

**International
Comparative
Legal Guides**



Practical cross-border insights into trade mark law

**Trade Marks
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Taiwan

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

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

1.2 What is the relevant trade mark legislation in your jurisdiction?

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

The current Trademark Act was amended and promulgated on November 30, 2016 and became effective on December 15, 2016.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Any sign with distinctiveness, which may consist of words, designs, symbols, colours, three-dimensional shapes, motions, holograms, sounds or any 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 scanned copy of the Power of Attorney.
- Specification of goods/services sought for registration.
- The filing date and application number of the corresponding priority application (if priority is claimed pursuant to the corresponding World Trade Organization (WTO) member country's trade mark application).
- A scanned copy of the 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).
- The exhibition priority document (if priority is claimed pursuant to the exhibition).
- A print (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 timeframe are provided below:

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

2.5 How is a trade mark adequately represented?

Traditional trade mark:

- A traditional trade mark should be presented in a two-dimensional still image.

Non-traditional trade marks:

- Three-dimensional trade mark: Such mark should be presented by views depicting the three-dimensional shape of the trade mark. The applicant shall furnish a description explaining the three-dimensional shape. The reproduction may use broken lines to show the manner, placement or context in which the trade mark is used on the designated goods or services with a description explaining such broken lines.
- Colour trade mark: Such mark does not have to be claimed using an internationally recognised colour code and can be presented by a sample of the colour(s). The reproduction may use broken lines to show the manner, placement or context in which the colour is, or the colours are, used on the designated goods or services. The matter shown by the broken lines is not part of the trade mark. The applicant shall furnish a description explaining such broken lines.
- Sound trade mark: Such mark should be represented by a musical notation on a staff, numeric music score or written explanation.
- Motion trade mark: Such mark can be presented by still images of the varying process of the moving images. The

applicant shall furnish a description explaining the movement in sequential order.

- Hologram trade mark: Such mark can be presented by the perspective drawing(s) of the hologram. The applicant should provide a description stating the hologram. For a hologram that generates different representations because of different perspective views, the description should include the changes of the different perspective drawings.
- Repeating-pattern trade mark: Such mark can be presented by the pattern structure and serial arrangement. Also, the trade mark may be displayed in dotted lines showing the manner, position or context it is used on the designated goods or services; in particular, how the repeating-pattern trade mark is used on a specific portion of goods indicating the actual use should be clearly explained in the trade mark description; however, the dotted lines should not be part of the trade mark.
- Smell trade mark: Such mark should be presented in written explanation. The applicant may submit product samples, product packages, and articles related to the services provided in actual use, or test papers with the smell, etc., as the specimens of a smell trade mark applied for registration.
- Position trade mark: Such mark can be presented by broken lines to show the position where the trade mark is actually applied on the goods or services, and a clear description of the trade mark itself and how and where the trade mark is used on the goods or services.

2.6 How are goods and services described?

Goods and services are classified according to the Nice Classification system. Most of the class headings will be considered 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The measures required to file non-traditional trade marks are given in question 2.5. In filing an application for registration of other non-traditional trade marks that are not given in question 2.5, the applicant must furnish the reproduction of the proposed trade mark. If the reproduction does not clearly and completely present the trade mark, a description or even specimen(s) thereof should be provided in order to precisely define the scope of the rights and to enable third parties to ascertain the registered trade mark and its scope of rights according to the publication of the trade mark registration.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for such purposes.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

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

2.10 Who can own a trade mark in your jurisdiction?

Any juridical or natural person, business or group can own a Taiwanese trade mark.

2.11 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 years of use and advertising in Taiwan to acquire distinctive character.

2.12 How long on average does registration take?

It takes at least one year from filing to registration if there is no objection from the examiner.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

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

Filing fees

Goods

- NT\$3,000.00 if the designated goods are under 20 items; and
- NT\$200.00 for each additional item if over 20 items.

Services

- NT\$3,000.00; and
- NT\$500.00 for each additional retail service of specific goods if there are over five such services in class 35.

Registration fees

- NT\$2,500.00.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

Except by filing an application in Taiwan, there is no other route to obtaining a registration in Taiwan.

2.15 Is a Power of Attorney needed?

A scanned copy of the Power of Attorney (simply signed by an authorised person) is required.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

2.17 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 months after the

Taiwanese application is filed; an extension of time to file the certified copy is not permitted.

