

Briefs of Classic Trademark Cases in Recent Years

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1. A case related to the trademark “Angelina”

How to determine the scope of goods in connection with which the trademark has been put to genuine use

Decision No.	Administrative Judgement of the Intellectual Property Court, 2019 Xing Shang Geng (Yi) Zi No.5
Date	October 31, 2019
Issue	The determination of whether the goods in connection with which a registered trademark has been put to genuine use can be deemed to be identical with the designated goods of that trademark in essence.
Relevant statutes	Article 63.1.2 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none">1. The legislative purpose of Article 63.1.2 of the Trademark Act is to prompt proprietors of the trademark rights actively using their registered trademarks to bring the function of trademarks, i.e. indicating the source of goods or services, into full play and keep maintaining their trademark rights. Nevertheless, to prevent the requirement from being too harsh, if the proprietor of the trademark rights has submitted the evidence which is enough to establish that the trademark has been put to genuine use in connection with part of the designated goods or services, other designated goods or services that are “identical in essence” can also be included in the scope of genuine use even if there is no evidence of use provided for each of them.2. The purpose of determining the “identical in essence” of goods or services is to moderately relax the burden of proof born by the proprietor of the trademark rights regarding genuine use of the registered trademark, which is different from the determination of “similar” goods or services that serves to define the protective scope of trademark rights. The two concepts shall not be confused with each other. Accordingly, directly citing the concept of “similar” goods or services to determine whether the goods or services are “identical in essence” or not shall be

	<p>avoided in order to prevent the protective scope of goods or services regarding genuine use of the trademark from over expansion which may cause the deviation from the purpose of Article 63.1.2, i.e. prompting proprietors of the trademark rights to actively use their trademarks in connection with registered goods or services to maintain their trademark rights.</p> <p>3. The determination of whether or not different goods or services are “identical in essence” shall be based on whether the content, expertise, intended purpose, function, etc., of the goods or services are identical and whether the general public can deem them to be identical according to the commercial practice (cited from the Judgement of the Supreme Administrative Court, 2019 Pan Zi No. 133).</p> <p>4. In this case, both of the goods “biscuits; dry cakes; bread” and the good “cakes” are produced and provided by bakery undertakings and made from flour (rice flour) through very similar manufacturing process. For the same undertaking, these goods can be produced by existing materials at any time to provide for relevant consumers and satisfy the same needs of them. According to the general social norms and the circumstances of trade in the market, these goods are identical with each other in essence.</p> <p>5. The good “crystallized fruits” refers to dehydrated or frosted fruits and vegetable made of materials like plums, peaches, apricots, pears, jujubes, etc., that are candied with sugar or honey. The good “candies” is made by means of melting and boiling its main ingredient sugar at high temperatures. Comparing the goods “crystallized fruits” and “candies” with the good “cakes” in connection with which the trademark has been put to genuine use, there are differences in terms of materials, manufacturing processes or patterns of actual production and sale. Therefore, these goods are not identical with each other in essence.</p>
Keywords	Identical in essence, genuine use

Contested trademark

Registered No. 00650036



Class 024 (used in former laws): Crystallized fruits; candies; biscuits; dry cakes; bread; cakes.

2. A case related to the trademark “東急”

Genuine use of the trademark conducted within the relevant territory

Decision No.	Administrative Judgement of the Intellectual Property Court, 2020 Xing Shang Su Zi No.104
Date	January 28, 2021
Issue	When it comes to the determination of the evidence of genuine use, whether the “actual transactions” raised to establish the registered trademark has been put to genuine use shall be limited to those take place in Taiwan.
Relevant statutes	Articles 5 and 63.1.2 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none">1. The plaintiff’s evidence is enough to establish that it had promoted the service related to its “東急” department store operated in Japan through the international tourism exposition held in Taiwan within 3 years before the date that the revocation was filed.2. To ensure that it can be deemed to be the genuine use of a trademark, in addition to meeting the requirement of “use in the course of trade” set out in Article 5 of the Trademark Act, more importance is attached to whether the trademark is continuously used through economically meaningful ways to create or maintain the sales market in the relevant territory. If the proprietor merely promotes the image of its trademark without conducting all or part of the transactions in Taiwan, there will be no chance for domestic consumers to have transactions in connection with any goods or services identified by the trademark in Taiwan. Consequently, the trademark will be incapable of fulfilling the economic function of creating the market or sales channels for its goods or services in Taiwan, and it also means that the trademark will obviously lose its value. Namely, it is not enough to constitute genuine use of a trademark.3. The plaintiff didn’t operate any department store in Taiwan, the coupons or flyers sent in the tourism exposition were no more than advertising activities. Taking into account the facts that the place where the service and overall transactions related to consuming the service are provided or conducted in Japan, no economic activities of department store occurred in Taiwan, such use of the trademark cannot be deemed to be genuine use. In

