



ICLG

The International Comparative Legal Guide to:

Trade Marks 2015

4th Edition

A practical cross-border insight into trade mark work

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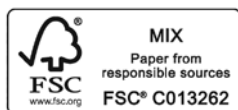
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EDITORIAL

Welcome to the fourth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

One general chapter entitled “BRIC Economies: Another BRIC in the Wall of Global IP Standards?”.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 42 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord (UK) LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The International Comparative Legal Guide series is also available online at www.iclg.co.uk.

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1 Relevant Authorities and Legislation

1.1 What is the relevant Taiwanese trade mark authority?

The relevant trade mark authority is the Taiwan Intellectual Property Office (TIPO).

1.2 What is the relevant Taiwanese trade mark legislation?

The Taiwan Trademark Act was first enacted and promulgated on May 6, 1930.

The current Trademark Act was amended and promulgated on June 29, 2011, and became effective on July 1, 2012.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Any word, device, symbol, colour, three-dimensional shape, motion, hologram, sound, smell, touch or taste with distinctiveness or a combination thereof can be registered as a trade mark.

2.2 What cannot be registered as a trade mark?

There is no sign that would be refused registration in Taiwan so long as it is distinctive enough.

2.3 What information is needed to register a trade mark?

The following information is needed:

- A Power of Attorney.
- Specification of goods/services sought for registration.
- Filing date and application number of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).
- A certified copy of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).
- The date of the first display of the goods or services and the name of the exhibition (if priority is claimed pursuant to the exhibition).

- Exhibition priority document (if priority is claimed pursuant to the exhibition).
- Five (5) prints (not less than 5cm and not exceeding 8cm in length and width) of the mark.

2.4 What is the general procedure for trade mark registration?

The trade mark registration procedure and estimated time are provided below:

- The applicant files the application.
- It takes about nine (9) months to receive an official decision.
- The registration fees must be paid within two (2) months from the day after the approval decision has been received.
- It takes about one (1) month to receive the registration certificate after the payment of the registration fees.

2.5 How can a trade mark be adequately graphically represented?

The applicant must submit a trade mark specimen. If the trade mark cannot be clearly and completely presented, a trade mark description, or even a trade mark sample, should be provided in order to exactly define its scope of right and to facilitate a third party in recognising the registered trade mark and its scope of right.

2.6 How are goods and services described?

The goods and services are classified according to the Nice Classification system. Most of the class headings will be considered as too broad/indefinite in meaning to be acceptable for registration purposes; it is necessary to specify the goods or services. It is not permissible to claim "all goods in class...".

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Taiwanese trade mark?

A trade mark registered in Taiwan can only be protected in Taiwan.

2.8 Who can own a Taiwanese trade mark?

Any legal or natural person can own a Taiwanese trade mark.

2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use. Generally speaking, it needs at least three (3) years of use and advertising in Taiwan to acquire distinctive character.

2.10 How long on average does registration take?

It takes at least one (1) year from filing until registration of a trade mark if there is no objection from the examiner.

2.11 What is the average cost of obtaining a Taiwanese trade mark?

In addition to attorneys' fees, the official fees (NT\$) for one (1) application in one (1) class are quoted as below:

Filing Fees

Goods:

NT\$3,000.00 if the designated goods are under 20 items; and

NT\$200.00 for each additional good if over 20 items.

Services:

NT\$3,000.00; and

NT\$500.00 for each additional service if there are over five items in a class; 35 in retail services of special goods.

Registration Fees

NT\$2,500.00.

2.12 Is there more than one route to obtaining a registration in Taiwan?

Except for filing applications in Taiwan, there is no other route to obtaining a registration in Taiwan.

2.13 Is a Power of Attorney needed?

A Power of Attorney (simply signed by an authorised person) is needed. Neither notarisation nor legalisation is required.

2.14 How is priority claimed?

The following documents and information are needed to claim priority pursuant to the corresponding WTO member country's trade mark application:

- Filing date and application number of the corresponding priority application: must be stated at the time of filing the Taiwanese application.
- A certified copy of the corresponding priority application: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the certified copy is not allowed.

The following documents and information are needed to claim priority pursuant to the exhibition:

- The date of the first display of the goods or services and the name of the exhibition: must be stated at the time of filing the Taiwanese application.
- Exhibition priority document: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the priority document is not allowed.

2.15 Does Taiwan recognise Collective or Certification marks?

Taiwan recognises Collective and Certification marks.

A collective trade mark is a sign that serves to indicate goods or services of a member in an association, society or any other group which is a juridical person and to distinguish goods or services of such member from those of others who are not members.