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

- The date of 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 months after the Taiwanese application is filed; an extension of time to file the priority document is not permitted.

2.18 Does your jurisdiction 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 that 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 to distinguish the goods or services from those that are not certified. Only a juridical person, group or government agency that is competent to certify another person's goods or services is eligible to apply 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 that is exclusively necessary for the goods or services to be functional.
- A trade mark that is identical or similar to the national flag, national emblem, national seal, military flags, military insignia, official seals, or medals of the Republic of China (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 that is identical to the portrait or name of Dr. Sun Yat-Sen or the head of state.
- A trade mark that is identical 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 that is identical 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 interest, and hence likely to mislead the public.
- A trade mark that is identical or similar to official signs and hallmarks indicating control and warranty adopted by domestic or foreign countries, and designated to identical or similar goods or services.
- A trade mark that is contrary to public policy or to accepted principles of morality.
- A trade mark that is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.

- A trade mark that is identical 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 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 that is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical 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 of relevant consumers, unless the consent of the proprietor of said registered trade mark or earlier filed trade mark to the application has been given and is not obviously improper.
- A trade mark that is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of said well-known trade mark or mark, unless the proprietor of said well-known trade mark or mark consents to the application.
- A trade mark that is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical 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 said earlier used trade mark consents to the application.
- A trade mark that contains another person's portrait or well-known name, stage name, pseudonym, or alternative name, unless said person consents to the application.
- A trade mark that contains the name of a well-known juridical person, business or any group, and hence there exists a likelihood of confusion of the relevant public, unless said juridical person, business or group consents to the application.
- A trade mark that 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 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?

The route of appeal is as follows:

- 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 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 and Commercial Court (IPCC) within two months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPCC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPCC's judgment has been received.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

With respect to the examination of an application for trade mark registration, Taiwan adopts the "comprehensive examination system", which means that the trade mark authority *ex officio* examines all grounds for refusal including grounds regarding conflicting trade marks that involve only private interests.

4.2 Are there ways to overcome a relative grounds objection?

An objection can be overcome by argument, limiting the specification, 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?

Please see question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The principal grounds for opposition are given below:

- A trade mark that is non-distinctive.
- A trade mark that is exclusively necessary for the goods or services to be functional.
- A trade mark that is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark that is identical 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 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 that is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical 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 of relevant consumers.

- A trade mark that is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of said well-known trade mark or mark.
- A trade mark that is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical 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 trade mark in your jurisdiction?

Anyone can oppose the registration of a Taiwanese trade mark.

5.3 What is the procedure for opposition?

The procedure is as follows:

- The opposer files the 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 10 years.

6.4 How is a trade mark renewed?

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

In addition to attorneys' fees, the official fee for one application for renewal of one registration in one class is NT\$4,000.00.

The renewal application shall be made within six months before the expiration of its period. However, it is permitted to pay twice the official fees for renewal within six months after the expiration of the period.

7 Registrable Transactions

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

Yes, an individual can register the assignment of a trade mark, and such assignment shall be recorded with the TIPO.

To record an assignment, the following documents are needed:

- a scanned copy of the Power of Attorney of the Assignee signed by an authorised person; and
- a scanned copy of the Deed of Assignment signed by the parties.

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 goodwill.

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

Yes, an individual can register the licensing of a trade mark, and such licence 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 scanned 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 with the TIPO. A description of the security interest signed by the parties is acceptable.

7.8 Are there different types of security interest?

No, there are not.

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 from those by which it was registered or supplemented with additional notes, whereby the trade mark is identical or similar to another person's registered trade mark in relation to goods or services that are identical or similar to those for which another person's registered trade mark is designated, and hence there exists a likelihood of confusion of 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 procedure is as follows:

- 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 main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The trade mark is not used in a form as registered but should be considered genuine use because its identity remains the same according to the general social concept.

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

Please see question 3.4.

9 Invalidity

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

Please see question 5.1.

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

The procedure is as follows:

- 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 cases where the invalidation action is based on the well-known status of such 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?

Please see question 3.4.