	conclusion, it is not enough to establish that the contested trademark has been legitimately put to genuine use in connection with the service “department store” designated by the plaintiff.
Keywords	Genuine use, relevant territory

Contested trademark
Registered No. 01768451

Class 35 : Advertising; department store; supermarket; mail order; internet shopping...
Classes 36 and 43

3. A case related to the trademark “聖旺”

The determination of likelihood of confusion

Decision No.	Administrative Judgment of the Intellectual Property Court, 2020 Xing Shang Su Zi No. 76
Date	March 25, 2021
Issue	Is there any likelihood of confusion between two trademarks with low degree of similarity, while the services designated by each of them are highly similar to each other?
Relevant statutes	Article 30.1.10 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none">1. With respect to the trademarks of the two parties, domestic consumers, who are accustomed to Chinese, normally take the Chinese characters as the basis to distinguish the sources of goods and services. In an overall assessment, the contested trademark contains a string of English characters “San Juan Easy Stay Inn Tainan” in a small font under the Chinese characters “聖旺商旅”; the cited trademark contains a string of English characters “SAN WANT HOTEL” in a small font under the Chinese characters “神旺大飯店”. The contested trademark is yellow, while the cited trademark is black. Their designs of the fonts are different from each other as well. That is to say, the colors, fonts, and Chinese and English characters of the two trademarks are different from each other; accordingly, their overall impressions presented to consumers are different. Although both of the “聖旺商旅” and the “神旺大飯店” contain the same character “旺”, neither of them is deliberately enlarged to highlight the character. Both trademarks are designated for use on the catering and hotel services rather than ordinary daily consumer goods. A consumer who purchases the service, or a potential consumer who may purchase the service in the future, with a certain degree of general attention, can easily distinguish the differences between the two trademarks. Therefore, the consumers will not perceive that the two trademarks come from the same or related sources. The degree of similarity between the two trademarks is extremely low.2. According to Article 30.1.10 of the Trademark Act, the similarity of goods or services between two trademarks shall be determined by the goods or services designated or registered. In this case, the two trademarks are both designated for use on hotels, restaurants, etc., with no

	<p>difference in essence. The differences in business model and business positioning claimed by the plaintiff shall be considered under other factors of confusion, which cannot be relied on to determine that the services at issue are not similar to each other.</p> <p>3. The accommodation service provided by the contested trademark is located in the center of Tainan, which is advertised as a business hotel with convenient location in the urban area, whereas the accommodation service provided by the cited trademark is a star-rated hotel located in Taipei. Although the cited trademark is indeed more famous than the contested trademark, relevant consumers in the catering and hotel service market should be able to distinguish their differences. Moreover, it is known to relevant consumers in this field that the two trademarks have concurrently existed in the marketplace.</p> <p>4. Since the degree of similarity between the two trademarks is low, one of the two essential factors for determining the likelihood of confusion is lacking. Although the services designated by the two trademarks are identical with or highly similar to each other, according to the evidence presented by the plaintiff, it can be determined that relevant consumers in the catering and hotel services have fully recognized the fact that the two trademarks are coexistent in the market. Furthermore, there are differences between the types of services provided by the two parties, and there is no evidence of actual confusion among relevant consumers. After thorough consideration, the court concluded that, it is not likely that relevant consumers will erroneously believe that the services of the two trademarks are from the same source or there is an affiliation, license, franchise, or some other similar relationship between the users of the two trademarks.</p>
Keywords	Likelihood of confusion, degree of similarity

Contested trademark	Cited trademark
Registered No.01982751	Registered No.00186675
	
Class 43: Inn; motel...	Class 43: Restaurant...; hotel; motel...



