

Examination Guidelines on Certification Marks, Collective Membership Marks and Collective Trademarks

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1. Preface

Certification marks, collective trademarks, and collective membership marks besides trademarks are all subject matters protected under the Trademark Act. As they differ from trademarks in definition, nature, and function, the requisite applicant qualifications and application documents therefor differ from those for trademarks as well. To provide a basis for examination of these marks, the *Examination Guidelines on Certification Marks, Collective Membership Marks and Collective Trademarks* (hereinafter the "Guidelines") were stipulated and promulgated on 25 July 2007. The 2011 amendment to the Trademark Act added or amended the definitions of the geographical certification mark, the geographical collective trademark, and the collective membership mark, as well as the matters that should be set forth in the regulations governing the use of the mark, and the definition of use of such marks. The Guidelines were accordingly amended and promulgated on 2 May 2012.

Rather than stipulating separate laws to protect "geographical indications," Taiwan's legal system protects them through registrations of "geographical certification marks" and "geographical collective trademarks" (hereinafter the "**geographical marks**"). As they are forms of protection for geographical indications, the focus of the examination therefor differs from that for general certification marks and collective trademarks. To enhance the awareness of the general public and improve examination quality, the Guidelines have devoted an entire chapter to geographical marks and adjusted the order of other chapters and sections accordingly. In response to questions about how types of certification marks are examined in practice, the 2022 amendment to the Guidelines added or amended the matters that should be set forth when stating the characteristics to be certified in the regulations governing the use of a mark, and such examination principles as unregistrable circumstances, with cases provided as examples. However, since the cited cases solely serve to elucidate and clarify the purport of the Guidelines, they do not necessarily reflect the actual circumstances of these registrations.

2. Certification marks

2.1 Definition

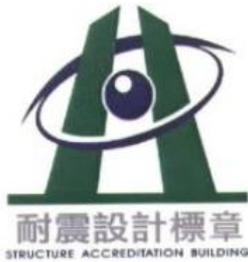
A certification mark, which is applied for registration by a juridical person, a group or a government agency which is competent to certify, is a sign that serves to certify a particular quality, accuracy, material, mode of manufacture, place of origin or other matters of another person's goods or services; provided that such person's goods or services meet the conditions prescribed in the

regulations governing the use of the mark, the proprietor of the mark allows such person to use the mark on the goods or services, thereby distinguishing them from those that are not certified (Paragraph 1 of Articles 80 and Paragraph 1 of Article 81 of the Trademark Act). This illustrates that a certification mark not only certifies that certain goods or services have certain characteristics, but distinguishes such goods or services from those that are not certified.

The proprietor of a certification mark has an obligation to exercise management and supervision to maintain and protect a certification mark's functions of certification and identification. The proprietor has to ensure that the certification mark is used in accordance with the regulations governing the use of the mark, that the goods or services on which the certification mark is used reflect a particular quality, accuracy, material, mode of manufacture, and place of origin certified by the certification mark, and that consumers' rights and interests in using the certification mark to identify the characteristics of the goods or services are protected.

A certification mark may be classified, according to the matters being certified, as either a general certification mark or a geographical certification mark. A general certification mark certifies the quality, accuracy, material, mode of manufacture, or other matters of goods or services, whereas a geographical certification mark certifies the place of origin of goods or the place where a service is provided. Where the certification mark serves to certify a place of origin, the goods or services from that geographical region shall have a given quality, reputation or other characteristic (Paragraph 2 of Article 80 of the Trademark Act). If the characteristic or quality of the goods to be certified by a certification mark is unrelated to the geographical region or environment in which the goods originate, such mark fails to meet the definition of a geographical certification mark. For instance, where a certification mark includes a geographical name but does not certify place of origin, and the characteristic or quality of the goods or services to be certified by the mark is not attributable to the geographical region but is purely the result of the exercise of supervision and control according to the production criteria established by the proprietor, it should be a general certification mark rather than a geographical certification mark (see Section 5.2 of the Guidelines for details).

Examples of accepted general certification marks:



This mark is registered and owned by the Taiwan Architecture and Building Center, and is used to certify that the architectural seismic design by the user of the mark conforms to the standards stipulated by the proprietor of the mark.



This mark is registered and owned by the Tourism Bureau of the Ministry of Transportation and Communications, and is used to certify that the establishment, operational scale, and relevant equipment and facilities of the guest house where the mark is used comply with the Act for the Development of Tourism and the Regulations for the Management of Home Stay Facilities.

Examples of accepted general certification marks (with a geographical name):



This mark is registered and owned by Kinmen County Government, and is used to certify that the agricultural products manufactured and marketed by the user are produced in Kinmen and meet the standards set by the Kinmen Animal and Plant Health Inspection Office. This mark is primarily used to certify that the goods meet certain testing standards. As the quality, reputation, or any other characteristic of the agricultural products so

certified is unrelated to geographical environment, the mark is a general certification mark.



This mark is registered and owned by the Industrial Development Bureau of the Ministry of Economic Affairs, and is used to certify that the goods produced or manufactured by the user conform to the Implementation and Management Regulations for the Made-in-Taiwan (MIT) Smile Logo of Taiwan-Made Products and the Main Points for Implementing and Managing the Certification System of MIT Products with Smile Logo. This mark is primarily used to certify that the goods meet certain quality standards. As the quality, reputation, or any other characteristic of the clothing, knit socks, bedding, or household appliances so certified is unrelated to geographical environment, the mark is a general certification mark.



This mark is registered and owned by the Taiwan Leisure Farms Development Association, and is used to certify that the quality of a leisure farm's services meets the requirements set forth in the Main Points for the Accreditation of the Quality of a Leisure Farm's Services established by the proprietor. This mark is primarily used to certify that the services meet certain quality standards. The quality of the leisure farm's services so certified is unrelated to geographical environment. Although the term "Taiwan" and an "outline of Taiwan" appear in the mark, they are used merely to indicate that the services are provided in Taiwan. Therefore, this mark is a general certification mark.

2.2 Examination of general certification mark applications

An application for registration of a general certification mark shall be made by filing an application containing (the name and address of) the applicant, a representation of the mark, and the goods or services to be certified (Paragraph 1 of Article 19 applicable *mutatis mutandis* to Article 94 of the Trademark Act), and by submitting documentation proving such person's capability to certify another person's goods or services, the regulations governing the use of the certification mark, and a declaration that such person does not carry on a business involving manufacture and marketing of the goods or provision of the services of the kind certified (Article 82 of the Trademark Act). In addition to these documents, an examination of the application as to the distinctiveness of the certification mark and other grounds for refusal of registration are also required (Articles 29 and 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act). Examination of procedural matters for trademarks shall be applicable *mutatis mutandis* to that for certification marks (see the *Examination Guidelines on Procedures for Trademark Registration Applications* for details). The following are examination guidelines on such special procedural matters as the definition of a certification mark, the applicant, and the regulations governing the use of a mark, and on the distinctiveness of the mark and other grounds for refusal of registration:

2.2.1 Whether the mark meets the definition of a general certification mark

A general certification mark is a sign that serves to certify a particular quality, accuracy, material, mode of manufacture, or other characteristic of another person's goods or services. Therefore, a sign applied for registration that does not certify certain characteristics of goods or services is not a general certification mark. For example, an application to register a certification mark to certify an individual's qualifications, skills, or academic proficiency, a logo filed by a government agency to promote public policies, or a mark filed by a testing provider to offer testing services and issue certificates of test results for others will not be approved, as they all fail to meet the definition of a certification mark, namely a mark used to certify a certain quality or other characteristic of goods or services. Hence, they are not registrable as certification marks (see Section 2.1 of the Guidelines for reference).

Examples of accepted marks:



- This mark is registered and owned by the Bureau of Energy of the Ministry of Economic Affairs, and is used to certify that the energy devices or new energy equipment certified are energy-saving.



- This mark is registered and owned by the TSUEI MA MA Foundation for Housing and Community Services, and is used to certify that the quality of moving services complies with the conditions set by the proprietor of the mark.

Examples of inadmissible cases:

- A city government applied to register a certification mark to certify the following: "For an agency subordinate to the city government, or any agency or school of this city, or any civil association, company and firm registered with this city, that seeks to promote tourism, it may apply to the city government for authorization to use the certification mark on any articles used in any promotional campaigns for tourism." Such mark was to be used as a logo by a government agency to promote tourism, rather than to certify that the quality or other characteristic of goods or services meets certain standards. It does not meet the definition of a certification mark and, therefore, the application was inadmissible.
- The labor affairs bureau of a city government applied to register a certification mark for certifying "the current state of gender equality in the workplace of a civic group, business entity, or government agency within the city." The mark is used by government agencies to promote gender equality in the workplace. However, the mark does not certify that certain

standards have been met with respect to the quality or other characteristics of goods or services. As the mark does not meet the definition of a certification mark, the application was inadmissible.

- A committee applied to register a certification mark for certifying that "the English proficiency skills of the tested individual have reached high, intermediary, or elementary level." Such mark was used to screen for and assess a person's qualifications or abilities, rather than to certify the quality or other characteristics of a service provided by a person. As the mark does not meet the definition of a certification mark, the application was inadmissible.
- An organization applied to register a certification mark for certifying that "the quality of the cleaning services provided has met the standards stipulated by this organization." However, from the regulations governing the use of the mark submitted by the applicant and the actual circumstances of use, it was concluded that the organization sought to evaluate and appraise the ability of a professional cleaner. Such mark failed to meet the definition of a certification mark.
- A competition is generally a one-time award event, with certificates serving as a symbol of the accolades received by the winners. Such certificates are not meant for winners to use in endorsing their goods or services to certify that the quality or characteristic of such goods or services meets the standards of use stipulated by the owner of a certification mark. Under such circumstances, the definition of a certification mark has not been met.

Where a mark submitted for registration does not meet the definition of a general certification mark, it may be amended to seek trademark registration if, upon consideration of the case's circumstances, the services designated for use with the mark belong to the category of screening and testing for skills and academic proficiency or educational examinations in Class 41 or the category of inspection or testing services in Class 42. As the application form for a certification mark differs significantly from that for other types of trademarks, the applicant shall be notified to amend the application. The applicant shall proceed to submit a *trademark* application containing the name of the applicant, the trademark representation, and the designated goods or services; the date on which this application is filed shall be taken to be the application date, and examination therefor shall continue accordingly. However, if the applicant fails to amend the application within the specified period, or if, even after the

amendment is made, the mark still fails to meet the definition of a certification mark, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). It should be noted that the applicant shall first confirm the type of rights sought—rights to a certification mark or a trademark—during formality examination. Once the trademark registrar office has begun the process of substantive examination, one cannot change the type of trademark in the application.

2.2.2 Applicant

2.2.2.1 Applicant's qualifications and capability to certify

Only a juridical person, a group or a government agency which is competent to certify another person's goods or services shall be eligible to apply for registration of a certification mark (Paragraph 1 of Article 81 of the Trademark Act). Such applicant may be a foundation or an association established under the Civil Code, a juridical person established under other laws (including the Company Act), as well as a government agency or an unincorporated association. Natural persons are ineligible to apply.

The subject matter protected by the Trademark Act is a kind of intangible property right, and in principle the applicant may only be a natural or juridical person who has the capacity for rights. However, in the case of a certification mark, it is very common in Taiwan to see an unincorporated association in the business of certification. Examples include the Chinese Organic Agriculture Association and the Taiwan Formosa Organic Association, which provide certification of organic agricultural products and organic agricultural processed products, and the Taiwan Leisure Farms Development Association, which provides certification of the quality of a leisure farm's services; these are all unincorporated associations. To accommodate practical needs, exceptions are allowed for an unincorporated association, and express provisions are included in the Trademark Act (Article 99 of the Trademark Act), under which an unincorporated association is eligible to file a complaint or initiate a private prosecution to safeguard its rights and interests. Moreover, a government agency may also be an applicant, as it may be necessary for a government agency to certify a particular characteristic of certain goods or services when dealing with matters that fall within the scope of its official duties (such as consumer safety, environmental protection, trade promotion). It would typically be difficult for a natural person to exercise proper supervision and control over the use of a mark, based on his or her limited power and material resources. A natural person thus does not meet the criterion of being competent to certify another person's goods or services and, therefore, is not eligible to apply for registration of a certification mark (Paragraph 1 of Article 81 of the Trademark Act).

An applicant must be competent to certify another person's goods or services. In other words, an applicant should be capable of exercising supervision and control over the use of a mark. Such capability should be adequate for implementing the regulations governing the use of the mark, and for managing and supervising compliance of the goods or services of the authorized user with the conditions of use of the certification mark. The applicant should have in place a mechanism for preventing any violations of the law and any improper use of the certification mark, and should ensure the quality and characteristics of the goods or services so certified.

To determine whether an applicant is competent to certify, one may examine the matters specified in the regulations governing the use of a mark, such as the nature and the purpose of establishment of the juridical person, group or government agency as the applicant, and the method with which it supervises and controls the use of the certification mark. Where an applicant is a commercial, industrial or occupational association, or any juridical person or group established in accordance with the law, to determine whether the applicant is competent to certify, the trademark registrar office may take into consideration the purpose of incorporation, the aim, mission, the lines of business, the scale of business, and the history of the juridical person or group. Take the certification mark "Taiwan Textile Federation Logo" applied for by the Taiwan Textile Federation as an example. Founded in 1975, the Taiwan Textile Federation provides services to all textile companies in Taiwan. The Federation's main business is to assist and provide guidance to textile companies to research and develop new products and expand the market. It enjoys a good reputation in the textile industry. Based on these facts, the Federation was held to be competent to certify that a textile clothing product, whether finished or semi-finished, passes the Federation's standard tests for either "pure cotton, anti-wrinkle textile clothing," or "far infrared textile clothing," or "waterproof breathable textile clothing." If the applicant is a government agency, the trademark registrar office may take its official duties into consideration. There should be fewer questions about a government agency's capability to certify, if it is the competent government authority with jurisdiction over the relevant industry of goods or services to be certified.

In the case where other laws also regulate the quality, accuracy, or other matters in relation to the goods or services intended to be certified, then the issue of whether the applicant of the certification mark is competent to certify must be determined in accordance with the relevant laws. For example, in the case of "organic agricultural products," the Organic Agriculture Promotion Act provides that a certification body must be accredited and issued an accreditation by an accreditation body of the Council of Agriculture of the Executive Yuan to

perform certification for organic agricultural products. Therefore, if an applicant is accredited by an accreditation body of the Council of Agriculture to be a certification body, it is competent to certify.

Where a certain testing procedure is required to certify that certain goods or services possess or reflect a particular quality, accuracy, material, mode of manufacture, or other matters, an applicant may undertake the required testing, or authorize a competent juridical person or group which is qualified to test to carry out the required testing or verification under its supervision and control (Article 47 of the Enforcement Rules of the Trademark Act; see also Section 2.2.3.3 of the Guidelines for reference). If objective facts or evidence indicate that the applicant lacks capability to certify and fails to delegate the testing or verification to a competent juridical person or group, the applicant's capability to certify another's goods or services would be questionable. In such cases, the applicant is required to make an amendment.

A certification mark application shall be inadmissible if an applicant who does not satisfy the requirements regarding qualification and capability to certify has been notified to amend such noncompliance, but such noncompliance is not amended within the specified period, or even after the amendment, the applicant is still found to lack the qualification for a juridical person, group, or government agency, or still cannot be found by the trademark registrar office to be competent to certify (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

2.2.2.2 Applicant shall not carry on a business of goods or services of the kind certified

A certification mark primarily serves to certify the characteristics of goods or services. If the applicant itself carries on a business of goods or services of the kind certified, it will not be easy for the applicant, as a competitor of those in the same industry, to maintain impartiality and objectivity, even if the trademark filed for registration is neither identical nor similar to the certification mark. And if the applicant itself uses the certification mark on its own goods or services, the fairness and objectivity of certification would be even further subject to question. Therefore, an applicant who carries on a business of goods or services of the kind certified cannot apply to register a certification mark (Paragraph 2 of Article 81 of the Trademark Act); Any person who applies to register a certification mark shall also submit a declaration that such person does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified (Paragraph 1 of Article 82 of the Trademark Act).

The above-described declaration will generally only undergo formality examination. However, if facts or evidence demonstrate that the applicant actually carries on a business of goods or services of the kind certified (e.g. the applicant has an earlier-registered trademark or an applied-for trademark on record covering the goods or services certified), the formality is inconsistent with the declaration. The applicant should be notified to submit an explanation, which should sufficiently show that it truly does not carry on a business of the goods or services of the kind certified. In practice, if the goods or services to be certified by the applicant are identical to those designated for use with a registered trademark or an applied-for trademark, the applicant should abandon the rights to the registered trademark or withdraw the trademark application, or reduce the scope of such trademark's goods or services that is identical to the scope of the goods or services to be certified, before the application is admissible.

A declaration of not carrying on a business of the goods or services of the kind certified as made by an applicant is mainly to ensure the neutrality of the proprietor of the certification mark, permit others to use the certification mark, and prevent any connection in the nature of commercial or business interest that pertains to the relevant market for the goods or services of the kind certified. For instance, where a manufacturer of the goods to be certified or a provider of the services to be certified is not the applicant of a certification mark, if there is objective evidence (e.g. third-party observations) showing that the raw material of the goods to be certified is provided by the applicant of the certification mark (e.g. the applicant of a certification mark used to certify characteristics of reishi mushroom capsules in Class 5 acquires the registration of a trademark for fresh reishi in Class 31), it would mean that the applicant of the certification mark may have a connection in the nature of commercial interest, thereby violating the obligation to remain neutral. Under these circumstances, the applicant should be notified to submit an explanation and should reduce the scope of the relevant goods or services designated for use with the trademark so as to maintain neutrality.

If the applicant does not submit with its application a declaration that the applicant does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified, or if the applicant submits a declaration that is not compliant with the relevant requirements, the applicant will be given notice to amend the noncompliance or submit an opinion; should the applicant fail to amend such noncompliance within the specified period, or even after the amendment or submission of opinion is made, the amendment or submission is still found to be noncompliant, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17

of the Trademark Act).

The Trademark Act merely restricts proprietors of certification marks from carrying on a business of goods or services of the kind certified. They can still freely carry on any business other than those of goods or services of the kind certified. Therefore, the proprietor of a certification mark may own both a trademark and a certification mark and use the former to indicate its own goods or services and the latter to certify the goods or services of others. For example, to promote a certification mark and to advertise the characteristics of the agricultural processed products or foods to be certified thereby, the applicant can apply to register an identical or similar trademark for use on "electronic publications" in Class 9, "publications" in Class 16, "advertising services" in Class 35, "publication services; education services; conducting seminars" in Class 41, and "testing services" in Class 42.

If a certification mark is used as a trademark, the trademark registrar office may, upon application by any person or *ex officio*, cancel the registration of the certification mark (Paragraph 1 of Article 93 of the Trademark Act). If an identical or similar representation is used to separately obtain the registration of a certification mark and a trademark, the facts or evidence showing use of the certification mark may not be those that demonstrate the proprietor thereof using the mark on the goods or services to be certified thereby; instead, relevant facts or evidence showing use of the certification mark by an authorized person shall be submitted (Paragraph 1 of Article 93 of the Trademark Act). Otherwise, one may raise doubts about the mark being used as a trademark.

Examples of inadmissible cases:



The image on the left was a trademark registered by Chung Hua Antibiotic Free Farming Association for use on goods in Classes 29 and 31. The image on the right was the certification mark subsequently filed for registration by the association to certify that the agricultural products (including aquaculture, meat, dairy, and egg products) certified thereby conform to the *Implementation Guidelines for Antibiotic Free Farming*.

The goods registered for use with the trademark were clearly covered by the scope of the goods to be certified by the certification mark. In terms of formality, there was a possibility of the applicant carrying on a business of the goods to be certified by the mark. As the applicant failed to amend such noncompliance within the specified period, the application was inadmissible.



This is a certification mark sought to be registered by the Audit Bureau of Circulations, R.O.C. to certify accuracy of an audited volume of magazine circulation. However, the applicant has an earlier-registered trademark that is used in the publication of various books, magazines, and literature, which fact shows that the bureau is in the business involving the services it certifies (publication of magazines). As no explanation was provided to remedy such noncompliance, the application was inadmissible.