10 Trade Mark Enforcement

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

According to the Trademark Act, a trade mark owner may initiate criminal and civil action against an infringer in Taiwan. In the event of trade mark infringement, a trade mark owner may initiate a civil action with the IPCC (discussed further at question 17.1) to seek infringement removal and damages. Alternatively, the trade mark owner may file a criminal complaint for violation of the Trademark Act 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 violation of the Trademark Act. A trade mark owner may also 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 key 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, to present their arguments on substantive issues in the oral argument sessions, after the civil action moves to proceedings at the district court. The preparatory proceedings usually take around five to eight months, during which period the judge first examines whether the required procedural formalities are met, and the parties submit their respective arguments or move for investigation on evidence. The judge compiles and lists the disputed issues of the case.

In a criminal action in regard to a trade mark infringement, the court issues a notice requesting the court appearance of the defendant and the prosecutor (or complainant) for preparatory proceedings, and the judge compiles the important issues on the substantive issues and evidence presented by the parties, provides opinions with respect to the admissibility of evidence presented by the parties, and decides whether to deny/accept the motion(s) for investigation on evidence. The preparatory proceedings for a criminal action 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.

- (i) 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 (a) likelihood of success on the merits of the case, (b) if the claimant would suffer irreparable harm in the absence of an injunction, (c) balance of interests between both parties, and (d) impact on public interest.
- (ii) Final injunctions are typically granted if the claimant is successful at trial in establishing that (a) the trade mark is infringed (trade mark similarity and likelihood of confusion), and (b) the defendant is currently engaging in infringing activities or is likely to 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 Article 344 of the Code of Civil Procedure, a party has the duty to disclose: (a) documents to which such party has made reference in the course of the proceedings; (b) documents whose delivery or inspection the other party may require, pursuant to applicable laws; (c) documents that were prepared for the interest of the other party; (d) commercial accounting books; and (e) documents that were made in respect of matters relating to the action (the party may refuse to produce such (e) documents that involve privacy or business secrets of a party or a third person and the disclosure of such documents may result in material harm to such party or third person. Notwithstanding, in order to determine whether the party has a justifiable reason to refuse disclosure of such documents, the court, if necessary, may order the party to produce the documents and examine them in private).

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 Intellectual Property Case Adjudication Act requires that the court may not suspend or stay the proceedings pending resolution of validity by the TIPO or the Administrative Court.

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

A damages claim for trade mark infringement is time-barred after a two-year period from the time when the trade mark owner became aware of the infringement and the infringer, or a 10-year period from the time when the infringement took 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 or collective trade mark, shall be liable to imprisonment for a period not exceeding three years and/or a fine not exceeding NT\$200,000.00:

- (1) using a trade mark that is identical to the registered or collective trade mark in relation to goods or services that are identical to those for which it is registered;
- (2) using a trade mark that is identical to the registered or collective trade mark and used in relation to goods or services similar to those for which the registered or collective trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers; or
- (3) using a trade mark that is similar to the registered or collective trade mark and used in relation to goods or services identical or similar to those for which the registered or collective trade mark is designated, and hence there exists a likelihood of confusion of 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\$50,000.00; the 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 can bring a criminal action against the infringer(s).

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

According to Article 2 of the Taiwan Fair Trade Commission Disposal Directions (Guidelines) on the Reviewing of Cases Involving Enterprises Issuing Warning Letters for Infringement on Copyright, Trademark, and Patent Rights (the Guidelines), the “act of issuing a warning letter by an enterprise” means an enterprise publicises to its own or another enterprise’s trading counterparts or potential trading counterparts that another enterprise has infringed its copyrights, trade marks, or patent rights.

Also, according to the first paragraph of Article 3 of the Guidelines, the act by an enterprise of issuing a warning letter constitutes proper exercise of rights pursuant to the Copyright Act, Trademark Act, or Patent Act where the enterprise has issued the warning letter subsequent to confirmation, through one of the following procedures, that its rights have been infringed: (1) a copyright, trade mark, or patent right infringement ruling has been rendered by a court of first instance; (2) a determination of copyright infringement has been rendered by the Copyright Review and Mediation Committee after conciliation; or (3) the allegedly infringing article has been submitted for assessment by a professional infringement assessment institution and an assessment report has been obtained, and the potentially infringing manufacturer, importer, or agent has either been notified beforehand or simultaneously about the issuance of the warning letter and is requested to cease such infringement.

