

(Translation)

Operational Points on Hearings for Trademark Dispute Cases

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1. Basis and objectives

1.1 These "Guidelines on Hearings for Trademark Dispute Cases" (the "Guidelines") are written by the Intellectual Property Office ("TIPO") of the Ministry of Economic Affairs, pursuant to Article 107(2) and Section 10 of Part 1 of the Administrative Procedure Act concerning hearing procedures, to govern hearings for trademark dispute cases.

1.2 The purpose of a hearing is to give the parties involved in a trademark dispute case an opportunity to present oral debates, using relevant evidence and legal opinions, to help the examiner in charge reach a reasonable and empirical decision. If any party is dissatisfied with such decision, he/she may file an administrative suit pursuant to Article 109 of the Administrative Procedure Act without having to go through the process of an administrative appeal.

2. Definitions:

2.1 A "trademark dispute case" refers to an opposition case, invalidation case, or revocation case relating to trademarks.

2.2 A "party" refers to the owner of the trademark at issue in a trademark dispute case, or the applicant or opposer of a trademark dispute case.

2.3 An "interested party" refers to any of the following parties other than the parties to a trademark dispute case:

- (1) Any party to a suit involving the trademark at issue.
- (2) Any assignee, licensee, or pledgee of the trademark at issue.
- (3) Any party whose rights or interests are affected by the existence of the right to the trademark at issue.

2.4 A "presiding official" refers to the director general of the Intellectual Property Office, or any person designated by the director general.

3. Proceedings of hearings

3.1 If either party to a trademark dispute case deems it necessary to have a face-to-face oral debate with the other party or to cross-examine the witness or expert who has testified, he/she may request for a hearing by submitting an application form (for detail, please see the application form published by TIPO).

3.2 TIPO may hold a hearing *ex officio*, if it deems the hearing necessary.

4. Notice and publication of hearings

4.1. If TIPO decides to hold a hearing for any specific case, a written notice stating the following matters shall be given to the parties involved and any other known interested party twenty (20) days prior to the date of the hearing, unless prior consent is obtained from the parties and known interested parties:

- (1) Reasons for and bases on which the hearing is held.
- (2) Name, residence/domicile, office, or place of business of the parties involved.
- (3) Date and venue of the hearing.
- (4) Procedures to the hearing.
- (5) The parties to the case may appoint agents to act on their behalf.
- (6) The parties may state their opinions and provide evidence in the

hearing. Either party may question any person designated by the authority, witness, expert, the other party to the case, or his/her agent with the consent of the presiding official.

- (7) If any of the parties to the case fails to attend the hearing after being legally notified, an *ex parte* hearing may proceed.

4.2 When the parties to a hearing request to cross-examine any witness or expert who has testified, TIPO shall notify, twenty (20) days prior to the date set for the hearing, the witness or expert of such request, unless prior consent is obtained from the witness or expert.

4.3 Application for rescheduling of the hearing shall be made in writing or by fax at least ten (10) days prior to the date set for the hearing. Approval or rejection of the rescheduling shall be made by TIPO based on the reasons stated in the rescheduling application.

4.4 The hearing attendance form shall be filled out and returned to TIPO ten (10) days prior to the date of the hearing. If any of the parties is unable to attend the hearing on the scheduled date, he/she may appoint an agent to attend the hearing on his/her behalf.

4.5 Before a hearing is conducted, it shall be published at TIPO or on TIPO's website.

The contents of the publication shall contain:

- (1) Reasons for and bases on which the hearing is based.
- (2) Names or titles and residences/domiciles, offices, or places of business of the parties.
- (3) Date and venue of the hearing.
- (4) Agent designated by the parties, if any.

5. Delivery of copies of relevant documents or evidence

Before a hearing begins, the examiner in charge shall deliver copies of relevant documents or evidence submitted by one party to the counter party.