Examples of accepted marks:



The image on the left was a trademark registered by Taiwan Vegetarian Association for use on vegetarian meat, vegetarian meat floss, tofu, and tofu skin. The image on the right was the certification mark subsequently filed for registration by the association to certify that the vegetarian products made by others conform to the Regulation for Certifying Vegetarian Products stipulated by the proprietor of the certification mark. The goods registered for use with the trademark were those to be certified by the certification mark. After the rights to the trademark were abandoned, the certification mark was granted registration.



THE STANDARD IN SAFETY



The image on the left is the earlier-registered trademark for use on such services as providing product safety testing services, testing goods of others to assess compliance and conformity pursuant to national and international standards, and testing goods of others to assess electromagnetic capability and compliance with telecommunications regulations. The image on the right was registered later by the proprietor as a certification mark to certify that electrical devices such as connecting plugs, soft wire connectors, connectors, contacts, plug terminals, and hospital grade connecting plugs are in compliance with particular guidelines and standards. Because the product safety testing services for which the earlier-registered trademark is used lie outside the scope of business involving the goods certified, the later-filed certification mark was granted registration.

JQA



The image on the left is the earlier-registered trademark for use on consultancy and advisory pertaining to the International Organization for Standardization (ISO). Subsequently, the trademark owner filed for registration of the image on the right to certify that another person's quality management system, food safety management system, safety management system, environment management system, occupational safety and health management system, or information safety management system meets ISO standards. The former trademark is designated for use on consultancy and advisory services, differing from the services to be certified by the latter trademark in terms of business. Hence, the later-filed certification mark was granted registration.



The image on the left is the earlier-registered certification mark, used to certify that the automotive repair parts manufactured and marketed by another person conform to the standards stipulated by the Certified Automotive Parts Association (CAPA). Subsequently, the image on the right was used to register a trademark designated for use on quality control of after-sales automotive body parts, i.e. stipulating quality assurance standards for car collision repair parts, and providing quality appraisal and inspection and testing report services for such goods. The quality appraisal and inspection and testing services designated for use by the latter trademark are not the car parts to be certified by the certification mark. Hence, the later-filed trademark was granted registration.



The image on the left is the earlier-registered certification mark, used to certify that the quality of moving services provided by another person conforms to the standards stipulated by the foundation. Subsequently, the image on the right was filed for registration as a trademark designated for use on real estate purchase and sale information, real estate rental information, advisory and consultancy relating to real estate purchase and sale, inspection and testing of a mover's service quality, consultancy relating to legal disputes over real estate purchase, sale and rental, and consultancy relating to community legal issues. The nature of the services designated for use by the latter trademark differs from that of the moving services to be certified by the certification mark. Hence, the later-filed trademark was granted registration.

2.2.3 Regulations governing use

The regulations governing the use of a certification mark are the basis for

controlling the use of the mark; therefore, an application for registration of a certification mark must include the regulations governing the use of the mark (Paragraph 1 of Article 82 of the Trademark Act), and specify the matters required therefor (Paragraph 4 of Article 82 of the Trademark Act). To make the relevant provisions relating to the use of a certification mark easily accessible and understood by any interested parties (such as potential users) as well as consumers, the regulations governing use must be published in the Trademark Gazette when the certification mark is registered (Paragraph 5 of Article 82 of the Trademark Act). If the regulations governing use are in a foreign language, a Chinese translation thereof or an abridged translation of the matters that should be set forth in such regulations must be provided; such Chinese translation or abridged translation will also be published in the Trademark Gazette. The applicant may amend the regulations governing use in the filing process, but the amendment may not broaden the scope of the goods or services certified by the mark.

The regulations governing use submitted by the applicant shall, in principle, undergo formality examination only with respect to the matters set forth therein. If any question arises during examination, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services. Particularly if the regulations governing use involve different areas of expertise, the characteristics to be certified by the mark and the conditions of certification shall undergo formality examination to ensure consistency. If the applicant does not submit with its application the regulations governing the use of the mark, or if there is deficiency or ambiguity in the submitted regulations, the applicant shall be given notice to amend such noncompliance; however, if such noncompliance is not amended within the specified period, or if, even after the amendment is made, the submitted regulations governing the use of the mark are still found not to meet the requirements therefor, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

The regulations governing the use of a general certification mark shall specify the characteristics to be certified, the conditions of use, the methods of managing and supervising use, the procedural matters for applications to use the mark, and the methods of resolving disputes (Paragraph 4 of Article 82 of the Trademark Act). Other matters that are related to the use of the mark may also be set forth in the regulations governing use. Matters that should be set forth in the regulations governing use are discussed below:

2.2.3.1 Characteristics to be certified

The characteristics to be certified are the core of a certification mark. An

application to register a certification mark must clearly state the certified goods or services, the characteristics to be certified, and the regulations governing compliance of those goods or services. The certified goods or services can be a generic name denoting their type, such as "foods," "electronic products," "textiles," "repair and maintenance of machines and equipment," "sightseeing tour and travel services," and the like. If one seeks to certify specific goods or services, they should be specified, such as "flat displays" or "bicycles." As for the characteristics to be certified by the mark and the regulations the goods or services must comply with, one may either specify the characteristics and the name of the relevant regulations, or simply state that they are "in compliance with the conditions prescribed by the proprietor of the certification mark."

Furthermore, a certification mark is a sign used to differentiate goods or services that have been certified from those that are not. Regarding the goods or services to be certified by such a mark, in order to help people ascertain the scope of the goods or services where the certification mark may be used, Article 19-5 of the Trademark Act and Articles 19-1 and 19-2 of the Enforcement Rules of the Trademark Act shall be applicable *mutatis mutandis*: the applicant shall designate the class(es) of goods or services according to the order of the Classification of Goods and Services, and shall specifically list the goods or services; and the trademark registrar office shall publish the Classification of Goods and Services according to the headings of classes under the International Classification of Goods and Services published by the World Intellectual Property Organization (Article 19 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act). The specification of goods and services shall be provided as an exhibit to the regulations governing the use of a mark to facilitate promulgation.

In addition to listing the goods or services to be certified in general classification terms when stating the characteristics to be certified, the applicant should refer to the Classification and Cross Reference Index for Goods and Services published by the Taiwan Intellectual Property Office to specifically designate the goods or services to be certified by the mark, without exceeding the scope of the goods or services previously set forth when stating the characteristics to be certified. The following is an example of a statement of the characteristics to be certified by a certification mark: "This certification mark is to be used by a person authorized by the proprietor thereof; the mark certifies that the agricultural produce provided by the person meets the standards and conditions stipulated by the proprietor of the certification mark." Under these circumstances, the applicant should simultaneously specify the following goods to be certified by the mark in the format of a table in the regulations governing the use of the mark: "Class 30: tea leaves; rice; processed grain"; and "Class 31:

fresh fruits; fresh vegetables; plants; flowers; unprocessed grain." To add or amend any goods or services in the regulations governing the use of a mark during the application process or after registration, one shall apply for amendment or register any changes, without exceeding the scope of "agricultural produce" set forth when stating the characteristics to be certified (see Section 2.3.1 of the Guidelines for reference).

Regarding the goods or services to be certified by a certification mark, if the specification of goods or services set forth according to the foregoing rules exceeds the scope that may be covered by the characteristics to be certified, or if the specification has too extensive a range of meanings, the applicant shall be notified to correct or supplement the application; however, if the noncompliance is not amended within the specified period, or if the correction or supplement fails to conform to the regulations after examination, thereby preventing the scope of the goods or services to be certified by the certification mark from being ascertained, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).



●

The characteristics to be certified: This mark is to be used by a person authorized by the proprietor thereof to certify that the hotel or homestay offered by such person conforms to the standards provided in the Implementation Plan for Age-Friendly Homestay Appraisal as stipulated by the Hualien County Health Bureau. The applicant shall specify the services to be certified, namely "Class 43: hotels; homestays," in the format of a table appended to the regulations governing the use of the mark.



●

The characteristics to be certified: This mark is to be used by a person authorized by the proprietor thereof to certify that the tires for passenger

vehicles manufactured or imported by such person conforms to the regulations governing the use of the mark "fuel-efficient tire" and the conditions provided in the relevant regulations in the Main Points of Operation for Promoting the Use of Fuel-Efficient Tire Mark. The applicant shall specify the characteristics to be certified, namely "Class 12: car tires; bicycle tires; ...," in the format of a table appended to the regulations governing the use of the mark.

2.2.3.2 Conditions of use

The conditions of the use of a certification mark means the conditions under which the proprietor consents to a third party's use of the mark on certain goods or services, such as standards relating to materials, mode of manufacture, method of production, quality, or other characteristics.

The conditions of use must be clear and precise enough to enable anyone to ascertain from the regulations governing the use of the mark what conditions they must fulfill to use the mark. If the content of the standards relating to the materials, mode of manufacture, method of production, quality, or other characteristics is particularly complicated, it may be provided as an attachment to the application. The applicant may either establish its own standards relating to the conditions of use, or use standards established by another party. For instance, use of the certification mark of product carbon footprint reduction label owned by the Environment Protection Administration (EPA) of the Executive Yuan should follow the conditions of use stipulated in the Main Points for Promoting the Management of Product Carbon Footprint as provided by the EPA. An example of using standards established by another party is the Environmentally Biodegradable Polymer Association's "compostability certification" mark, which is used to certify that plastic materials and their products are compostable plastics in compliance with the national standards CNS 14661.

If the proprietor has provided regulations to govern the manner in which the certification mark may be used, such as the place where the mark should appear on goods or packaging, and the size of the mark, they should be stated under this heading. In addition, if any fee is charged for a request to use or for using the certification mark, it should also be stated under this heading.

2.2.3.3 Methods of managing and supervising use

The methods of managing and supervising the use of a certification mark refer to the concrete methods the proprietor uses to manage and supervise the use of its certification mark as well as the rules regarding the relevant

procedures, such as procedures for implementing supervision and periodical or non-periodical testing or inspection, prescribed period for improvement and penalties in case of non-compliance, and penalties based on the seriousness of the violation of the regulations governing use.

Where use of the certification mark is concerned, if there are standards established for testing or inspection of goods or services, the testing or inspection methods must be stated. If the applicant does not undertake the testing or inspection itself, it may commission a competent juridical person or group to undertake the task on its behalf. The commissioned juridical person or group may also be authorized to give consent to the use of the certification mark in the proprietor's name if the tested or inspected goods or services are found to comply with the conditions prescribed in the regulations governing use. However, even though the proprietor does not undertake the testing or inspection or the certification task itself, it should still exercise control over the use of the mark to ensure compliance with the regulations governing use. Therefore, the proprietor must exercise supervision or control over the commissioned tester/inspector or certifier and, in addition to specifying the name of the commissioned tester/inspector or certifier, provide an explanation under this heading of how it will supervise and exercise control over the commissioned party. Take the "CAS Excellent Taiwan Agricultural Product Certification Mark" for an example. The mark is used to certify the safety and excellence of agricultural products and processed agricultural products. It is owned by the Council of Agriculture of the Executive Yuan, which approved and commissioned Taiwan Accreditation Foundation (TAF) to conduct accreditations. The TAF accredited the Taiwan Excellent Agricultural Product Development Association, the National Animal Industry Foundation, and the Food Industry Research and Development Institute to serve as certification bodies for CAS marks. The "Energy-Efficient Mark" promoted by the Bureau of Energy, Ministry of Economic Affairs is used to certify that the device or new equipment or product that consumes energy is energy-efficient. The Industrial Technology Research Institute is commissioned to conduct such operations as use application, approval, issuance, and follow-up management pertaining to such mark.

2.2.3.4 Procedural matters for applications to use a certification mark and methods of resolving disputes over use

The regulations governing the use of a certification mark should set forth procedural matters relating to applications to use the mark, including filing procedures and required documents, such as certifications that need to be submitted by those required to submit proof of identity or qualification

documents, forms that need to be filled out by those required to do so, qualification documents or test samples from those required to pass certain testing standards, and agreement samples that both parties have agreed to use.

The regulations governing the use of a certification mark should also set forth how disputes over the use of a certification mark may be resolved. Such disputes may relate, for example, to a decision not to allow use, disagreement over failure of goods already circulating in the market to pass post-sale inspection, and any other dispute with the certification mark proprietor regarding use of the mark. Fairness and justice should be given top priority in the resolution of disputes. Therefore, a certification mark proprietor may adopt an initial internal procedure to resolve a dispute, but the final decision-maker should be a neutral third party such as a court, an arbitrator, or a mediation committee. If the certification mark proprietor's decision is an administrative disposition, the dispute concerned should be resolved in compliance with the relevant administrative remedy procedure.

2.2.4 Distinctiveness

Distinctiveness of a certification mark means the characteristic of the mark that enables it to indicate the certified goods or services and to distinguish them from non-certified goods or services. Therefore, determination of whether a certification mark is distinctive is based on the relationship between the mark and the goods or services certified by the mark. The provisions of Article 29 of the Trademark Act relating to distinctiveness of trademarks should apply when determining such issues as distinctiveness, acquired distinctiveness, and disclaimers, depending on the nature of the issue to be determined. The *Examination Guidelines on Distinctiveness of Trademarks* and the *Examination Guidelines on Disclaimers* should also apply *mutatis mutandis* in the examination of such issues.

A certification mark shall not be registered if it is devoid of distinctiveness because of consisting exclusively of a description of the goods or services to be certified, the generic mark or term, or other signs which are devoid of any distinctiveness (Paragraph 1 of Article 29 applicable *mutatis mutandis* to Article 94 of the Trademark Act). For example, "100% Cotton" is a common description of ingredient used by the textile industry. The use thereof as a certification mark to certify the material is incapable of indicating the certified clothes, nor can it distinguish the certified clothes from non-certified clothes. Hence, "100% Cotton" is non-distinctive as a certification mark and should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

Where the geographical name contained in a general certification mark merely describes a geographical location, such as "Taiwan rice" and "Xizhou Township agricultural produce," the characteristic or quality of the goods to be certified cannot be attributed to such geographical region and is unrelated thereto—all it conveys is the geographical location related to the goods or services to be certified by the proprietor of the mark. With respect to such geographical name in the mark, to prevent a general certification mark proprietor from erroneously believing that it also has the right to preclude others from using the geographical name in its mark, a disclaimer shall be made therefor before the mark can be granted registration, because without a disclaimer the circumstances will give rise to doubts as to the scope of the rights in the certification mark (Paragraph 3 of Article 29 applicable *mutatis mutandis* to Article 94 of the Trademark Act). As for whether a description, generic mark/term or other signs which are devoid of any distinctiveness other than the name of a geographical origin contained in a general certification mark must be disclaimed, this should be determined in accordance with the *Examination Guidelines on Disclaimers*.

Examples of accepted marks:



This mark is registered and owned by the Xizhou (Hsichou) Township Office, Chungghwa County. The mark is used to certify that the agricultural produce from the authorized user of the mark is produced within the township, and that it conforms to the standards provided in the regulations of use of agricultural produce certification mark stipulated by the township office. The mark certifies that the user's agricultural produce conforms to the Standards for Pesticide Residue Limits in Foods promulgated by the Taiwan Food and Drug Administration (FDA); the term "agricultural produce" of a broad nature and lacks specificity that correlates with individual products and their respective geographical region and environment. Hence, the mark is a general certification mark. The terms "溪州農產" and "HSICHOU PRODUCE" in the mark shall be disclaimed as they may give rise to doubts as to the scope of the rights in the mark.



This mark is registered and owned by the Taiwan Towel Industry Association, and is used to certify that the towels produced or manufactured by the user of the mark are produced or manufactured completely in Taiwan and are in compliance with the requirements of the Regulations on the Use of the Certification Mark for MIT Towels. It certifies that towels displaying the mark meet certain quality standards; the mark is unrelated to the environment of a geographical region, so it is a general certification mark. The elements "MIT," "TAIWAN," "臺灣製" (made in Taiwan), and the "outline of Taiwan" in the mark shall be disclaimed as they may give rise to doubts as to the scope of the rights in the mark.

2.2.5 Other grounds for refusal of registration

For an application to register a certification mark, none of the grounds specified in Articles 30 and Paragraph 3 of Article 65 of the Trademark Act for refusal of registration should exist (Articles 30 and Paragraph 3 of Article 65 applicable *mutatis mutandis* to Article 94 of the Trademark Act). With respect to the determination of likelihood of confusion and protection of well-known marks, the *Examination Guidelines on Likelihood of Confusion* and the *Examination Guidelines for the Protection of Well-known Trademarks under Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act* will be applied. To illustrate the relevant principles applied when examining certification mark applications, the following explanation addresses the grounds for refusal of registration commonly seen in practice.

2.2.5.1 Likely to confuse and mislead the public as to the nature, quality, or place of origin of the goods or services being certified

If a certification mark contains a description of the nature or quality of the certified goods or services, the trademark registrar office should take into consideration the content of the certification and the conditions under which the certification mark is used. If such description is untruthful and may mislead consumers into believing that it is true and so affect their wish to make the purchase, the certification mark is likely to mislead the public as to the nature,

quality, or place of origin of the goods or services (Subparagraph 8 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and should be refused registration accordingly (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). For example, if a certification mark contains "100% honey," but according to the content of the certification and the conditions under which the certification mark is used, the certification mark can also be used on blended honey, then the certification mark is deemed likely to lead consumers to assume or believe mistakenly that the goods bearing it are of a higher quality. If deletion from the representation of that portion which causes a likelihood of mistaken belief by the public as to the nature or quality of goods or services would not constitute a substantial change of the mark, the trademark registrar office may require the applicant to delete that portion and allow registration of the mark after such deletion is made (Article 23 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

2.2.5.2 Likely to cause confusion among relevant consumers

If a later-filed certification mark is identical or similar to an earlier-registered or earlier-filed certification mark and is used to certify the same or similar goods or services, it may cause relevant consumers to assume mistakenly that the goods or services of the later-filed mark are certified by the earlier mark proprietor, or that the applicant of the later mark is an affiliate, licensee or franchisee of, or is otherwise associated with the earlier mark proprietor. In such a case, there exists a likelihood of confusion among relevant consumers (Subparagraph 10 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and, therefore, should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). Moreover, although a certification mark is not used to indicate the source of goods or services, it is employed by the users given consent to use the mark for marketing purposes and on the goods or packaging for the goods, on articles associated with the provision of services, or in connection with business papers or advertising related to the goods or services; it is used in a manner no different from a trademark. Therefore, if an applied-for certification mark is identical or similar to an earlier-registered or earlier-filed trademark or collective trademark, and the goods or services certified by the certification mark are identical or similar to those on which the earlier trademark or collective trademark is used, then the use of the certification mark on the goods or services is likely to cause relevant consumers to assume mistakenly that the goods or services certified by the certification mark and the earlier-registered or earlier-filed trademark or collective trademark proprietor's goods or services are from the same or a related source. In such a case, there exists a likelihood of confusion among relevant consumers (Subparagraph 10 of

Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and, therefore, should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

Example of marks causing a likelihood of confusion:



The image on the left is an earlier-registered trademark "USI and Device" for use on "styluses; computers"; the image on the right is a "USI CERTIFIED" certification mark subsequently filed for registration by another person to certify the following: "This mark is used by a person authorized by the proprietor thereof to certify that the digital electronic styluses, ..., and computer displays manufactured or marketed thereby conforms to the conditions set forth in the regulations governing the use of the mark." The trademark and the mark are graphically similar, and the scope of the goods or services to be certified by the mark is identical or similar to that designated for use by the trademark. Accordingly, the relevant consumers may wrongly believe that the goods to be certified by the mark and those goods designated for use by the earlier-registered trademark originate from the same source or from different but related sources. As this would cause a likelihood of confusion, the mark was refused registration.

In addition, a certification mark functions to identify and indicate certified goods or services and to distinguish them from non-certified goods or services. Therefore, where a certification mark is earlier filed or registered, if a later-filed trademark or collective trademark is identical or similar to the certification mark and is used on goods or services that are identical or similar to those certified by the certification mark, it may cause the relevant consumers to wrongly assume that such goods or services have been certified. Accordingly, this will cause a likelihood of confusion among the relevant consumers (Subparagraph 10 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and therefore it should be refused registration. Even if the later applicant claims that the designated goods or services are certified by the certification mark proprietor, there still exists a likelihood of confusion among the relevant consumers if they may be misled by the later-filed trademark or collective trademark into thinking that the applicant is an affiliate, licensee or

franchisee of, or is otherwise associated with the certification mark proprietor.