4. A case related to the trademark “旺旺”

Whether the trademark is well-known enough to be entitled to the protection against likelihood of dilution of the reputation

Decision No.	Civil Judgement of the Intellectual Property Court, 2020 Min Shang Shang Zi No. 9
Date	October 22, 2020
Issue	Is the protective scope varying among well-known trademarks due to different levels of fame?
Relevant statutes	Articles 30.1.11 and Subparagraph 2 of Article 70 of the Trademark Act
Decision Highlight	<p>1. The expression “likelihood of dilution of the distinctiveness of well-known trademarks” refers to the likelihood that the distinctiveness of well-known trademarks may be diminished. That is to say, originally, the use of a well-known trademark on certain goods or services is capable to create the association with a single source; nevertheless, when the capability of the trademark to indicate the single source is gradually reduced or dispersed by unauthorized use made by third parties, it is highly possible that the trademark will become the one that indicates two or more sources, which is not capable to leave the sole association and unique impression in the mind of the public. The expression “likelihood of dilution of the reputation of well-known trademarks” refers to the likelihood that the reputation of a well-known trademark may be tarnished. For example, the creation of a disparaging or negative association in the mind of the consumers regarding the quality and reputation of a well-known trademark due to unauthorized use made by third parties. When determining whether there is any likelihood of dilution of the distinctiveness or reputation of well-known trademarks, following factors shall be considered:</p> <p>(1) The extent to which the trademark is well-known:</p>

	<p>If a trademark enjoys a higher level of fame, there is higher possibility that the distinctiveness and reputation of the trademark is going to be diluted.</p> <p>(2) The degree of similarity between trademarks:</p> <p>With respect to the degree of similarity, a higher degree is required to determine there is likelihood of dilution comparing with the determination of likelihood of confusion. When two trademarks are not identical with each other and the degree of similarity is not high, it is comparatively difficult to establish there is likelihood that the distinctiveness or reputation of the well-known trademark at issue is going to be diluted.</p> <p>(3) The extent to which the trademark is widely used in connection with other goods/services:</p> <p>If a trademark has been widely used by third parties in connection with different goods/services, the extent of exclusive use of the trademark is relatively low. The distinctiveness or reputation of such a trademark is less likely to be diluted.</p> <p>(4) The level of inherent or acquired distinctiveness of the well-known trademark:</p> <p>It may be true that the distinctiveness of a trademark is associated with the level of fame the trademark enjoys, but the creativity embodied in the trademark is also an important factor to identify its distinctiveness. Accordingly, the object of the protection against trademark dilution is trademarks that enjoy a higher level of distinctiveness and fame, and it is easier for coined trademarks to achieve such a level of distinctiveness and fame.</p> <p>(5) Other factors to be considered.</p> <p>2. As to the provision of the latter part of Article 30.1.11 related to dilution of well-known trademarks, it shall be interpreted as meaning that the fame of such well-known trademarks shall attain the level that it is widely</p>
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	<p>recognized by not just the “relevant public” but the “general public”, which is different from the interpretation of the fore part of the same subparagraph related to likelihood of confusion that only requires it is widely recognized by the “relevant public”. (Referring to Judgment of the Supreme Administrative Court, 2018 Pan Zi No. 446). According to the legal doctrine that the same term has the same connotation, the interpretation related to dilution mentioned above shall be applied to disputes of trademark infringement as well. Therefore, the well-known trademarks protected by subparagraph 2 of Article 70 of the Trademark Act, regarding conducts deemed to be trademark infringement due to the fact that these conducts may dilute the distinctiveness or reputation of well-known trademarks, shall be limited to those with a high level of fame that are widely known by the “general public”.</p>
Keywords	Well-known trademarks, dilution

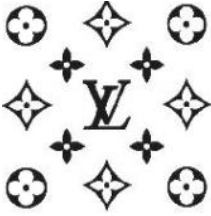

Cited trademark 1	Cited trademark 2
Registered No. 01174816	Registered No. 01515970
	
Classes 1, 2, 5, 6, 7, 8, 9, 10, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 26, 29, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45	Class 35: Advertising planning, design, production, agency and dissemination, and distribution of promotional product...