6. During a hearing, investigation and oral argument on the trademark dispute case evidence may be conducted to verify the following matters:

- (1) Whether the trademark is distinctive;
- (2) Whether the trademark consists of a description of the designated goods or services, or the generic mark or term for the designated goods or services;
- (3) Whether the trademark is necessary for the goods or services to be functional;
- (4) Whether there exists a likelihood of confusion;
- (5) The degree of fame of a well-known trademark or mark, or the circumstances of dilution of the distinctiveness or reputation of a well-known trademark or mark;
- (6) Other relationship referred to in Subparagraph 12 of Paragraph 1 of Article 30 of the Act
- (7) Whether the use of the trademark does not affect the identity of the trademark according to general concepts prevailing in the society;
- (8) Whether the use of the trademark is genuine and comply with the general practice of trade;
- (9) Whether transferring or licensing the right of a certification mark, a collective membership mark or a collective trademark to another person for use is unlikely to damage the interests of consumers or to contravene fair competition; or
- (10) Other subject matters relating to the trademark dispute case that should be investigated.

7. Decision not to hold hearings

If TIPO considers that the reasons for requesting a hearing are obviously irrelevant to the case or that there is no need to hold a hearing as the case is unambiguous, the decision on the trademark invalidation, the decision on the

trademark opposition, or the decision on the trademark revocation shall expressly state the reasons why a hearing is not to be held.

8. The presiding official shall preside over a hearing fairly. During a hearing, the presiding official may perform the following duties:

- (1) Question the parties or other persons attending the hearing on the facts or legal issues or urge them to provide evidence.
- (2) Notify any witness or expert to attend the hearing.
- (3) Give the parties and other persons attending the hearing the floor to speak.
- (4) Prohibit the parties or other persons attending the hearing from speaking to avoid delay in the hearing proceedings. Any person who severely obstructs the hearing may be dismissed.
- (5) If any of the parties is absent without any reason, the hearing may proceed, be delayed, or be terminated.
- (6) Depending on the number of seating at the hearing venue, decide the number of people allowed to the hearing.
- (7) Other measures necessary to facilitate the hearing.

9. Hearing procedures

9.1 The hearing shall proceed on the date specified in the notice and at TIPO's conference room or any place TIPO designates.

9.2 The hearing shall be public and be conducted verbally.

If holding a hearing in public will severely damage the interests of the parties, the presiding official may decide whether the hearing be made public in whole or in part.

9.3 Before a hearing begins, identification documents of the persons attending the hearing shall be verified. The persons who attend the hearing shall voluntarily present their identification documents for inspection. Any person who fails to provide identification documents and cannot present one timely may be banned from attending (observing) the hearing and such ban will be put on the records of the hearing.

- 9.4 An invalidation case is examined by three or more examiners on a panel. When a hearing proceeds, all examiners on the panel shall attend the hearing.
- 9.5 The presiding official shall announce the commencement of a hearing and ask each party to introduce the persons who attend the hearing and inquire whether any party opposes any person's attendance. If no objection is raised, the presiding official may explain the gist of the hearing, announce the predetermined speaking and cross-examination sequence and other matters that warrant special attention. Then the presiding official shall read aloud the rights and obligations of the parties, and ask them whether any request for withdrawing the examiner in charge is made, whether they request any witness to testify and to present evidence, or whether they need an expert to explain the matters to be authenticated.
- 9.6 The presiding official shall briefly explain the case and the disputes, and then inspect the evidence submitted by each party.
- 9.7 Any of the parties or interested parties may provide new evidence at this point. The counter party may either defend itself in view of the new evidence or declare to submit a written defense.
- 9.8 When both parties have recognized the evidence and facts, an oral argument shall proceed. In an oral argument, either the applicant or the opposer states opinions on the facts, evidence, disputes, and applicable laws, then, the trademark owner provides the defense. Cross-examination of the parties may proceed repeatedly, and questions may be raised about any matter in dispute.
- 9.9 The parties may ask the presiding official questions about the circumstances of the case or formality issues. The presiding official shall make brief explanations. The parties shall not ask the presiding official to express any opinion or make any judgment on any substantive issue.
- 9.10 If many issues of the case are left to be verified or much evidence remains to be investigated, the presiding official may order the parties to ask questions and defend the issues or evidence one at a time.

