

## Proposed Amendments of Taiwan Trademark Act

The prevailing Taiwan Trademark Act was amended on June 29, 2011 and implemented on July 1, 2011. To meet the changes of international trends and local examination requirements, Taiwan Intellectual Property Office (TIPO) began the discussions with experts and scholars on amendment issues of Trademark Act since last year, including the abolishment of trademark opposition system. Thereafter TIPO made a draft by amending some provisions of the Trademark Act and held public hearing on October 15, 2019. After hearing and collecting the public opinion, TIPO decided not to delete current provisions relating to trademark opposition, and published a proposed Trademark Act Amendment on November 26, 2019. The key points of the proposed amendments are listed below.

### **Qualification of trademark agent**

Expressly stipulating a trademark agent shall be a lawyer (attorney-at-law) or a trademark agent who could practice per law, or a specialist with trademark relevant knowledge, the latter shall be registered and administered under regulations by trademark authority.

### **Eligibility of trademark applicant**

The eligible applicant shall be a natural person, juristic person, partnership, administrative agency, or a non-juristic person group registered under the law, or a commerce registered under Commerce Registration Act, who desires to engage the work for goods or services as designated.

### **Accelerated examination measure**

When filing a trademark registration, the applicant could request for an accelerated examination by stating the fact and reasons, such as the necessity of determining the legal right due to lawsuit involved trademark infringement, or the commercialization of goods.

### **Scope of acquired distinctiveness for trademark specimen**

For a non-distinctive part of trademark specimen, it is not required to make a disclaimer on said part if the applicant has used the same and acquired its distinctiveness.

### **Scope of functionality for trademark specimen**

The functional part of trademark specimen shall be presented by dotted lines, otherwise a disclaimer shall be made by stating that it is not a part of trademark.

### **Nominative fair use without binding effect of trademark right**

In order to indicate the use of goods/services, one who, per honest practices in industrial or commercial matters due to the necessity use of another person's trademark to indicate another person's goods/services, shall not be bound by the effects of a registered trademark rights.

The above proposed Trademark Act Amendment will be submitted for deliberation by the Ministry of Economic Affairs and the Executive Yuan (the Cabinet) and then passed by the Legislative Yuan (the Congress), so it is anticipated that enforcement thereof would be in 2020 or 2021.