5. A case related to the trademark “LV”

A parody of the trademark

Decision No.	Civil Judgement of the Intellectual Property Court, 2019 Min Shang Shang Zi No. 5
Date	January 16, 2020
Issue	The determination of the parody defense related to trademark infringement
Relevant statutes	Articles 5, 36.1.1, and 68 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none">1. Ridicule or jokes are closely related to the language, culture, social background, life experience, history and other factors of a country. Even if locals can understand the literal meaning of jokes common to foreigners, they may not be able to appreciate them. When it comes to the content and elements of humor in ridicule or jokes, sometimes, the listener must go through a certain process of reasoning and thinking to figure out the punchline. As to the question whether a trademark is going to cause likelihood of confusion among relevant consumers, the result often depends on whether relevant consumers are going to have the impression that the trademark is identical with or related to other sources of goods or services according to their immediate reaction at the moment they see the trademark (without much reasoning and thinking). In the MOB case of the United States, the court pointed out the criteria for a parody defense to be sustainable which included the alleged parody must be able to “clearly indicate that it is not connected in any way with the original” and “allow the consumers to immediately perceive that it is a parody”.2. Under the realm of our Trademark Act, the one who raises the fair use defense on the basis of parody may depend on two kinds of argument:

	<p>(1) The trademark is only used to express a parodic speech rather than indicate the source of the goods or services. Accordingly, it does not constitute the “use of a trademark”, not to mention trademark infringement.</p> <p>(2) If the first argument is not sustained by the court, the user can still argue that there is no infringement of the trademark rights because the use of the trademark is not going to cause any likelihood of confusion among relevant consumers.</p> <p>However, if the use of another person’s trademark is detrimental to the most important function of the trademark which is to identify the source of the goods or services, such use cannot be immune from trademark infringement on the excuse of the parody.</p>
Keywords	Parody, trademark infringement

Trademarks at issue	
Registered No. 01552668 and 01592692	
	<p>Classes 4, 8, 9, 12, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 34: Sunglasses...; jewelry...; printed matter...; handbags...; mirrors...; clothes... and some other goods.</p>
Registered No. 01155372	
	<p>Class 9: Eyeglasses; sunglasses and eyeglass cases. Class 14: Jewelry; rings... Class 18: Leather and artificial leather; travelling bags... Class 25: Clothes and underwear; sweaters; shirts...</p>

Registered No. 00831283



Class 18: Cases of leather or leather board...

Registered No. 00843926



Class 18: Cases of leather or leather board...

Registered No. 01182808



Class 9: Eyeglasses; sunglasses and eyeglass cases.
Class 14: Jewelry, including rings...
Class 18: Leather and artificial leather; travelling bags...
Class 25: Clothes and underwear, including sweaters...

The attached tables of the judgement



(一) 系爭氣墊粉餅



(二) 系爭帆布袋



(三) 系爭手拿鏡



6. A case related to the trademark “瑪麗蓮”

Keyword advertising and the determination of trademark infringement

Decision No.	Civil Judgement of the Intellectual Property Court, 2018 Min Shang Su Zi No. 41
Date	August 31, 2020
Issue	<ol style="list-style-type: none"> 1. The determination of whether using another person’s trademark to be the keyword for keyword advertising or the title of the advertisement constitutes the “use of a trademark”. 2. The determination of whether publishing the advertisement whose title consists of another person’s trademark constitutes a conduct of unfair competition stipulated in Article 25 of the Fair Trade Act.
Relevant statutes	Articles 5 and 68 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none"> 1. The defendant’s conduct of using the trademark at issue “瑪麗蓮(Marilyn)” to be the keyword of a “bring-out” type of keyword advertising is an internal conduct of linking program instruction. It is an internal intangible use rather than an external tangible use, which is not enough to make consumers recognize it as a trademark. Accordingly, it does not constitute the “use of a trademark”. The plaintiff argues that, according to the so-called “initial interest confusion”, the advertisement shown after using the trademark at issue as the keyword to perform the search may cause confusion, misleading relevant consumers to erroneously believe that the website address is owned by the plaintiff. Nevertheless, once the consumers click on the website address and enter into it, they will clearly notice that the owner of the website is another person (namely, the defendant “company A”) because the trademark at issue is not used