Example of marks causing a likelihood of confusion:



慈 心

The image on the left is registered as a certification mark by Tse-Xin Organic Agriculture Foundation to certify that the organic agricultural produce certified thereby conform to the *Tse-Xin Organic Certification Guidelines* provided by the foundation. Another person filed for registration of the image on the right as a trademark for use on "seeds; fruit seedlings; seeds for planting; plant seeds; seedlings." Both the certification mark and the applied-for trademark have the same identifying Chinese characters "慈心"; and the goods designated for use by the later-filed trademark are identical or similar to those certified by the certification mark. Accordingly, it may cause the relevant consumers to wrongly believe that the goods sold by the applicant of the later-filed trademark have been certified by the proprietor of the certification mark, or that the parties have a licensing, franchising, or any other similar relationship, thereby causing a likelihood of confusion among the relevant consumers. Hence, the application of the later-filed trademark was refused.

In the examination of whether the proviso of Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act shall apply, when one determines whether the circumstances are obviously improper in a given case, the relevant provisions in the Trademark Act shall apply *mutatis mutandis* and the principles of examining trademark registration applications shall govern according to the nature of the circumstances (Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act), with the objective facts or evidence present in the case taken into consideration. Where two certification marks, one filed earlier and the other later for registration, are identical or similar, and the goods or services certified thereby are also identical or similar, if the applicant of the later-filed mark submits documents of proof showing that the proprietor of the earlier-registered certification mark consents to the registration of the later-filed mark, the examination to determine whether the circumstances are obviously improper shall be conducted in accordance with

Subparagraph 1 of Paragraph 1 of Article 30 of the Enforcement Rules of the Trademark Act. Where two marks, one registered earlier than the other, differ in the type of the rights registered, it is noteworthy that the Trademark Act does not allow a certification mark to be used as a trademark, and that regulations governing the use of a mark are often used to manage and supervise the quality or characteristic of the goods or services certified by a collective trademark or certification mark. Therefore, to protect the interests of consumers in identifying whether certain goods have a certain characteristic, even under circumstances where a coexistence agreement is submitted, if the circumstances are such that no clear distinction between a certification mark and a trademark can be made, such circumstances shall be deemed to be obviously improper, and accordingly the later-filed mark shall be unregistrable (Subparagraph 3 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act).

Secondly, where the court grants an injunction prohibiting disposition of an earlier-registered trademark, collective trademark or certification mark, if any coexistence registration involving such mark is granted, it may cause a conflict of rights and interests between the future winning bidder and the party given consent in the matter of coexistence registration—such circumstances are also considered to be obviously improper (Subparagraph 2 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act).

Examples of obviously improper circumstances:



The image on the left is a certification mark registered by Japan's Ministry of Economy, Trade and Industry (METI) used to certify that the goods, services, and electromagnetic records as manufactured, marketed or provided by another person that are listed in the List of Goods and Services Certified by JIS Mark conform to the Japanese Industrial Standards (JIS) in size, quality, performance, and safety. The image on the right is a trademark registered by another person for use on corsets, corset underwear, girdles, pajamas, and bathrobes. The mark and the trademark are graphically similar, and the scope of the goods certified by the certification

mark covers textiles and fabrics, which have a relationship of similarity with the clothes designated for use by the applied-for trademark. Accordingly, the relevant consumers may wrongly believe that the proprietor of the earlier-registered certification mark has an affiliated, licensing, franchising, or any other similar relationship with the applicant of the later-filed trademark. Even if the latter submits a coexistence agreement, it may lead to unclear distinction between the use of the certification mark and of the trademark. As the circumstances are considered to be obviously improper (Subparagraph 3 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act), the trademark was refused registration.



The image on the left is an earlier-registered certification mark for certifying that the architectural design of the certified building conforms to the standards symbolized by "Fire Safety Building Mark." The image on the right is a certification mark filed for registration by another person using the same image for certifying that "the certified building conforms to the fire safety standards stipulated by the proprietor of the certification mark." As the services certified by the two marks are both related to architectural design, the later-filed mark may not be registered, pursuant to Subparagraph 10 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act. Since the two certify substantially the same characteristics, even if a coexistence agreement is submitted, the circumstances are obviously improper (Subparagraph 1 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act). As the application of the cited provision cannot be ruled out, the later-filed application was refused.

2.2.6 Miscellaneous matters

Different countries have different trademark regimes. In some countries, trademark laws do not specifically provide registration of certification marks, and so permit registration of trademarks for certification services. An applicant seeking to obtain registration of a trademark in Taiwan for the service of certification, by submitting to the trademark registrar office materials showing

registration of the mark in its home country, is required to amend the name of the service to the equivalent term "inspection or testing service" or another appropriate service name, since in Taiwan *certification* is not an accepted name for a service. An applicant seeking to obtain registration of a certification mark is required to possess the qualifications and the capability to certify as prescribed in Taiwan's Trademark Act, and to file with the application the required documents.

Example of an accepted mark:



The applicant applied to register the above logo as a trademark in connection with "certification services; inspection body services in the nature of quality control of goods; inspection services; quality control; environmental (environmental protection) certification services" under Class 42. The trademark as used on the services named is to identify the services provided by the applicant. Such use is different from the use of a certification mark by an accepted user on the certified goods or services. The applicant was therefore required to make amendments by providing explanation. According to the applicant's explanation, Korea's trademark law does not include provisions relating to certification marks, but accepts "certification services" as a service name. Because the applicant did not want to amend the application as a certification mark application, the trademark was granted registration after the services were amended to indicate "quality control; providing inspection and testing of goods for quality control and environmental management systems to access compliance with ISO standards, and providing guidance and consulting services relating to applications for ISO certification."

Where an applicant who has obtained registration of a collective trademark in another country seeks to register the mark as a certification mark in Taiwan, as a general rule every country requires that a collective trademark be used only by a member of the collective, but does not require that the use of a certification mark be restricted to members only. As they clearly differ in user requirement, the applicant must state that use of its collective trademark is not restricted to members. For example, where the applicant's country of origin does not require that a collective trademark be used by members only or allows a collective trademark to be used by non-members under license, or where the laws of the applicant's country of origin restrict the license of a collective trademark, but the

applicant has obtained the trademark authority's permission to license use of the collective trademark to non-members, the applicant may obtain registration of a certification mark by providing the relevant laws or documents as evidence, and stating in the regulations governing use that the application is for a certification mark.

2.3 Post registration matters

2.3.1 Amendment to the regulations governing use

The proprietor of a certification mark may amend the regulations governing use after the mark is accepted for registration, such as changing the quality standards the goods must meet, the manner in which the mark is used, and procedural matters relating to applications; however, the amendment may not broaden the scope of the goods or services certified by the mark. The regulations governing use may affect use of the mark by existing and potential users as well as consumers' interests in relying on the mark to recognize and identify goods or services of a certain quality or characteristic. Therefore, any amended regulations governing use must be examined by the trademark registrar office in the same way as those filed for a new application. Once accepted, the amended regulations governing use will be published in the Trademark Gazette (Paragraph 5 of Article 82 of the Trademark Act).

2.3.2 Use of a certification mark

"Use of a certification mark" means the use of such mark by any person who is allowed by the proprietor of such mark in accordance with the conditions prescribed in the regulations governing the use of such mark (Article 83 of the Trademark Act). In other words, it means a person who is allowed by the proprietor of such mark apply the mark in the course of trade to goods or packaging or containers thereof, to articles relating to the provision of services, to commercial documents or advertisements relating to goods or services, or to acts performed by digital audio-visual means, through electronic media, on the Internet, or through other media, where such mark is capable of being recognized by relevant consumers as a certification mark (Article 5 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The proprietor of a certification mark cannot itself use the mark on the goods or services certified by the mark, but may use the mark in advertising or promotion of the mark.

2.3.3 Certification mark transfer, license, and pledge

The right of a certification mark shall not be transferred or licensed after registration. However, if such transfer or license is unlikely to injure the interests of consumers or contravene fair competition and has been accepted by

the trademark registrar office, such right may be transferred or licensed (Article 92 of the Trademark Act). Where a certification mark transfer or license is concerned, the trademark registrar office should take into consideration the transferee's or the licensee's qualifications and capability to certify, and whether the transfer or license will be detrimental to the interests of consumers and contravene fair competition. The transferee or licensee should be required to make a declaration that it does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified. If the transfer of a certification mark necessitates corresponding amendment to the regulations governing use, such as the mark proprietor's name or address, an amended version of the regulations governing use must be submitted to the trademark registrar office when available. Moreover, if a mark contains the original mark proprietor's name, a transfer of such mark will result in a discrepancy between the mark and the mark proprietor's name. In such a case, the transfer will not be accepted. It would be more appropriate for the transferee to file a new application to register the mark.

Examples of accepted transfer applications:



This mark was originally owned by the Taiwan External Trade Development Council, which was commissioned by the Ministry of Economic Affairs to register the mark and act as the mark proprietor. The Council later filed a request to have the rights to the mark transferred to the Ministry of Economic Affairs. After examination, the trademark registrar office accepted the transfer on the grounds that the transferee, as a government entity, possesses the qualifications of a certification mark proprietor and the capability to certify, and is more credible and relatively just and impartial, and that the transfer thereof is not likely to damage the interests of consumers and contravene fair competition.



This mark was originally owned by the Taiwan Textile Federation. A request was later made to have the rights to the mark transferred to the MIT Underwear Innovation Alliance. After examination, the trademark registrar office accepted the transfer on the grounds that the transferee possesses the qualifications of a certification mark proprietor and the capability to certify, and that the transfer thereof is not likely to damage the interests of consumers and contravene fair competition.

Example of a refused licensing application:



This is the certification mark "美國威斯康辛州花旗蔘農業總會 Ginseng Board of Wisconsin Logo (in Color)" Reg. No. 01197468. The applicant sought to license the mark to the licensee "○○興業有限公司." The nature of the company is that of a general for-profit business. The "amended agreement of certification mark distributorship" and the import-export customs information for *Panax quinquefolius* submitted with the application were mutually executed by the proprietor of the certification mark and "○○興業有限公司," so they should be considered business agreements through which the company was designated to act as a distributor in Taiwan for certified *Panax quinquefolius* products. Such documents may be considered the agreement through which the proprietor of the certification mark consented to the use of the mark by the company. However, it is not in the nature of a license as provided in Article 39 of the Trademark Act, and it cannot be established that the licensee has certification, supervision and management capabilities. As the circumstances may be detrimental to consumer interests and violate fair

competition, the application was refused.

The right of a certification mark shall not be the subject of a pledge (Article 92 of the Trademark Act). The purpose of a pledge is to provide security for the payment of a debt; the creditor may sell the article pledged if the debt is not paid by the due date. Because certification mark proprietors are limited to parties with certain qualifications and capability to certify, and because to be effective, the transfer of the rights in a certification mark must be accepted by the trademark registrar office, it is inappropriate for the rights in a certification mark to be the subject of a pledge.

2.3.4 Opposition, invalidation, and revocation proceedings against certification marks

Any person may file an opposition to registration of a certification mark within three months from the day following the date of publication of registration on the grounds that such registration falls under Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65 (Article 48 applicable *mutatis mutandis* to Article 94 of the Trademark Act); an interested party may also file invalidation, or a trademark examiner may submit a proposal for invalidation, against the registration of a certification mark on the same grounds after the date of publication of registration (Article 57 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

A certification mark may be revoked under Article 93 of the Trademark Act, which sets forth the grounds to revoke a certification mark, as well as on the same grounds as those for the revocation of a trademark (Paragraphs 2 and 3 of Article 63 applicable *mutatis mutandis* to Article 94 of the Trademark Act). The grounds for revocation of a certification mark as set forth in Article 93 of the Trademark Act (Paragraph 1 of Article 93 of the Trademark Act) refer to the following:

1. The certification mark is used by the proprietor of such mark as a trademark: If a certification mark proprietor uses the certification mark as a trademark to identify its own goods or services, the function of the certification mark for indicating and distinguishing the goods or services certified will be weakened, thereby eliminating the basis for the rights associated with the mark. Therefore, such use should be prohibited.
2. The proprietor of the certification mark carries on a business of goods or services of the kind certified: There is a competitive relationship between the certification mark proprietor and businesses in the same trade. If the mark proprietor itself is in the business of the certified goods or services, it

may fail to be fair and objective, and questions may arise about the fairness with which the certification mark is controlled. Hence, such conflicting interests constitute grounds for revocation.

3. The proprietor of the certification mark is no longer competent to certify another person's goods or services to which the registration certification mark is designated: A certification mark proprietor who is no longer deemed competent to certify can hardly continue to certify goods or services of others to assess compliance with the conditions stipulated in the regulations governing use. Therefore, such circumstances constitute grounds for revocation.
4. The proprietor of the certification mark discriminates against those who apply for certification: A certification mark serves to guarantee the particular quality or characteristics of the goods or services that it certifies, and goods or services that have been certified by a certification mark are often more competitive than those that are not certified. If a certification mark proprietor discriminates against applicants, it will adversely impact fair competition in the marketplace. Therefore, this constitutes grounds for revocation.
5. The proprietor of such mark transfers, licenses, or establishes a pledge on the right of the mark which falls under Article 92 of the Trademark Act: If a certification mark is transferred, licensed, or pledged by the mark proprietor without the trademark registrar office's approval, such act will have no effect; as the proprietor's act is culpable, it constitutes grounds for revocation.
6. The proprietor of such mark does not manage or supervise the use of the mark pursuant to the regulations governing use: The preservation of a certification mark's function to certify depends completely on the mark proprietor's management and supervision over the use of the certification mark in accordance with the regulations governing use. A certification mark's function to certify would be harmed if the proprietor fails to fulfill this obligation. Therefore, it constitutes grounds for revocation.
7. The proprietor of such mark uses the mark improperly that is likely to cause damage to others or the public: This is a general regulation. In addition to the grounds specified above, a registration may be revoked if the mark is used in a manner that is improper and may therefore cause damage to others or to the public.
8. Although a certification mark proprietor may, upon approval by the

trademark registrar office, grant others a license to use the certification mark, it should still exercise reasonable care to see if the licensees exercise management and supervision in accordance with the regulations governing use and if they violate any provisions of the Trademark Act relating to the use of certification marks. The revocation shall also apply in the case where the proprietor of the registered certification mark who, knowingly or with reasonable grounds to know, shows no objection to the conduct as prescribed in the preceding paragraph by a licensee (Paragraph 2 of Article 93 of the Trademark Act).

3. Collective membership marks

3.1 Definition

A collective membership mark is a sign that serves to identify the membership of members in an association, society or any other group which is a juridical person and distinguish such members from non-members (Article 85 of the Trademark Act). Collective membership marks are not for use in connection with goods or services in commerce or in the course of trade. They are used to indicate membership in a particular group and make known to the public that users of the collective membership mark (i.e., a member of the group) are associated with the group.

Examples of accepted marks:



This mark is registered and owned by the Chinese Blood Donation Association, and is used to indicate membership in the Chinese Blood Donation Association.



This mark is registered and owned by the Bankers' Association of R.O.C.,

and is used to indicate membership in the Bankers Association of the Republic of China.

3.2 Examination of collective membership mark applications

An application for registration of a collective membership mark shall be made by filing an application containing (the name and address of) the applicant, a representation of the trademark, and a statement of the content indicated by the mark (Paragraph 1 of Article 19 applicable *mutatis mutandis* to Article 94 of the Trademark Act). The application should also include the regulations governing the use of the collective membership mark (Paragraph 1 of Article 86 of the Trademark Act). The statement of the content indicated by the mark may set forth the following: "This mark indicates membership in _____." For example, if the Taiwan Patent Attorneys Association files an application to register a collective membership mark, the statement of the content indicated by the mark may be "This mark indicates membership in the Taiwan Patent Attorneys Association." In addition to the aforesaid documents, an examination of the application as to the distinctiveness of the mark and other grounds for refusal of registration is also required (Articles 29 and 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act). Examination of procedural matters for trademarks shall be applicable *mutatis mutandis* to that for certification marks (see the *Examination Guidelines on Procedures for Trademark Registration Applications* for details). The following are examination guidelines on such special procedural matters as the definition of a collective membership mark, the applicant, and the regulations governing the use of a mark, and on the distinctiveness of the mark and other grounds for refusal of registration:

3.2.1 Whether the mark meets the definition of a collective membership mark

A collective membership mark is used to indicate membership in a group. If this is not the applicant's purpose, the applicant should amend the application to seek registration of another type of trademark. The application form for a collective membership mark differs significantly from that for other types of trademarks, so it is essential to submit the correct application form; presuming all requirements for filing date are met, the date on which the correct type of trademark application is filed will be taken to be the filing date of the application. The application shall be inadmissible if the applicant has been notified of a noncompliance but fails to amend such noncompliance within the specified period (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The applicant shall first confirm the type of rights sought during formality examination. Once the trademark registrar office has begun the process of substantive examination, one cannot apply to change the

type of mark.

3.2.2 Applicant's qualifications

The applicant must be an association, society or any other group that exists as a juridical person (Paragraph 1 of Article 85 of the Trademark Act). The Civil Associations Act provides that civil associations are divided into occupational associations, social associations, and political associations. A civil association established with the approval of a competent authority in accordance with the Civil Associations Act is not yet qualified as a juridical person; it must register with the competent district court as a juridical person pursuant to the law. Take a professional association in the nature of an occupational association and a political party in the nature of a political association for example. Currently there are no relevant laws and regulations applicable to professional associations; political parties are not granted the qualification of a juridical person under the Political Parties Act, so it must register to be a juridical person with the competent district court pursuant to the law. Therefore, the applicant must submit with its application a certificate of incorporation to prove that it has been registered with a competent district court. If the applicant is a farmers' association, fishermen's association, cooperative, association, or educational association that is incorporated pursuant to the Farmers Association Act, the Fishermen Association Act, the Cooperative Act, the Business Group Act, the Industrial Group Act, or the Educational Association Act, it came into existence as a juridical person when it was established under the law; therefore, submission of a certificate of registration is sufficient.

A collective membership mark is provided by a group for use by its members. Therefore, the applicant must be an association, society or any other group that is a collective entity of *persons*. A foundation is a collective entity of *property*. Although a company is a profit-seeking corporation, there is no need for a company's shareholders to use a collective membership mark to indicate their identity. A natural person has the capacity for rights, but a natural person by definition is not a group. Accordingly, foundations, companies, and natural persons are all ineligible to apply for registration of a collective membership mark.

A collective membership mark application shall be inadmissible if the applicant's qualifications are in question and the applicant has been notified to amend such noncompliance, but such noncompliance is not amended within the specified period, or even after the amendment, the applicant still does not meet the required qualifications (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

Examples of inadmissible cases:

- The applicant, a certain Foundation, is a collective entity of *property* that has no members. There is no need for it to use the proposed collective membership mark to indicate members' identity. Therefore, the application it filed was inadmissible according to the law.
- The applicant, a certain Public Health Bureau of a county government, is not a juridical person and has no members. Therefore, the application it filed was inadmissible according to the law.
- The applicant, a graduate school of a national university, is not a juridical person. Therefore, the application it filed was inadmissible according to the law.

3.2.3 Regulations governing use

The regulations governing the use of a collective membership mark are the basis for controlling the use of the mark. The applicant must submit with its application the regulations governing the use of the collective membership mark (Paragraph 1 of Article 86 of the Trademark Act), and state in detail in the regulations the matters that should be set forth therein. If the regulations governing the use of a collective membership mark are in a foreign language, a Chinese translation thereof or an abridged translation of the matters that should be set forth in such regulations must be provided. The regulations governing use submitted by the applicant shall, in principle, undergo formality examination with respect to the matters set forth therein. If amendments are found necessary or any question arises during examination, the trademark registrar office may issue a notice to the applicant to undertake the required amendments or submit an opinion. If the applicant does not submit with its application the regulations governing the use of the mark, or if there is deficiency or ambiguity in the submitted regulations, the applicant shall be given a notice to amend such noncompliance; however, if such noncompliance is not amended within the specified period, or if, even after the amendment is made, the submitted regulations governing the use of the mark are still found to be noncompliant, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

Collective membership marks are not for use in commerce, and so consumers' interests are rarely involved. For this reason, it is not necessary for the regulations governing the use of a collective membership mark to be published.