A certification mark is a sign that serves to certify a particular quality, accuracy, material, mode of manufacture, place of origin or other matters of another person's goods or services by the proprietor of the certification mark and distinguish the goods or services from those that are not certified. Only a juridical person, a group or a government agency which is competent to certify another person's goods or services shall be eligible to be an applicant of an application for registration of a certification mark.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The principal absolute grounds for refusal of registration are provided below:

- A trade mark that is non-distinctive.
- A trade mark for goods or services which is exclusively necessary for the goods or services to be functional.
- A trade mark which is identical with or similar to the national flag, national emblem, national seal, military flags, military insignia, official seals, or medals of the ROC, or the state flags of foreign countries, or the armorial bearings, national seals or other state emblems of foreign countries communicated by any member of the WTO under Paragraph 3 of Article 6ter of the Paris Convention.
- A trade mark which is identical with the portrait or name of Dr. Sun Yat-Sen or of the head of the state.
- A trade mark which is identical with or similar to the mark of a government agency of the ROC or an official exhibition held thereby, or the medal or certificate awarded thereby.
- A trade mark which is identical with or similar to the armorial bearings, flags, other emblems, abbreviations, and names of international intergovernmental organisations or well-known domestic or foreign institutions undertaking business for public interests, and hence being likely to mislead the public.
- A trade mark which is identical with or similar to official signs and hallmarks indicating control and warranty adopted by the domestic or foreign countries, and being designated to the identical or similar goods or services.
- A trade mark which is contrary to public policy or to accepted principles of morality.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical with or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical with or similar to

those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers, unless the consent of the proprietor of the said registered trade mark or earlier filed trade mark to the application has been given and is not obviously improper.

- A trade mark which is identical with or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark, unless the proprietor of the said well-known trade mark or mark consents to the application.
- A trade mark which is identical with or similar to another person's earlier used trade mark and to be applied for goods or services identical with or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration, unless the proprietor of the said earlier used trade mark consents to the application.
- A trade mark which contains another person's portrait or well-known name, stage name, pseudonym, or alternative name, unless the said person consents to the application.
- A trade mark which contains the name of a well-known juridical person, business or group, and hence there exists a likelihood of confusion on the relevant public, unless the said juridical person, business or group consents to the application.
- A trade mark which is an infringement of another person's copyright, patent right, or any other right, where a final judgment of the court has been rendered, unless the said person consents to the application.

3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds refusal can be overcome through argument, acquired distinctiveness through use, and/or obtaining a letter of consent.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

3.4 What is the route of appeal?

- In disagreement with the TIPO's decision, an initial appeal may be filed with the Ministry of Economic Affairs (MOEA) within 30 days, counting from the next day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the next day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The principal relative grounds for refusal of registration are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical with or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical with or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers.
- A trade mark which is identical with or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical with or similar to another person's earlier used trade mark and to be applied for goods or services identical with or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection can be overcome by argument, agreement, limiting the specification, applying for a limitation on the mark of some kind, a letter of consent, and/or invalidating the earlier mark.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

4.4 What is the route of appeal?

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the next day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the next day after the MOEA's decision has been received.

- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The principal grounds for opposition are given as below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical with or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical with or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers.
- A trade mark which is identical with or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical with or similar to another person's earlier used trade mark and to be applied for goods or services identical with or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

5.2 Who can oppose the registration of a Taiwanese trade mark?

Anyone can oppose the registration of a Taiwanese trade mark.

5.3 What is the procedure for opposition?

- The opposer files opposition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the opposer to submit supplementary opposition reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The opposition is finalised if no appeal is filed.

6 Registration

6.1 What happens when a trade mark is granted registration?

The registration fees must be paid within two months from the day after the approval decision has been received. The trade mark will be registered and published after payment of the registration fees, and a registration certificate will then be issued.

6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights in Taiwan commence from the date of registration.

6.3 What is the term of a trade mark?

The term of a trade mark is ten (10) years.

6.4 How is a trade mark renewed?

Renewal will be granted upon filing of a renewal application and payment of the official fees.

In addition to attorneys' fees, the official fees for one (1) application for renewal of one (1) registration in one (1) class are NT\$4,000.00.

The renewal application shall be made within six (6) months before the expiration of its period. However, twice the official fees shall be paid if the renewal application is filed within six (6) months after expiration of the period.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

An assignment of a trade mark shall be recorded with the TIPO.

For recordal of assignment, the following documents are needed:

- a Power of Attorney of the Assignee: to be simply signed by an authorised person; and
- a Deed of Assignment signed by the parties (a copy of the assignment is acceptable).

