

(Translation)
Notice on the Use of Registered Trademarks

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1. Preface

Republic of China (Taiwan) adopts a "first-to-file" trademark registration system, so prior use of a trademark is not a prerequisite for filing a trademark application. Despite this, the function of a trademark and the purpose of registering one entail more than acquiring trademark rights. It is only through actual use of a trademark that consumers come to associate it with certain goods or services, thus demonstrating the value of the trademark through fulfillment of its source-identifying, quality assurance and advertising functions. The Trademark Act affords the applicant who first files the application to register a certain trademark the rights to it, whereby an originally unregistered trademark becomes the applicant's proprietary right. However, if the trademark owner merely acquires registration without using the trademark despite having rights to it, it would lead to others having a reduced chance of filing registration applications—which goes against the legislative purpose of the Trademark Act in protecting trademark rights—and cause the trademark to lose its function and value.

Given the importance of exercising the trademark rights to use a trademark, Article 5 of the Trademark Act expressly defines trademark use and Article 63 of the same Act provides that a proprietor of a trademark is obliged to use the trademark after its registration in accordance with the law. Under the latter Article, the registration of a trademark may be revoked if the trademark 1) has not been used for three years or more, 2) is used only in part, or 3) is altered or supplemented with additions. To prevent an unreasonable situation in which a trademark not used in the marketplace precludes others from registering their trademarks, it is stipulated that an applicant filing an invalidation or revocation action against another's registered trademark (detailed in Item 5.3 of this Notice) shall have the burden of first proving legitimate and continuous use of the applicant's registered trademark on which the invalidation or revocation is based during the three-year period before the filing of invalidation or revocation, if the trademark has already been registered for three years. This is to incorporate the actual use of the trademark in the marketplace into the consideration of factors for determining likelihood of confusion, and to meet the requirement for trademark protection. This Notice is enacted to serve as a reminder and guide to proprietors of trademarks to use

registered trademarks correctly and legitimately so as to maintain their trademark rights effectively. This Notice shall apply *mutatis mutandis* to the use of certification marks, collective trademarks, and collective membership marks in accordance with their nature.¹

2. Definition and forms of trademark use

Use of a trademark means any of the following acts, in the course of trade, where such sign is capable of being recognized by relevant consumers as a trademark:

- (1) to apply a trademark to goods or their packaging or containers;
- (2) to possess, display, sell, export, or import the goods referred to in the preceding subparagraph;
- (3) to apply a trademark to articles relating to the provision of services; and
- (4) to apply a trademark to commercial documents or advertisements relating to goods or services.

The same shall apply if the use in circumstances in any subparagraph of the preceding paragraph is done by digital audio-visual means, through electronic media, on the Internet, or through other media (Article 5 of the Trademark Act).

Through use, a registered trademark becomes associated with the goods or services designated for use by it. To ensure continued protection of the registered trademark under the Trademark Act, the trademark owner shall actively and continuously put the trademark to use within the scope of the goods or services covered by the trademark registration. Only then will it be necessary to afford protection to the owner's rights and interests to the trademark. Such use is deemed use of a trademark for maintaining trademark rights,² the definition of which requires all of the following

¹ According to Article 17 of the Trademark Act, provisions on trademark use apply *mutatis mutandis* to the use of certification marks, collective membership marks, and collective trademarks. Provisions stipulated in Articles 83, 87 and 90 of the same Act regarding the use of certification marks, collective membership marks, and collective trademarks are cited as reference.

² Supreme Administrative Court Judgment 106-Pan-Zi-163

conditions to be met:

- (1) A trademark user must have the subjective intent to use the mark for marketing purposes. Conceptually, "marketing purposes" is similar to the phrase "in the course of trade," which is not limited to sales involving compensation or for-profit transactions. With the development of commercial activities, the determination of whether an act is for "marketing purposes" and thus constitutes trademark use shall be made with the consideration of whether the goods or services identified in the case at issue can be known and recognized by the relevant consumers to distinguish the source of the goods or services from those of others. If the proprietor of a trademark has subjectively marketed and promoted goods or services in the marketplace such that the use of the trademark becomes closely associated with the goods or services offered, then such action shall be deemed to have marketing purposes.
- (2) Use of a trademark must, objectively, be sufficient for relevant consumers to recognize it as such. The primary function of a trademark is to serve as a badge of origin for goods or services. Use of a trademark shall accordingly allow relevant consumers to recognize it as such so that they may refer to it in the future for the same purchasing experience. Yet, if a trademark is used merely as a relevant description of the goods or services *per se*, then it cannot serve as a sign for distinguishing the source of the goods or services of one party from those of others.
- (3) A trademark must be put to use. The manners of trademark use provided in Article 5 of the Trademark Act include the following: the use of a trademark on goods or their packaging or containers; the possession, display, sale, export, or import of goods bearing a trademark; the use of a trademark on articles related to the provision of services; the use of a trademark in a commercial document or advertisement related to goods or services; or the use of a trademark by digital audio-visual means, through electronic media, on the Internet, or through other media. It shall be noted that a trademark owner attempting to prove use of its

registered trademark shall submit evidence consistent with general commercial practices and sufficient to establish genuine use of the trademark on the goods or services designated for use by it (Paragraph 3 of Article 57 of the Trademark Act applicable *mutatis mutandis* under Paragraph 3 of Article 67 of the same Act).

2.1. Trademark use in relation to goods

Use of a trademark in relation to goods mainly refers to placement of the trademark on the goods or their packaging or containers, or on commercial documents or advertisements relating to the goods (e.g. labels, instructions, tags, price lists, and catalogs), or display of the trademark by digital audio-visual means, through electronic media, on the Internet, or through other media, to promote the goods identified by the trademark. Therefore, in addition to the typical use of a trademark, i.e. affixing a trademark directly to goods or their packaging or containers, it shall also be deemed trademark use if display of a trademark in such advertising media as magazines and TV for promoting goods soon to be or already marketed is sufficient for consumers to recognize the goods as being identified by such trademark. For example, a pharmaceutical company seeking to promote the pharmaceuticals it manufactures and sells may apply a trademark for pharmaceuticals to such articles or documents as tablets and their packages, instructions and notes on ingredients, posters, and promotional flyers, run advertisements on the Internet, TV, radio, newspapers, and electronic display boards, or organize a product launch event.

2.2. Trademark use in relation to services

Use of a trademark in relation to services means that, in the provision of services for others, the trademark is applied to articles relating to the provision of the services, or to commercial documents or advertisements relating to the services, or displayed by digital audio-visual means, through electronic media, on the Internet, or through other media, to promote the services identified by the trademark. As provision of services, intangible by nature, does not allow for direct placement of a trademark, the trademark can instead be affixed to tangible articles. For example, a restaurant seeking

to promote the restaurant services it offers may place a trademark on such articles or documents as commercial signboards, employee uniforms, dinner plates, menus, price lists, and business cards, run advertisements on the Internet, TV, radio, newspapers, and electronic display boards, or participate in gourmet shows. If a trademark for identifying services is used on goods or their packaging or containers in a way deemed promotion of the goods, then such use shall not be considered use of the trademark for the services offered.

Take, for example, department stores, supermarkets and warehouse stores seeking to promote the retailing services they offer for general merchandise. Generally, the various divisions of a department store, in the course of providing retailing services for multiple series of goods (e.g. day-to-day household items or foods) rather than a single series of goods, affix trademarks to such articles or documents as commercial signboards, floor guides, signboards indicating areas of sale, clerk uniforms, display windows and racks, shopping carts, baskets and bags, cash registers, receipts, and flyers, run advertisements on the Internet, TV, radio, newspapers, and electronic display boards, or organize anniversary sales and discount events, to promote the retailing services it offers. However, if the store at issue, for promotional purposes, simultaneously puts on display goods bearing its own brand for sale, then the use of a trademark on such goods cannot be deemed use of a trademark for the retailing of general merchandise.

Use of a trademark in relation to services entails actual provision of services or activities to others, and such services must differ from those relevant services that must accompany the sale of one's own goods. If the services as identified by a trademark are provided only for the trademark owner's articles or goods, rather than for the multiple unspecified persons—in other words, the services are not rendered for the relevant consumers—then such use of the trademark shall not be considered legitimate. For example, a trademark registered for "planning and construction of a website" means that the trademark is used for the services of planning and construction of another's website. While the trademark owner may provide back-end sales and distribution information from its clients using its website services that displays its trademark, it shall be noted that such information is provided by the clients internally to its

administrators for back-end computer management for accessing and editing purposes, so it may not serve as objective facts and evidence of the trademark owner providing the designated services to others.³ Take "import/export agency services" for another example. For a trademark registered for use in relation to such services, the tripartite legal relationship of an agency formed by the principal, agent, and third party is essential to constituting a legitimate act of agency.⁴ Accordingly, as such services have to do with conducting import/export businesses for others, the registered trademark used for import/export of the trademark owner's goods cannot be considered legitimate use of the trademark in relation to the designated "import/export agency services."