In addition, the first paragraph of Article 4 of the Guidelines provides that an enterprise shall be considered as properly exercising its rights pursuant to the Copyright Act, Trademark Act, or Patent Act if it only issues warning letters after carrying out the following procedures to confirm its rights have been infringed: (1) notify the allegedly infringing manufacturer, importer, or agent to request cease of infringement beforehand or simultaneously with the issuance of the warning letter; and (2) state clearly the precise content and scope of copyright, trade mark or patent rights, and the concrete facts of infringement in the warning letter, so that the receivers of letters have sufficient knowledge that the rights at issue are possibly being infringed.

By doing so, the enterprise will not violate Article 25 of the Taiwan Fair Trade Act (the Fair Trade Act) stipulating that in addition to what is provided for in this Act, no enterprise shall otherwise have any deceptive or obviously unfair conduct that is able to affect trading order.

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 a defence: (1) the allegedly infringing mark is not identical or similar to the allegedly

infringed mark and is unlikely to cause confusion; (2) the allegedly infringing mark is not used as a trade mark; (3) the allegedly infringing mark is not used for marketing purposes; or (4) the allegedly infringing mark should be cancelled or revoked.

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:

- (1) 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: (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, with *bona fide* intent and prior to the filing date of the registered trade mark, an identical or similar mark on goods or services identical 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, and unless there exist other legitimate reasons (Article 36 of the Trademark Act);
- (2) 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
- (3) the plaintiff's claim for damages was time-barred (see question 10.7).

12 Relief

12.1 What remedies are available for trade mark infringement?

In criminal aspects, the trade mark owner may file a criminal complaint against an infringer for violation of the Trademark Act and seek a raid action to be initiated by the police and further initiate an incidental civil action during the trial proceedings after the prosecutor's indictment, which will have more impeding effects and also satisfy cost-saving purpose. Seized counterfeit items will be confiscated and destroyed after the judge confirms and sustains the occurrence of a violation of the Trademark Act. A civil action serves as another remedy, by which a trade mark owner may seek injunction, removal of infringement, compensation, and destruction of the counterfeits.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

In order to initiate 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, at 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 litigation expenses that have been incurred by them respectively. In addition, the parties each should bear their attorney's fee incurred by them respectively, unless the court determines that the losing party should bear the attorney's fee 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 a trade mark infringement action, the complainant may also seek an appeal, 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, however, be the final judgment, with binding effects on the criminal cases of trade mark infringement. That is to say, neither the prosecutor nor the defendant will be allowed to bring the criminal case to a third-instance trial. In a 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 claim value meets the NT\$1.65 million threshold. An appeal taken to the Supreme Court must be based on a 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 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The trade mark owner or its authorised agent may file the request for recording its registered trade mark(s) with the Customs Authority with the material on the key points to identify a counterfeit to the Customs Authority's database for use in combating counterfeit goods at the border. The recordation will be valid until expiration of the trade mark term.

The Customs Authority will withhold the shipment of suspected counterfeits declared for export or import in a random inspection based on the relevant recordation data. The trade mark owner or its local agent must respond to the Customs Authority within 24 hours whether it is willing to either conduct an authentication based on the photos of the suspected goods provided by the Customs officer through the designated Customs online platform or go to the Customs office for authentication upon receiving the Customs' notice.

Further, the Customs Authority must duly obtain a signed examination report and valuation report issued by the trade mark owner within three business days to be legally authorised to withhold the shipment of suspected counterfeits from release. (Upon request, the Customs Authority may allow an extension of three business days when necessary.) If the trade mark owner fails to do so, the shipment of the suspected goods shall be released.

15 Other Related Rights

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

Unregistered trade marks that are commonly known to the public are eligible for right protection under the Fair Trade Act in cases where they are used in the same or similar manner so as to cause confusion with other goods or services (Article 22 of the Fair Trade Act). 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 if 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 to that of another company. Where two companies' names contain any word that may specify their different business categories, such company names will not be considered identical. A company name can be used exclusively by its owner once it has been approved by and registered at the competent authority. Anyone may initiate a civil action with the court for protection of his/her company name from use by a third party. Furthermore, he/she may file a complaint with the Taiwan Fair Trade Commission against the use of his/her company name that is commonly known to the public 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?

Fair Trade Act protection is conferred on unregistered trade marks, personal names, business or corporate names, or containers, packaging, or appearance of another's goods, or any other symbol that represents such person's goods, commonly known to the public, so as to cause confusion with such person's goods (Article 22 of the Fair Trade Act). In addition, an enterprise may be held in violation of Article 25 of the Fair Trade Act for any deceptive or obviously unfair conduct that is able to affect trading order by taking a free ride on any other person's goodwill, or by the act of plagiarising any other person's packaging or appearance of goods, book title or film title, etc. 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 to the Registrar, such as the Taiwan Network Information Center (TWNIC), to register the domain name he/she selects and to pay the annuity.