7.2 Are there different types of assignment?

A partial assignment is possible for certain goods or services and a trade mark can be assigned with or without the goodwill.

7.3 Can an individual register the licensing of a trade mark?

A licence of a trade mark shall be recorded with the TIPO.

A licence agreement is no longer required for filing a licence application if the application is filed by the registrant.

A copy of the licence agreement signed by the parties is acceptable if the licence application is filed by the licensee.

7.4 Are there different types of licence?

A registered trade mark may be licensed by the proprietor, exclusively or non-exclusively, for all or some of the designated goods or services for which it is registered and for a particular locality.

7.5 Can a trade mark licensee sue for infringement?

Only an exclusive licensee is entitled, within the scope of the licence, to bring infringement proceedings in his/her own name unless otherwise prescribed in a licensing contract.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence.

7.7 Can an individual register a security interest under a trade mark?

A creation, change, or extinguishment of a security interest made by a trade mark right holder shall be recorded by the TIPO.

A description of the security interest signed by the parties is acceptable.

7.8 Are there different types of security interest?

There are no different types of security interest.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The principal grounds for revocation are provided below:

- Where the trade mark is altered by the proprietor in different forms in which it was registered or supplemented with additional notes whereby the trade mark is identical with or similar to another person's registered trade mark in relation to goods or services which are identical with or similar to those for which another person's registered trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers.
- Where the trade mark has not yet been put to use or such use has been suspended for a continuous period of not less than three years without proper reasons for non-use.
- Where the trade mark has become the generic mark or term, or common shape for the designated goods or services.

8.2 What is the procedure for revocation of a trade mark?

- The petitioner files a revocation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the petitioner to submit supplementary revocation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The revocation is finalised if no appeal is filed.

8.3 Who can commence revocation proceedings?

Anyone can commence revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

The use of a trade mark connotes the utilisation for marketing purposes of a trade mark on goods, services or relevant articles thereof, or the utilisation through the means of two-dimensional graphics, audio and visual digitisations, electronic media, or other mediums to sufficiently make relevant consumers recognise it as a trade mark. Fact proving the use of a trade mark presented by the trade mark right holder shall comply with the general practice of trade.

Use in a form not as registered can be considered genuine use if its identity remains the same according to general social concepts.

8.5 What is the route of appeal from a decision of revocation?

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the next day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the next day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The principal grounds for invalidation are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical with or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical with or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers.
- A trade mark which is identical with or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.

- A trade mark which is identical with or similar to another person's earlier used trade mark and to be applied for goods or services identical with or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

9.2 What is the procedure for invalidation of a trade mark?

- The petitioner files an invalidation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the petitioner to submit supplementary invalidation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The invalidation is finalised if no appeal is filed.

9.3 Who can commence invalidation proceedings?

Only an interested party can commence invalidation proceedings.

9.4 What grounds of defence can be raised to an invalidation action?

The main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The cited mark is not well-known in Taiwan in the case that the invalidation action is based on the well-known status of the cited mark.
- The disputed mark is not filed in bad faith.
- The disputed mark is inherently distinctive or has acquired distinctiveness through use.

9.5 What is the route of appeal from a decision of invalidity?

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the next day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the next day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The Taiwan Intellectual Property Court (the Taiwan IP Court) has jurisdiction over all IP-related actions in Taiwan. In the occurrence

of trade mark infringement, a trade mark right holder may initiate a civil action against a suspected trade mark infringer with the Taiwan IP Court to seek infringement removal and damages. Alternatively, the trade mark right holder may file a criminal complaint alleging trade mark infringement against the suspected infringer with the district prosecutor's office that has jurisdiction in the place where the suspected infringer has his/her domicile or where he/she commits the alleged trade mark infringement. After the prosecutor indicts the suspected infringer and the district court passes a judgment on the trade mark infringement case, the prosecutor, the complainant (by requesting the prosecutor), or the suspected infringer who is not satisfied with the judgment may appeal the case to the criminal tribunal of the Taiwan IP Court in the second instance, and the trade mark right holder may initiate an incidental civil action during the trial proceedings after the prosecutor's indictment. Under the Intellectual Property Case Adjudication Act, the judge will hear and decide on the criminal action and the incidental civil action at the same time.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

In Taiwan, instead of the pre-trial discovery regime adopted in the US and Europe, the preparatory proceedings should go first, before the parties in a civil action with respect to a trade mark infringement present their arguments on substantive issues in the oral argument sessions after the civil action moves to the proceedings at the district court. The preparatory proceedings usually take around a time frame of three to five months, during which period the judge would first examine if the required procedural formalities are met and the parties should submit their respective arguments or move for investigation on evidence. The judge would compile and list the disputed issues on the case.