3. Determination of use of a registered trademark

The proprietor of a registered trademark has the exclusive right in the trademark in relation to the designated goods or services (Paragraph 1 of Article 35 of the Trademark Act) and shall accordingly use the registered trademark in relation to the goods or services for which it is designated. Once registered, a trademark may be marked as registered or with the internationally used trademark registration symbol "®" (Paragraph 3 of Article 35 of the Trademark Act). In actual use, however, marking "TM" or "®" does not necessarily mean that such manners of use will be deemed trademark use. Objective facts and evidence still need to be considered on a case-by-case basis to determine whether the actual form of use is sufficient for consumers to recognize it as a trademark.

3.1. Subject

3.1.1. Trademark proprietor

In principle, a registered trademark is used by the owner of the trademark. The " proprietor of a trademark" may be a company, a firm, or a natural person. A company and its representative are two different subjects of rights. For instance, in a situation where rights to trademark "A" belong to the company's representative, the company's use of the trademark and the representative's use of the trademark are considered uses by different

³ Appeal Decision Jing-Su-Zi-10506305160

⁴ Appeal Decision Jing-Su-Zi-10706314270

subjects. Therefore, for the use of trademark "A" by the company to be acknowledged as use by the representative, the representative must consent to the company's use of the trademark (Proviso of Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act). In practice, however, when the proprietor of the trademark (in this case, the company's representative) provides evidence of the company's use of trademark "A," it is determined, on the basis of general consensus in society and rule of thumb, that trademark A has indeed been used, provided that there are no facts and evidence to the contrary.

The rights and obligations of a business name registered under the Business Registration Act shall be held by the contributor or all of the partners contributing to the business name. For instance, a trademark filed under a business name shall in principle be registered in the format "[business name]; [name of responsible person]" pursuant to current trademark registration practice. This format is adopted regardless of the "type of business organization" being a sole proprietorship or partnership. The trademark rights to such business name, however, shall be held by the responsible person of a sole proprietorship or all of the partners. Therefore, evidence of the registered trademark being used under a business name, or in the name of the responsible person or a partner, can be considered evidence showing use of the registered trademark.

3.1.2. Licensee

A registered trademark may also be used by a person consented by the trademark proprietor to do so, i.e. a licensee. When the facts show that the trademark proprietor has licensed another to use the registered trademark, legitimate use of the trademark can be established. In other words, once a registered trademark is licensed to another, the licensee's use of the trademark can be regarded as use by the trademark proprietor. However, if the registered trademark is used by neither the trademark proprietor nor a party consented by the trademark proprietor to do so, such use cannot be considered legitimate use of the trademark.

While a trademark license shall have no *locus standi* against a third party unless it is recorded with TIPO, whether the trademark is in use is a question of fact. If the trademark owner has licensed another to use the

trademark without recording the license with TIPO, legitimate use of the trademark by the trademark owner can still be established so long as facts showing use of the registered trademark by the licensee are sufficiently found.⁵

3.2. Object

From the perspective of the Trademark Act, the object of trademark use covers any registered trademark and the goods or services designated for use by the trademark. Therefore, whether a trademark is in use and whether such use constitutes grounds for revocation under Article 63 of the same Act pertain to the registered trademark and its designated goods or services.

3.2.1. Trademark

In principle, a registered trademark shall be used in its entirety as originally registered. However, when actual use of a registered trademark is in a form slightly different from that originally registered but the identity of the trademark would, according to general consensus in society, endure, then it can be established that the registered trademark has been put to use (Article 64 of the Trademark Act). By the term "identity," it is meant that a registered trademark and the trademark actually used are slightly different in form but the dominant identifying features of the registered trademark are not substantially altered—consumers are left with the impression that the trademark actually used is identical to the one registered and accordingly perceive them to be one and the same on the basis of general consensus in society and consumer perception. In such a case where identity is established, the registered trademark can be considered to be in use. However, if the dominant, striking portion of a trademark is omitted from use, or if any other word or device is added, causing the altered form to differ from the registered trademark so significantly that consumers, on the basis of general consensus in society and consumer perception, do not identify the altered form as the registered trademark, then their identity cannot be established. Accordingly, the registered trademark is not considered in use.⁶ To establish the identity of a registered trademark and

⁵ Supreme Administrative Court Judgment 88-Pan-Zi-3467

⁶ Taipei High Administrative Court 95-Su-Zi-3716: "In principle, a registered trademark

the one actually used, one first has to identify the registered trademark's dominant identifying features, evaluate whether such features are altered in the trademark actually used, and then consider, in the case at hand, the relevant trading circumstances in the marketplace before making a comprehensive judgment.

3.2.1.1. Determining identity

1. Changing the appearance of a trademark

Changes to a registered trademark in actual use in terms of size, proportion, font, lettering layout, use of standard or variant form of Chinese characters, or capitalization of foreign letters, are generally considered slight differences in form and do not constitute loss of identity. However, the determination of identity or the lack thereof must be made on a case-by-case basis in accordance with general consensus in society and consumer perception.

(1) Changing only the lettering layout of the text in a trademark

a. Registered trademark	Actual use
(Chinese characters written horizontally)	(Chinese characters written vertically) (Valid use of the registered trademark)

亞都

亞
都

b. Registered trademark	Actual use
(English letters below)	(English letters to the left/right)

should be used in its entirety as it was originally registered. If any change is made to the size, proportion, or font of the trademark in actual use, the altered form has to be seen as identical to the registered trademark on the basis of general consensus in society for the registered trademark to be considered in use. If the dominant portion of a trademark is omitted from use, making it so significantly different from the originally registered form that the two are not regarded as one and the same on the basis of general consensus in society, then the registered trademark is not considered in use."

(Valid use of the registered trademark⁷)

淇 淇
g i g i

淇淇gigi

(2) Changing only the font of the text in a trademark

- a. The registered trademark is in standard Chinese font (DFKai-SB), and the actual use in "clerical script" font (*lishu*).

Registered trademark

Actual use

(Valid use of the registered trademark)

香 草 集

香 草 集

- b. The registered trademark is in uppercase, and the actual use in lowercase; both are written in a foreign language.

Registered trademark

Actual use

(Valid use of the registered trademark)

BABY CARE

baby care

(3) Changing only the subordinate (non-dominant) portion of the trademark

⁷ Intellectual Property Court Administrative Judgment 103-Xing-Shang-Su-Zi-127: "The trademark at issue consists of the Chinese characters "淇淇" and the foreign letters "gigi" arranged in two rows, the former over the latter. In actual use, these elements are placed side by side. Despite minor differences in layout and font size of the foreign letters between the trademark as registered and actually used, it is deemed, on the basis of general consensus in society, that their identity endures, and hence the registered trademark has been used."

Registered trademark



Actual use

(Valid use of the registered trademark)

The image shows the letters "BSM" in a bold, sans-serif font, identical to the registered trademark but without the circular border.

(4) Changing the color of a registered trademark

A registered trademark should be used in the registered color. Whether any change of color to the trademark affects identity should be determined by the circumstances of actual use in the case at hand. In principle, when a trademark is registered in black but actually used in one or more colors, the registered trademark can be deemed in use on the basis of general consensus in society and consumer perception so long as the registered form and the actual use differ only slightly in form, without substantial change to the dominant identifying features of the registered form. However, in a case where a registered trademark is not in black (a "colored trademark" as termed in practice) and its color serves as the trademark's dominant identifying feature, if the actual use is in black or other color(s) and such use is deemed, on the basis of general consensus in society and consumer perception, to have substantially altered the trademark's dominant identifying features, then identity is considered lost and hence the registered trademark is not regarded as in use.

a. Registered trademark
(black and white)



Actual use (colored)

(Valid use of the registered trademark)



b. Registered trademark
(blue)

Actual use (in black; colored)

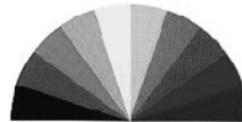
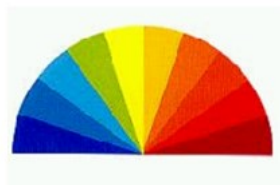
(Valid use of the registered trademark⁸)

⁸ Intellectual Property Court Administrative Judgment 105-Xing-Shang-Su-Zi-27: "The trademark at issue is visually represented by Chinese, English and the Japanese syllable "の"



c. Registered trademark
(colored)

Actual use (black and white)
(Which is not deemed use of the
registered trademark)



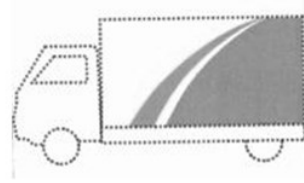
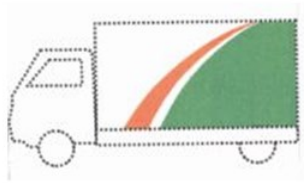
(5) Changing the color of a color trademark

Color is the primary feature of a color trademark, which consists of one or more colors applied to the portion stated in the description of the mark. Color being the dominant identifying feature of such mark, if the actual use is in black or other color(s) and deemed, on the basis of general consensus in society and consumer perception, to have substantially altered the trademark's dominant identifying feature, then identity is considered lost and hence the registered trademark is not regarded as in use.