The regulations governing the use of a collective membership mark must set forth such matters as membership qualifications, the conditions of use, the methods of managing and supervising use, and provisions on handling violations (Paragraph 2 of Article 86 of the Trademark Act). Other matters that are related to use of the collective membership mark may also be set forth in the regulations governing use. These matters are discussed below:

3.2.3.1 Membership qualifications

To enable any potential user of a collective membership mark to know the conditions for joining the group, the regulations governing the use of the collective membership mark must set forth membership qualifications. For example, the place of residence or place of business, the business activities, or certain skills or abilities can be made a qualification or condition of membership. When examining a collective membership mark application, the trademark registrar office should be able to know from the articles of association submitted by the applicant the qualifications and conditions for becoming a member of the group.

3.2.3.2 Conditions of use

The user of a collective membership mark must possess the qualifications to be admitted as a member. The applicant may also add conditions for the use of a collective membership mark according to the group's nature, the purpose of its incorporation, and the applicant's purpose in seeking registration of the collective membership mark. In such a case, only members who comply with the added conditions may use the collective membership mark.

If the applicant has additional requirements for the use of the collective membership mark such as the conditions of use, the manner of use, and the time to use the mark, they should also be set forth in the regulations governing use. Examples include such manners of use as the place where the mark appears and the size of the mark, and such occasions to use the marks as the use of the mark on promotional materials, relevant documents and articles. In addition, if any fee is charged for joining the group to become a member, or for a request to use or for using the collective membership mark, such matters should also be stated under this heading.

3.2.3.3 Methods of managing and supervising use

It is members who come to the consensus about how a collective membership mark should be used and cause it to become a common rule to which all members must adhere. The regulations governing the use of a

collective membership mark must set forth the methods used to manage and supervise use of collective membership mark, which may include the procedural matters relating to the request for use of the collective membership mark, the required documents for a request for use of the mark, the management of the issuance and the supervision of the use of the mark.

3.2.3.4 Provisions on handling violations

To achieve the result of regulating the use of a collective membership mark by the members in accordance with the regulations governing use, the applicant should include in the regulations governing use how violations thereof will be handled. For example, if a member's use of a collective membership mark is found in violation of the regulations governing use or other legal provisions, the member may either be required to rectify the violation by a specified period or be suspended from use of the mark, or may be dropped from the membership roll, based on the seriousness of the violation.

3.2.4 Distinctiveness

A collective membership mark functions to indicate membership and distinguish members from non-members. Therefore, determination of distinctiveness of a collective membership mark must be made based on the relationship between the collective membership mark and the content indicated by the mark. The provisions of Article 29 of the Trademark Act relating to distinctiveness of trademarks may apply when determining such issues as distinctiveness, acquired distinctiveness, and disclaimers, depending on the nature of the issue to be determined. The *Examination Guidelines on Distinctiveness of Trademarks* and the *Examination Guidelines on Disclaimers* should also apply in the examination of such issues.

A collective membership mark consisting solely of a description relating to the content it identifies, a generic mark or name, or other non-distinctive signs is unregistrable for being non-distinctive (Paragraph 1 of Article 29 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and shall be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

Examples of marks refused registration:

台灣童子軍

● SCOUTS OF TAIWAN

Both "台灣童子軍" and "SCOUTS OF TAIWAN" mean boy scouts in Taiwan. As its use to indicate membership in the Scout Association of Taiwan is incapable of distinguishing members from non-members, it is non-distinctive. Hence, the mark was refused registration.

● 女青年會

The first impression conveyed by "女青年會" is merely that it describes its members to be young women. It is not sufficient for one to recognize it as a sign for indicating membership and for distinguishing one group from another. Being non-distinctive, the mark was refused registration.

3.2.5 Other grounds for refusal of registration

For an application to register a collective membership mark, none of the grounds specified in Articles 30 and Paragraph 3 of Article 65 of the Trademark Act for refusal of registration may exist (Article 30 and Paragraph 3 of Article 65 applicable *mutatis mutandis* to Article 94 of the Trademark Act). With respect to the determination of likelihood of confusion and protection of well-known marks, the *Examination Guidelines on Likelihood of Confusion* and the *Examination Guidelines for the Protection of Well-known Trademarks under Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act* shall apply. The following are the grounds for refusal of registration commonly seen in practice and explanation of the relevant principles applied.

3.2.5.1 Identical or similar to the mark of a government agency of Taiwan (R.O.C.) or an official exhibition held thereby, or the medal or certificate awarded thereby

A collective membership mark will be refused registration if it is unregistrable under Subparagraph 4 of Paragraph 1 of Article 30 of the Trademark Act on the ground that it is identical or similar to the mark of Taiwan's government agency or an exhibition it conducts, or a medal or certificate awarded thereby.

Example of a mark refused registration:



The image on the left is the mark of National Police Agency, Ministry of the Interior. The Volunteer Police Association of Taichung County applied to register the image on the right as a collective membership mark. This mark was refused registration on the ground that it is similar to the other mark and may cause confusion between the two.

3.2.5.2 Likely to cause confusion among relevant consumers

A collective membership mark is unregistrable and should be refused registration under Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act if it is identical or similar to a collective membership mark that is applied for or earlier registered by another person, and if the two groups are of the same or a similar nature, so that the public is likely to be confused about the membership indicated by the two marks. However, industrial, commercial, and occupational associations often require that members be based in a specific geographical area to be considered for membership, such as the industrial associations, commercial associations, and occupational associations of different counties or cities. If there is precedent where the same or a similar logo was used, the use of a collective membership mark containing that same or similar logo as a portion thereof will not be likely to cause confusion, as long as there are other elements that may be used to identify the entity applying for the mark. In such a case, the later-filed collective membership mark may be granted registration.

Example of marks causing no likelihood of confusion:



The mark on the left is used to indicate membership in the Taipei Certified Public Accountant Association, and the mark on the right is used to indicate membership in the Taiwan CPA Association of the Republic of China. Both marks contain a device consisting of a balance, a gear, and a wheatear; the overall designs of the two marks are very similar. After the National Federation of Certified Public Accountants Association of the R.O.C, the Taiwan CPA Association of the Republic of China, the Taipei Certified Public Accountant Association, and the Kaohsiung Certified Public Accountant Association were established, said device, which represents the just and flawless practice of accountants, was used by the four associations of accountants that locate in different areas of Taiwan, in combination with their respective Chinese and English names. As each of these two marks includes the name of the association using it, they should not cause a likelihood of confusion among the general public. Accordingly, the later-filed mark of the Taiwan CPA Association of the Republic of China was granted registration.

Examples of marks causing a likelihood of confusion:



The image on the left is a collective membership mark earlier registered by the Aisin Charity Association of the Republic of China; the image on the right is a collective membership mark later filed by another party. The latter mark is mainly a device of two hands holding a heart, with the Chinese characters "愛心" and "普門" disclaimed by the applicant. The two devices are very much similar, and both groups are charities. As it is likely that the public would confuse the membership indicated by the latter mark with the membership indicated by the former mark, the latter mark was refused registration.



Of the two images, the one on the left is a collective membership mark earlier-registered by the Red Cross Society of the Republic of China (Taiwan); the image on the right is a collective membership mark subsequently filed for registration by Chiayi Rescue Association. Both contain a device in which a "red cross" is placed within a plum blossom outline, which makes them highly similar, and both associations are charitable in nature. Accordingly, the public may wrongly believe that the membership indicated by the later-filed mark suggests a sponsorship, consent or any other similar relationship with the earlier-registered mark, thereby causing a likelihood of confusion. Hence, the later-filed mark was refused registration.

With respect to the determination of whether a collective membership mark is likely to be confused with another person's trademark, if an earlier-registered or earlier-filed trademark of another person and a later-filed or later-registered collective membership mark are identical or similar, and if the goods or services on which the trademark is used are similar to the mission of the group in nature, so that consumers may be misled into thinking that the group is associated with the proprietor of the registered trademark, then there is a likelihood of confusion between the marks among relevant consumers. A collective membership mark submitted for registration by a group of toy hobbyists may be an example. If the collective membership mark is identical or similar to a registered trademark that is designated for use on toys, the use thereof will cause relevant consumers to assume mistakenly that the group is supported or sponsored by, or is otherwise associated with the trademark proprietor. Moreover, it is possible for the member of an occupational, commercial, or industrial association to display, in the course of providing goods or services related to the group's mission, the collective membership mark on business cards, in the advertising, or on other articles related to the provision of services, to identify the member's association with the incorporated association. If such use of the collective membership mark is likely to cause consumers to assume mistakenly that the group is associated with the proprietor of a registered trademark or that the goods or services provided by a member of the group and the goods or services on which the registered trademark is used are from the same source or different but related

sources, then the use of the collective membership mark is also deemed likely to cause confusion among relevant consumers. For example, if an association of plastic products files an application to register a collective membership mark, which is identical or similar to a registered trademark that is designated for use on plastic goods, the use of the collective membership mark will lead relevant consumers to assume mistakenly that the association of plastic products is associated with the trademark proprietor, or that the plastic products provided by the member of the association and the goods bearing the earlier-registered trademark are from the same source or different but related sources. In such a case, there is a likelihood of confusion between the marks.

Examples of marks causing a likelihood of confusion:



The image on the left is an earlier-registered trademark. Subsequently, an association filed for registration of a certification mark using a similar image, namely the image on the right. Its mission statement is the promotion of the education of mental arithmetic, and its members are businesses or groups that carry on a business relating to the education of mental arithmetic, which is similar to the services of tutoring classes for which the earlier-registered trademark is designated. Accordingly, consumers are likely to be misled into thinking that the association is identical to the proprietor of the trademark, or that members of the association and the proprietor of the trademark are from the same source or from different but related sources, thereby causing a likelihood of confusion among consumers. Hence, the collective membership mark application was refused.

In addition, in the case where a collective membership mark is earlier filed or registered and a trademark is submitted for registration later, consumption of goods or services is not involved in such a situation because the collective membership mark is used to indicate membership. Hence, likelihood of confusion refers to the likelihood that consumers will be misled by the use of the trademark on the designated goods or services into thinking that the goods or services provided by the applicant of the later-filed trademark are accredited by the group, or that the applicant of the trademark is a sponsor for or licensee of, or is otherwise associated with the group. For example, a trademark submitted

for registration is identical or similar to a collective membership mark earlier registered by a fire apparatus manufacturers' association and is used on goods related to fire extinguishing apparatus. In such a case, consumers are likely to be misled into thinking that the goods bearing the applied-for trademark are accredited by the fire apparatus manufacturers' association, or that the applicant of the trademark is a sponsor for or licensee of, or is otherwise associated with the fire apparatus manufacturers' association, thereby causing a likelihood of confusion (Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act).

In practice, it is common for an incorporated association to have a certain logo, and it may also want to use a mark identical or similar to that logo to indicate membership in the association and the goods or services provided by members thereof. Currently, the Trademark Act does not include provisions banning such applications. In principle, an incorporated association may use an identical or similar device to separately register a collective membership mark and a trademark.

Examples of accepted marks:



The Taiwan Patent Attorneys Association sought to register the image as a collective trademark and a collective membership mark, with the former designated for use on periodicals, quarterly journals, gazettes, picture books, and printed publications. Both applications were granted registration.



The Fangliao Fishermen's Association of Pingtung first registered the image above as a collective membership mark to indicate membership in the association, and later sought to register the same image as a trademark for use on whitebait fish, fish balls, shredded fish jerky, fish jerky, and

preserved dried fish. The latter mark was also granted registration.

3.3 Post registration matters

3.3.1 Amendment to the regulations governing use

The proprietor of a collective membership mark may amend the regulations governing use after the mark is accepted for registration, such as changing the manner in which the mark may be used and the procedural matters for applications; however, the content indicated by the mark may not be amended. The proprietor must send a copy of the amended regulations governing use to the trademark registrar office.

3.3.2 Use of a collective membership mark

"Use of a collective membership mark" means the use of such mark by any member to identify his/her membership in a group in accordance with the conditions prescribed in the regulations governing the use of such mark (Article 87 of the Trademark Act). For a group to prevent its collective membership mark from being revoked for non-use, it must put the mark to use. For example, a collective membership mark may be used on membership badges, cards, or certificates for the members to wear or for their utilization, or may be used by the members to print name cards in accordance with the conditions of use prescribed in the regulations governing use, to identify their membership and to distinguish themselves from non-members.

3.3.3 Collective membership mark transfer, license, and pledge

The right of a collective membership mark shall not be transferred or licensed after registration. However, if such transfer or license is unlikely to injure the interests of consumers or contravene fair competition and has been accepted by the trademark registrar office, such right may be transferred or licensed (Article 92 of the Trademark Act). Where a collective membership mark transfer or license is concerned, the trademark registrar office should take into consideration the transferee's or the licensee's qualifications, and whether the transfer or license will be detrimental to the interests of consumers and contravene fair competition. Moreover, if a collective membership mark contains the original mark proprietor's name, a transfer of such mark will result in a discrepancy between the mark and the mark proprietor's name. In such a case, the transfer will not be accepted. It would be more appropriate for the transferee to file a new application to register the mark (see Section 4.3.3 of the Guidelines for details).

Example of an accepted transfer application:



The proprietor of this mark was originally the Taipei Bills Finance Association, which was later merged with the Bills Finance Association of the Republic of China. Pursuant to the law, the Bills Finance Association of the Republic of China, the surviving entity of the merger, succeeded to and acquired the rights associated with this mark. As the Bills Finance Association of the Republic of China is a national group for bills and finance businesses, its ownership of this mark would not be likely to damage the interests of consumers and contravene fair competition. Therefore, the trademark registrar office accepted the transfer.

Examples of refused transfer applications:



The collective membership mark displays the name of the proprietor thereof. If it is transferred to another incorporated association, there will be a discrepancy between the name of the association indicated thereby and the name of the mark's proprietor. Hence, the transfer application was refused.



An application was filed to transfer this collective membership mark to a

natural person. However, as provided in Article 85 of the Trademark Act, a collective membership mark is a sign that serves to identify the membership of members in an association, society or any other group which is a juridical person and distinguish such members from non-members. As the transferee of the applied-for transfer is a natural person rather than a collective membership mark proprietor with eligibility, the application failed to comply with the statutory format and therefore was inadmissible (Paragraph 1 of Article 17 of the Trademark Act).

The right of a collective membership mark shall not be the subject of a pledge (Article 92 of the Trademark Act). The purpose of a pledge is to provide security for the payment of a debt; the creditor may sell the article pledged if the debt is not paid by the due date. Because collective membership mark proprietors are limited to parties with certain qualifications, and because a collective membership mark indicates membership, the transfer of the rights in a collective membership mark is only effective if accepted by the trademark registrar office. Therefore, it is inappropriate for the rights in a collective membership mark to be the subject of a pledge.

3.3.4 Opposition, invalidation, and cancellation proceedings against collective membership marks

Any person may file an opposition to registration of a collective membership mark within three months from the day following the date of publication of registration on the grounds that such registration falls under Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65 (Article 48 applicable *mutatis mutandis* to Article 94 of the Trademark Act); an interested party may also file invalidation, or a trademark examiner may submit a proposal for invalidation, against the registration of a collective membership mark on the same grounds after the date of publication of registration (Article 57 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

A collective membership mark may be revoked under Article 93 of the Trademark Act, which sets forth the grounds to revoke a collective membership mark, as well as on the same grounds as those for the revocation of a trademark (Paragraph 2 and 3 of Articles 63 applicable *mutatis mutandis* to Article 94 of the Trademark Act). The grounds for revocation of a collective membership mark as set forth in Article 93 of the Trademark Act (Paragraph 1 of Article 93 of the Trademark Act) refer to the following:

1. The proprietor of such mark transfers, licenses, or establishes a pledge on the right of such mark which falls under Article 92 of the Trademark Act: If

a collective membership mark is transferred, licensed, or pledged by the mark proprietor without the trademark registrar office's approval, such act will have no effect; as the proprietor's post-registration act is culpable, it constitutes grounds for revocation.

2. The proprietor of such mark does not manage or supervise the use of the mark pursuant to the regulations governing use: The proprietor of a collective membership mark must manage and supervise the use of the collective membership mark to maintain and protect the common interests of its members to use the mark to indicate membership. The proprietor's failure to perform such obligation will constitute grounds for revocation of the registration of a collective membership mark.
3. The proprietor of such mark uses the mark improperly that is likely to cause damage to others or the public: This is a general regulation. In addition to the grounds specified above, a registration may be revoked if the collective membership mark is used in a manner that is improper and may therefore cause damage to others or to the public.
4. Although a collective membership mark proprietor may, upon approval by the trademark registrar office, grant others a license to use the collective membership mark, it should be noted that if the licensees of the mark commits any of the acts described above, and the mark proprietor knows of such acts or has reasonable grounds to know but does not make any objection thereto, this culpable failure by the collective membership mark proprietor will also constitute grounds for revocation (Paragraph 2 of Article 93 of the Trademark Act).

4. Collective trademarks

4.1 Definition

A collective trademark is a sign that serves to indicate goods or services of a member in an association, society or any other group which is a juridical person and distinguish goods or services of such member from those of non-members (Paragraph 1 of Article 88 of the Trademark Act). Therefore, a collective trademark is a sign provided for use by members of a group and is used to indicate that goods or services originate from a member of a particular group. The trademark registrar office may also set forth requirements relating to the quality, geographical origin, or other characteristics of the goods or services.

An incorporated association owns the rights to a collective trademark for the purpose of maintaining and protecting the common interests of its members. The proprietor of a collective trademark must manage and supervise the use of

the mark to prevent misuse by any individual member that may adversely affect the reputation of the mark. Although collective trademarks and trademarks are both used to indicate the commercial source of goods or services, a trademark indicates a single commercial source, whereas a collective trademark indicates multiple commercial sources. The proprietor of a collective trademark may carry on a business relating to the goods or services provided by members of the collective organization, and may also use the collective trademark in any advertising and promotional activities to promote the goods or services provided by the collective organization's members.

A collective trademark may be classified as either a general collective trademark or geographical collective trademark. The former serves to indicate that certain goods or services originate from a member in a particular group; the latter serves the same function plus the indication of the place of origin of such goods or services. Where a geographical collective trademark is concerned, the goods or services from that geographical region shall have a given quality, reputation or any other characteristics (Paragraph 2 of Article 88 of the Trademark Act). If the characteristic or quality of the goods designated for use by a collective trademark is purely the result of the exercise of supervision and control according to the production criteria established by the proprietor, rather than being related to the geographical environment in a region, the definition of a geographical collective trademark is not met. Even if the trademark contains a geographical name or indicates a geographical location relating to the place of origin of the designated goods or the place where the designated service is provided, it should be a general collective trademark rather than a geographical collective trademark (see Section 5.3 of the Guidelines for details).

Examples of accepted general collective trademarks:



This mark is designated for use on bicycles, parts and fittings of bicycles, electric bicycles, and parts and fittings of electric bicycles. It is registered and owned by A-Team Association, and is provided for use by its members on said goods.



- 美綠藤印加果

This mark is designated for use on sachu inchi oil, sachu inchi oil capsules, and sachu inchi oil enzyme capsules. It is registered and owned by the Limited Liability Chiayi County Sachu Inchi Agricultural Cooperative, and is provided for use by its members on said goods.

Examples of accepted general collective trademarks (with a geographical name):



- This mark is designated for use on charcoal, artificial charcoal, fuel, coke, recarburizers, and charcoal bricks. It is registered and owned by the Taiwan Ecological Material Industrial Development Association. The trademark contains the characters "臺灣" (Taiwan) and "炭" (coal), which merely describe the place of origin of the members' goods, and proof as to any connection between the geographical environment and the goods' quality, reputation or any other characteristic has not been provided. Therefore, it is a general collective trademark.



This mark is designated for use on fresh fruit, fresh vegetables, flowers, seedlings, and unprocessed rice, and it is registered and owned by the Taiwan Safe and High-Quality Agriculture Extension Association. The trademark contains the word "TAIWAN," which merely describes the place of origin of the members' goods, and proof as to any connection between the geographical environment and the goods' quality, reputation or any other characteristic has not been provided. Therefore, it is a general collective trademark.