In a criminal action in regard to a trade mark infringement, the court would issue a notice requesting the court appearance of the defendant and the prosecutor (or complainant) for preparatory proceedings and the judge would compile the important issues on the substantive issues and evidence presented by the parties, provide opinions with respect to the admissibility of evidence presented by the parties, and decide to deny/accept motion(s) for investigation on evidence. Likewise, the preparatory proceedings for a criminal action would take around three to five months.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary injunctions and final injunctions are available in Taiwan.

- A preliminary injunction is granted if the claimant can show that an injunction is necessary to prevent material harm or imminent danger or other similar circumstances. The factors generally considered by the court to determine whether a preliminary injunction is warranted include (i) likelihood of success on the merits of the case (both invalidity and infringement would be considered), (ii) if the claimant would suffer irreparable harm absent an injunction, (iii) balance of interests between both parties, and (iv) impact on the public interest.
- Final injunctions are typically granted if the claimant is successful at trial in establishing that (i) the trade mark is infringed (trade mark similarity and likelihood of confusion), and (ii) the defendant is currently engaging in infringing activities or is likely to engage in infringing activities in the future.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party in a civil action may move the court to order the opposing party to produce documentary evidence in the opposing party's possession. The motion must specify the relationship between such documentary evidence and the disputed fact to be proved, as well as the legal ground for the opposing party's duty to produce such documents or materials. Under the Code of Civil Procedure, a party has the duty to disclose (a) documents that such party has made reference to in the course of the proceedings, (b) documents of which the other party may require the delivery or inspection pursuant to applicable laws, (c) documents which were made for the interest of the other party, (d) commercial accounting books, and (e) documents which were made in respect of matters relating to the action (the party may refuse to produce such documents on the grounds of privacy or trade secrets).

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In a criminal action for trade mark infringement, in principle, arguments or written statements made out of court by any person other than the defendant of an action cannot be taken as evidence, unless they are made by such a person being cross-examined in court. Any person who testifies by providing arguments or written statements before the judge should be ordered to make an affidavit and any false statements given by such a person will be considered perjury as defined by the Taiwan Criminal Code.

In a civil action for trade mark infringement, either party may introduce a desired witness(es) or produce evidence in written form and also move for the judge to conduct a necessary examination of the witness(es) or conduct such examination himself/herself after informing the judge.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

No, Article 16 of the Taiwan Intellectual Property Case Adjudication Act requires that the court may not suspend or stay the proceedings pending resolution of validity in TIPO or the Administrative Court.

10.7 After what period is a claim for trade mark infringement time-barred?

The civil claim for trade mark infringement is time-barred after a two-year period from the time when the patent owner becomes aware of the infringement and the infringer, or a 10-year period from the time when the infringement takes place, whichever expires earlier.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities for trade mark infringement in Taiwan.

Any person who commits any of the following acts, in the course of trade and without the consent of the proprietor of a registered trade mark or collective trade mark, shall be liable to imprisonment for a period not exceeding three years and/or a fine not exceeding NT\$200,000:

- (1) using a trade mark which is identical with the registered trade mark or collective trade mark in relation to goods or services which are identical with those for which it is registered;
- (2) using a trade mark which is identical with the registered trade mark or collective trade mark and used in relation to goods or services similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers; or
- (3) using a trade mark which is similar to the registered trade mark or collective trade mark and used in relation to goods or services identical with or similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion on relevant consumers. (Article 95 of the Trademark Act.)

Any person who knowingly sells or, due to an intent to sell, possesses, displays, exports, or imports infringing goods shall be liable to imprisonment for a period not exceeding one year and/or a fine not exceeding NT\$50,000; same penalties shall also apply to acts performed through electronic media or on the internet. (Article 97 of the Trademark Act.)

10.9 If so, who can pursue a criminal prosecution?

The trade mark owner and/or the exclusive licensee who registers the licence with the TIPO can bring a criminal action against the infringer(s).