Registered trademark
(color trademark)

Actual use (black and white)
(Which is not deemed use of the
registered trademark)

combined. The striking feature of the trademark's appearance should be the visual representation of such word combination. As the change to color does not alter or modify the trademark's distinctive meaning, identity is deemed intact."



(6) Changing the color and layout of a registered trademark

Registered trademark
(colored)

Actual use (white)
(Which is not deemed use of the
registered trademark⁹)



(7) Changing the standard or variant form of Chinese characters

Registered trademark

Actual use
(Valid use of the registered trademark¹⁰)



According to the Revised Mandarin Chinese Dictionary issued and edited by the Ministry of Education, "台" and "臺" are variants with the same meaning familiar to the general public. Both "臺大" and "台大," being highly distinctive, indicate the trademark proprietor "國立臺灣大學" (National Taiwan University). Thus, it is deemed that the dominant identifying portion of the registered trademark has not been substantially altered, and that the identity of the two remains intact according to general consensus in society.

⁹ Appeal Decision Jing-Su-Zi-10606302340

¹⁰ Intellectual Property Court Administrative Judgment 107-Xing-Shang-Su-Zi-55

Particular care should be taken with respect to differences between standard or variant forms of Traditional Chinese characters and those written in Simplified Chinese. The differences between some Simplified Chinese characters and their corresponding standard forms of Traditional Chinese characters in terms of stroke and appearance can vary to a large degree. For instance, "潔" vs. "洁," "葉" vs. "叶," and "業" vs. "业" show that consumers cannot directly identify and recognize the corresponding characters in each pair. In a case where the trademark proprietor changes the registered trademark's standard or variant form of Traditional Chinese character into the Simplified Chinese version, the determination of identity has to be made with consideration of the perception of the relevant consumers and the circumstances of the case at hand.

2. Adding words or devices

In principle, when the word or device of a trademark in actual use differs from that of the registered form, the overall commercial impression conveyed may change. If it is only the addition of a generic mark or name for goods or services, or a statement or device describing quality, use, function, raw material, place of origin or relevant characteristics, or other non-distinctive, decorative devices, the registered trademark can be deemed in use so long as the foregoing does not alter the dominant identifying feature of the trademark.

(1) Adding designations of goods or services

Registered trademark



Actual use

(Valid use of the registered trademark)



The trademark "艾菲而及圖 EIFFEL," for use on display stands, is designed with white, hollowed-out letters of a foreign language. Its actual use has the letters in black, with the wording "展示架" (display stands), the name of the goods, added. As the change of font color and addition of the

name of the goods do not cause the loss of identity¹¹, the registered trademark is considered in use.

(2) Adding descriptive texts for goods or services

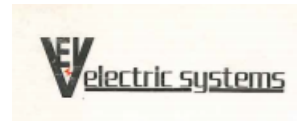
a. Adding descriptive texts for goods

Registered trademark



Actual use

(Valid use of the registered trademark)



When put to actual use, the trademark "E and device," for use on switches, is combined with the wording "electric systems," which emphasizes that the goods bearing the trademark is related to electromechanical systems. The wording merely serves a complementary, descriptive function that does not affect consumers' perception of the trademark and its identity.¹² Hence, the registered trademark is deemed in use.

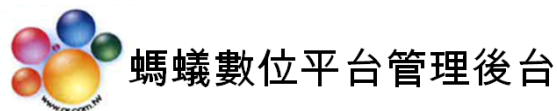
b. Adding descriptive texts for services

Registered trademark



Actual use

(Valid use of the registered trademark)



The trademark "螞蟻數位 and device" consists of five closely connected, black circles of varying sizes combined with the wording "螞蟻數位" and is for use with planning and construction of websites. Its actual

¹¹ Intellectual Property Court Administrative Judgment 103-Xing-Shang-Su-Zi-50

¹² Taipei High Administrative Court Judgment 97-Su-Zi-1659

use utilizes five colorful circles of varying sizes, not joined together, combined with the wording "螞蟻數位平台管理後台" and web address "www.ar.com.tw," of which the wording "平台管理後台" and the web address are descriptive texts related to the service of planning and construction of websites. From overall observation of these two forms, it is concluded that there is no major difference between them in terms of the impression conveyed by the trademark's dominant identifying feature. Accordingly, their identity is seen as intact on the basis of general consensus in society¹³ and the registered trademark is deemed in use.

(3) Adding plain decorations or symbols

a. Adding plain lines

Registered trademark



Actual use

(Valid use of the registered trademark)



The trademark "ipe CAVALLI and design" comprises the wording "ipe" and "CAVALLI" arranged in two rows, the former over the latter. In actual use, the only changes are the manner of arrangement of the letters and the deletion of the mark's square frame, a non-dominant identifying portion. The added straight and horizontal lines are merely plain lines; the added foreign word "GROUP," located in the lower right corner, is rather small. Overall, the actual use does not affect consumers' perception of the original trademark, so their identity is considered intact.¹⁴ The registered trademark is therefore deemed in use.

b. Adding plain symbols

¹³ Intellectual Property Court Administrative Judgment 105-Xing-Shang-Su-Zi-139

¹⁴ Appeal Decision Jing-Su-Zi-10506312360

Registered trademark

KOBO

Actual use
(Valid use of the registered trademark)

KOBO!

KoBo!

The trademark "KOBO" consists of plain, foreign letters. In actual use, the only changes are to font and letter case as well as an added exclamation mark, which altogether do not substantially alter the dominant identifying features of the trademark. The identity of the two forms is considered intact¹⁵ and hence the registered trademark is deemed in use.

(4) Adding words or devices that change the meaning of the trademark

Registered trademark

萃取

Actual use
(Which is not deemed use of the
registered trademark)

生機精華萃取機

生機精華® 萃取® 機

The trademark "萃取" is for use on vegetable and fruit juicers. In actual use, the terms "生機精華" and "機" are added and placed before and after "萃取" respectively. The wording's overall meaning is merely descriptive of the function of the goods and does not enable consumers to perceive "萃取" as a trademark indicating the source of the goods. Hence, the registered trademark is not considered in use. Even if the internationally used trademark registration symbol "®" is added to the upper corner of the wording "萃取," with spaces before and after the wording to separate it from other words, in view of the overall word meaning of the term "生機精華萃取機" (formed by the term "萃取" and its adjacent characters), the consistency of the word font and its layout, it is difficult for consumers to

¹⁵ Intellectual Property Court Administrative Judgment 105-Xing-Shang-Su-Zi-26

separate the term "萃取" from the entire wording and identify it as a source indicator. Hence, the registered trademark is deemed not in use.¹⁶

3. Deleting the non-distinctive portion of the trademark

Registered trademark



Actual use

(Valid use of the registered trademark)



The trademark "Tutti Frutti 冰菓新樂園," for use with fruit and ice eatery, has the foreign wording "ice cream" in the registered form. But in actual use, it is not shown. As it merely indicates the name of the designated goods and occupies a rather minor portion of the trademark in terms of the proportion of font size and placement, its deletion in actual use does not affect the identity of the two forms from the perception of consumers.¹⁷

3.2.1.2. Used in combination with other trademarks or signs

In the marketplace, it is common to see goods or services bearing multiple trademarks simultaneously or a combination of trademarks and signs. In this regard, the Trademark Act does not stipulate restrictions. However, when one seeks to establish use of a registered trademark with evidence showing such combined trademark use, the registered trademark can only be deemed in use if there is no change to the dominant identifying features of the registered form.

(1) Used in combination with a portion of other signs

Registered trademark

Actual use

(Valid use of the registered trademark)



¹⁶ Intellectual Property Court Administrative Judgment 102-Xing-Shang-Su-Zi-115

¹⁷ Appeal Decision Jing-Su-Zi-10006104870



The registered trademark is designed with a plain device. In actual use, "FORMOSA," a specific portion of the trademark owner's English company name, is incorporated; the wording and the device, independent of each another, are used together. As this form does not alter the registered trademark's dominant identifying features,¹⁸ the registered trademark is considered in use.

(2) Used in combination with two or more registered trademarks

Registered trademark	Registered trademark of another case	Actual use (Valid use of the registered trademark)
		

The trademark at issue "黑金剛"¹⁹ is used in conjunction with the trademark "金剛頭像圖案." The Chinese characters and device forming the entirety of a trademark drawing ("黑金剛 and device") have been

¹⁸ Intellectual Property Court Administrative Judgment 102-Xing-Shang-Su-Zi-124: "The Plaintiff places the foreign wording "FORMOSA," a specific portion of its English company name, under the trademark at issue to better promote the manufacturing source of the goods, making it easier for the relevant consumers or businesses to come to know the trademark at issue and its trademark owner. By combining the entire drawing of the trademark at issue with the word "FORMOSA," the Plaintiff enables the relevant consumers to associate the actual use with the registered form of the trademark and to correctly identify the manufacturing source of the goods."

