

Frequently Asked Questions Regarding Protection of Trademarks in Taiwan

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 market. The definition of a Trademark in the Trademark Law presently refers only to marks used to identify goods. For marks used to identify services, an applicant has to apply for 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(ies) 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 general, one gains the exclusive right to use of a Trademark in Taiwan only through registration. Therefore, in order to prevent others from using a mark that is the same as or confusingly similar to your mark, in connection with sales of comparable goods in Taiwan, it is essential to register all of your company's Trademarks in Taiwan as early as possible.

3. What risks does one take by not registering ones Trademark in Taiwan?

By not applying for Trademark registration in Taiwan, the owner of a mark may lose the right to prevent others from using the same mark in Taiwan, even on the same types of goods. Although the Trademark Law prohibits registration, in the relevant class of goods, of any mark that is the same or confusingly similar to a "famous mark," the evidentiary requirements for demonstrating that a mark is "famous" are rigorous. Further, "famous mark" may refer to a mark that is only used in Taiwan. Consequently, by not filing for early registration of a mark, the owner also runs the risk of not being able to use the mark in Taiwan if another party registered the mark first.

4. How long does Trademark registration last in Taiwan?

The term of a Taiwan Trademark registration is ten (10) years from the date of registration.

5. Can one extend a Trademark registration?

A Trademark registration may be extended for additional terms of ten (10) years each,

in perpetuity, provided that the renewal application is filed not more than six (6) months before or after expiration of the registration. For those applications filed within the six-month period after the registration has expired the renewal fee is doubled.

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

There is no requirement that a mark be used in Taiwan in order to register the mark and gain the exclusive right to use it in commerce. However, a registered trademark that has not been used in Taiwan for a period of three or more years is subject to possible cancellation.

7. 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 a good part of a comprehensive strategy of IP protection. We do recommend, however, that a company first register its existing marks as early as possible.

8. How can one tell if similar marks have been registered by others in Taiwan?

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

Application Procedure

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

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

10. What are the different types of marks that can be protected under Taiwan law?

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

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

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

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

Except for specimens of the mark, the other documents must be submitted in Chinese, but we will be happy to provide you with translations of the necessary documents.

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

Typically the registration process takes from 8 to 12 months in Taiwan (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 (3) months in the official gazette, registration of the approved mark will be granted.

13. Is expedited filing service available through your law firm?

Yes. If a client provides us with (a) Power of Attorney, (b) specimens 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 of the date of receipt. The original copies of the documents are still required and may be sent after the process has commenced.

14. 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 filing the Taiwan application. According to the IPO, however, there may be some rare exceptions for applications seeking priority based on applications filed in China.

15. Can one file an opposition to a pending Trademark application?

Yes. Presently, for three (3) months after commencement of publication 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, and the IPO issues a written decision on the opposition, which may be appealed by either party.

16. 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.

17. 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 classifications in 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.

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

No. Unlike the laws in some jurisdictions, Taiwan 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

19. When will the latest amendments become effective?

Amendments to Taiwan's Trademark Law were passed by the legislature in April 2003. They are expected to come into force by proclamation of the President by the end of 2003.

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

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

21. Will electronic filing be available?

Yes. Pursuant to the amendments, electronic filing will be available in the future although the exact procedure has yet to be announced.

22. Can one register for trade dress protection?

Currently, trade dress protection is unavailable in Taiwan. However, the amendments will allow 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?

Once the amendments become effective, the registration of a mark will be granted when the application for registration is approved and the necessary fees paid. The

three (3) month publication period will start to run on the day the registration is granted. Any opposition will be required to be filed within this period.

24. Will 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 (2) 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. The second installment is due within three (3) months prior to the expiry of three (3) years after publication of the registered mark.

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.

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