

Taiwan

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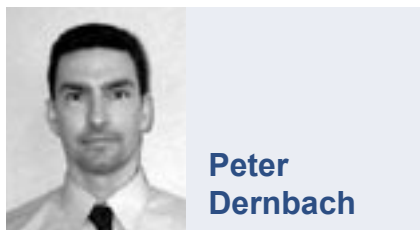
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New Trademark Law Improves Protection

Taiwan has recently made sweeping changes to its *Trademark Law* (the revised Law). The revised Law is a major step on Taiwan's part towards bringing its trademark regime in line with TRIPs requirements and offers significant opportunities for mark owners to obtain better, more effective protection for their trademarks in Taiwan. Promulgated in late May, the revised law will take effect on November 28 2003. Draft amendments to its Enforcement Regulations have been completed and public hearings on these are expected to begin in the next few months. Key changes are highlighted below.

Sound, 3D and single-colour marks

The revised Law explicitly includes sound marks, 3D trademarks and single colours as registrable subject matter. Article 5 therein provides that any word, device, symbol, colour, sound, 3D shape or combination thereof may constitute a trademark; provided that such mark enables consumers to recognize it as a mark identifying the goods or services and causes such goods or services to be distinguished from those

provided by others. Taiwan's Intellectual Property Office (IPO), however, will likely continue to limit registration to those forms explicitly listed as registrable subject matter in the revised Law.

Well-known marks

Under newly adopted provisions, a mark may not be registered if it is likely to damage the distinctiveness or reputation of a well-known mark. As such, well-known marks would be able to block the registration of diluting trademarks, even where no likelihood of confusion is established. Also, Article 62 now provides that use of a mark identical or similar to a well-known mark as a company name, domain name, or other indication of a business in a way that detracts from the distinctiveness of the well-known mark or damages its reputation shall be deemed civil infringement of the well-known mark's trademark rights.

Geographical indications

Registration shall be refused to any mark identical or similar to geographical indications for wines and spirits, where such mark has been designated for use on wine or spirits products under the revised Law. In addition, Article 72 now allows for registration of certification marks for indications of origin.

Trademark use definition

The revised Law's definition of trademark "use" includes use of the mark by means of "two dimensional images, digital sounds or images, electronic media, or other media, where such use is sufficient to cause the

relevant consumers to regard the above as trademarks."

Coexistence agreements

Under the revised Law, if the owner of the senior mark consents to the registration of the junior mark, a coexistence agreement may be used to overcome an objection, unless the marks are identical and are used in connection with the same goods or services. This reflects the international trend that suggests that the mark owners are in the best position to determine the likelihood of confusion between two marks.

Registration fees

Registration fees may be paid in two installments under the new Law. The first is to be paid within two months from the day following the applicant's receipt of the IPO's decision approving the trademark registration. The second must be paid within three months prior to the end of the third year from the date of the publication of the registration. The change is designed to clear the register of registered marks that are no longer being used or that the owner is no longer interested in maintaining.

Opposition to registration

Under the old Trademark Law less than 3% of approved applications were opposed, and less than 1% of approvals were ultimately revoked as a result of a successful opposition. The revised Law provides that once the mark is approved for registration by the IPO, its registration will be published in the *Trademark Gazette*. A party that believes that the registration was issued in violation of the law may then file an opposition with the IPO within three months of the publication of the registration.

Multi-class applications and renewals

Single applications that identify goods and services in multiple international classes are allowed under the new Law and substantive review of marks upon the renewal of a registration has been eliminated.