¹⁹ The trademark "黑金剛" Reg. No. 711913 is for use on "various alcoholic beverages, except beer."

registered by the trademark owner in another case.²⁰ It should be noted that the trademark "金剛頭像圖案" has not altered the dominant identifying feature of the trademark at issue "黑金剛," so trademark identity should be deemed intact.²¹ As whether "黑金剛" is written vertically or horizontally only changes the form slightly, and "料理米酒," being the name of the goods, does not affect the dominant identifying feature of the registered trademark, the mark should be deemed in use.

3.2.1.3. Partial use

In actual use, a registered trademark should be used in its entirety; use of any part thereof alone is not allowed.²² Partial use is not considered use of the registered trademark.

Example:

Registered trademark²³

寶島
FORMOSA

Actual use
(Which is not deemed use of the
registered trademark)

FORMOSA

If it is desired that a portion alone be used as a trademark, a separate application should be filed in accordance with the Trademark Act. For example, when an exporter who owns a composite mark comprising Chinese characters and foreign words seeks to use the foreign wording alone for exporting its goods, an application to register the foreign wording as a trademark should be filed pursuant to relevant regulations. This is to

²⁰ The trademark "黑金剛 and Device (I)" Reg. No. 711914 is for use on "various alcoholic beverages, except beer."

²¹ Intellectual Property Court Administrative Judgment 102-Xing-Shang-Su-Zi-103

²² Taipei High Administrative Court Administrative Judgment 96-Su-Zi-1223: "The trademark granted registration consists of a combination of Chinese and foreign words and a device. All of these elements shall be used together; use of any part alone is not allowed."

²³ Appeal Decision Jing-Su-Zi-09406124480

prevent the registered trademark from being revoked for non-use, a ground for revocation, when only the portion of the foreign wording is used.²⁴

Example:

Registered trademark



Actual use

(Which is not deemed use of the registered trademark)



For a registered composite trademark comprising Chinese characters and foreign words, both the Chinese characters and foreign words have to be used together. Separate use of a portion of the mark on different articles does not constitute use of the composite trademark. For example, in a case where a registered composite trademark comprising Chinese characters and foreign words is used on the same article (e.g. the Chinese characters and foreign words being separately affixed to the front and back of a box for packaging), such use is considered valid.²⁵ However, when a portion of the registered trademark is separately used on different articles, whether such use can be deemed valid use of the registered composite trademark shall be determined with consideration of the circumstances of actual use along with other use evidence.

²⁴ Taipei High Administrative Court Administrative Judgment 95-Su-Zi-03716

²⁵ Appeal Decision Jing-Su-Zi-09706113390: "From the outer packaging of the submitted goods, one can see the Chinese "葆青美" and the foreign wording "PROGENE" respectively labeled on the front and back of the box for packaging. This form is different from the trademark at issue, the layout of which is in two rows with the Chinese characters placed over the foreign wording. Nevertheless, for such general, imported goods with nutritional value, it is common to see the Chinese characters and foreign words labelled on such goods to be separately placed on different sides of the box for packaging. This manner of labeling enables consumers to perceive that the mark's dominant identifying features remain "葆青美" and "PROGENE," and hence is sufficient to establish identity of the actual use and the registered form of the trademark at issue."

3.2.2. Goods or services

When a registered trademark is put to actual use, it should be used on the same goods or services identified in the original registration. Failure to use a registered trademark on the designated goods or services for three or more years without legitimate reasons constitutes a ground for revocation under Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act. According to Paragraph 4 of the same Article, when grounds for revocation of a registered trademark exist in connection with only some of the designated goods or services, the registration of the trademark may be partially revoked for that portion of the goods or services. Therefore, if a trademark is only used in relation to some of the designated goods or services, the unused portion of the designated goods or services will constitute grounds for partial revocation of the trademark. Accordingly, particular care should be taken to ensure that the goods or services actually used by a trademark are consistent with the goods or services designated in the registration.

In the determination of whether the goods or services actually used in a case fall within the scope registered for the trademark, it is accepted that those goods or services within the registered scope which are "equivalent or identical in nature" to the portion of the goods or services actually used can be deemed in use to a reasonable extent, to prevent burdening the trademark proprietor with the task of providing an exhaustive list of evidence. The judging criteria for such goods or services should be based on whether these goods or services and those actually used by the trademark are identical in terms of content, expertise, use and function, and whether the general public can identify them as the same on the basis of commercial practices.²⁶ The determination of whether such goods or services are equivalent in nature to those designated for use by the registered trademark may be made on the basis of their nature with consideration of classification practices in administrative examinations.

With respect to two goods or services, it can be deemed that the goods or services actually used by a trademark conform to those designated for its use when 1) these two goods or services are in a superordinate-subordinate relationship; 2) one includes the other; 3) they overlap; or 4) they are

²⁶ Supreme Administrative Court Judgment 106-Pan-Zi-163

deemed equivalent.²⁷ Given the above, if the name of the registered goods or services has a broad meaning or is of a general quality, the trademark proprietor can provide specific goods or services within the scope of the same concept as evidence of use. If the name of the goods or services is specific, the trademark owner should provide evidence showing use of the same, because the goods or services designated is very explicit.

Examples:

- (1) When a trademark registered for use on cosmetics is actually used on compacts and eye shadows, it is considered in use on cosmetics, because "cosmetics" is a general name for goods while compacts and eyeshadows are specific goods within the scope of the same concept.
- (2) When a trademark registered for use on pharmaceuticals for human use is actually used on pharmaceuticals for animals, the trademark is not considered used on the former. This is because pharmaceuticals for animals are approved by the Council of Agriculture for treatment and correction purposes in connection with animal diseases, whereas pharmaceuticals for human use are approved by the Department of Health for treating human diseases—the two are totally different in terms of use and function.
- (3) When a trademark registered for use in relation to banking services is actually used, specifically, to issue credit cards, it is deemed that the trademark has been used in relation to banking services.
- (4) When a trademark registered for use on drug dispensing services is actually used on various pathological testing services, the trademark is not considered used on the former, because they are totally different in terms of the service rendered and expertise offered.
- (5) The List of Codes of Businesses conducted by Companies

²⁷ Supreme Administrative Court Judgment 104-Pan-Zi-429

compiled by the Ministry of Economic Affairs provides the following definition for "supermarket services": "Retailing of household goods and foods, department by department; the business mainly provides fresh foods and assortment of foods for cooking." Thus, for a registered trademark for use in relation to supermarket services, facts and evidence showing that the foregoing household goods, foods, fresh foods or assortment of foods for cooking are placed in the same location for consumers to browse and purchase should be collected and provided. If the trademark is used only for retailing of such specific goods as cigarettes and liquors, it is not deemed in use in relation to supermarket services.

The legislative purpose of Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act is to make trademark proprietors, after registering their trademarks, continuously and legitimately use the trademarks in relation to the designated goods or services. Thus, the goods or services in actual use as submitted by the trademark proprietors should conform to or be equivalent in nature to those registered for use by the trademark. The determination involved is not based on the concept of "similar goods or services" for seeking exclusive registration or use. Given the above, it is not valid to claim that, on the basis of a particular goods or services being in use, other goods or services having a similar relationship are also in use.

In practice, uncertainties arise when a registered trademark is used on giveaways. Whether the display of a trademark on a giveaway is considered use of the trademark shall be determined by considering the definition of trademark use provided in Article 5 of the Trademark Act. That is, it depends on whether the trademark is put to genuine use in the course of trade with the user's subjective intention of promoting the goods or services and whether the result of such use objectively enables the relevant consumers to recognize it as the user's trademark for selling the goods or services. For instance, when a giveaway bearing a registered trademark is only gifted to the customer who has spent a certain amount of money in making purchases, it is considered a conditional giveaway, different from an unconditional one given freely. The former is considered to have the function of promoting the sale of goods or services, with marketing

purposes, and hence an act of trademark use.²⁸

If a giveaway is used only for promotional purposes and not for promoting the sale of the giveaway itself, the relevant consumers will not regard the trademark on it as such, and hence such use will not be deemed use of the trademark on the giveaway. Take, for example, a department store offering balloons marked with the trademark "A" to passersby on the street in celebration of its anniversary sale. As the gifting of balloons on the street is not to sell them but to use them as advertising media to promote its department store services, the display of trademark "A" on the balloons is considered trademark use for its department store services, not for the balloons themselves as products.

