



NEWSLETTER

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The Use of Taiwan Registered Trademarks

In Taiwan, an application for trademark registration adopts the first-to-file principle, and does not require prior use before the trademark is allowed for registration. However, after a trademark has been registered and obtained the trademark right, the trademark should be properly used in accordance with the law. If a trademark has not been used for three consecutive years after registration, anyone can file a request to revoke the registered trademark. Due to the importance of trademark use in maintaining trademark rights, the Taiwan Intellectual Property Office (TIPO) has specially stipulated "Notes on the Use of Registered Trademarks," and the relevant content is summarized as follows.

Meaning of Use

Generally, a trademark is used for marketing purpose, and in the course of trade, it is capable of being recognized by the consumers as a trademark, and shall comply with the usual commercial transaction practices.

Determination of Use

- Trademark user:** The user can be the Trademark registrant (right holder), or the person such as a Licensee consented by the holder.
- Trademark marking or labelling:** A registered trademark may be displayed with the words "registered trademark" or marked with the internationally used symbol ® (or the ™ symbol which has been used when filing the trademark before registration). But the use of a trademark is determined by the facts and evidence on a case-by-case basis, not solely the symbol marking.
- Trademark identity:** The trademark in actual use shall be identical to the registered trademark, and the main features of the registered trademark must not be substantially changed. Trademark identity can be determined by the arrangement of text, font size, capitalization of foreign letters (of alphabets), attached parts, color, etc. If the trademark is simply changed in form and does not change the feature or meaning of the trademark, it can usually be considered identical. Normally, black and white trademarks are more widely protected. If the registered trademark is in black and white, while its actual use is in color, it can be deemed use of the trademark.
- Combined or partial use:** The Trademark Act does not restrict the simultaneous use of multiple trademarks or a combination of trademarks and signs, but it cannot change the dominant identifying features of the original registered trademark. The registered trademark should be used in its entirety, and if only a part of the trademark is used, the trademark should not be considered in use.
- Goods or services:** The actual use of a trademark should correspond to or be equivalent in nature to the goods/services designated in the registration. For example, if the registration designates "cosmetics" but the actual use is for "pressed powder," they are considered similar in nature and thus constitute the use of a trademark. However, if the registration designates "human drugs" but the actual use is for "animal drugs," the trademark is not considered use because the purposes and functions differ. If the registration is designated as "drug preparation services" but the actual use is for "various pathological examination services," they are different in terms of service rendered and expertise offered, thus the trademark would not be deemed use. In addition, using a trademark on promotional gifts may be recognized as trademark use for

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marketing purposes, but the gifts themselves are not considered as using the trademark. For example, a department store can display its trademark on balloons given as free gifts to promote the sale of services it provides, but the balloons cannot be used alone to determine the use of trademark.

6. **Cross-border use:** Typically, trademark use is subject to the jurisdiction of Taiwan. However, according to the act of sale in the course of trade stipulated under the Trademark Act, the territorial scope of the marketplace shall cover the local market and the exports from Taiwan to other countries. Therefore, Taiwanese products exported overseas can also be considered as the use of trademark. For trade act of OEM or ODM which a foreign company owned a Taiwan trademark, and then licensed to a Taiwan manufacturer for production and delivery of products to the foreigner owner's home country or a third country, the trademark of the exported products can be considered to be in use. Despite the products are not sold directly in Taiwan, the products are manufactured locally and the use of trademark complies with the usual business practice conducting in international trade.

Duration of use and Revocation

A registered trademark possesses an exclusive right of 10-year protection period from the registration date. The trademark right period may be extended within six months before the expiry of period, and each extension shall be ten years. If a registered trademark, without justifiable reasons, is not used or has been discontinued in use for three years after registration, the trademark may be revoked by any person or ex officio by the Examiner at TIPO. If the trademark right holder receives a revocation request from TIPO, it is required to file a counter-statement and evidences of trademark use, in defending against the revocation.

Evidence of use

The trademark holders must keep evidences of trademark use at all times during normal business transactions or activities. The evidences should bear the registered trademark, date, and user. They may include the physical products, photos, packages or containers; catalogs, posters, and flyers for advertising and marketing; invoices, purchase orders, and delivery orders for sales proof; exhibition manuals and booth photos for exhibition records, etc. Online evidences can be screenshots of web pages, online transaction records, emails with customers, online advertising materials, online media reports, electronic invoices, contracts signed with online platform operators, and so on.

Use on Internet

A registered trademark can be used on the Internet. If it is not a Taiwan website (e.g. not domain address of ".tw"), but a foreign website, then it is necessary to prove that the content of the web page is marketed in the Taiwan market. For example, the web page should indicate the address and telephone contact information in Taiwan, the price in Taiwan dollars or be payable in Taiwan, the after-sales service, etc. The date of the trademark use on the internet can be proved by the time stamp of the domain history, the indexing date of the internet search engine, the website time back machine, and so on.

Conclusion

A registered trademark should be used properly, legally, and continuously, in accordance with the law. The trademark use must be genuine, not merely symbolic, in order to fulfill the essential function and value of a trademark. On the other hand, if there are business adjustments, the registrant may consider deleting unused classes from the originally registered trademark. In case it is necessary to alter/modify the trademark due to market changes, a new trademark registration may be filed.

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