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

No one may repeat the registration of any registered domain names. According to the "Domain Name Dispute Resolution Policy" passed by the TWNIC, in the following three circumstances, a complaint should be sustained and the TWNIC Registry Administrator should cancel or transfer a registered domain name to the complainant after the dispute resolution provider decides in favour of the complainant:

- (1) The domain name in dispute is identical or confusingly similar to the complainant's trade mark(s).
- (2) The registrant of the domain name in dispute has no rights or legitimate interests in the domain name in dispute.
- (3) The registrant has registered or used the domain name in dispute in bad faith.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The TWNIC deals with disputes in relation to ccTLDs ending with ".tw".

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Taiwan, domain name disputes may be brought to court for resolution by initiating a lawsuit. In addition to a lawsuit, there is another expedited procedure for dispute resolution in which the dispute is handled by a dispute resolution provider that is an organisation or institution approved and recognised by the TWNIC, such as the Science & Technology Law Institute or Taipei Bar Association, which will select qualified panellists to handle domain name disputes according to the "Domain Name Dispute Resolution Policy".

17 Current Developments

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

- On September 15, 2021, the Customs Administration, Ministry of Finance announced the amendment to Articles 7 and 9 of the Regulations Governing Customs Measures in Protecting the Rights and Interests of Trademark, and the amendment took effect as of the same date. According to the amendment, trade mark proprietors or their trade mark agents who receive the Customs notice with respect to any suspected imported/exported goods sighted by Customs may choose to conduct identification of trade mark infringement either at the Customs office as currently required or on the e-platform authorised by Customs. Likewise, importers/exporters may submit non-infringement documents by uploading the same to the e-platform. It is foreseeable that the new measure will save trade mark proprietors and importers/exporters money, time, and

manpower and also enhance efficiency of administrative management. For coping with the amended regulations, Customs has established the e-platform, which is now online for operation.

- The IPCC officially began its operation as of July 1, 2021 after consolidating and reorganising with the existing Intellectual Property Court for hearing and adjudicating major commercial disputes and matters that involve claims in the price or value equivalent to or more than NT\$100 million. To adjudicate major commercial disputes in an appropriate and expeditious process, the IPCC operates at the same level as the High Court in a two-level and two-instance adjudication system. Also, the IPCC adopts such mechanism as mandatory preliminary mediation, mandatory representation by attorneys, e-filing transmission of written statements, distance interrogation and use of e-facilities, expert witness, and trial plan discussion and formulation, etc.

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

The IPCC’s administrative judgment rendered under docket (109) Xin-Shang-Su-Zi No. 96 (rendered on January 14, 2021) (the Supreme Administrative Court rendered a judgment under docket (110) Shang-Zi No. 236 in April 2021 dismissing the appeal filed against the IPCC’s judgment)

In September 2017, the applicant filed an application for registering “101” as a trade mark and designated its use on the services of department stores, etc. The TIPO approved this application. However, a Taiwanese company filed an opposition against the registration of such mark but the opposition was not sustained. Thus, the company initiated an administrative lawsuit against the TIPO’s decision with the IPCC.

In 2020, the IPCC dismissed the administrative action and sustained that the 101 mark is eligible for trade mark registration on the ground that **the applicant’s long-term and frequent use and promotion of the 101 mark has caused relevant consumers to associate the 101 mark with the applicant and made the 101 mark a significant business symbol, and thus, the 101 mark has strong identifying function and has acquired distinctiveness.** This Taiwanese company disagreed with the IPCC’s judgment and filed an appeal against it with the Taiwan Supreme Administrative Court; however, the Court decided to dismiss its appeal on April 22, 2020 and the case became final with binding effect.

The Taiwan Supreme Court’s civil judgment under docket (109) Tai-Shang-Zi No. 2370 (rendered on August 31, 2021)

Burberry Limited (Burberry) holds Taiwanese registrations of its BURBERRY mark and designates its use on watches. Burberry filed a lawsuit against Eastern Home Shopping & Leisure Co., Ltd. (Eastern Home), which is engaged in the business of online and TV shopping and had worked with the co-defendant, namely, its supplier, to jointly display and sell watches bearing the BURBERRY mark imported from China on Eastern Home’s online and TV shopping channels and promoted their watches by the deceptive slogan of “original and British choice goods” from October 2011 to December 2012. Such promotion had caused unspecific consumers to mistakenly believe that these watches were genuine.