This mark is designated for use on foot massage, massage, aromatherapy, and traditional folk therapy, and it is registered and owned by the Taichung Foot Reflex Therapist Labor Union. The trademark contains "台中市" and "Taichung," which merely describe the place where the members' services are provided, and proof as to any connection between the geographical environment and the services' quality, reputation or any other characteristic has not been provided. Therefore, it is a general collective trademark.

4.2 Examination of general collective trademark applications

An application to register a collective trademark shall be made by filing an application setting forth the applicant's name, a representation of the proposed mark, and the designated goods or services (Paragraph 1 of Article 19 applicable *mutatis mutandis* to Article 94 of the Trademark Act). In addition, the applicant must submit the regulations governing the use of its collective trademark (Paragraph 1 of Article 89 of the Trademarks Act); for the collective trademark to be granted registration, it must be distinctive and there should be no other grounds for refusal (Articles 29 and 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act). Examination of procedural matters for trademarks shall be applicable *mutatis mutandis* to that for general collective trademarks (see the *Examination Guidelines on Procedures for Trademark Registration Applications* for details). The following are examination guidelines on such special procedural matters as the definition of a general collective trademark, the

applicant, and the regulations governing the use of a mark, and on the distinctiveness of the mark and other grounds for refusal of registration:

4.2.1 Whether the mark meets the definition of a general collective trademark

A collective trademark is a sign that serves to indicate goods or services of a member in a group and distinguish goods or services of such member from those of non-members. Therefore, a sign does not belong to the category of collective trademarks if it is not provided for use by members or is not used on goods or services to indicate their commercial source.

If an applied-for collective trademark does not meet the definition of a general collective trademark, the trademark registrar office will consider whether it qualifies as any other type of trademark according to the facts of the particular case. However, the application form for a collective trademark differs significantly from that for other types of trademarks, so it is essential to submit the correct application form; presuming all requirements for filing date are met, the date on which the correct type of trademark application is filed will be taken to be the filing date of the application. If any noncompliance is not amended within the specified period, or if, even after the amendment is made, the mark still does not meet the definition of a geographical collective trademark after examination, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The applicant shall first confirm the type of rights sought during formality examination. Once the trademark registrar office has begun the process of substantive examination, one cannot apply to change the type of mark.

4.2.2 Applicant's qualifications and representativeness

The applicant of a collective trademark application must be an association, society or any other group which is a juridical person (Paragraph 1 of Article 88 of the Trademark Act). The Civil Associations Act provides that civil associations are divided into occupational associations, social associations, and political associations. A civil association established with the approval of a competent authority in accordance with the Civil Associations Act is not yet qualified as a juridical person; it must register with the competent district court as a juridical person pursuant to the law. Take, for example, a professional association in the nature of an occupational association and a political party in the nature of a political association. Currently there are no relevant laws and regulations applicable to professional associations; political parties are not granted the qualification of a juridical person under the Political Parties Act, so it must register to be a juridical person with the competent district court pursuant

to the law. Therefore, the applicant must submit with its application a certificate of incorporation to prove that it has been registered with a competent district court. If the applicant is a farmers' association, fishermen's association, cooperative, association, or educational association that is incorporated pursuant to the Farmers Association Act, the Fishermen Association Act, the Cooperative Act, the Business Group Act, the Industrial Group Act, or the Educational Association Act, it came into existence as a juridical person when it was established under the law; therefore, submission of a certificate of registration is sufficient.

A collective trademark is provided by an incorporated association for use by its members. Therefore, the applicant must be an association, society or any other group that is a collective entity of *persons*. A foundation is a collective entity of *property*. Although a company is a business corporation, it is itself a business entity, rather than an entity doing business in the name of each individual shareholder, and therefore there is no need for a company to use a collective trademark to indicate the goods or services provided by its members. A natural person has the capacity for rights, but a natural person by definition is not an association, a society or any other group. Accordingly, foundations, companies, and natural persons are all ineligible to apply for registration of a collective trademark.

Examples of inadmissible cases:

- A certain tourism association applied to register a collective trademark. Although this association is a juridical person, it is a collective entity of "property" that has no members. Given this, said association was not a qualified applicant and the application it filed was inadmissible.
- A certain cosmetics international limited company applied to register a collective trademark. It is a company which is itself a business entity, rather than an entity doing business in the name of each individual shareholder, and therefore there is no need for it to use a collective trademark to indicate the goods or services provided by its members. Given this, said company was not a qualified applicant and the application it filed was inadmissible.
- A certain production and marketing group applied to register a collective trademark. Because a production and marketing group has no legal personality, the application was inadmissible.

4.2.3 Regulations governing use

The regulations governing the use of a collective trademark are the basis for controlling the use of the mark. To make the relevant provisions relating to

the use of a collective trademark easily accessible and understood by any interested parties (such as potential users) as well as the public, the Trademark Act expressly provides that the applicant must submit with its application the regulations governing the use of the collective trademark (Paragraph 1 of Article 89 of the Trademark Act), matters that should be set forth in the regulations governing use (Paragraph 2 of Article 89 of the Trademark Act), and publication of the regulations governing use in the Trademark Gazette (Paragraph 4 of Article 89 of the Trademark Act). Therefore, when a collective trademark is registered, the regulations governing its use will be published in the Trademark Gazette. If the regulations governing the use of a collective trademark are in a foreign language, a Chinese translation thereof or an abridged translation of the matters that should be set forth in such regulations must be provided; such Chinese translation or abridged translation will also be published. The applicant may amend the regulations governing the use of a collective membership mark in the filing process, but the amendment may not broaden the scope of the goods or services on which the collective membership mark is designated to be used.

The regulations governing use submitted by the applicant shall, in principle, undergo formality examination with respect to the matters set forth therein. If any question arises during examination, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services. If the applicant does not submit with its application the regulations governing the use of the mark, or if there is deficiency or ambiguity in the submitted regulations, the applicant shall be given a notice to amend such noncompliance; however, if such noncompliance is not amended within the specified period, or if, even after the amendment is made, the submitted regulations governing use are still found not to meet the requirements therefor, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

The regulations governing the use of a collective trademark must set forth such matters as membership qualifications, the conditions of use, the methods of managing and supervising use, and the provisions on handling violations. Other matters that are related to the use of the collective trademark may also be set forth in the regulations governing use. These matters are discussed below:

4.2.3.1 Membership qualifications

To enable any potential user of a collective trademark to know the conditions for joining the group, the regulations governing the use of the collective trademark must set forth membership qualifications. For example, the place of residence or place of business, the business activities, or certain skills or

abilities can be made a qualification or condition of membership. When examining a collective trademark application, the trademark registrar office should be able to know from the articles of association submitted by the applicant the qualifications and conditions for becoming a member of the group.

4.2.3.2 Conditions of the use of a general collective trademark

The user of a collective trademark must possess the qualifications to be admitted as a member. It may be a condition for the use of a collective trademark that the user possesses the qualifications of a member of the group. In other words, all members of the group are eligible to use the collective trademark. Alternatively, the applicant may add conditions for the use of the collective trademark according to the group's nature, the purpose of its incorporation, and the applicant's purpose in seeking registration of the collective trademark. For example, the applicant may require that the members possess, in addition to the qualifications to be admitted as standard members of a general group, a specific qualification or a certain ability, or may require that the members' goods or services comply with certain requirements. The conditions must be clear and specific enough to enable anyone to ascertain from the regulations governing the use of the collective trademark what conditions they must fulfill to use the mark. If the content of the standards relating to the materials, mode of manufacture, method of production, quality, or other characteristics is particularly complicated, it may be provided as an attachment to the application.

If the proprietor has provided regulations to govern the manner in which the collective trademark may be used, such as the place where the mark should appear on goods or packaging, and the size of the mark, they should be stated under this heading. In addition, if any fee is charged for a request to use or for using the collective trademark, it should also be stated under this heading.

4.2.3.3 Methods of managing and supervising use

The methods of managing and supervising the use of the collective trademark refer to the concrete methods the proprietor uses to manage and supervise the use of its collective trademark as well as the rules regarding the relevant procedures, such as conducting inspection of the production environment, implementing periodic or non-periodic inspection and testing of semi-finished or finished products, or carrying out post-sale inspection of products already circulated in the market.

4.2.3.4 Provisions on handling violations

While a group and its members enjoy the right to use a collective trademark, they are also obliged to use the mark according to the regulations governing use. The regulations governing use must set forth how violations of the regulations will be handled. For example, if a collective trademark is used in violation of the regulations governing use or other legal provisions, the user may either be required to rectify the violation by a specified period or be suspended from use of the mark, or the user's membership may be revoked, based on the seriousness of the violation.

4.2.4 Distinctiveness

Distinctiveness of a collective trademark means the characteristic of the mark that enables it to indicate the goods or services provided by members and to distinguish them from those of non-members. Therefore, determination of whether a collective trademark is distinctive is based on the relationship between the collective trademark and the designated goods or services. The provisions of Article 29 of the Trademark Act relating to distinctiveness of trademarks may apply when determining such issues as distinctiveness, acquired distinctiveness, and disclaimers, depending on the nature of the issue to be determined. The *Examination Guidelines on Distinctiveness of Trademarks* and the *Examination Guidelines on Disclaimers* should also apply in the examination of such issues.

A general collective trademark is unregistrable for being devoid of distinctiveness (Paragraph 1 of Article 29 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act) if it consists exclusively of a description of the designated goods or services, a generic mark/term for the designated goods or services, or other signs which are devoid of any distinctiveness.

Examples of trademarks refused registration:



This mark is designated for use on pastries, Chinese moon cakes, pineapple cakes, and Chinese wedding cakes. The Chinese characters "護國庇民" constitute a blessing phrase, and the use thereof on the designated goods cannot identify the goods as goods from the applicant's members. Therefore,

the mark was refused registration.

● 貓狗119

This mark is designated for use on animal medical services. Dogs and cats are the most common pets that Taiwanese people keep at home, and "119" is the number to call for an ambulance when one needs emergency medical services. Therefore, the use of the mark on the designated services is describing that the services are providing emergency medical services to animals. Being non-distinctive, the mark was refused registration.

● 靈魂啟蒙師

This mark is designated for use on education and training services. The mark gives consumers the impression that it promotes someone with this title as an expert on "soul enlightenment" (靈魂啟蒙). The mark is descriptive of the designated services. Being non-distinctive, the mark was refused registration.

The geographical name contained in a general collective trademark merely carries an origin-indicating significance—it merely gives simple information about such geographical location as the place of origin of certain goods or the place where a certain service is provided. To prevent a general collective trademark proprietor from erroneously believing that it also has a right to preclude others from using the geographical name in its mark, where a general collective trademark contains a geographical name and it is likely to give rise to doubts as to the scope of the rights in the collective trademark, the applicant must file a disclaimer before the trademark can be registered (Paragraph 3 of Article 29 applicable *mutatis mutandis* to Article 94 of the Trademark Act). As for whether a description, generic mark/term or other signs which are devoid of any distinctiveness other than the name of a geographical origin contained in a general collective trademark must be disclaimed, this should be determined in accordance with the *Examination Guidelines on Disclaimers*.

Examples of accepted trademarks:



This trademark is used on goat meat and is registered and owned by the Goat Farmer Association, R.O.C. As the quality, reputation, or any other characteristic of goat meat produced in Taiwan is unrelated to the geographical environment of Taiwan, this trademark belongs to the category of general collective trademarks. The words "TAIWAN FRESH GOAT MEAT" in the trademark are non-distinctive and are actually portions that may give rise to doubts as to the scope of the rights in the mark; therefore, they have to be disclaimed.



This trademark is used on yarns and threads for textile use and on fabrics, and is registered and owned by the TVS TEXTILVERBAND SCHWEIZ. As the quality, reputation, or any other characteristic of yarns and threads for textile use and fabrics produced in Switzerland is unrelated to the geographical environment of Switzerland, this mark belongs to the category of general collective trademarks. The words "SWISS COTTON" in the trademark are non-distinctive and are actually portions that may give rise to doubts as to the scope of the rights in the trademark; therefore, they have to be disclaimed.



This trademark is used on nutritional supplements made of *Taiwanofungus camphoratus* extracts, *Taiwanofungus camphoratus* tea, and fresh *Taiwanofungus camphoratus*, and is registered and owned by the *Antrodia Cinnamomea* Association of Taiwan Treasure. The marks "MIT" and

"outline of Taiwan" merely describe the place of origin of the goods. There is no connection between the characteristic or quality of the goods and the geographical environment in which the goods originate. Hence, the mark is a general collective trademark. The marks "MIT" and "outline of Taiwan" have to be disclaimed to prevent any doubts as to the scope of the rights in the trademark.

4.2.5 Other grounds for refusal of registration

For an application to register a collective trademark, none of the grounds specified in Articles 30 and 65-3 of the Trademark Act for refusal of registration should exist (Article 30 and Paragraph 3 of Article 65 applicable *mutatis mutandis* to Article 94 of the Trademark Act). With respect to the determination of likelihood of confusion and protection of well-known marks, the trademark registrar office will apply the *Examination Guidelines on Likelihood of Confusion* and the *Examination Guidelines for the Protection of Well-known Trademarks under Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act*. The following are the grounds for refusal of registration commonly seen in practice and explanation of the relevant principles applied.

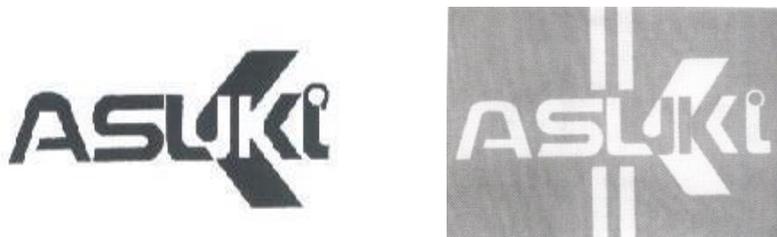
4.2.5.1 Likely to mislead the public as to the nature, quality, or place of origin of the goods or services

If a collective trademark contains a description of the nature or quality of the designated goods or services, but from the conditions under which the collective trademark is used such description is untruthful and may mislead consumers into believing that it is true and so affect their wish to make a purchase, the collective trademark is deemed likely to mislead the public as to the nature, quality, or place of origin of the goods or services (Subparagraph 8 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and should be refused registration accordingly (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). For example, in a case where the representation of a collective trademark contains the wording "100% longan honey," and the conditions under which the collective trademark is used states that the collective trademark can also be used on non-100% longan honey, it is deemed that such circumstances are likely to lead consumers to assume or believe mistakenly that the goods bearing the mark are of a particular nature. If deletion from the representation of that portion which causes a likelihood of mistaken belief by the public as to the nature or quality of goods or services would not constitute a substantial change of the mark, the trademark registrar office may require the applicant to delete that portion and allow registration of the mark after such deletion is made (Article 23 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

4.2.5.2 Likely to cause confusion among relevant consumers

If an applied-for collective trademark is identical or similar to an earlier-registered or earlier-filed trademark, collective trademark, or certification mark, and is designated for use on goods or services that are the same or similar to those designated for use by the latter mark, it may cause relevant consumers to assume mistakenly that the goods or services designated for use by the later-filed collective trademark and those designated for use by the earlier-registered or earlier-filed trademark or certification mark proprietor are from the same source or different but related sources; or it may cause consumers to assume mistakenly that the goods or services on which the later-filed collective trademark is used are those certified by of the senior certification mark proprietor; or that the applicant of the junior collective trademark and the proprietor of the senior certification mark have an affiliated, licensing, franchising, or any other similar relationship. In such a case, the applied-for collective trademark causes a likelihood of confusion among relevant consumers (Subparagraph 10 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and, therefore, should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). As for whether there is a likelihood of confusion, the *Examination Guidelines on Likelihood of Confusion* should apply when determining this issue.

Example of trademarks causing a likelihood of confusion:



The image on the left is a registered trademark designated for use on pistons, bearings, connecting rods, clutches, and cylinder liners. The image on the right is a collective trademark filed for registration by another party, designated for use on wholesale services for automobiles and retail and wholesale services for automobile parts and equipment. The two images are highly similar. The retail services designated for use by the latter mark cover the goods designated for use by the former. As there is a relationship of similarity between them, they cause the relevant consumers to mistakenly believe that the goods bearing the parties' trademarks originate from the same source or from different but related sources. Therefore, the applied-for trademark was refused registration.

In the examination of whether the proviso of Subparagraph 10 of Paragraph 1 of Article 30 of the Trademark Act shall apply, when one determines whether the circumstances are obviously improper in a given case, the relevant provisions in the Trademark Act shall apply *mutatis mutandis* and the principles of examining trademark registration applications shall govern according to the nature of the circumstances (Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act), with the objective facts or evidence present in the case taken into consideration (see Section 2.2.5.2 of the Guidelines for reference). For instance, where the regulations of use of a collective trademark have a particular rule regarding the quality or characteristic of the goods designated for use by the trademark, and where the proprietor of a collective trademark, designated for use on "tea leaves," agrees to the coexisting registration of an identical trademark, owned by another party, for use on such similar goods as "tea beverages," but does not require that such goods have the same quality or characteristic certified by the collective trademark, it may cause the relevant consumers to wrongly believe that such beverages originate from the same source as that of tea leaves bearing the collective trademark, thereby preventing the collective trademark from functioning as a sign for indicating a certain quality or characteristic of tea leaves. As this will have an impact on the interests of consumers, i.e. relying on the collective trademark to identify whether certain goods have a certain quality or characteristic, the aforesaid circumstances shall be deemed obviously improper (Subparagraph 3 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 48 of the Enforcement Rules of the Trademark Act).

4.3 Post registration matters

4.3.1 Amendment to the regulations governing use

The proprietor of a collective trademark may amend the regulations governing use after the mark is accepted for registration, such as changing the quality standards the goods must meet and the methods used to manage and supervise use of the collective trademark; however, the amendment may not broaden the scope of the designated goods or services. The regulations governing use have a bearing on use of the mark by existing and potential members of the group as well as consumers' interests in relying on the trademark to recognize and identify goods or services. Therefore, any amended regulations governing use must be examined by the trademark registrar office in the same way as those filed for a new application. Once accepted, the amended regulations governing use will be published in the Trademark Gazette (Paragraph 4 of Article 89 of the Trademark Act).

4.3.2 Use of a collective trademark

"Use of a collective trademark" means the use of such mark by the group or any of its members in accordance with the conditions prescribed in the regulations governing the use of such mark (Article 90 of the Trademark Act). In other words, it means a person who is allowed by the proprietor of such trademark apply the trademark in the course of trade to goods or packaging or containers thereof, to articles relating to the provision of services, to commercial documents or advertisements relating to goods or services, or to acts performed by digital audio-visual means, through electronic media, on the Internet, or through other media, where such trademark is capable of being recognized by relevant consumers as a collective trademark (Article 5 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The proprietor of a collective trademark may use the collective trademark in advertising or promotion of the mark in order to publicize the mark and the goods or services provided by members of the group. While the proprietor of a collective trademark may use the mark on designated goods or services, it should be noted that the function of a collective trademark is to indicate that goods or services bearing the trademark are provided by members of the group; the purpose of obtaining registration of a collective trademark is not for the group itself to use the mark but to let members of the group use it. Therefore, the use of a collective trademark shall essentially be by a member of the group that would enable one to distinguish between the goods or services provided by a member of the group and those provided by non-members.

4.3.3 Collective trademark transfer, license, and pledge

The right of a collective trademark shall not be transferred or licensed after registration. However, if such transfer or license is unlikely to injure the interests of consumers or contravene fair competition and has been accepted by the trademark registrar office, such right may be transferred or licensed (Article 92 of the Trademark Act). Where a collective trademark transfer or license is concerned, the trademark registrar office should take into consideration the transferee's or the licensee's qualifications and representativeness, and whether the transfer or license will be detrimental to the interests of consumers and contravene fair competition. If the transfer of a collective trademark necessitates corresponding amendment to the regulations governing use, such as the mark proprietor's name or address, an amended version of the regulations governing use must be submitted to the trademark registrar office when available. Moreover, if a collective trademark contains the original mark proprietor's name, an transfer of such mark will result in a discrepancy between the trademark and the trademark proprietor's name. In such a case, the transfer will not be accepted. It would be more appropriate for the transferee to file a new application to

register the trademark.