- 9.11 During the hearing, the presiding official may ask the parties whether they are willing to settle the matter amicably. If both parties wish to do so, the presiding official may terminate the hearing and the termination shall be handled pursuant to Article 10 of these Guidelines on termination of hearing procedure.
- 9.12 If the presiding official considers that the parties have adequately carried out the oral argument, the presiding official shall announce the closure of the oral argument after both parties have made the final statements of their opinions. If the oral argument is not adequately carried out, the date and venue to continue the hearing shall be decided before the closure of the hearing.
- 9.13 During the hearing, the applicant may withdraw or renounce part of the claims, or reduce the coverage of designated goods or services. The trademark owner may also agree to reduce the coverage of the goods or services designated for the registered trademark, or renounce the trademark right, or apply to divide the trademark right. However, either of them shall see the reduction, renouncement, or division application through.
- 9.14 The presiding official shall expressly inform the parties that under Article 109 of the Administrative Procedure Act, dissatisfactions with the administrative decision rendered in the hearing are eligible for administrative suit.

10. Termination of hearings

10.1 Reasons for hearing termination

If the parties are willing to settle the disputes amicably, or if the contents of new evidential materials submitted after the commencement of the hearing cannot be confirmed or verified during the hearing and have substantial influence on the trademark dispute case, the presiding official may terminate the hearing upon a request or *ex officio*.

- 10.2 When the presiding official decides to terminate the hearing, the records of the hearing should indicate the reasons for the termination.

11. Maintaining order at hearings

- (1) No smoking or drinking is allowed in the hearing. Also, cellular phones should be turned off or switched to silent mode.
- (2) No applause or heckling is permitted while any party has the floor.
- (3) Neither interference nor challenge should be made or raised while any party has the floor.
- (4) Statements should address only matters relevant to the case; no personal attacks are allowed.
- (5) During a hearing, no sound recording, video recording, or photographing is allowed.

12. Record of the hearing

- 12.1 Record of the hearing should be made by the recorder, and should be enclosed with the case file.

Record should include the following matters and be signed by the presiding official:

- (1) Circumstances of the case.
- (2) Names of the parties, interested parties, witnesses, experts, and their agents attending the hearing.
- (3) Hearing date and venue.
- (4) Gists of the statements made or questions raised by the parties, interested parties, witnesses, experts, or their agents, and the documentation and evidence they provided.
- (5) Matters opposed by the parties during the hearing and the reasons therefor, and how the presiding official has dealt with the opposition.
- (6) Gists of the inquiries raised and their corresponding responses.

- 12.2 The record of a hearing may be accompanied by sound recording or video recording.

12.3 The record of a hearing completed on the spot should be signed or sealed by the parties, interested parties, witnesses, and experts. Any objection to the record may be timely raised. If the presiding official considers the opposition justified, corrections or supplements should be made; if the presiding official considers the opposition not justified, the opposition should be recorded.

12.4 If any of the parties, interested parties, witnesses, or experts refuses to sign or seal the records, the reasons for such refusal should be clearly stated.

12.5 When the record of a hearing cannot be completed on the spot, the parties, interested parties, witnesses, and experts should be notified, before or after the closure of the hearing, of the date and place for the reading and signature or seal of the records. If any of attending party refuses to sign or seal, or fails to review the records at the set date or place, the reasons should be clearly stated.

13. Public attendance at hearings

13.1 When the general public desires to observe a hearing, they should file an application with TIPO 10 days prior to the hearing date.

13.2 Due to the limited space at the hearing venue, petitions for public attendance should be handled on a "first come, first served" basis.

14. Language use at hearings

All hearings should proceed in Mandarin. The party using languages other than Mandarin may file a request with TIPO for an interpreter.