The IPCC ruled in the first-instance judgment that Eastern Home and the supplier should be held liable for damages payable to Burberry. The case was appealed to the Supreme Court. **The**

Supreme Court vacated the IPCC judgment and remanded this civil case back to the IPCC on the ground that the damages claimed by Burberry were calculated based on the unit retail price of the seized infringing products as provided by the third subparagraph of the first paragraph of Article 71 of the Trademark Act. The “seized infringing products” are not limited to those under criminal seizure and also include the infringing products the infringer has sold. The supplier was convicted, by a final criminal judgment, of the offence of illegally selling products that infringed upon any other person’s trade mark right. The fact established in the IPCC judgment was that in addition to the 233 infringing watches seized in the criminal case, 6,270 infringing watches had been sold. However, the IPCC granted an award of damages in an amount calculated based on only the 233 seized watches, which was a calculation inappropriate and adverse to Burberry.

Supreme Court judgment under docket (109) Tai-Shang-Zi No. 2726 (rendered on September 9, 2021)

Rimowa GmbH (Rimowa) acted upon the first subparagraph of the first paragraph of Articles 22 and 25 of the Fair Trade Act to assert its rights and filed a lawsuit against two local companies selling online and importing suitcases whose appearance was a close imitation of the “groove design” of Rimowa’s suitcases, and the two local companies’ suitcases would cause consumers confusion and thus infringe upon Rimowa’s groove design as a symbol. The two local companies defended themselves by arguing that the external design of their suitcases was obviously different from Rimowa’s, and that there would be no confusion because their suitcases are sold online and have sales channels and groups of customers that are totally different from those of Rimowa’s products; that is to say, they did not take advantage of Rimowa’s goodwill or exploit the result of Rimowa’s efforts, nor did they show deceptive conduct that would seriously affect trading order.

The IPCC sustained Rimowa’s groove design as a “well-known symbol” in the first- and second-instance proceedings, and thus established the two local companies’ infringement on the ground that some of their products were considered similar to Rimowa’s and thus there was the likelihood of confusion. After this case moved to third-instance proceedings, **the Supreme Court, however, questioned the IPCC’s holding by the issues of whether (a) Rimowa’s groove design alone can still signify products as those from Rimowa if there is no Rimowa mark placed together with the groove design, and (b) the groove design alone is able to help relevant enterprises and consumers identify the source of Rimowa’s products and see the groove design as the reason for purchasing Rimowa’s products.** Moreover, to challenge Rimowa’s assertion with respect to the alleged uniqueness of the groove design, the two companies submitted information showing that many suitcases sold in the domestic market and in foreign countries all carried the design of stripes. This challenge served as the two local companies’ important means of attack and defence to test the issue of whether relevant enterprises or consumers differentiate between the sources of suitcases by said groove design. However, the IPCC failed to look into this issue and directly made a decision that was unfavourable to the defendants. This decision is believed to be questionable, and has resulted in this case being remanded back to the IPCC and pending retrial.

Whether the groove design of Rimowa’s suitcase products is a well-known symbol is a controversial issue in Taiwan. In another civil judgment rendered by the IPCC under docket (110) Min-Gong-Shang-Geng-(1)-Zi No. 2 (rendered on December 23, 2021), the IPCC determined that the groove design of Rimowa’s

suitcase products serves as a symbol that has been commonly recognised by relevant enterprises and consumers and associated with Rimowa. Hence, it is reasonable to sustain Rimowa's groove design as a well-known symbol (a trade dress) that is enables consumers to to distinguish and signify the source.

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

On January 1, 2021, the TIPO announced the amendments to partial provisions of the Trademark Act. One of the key points of the amendments is the establishment of a new division within the TIPO, the "Re-examination and Dispute Deliberation Board" (a tentative English translation of the division name, hereinafter referred to as the R&DD Board), which will conduct independent review of rejected patent/trade mark applications and patent (invalidation) and trade mark (invalidation or revocation) disputes. The R&DD Board has independent authority and power over patent and trade mark remedy cases. Those who further contest decisions made by the R&DD Board may seek remedy by directly initiating a civil action with the IPCC without going through the administrative appeal procedure currently adopted.