- Where A and B, the proprietors of two collective trademarks, merge into one legal entity, resulting in a situation where the surviving legal entity A has changed its name but its uniform tax number remains unchanged, the collective trademarks respectively registered shall be handled in the following manner:
 1. Where A's collective trademark does not contain the name of the proprietor A, the proprietor of the surviving A shall proceed to change the name of the proprietor of the collective trademark.
 2. Since B, the proprietor of its collective trademark, is dissolved after a merger or consolidation, Article 92 of the Trademark Act provides that, in order to register the transfer of B's collective trademark to the surviving A, one shall submit an application form, certification documentation approving the merger or consolidation, and an amended regulations of use for approval by the trademark registrar office before the transfer may be granted.
 3. Where the representation of a collective trademark contains the proprietor's name, it should be noted that the "trademark representation" may not be changed after registration (Article 38 applicable *mutatis mutandis* to Article 94 of the Trademark Act). If the transfer of the right of the collective trademark to the surviving legal entity causes inconsistency between the name of the source indicated by the collective trademark and the name of the proprietor, the application to transfer the registration of the collective trademark shall not be approved. To ensure correct indication of the source of the goods by the registration of the collective trademark, it would be more appropriate for the surviving legal entity after the merger or consolidation to separately file for registration.

The right of a collective trademark shall not be the subject of a pledge (Article 92 of the Trademark Act). The purpose of a pledge is to provide security for the payment of a debt; the creditor may sell the article pledged if the debt is not paid by the due date. Because collective trademark proprietors are limited to parties with certain qualifications and representativeness, and because to be effective, the transfer of the rights in a collective trademark must be accepted by the trademark registrar office, it is inappropriate for the rights in a collective trademark to be the subject of a pledge.

4.3.4 Opposition, invalidation, and cancellation proceedings against collective trademarks

Any person may file an opposition to the registration of a collective trademark within three months from the day following the date of publication of the registration on the grounds that such registration falls under Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65 of the Trademark Act (Article 48 applicable *mutatis mutandis* to Article 94 of the Trademark Act); an interested party may also file an invalidation, or a trademark examiner may submit a proposal for invalidation, against the registration of a collective trademark on the same grounds after the date of publication of the registration (Article 57 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

A collective trademark may be revoked under Article 93 of the Trademark Act, which sets forth the grounds to revoke a collective trademark, as well as on the same grounds as those for the revocation of a trademark (Paragraphs 1 and 2 of Article 63 applicable *mutatis mutandis* to Article 94 of the Trademark Act). The grounds for revocation of a collective trademark as set forth in Article 93 of the Trademark Act (Paragraph 1 of Article 93 of the Trademark Act) refer to the following:

1. The proprietor of such trademark transfers, licenses, or establishes a pledge on the right of such trademark which falls under Article 92 of the Trademark Act: If a collective trademark is transferred, licensed, or pledged by the mark proprietor without the trademark registrar office's approval, such act will have no effect; as the proprietor's post-registration act is culpable, it may constitute grounds for revocation.
2. The proprietor of such trademark does not manage or supervise the use pursuant to the regulations governing use: A collective trademark is to be mainly used by members of the collective organization. The proprietor of a collective trademark must manage and supervise the use of the collective trademark to maintain and protect the common interests of its members. Where the collective trademark is a geographical collective trademark, the proprietor's failure to exercise proper management and supervision resulting in a likelihood of damage to the reputation of that mark may lead to the revocation of its registration.
3. The proprietor of such trademark uses the trademark improperly that is likely to cause damage to others or the public: This is a general regulation. In addition to the grounds specified above, a registration may be revoked if the collective trademark is used in a manner that is improper and may

therefore cause damage to others or to the public.

4. Although a collective trademark proprietor may, upon approval by the trademark registrar office, grant others a license to use the collective trademark, it should still exercise reasonable care to see if the licensees exercise management and supervision in accordance with the regulations governing use and if they violate any provisions of the Trademark Act relating to the use of collective trademarks. If a licensee commits any of the acts described above, and the mark proprietor knows of such acts or has reasonable grounds to know but does not make any objection thereto, this culpable failure by the collective trademark proprietor will also constitute grounds for revocation (Paragraph 2 of Article 93 of the Trademark Act).

5. Geographical marks

5.1 Definition

As Taiwan is a member of the World Trade Organization (WTO), it shall comply with the provisions on protecting geographical indications as provided in the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Agreement. As a measure to strengthen the mechanism for protecting geographical indications, the Main Points of Operation for Applications to Register Geographical Certification Marks was promulgated in 2004 as the legal text applicable to applications to register geographical certification marks. Article 22 of the TRIPS Agreement provides that a geographical indication is one that identifies goods as originating in a certain region, and that a given quality, reputation or other characteristic of the goods is primarily attributable to the region's natural or human factors. To ensure compliance with such definition, the chapters on "geographical certification marks" and "geographical collective trademarks" have been separately provided in the Trademark Act to detail application requirements. On 25 July 2007, the *Examination Guidelines on Certification Marks, Collective Membership Marks and Collective Trademarks* (the "Guidelines") were stipulated and promulgated (simultaneously, the Main Points of Operation for Applications to Register Geographical Certification Marks were accordingly abolished).

The Guidelines use "geographical marks" to collectively refer to "geographical certification marks" and "geographical collective trademarks." To apply for registration of geographical marks, one shall submit an application that includes the name of the applicant, the representation of the mark, and the goods or services to be certified thereby (Paragraph 1 of Article 19 applicable *mutatis mutandis* to Article 94 of the Trademark Act) or the goods or services designated for use thereby. Examination of procedural matters for trademarks

shall be applicable *mutatis mutandis* to that for geographical marks (see the *Examination Guidelines on Procedures for Trademark Registration Applications* for details). The following are examination guidelines on such special procedural matters as the definition of a geographical certification mark and a geographical collective trademark, the applicant, and the regulations governing the use of a mark, and on the distinctiveness of the mark and other grounds for refusal of registration:

5.2 Examination of geographical certification mark applications

Where the certification mark serves to certify a place of origin, the goods or services from that geographical region shall have a given quality, reputation or other characteristic (Paragraph 2 of Article 80 of the Trademark Act). The meaning of "the goods or services from that geographical region shall have a given quality, reputation or other characteristic" is that such goods or services have a given characteristic due to the geographical environment; in other words, the quality, reputation or other characteristic of such goods or services is to a certain extent connected with the geographical environment. Such connection could be attributable to such natural conditions of the geographical environment such as the soil, climate, wind, water quality, elevation, and humidity, or such human factors as the manufacturing process, method of production, and manufacturing techniques that are traditional or unique to the place. If the characteristic or quality of the goods to be certified by a certification mark is unrelated to the geographical environment from which the goods originate but is simply the result of the exercise of supervision and control according to the production criteria established by the proprietor, the mark should be a general certification mark that certifies the quality, accuracy, material, mode of manufacture, or other matters of such goods or services (see Section 2.1 of the Guidelines for reference).

5.2.1 Whether the mark meets the definition of a geographical certification mark

A geographical certification mark certifies the place of origin of goods or services; such goods or services from the geographical region should possess a particular quality, reputation, or other characteristic. Therefore, such characteristic of the goods or services has to have a connection with the geographical environment (see Section 2.1 of the Guidelines for reference). If an applied-for certification mark contains the name of a place but does not meet the definition of a geographical certification mark, the trademark registrar office will consider whether it qualifies as an application for a general certification mark or any other type of trademark application according to the facts of the particular case. However, the application form for a certification mark differs

significantly from that for other types of trademarks, so it is essential to submit the correct application form; presuming all requirements for filing date are met, the date on which the correct type of trademark application is filed will be taken to be the filing date of the application. If any noncompliance is not amended within the specified period, or if, even after the amendment is made, the mark still does not meet the definition of a geographical certification mark after examination, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). Once an advance notice of disapproval has been issued after substantive examination, any application filed subsequently to change the applied-for mark to a general certification mark may only be granted if specific reasons are given.

Example of an accepted mark:



This mark is registered and owned by the Yuchih Township Office of Nantou County, and is used to certify that the Sun Moon Lake black tea produced or manufactured by the user of the mark originates in Yuchih Township in Nantou and meets the standards set forth in the Regulations Governing the Use of the "Sun Moon Lake Black Tea" Geographical Certification Mark of the Yuchih Township Office of Nantou County. The tea gardens in the region occupy hill slopes at altitudes of 421 to 1,000 meters, and are favored by a mild, subtropical monsoon climate, with moderately high relative humidity. Winters are generally dry, while summers are warm and rainy. Together with ample rainfall, warm climate, slightly acidic well-drained soil, the region's geographical characteristics all contribute to the unique fragrance and premium quality of Sun Moon Lake black teas.

5.2.2 Applicant

5.2.2.1 Applicant's qualifications and capability to certify

An applicant of a geographical certification mark must meet the required

qualifications and be competent to certify (Paragraph 1 of Article 81 of the Trademark Act; see also Section 2.2.2.1 of the Guidelines for reference). With respect to the capability to certify, because a geographical certification mainly serves to certify place of origin, it is generally more appropriate for a government agency to establish use standards for geographical certification marks and to exercise control over such use, since a government agency has the authority to control the use of the name of a place. If the application is filed by a person other than a government agency or a government-authorized juridical person or group, the applicant must state, and provide relevant evidence, that it has the capability to control the use of the place name.

The applicant of a geographical certification mark must not only have the capability to supervise and control the use of the mark, but also be capable of representing all relevant producers, manufacturers, and marketers within a defined scope of the geographical region concerned. The term "representativeness" means the state of being representative of those carried on a business of goods or services of the kind certified within a particular geographical region. Where the application is filed by a government agency or a government-authorized juridical person or group, the applicant can basically be presumed to be representative. But if the application is filed by a person other than a government agency or a government-authorized juridical person or group, then the determination of representativeness may be based on how long the applicant has been established, the extent to which the applicant is known in the region concerned, the percentage of businesses in the region the applicant is able to control, and how familiar the applicant is with the quality, characteristics, production, technical matters, and the producers/manufacturers of the products in the region. If there is any doubt about the representativeness of the applicant, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services (Paragraph 2 of Article 82 of the Trademark Act).

A place of origin may be a particular geographical region formed over time due to natural and human factors. Hence, the place of origin certified by a geographical certification trademark may cover more than one administrative area, the borders of which are artificial. In such a case, the application to register the name of that particular place should be filed jointly by the administrative agencies that have jurisdiction over the place. If one of the agencies is unwilling to file such application, it should authorize other agencies to do so, or the application may alternatively be filed by the higher-level agency to which the administrative agencies are subordinate. If within the same place of origin there are a number of juridical persons or groups, with each representing only a portion of the local businesses, the application may be filed jointly or, after

negotiation and agreement, by one or some of them.

Example of an accepted mark:



This mark is used to certify He Huan High Mountain oolong tea as originating in the He Huan Mountain area, which includes Renai Township in Nantou County, Fushi Village in Sioulin Township of Hualien County, and Lishan Village and Pingdeng Village in Heping District of Taichung City. It was after the Hualien County Government and the Taichung City Government gave their consent to the filing of the application to register this mark that the Nantou County Government filed the application. Having representativeness and the capability to supervise and control the use of the mark, the Nantou County Government is competent to certify.

Where the geographical certification mark being filed for registration is based on a foreign place of origin, if the foreign juridical person, group or government agency filing to register the mark has submitted documentation showing that such mark is protected in the country of origin under its name, the applicant may be considered competent to certify (Paragraph 3 of Article 82 of the Trademark Act).

Where an applicant's qualifications and capability to certify fail to comply with the requirements, the geographical certification mark application shall be inadmissible if the applicant, after being notified to amend such noncompliance, fails to make amendments within the specified period, or, even after the amendment is made, is still found to be unqualified, or is still found by the trademark registrar office to lack the capability to certify (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

5.2.2.2 Applicant shall not carry on a business of goods or services of the kind certified

To ensure that the applicant maintains impartiality and that the certification outcome is fair and objective, the applicant is prohibited from carrying on a

business of goods or services of the kind certified, and the applicant must submit with its application a declaration that the applicant does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified (see Section 2.2.2.2 of the Guidelines for reference).

The Trademark Act prohibits certification mark proprietors merely from carrying on a business of goods or services of the kind certified. They can still freely carry on any businesses other than those of goods or services of the kind certified. Therefore, a certification mark proprietor may own both a trademark and a certification mark and use them to indicate its own goods or services and to certify the goods or services of others, respectively. For example, a nonprofit group formed by producers of agricultural products in a geographical region may obtain registration of a geographical certification mark. In addition, for purposes of promoting the agricultural products in the region, it may also obtain registration of a trademark on the services of publishing books and magazines.

5.2.3 Regulations governing use

The regulations governing the use of a certification mark are the basis for controlling the use of such mark. The regulations governing use submitted by the applicant shall, in principle, undergo formality examination with respect to the matters set forth therein. If any question arises during examination, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services (see Section 2.2.3 of the Guidelines for reference).

The regulations governing the use of a geographical certification mark shall specify the characteristics to be certified, the conditions of use, the methods of managing and supervising use, the procedural matters for applications to use the certification mark and the methods of resolving disputes (Paragraph 4 of Article 82 of the Trademark Act). Other matters that are related to the use of the mark may also be set forth in the regulations governing use. Matters that should be set forth in the regulations governing use are discussed below:

5.2.3.1 Characteristics to be certified

The characteristics to be certified by a geographical certification mark should contain the goods or services certified, the place of origin to be certified by the mark, and the standards these goods or services meet. A geographical certification mark is used to certify the place of origin of the goods or services certified, and the quality, reputation, or other characteristics the certified goods or services possess must be related to the geographical environment of the region. The unique natural or human factors of a geographical region often make

the region suitable for developing certain goods or services. Therefore, a geographical certification mark, in principle, is used to certify only one type of goods, such as "tea leaves," "rice," "taro," or "misua noodles." However, in exceptional circumstances, given the unique natural or human factors of the geographical environment, a geographical certification mark may certify goods or services from such place of origin under a generic category, such as "aquatic products" (from the same territorial waters or aquatic ecosystem), provided that the type and name of such goods or services be specified (as detailed in Section 2.2.3.1 of the Guidelines). As for the regulations the goods or services must meet, they may be clearly specified or simply indicated by stating that said goods or services are "in compliance with the conditions prescribed by the proprietor of the certification mark."

Examples of accepted marks:



This mark is registered and owned by the Lugu Township Office of Nantou County. The content of the certification is: The tea leaves are certified as originating in Lugu Township of Nantou County and as complying with the standards set forth in the Lugu Township Office's Regulations Pertaining to the Use of the Certification Mark for Lugu DonDing Oolong Tea.



This mark is registered and owned by the Penghu County Government. The content of the certification is: The aquatic products are certified as originating in Penghu County and as meeting the requirements specified in

the Penghu County Government's Operational Regulations for Managing the Use of the Certification Mark for Penghu Seafood.

5.2.3.2 Conditions of use

An essential requirement to use a geographical certification mark is that the goods or services certified thereby have to originate from a specific place. In addition, the applicant must state under this heading the specific quality, reputation, or other characteristics the goods or services possess (Paragraph 2 of Article 80 of the Trademark Act) and how those characteristics are related to the geographical environment of the place. If the applicant has provided regulations to govern the manner in which the certification mark may be used, or if any fee is charged for a request to use or for using the certification mark, such matters should also be stated under this heading.

The conditions of the use of the certification mark must be clear and precise enough to enable anyone to ascertain from the regulations governing the use of the mark what conditions they must fulfill to use the mark. If the content of the standards relating to the materials, mode of manufacture, method of production, quality, or other characteristics is particularly complicated, it may be provided as an attachment to the application.

(1) Defined scope of region

The regulations governing use must specify the scope of the geographical origin certified by the geographical certification mark. If it matches an administrative division such as a county, city, or township, the applicant may use that administrative division to indicate the geographical origin certified. But if it is difficult to use an existing administrative division to define the scope of the geographical origin, the applicant may use a geographical name that suggests a specific geographical region.

Examples of accepted marks:



This mark certifies aquatic products as originating in Penghu County (a place consisting of 90 small islands and islets scattered in a sea area at 23 degrees 12 minutes to 23 degrees 47 minutes north latitude, and 119 degrees 19 minutes to 119 degrees 43 minutes east longitude). Penghu County is an existing administrative division.



This mark certifies tea leaves as originating in the Wenshan area, which includes Xindian, Pinglin, Shihding, Shenken, Xizhi and Pingxi in New Taipei City as well as Wenshan District and Nangang District in Taipei City. The Wenshan area is a geographical name that suggests a specific geographical region.

(2) The quality, reputation, or other characteristics the goods or services possess

The goods or services identified by a geographical certification mark must possess a particular quality, reputation or other characteristic. Quality means any physical characteristic that can be objectively identified, such as the degree of sweetness and weight of a fruit. Reputation means that the reputation the goods enjoy among consumers is linked to a geographical region; for example, if a place where certain goods originate immediately comes to a consumer's mind when the goods are mentioned, it denotes a certain reputational connection between the goods and the place of origin. As for other characteristics, they may include color, texture, and scent. Generally speaking, quality refers to the characteristics of goods or services that are liked, and reputation demonstrates the extent to which goods or services are known. However, such other characteristics as color, texture, and scent may not necessarily be appreciated by consumers; in fact, they may leave one with a neutral or even negative impression. Examples include the smell of blue cheese and stinky tofu.

To ensure that goods or services possess certain quality or characteristics, the applicant may require that the goods or services or their materials, mode of manufacture, or method of production meet a certain set of standards, such as rice taste value, residue standards and storage conditions for aquatic products, and the sensory quality and mode of manufacture of tea leaves. All the relevant standards must be specified.

If the applicant claims that the goods or services certified have a certain reputation, it must submit evidence showing that the geographical origin is well known for the goods or services certified, such as media reports from newspapers, magazines, or radio, records of prizes or awards won, or advertisements or promotional materials for the marketing of the goods or services. Discussions on the Internet may also be considered, but care must be taken to ensure their accuracy and objectivity.

Example of an accepted mark:



The required quality or characteristics for tea leaves are: ① being leaf buds picked from the tea plant *Camellia sinensis* and lightly fermented to make tea; ② lightly fermented tea: tea processed from selected fresh tea leaves that go through the withering and tossing processes indoors to cause oxidation and fermentation of "catechin," the main ingredient in tea leaves, by enzymes, resulting in the emission of a unique fragrance or flavor, and then go through such processes as blanching, rolling, drying, and refined baking; ③ features: possessing a delicate fragrance and rich aroma with a smooth and mellow flavor; appearance of dried leaves: tight and well-proportioned with a dark green color and oily appearance; liquor of brewed tea: clear and bright with a honey-green or honey-yellow color; fragrance: mildly sweet with a delicate aroma and smooth texture; wet leaf: remaining whole and with leaf and stem joint, green with luster, and surrounded by red borders; ④ safety: being within the safe tolerance limits announced by the Department of Health of the Executive Yuan; and ⑤ storage: tea leaves that are sought to be certified should be specifically distinguished and stored.

(3) How the characteristics are related to geographical environment

The relatedness of a specific quality, reputation, or other characteristic of certain goods or services to the geographical environment of a place includes the relatedness thereof to the natural or human factors of that place. For example, if the quality, reputation, or other characteristics of certain goods are essentially attributable to the natural conditions of that place such as the soil, climate, wind,

water quality, elevation, and humidity, or are related to such human factors as the manufacturing process, method of production, and manufacturing techniques that are traditional or unique to that place, they are related to the geographical origin.

Examples of accepted marks:



This mark is registered and owned by the Chiayi County Government. The quality, reputation, or other characteristics of Alishan high mountain tea from Chiayi County are related to the geographical environment of the place named in the mark. Such relatedness is due to the following: In the area around Alishan and Yushan mountains, exposure to sunlight is relatively brief most days, and the soil is ideal for growing tea. The climate and water quality are optimal as well. The area receives abundant sunlight in the morning from the east but becomes cloudy and misty in the afternoon, when the sunlight, reflected by water vapor, becomes soft and diffused. At this time the temperature drops, which slows the growth of the tea plants. The cell walls of the tea leaves become thicker. The buds are soft and the leaves are thick, plump, and rich in pectin. Farmers will carefully select the best stems with "one bud and two leaves" and pick the leaves by hand. The tea has a sweet taste and emits a rich aroma when brewed.