3.3. Term of trademark rights

Once a trademark is granted registration, the trademark owner holds rights to the trademark in connection with the designated goods or services for a term of ten years. When the term expires, the registration may be renewed upon application every ten years, for an unlimited number of times; each term of renewal is ten years (Article 33 of the Trademark Act). After registration, a trademark must be put to use in accordance with the law. If, without legitimate reasons, it is not used or has not been used for three years, it will constitute grounds for revocation under Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act. The current examination practice looks at the use evidence dated within the three-year period before the filing date of revocation as submitted by the trademark owner to determine whether the registered trademark has been used. However, if the use of a trademark only began within the three-month period before the filing date of revocation because the trademark owner had previously learnt of an imminent revocation to be filed against its trademark (Paragraph 3 of Article 63 of the Trademark Act), such trademark use cannot serve as favorable evidence showing that the trademark had been used by the trademark owner within the three-year period before the filing date of revocation. Besides, for a trademark owner who had indeed put its registered trademark to genuine use in relation to designated goods or services before a revocation action was filed against it, it can surely provide evidence of trademark use dated outside the three-month time frame

²⁸ Intellectual Property Court Administrative Judgment 103-Xing-Shang-Su-Zi-128

preceding the filing date of revocation to establish continuous use of the registered trademark.²⁹

A trademark owner citing a "legitimate reason" for non-use of its registered trademark means that it is unable to do so due to a factual obstacle or any other reason that cannot be attributed to itself. Such circumstances include the following:

- (1) Before the launch of a drug, approval by the competent authority in charge of pharmaceutical affairs must be obtained. Before the examination is complete and the drug is approved, use of the drug is not allowed. This state of affairs constitutes a legitimate reason for non-use.
- (2) As yet, alcoholic products made in China are not permitted to be imported for sale in Taiwan. This constitutes a legitimate reason for non-use.
- (3) Cutoff of maritime transport, shortage of raw materials, and occurrence of natural disasters leading to material damage to factory machinery which in turn causes factory production or sale to be discontinued are considered legitimate reasons for non-use.³⁰
- (4) Bankruptcy and liquidation: Besides settling pending affairs and facilitating liquidation, a company during the period of bankruptcy or liquidation loses the capability to operate its business. However, being a valuable property in commerce, a trademark is part of a company's asset. To make sure it does not become unusable and consequently being revoked during bankruptcy proceedings, which in turn prevents repayment to creditors, it should be deemed that there is a legitimate reason for non-use of the trademark.

Reasons that should not be attributable to oneself refer to those that, with the exercise of ordinary care, are unforeseeable or unavoidable based

²⁹ Intellectual Property Court Administrative Judgment 107-Xing-Shang-Su-Zi-50

³⁰ Administrative Court Judgment 55-Pan-Zi-301

on objective criteria. If such a reason is only subjectively deemed to be so, it does not count as one.³¹ Thus, if a trademark owner at its discretion does not use the trademark for business reasons of its own, such non-use is not considered to be based on a legitimate reason. For instance, when a company does not use its registered trademark for reasons, such as moving to a new location, company rebuilding, or decisions on business policy, it should be clear that these are tactical decisions made voluntarily, not reasons that cannot be attributed to itself. Hence, these are not legitimate reasons as defined above.³² In a case where a trademark owner, on the basis of the trademark at issue being involved in further dispute yet to be determined, continues its non-use of the trademark, such reason reflects the trademark owner's subjective perception and is not considered legitimate.³³

When a registered trademark is subject to provisional attachment and an injunction is issued against it, the trademark owner is only prohibited from assigning the trademark or taking other measures with respect to it, so the trademark can and should be used continuously by the trademark owner. Thus, the foregoing provisional attachment and injunction do not constitute legitimate reasons for non-use of the trademark.³⁴

3.4. Territory

Given the territorial nature of trademark registration, the exercise of trademark rights and their exclusionary effect are valid within the jurisdiction of Taiwan. In principle, once a trademark is registered, the determination of whether it is used on the designated goods or services is made with consideration of whether such use is done by the trademark owner or a party consented by the trademark owner within the jurisdiction of Taiwan. In the following circumstances, although the products are not sold in Taiwan, the registered trademarks may be considered to be in use.

³¹ Intellectual Property Court Administrative Judgment 99-Xing-Shang-Su-Zi-133

³² Intellectual Property Court Administrative Judgment 107-Xing-Shang-Su-Zi-102

³³ Intellectual Property Court Administrative Judgment 99-Xing-Shang-Su-Zi-133

³⁴ Appeal Decision Jing-Su-Zi-09506180090 of the Ministry of Economic Affairs: "Injunction issued by provisional attachment only prohibits assignment of or other measures taken with respect to the trademark, which accordingly can still be used. Thus, the foregoing provisional attachment and injunction do not constitute legitimate reasons for non-use of the trademark."

3.4.1. Export

As provided in Article 5 of the Trademark Act, a person promoting its goods or services for sale in the marketplace in the course of trade is seen as having "marketing purposes." The territorial scope of the marketplace as defined by the clause includes domestic market sales and exports from Taiwan to other countries. "Export" means that products are exported from the territory of Taiwan. Although the subsequent commercial transactions take place in foreign markets, exporting goods marked with a registered trademark shall be deemed use of the registered trademark pursuant to Subparagraph 2 of Paragraph 1 of Article 5 of the Trademark Act. Furthermore, in the course of trade, if there is evidence showing that a trademark owner has used its trademark in Taiwan, such as marking its registered trademark on the relevant purchase order, and relevant negotiations for the purchase order are completed in Taiwan which is sufficient for the trading counterpart to consider the transaction will be completed within Taiwan, then such trademark use will be deemed domestic use.³⁵

In a case where Party A, a foreign trademark owner, commissions Party B to manufacture goods bearing its trademark for Party A to sell them back to its native country or a third country, such business acts meet the definition of the so-called OEM (short for "original equipment manufacturer") or ODM (short for "original design manufacturer") business model. Though not directly sold in Taiwan's market, the goods bearing Party A's trademark are indeed made within the country. This type of trademark use conforms to the commercial practice of domestic businesses conducting international trade, so Party A's act of selling the goods back to its native country or a third country can be deemed use of its trademark. As Party B is the contract manufacturer who has no intent to engage in acts of marketing, it is not considered a user of the trademark.

3.4.2. Use on the Internet

Use on the Internet means that a trademark owner or a party with its

³⁵ Intellectual Property Court Administrative Judgment 106-Xing-Shang-Su-Zi-99 and Supreme Administrative Court Administrative Ruling 107-Cai-Zi-1427

consent takes advantage of the rapid transmission of information via computer networks to promote their goods or services by using the trademark on web pages to attract consumers to browse and purchase the same. While use of a trademark via the Internet can serve as evidence of use of the registered trademark, one must keep in mind that the Internet transcends borders, so use of a trademark on the Internet has to meet the definition of trademark use provided in Article 5 of the Trademark Act before it can be deemed evidence of use of the registered trademark. That is, the user has to subjectively engage in marketing efforts in Taiwan's market by displaying on web pages the registered trademark and the designated goods or services, and such display has to be sufficiently recognizable in the eyes of the relevant consumers who accordingly can regard the user as having genuinely used the registered trademark in the course of trade.

Another example is the web address. In principle, if the web page showing use of the registered trademark has ".tw" as the top-level domain in the web address, the user can be considered to have the intent of engaging in marketing efforts in Taiwan and targeting Taiwanese consumers within the country. If the website is for another country, further proof must be provided to show that the content of the web page is for marketing efforts in Taiwan and targeting Taiwanese consumers within the country. For instance, such web page has to show the registered trademark and the trademarked goods for sale, with delivery services offered to Taiwanese consumers; or the language in which the web page is shown has to have the Traditional Chinese version available. The factors for determining whether the material showing Internet use of a registered trademark meets the definition of trademark use in Article 5 of the Trademark Act may include but not limited to the following:

- (1) Whether consumers have indeed browsed the relevant web page, or relied on the information provided on the relevant website to purchase the trademarked goods or received the trademarked services;
- (2) Whether the trademark user provides after-sales activities (e.g. guarantees or services) domestically, or builds a business relationship with Taiwanese individuals within the country, or conducts other commercial activities;

- (3) Whether the trademark user displays on the web page a domestic address, telephone number, or any other contact information necessary for consumers to place an order directly with the user; and
- (4) Whether the goods or services provided on the website can be legally delivered within the territory of Taiwan, and whether the prices are shown in New Taiwan dollars.

When the evidence of the Internet use of a registered trademark provided is only on networks linked to foreign web addresses, the party submitting such evidence should make sure it conforms to the relevant factors listed above. For example, for a trademark owner who submits receipts and invoices of goods and product catalogs from online shopping sites in connection with orders placed by consumers in Taiwan via the Internet or by facsimile to prove that domestic consumers have ordered the goods via the Internet, it can be deemed that the trademark owner has used the registered trademark at issue.³⁶

It is not easy to verify the actual date on which a piece of online information is published on the Internet, because not all web pages, at the time when they are made available to the public, disclose their actual date of publication. Moreover, updating websites is fairly easy. Yet most websites do not provide files showing what was previously posted, nor records detailing changes made, for the public to verify the content or date of the published information. Thus, with respect to the facts and evidence of a trademark owner's use of its trademark on the Internet, particular care should be exercised as to the time of clicking on the relevant website by the trademark owner whenever it does so, or the time when online information is made public. The following Internet dates are generally accepted as credible:

- (1) Time stamps showing a web page or file's edit history, e.g. Wikipedia's edit history.