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Any trade mark right holder who inappropriately issues warning letters to any other persons alleging that his/her competitors have infringed his/her trade mark right should constitute improper use of a trade mark right. Any violator of the Taiwan Fair Trade Act by the act of improperly using his/her trade mark right and thus impeding fair competition shall be punished by imprisonment for no more than two years, detention, or *in lieu* thereof or in addition thereto, a fine of no more than NT\$50,000,000, where the violator is ordered by the central competent authority to cease or rectify his/her conduct within a prescribed time period and fails to do what is ordered within the said time period.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A suspected trade mark infringer may allege non-infringement by raising the following grounds as defence: (1) the allegedly infringed mark should be cancelled or revoked; (2) the allegedly infringing mark is not identical or similar to the allegedly infringed mark and is unlikely to cause confusion; (3) the allegedly infringing mark is not used as a trade mark; or (4) the allegedly infringing mark is not used for marketing purposes.

11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to a non-infringement allegation, the suspected infringer may assert that: (a) he/she properly uses the mark in dispute and should be free from the capacity of the allegedly infringed trade mark right in the following circumstances where: (i) he/she indicates his/her own name, or the term, shape, quality, nature, characteristic, intended purpose, place of origin, or any other description in relation to his/her own goods or services, in accordance with honest practices in industrial or commercial matters but does not use the mark in dispute as a trade mark; (ii) he/she uses the mark in dispute where it is necessary for the goods or services to be functional; (iii) he/she uses, on *bona fide* intent and prior to the filing date of the registered trade mark, an identical or similar mark on goods or services identical with or similar to those for which the registered trade mark is protected, provided that the use is only on the original goods or services and the proprietor of the registered trade mark is entitled to request the party who uses the trade mark to add an appropriate and distinguishing indication; or (iv) goods have been put on the domestic or foreign market under a registered trade mark by the proprietor or with the proprietor's consent, and the proprietor is not entitled to claim trade mark rights on such goods, unless such claim is to prevent the condition of the goods having been changed or impaired after they have been put on the market or unless there exist other legitimate reasons; (b) no damages should be awarded because the suspected infringer lacks the subjective intention or negligence on which an award of damages must be based; or (c) the plaintiff's claim was time-barred (see the answer to question 10.7).

12 Relief

12.1 What remedies are available for trade mark infringement?

In Taiwan's IP protection regime, filing a criminal complaint asserting trade mark infringement is one of the available remedies for a trade mark right holder. Seized counterfeit items will be confiscated and destroyed after the judge confirms and sustains, by a decision, the occurrence of the alleged trade mark infringement. A civil action serves as another remedy, by which a trade mark right holder may seek injunction, removal of infringement, compensation, and destruction of seized counterfeits.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

For initiating a civil action regarding trade mark infringement, the plaintiff should first pay litigation expenses to the court, and the losing party should bear the litigation expenses upon conclusion of the case. In other words, the winning party may request the losing party to bear litigation expenses. Where the parties each win the case in part, the court may, in its discretion, order the parties to bear the litigation expenses in a certain proportion or a particular party alone to bear them, or order both parties to bear their litigation expenses that have been incurred to them respectively. In addition, the parties each should bear their attorneys' fees incurred to them respectively, unless the court determines that the losing party should bear the attorneys' fees incurred in the third instance proceedings.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In the criminal aspect of the trade mark infringement action, the complainant may seek an appeal as well by filing a motion with the prosecutor's office for the prosecutor to take an appeal if he/she finds the judgment unjustifiable. The second instance judgment will be, however, the final judgment with binding effects on the trade mark infringement action. That is to say, neither the prosecutor nor the defendant will be allowed to bring the criminal case to a third instance trial.

In the civil action, either party may appeal the district court judgment to the High Court should they find the judgment unjustifiable. The matter may be brought to the Supreme Court, the court of third instance, if the value of claim meets the NT\$1.65 million threshold. An appeal taken to the Supreme Court must be based on point of law.

13.2 In what circumstances can new evidence be added at the appeal stage?

The parties in a trade mark infringement action may present arguments, materials and/or introduce (new) evidence in due course during the relevant proceedings or the court may deny those presented by reason of obstruction of proceedings. Furthermore, as the third instance court is to examine judicial and only judicial issues, neither party is to present a new argument or introduce evidence of any kind during the third instance proceedings.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The trade mark right holder or its authorised agent may file the request for recording its trade mark(s) with the Customs Authority with the material on the key points to identify a counterfeit. The Customs Authority will withhold the shipment of suspected counterfeits declared for export or import based on the relevant recordation data. The Customs Authority shall give a notice to the right holder of the said trade mark and the importer/exporter, and specify a period for the right holder to come to the Customs Authority to identify the existence/non-existence of an infringement and furnish proof of the infringement and also for the importer/exporter to furnish proof of non-infringement. If the result of the authenticity examination performed by the trade mark holder (or its authorised agent) shows the sample examined is counterfeit and the importer/exporter is unable to produce the authorisation letter or any evidence of non-infringement, the shipment will be detained. After the Customs Authority has detained the suspected articles or suspended release of such articles, it shall inform the right holder, upon the right holder's request, of the names and addresses of the importer/exporter, the consignee/consignee, and the quantity of the suspected articles, in which case, the trade mark holder may initiate a trade mark infringement action against the importer/exporter with a claim for damages.