This mark is registered and owned by the Penghu County Government. The quality, reputation, and other characteristics of Penghu Siwei handmade misua noodles are related to the geographical environment of the place named in the mark. Such relatedness is due to the following: Siwei is a

village located at the northernmost part of Magong City in Penghu. Siwei is bounded by sea to the north and east, which provides the area with pleasant breezes. It receives scarce rainfall and abundant sunlight. The area's geographical features are very special. Moreover, the Penghu breezes are salty, adding a unique traditional flavor to the area's misua noodles. Siwei misua noodles were introduced to Penghu by a chef from China in the mid-to-late Qing Dynasty, and it has been nearly 150 years since then. Throughout the community, families can be seen stretching misua noodles and hanging them to dry under the sun. Exposed to sun and sea breezes, the misua noodles absorb the natural nutrients of the pristine air, which, combined with a century of sophisticated noodle-making skills, contribute to the unique process by which Siwei handmade misua noodles are produced.

(4) Manner of use and fees for use of a certification mark

If the proprietor has provided regulations to govern the manner in which the certification mark may be used, such as the place where the mark should appear on goods or packaging, and the size of the mark, they should be stated under this heading. In addition, if any fee is charged for a request to use or for using the certification mark, it should also be stated under this heading.

5.2.3.3 Methods of managing and supervising use

The methods of managing and supervising the use of a certification mark refer to the concrete methods the proprietor uses to manage and supervise the use of its certification mark as well as relevant rules regarding operating procedures, such as procedures for implementing supervision and periodical or non-periodical testing or inspection, prescribed period for improvement and penalties in case of non-compliance, and penalties based on the seriousness of violation of the regulations governing use.

Where testing or inspection of goods or services is required for use of a certification mark, the testing or inspection methods must be stated. If the applicant does not undertake the testing or inspection task itself, it may commission a competent juridical person or group to undertake the task on its behalf. The commissioned juridical person or group may also give consent to the use of the certification mark in the proprietor's name, if the tested or inspected goods or services are found to comply with the conditions prescribed in the regulations governing use. Under such circumstances, even though the proprietor does not undertake the testing or inspection or the certification task itself, it should still exercise control over the use of the mark to ensure compliance with the regulations governing use. Therefore, the proprietor must

exercise supervision or control over the commissioned tester/inspector or certifier and, in addition to specifying the name of the commissioned tester/inspector or certifier, provide an explanation of how it will supervise and control them under this heading.

5.2.3.4 Procedural matters for applications to use a certification mark and methods of resolving disputes over use

See Section 2.2.3.4 of the Guidelines for reference.

5.2.4 Distinctiveness

The distinctiveness of a geographical certification mark is the characteristic of the mark indicating the place from which the certified goods or services originate and distinguishing them from those that are not certified (Paragraph 1 of Article 80 of the Trademark Act). Therefore, a geographical certification mark must be distinctive enough to be used by general consumers to identify geographical origin as well as to distinguish goods or services that are certified by the mark as originating in the geographical region from those that are not certified as originating in the geographical region. The provisions of Article 29 of the Trademark Act relating to distinctiveness of trademarks should apply when determining such issues as distinctiveness, acquired distinctiveness, and disclaimers, depending on the nature of the issue to be determined. The *Examination Guidelines on Distinctiveness of Trademarks* and the *Examination Guidelines on Disclaimers* should also be applied in the examination of such issues.

The ability of a geographical certification mark to distinguish the goods or services that it certifies as originating in the geographical region from those that are not certified as originating in the geographical region is due to the fact that it certifies a geographical origin, a special feature of geographical certification marks. Therefore, the Trademark Act includes special provisions relating to the distinctiveness of geographical certification marks and disclaimer of the name of a geographical location (Paragraph 1 of Article 84 of the Trademark Act). In the examination of an application to register a trademark, if the trademark consists merely of words descriptive of the geographical origin of the goods or services, registration will often be refused on the ground that the trademark is non-distinctive. However, in the case of a geographical certification mark, because the geographical origin is a matter to be certified by the mark, registration should not be refused on the ground that the mark is non-distinctive as it consists merely of word(s) descriptive of the geographical origin of the goods or services. When the name of a geographical origin is used as a portion of a mark and the mark as a whole is distinctive, the trademark registrar office

should not require from the applicant a disclaimer of that portion on the ground that it describes the geographical origin of the goods or services and may give rise to doubts or questions about the scope of the rights in the mark. In this regard, Subparagraph 1 of Paragraph 1 and Paragraph 3 of Article 29 of the Trademark Act do not apply to the name of a geographical origin identified in a geographical certification mark. As for whether or not a description, generic mark/term or other signs which are devoid of any distinctiveness other than the name of a geographical origin, contained in a geographical certification mark must be disclaimed, it should still be determined in accordance with the *Examination Guidelines on Disclaimers*.

In some circumstances, it is customary for traders of agricultural products to use "the name of a geographical origin followed by the name of goods" to indicate the place from which the goods originate. For example, "雲林木瓜" ("Yunlin papaya") is used merely to indicate that the papaya originates in Yunlin. If an applicant obtains registration of a geographical certification mark that consists entirely of "the name of a geographical origin followed by the name of goods," there will be doubts or questions as to whether or not a claim of infringement may be made or whether it is reasonable use when an unauthorized person uses "the name of a geographical origin followed by the name of goods" as a certification mark. To differentiate certified goods from non-certified goods, the proprietor may stipulate in the regulations governing use the conditions of use of the mark, such as the place where the mark should appear, the style in which the mark is presented, and the color(s) of the packaging for the goods. To resolve the issue described above, it is advisable to include in the mark, at the filing of the application, a distinctive device or words in addition to "the name of a geographical origin followed by the name of goods," especially words that clearly indicate that the sign is a geographical certification mark. This may increase the distinctiveness of the mark and help safeguard the rights to the mark.

Examples of accepted marks:



In addition to "the name of a geographical origin (北埔) followed by the

name of goods (膨風茶)," this mark also includes a distinctive device and the text "臺灣·新竹·北埔鄉公所產地證明標章" and "Taiwan. Hsinchu. Beipu Township Office."



In addition to "the name of a geographical origin (日月潭) followed by the name of goods (紅茶)," this mark also includes a distinctive device.



In addition to "the name of a geographical origin (澎湖) and the name in English (PENGHU) followed by the name of goods (Seafood)," this mark also includes a distinctive device and the words "優鮮."

If for general consumers the name of a geographical origin carries the significance of a particular mode of manufacture, flavor, or way of cooking, then "the name of a geographical origin" or "the name of a geographical origin followed by the name of goods" used in the mark may become a descriptive or generic name other than the name of the place from which the good originates. For example, both "樓蘭磚" ("Loulan brick") and "紹興酒" ("Shaoxing rice wine") are already generic names; any application to register such a name as a geographical certification mark will not be accepted as they will be held to be non-distinctive. If any question arises as to whether the name of a geographical origin has become a descriptive or generic name for goods or services, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services.

Example of refusal:



● The applicant filed for registration of this mark, which consists of the Simplified Chinese characters "龍井茶" and their English translation "Longjing Tea," as a geographical certification mark to certify that the tea leaves bearing the mark originate from a certain region in Zhejiang Province, China. However, Taiwan's Ministry of Agriculture under the Executive Yuan—as the competent government authority with jurisdiction over the relevant industry of goods or services—was of the opinion that "龍井茶" is a generic name for tea leaves, that such tea is also grown in tea plantations in Sanxi and Xindian Districts in New Taipei City, and that accordingly it cannot serve as a sign to indicate the place of origin of the kind of tea leaves to be certified and enable people to distinguish between different geographical origins. Hence, the application was refused.

Example of an accepted mark with a disclaimer:



● The applicant filed for registration of this mark, which consists of the characters "普洱茶" and their English translation "PUER," as a geographical certification mark to certify that the quality of the tea leaves produced meets its standards. However, "普洱茶" is considered a generic name for tea leaves in Taiwan. Therefore, it cannot serve as a sign to indicate the place of origin of the kind of tea leaves to be certified and enable people to distinguish between different geographical origins. As the applicant subsequently disclaimed the use of "普洱茶" and "PUER," the mark was granted registration as a general certification mark.

5.2.5 Other grounds for refusal of registration

For an application to register a geographical certification mark, none of the grounds specified in Articles 30 and Paragraph 3 of Article 65 of the Trademark Act for refusal of registration should exist (see Section 2.2.5 of the Guidelines for reference). To illustrate the relevant principles applied when examining geographical certification mark applications, the following explanation addresses the grounds for refusal of registration commonly seen in practice.

5.2.5.1 Likely to mislead the public as to the nature, quality, or place of origin of the certified goods or services

A geographical certification mark is used to certify a geographical origin; therefore, it is rare for a geographical certification mark to be considered likely to mislead the public as to the origin of the goods or services certified. However, when a geographical certification mark contains a description of the nature or quality of the certified goods or services, but from the content of the certification and the conditions of use of the mark, such description is untruthful and may mislead consumers into believing that it is true and so affect their wish to make a purchase, the mark is deemed likely to mislead the public as to the nature, quality, or place of origin of the goods or services (Subparagraph 8 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and should be refused registration accordingly (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). If deletion from the representation of that portion which causes a likelihood of mistaken belief by the public as to the nature or quality of goods or services would not constitute a substantial change of the mark, the trademark registrar office may require the applicant to delete that portion and allow registration of the mark after such deletion is made (Article 23 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

5.2.5.2 Likely to cause confusion among relevant consumers

A geographical certification mark has an origin-indicating significance, and it usually contains the name of a place or a sign capable of indicating a particular geographical region. When determining whether a certification mark is similar to a trademark, they cannot be held to be similar merely because they contain the same name of a place or signs that suggest the same geographical place. Whether a certification mark is similar to a trademark must be determined by viewing the mark as a whole. This is no different from determination of similarity between trademarks. See Section 2.2.5.2 of the Guidelines for principles employed to determine likelihood of confusion among relevant consumers.

Example of marks causing a likelihood of confusion:



The image on the left is the geographical certification mark "關山米" for certifying that a user with permission to use the mark produces rice originating from Guanshan Township in Taitung County. An applicant filed for registration of the image on the right as a trademark for use on "rice; germ rice; glutinous rice; brown rice," which are similar to the rice goods certified by the geographical certification mark. Moreover, the striking dominant part in both marks contain the same geographical name "關山"; the reputation of Guanshan rice is also known to consumers. As there exists a likelihood of confusion among the relevant consumers, the trademark application was refused.

Examples of marks causing no likelihood of confusion:



The image on the left is a trademark earlier registered by the Alishan Township Farmers' Association of Chiayi County for use on tea leaves. The image on the right was registered later by the Chiayi County Government as a certification mark to certify tea leaves originating in the Alishan tea plantation region. Although both marks contain "阿里山" to indicate the place of origin, there are also different devices and words included in the marks. The degree of similarity between them is very low. They do not mislead relevant consumers into thinking that the goods on which the later-filed certification mark is used and the goods on which the earlier-registered trademark is used are from the same source or different but related sources. Hence, the certification mark was granted registration.



The image on the left is a certification mark registered by the Lugu Township Office of Nantou County and used to certify tea leaves as originating in Lugu Township of Nantou County. The trademark in the right image was registered later by the Lugu Township Farmers' Association of Nantou County and is used in connection with tea leaves and tea-based beverages. Although both marks contain "鹿谷" ("Lugu") and may indicate that Lugu is the place from which the goods originate, the marks are completely different in terms of composition of elements. Even if they are both used on tea leaves, consumers will not be confused into thinking that the goods bearing the trademark on the right are goods certified by the Lugu Township Office of Nantou County. Hence, the trademark was granted registration.

5.2.6 Miscellaneous matters

Where an applicant who has obtained registration of a collective trademark in another country seeks to register the mark as a certification mark in Taiwan, as a general rule every country requires that a collective trademark be used only by a member of the collective, but does not require that the use of a certification mark be restricted to members only. As they clearly differ in user requirement, the applicant must state that use of its collective trademark is not restricted to members. For example, where the applicant's country of origin does not require that a collective trademark be used by members only or allows a collective trademark to be used by non-members under license, or where the laws of the applicant's country of origin restrict the license of a collective trademark, but the applicant has obtained the trademark authority's permission to license use of the collective trademark to non-members, the applicant may obtain registration of a certification mark by providing the relevant laws or documents as evidence, and stating in the regulations governing use that the application is for a certification mark.

5.3 Examination of geographical collective trademark applications

A geographical collective trademark indicates that certain goods or services originate from a member in a particular group, and that such goods or services originate from a certain place of origin. Where a geographical collective trademark is concerned, the goods or services from that geographical region shall have a given quality, reputation or other characteristic (Paragraph 2 of Article 80 of the Trademark Act). The meaning of "the goods or services from that geographical region shall have a given quality, reputation or other characteristic" is that such goods or services have a given characteristic due to geographical environment; in other words, the quality, reputation or other characteristic of such goods or services is to a certain extent connected with the geographical environment. Such connection could be attributable to such natural conditions of that place such as the soil, climate, wind, water quality, elevation, and humidity, or are related to such human factors as the manufacturing process, method of production, and manufacturing techniques that are traditional or unique to that place. Suppose the representation of a collective trademark contains a geographical name, yet what the collective trademark certifies has nothing to do with the geographical environment but is purely the result of the exercise of supervision and control according to the production criteria established by the proprietor, it should be a general collective trademark (see Section 4.1 of the Guidelines for reference).

5.3.1 Whether the mark meets the definition of a geographical collective trademark

A geographical collective trademark indicates that the goods or services provided by a member originate from a certain place of origin; such goods or services from the geographical region should possess a particular quality, reputation, or other characteristic, and such characteristic of the goods or services has to have a connection with the geographical environment. If an applied-for collective trademark contains the name of a place but does not meet the definition of a geographical collective trademark, the trademark registrar office will consider whether it qualifies as an application for a general collective trademark or any other type of trademark application according to the facts of the particular case. Due to significant differences between the application form for other types of trademarks and that for a geographical collective trademark, it is essential to submit the correct application form; presuming all requirements for filing date are met, the date on which the correct type of trademark application is filed will be taken to be the filing date of the application. If any noncompliance is not amended within the specified period, or if, even after the amendment is made, the trademark still does not meet the definition of a geographical collective trademark after examination, the application shall be

inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). Once an advance notice of disapproval has been issued after substantive examination, any application filed subsequently to change the applied-for mark to a general collective trademark may only be granted if specific reasons are given.

5.3.2 Applicant's qualifications and representativeness

The function of a geographical collective trademark is to indicate that a member's goods come from a particular place, and the applicant thereof must have representativeness to file the application with respect to the name of that place (Paragraph 2 of Article 82 applicable *mutatis mutandis* to Article 91 of the Trademark Act). The term "representativeness" means the quality of being representative of those carrying on a business of the goods or services of the kind certified within a particular geographical region. Determination of an applicant's representativeness may be based on how long the applicant has been established, the extent to which the applicant is known in the region concerned, the percentage of businesses in the region the applicant is able to control, and how familiar the applicant is with the quality, characteristics, production, technical matters, and the producers/manufacturers of the products in the region. If there is any doubt about the representativeness of the applicant, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services (Paragraph 2 of Article 82 applicable *mutatis mutandis* to Article 91 of the Trademark Act).

A place of origin may be a particular geographical region formed over time due to natural and human factors. Hence, the place of origin of a geographical collective trademark may cover more than one administrative area, the borders of which are artificial. If within the same place of origin there are a number of incorporated associations, with each representing only a portion of the local businesses, the application may be filed by such juridical persons or groups jointly or, after negotiation and agreement, by one or some of them.

Where the geographical collective trademark being filed for registration is based on a foreign place of origin, if the foreign juridical person or group filing to register the trademark has submitted documentation showing that such trademark is protected in the country of origin under its name, the applicant may be deemed representative (Paragraph 3 of Article 82 applicable *mutatis mutandis* to Article 91 of the Trademark Act).

Where there is any doubt as to an applicant's qualifications and capability to certify, the application shall be inadmissible if the applicant, after being

notified to amend such noncompliance, fails to make amendment within the specified period, or, even after the amendment is made, is still found to be unqualified, or is still found to lack representativeness (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act).

Examples of inadmissible cases:

● 貢寮鮑

The applied-for geographical collective trademark "貢寮鮑" is designated for use on "abalone; ormer; instant packs of abalone." After consultation with the Ministry of Agriculture under the Executive Yuan, it was determined that the documentation for plans to organize the Gongliao Abalone and Ormer Festival submitted by the applicant was not sufficient for determination of representativeness. As such noncompliance was not amended, the application was inadmissible.



●

The applied-for geographical collective trademark "埔里大坪頂 Puli Dapingding and Device" is designated for use on "passion fruits" grown in Dapingding, Puli Township in Nantou County. The trademark registrar office consulted with the Ministry of Agriculture under the Executive Yuan, which stated that a number of local agricultural cooperatives and groups engage in the production and marketing of passion fruits, so the process of negotiation and delegation has to be undertaken for the applicant to obtain representativeness. As the issue of the applicant's representativeness remained unresolved, the application was amended to be for registration of a general collective trademark instead. With such procedural matters as the regulations of use amended, and with the terms "埔里大坪頂" and "Puli Dapingding" disclaimed, the amended application was granted.

5.3.3 Regulations governing use

The regulations governing use submitted by the applicant shall, in principle, undergo formality examination with respect to the matters set forth therein. If any question arises during examination, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services. If the applicant does not submit with its application the regulations governing the use of the mark, or if there is deficiency in the submitted regulations, the applicant shall be given a notice to amend such noncompliance; however, if such noncompliance is not amended within the specified period, or if, even after the amendment is made, the submitted regulations governing use are still found to be noncompliant, the application shall be inadmissible (Paragraph 1 of Article 8 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The regulations governing the use of a geographical collective trademark must set forth such matters as membership qualifications, the conditions of use, the methods of managing and supervising use, and the provisions on handling violations. Other matters that are related to the use of the collective trademark may also be set forth in the regulations governing use. These matters are discussed below:

5.3.3.1 Membership qualifications

A geographical collective trademark is indicative of a place of origin. Businesses within the geographical area of the place of origin should be eligible to join the group to obtain the opportunity to use the collective trademark if their goods or services comply with the conditions stipulated in the regulations governing use and they also possess the qualifications to be admitted as members. To safeguard businesses' rights and interests to have fair use of a geographical collective trademark, it shall be specified under this heading that any person from the corresponding geographical region whose goods or services and qualifications comply with the conditions contained in the regulations governing use may be allowed to become a member of the group by the proprietor of the geographical collective trademark (Paragraph 3 of Article 89 of the Trademark Act).

5.3.3.2 Conditions of use

To use a geographical collective trademark, it is required that the goods or services come from a specific place of origin. The applicant must state under this heading the given quality, reputation, or other characteristics the goods or services possess (Paragraph 2 of Article 88 of the Trademark Act) and how such characteristic is related to the geographical environment of the place. If the applicant has provided regulations to govern the manner in which the

geographical collective trademark may be used, or if any fee is charged for a request to use or for using the geographical collective trademark, such matters should also be stated under this heading.

(1) Defined scope of region

The regulations governing use must specify the geographical area of the place of origin indicated by the geographical collective trademark. If it matches an administrative division such as a county, city, or township, the applicant may use that administrative division to indicate that geographical origin. But if it is difficult to use an existing administrative division to define the geographical area of the place of origin, the applicant may use a geographical name that suggests a specific geographical region to indicate it.

Example of an accepted mark:



This geographical collective trademark certifies Wentan pomelos as originating in Madou District in Tainan City, an existing administrative division.

