

# TAIWAN NEWSLETTER

UNION PATENT SERVICE CENTER

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## [ Differences Between Patent and Trademark Practices in Taiwan ]

In Taiwan, patents (including inventions, new models, designs) and trademarks are the two most important types of industrial property rights. Also, the laws, practices, and applicants of both patents and trademarks appear to be the same or similar, and the competent authority thereof is the Taiwan Intellectual Property Office (abbreviated as TIPO) under the Ministry of Economic Affairs (MOEA). According to TIPO, patent cases are examined by Patent Division I, Patent Division II and Patent Division III, while the trademark cases are examined by Trademark Division. However, in Taiwan, the patent and trademark practices are of some differences as they are handled separately by the Patent Divisions and Trademark Division of TIPO.

The main differences between Taiwan patent and trademark practices are summarized as follows  
(Differences in law are not included in this discussion):

	Content	Patent Practice	Trademark Practice
1	The relationship between priority and applicant	<ul style="list-style-type: none"> <li>➤ In principle, the applicant who claims a foreign priority and the right holder of said priority case should be the same, yet in practice, they could be different entities. Generally, there is no need to provide any explanation or proof for why they are different.</li> </ul>	<ul style="list-style-type: none"> <li>➤ In principle, the applicant who claims a foreign priority and the right holder of said priority case should be the same, otherwise it is required to file an explanation or a proof showing the change of name or transfer of right.</li> </ul>
2	Submission of a certified priority document	<ul style="list-style-type: none"> <li>➤ The priority document should be an original document issued by the foreign government; or its full scanned copy to be submitted via TIPO's electronic filing system.</li> <li>➤ For claiming a priority case filed in JPO or KIPO, the applicant can simply provide the <b>access code</b> for a Japanese priority case or indicate as "<b>electronic exchange</b>" for a Korean priority case, without submitting the original certified priority document.</li> </ul>	<ul style="list-style-type: none"> <li>➤ A photocopy of the certified priority document can be submitted, instead of the original Priority document.</li> <li>➤ For claiming a priority filed in EUIPO or IPONZ (New Zealand), the applicant can file a printout of the online priority document from EUIPO or IPONZ.</li> </ul>
3	Recordal of changes (for applicant's name, address and representative; or assignment/merger and transfer of right)	<ul style="list-style-type: none"> <li>➤ If the facts or entity of right holder before and after the change are the same, a recordal of change can be filed by a <b>single application form</b> containing multiple patent cases. TIPO will also issue only one notification when approving the recordal.</li> <li>➤ The recordal of patent <b>assignment/merger</b> for multiple cases <b>cannot be filed by a single application</b></li> </ul>	<ul style="list-style-type: none"> <li>➤ If the facts or entity of right holder before and after the change are the same, a recordal of change can be filed by a <b>single application form</b> containing multiple trademark cases. TIPO will also issue only one notification when approving the recordal.</li> <li>➤ The recordal of trademark <b>assignment/merger</b> for multiple cases <b>can be filed by a single application</b></li> </ul>

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		<p><b>form</b> but must be separately filed for each patent case (pending patent application or granted patent); TIPO will issue a notification approving the recordal for <b>each</b> patent case, with a re-issued Letters Patent in the name of Assignee (new patentee) if said case is a granted patent.</p>	<p><b>form</b>. TIPO will also issue only one notification when approving the recordal, without re-issuing the trademark registration certificate to the Assignee (the new trademark owner).</p>
4	Special agent (not the original registered agent) handling the recordal	<ul style="list-style-type: none"> <li>➤ The recordal of name/address change or <b>assignment/merger</b> of a granted patent case can be handled by a specially appointed agent who is not the originally recorded agent on file, <b>without taking over the representation</b>.</li> <li>➤ However, after the approval of assignment recordal, TIPO will issue a reminder for a granted patent that the said granted patent is in the state of no agent recorded on file. But for a pending patent application, TIPO will issue a notice within a certain period requiring the Assignee (new applicant after the assignment) to appoint an agent (which can be the original agent or a new agent) for continually handling the prosecution of said patent application.</li> </ul>	<ul style="list-style-type: none"> <li>➤ The recordal of change (such as name or address change, but not for assignment/merger) of a trademark case can be handled by a specially appointed agent who is not the originally recorded agent on file, <b>without taking over the representation</b>.</li> <li>➤ For the record of <b>assignment/merger</b> of a trademark case, the agent handling the record <b>must take over the representation and become the recorded agent of said trademark case</b>.</li> </ul>
5	Opposition system	<ul style="list-style-type: none"> <li>➤ No. However, an revocation against a granted patent, instead of an opposition, can be filed.</li> </ul>	<ul style="list-style-type: none"> <li>➤ Yes. After the opposition period, an invalidation can also be filed against a registered trademark.</li> </ul>
6	Revocation system	<ul style="list-style-type: none"> <li>➤ For patent revocation, the demander shall submit the reasons and evidence when filing or within three months after filing the revocation, and then the patent owner (patentee) shall file a counterstatement within one month (extendable). After this period normally new evidence and reasons or supplementary counterstatement will not be acceptable unless in response to TIPO's examination opinion raised by the Examiner</li> </ul>	<ul style="list-style-type: none"> <li>➤ For trademark invalidation system (and opposition system), the demander (and opposer) or the trademark owner (trademark registrant or applicant) can file new evidence and reasons before a decision is made, and both sides can contest against each other the offense and defense at least two rounds.</li> </ul>
7	Third party submission	<ul style="list-style-type: none"> <li>➤ Third party submission cannot be filed anonymously</li> </ul>	<ul style="list-style-type: none"> <li>➤ Third party submission may be submitted anonymously</li> </ul>