³⁶ Taipei High Administrative Court Ruling 95-Su-Zi-03419 (TIPO Revocation Decision Zhong-Tai-Fei-Zi-940007)

- (2) Indexing dates provided by web search engines, e.g. Google's cached pages.
- (3) Computer-generated time stamps for online information with notes automatically added, e.g. time of publication of blog articles or forum messages.
- (4) Online information provided by Internet archive services, e.g. Wayback Machine.

When there is additional doubt as to the displayed date or content of a piece of online information, other evidence should be submitted as further proof.

3.5. Evidence

3.5.1. Displaying the trademark

Whether a trademark is used is a question of fact. In a trademark revocation case filed on the ground of non-use, the trademark owner is obliged, pursuant to Paragraph 2 of Article 65 of the Trademark Act, to prove its use of the registered trademark when it is served the notice to file a defense. For an application filed for invalidation or revocation of a trademark registration on the ground that such registered trademark is identical with or similar to a cited trademark and hence there exists a likelihood of confusion, evidence showing use of the cited trademark during the three-year period before the date the application for invalidation or revocation is filed shall be submitted, pursuant to Paragraph 3 of Article 57 and Paragraph 2 of Article 67 of the Trademark Act. Therefore, trademark owners should always collect and maintain evidence of trademark use in the ordinary course of trade or when conducting other commercial activities. Admissible evidence of use of a registered trademark includes the following: articles or commercial documents on which the trademark is displayed (e.g. goods, photographs, packaging, containers, purchase orders for signboards, receipts of decoration costs, contracts, shipping notices, export declarations, advertisements, catalogs, posters, and promotional leaflets); or business documents or photographs of the business premises displaying the trademark that pertain to the services for

which the trademark is registered, along with evidence of the service revenue (e.g. invoices, receipts, quotations, and documentary proof of advertising).

The required evidence of use for non-traditional trademarks is basically the same as that stated above for ordinary trademarks. The evidence of use can be in the form of a sample of goods or services, marketing records, product catalogs, newspapers, magazines, or broadcasting particulars for commercials on TV or other media that is sufficient for the relevant consumers to recognize the trademark. For a sound trademark, the sheet music for it is merely its description and does not directly represent the trademark in actual use (i.e. when it's played), so the sheet music cannot serve as the trademark's sole evidence of use.

3.5.2. Displaying the date and user

The evidence of use of a registered trademark should show the registered trademark, the date and user, or other supporting information enabling the identification of the trademark, the date and user; or there should be objective facts and evidence enabling the use evidence to be verified by comparison and considered altogether that sufficiently establish the use of the registered trademark.

Examples:

- (1) With respect to an advertisement placed on a magazine, usually the magazine's issue date is printed on its cover or bottom page, with the goods bearing the promoted trademark and the name of the manufacturer shown on the advertisement page. If no date is shown on the evidence, such as a catalogue and poster advertisement, which generally are undated, relevant evidence for cross reference must be further submitted, such as proof of printing date issued by a printing company.
- (2) An invoice merely establishes the time when a transaction is completed. Relevant regulations stipulate that it is not necessary for an invoice to display a trademark,³⁷ so an invoice cannot be

³⁷ Regulations Governing the Use of Uniform Invoices

adopted as the sole evidence. Even though a trademark name may be shown in the product or remarks column, additional evidence for cross reference should be provided to establish the authenticity and credibility of the invoice. When an invoice displaying the name of the goods includes the goods' model number but not the registered trademark, it may serve as proof of the trademark owner's use of the goods bearing the trademark within the prescribed period if a product catalog as supporting proof is also submitted.

- (3) Customs declarations: In line with general commercial practices and trading circumstances in the marketplace, a foreign trademark owner importing its trademarked goods into the country may display its product brand as shown in the columns "product name," "brand name," and "specifications" on import declarations to indicate the use of the products produced and sold by it. With respect to the name of the brand and goods detailed in the declaration, the one seeking to prove that foreign manufacturers have been commissioned to make the goods bearing its own trademark and these goods are to be transported to its domestic market for sale may provide relevant documentary proof such as a contract manufacturing agreement. A domestic trademark owner using its trademark mainly for export may provide an export declaration to prove its use of the registered trademark.³⁸
- (4) For a registered trademark used on the Internet, one may provide evidence, such as screenshots, online transaction records, email correspondence with clients, online advertising materials, online media coverage, electronic invoices, and agreements signed with online platform businesses. The evidence shall include relevant information, such as the trademark, its designated goods or services, the date and user, or other supporting information that is identifiable or verifiable by cross reference. When there is doubt about the content or date of a piece of online evidence, the trademark owner should provide other supporting evidence to establish the genuine use of its registered trademark on the Internet. For example, when there is no contact information (e.g.

³⁸ Appeal Decision Jing-Su-Zi-09606069850

sales address and phone number) for consumers to directly order goods or relevant information on the seller, relevant information, such as the registered trademark and its designated goods or services being posted on a website cannot become use evidence of the registered trademark unless specific details, such as the publication date of the web page in question or the basic registration particulars of the blog at issue are provided as supporting information.³⁹

- (5) Goods that only exist in or are attached to computers, networks or other media, i.e. technological products, such as computer programs and software, consist of a series of computer commands or a combination of computer data. Though intangible, these goods may be sold in physical form, i.e. magnetic disks or compact discs recorded with computer programs, or obtained by download through network drivers. This latter method enables the downloadable version of a software to be purchased on the Internet by consumers who may download the file through the link storing the software and activate it for use after obtaining the necessary license code by email.⁴⁰ When seeking to prove the use of goods or services that can only be downloaded via or used with computers or networks, one has to further provide relevant evidence, such as web pages, commercial documents (e.g. sales records) and advertisements promoting the sale of the goods or services before the use circumstances of the goods or services can be determined.

3.5.3. Conforming to commercial practices

The submitted evidence of use of a registered trademark shall conform to commercial practices to prove genuine use of the trademark (Paragraph 3 of Article 57 of the Trademark Act applicable *mutatis mutandis* under Paragraphs 2 and 3 of Article 67 of the same Act). Such evidence cannot be created solely for the purposes of lawsuit or demonstrate only token use of the trademark, nor can it be falsified or fabricated. Invoices, receipts or documentary records with falsified transaction dates and those showing

³⁹ Appeal Decision Jing-Su-Zi-10306128150

⁴⁰ Supreme Administrative Court Judgment 104-Pan-Zi-429


dates for fictitious transactions are some examples of such invalid evidence. To determine genuine use of a trademark, one shall examine whether the factors, such as the type, feature, transaction period, sales volume, and manner of transaction with respect to the goods or services conform to general commercial practices to arrive at a factual judgment.⁴¹ One can examine the use evidence, such as the quotation, bill of sale and invoice provided by the trademark owner by comparison to determine whether the foregoing is sufficient to establish the sale of the designated goods or services. It should also be noted that the result of marketing has no bearing on the determination of the trademark use; trademark use can be determined regardless of whether the relevant transaction is completed.⁴²

In accordance with general commercial practices, businesses seeking to draw the attention of consumers or encourage them to make purchases usually have their trademarks or the appearance or feature of certain goods in the form of words or images published in newspapers, often on pages more frequently browsed by consumers, in order to promote the goods.⁴³ However, if the evidence provided by the trademark owner is a classified advertisement in a local newspaper and when its manner of publication only displays the trademark drawing and the description of designated goods or services of the registered trademark, there is no corresponding form of use of the goods or services sufficient for recognition and association by the relevant consumers on the basis of general consensus in society and trading practices in the marketplace, so it cannot be determined that the trademark owner, for marketing purposes, has promoted its goods or services in commerce. Since the circumstances described do not conform to general commercial practices, such use does not count as use of the registered trademark.

⁴¹ Supreme Administrative Court Judgment 107-Pan-Zi-726

⁴² Intellectual Property Court Administrative Judgments 97-Xing-Shang-Su-Zi-88 and 102-Xing-Shang-Su-Zi-151

⁴³ Appeal Decision Jing-Su-Zi-10206103400

	Ann 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	潔莉安 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	JOY 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	MSE 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子
妙欣 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	I&Q 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	愛之船 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	馨韻 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	Sinda 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子
海拉斯 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	捷莉 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	蒂華納 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	Rose 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	美樂思 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子
Lady 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	蒂華納 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	PHOENIX 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	仙蒂 Sandy 衣服、襪衫、 內衣、褲子、 內褲、西服、 領帶、襪子、 襪子、襪子、 襪子、襪子	〇〇〇服飾 股份有限公司 台北市〇 〇路〇巷 〇號〇樓

4. Situations leading to the revocation of a registered trademark

Once a trademark is registered, the trademark owner shall use it continuously and legitimately to maintain its rights. If any of the following occurs, it may constitute a ground for revocation of the trademark.