(2) The quality, reputation, or other characteristics the goods or services possess

The goods or services identified by a geographical collective trademark must possess a particular quality, reputation or other characteristic. Quality means any physical characteristic that can be objectively identified, such as the degree of sweetness and weight of a fruit. Reputation means that the reputation the goods enjoy among consumers is linked to a geographical region; for example, if a place where certain goods originate immediately comes to a consumer's mind when the goods are mentioned, it denotes a certain reputational connection between the goods and the place of origin. As for other characteristics, they may include color, texture, and scent. Generally speaking, quality refers to the characteristics of goods or services that are liked, and reputation demonstrates the extent to which goods or services are known. However, such other characteristics as color, texture, and scent may not

necessarily be appreciated by consumers; in fact, they may leave one with a neutral or even negative impression. Examples include the smell of blue cheese and stinky tofu.

To ensure that goods or services possess the required quality or characteristics, the applicant may require that the goods or services or their materials, mode of manufacture, or method of production meet a certain set of standards, such as rice taste value, residue standards and storage conditions for aquatic products, and the sensory quality and mode of manufacture of tea leaves. All the relevant standards must be specified.

If the applicant claims that the goods or services certified have a certain reputation, it must submit evidence showing that the geographical origin is well known for the goods or services certified, such as media reports from newspapers, magazines, or radio, records of prizes or awards won, or advertisements or promotional materials for the marketing of the goods or services. Discussions on the Internet may also be considered, but care must be taken to ensure their accuracy and objectivity.

Example of an accepted mark:



This geographical collective trademark is designated for use on high mountain teas grown in Lala Mountain, identifying tea leaves produced in tea plantations at an altitude of 1,000 meters or higher in Fuxing District in Taoyuan City. The quality and characteristic of high mountain teas in Lala Mountain are connected with the geographical environment, including such features of Fuxing District as high elevation, high latitude, cool climate, persistent fog all year round, day-night temperature difference at 10°C or higher, well-preserved vegetation type, and fertile, well-draining soil of a sandy and rocky nature, all of which are conducive to the cultivation and growth of tea plants. The tea leaves cultivated in this region do not give off an earthy smell; the teas made from them are briskly fragrant, taste sweet and rich, and present a strong aftertaste without a hint of bitterness. The tea leaves are fleshy and rich in pectin, the quality of the tea is sweet and soft, and the fragrance is that of a unique mixture of flower and fruit.

(3) How the characteristics are related to geographical environment

The relatedness of a specific quality, reputation, or other characteristic of certain goods or services to the geographical environment of a place includes the relatedness thereof to the natural or human factors of that place. For example, if the quality, reputation, or other characteristics of certain goods are essentially attributable to the natural conditions of that place such as the soil, climate, wind, water quality, elevation, and humidity, or are related to such human factors as the manufacturing process, method of production, and manufacturing techniques that are traditional or unique to that place, they are related to the geographical origin (see Section 2.3.3.2(3) of the Guidelines for reference).

Examples of accepted marks:



This mark is used on taro that originates in Dajia District in Taichung City. The quality, reputation, or other characteristics of the taro are related to the geographical environment of Dajia, and such relatedness is due to the following: Taro is adapted to high temperature and humidity, and grows in temperature above 20°C during the growing season. Taro grows and yields well on soils or clay loams that are rich in organic matter and have a high water retention capacity, which maximize root growth and help the taro to grow healthy and produce better quality taro. Dajia area has a subtropical monsoon climate. The average annual temperature is 21°C, and the average annual rainfall is 1,600 mm. And the average humidity level is 80 percent. These features make Dajia an ideal place for growing taro. Also, the two pollution-free rivers, Dajia River and Daan River, irrigate and nourish the area, and bring down large quantities of alluvial soil that is solid and fertile. All these have made Dajia the best environment for taro to grow. Dajia taro needs a ten-month growing season before it is harvested for eating. It takes time for taro to grow to achieve the special aroma and be of the quality unique to Dajia taro.



This mark is used on beef, beefsteak, beef jerky, and shredded beef jerky that originate in Kinmen County. The quality, reputation, or other characteristics of the goods are related to the geographical environment of Kinmen, and such relatedness is due to the following: Kinmen County has a subtropical marine climate. It receives rainfall mostly in the period from April to September in the whole year, and the average annual rainfall is 1,049.4 mm. The natural conditions of Kinmen are ideal for growing sorghum, a drought-tolerant plant. Kaoliang liquor (sorghum wine) is the biggest product produced by Kinmen County. The liquor production process generates about 200 metric tons of Kaoliang lees, the residues of Kaoliang liquor, a day. The topography of Kinmen is particularly suitable for animal husbandry, and so the Kaoliang lees are used as forage for cows. The enzyme and other ingredients contained in wine lees can give special taste and aroma to beef. Beef fed by Kaoliang lees has more marbling and the meat is redder and has clearer marbling than similar beef cuts sold in the marketplace. Besides, such beef has lower pH levels (approximately 5.56 to 5.66).

(4) Manner of use and fees for use of a collective trademark

If the proprietor has provided regulations to govern the manner in which the collective trademark may be used, such as the place where the mark should appear on goods or packaging, and the size of the mark, they should be stated under this heading. In addition, if any fee is charged for a request to use or for using the collective trademark, it should also be stated under this heading.

5.3.3.3 Methods of managing and supervising use

See Section 4.2.3.3 of the Guidelines for reference.

5.3.3.4 Provisions on handling violations

See Section 4.2.3.4 of the Guidelines for reference.

5.3.4 Distinctiveness

The distinctiveness of a geographical collective trademark is the characteristic of the mark to indicate the place from which the goods or services

of the collective's members originate and to distinguish them from those of non-members. Therefore, the relevant consumers must be able to identify the place of origin when they see a geographical collective trademark and to distinguish the goods or services designated for use by the geographical collective trademark from those that are provided by non-members.

The ability of a geographical collective trademark to distinguish the goods or services that originate in the named geographical region from those that do not originate in that geographical region is due to the fact that a geographical collective trademark indicates a geographical origin, a special feature of geographical collective trademarks. Therefore, the Trademark Act includes special provisions relating to the distinctiveness of geographical collective trademarks and disclaimers of the name of a geographical location (Paragraph 1 of Article 84 applicable *mutatis mutandis* to Article 91 of the Trademark Act). In the examination of an application to register a trademark, if the trademark consists merely of words descriptive of the geographical origin of the goods or services, registration will often be refused on the ground that the trademark is non-distinctive (Subparagraph 1 of Paragraph 1 of Article 29 of the Trademark Act). However, the primary function of a geographical collective trademark is to indicate the geographical origin, so registration should not be refused on the ground that the mark is non-distinctive as it consists merely of word(s) descriptive of the geographical origin of the designated goods or services. When the name of a geographical origin is used as a portion of a collective trademark and the mark as a whole is distinctive, the trademark registrar office should not require from the applicant a disclaimer of that portion on the ground that it describes the geographical origin of the goods or services and may give rise to doubts or questions about the scope of the rights in the mark. In this regard, Subparagraph 1 of Paragraph 1 of Article 29 and Paragraph 3 of Article 29 of the Trademark Act do not apply to the name of a geographical origin identified in a geographical collective trademark. As for whether or not a description, generic mark/term or other signs which are devoid of any distinctiveness, other than the name of a geographical origin, contained in a general geographical collective trademark must be disclaimed, it should still be determined in accordance with the *Examination Guidelines on Disclaimers*.

In some circumstances, it is customary for traders of agricultural products to use "the name of a geographical origin followed by the name of goods" to indicate the place from which the goods originate. For example, "雲林木瓜" ("Yunlin papaya") is used merely to indicate that the papaya originates in Yunlin. If an applicant obtains registration of a geographical collective trademark that consists entirely of "the name of a geographical origin followed by the name of goods," there will be doubts or questions as to whether or not a claim of

infringement may be made or whether it is reasonable use when an unauthorized person uses "the name of a geographical origin followed by the name of goods" as a trademark. To differentiate the goods of members of a group from those of non-members within the named geographical region, the proprietor of a collective trademark may stipulate in the regulations governing use the conditions of use of the collective trademark, such as the place where the mark should appear, the style in which the mark is presented, and the color(s) of the packaging for the goods. To resolve the issue described above, it is advisable to include in the mark, at the filing of the application, a distinctive device or words in addition to "the name of a geographical origin followed by the name of goods," especially words that clearly indicate that the sign is a geographical collective trademark (see the example of "北埔膨風茶" given in Section 5.2.4 for reference). This may increase the distinctiveness of the trademark and help safeguard the rights to the geographical collective trademark.

Example of an accepted mark:



In addition to "the name of a geographical origin (大甲) followed by the name of goods (芋頭)," this trademark also includes a distinctive device.

If for general consumers the name of a geographical origin carries the significance of a particular mode of manufacture, flavor, or way of cooking, then "the name of a geographical origin" or "the name of a geographical origin followed by the name of goods" used in the mark may become a descriptive or generic name other than the name of the place from which the goods originate. For example, both "樓蘭磚" ("Loulan brick") and "紹興酒" ("Shaoxing rice wine") are already generic names; any application to register such a name as a geographical collective trademark will not be accepted as they will be held to be non-distinctive. If any question arises as to whether the name of a geographical origin has become a descriptive or generic name for goods or services, the trademark registrar office may consult and seek advice from the competent central government authority with jurisdiction over the relevant industry of goods or services.

5.3.5 Other grounds for refusal of registration

For an application to register a collective trademark, none of the grounds specified in Articles 30 and 65-3 of the Trademark Act for refusal of registration should exist (Article 30 and Paragraph 3 of Article 65 applicable *mutatis mutandis* to Article 94 of the Trademark Act). With respect to the determination of likelihood of confusion and protection of well-known marks, the trademark registrar office will apply the *Examination Guidelines on Likelihood of Confusion* and the *Examination Guidelines for the Protection of Well-known Trademarks under Subparagraph 11 of Paragraph 1 of Article 30 of the Trademark Act*. The following are the grounds for refusal of registration commonly seen in practice and explanation of the relevant principles applied.

5.3.5.1 Likely to mislead the public as to the nature, quality, or place of origin of the goods or services

If a collective trademark contains a description of the nature or quality of the designated goods or services, but from the conditions under which the collective trademark is used such description is untruthful and may mislead consumers into believing that it is true and so affect their wish to make a purchase, the collective trademark is deemed likely to mislead the public as to the nature, quality, or place of origin of the goods or services (Subparagraph 8 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and shall be refused registration accordingly (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act).

A geographical collective trademark is used to indicate that the goods or services of a member of the group originate in a specific place and that they meet the conditions of use of the geographical collective trademark. Therefore, it is rare for a geographical collective trademark to be likely to mislead the public as to the origin of goods or services. However, if a geographical collective trademark contains a description of the nature or quality of the designated goods or services, whether it may mislead the public as to the quality or nature of the goods or services should be determined in the same way described above.

5.3.5.2 Likely to cause confusion among relevant consumers

If an applied-for collective trademark is identical or similar to an earlier-registered or earlier-filed trademark, collective trademark, or certification mark, and is designated for use on goods or services that are the same or similar to those of the latter mark, it may cause relevant consumers to assume mistakenly that the goods or services of the later-filed collective trademark and

the goods or services of the earlier-registered or earlier-filed trademark or certification mark proprietor are from the same source or different but related sources; or that the goods or service on which the later-filed collective trademark is used are the goods or services of the prior certification mark proprietor; or that the applicant of the later collective trademark is an affiliate, licensee or franchisee of, or is otherwise associated with the earlier certification mark proprietor. In such a case, there exists a likelihood of confusion among relevant consumers (Subparagraph 10 of Paragraph 1 of Article 30 applicable *mutatis mutandis* to Article 94 of the Trademark Act) and, therefore, should be refused registration (Paragraph 1 of Article 31 applicable *mutatis mutandis* to Article 94 of the Trademark Act). As for whether there is a likelihood of confusion, the *Examination Guidelines on Likelihood of Confusion* should apply when determining this issue.

A geographical collective trademark usually contains the name of a place or a sign capable of indicating a particular geographical region. When determining whether a collective trademark is similar to a trademark or certification mark, they cannot be held to be similar merely because they contain the same name of a place or signs that suggest the same geographical place. Whether a collective trademark is similar to a trademark or certification mark must still be determined by viewing the mark as a whole. This is no different from determination of similarity between trademarks.

Example of marks causing a likelihood of confusion:



The image on the left is a registered geographical collective trademark "公館紅棗 Taiwan Kung-Kuan Jujube 及圖." The image on the right was a trademark filed for registration by another person. As both contain the same Chinese characters "公館紅棗," they constitute similar trademarks. It was noted that they are designated for use on identical or similar goods, namely "dried fruits and vegetables; frozen fruits and vegetables," and that the geographical collective trademark has become familiar to the relevant consumers. Since it might cause confusion as to the origin of the goods, the

applied-for trademark was refused registration.

Example of marks causing no likelihood of confusion:

● 麻豆文旦



The geographical collective trademark on the left is registered and owned by the Madou Township Farmers' Association of Tainan City, and is used on pomelos that originate in Madou in Tainan County. The trademark on the right was a trademark filed for registration by another party for use in connection with Madou pomelos. Although both marks contain "麻豆" ("Madou"), the later-filed trademark is "麻豆丫嬭," which in its entirety contains additional wording and device sufficient for one to distinguish between the two trademarks. As it would not cause any consumer confusion as to the origin of the goods, the later-filed trademark was granted registration.

5.3.6 Miscellaneous matters

Where an applicant who has obtained registration of a certification mark or trademark in another country seeks to register the mark as a geographical collective trademark in Taiwan, as a general rule every country requires that a collective trademark be used only by a member of the collective, but does not require that the use of a certification mark be restricted to members only. As they clearly differ in user requirement, the applicant must explain the state of the registration and use of its certification mark or trademark in the country of origin, provide the relevant laws or regulations as evidence, and state in the regulations governing use that the application is for a geographical collective trademark before the applicant may obtain registration of the geographical collective trademark.

5.4 Post registration matters

5.4.1 Amendment to the regulations governing use

The proprietor of a geographical certification mark or of a geographical collective trademark may amend the regulations governing use after the mark or trademark is accepted for registration, such as changing the quality standards the

goods must meet, the manner in which the mark is used, and procedural matters relating to applications; however, the amendment may not broaden the scope of the goods or services certified or designated for use thereby. The regulations governing use may affect use of the mark by existing and potential users as well as consumers' interests in relying on the mark to recognize and identify goods or services of a certain quality or characteristic. Therefore, any amended regulations governing use must be examined by the trademark registrar office in the same way as those filed for a new application. Once accepted, the amended regulations governing use will be published in the Trademark Gazette (Paragraph 5 of Article 82 and Paragraph 4 of Article 89 of the Trademark Act).

5.4.2 Use of geographical marks

5.4.2.1 Use of a geographical certification mark

"Use of a geographical certification mark" means the use of such mark by any person who is allowed by the proprietor of such mark in accordance with the conditions prescribed in the regulations governing the use of such mark (Article 83 of the Trademark Act). In other words, it means a person who is allowed by the proprietor of such mark apply the mark in the course of trade to goods or packaging or containers thereof, to articles relating to the provision of services, to commercial documents or advertisements relating to goods or services, or to acts performed by digital audio-visual means, through electronic media, on the Internet, or through other media, where such mark is capable of being recognized by relevant consumers as a certification mark (Article 5 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The proprietor of a certification mark cannot itself use the mark on the goods or services certified by the mark, but may use the mark in advertising or promotion of the mark.

Obtaining registration of a geographical certification mark does not guarantee that the goods will achieve acclaim in the market. Only through persistent promotion of the mark and the goods certified by the mark and practical management and supervision of the use of the mark to support recognition thereof and belief by consumers that the goods from the place identified by the mark possess a certain quality or characteristic does the value of a geographical certification mark become manifest. In addition, the proprietor and the users of a certification mark have to work together to improve the quality of the goods from the certified geographical origin. Only by doing so can the goods come to the fore in a highly competitive market and the marks retain significance with the passage of time. And only then does protection for marks that are used as an indication that goods originate from a particular geographical region have any actual meaning.

A geographical origin has a descriptive significance in relation to goods or services. Before a certification mark is filed for registration, it is common for businesses within the scope of the region identified by the geographical origin named in the certification mark to indicate the geographical origin in a way that is consistent with the commercial trading practices for the goods or services in that region. Therefore, even if the rights to the certification mark as afforded by the Trademark Act have been obtained by the proprietor, the proprietor has no right to prohibit other persons from indicating the place of origin of their goods or services in a good faith manner in accordance with existing commercial trading practices (Paragraph 2 of Article 84 of the Trademark Act).

5.4.2.2 Use of a geographical collective trademark

"Use of a collective trademark" means the use of such mark by the collective or any of its members in accordance with the conditions prescribed in the regulations governing the use of such mark (Article 90 of the Trademark Act). In other words, it means a person who is allowed by the proprietor of such trademark apply the trademark in the course of trade to goods or packaging or containers thereof, to articles relating to the provision of services, to commercial documents or advertisements relating to goods or services, or to acts performed by digital audio-visual means, through electronic media, on the Internet, or through other media, where such trademark is capable of being recognized by relevant consumers as a collective trademark (Article 5 applicable *mutatis mutandis* to Article 17 of the Trademark Act). The proprietor of a collective trademark may use the collective trademark in advertising or promotion of the mark in order to publicize the mark and the goods or services provided by members of the collective. While the proprietor of a collective trademark may use the mark on designated goods or services, it should be noted that the function of a collective trademark is to indicate that goods or services bearing the trademark are provided by members of the collective; a collective's purpose of obtaining registration of a collective trademark is not to use the mark by itself but to let members of the collective use it. Therefore, the use of a collective trademark must be sufficient for the relevant consumers to recognize it as such.

A geographical origin has a descriptive significance in relation to goods or services. Before a collective trademark is filed for registration, it is common for businesses within the scope of the region identified by the geographical origin named in the collective trademark to indicate the geographical origin in a way that is consistent with the commercial trading practices for the goods or services in that region. Therefore, even if the rights to the collective trademark as afforded by the Trademark Act have been obtained by the proprietor, the proprietor has no right to prohibit other persons from indicating the place of origin of their goods or services in a good faith manner in accordance with

existing commercial trading practices (Paragraph 2 of Article 84 applicable *mutatis mutandis* to Article 91 of the Trademark Act).

5.4.3 Geographical mark transfer, license, and pledge

The right of a geographical mark may not transferred or licensed after registration. However, if such transfer or license is unlikely to injure the interests of consumers or contravene fair competition, such right may be transferred or licensed upon approval by the trademark registrar office (Article 92 of the Trademark Act). Where a geographical mark transfer or license is concerned, the trademark registrar office shall take into consideration whether the transfer or license will be detrimental to the interests of consumers and contravene fair competition, and in particular the qualifications and representativeness of the transferee or licensee. See Sections 2.3.3 and 4.3.3 of the Guidelines for details.

5.4.4 Opposition, invalidation, and cancellation proceedings against geographical marks

Any person may file an opposition to the registration of a geographical mark within three months from the day following the date of publication of the registration on the grounds of applicability of the unregistrable circumstances provided in Paragraph 1 of Article 29, Paragraph 1 of Article 30, or Paragraph 3 of Article 65 of the Trademark Act (Article 48 applicable *mutatis mutandis* to Article 94 of the Trademark Act); an interested party may file an invalidation, or a trademark examiner may submit a proposal for invalidation, against the registration of a geographical mark in accordance with the law after the date of publication of the registration (Article 57 applicable *mutatis mutandis* to Article 94 of the Trademark Act). It should be noted that a geographical certification mark certifies place of origin and is used to distinguish goods or services with their place of origin certified from those that do not have their place of origin certified; and that a geographical collective trademark is used to indicate that the goods or services of a member of the collective originate from a particular geographical region. Therefore, given its definition as provided by the law, the name of the place of origin registered for a geographical mark shall be considered well-known to a certain extent, and Subparagraph 1 of Paragraph 1 of Article 29 and Paragraph 3 of Article 29 of the Trademark Act shall not be applicable (Articles 84 and 91 of the Trademark Act)—this can be considered a critical factor to be taken into consideration in the determination of whether there are any unregistrable circumstances. A geographical mark may be revoked under Article 93 of the Trademark Act, which sets forth the grounds for revocation, as well as on the grounds for revocation of a trademark (Paragraphs 1 and 2 of Articles 63 applicable *mutatis mutandis* to Article 94 of the

Trademark Act). See Sections 2.3.4 and 4.3.4 of the Guidelines for details.