者應非屬類似商品，並已為法院所肯認，又，經本所主動搜索世界智慧財產權組織網站(WIPO)，發現本案商標與引據商標於新加坡並存註冊在案，本案商標應無使相關消費者誤認其表彰之來源與據駁商標有關之虞，二商標間並無混淆誤認之虞，本件商標最終獲准註冊。</p> <p>The Applicant, Elevar Therapeutics, Inc., filed an application for TM “ELEVAR”. After preliminary examination, the IPO stated, the disputed TM “ELEVAR” is similar to the cited “ELEVA 菁摯”, “ELEVA” and “Eleva (STYLIZED)” trademarks; the designated pharmaceutical preparations of the disputed trademark are similar to the nutritional supplements of the cited trademarks, so that it is likely to cause confusion and misidentification.</p> <p>However, according to our research, the Pharmaceutical Affairs Act and relevant judgements manifest that pharmaceutical preparations and nutritional supplements should not be deemed similar and the court did share the same point of view. Further, the WIPO database shows that the instant trademark and the cited trademark co-exist in Singapore. Therefore, the disputed trademark could not possibly be misidentified with the cited trademark in regard to the source. There is no likelihood of confusion and misidentification between the two trademarks. Finally, the disputed trademark was granted registration.</p>
<p><b>IP advisers from your firm involved</b></p>	<p>林志剛 律師／專利師 黃闡億 律師／專利代理人 J. K. LIN, Attorney-at-Law / Certified Patent Attorney CHEGN-YI HUANG, Attorney-at-Law / Certified Patent Agent</p>
<p><b>Other IP firms involved</b></p>	<p>N/A</p>
<p><b>Date(s)</b></p>	<p>2021/04/01 – 提出本件商標註冊申請。 2021/10/05 – 智慧財產局 OA 通知商品修正。 2021/11/04 – 回覆智慧財產局 OA 商品修正。 2021/11/29 – 智慧財產局 OA 通知初步審查結果。 2022/01/28 – 回覆智慧財產局 OA。 2022/07/27 – 回覆智慧財產局 OA(補充)。 2022/08/16 – 智慧財產局通知商標核准註冊。 April 1, 2021 – Application filed October 5, 2021 – IPO’s office action for amendment of goods November 4, 2021 – Response November 29, 2021 – IPO’s official letter January 28, 2022 – Response July 27, 2022 – Supplemental argument August 16, 2022 – Approval Decision</p>
<p><b>Why was it important?</b></p>	<p>商標申請案於初步審查階段遭質疑乃與據駁諸商標有混淆誤認之虞，倘此時申請人不欲減縮指定商品/服務，且無法或不欲取得併存同意書時，該如何克服？</p>

經本所查閱藥事法條文及相關判決，指出藥品與營養補充品之用途、功能及目的均不同，且不具有上下位、包含、重疊或相當之關係，二者應非屬類似商品，並已為法院所肯認。本所向智慧產局主張，本案商標定使用於臨床實驗及新型癌症治療藥劑商品，其消費者非一般大眾，而是限定在高度先進的醫學研究單位，盡力描繪出二造使用商品之差異。經本所主動搜索世界智慧財產權組織網站(WIPO)，發現本案商標與引據商標於新加坡並存註冊在案，本案商標申請案係使用外文，在以英文為主要通行語及第一語言之新加坡與對造商標並存註冊在案，即肯定二造商標不具混淆誤認之可能，成功說服智慧財產局二造商標無致相關消費者產生混淆誤認之虞。本件商標申請案既無需減縮商品，亦無須向據駁商標之申請人取得並存同意書，為客戶向智慧財產局權益爭取保障，最終取得商標註冊。

How to overcome the obstacle to register a trademark which is deemed likely to cause confusion and misidentification with the cited trademark/s during the filing proceeding, if the Applicant does not wish to reduce the designated goods/services or it is difficult to obtain a co-existing agreement from the cited trademark owner?

After checking with the Pharmaceutical Affairs Act and relevant judgements, pharmaceutical preparations and nutritional supplements are different in utility, function and purpose and have no superordinate/subordinate, inclusive, overlapping or equivalent relationship, which has been recognized by the court. To stress on the difference between the two parties' products, we claimed, the pharmaceutical preparations of the disputed trademark are not those for ordinary public, instead, they are clinical experimental and novel cancer therapeutic pharmaceuticals, specifically used in connection with advanced medical research units. In the English-speaking Singapore, their trademark authorities determined no likelihood of confusion and misidentification between the disputed trademark in English and the cited trademark. The IPO accepting our argumentation that the two parties' trademarks are unlikely to cause confusion and misidentification finally granted registration to the disputed trademark without reduction of the goods or a co-existence agreement.

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