

[Editor's Note: This paper was reviewed and updated in August 2010. It was originally published in early 2003. Relevant legislation was updated (Amendments to Taiwan's Trademark Law that came into effect in November 2003) and other items were updated in order to ensure the accuracy and time relevance of this document. For more information on this subject matter, please contact Shay & Partners directly.]

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Frequently Asked Questions Protecting Your Trademarks in Taiwan

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General Questions

1. What is a Trademark and what rights does a Trademark owner have in Taiwan?

A Trademark is any mark used to identify a product and distinguish it from other similar products in the marketplace. The definition of a Trademark in Trademark Law refers only to marks used to identify goods. For marks used to identify services, an applicant has to apply for a service mark protection. The owner of a Trademark that is properly registered in Taiwan has the exclusive right to use the registered mark in Taiwan, on any goods listed in the specific category of registration.

2. Is registration required in order to protect a Trademark in Taiwan?

Yes. Unlike the US, Taiwan has no Common-Law system of Trademark protection that grants exclusive rights based on prior use of the mark. In Taiwan, one gains the exclusive right to the use of a Trademark only through formal registration. Therefore, in order to prevent others from using a mark that is the same as or confusingly similar to your mark, it is essential to register all of your Trademarks as early as possible. Even "famous marks" which are well known outside of Taiwan do not receive protection and relief as granted to the registered trademarks until it has completed official registration in Taiwan.

3. How long does Trademark registration last in Taiwan?

The term of a Taiwan Trademark registration is ten years from the date of registration.

4. Can one extend a Trademark registration?

A Trademark registration may be extended for additional terms of ten years each, in perpetuity, provided that the renewal application is filed not more than six months before or six months after expiration of the registration. For those applications filed within the six-month period after the registration has expired the renewal fee is doubled.

5. Can one register a Trademark that is not being used in Taiwan?

There is no requirement that a mark must be in use in Taiwan beforehand for purposes of filing the Trademark registration. However a registered trademark may be subject to cancellation if it has not been used in Taiwan for a period of three or more years.

6. Is it necessary to register a Chinese translation of the mark?

When registering a Trademark in Taiwan, there is no requirement to register a Chinese translation of the mark. However, some companies choose to register Chinese translations or transliterations of their marks either for marketing purposes or as a defensive strategy. While such registration is not required, it can be part of a comprehensive strategy of Intellectual Property protection. We do recommend, however, that a company first register its existing marks as early as possible.

7. How can one tell if others have registered similar marks in Taiwan?

When filing for registration, or upon request, Shay & Partners will perform a search for registrations or applications for registration of the same or similar marks to ensure that there are no conflicting marks in Taiwan.

Application Procedure

8. Can one register a Trademark in Taiwan without using an agent?

Taiwan's Intellectual Property Office (IPO) requires that any foreign applicant without a Taiwan address file its applications for Trademark registration through a qualified law office or Trademark agent.

9. What are the different types of marks that can be protected under Taiwanese law?

Taiwan's Trademark Law presently offers protection for Trademarks, Service Marks, Certificate Marks and Collective Marks. Trademarks can further be divided into Principal Trademarks, Associated Trademarks and Defensive Trademarks.

10. What documents are required to file an application for Trademark registration?

To apply for a Trademark, one must submit the following documents to the IPO:

- a) Power of Attorney executed by the representative of the applicant,
- b) Specimens of the mark, and
- c) Priority documents, if any, issued by the IPO of the country where the application for the same mark was previously filed.

Except for specimens of the mark, all other documents must be submitted in Chinese, but Shay & Partners can provide you with translations of the necessary documents.

11. How long does it take to register a Trademark in Taiwan?

The registration process takes from 8 to 12 months (according to 1999 statistics, the process takes about 21 months in Japan and 18.9 months in the US). Once an application is approved and has been published for three months in the official gazette, registration of the approved mark will be granted.

12. Is an expedited filing service available through Shay & Partners?

Yes. If a client provides us with (a) Power of Attorney, (b) specimens of the mark and (c) priority documents (if any) by fax, with a request for urgent service, we are usually able to file the application within one business day from the date of receipt. The original copies of the documents are still required, but may be sent after the application is in process.

13. Can one claim a priority filing date based on registration in another country?

Yes. Priority filing is available if an application to register the same mark was filed in another WTO member country less than six months prior to its filing in Taiwan. According to the IPO, there may be some rare exceptions for applications seeking priority based on applications filed in China.

14. Can you file an opposition to a pending Trademark application?

Yes. For three months after commencement of publication in the official gazette, any party may file an opposition to the application setting forth the grounds on which the application should be denied. The applicant then has a certain period of time to respond to the opposition. The IPO will then issue a written decision on the opposition, which may be appealed by either party.

15. Can one register a color mark?

Yes. However, we suggest that all applications be submitted in black and white for filing, as one can designate any colors to the mark after it is approved, without affecting the rights.

16. Does Taiwan follow the Nice Agreement's classifications of goods?

Yes. Taiwan is not a signatory party to the Nice Agreement; however, Taiwan has adopted the Nice Agreement classifications into Taiwan's Trademark Law, except that Taiwan's classifications contain additional sub-classifications. Therefore, we suggest that applicants send us detailed specifications of the goods or services on which trademark protection is sought and we will discuss any concerns regarding the additional sub-classifications required for Taiwan filing.

17. Must one file a "Declaration of Use" after registering a mark?

No. Unlike the laws in some jurisdictions, Taiwanese law does not require the registrant of a mark to file a Declaration of Use after a certain period, as the applications for in-use mark and intent-to-use mark are treated the same.

Amendments to Taiwan's Trademark Law

18. When did the latest amendments become effective?

Amendments to Taiwan's Trademark Law were passed by the legislature in April 2003 and came into effect on November 30, 2003.

19. What is the effect of the latest amendments on the definition of a Trademark?

The definition of a Trademark has been broadened to include marks for both goods and services. Previously, it only included goods. In other words, protection for service marks will now fall under the general category of a Trademark. Moreover, the associated Trademark system has been abolished by the amendments of 2003 and the defensive Trademark system will be phased out.

20. Is electronic filing available?

Yes. Taiwan's IPO (Intellectual Property Office) kicked off its trademark electronic filing system in May 2008. Individuals and legal entities, foreign or domestic, are permitted to register online for filing. Details are available at the IPO website: http://www.tipo.gov.tw/ch/AllInOne_Show.aspx?path=2906&guid=e10637ab-fb18-4f50-a920-afeb38fe4602&lang=zh-tw.

21. Can one register for trade dress protection?

Previously trade dress protection was only available under the Fair Trade Law in Taiwan. The amendments of 2003, however, allows for the protection of three-dimensional packaging, or trade dress, under Taiwan's Trademark Law.

23. What is the effect of the amendments on the publication procedure?

The registration of a mark will be granted when the application for registration is approved and the necessary fees are paid. The three-month publication period will commence on the day the registration is granted. Any opposition will be required to be filed within this three-month period.

24. Did the amendments alter the application fees?

Yes. Instead of payment upon submission of the application, the amendments put in place a fee installment system. Within two months from the date the application is approved, the applicant must pay the first installment of the fees in order for the Trademark to be registered and publication to commence. Those who wish to pay in installments shall pay the second installment within the last three months before the end of the third year from the publication date of trademark registration.

If you have any questions concerning the above information or require assistance with the registration, transfer or enforcement of trademarks in Taiwan, please contact us.