On July 10, 2021, the TIPO further announced the second draft amendment to a total of 53 Articles of the Trademark Act with 9 Articles revised, 33 added, and 11 repealed. Compared to and consolidated with the previous amendment announced in January 1, 2021 for public comments, the second draft amendment introduces the following revisions in addition to wording revisions: representation by an attorney-at-law is required for the first-instance proceedings of trade mark re-examination and dispute lawsuits, and circumstances where an agent *ad litem* may

not be an attorney-at-law with the presiding judge's permission, while representation by an attorney-at-law is mandatory for the appellate proceedings. This amendment introduces the grounds for adducing new evidence when and only when (1) the evidence to be adduced was not presented due to the competent authority acting against the law, (2) the facts are apparent at the court, or (3) the competent authority was supposed to know or should have conducted its investigation *ex officio*.

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

In general circumstances of trade mark infringement occurrences, trade mark proprietors may act upon the Trademark Act to assert trade mark rights for civil or criminal aspects involved. For criminal aspects, trade mark proprietors may seek initiation of a raid action by the Intellectual Property Rights Police Team, which will produce more impeding effects and thus serve as the most common remedial measure for trade mark proprietors in Taiwan. In addition, civil and criminal lawsuits are subject to different standards sustaining the existence of trade mark infringement. In criminal cases involving trade mark infringement, the issue whether the defendant sells infringing products under his/her subjective knowledge about the product he/she sells being counterfeit should be tested and examined strictly, while criminal judgments have no binding effects on the civil cases involving the same incident (matter/occurrence). Therefore, in practice, even if the trade mark proprietor loses the criminal lawsuit, he/she has a fair chance of winning the civil action to obtain the award of damages if the infringer is held to infringe upon trade mark rights out of intention or by negligence.



J. K. Lin, Attorney-at-Law and Patent Attorney, Director of TIPLo Attorneys-at-Law.

J. K. Lin became the Director of TIPLo in 1997, the same year TIPLo's founder, Mr. M. S. Lin, passed away. During the 24-year tenure to date, J. K. has set out to further streamline the hierarchy of the staff and adopted effective formulae leading to improved synergy in all aspects of TIPLo's patent, trade mark and legal services to proactively accommodate clients' intensifying needs for IPR enforcement. J. K. also devotes his time to many public speaking events targeted at global corporations and international society, addressing issues of IP-related concerns and unfair competition among other subjects, while following the footsteps of his late father in his dedication to *pro bono* activities organised by various NGOs such as the Judicial Reform Foundation, the Taiwan International Law Society and the Taiwan Human Rights Committee, among many others. He was the Co-Chairperson of the Organising Committee of the 2019 Asian Patent Attorneys Association (APAA) 70th Council Meeting in Taipei, and is currently a Council Member of the APAA and Vice-President of the APAA Taiwan Group.

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H. G. Chen is the Chief Counsel of the Legal Department of TIPLo. He has been practising law in Taiwan for more than 30 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 preminent 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, licensing and negotiation in Taiwan, and this illustrious record has won him a reputation as one of the most successful lawyers in the country. He served as the President of the Taipei Bar Association for the term of May 2005 to November 2006. 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 currently a Council Member of the Asian Patent Attorneys Association (APAA) and an Executive Member of the Board of Directors of the APAA Taiwan Group.

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TIPLo Attorneys-at-Law (also known as 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. Being a leading firm in patent and trade mark prosecution and enforcement, TIPLo is one of the largest and most reliable full-range IP service law firms in Taiwan. TIPLo is currently staffed by 285 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages. TIPLo mainly consists of three departments – Patent, Trademark, and Legal. Our patent engineers and attorneys have a continuous career length of more than 10 years on average, with expertise and experience covering a wide range of technical fields including electrical engineering, mechanical engineering, applied chemistry, biochemical engineering, biotechnology, pharmaceuticals, semiconductors, computer technology and other emerging areas. TIPLo is a leading firm in patent and trade mark prosecution, invalidation and

opposition proceedings, infringement assessment and validity appraisal. The proficiency of our Legal Department in IP enforcement – in particular, litigating infringement cases and coordinating law enforcement efforts – is highly recognised as well by local enforcement authorities of all levels and industries alike, reinforcing TIPLo as one of the most effective law firms representing the interests of its clients.

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