



# The Trademark Prosecution Review

2024

**Taiwan: Draft Amendments Aim to  
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for Protection**

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# Taiwan: Draft Amendments Aim to Attract More Rights Holders to Apply for Protection

**Li Yi-Ying** and **Fu Ting-Yun**

Taiwan Advance Patent & Trademark Office

## Summary

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## In summary

This article introduces the trademark application process in Taiwan, from examination to the registration and publication process, and the most recent Taiwan Trademark Law draft in 2023.

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## Discussion points

- Trademark application process
  - Trademark examination
  - The rights of third parties during the period of trademark publication
  - The latest Taiwan Trademark Law draft in 2023
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## Referenced in this article

- Taiwan Trademark Act
- Enforcement Rules of the Trademark Act

## Taiwan trademark application process

The basis for the registration of trademark rights can generally be divided into two types: first to register and first to use. First to register is the main way to obtain trademark rights in Taiwan. After the applicant files a trademark application, it goes through two processes: procedural examination and substantive examination.

Procedural examination refers to the review of the documents provided by the trademark applicant to confirm whether the submitted documents comply with the Taiwan Trademark Act and whether the identification of designated goods or services are acceptable. If the application does not comply with these requirements, an official notice by the Taiwan Intellectual Property Office (TIPO) will be issued.

After procedural examination, the TIPO begins to examine whether the applied trademark is distinctive or has grounds of refusal for non-registration, such as likely causing confusion, trademark squatting and likely causing confusion with another's well-known trademark.

If the application overcomes all the issues raised in the examination, the trademark will be published for registration.

## The public review system after the trademark is approved: opposition and invalidation

Who can file an opposition or invalidation against a registered trademark?

Anyone (for opposition) or an interested party (for invalidation) who thinks that a registered trademark lacks distinctiveness, or it could likely cause confusion with a previously registered trademark, or other legal provisions stipulate that it cannot be registered. In those cases, a party can file in opposition or for invalidation to the TIPO to revoke the registration.

Recently, the most famous case in Taiwan regarding trademark opposition was **STARLUX Airlines v Songlin Travel Agency** for the Chinese trademark '✈️' (Chinese translation of 'STARLUX'). Zhang Guo-Wei, the founder of STARLUX Airlines, publicly announced the establishment of his new company in November 2016, and widely publicised and reported it through the media. When he tried to apply for the '✈️' trademark in 2017, however, it had been applied for by Songlin Travel Agency in December 2016, and designated in the same services of sightseeing and tourism transportation services and provision of catering services with STARLUX Airlines. After about two years' fight, STARLUX Airlines finally won the opposition case by proving that the trademark had been intently squatted by Songlin Travel Agency.

## The introduction of a 2023 Taiwan Trademark Law draft

### Abolition of opposition procedure

In view of the similarity between opposition and invalidation, the Legislative Yuan decided to abolish the opposition procedure, and the illegality of trademark registration is uniformly resolved through the invalidation procedure. At the same time, the restrictions qualifying applicants are relaxed. Namely, anyone will be able to file for invalidation against illegal trademark registrations.

### Trademark attorney certification

According to Taiwan's trademark laws and regulations, those who can perform trademark agency business are "specialized professionals (such as lawyers and accountants) " or "trademark attorneys". The newest draft of Taiwan Trademark Act requires a stricter qualification of trademark attorney. They must:

1. pass the trademark professional ability certification examination held by the TIPO; or
2. have engaged in trademark examination work for a certain period of time; and
3. apply for registration as a trademark attorney in the TIPO; and
4. complete a certain number of hours of on-the-job training each year.

## Acceptance of accelerated approval system

If the trademark applicant needs to obtain the trademark rights earlier, he or she may apply to the TIPO for accelerated examination after stating the facts and reasons as to why the application needs this procedure and paying the accelerated examination fee.

## Conclusion

Internationalisation has always been the goal pursued by Taiwan's intellectual property legal system. Through the newest Trademark Act amendments, trademark registration procedures can be simplified and costs can be reduced, thus encouraging more trademark owners to apply for trademark protection. Furthermore, more Taiwan enterprises will be willing to invest in brand and innovation to improve the effectiveness of products and services, thereby promoting market competition and economic development.

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## **THE INTRODUCTION OF A 2023 TAIWAN TRADEMARK LAW DRAFT**

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4F, No. 410, Sec 5, Chunghsiao E Road, Taipei 110, Taiwan

Tel: +886 02 2723 8589

<https://kurojica.com/schedule/>

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