It should be noted that the Customs Authority's request for an authenticity examination must be answered in a working day from receiving a notice from the Customs Authority and the assessment report confirming the shipment to be counterfeit issued by the right

holder or its authorised agent should be provided to the Customs Authority within three working days. Once the right holder confirms the shipment as counterfeit to the Customs Authority, the shipment will be detained immediately.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in Taiwan?

Unregistered trade marks that are commonly known to relevant enterprises or consumers are eligible for right protection under the Taiwan Fair Trade Act in case they are used in the same or a similar manner so as to cause confusion with the goods of another. Advertisements published in Taiwan and figures with respect to sales volume and market share, etc., for the past two to three years shall be presented for seeking Fair Trade Act protection.

15.2 To what extent does a company name offer protection from use by a third party?

No company may use a company name identical with that of another company. Where two companies' company names contain any word that may specify their different business categories, such company names shall not be considered identical with each other. A company name can be used exclusively by its owner once it has been approved by and registered at the competent authority. Anyone can initiate a civil action with the court or file a complaint with the Fair Trade Commission against the use of his/her company name by a third party in the same or similar manner without his/her prior consent to seek remedy and protection by asserting the third party's violation of the Fair Trade Act.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Registered trade marks are eligible for protection under the Trademark Act. In addition, Fair Trade Act protection is also conferred on unregistered trade marks, containers, packaging, or appearance of goods or any other symbol that represent the goods of any person. An enterprise should be held in violation of the Taiwan Fair Trade Act for having any deceptive or obviously unfair conduct that is able to affect trading order by taking a free ride on any other person's goodwill, such as the act of using the appearance of goods that are identical or similar to that of another recognised by relevant enterprises or consumers and thus causing confusion, or by the act of plagiarising any other person's book title that is able to affect trading order.

16 Domain Names

16.1 Who can own a domain name?

Anyone can own a domain name after completing the due course of registration.

16.2 How is a domain name registered?

A registrant may apply with the Registrar, such as TWNIC, for registering the domain name he/she selects and for paying the annuity.

16.3 What protection does a domain name afford *per se*?

No one can repeat the registration of any registered domain names.

Where any registrant's domain name is identical or similar to any other person's registered trade mark(s) and the registrant has no rights or legitimate interests in respect of the said domain name and has registered the said domain name in bad faith, such a person may act as a complainant to file a complaint with the dispute-resolution provider. The registration of the registrant's said domain name will be cancelled or transferred to the complainant after the dispute-resolution provider decides in favour of the complainant.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

In accordance with the Taiwan IPO's bulletin released in October 2014, the Taiwan IPO received a total of 6,316 trade mark registration applications in September 2014, among which 3,193 applications were submitted via e-filing system, comprising 50.55% of the total applications and representing a percentage higher than 50% for the first time ever since the e-filing system became available in August 2008. The trade mark e-filing system can not only decrease application fees and cost but also expedite the Taiwan IPO's filing time and improve data accuracy. Further, it can also enhance administrative efficiency and accelerate granting of trade mark applications.

17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

IP Court civil judgment under docket (102) Xin-Shang-Su No. 19 [103.5.5]

Moroccanoil Israel Ltd. sued JuiTai Precision-Ind. Co., alleging infringement upon its **moroccanoil** mark by the *Magic morocco hairoil* product made by JuiTai Precision. Moroccanoil Israel also sued TaiRei International Co., the distributor, and Watsons Personal Care Stores (Taiwan) Co., Limited, the distribution network. The IP Court found the infringement alleged stands and ordered the three defendant companies to jointly and severally pay Moroccanoil Israel TWD2,420,000 in damages. The IP Court held the **moroccanoil** mark, which literally means Moroccan oil, descriptive and non-distinctive. However, owing to Moroccanoil Israel's active marketing efforts, the **moroccanoil** mark has become known to and recognised by the relevant consumers as the device distinguishing the source and acquired secondary meaning. The IP Court further found the **moroccanoil** mark a distinctive mark characterised by its design and colour scheme: a background in turquoise with a capital letter M in large orange type, accompanied by the word *moroccanoil* in white in a comparatively small-size font. JuiTai Precision, on the other hand, has the outer packaging of its product in dispute bearing the two words *morocco hairoil* depicted in white sitting conspicuously in the very centre, also with a turquoise background accompanied by a capital letter M in large-size orange type atop. Being so conspicuously depicted as described above, the two words *morocco hairoil* as a whole may be considered being used as a commercial mark. In short, the outer packaging of Moroccanoil Israel's product and that of JuiTai Precision's product in dispute share in common a turquoise colour background, a large-font capital letter M in orange and the English word(s), *moroccanoil* and *morocco*