4.1. Non-use for three years

After registration, a trademark that, without legitimate reasons, has not been put to use or has not been used for over three consecutive years constitutes grounds for revocation under Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act. However, non-use of a trademark is a negative fact; it is extremely difficult for a third party to prove non-use of a registered trademark. Therefore, to validly file a trademark revocation case, the applicant only needs to make a preliminary showing of the negative fact that the trademark is not used by the trademark owner to the extent that the trademark authority becomes reasonably suspicious of the state of non-use, provided that the case is not built on speculation or empty word. The legislative purpose of the foregoing provision is to make sure that trademark owners continuously and legitimately use their trademarks on the designated goods or services after registration. According to Paragraph 2 of Article 65 of the Trademark Act, a trademark owner is obliged to prove use of its registered trademark upon being served a notice to file a defense in response to a revocation action. For details about "legitimate

reasons" and "evidence of use," please refer to Section 3.3 and Section 3.5 of this Notice, respectively.

4.2. Alterations or additions with notes

If a trademark owner makes alterations or additions to the wording, device or color of its registered trademark and accordingly causes it to become identical with or similar to another party's registered trademark used in relation to identical or similar goods or services, which consequently causes relevant consumers a likelihood of confusion as to the source of the goods or manufacturing entity identified, it will constitute the ground for revocation under Subparagraph 1 of Paragraph 1 of Article 63 of the Trademark Act. The legislative purpose of this provision is to require trademark owners to legitimately use their registered trademarks after registration to prevent any improper use that might lead to conflict and confusion with respect to another person's registered trademark and to maintain trading order and fair competition in the marketplace. Hence, the determination of whether this provision should apply depends on whether the use of a trademark altered or added with notes by the trademark owner on its own initiative causes relevant consumers a likelihood of confusion. The legislative purpose of this provision and its application do not pertain to the determination of whether a trademark is put to genuine use; in practice, an argument for the application of this provision should not be based on the question of identity of the trademark as registered and actually used.

Examples:

- (1) The trademark at issue "紅馬 REDHORSE and Device" was altered and added notes by the trademark owner, forming two concentric circles with the inner circle showing a horse head device and the space in-between the two circles marked with the words "STAINLESS" on top and "RED HORSE" on the bottom. This form is similar to the trademark "ZEBRA & Zebra Head Device" cited to oppose the registered trademark. They are for use in relation to identical or similar goods such as bento boxes, causing relevant consumers likelihood of

confusion. Hence, the registered trademark was revoked.⁴⁴

Registered trademark

Altered use with
added notes

The cited trademark



- (2) Originally registered in black and white, the trademark "FLYANT and Device" was colored red by the trademark owner, and the distinctive wings on the ant are intentionally made inconspicuous by giving them the same color as the clothes. (As illustrated in the figure below, the ant device is embroidered in red on a blue shirt; the wings are in blue, the same as the shirt.) The ant as originally registered appears to move rightwards; in the altered use, the ant in red appears to move leftwards. A comparison of this altered version and the cited trademark "per GIB and Device" shows that they have the same color conception, that both ants appear to move leftwards, and that the trademarks are registered for use in relation to the same goods, namely jackets, causing relevant consumers a likelihood of confusion. Hence, the registered trademark was revoked.⁴⁵

Registered trademark

Altered use

The cited trademark

⁴⁴ TIPO Revocation Decision Zhong-Tai-Fei-Zi-L00920288 and Taipei High Administrative Court Judgment 94-Su-1461

⁴⁵ TIPO Revocation Decision Zhong-Tai-Fei-Zi-L00920008



A device showing a red ant moving leftwards



4.3. Generic terms

If a trademark, after registration, is used improperly by the trademark owner, or if someone with the trademark owner's permission uses it as a name for goods, turning the trademark into a generic term for the goods on which it is designated for use, the trademark will lose its identifying function, which constitutes grounds for revocation under Subparagraph 4 of Paragraph 1 of Article 63 of the Trademark Act. For this reason, use of a registered trademark as a name, byword, or synonym for the product should be avoided. Generally, the reason why a registered trademark becomes a generic term is usually because the product bearing the trademark, being novel and widely popular, is directly called by the name of the trademark by consumers purchasing it, or because the business launches and calls its product by the name of the trademark—over time, the trademark becomes a byword for the product commonly used by consumers and businesses alike. Accordingly, the trademark loses its function as an indicator of the source and can no longer be used by consumers to identify the source of the product.

One of the ways to prevent a registered trademark from becoming a generic term for the designated goods is to use the trademark together with the product name, thus making the trademark an adjective indicating (describing) the source of the product, e.g. 大同電鍋 (Tatung electric cooker) and 黑松沙士 (Hey Song Sarsaparilla). When a company

successfully develops a new product—especially when it is the first of its kind in the relevant field—the company should clearly inform consumers of the product name when launching it, to prevent consumers from simply using the trademark to refer to the new product due to not knowing what to call it. For example, "NESCAFE" instant coffee was launched with both the trademark "NESCAFE" and the product name "instant coffee" displayed on the product so that consumers would not simply call the product "NESCAFE." The question of whether a trademark has become a generic term for a product is mainly determined by whether the impression and primary meaning conveyed by the trademark to consumers is the name of the manufacturer or that of the product. Therefore, wherever possible, a registered trademark should be used in a distinctive manner to make consumers notice it and recognize it as a trademark. Once registered, a trademark may be marked as registered or with the internationally used trademark registration symbol "®" to tell and emphasize to consumers that the trademark has been registered, and to remind third parties not to perform any act of infringement against it, thus helping to maintain its trademark rights (Paragraph 3 of Article 35 of the Trademark Act). A trademark owner may also take proactive measures to stop others from using its registered trademark improperly as a way to safeguard its rights and interests to the trademark.

Example:

The trademark "貓眼" was registered for use in relation to reflector mirrors and rear lights for various cars, motorcycles, and bicycles. In a revocation case against it, the applicant cited "St-pioneer" Magazine (技術尖兵) and Google search results to show that "貓眼" (cat's eye) has become a generic term used by businesses making reflective signs and reflectors used as road markers in night time and thus has lost its identifying function as a trademark. Accordingly, its registration for use in relation to "various reflectors and reflection lights for road signs" was revoked under Subparagraph 4 of Paragraph 1 of Article 63 of the Trademark Act.⁴⁶

⁴⁶ TIPO Revocation Decision Zhong-Tai-Fei-Zi-L00940340



Example:

The trademark "卡哩卡哩カリカリ Calhi Calhi CSS and Device," consisting of a combination of words and devices, was registered for use in relation to biscuits, crackers, crispy cakes and oil-fried crackers. The four characters "卡哩卡哩" on the device were established to be a generic term for a kind of spiral-shaped cookies with "old-time" flavor. The mark, however, is formed by a combination of words and devices, not just these four Chinese characters, so the entirety of the mark remains distinctive. The trademark owner acquired rights to the entire trademark for use in relation to designated goods or services, not rights to use a specific part of the trademark alone. Though circumstances pertaining to this trademark did not constitute grounds for revocation, it is manifestly evident that the trademark owner may not claim exclusive rights to the portion "卡哩卡哩" alone.⁴⁷



4.4. Causing the public a likelihood of being misled as to the nature, quality or place of origin of goods or services

A registered trademark should be used as it was registered and in relation to the designated goods or services. Any improper use of a registered trademark which causes the public a likelihood of being misled as to the nature, quality or place of origin of designated goods or services

⁴⁷ TIPO Revocation Decision Zhong-Tai-Fei-Zi-L01040075

constitutes a ground for revocation under Subparagraph 5 of Paragraph 1 of Article 63 of the Trademark Act.

Example:

The trademark "慈愛有機商行 and Device" was registered for use in relation to retailing of agricultural supplies, foods and beverages, and organic foods. With the finding of residues of agricultural chemicals in the oranges produced by the trademark owner, TIPO deemed the wording "有機" (organic) in the registered trademark inconsistent with the circumstances of its actual use, which caused the public a likelihood of making purchases on the basis of a mistaken belief about the nature and quality of the goods or services bearing the trademark, namely, being free of agricultural chemicals. As such use disturbed normal trading order, the registration was revoked.⁴⁸



Example:

The trademark "台東初鹿鮮乳設計圖" (TAITUNG CHULU FRESH MILK Device) was registered for use in relation to the goods, such as beast milk, flavored milk, and cow's milk. An official document from the Taitung County Government stated that the actual milk products used by the trademark owner did not use milk originating from Chulu, Taitung, a fact admitted by the trademark owner. The expressions "台東初鹿鮮乳" (Taitung Chulu milk), "TAIDUNG CHULU FRESH MILK," and "たいとうしょかからのぎゅうにゅう" (cow's milk originating from Chulu, Taitung) shown on the product packaging caused the public a likelihood of mistakenly believing that the goods originated from Chulu, Taitung. As for goods, such as rice milk, tofu pudding and jelly registered for use by the trademark, it should be pointed out that the mark's actual use contains the wording "台東初鹿鮮乳" (Taitung Chulu milk). If the mark is used on

⁴⁸ TIPO Revocation Decision Zhong-Tai-Fei-Zi-L00940033

such goods, the public is likely to perceive these goods as originating from "Chulu, Taitung" in terms of the place of origin and as containing "milk" ingredient in terms of the nature of the goods. As the milk provided by the trademark owner did not come from Chulu, Taitung, the actual use of the mark in relation to such goods caused the public a likelihood of being misled as to the nature, quality or place of origin of the goods. Hence, the registered trademark was subject to Subparagraph 5 of Paragraph 1 of Article 63 of the Trademark Act.⁴⁹



5. Other issues

The following sections discuss recurring issues of use in non-trademark form and use of a registered trademark with a disclaimer.