hairoil, depicted in white, both of which start with *morocco-* and end with *-oil*. In view of the above, the **moroccanoil** mark and the **morocco hairoil** mark are considered strikingly similar in terms of their overall appearance, concept and pronunciation. With the two marks both being used on hair oil products, it is extremely likely that consumers will be confused and led to form the mistaken belief that the hair oil products bearing the two marks respectively have come from the same or associated sources. The IP Court therefore found the trade mark infringement alleged stands and awarded damages to Moroccanoil Israel.

IP Court administrative judgment under docket (102) Xing-Shang-Su No. 112 [103.2.13]

Ferrero has been holding a Taiwanese registration for its Chinese characters mark “金莎”, whose specification covers candies, chocolates and cookie products. Out of its dissatisfaction with a man surnamed Su who successfully registered his Chinese characters mark “金莎織女” with specification thereof covering tea leaves, black tea, green tea, coffee drinks, rice, wheat flakes, flour products, cereal powder, tapioca pearls, sweet mixed congee, etc., Ferrero initiated an administrative action against Su with the Taiwan IP Court. The Taiwan IP Court held that the two marks in dispute are similar to each other and that Su designated his Chinese characters mark “金莎織女” to be used on coffee drink products, while coffee drink products and chocolates, one of the designated products of Ferrero’s Chinese characters mark “金莎”, are identical or similar products in accordance with the general social concept and transaction situation due to their common and related ways of production and marketing channels. As to the other designated products of Su’s Chinese characters mark “金莎織女”, tea leaves, black tea, green tea, rice, wheat flakes, flour products, cereal powder, tapioca pearls, sweet mixed congee, they are energy drinks or cereal products or Chinese traditional desserts and ingredients for desserts and are different from the designated products of Ferrero’s Chinese characters mark “金莎” because their ways of production are different from that of the designated products of Ferrero’s Chinese characters mark “金莎”. Hence, the Taiwan IPO dismissed Ferrero’s initiation of the administrative action with respect to the designated products of Chinese characters mark “金莎織女” other than coffee drinks by the reason that the other designated products of the Chinese characters mark “金莎織女” and the designated products of Ferrero’s Chinese characters mark “金莎” are not similar products in view of their different functions and purposes.

IP Court civil judgment under docket (102) Min-Shang-Zi No. 12 [102.12.26]

A well-known tea beverage product is sold by Vitalon Foods Company (Vitalon) under the three Chinese characters mark “御茶園”, which has been successfully registered as a trade mark since 2001. On the other hand, Standard Foods Corporation (“Standard Foods”) holds a Taiwanese registration for its three Chinese characters mark “御茶釀”, registered in 2007. Vitalon maintained that even though Standard Foods’ mark is designated to be used on soy sauce product, Standard Foods’ mark “御茶釀” is highly similar to its registered mark “御茶園” and hence causes consumers to mistakenly believe that the two marks in dispute represent products of the same series. Standard Foods made defensive arguments that the third Chinese character of each of the two marks in dispute, namely “園” and “釀” are different in appearance, and tea beverage and soy sauce are two products with different uses and which fulfil

different daily needs. Also, for avoiding consumer confusion, Standard Foods has narrowed down the scope of the designated products of its three Chinese characters mark “御茶釀” to include only “soy sauce and seasoning products”. Based on the Taiwan IPO’s approval of registration of its “御茶釀” mark, Standard Foods has been using the said mark for more than five years. However, the Taiwan IP Court determined in the first instance that the two marks in dispute are similar and indeed would cause consumers confusion and therefore prohibited Standard Foods from using the Chinese characters mark “御茶釀” on products and in advertisements, against which Standard Foods filed an appeal. The IP Court still maintained the same decision in the second instance by dismissing Standard Foods’ appeal on the ground that the two marks in dispute are highly similar and would cause consumers confusion.

17.3 Are there any significant developments expected in the next year?

According to the Taiwan IPO’s 2015 plan, with respect to amendments to the Taiwan trademark regime, the following laws and regulations are expected to be amended in 2015:

- (1) Enforcement Rules of Trademark Act.
- (2) Examination Guidelines and Procedures for Trademark Registration Applications.
- (3) Directions for Assisting in Handling Cross-Strait Trademark Matters.

17.4 Are there any general practice or enforcement trends that have become apparent in Taiwan over the last year or so?

Criminal liabilities to be imposed on infringers in accordance with the Taiwan Trademark Act will produce more impeding and intimidating effects. Therefore, in common practice, filing a criminal complaint asserting the infringer’s trade mark infringement is usually the trade mark right holder’s first step to take. Thereafter, the trade mark right holder will provide assistance in police raid action for having the suspected counterfeits seized. Further, the trade mark right holder may choose to bring an incidental civil action after the prosecutor indicts the infringer and the matter is brought to the district court for trial on the criminal aspects of the matter for seeking infringement removal and damages. Under the Intellectual Property Case Adjudication Act, the judge will hear and decide on the criminal action and the incidental civil action at the same time.

Moreover, where the Customs Authority finds any imported/exported shipment that is likely to involve infringing goods, it would notify the trade mark right holder and importer/exporter, and the trade mark right holder should, within a given time, produce any evidence proving the existence of the infringement, by which the Customs Authority will suspend the release of such shipment in accordance with the laws and refer the matter to the district prosecutor’s office that has jurisdiction for investigation. According to the Taiwan Trademark Act, the trade mark right holder may request the Customs Authority to provide the information with respect to the importer/exporter of such shipment and the quantity of the suspected goods. Such information will facilitate the trade mark right holder to exercise his/her trade mark right.

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Mr. J. K. Lin became the director of TIPLO in 1997, after TIPLO's founder Mr. M. S. Lin passed away. During his earlier tenure, J. K. has set out to further streamline the hierarchy of the staff and adopted effective formulae leading to significant improvements in the quality of TIPLO's patent, trade mark and legal services, which further accommodate clients' intensifying needs for IPR enforcement. J. K. also devotes his time to public speaking engagements targeted at global corporations and the international community, addressing issues of IP concerns, unfair competition and others, and continues the footsteps of his late father in being dedicated to *pro bono* NGOs' activities like that of the Judicial Reform Foundation, the Taiwan International Law Society and the Taiwan Human Right Committee, among many others. He is currently on the Board of Directors of the Asian Patent Attorneys Association (APAA), and a vice-president to the APAA, Taiwan Group.

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Mr. H. G. Chen is the Chief of the Legal Department of TIPLO. He has been practising law in Taiwan for more than 28 years. H. G. has extensive experience in the fields of intellectual property, litigation, unfair competition, dispute resolution and general corporate matters. In the late 1980s, he demonstrated preeminent litigious flair by successfully representing a client in a leading trade dress case in Taiwan before the enactment of the Taiwan Fair Trade Act. He has represented various global corporate clients from Japan, the United States and Europe in patent and trade mark litigation, and licensing and negotiation in Taiwan, and this illustrious record has won him a reputation as one of the most successful lawyers in Taiwan. He served as the president of the Taipei Bar Association for the term of 2005.5-2006.11. He was the Director of the Intellectual Property Committee of the Taipei Bar Association (1990-1993) and the Taiwan Bar Association (1993-1995). He is now an executive member to the Board of Directors of the Asian Patent Attorneys Association (APAA), Taiwan Group.



台灣國際專利法律事務所

TIPLO Attorneys-at-Law (also **Taiwan International Patent & Law Office**) was founded in 1965 by M. S. Lin and a group of professional legal and technical associates specialising in intellectual property rights. With over four decades of evolution, **TIPLO** is now one of the largest and most reliable intellectual property law firms in Taiwan, with diversified expertise that encompasses IP as well as general legal services, all provided by a full-service law firm. **TIPLO** is currently staffed by over 275 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages.

TIPLO mainly consists of three departments, namely the Patent, Trademark and Legal Departments. Our patent engineers and attorneys have an average career length of more than 10 years, with expertise and experience covering a wide range of technical fields including electrical engineering, mechanical engineering, applied chemistry, biochemical engineering, biotechnology, pharmaceutical, semi-conductor, computer technology and other emerging areas.

TIPLO is a leading firm in patent and trade mark prosecution, invalidation and opposition proceedings, and infringement assessment and validity appraisal. The proficiency of our Legal Department in IP enforcement, in particular infringement litigation and coordination of police raids, is also highly recognised by law enforcement institutes of all levels and the industry alike, reinforcing **TIPLO** as one of the most effective law firms representing the interests of its clients.

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