5.1. Use in non-trademark form

5.1.1. Full company name

The name of a company is a designation used to refer to a business entity, whereas a trademark is used to identify the source of the goods or services designated for use by it and to distinguish them from those of others—they are different in nature. If a specific part of a company's name is used to apply for trademark registration, but in actual use the full company name is put to ordinary use in relation to goods, their packaging, or other relevant business articles or documents, such use shall be seen as use of the company name rather than the registered trademark.

5.1.2. Ornamental design

⁴⁹ The Intellectual Property Court Administrative Judgment 103-Xing-Shang-Su-Zi-94

An ornamental design decorates the appearance of goods, and it has no trademark function in principle. If a user puts it to use as a registered trademark but the relevant consumers do not see it so on the basis of general consensus in society and the perception of relevant consumers, such use is not deemed use of the registered trademark. Whether an ornamental design is used as a trademark or for purely decorative purposes pertains to the labeling practices, i.e. how and where labels are used, of the relevant businesses in a field. For instance, clothing businesses usually affix their trademarks to neck labels, pockets, sleeves, or front of the clothing. For sports shoes businesses, usually the two sides of the shoe uppers are where trademarks are displayed. When the submitted use evidence conforms to the labeling practices of businesses in a field, the registered trademark in question is more likely to be deemed in use.

The perception of relevant consumers is also one of the key factors in judging whether an ornamental design can serve as evidence of use of a registered trademark. For example, it is usually likely for consumers to regard the repeating pattern of an ornamental design on a leather bag as ornamental, so originally it is inherently non-distinctive. Yet, if the applicant can provide evidence to prove that the repeating pattern has been used extensively for long periods to such an extent that the relevant consumers recognize it as a trademark, it can accordingly acquire distinctiveness and be granted trademark registration. Regarding the leather bag provided by the applicant as use evidence subsequent to registration, one notes that the use of the registered trademark on the entire surface of the bag creates a repeating pattern extending continuously; the pattern is used by the applicant as a sign to identify the source of the goods or services. Since the relevant consumers see it as a trademark, the bag is admissible as evidence of using the registered trademark.

5.2. Use of a registered trademark with a disclaimer

The trademark disclaimer system serves as precautionary administrative measures taken during examination proceedings against possible trademark right disputes in the future. Thus, in the determination of identity of a trademark as registered and actually used after its registration—regardless of whether the non-distinctive portion of the mark creates a likelihood of doubt with respect to the scope of the trademark

rights and therefore being disclaimed—factors, such as the placement, layout, and font size, among others, of both the disclaimed and the non-disclaimed portions of the mark may be taken into consideration on the basis of general consensus in society and consumer perception to determine whether the commercial impression conveyed by the entire trademark has been changed.

Example:

(1)

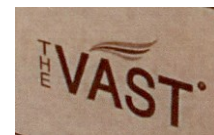
Registered trademark



"Your Vast possibility"
disclaimed

Actual use

(Which are not deemed use of the
registered trademark)



The trademark "THE VAST Your Vast possibility and Device" was registered for use in relation to women's shoes, men's shoes and footwear. The foreign wording "Your Vast possibility" on the device was disclaimed. The mark's actual use shows an asymmetric geometric device comprising three lines and the foreign wording "THE VAST" but not "Your Vast possibility." Clearly, such use does not include all of the compositional elements of the trademark. While a disclaimer for the wording "Your Vast possibility" was made, the wording formed an integral part of the trademark and it created doubt as to the scope of the trademark's rights, so the trademark owner should not have arbitrarily omitted it from its use of the trademark. Accordingly, the identity of the registered form and its actual use was considered lost.⁵⁰ Hence, the registered trademark was not deemed in use.

If the design of a registered trademark is derived from words, the trademark owner may obtain the exclusive right to the stylized words or the

⁵⁰ Appeal Decision Jing-Su-Zi-10706312900

words shown incorrectly. While it is only when there is a likelihood of doubt about the scope of the trademark rights that a disclaimer is required, in a case where the words of a trademark are not distinctive in the original or correct wording but become the mark's dominant identifying feature only when stylized, any actual use of the mark has to conform to the stylized form as originally registered for it to be deemed in use.

Example:

(2)

Registered trademark



Actual use

(Which is not deemed use of the registered trademark)

Café

The trademark is registered for use in relation to "coffee, beverages made from coffee, beverages made from cocoa."⁵¹ "CAFE" is a descriptive term commonly used by businesses, so a disclaimer is not required.

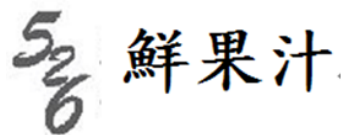
(3)

Registered trademark



Actual use

(Which is not deemed use of the registered trademark)



⁵¹ Trademark Reg. No. 01304614

The trademark is registered for use on "hot and cold beverage store, eating house, snack bar, beverage store."⁵² "鮮果汁" is a generic term of the goods and does not require a disclaimer.

5.3. Use evidence to be submitted by the applicant filing an invalidation or revocation against another's trademark registration

A trademark is a source-indicating sign used in trade that must be put to actual use in the marketplace for it to fulfill its function, accumulate goodwill and create value as a trademark. Therefore, to meet the necessity of trademark protection, whether two trademarks cause a likelihood of confusion on the market has to be determined on the basis of their actual use on the market. For a trademark owner claiming that the registration of another's trademark is identical with or similar to its registered or earlier-filed trademark for use in relation to identical or similar designated goods or services and that it results in a likelihood of confusion by the relevant consumers (Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act), it may file an invalidation. If the trademark cited to file the invalidation has already been registered for three years, evidence of its use on the designated goods or services during the three-year period before the filing of invalidation, or facts and evidence of its non-use for legitimate reasons, must be provided (Paragraph 2 of Article 57 of the Trademark Act). For a trademark owner claiming that another's trademark becomes identical with or similar to its trademark due to alterations or additions with notes, and that it results in a likelihood of confusion by the relevant consumers (Subparagraph 1 of Paragraph 1 of Article 63 of the Trademark Act), it may file a revocation action. If the trademark cited to file the revocation has already been registered for three years, evidence of its use, or facts and evidence of its non-use for legitimate reasons, must be provided (Paragraph 2 and 3 of Article 57 of the Trademark Act applicable *mutatis mutandis* under Paragraph 2 of Article 67 of the same Act). The submitted evidence of use shall be consistent with general commercial practices and sufficient to establish genuine use of the trademark (Paragraph 3 of Article 57 of the Trademark Act). For details about "legitimate reasons" and "evidence of use," please refer to Section 3.3 and Section 3.5 of this Notice, respectively.

⁵² Trademark Reg. No. 01309072

"Evidence showing use of the cited trademark on the designated goods or services to be submitted ..." as stipulated in aforementioned Paragraph 2 of Article 57 of the Trademark Act refers to the facts and evidence on use of the goods or services that cause a likelihood of confusion as claimed by the trademark owner. These facts and evidence not only serve as the preconditions for substantive examination in invalidation or revocation proceedings but also have a direct impact on the scope of the goods and services for excluding others from registering their goods or services in the case at issue. For example, in a case where the cited trademark "A" and the trademark "B" filed after it are registered for use in relation to the goods or services "A1, A2, ..., A10" and "B1, B2, ..., B5," respectively, when the applicant filing an invalidation or revocation provides only the evidence of using the goods "A1 and A2," only these goods are put forward as the concrete facts and evidence for determining whether trademark "B" for use in relation to the goods or services "B1 to B5" causes a likelihood of confusion. As evidence of using the goods "A3 to A10" has not been provided, the substantive examination for the invalidation (Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act) or the revocation (Subparagraph 1 of Paragraph 1 of Article 63 of the Trademark Act) proceedings shall not take these goods into account. As to whether the registration of the trademark in relation to the goods "A3 to A10" shall be revoked due to non-use for three years, another revocation action to determine this issue has to be filed separately.

The evidence of trademark use as provided by a trademark owner following the foregoing regulations only needs to pertain to those goods or services designated for use by the registered trademark claimed by the trademark owner to cause a likelihood of confusion. This is different from the examination of a revocation filed on the grounds that the trademark has not been used after registration (Subparagraph 2 of Paragraph 1 of Article 63 of the Trademark Act), which requires that use of the goods or services covered by the trademark be proven.