	<p>in the website and the owner of the website has identified the name of its own company or other distinctive signs in the website. Therefore, relevant consumers will not erroneously believe that the website is owned by the plaintiff, not to mention the likelihood of confusion caused by erroneously believing that the goods or services on the advertiser’s website originate from the plaintiff. The so-called “initial interest confusion” does not fall into the scope of “likelihood of confusion” stipulated in Article 68 of the Trademark Act.</p> <p>2. The defendant “company B” used the keyword insertion function provided by the advertising platform to its advertisement at issue and the content of the advertisement shown on the search results page did contain the keyword “瑪麗蓮” juxtaposed with the term “維娜斯(Venus)”, enabling relevant consumers to recognize that “瑪麗蓮” is a trademark and click on the link to the official website owned by defendant A. Obviously, defendant B intended to actively promote defendant A’s shapewear and other goods or services on the internet through aforementioned attempts, which was different from the “bring-out” type of keyword advertising mentioned above because it was not just an internal intangible use that simply triggered the search through the use of keywords. As a result, defendant B’s conducts certainly belong to the “use of a trademark”.</p> <p>3. If a business purchases the keyword consisting of the name or brand of another business, its online advertisements and the link to its website will be shown on the search results page once the keyword is used by consumers to perform the search online even if the content of the keyword is not related to itself or the goods or services that it expects to provide. In addition to that, if the said business also uses controversial wordings concerning the keyword to lead consumers entering its website and browsing the content for the sake of promoting its own goods or services, it is taking</p>
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	<p>advantage of the hard efforts of another business to secure the trading opportunities, i.e. extracting economic benefits and achievements included in the commercial reputation of another business. This kind of conducts is not only culpable from the perspective of business ethics, but also detrimental to the order of fair competition in the market, which shall fall into the scope of the conducts of unfair competition stipulated in Article 25 of the Fair Trade Act.</p>
Keywords	Keyword advertising, unfair competition


Trademarks at issue	
<h1>瑪麗蓮</h1>	Registered No. 01596983
	Class 25: Brassieres; underwear...
	Registered No. 01592205
	Class 35: Advertising planning; advertising design...; online shopping...

7. A case related to the trademark “德可立爾”

Selling goods without maintaining their original packaging and a defense to trademark infringement

Decision No.	Criminal Judgement of the Intellectual Property Court, 2018 Xing Zhi Shang Su Zi No. 44
Date	February 21, 2019
Issue	The application of Article 36.2 of the Trademark Act regarding the defense of exhaustion of trademark rights
Relevant statutes	Articles 36.2 and 95 of the Trademark Act
Decision Highlight	<ol style="list-style-type: none"> 1. The offense of illegal sale of trademark-infringing goods stipulated in Article 97 of the Trademark Act targets the goods on which counterfeit trademarks are used. If the trademarks were legally attached to the goods for sale, the quality is the same as the identical goods sold by the proprietor of the trademark rights, and there is no likelihood of causing confusion and deception among relevant consumers, the commercial reputation of the proprietor of the trademark rights and the interest of consumers are not going to be damaged. Moreover, the distribution of this kind of goods can function to prevent the proprietor of the trademark rights from monopolizing the market or controlling the prices of the goods, promote price competition, and provide more options of identical goods for consumers. By doing so, consumers can enjoy the benefits of free competition, which is not contrary to the purpose of the Trademark Act. 2. In contrast, if the goods for sale have been processed, reformed, or changed without consent, i.e. the goods are not sold with their original packaging, or the result of displaying and disseminating advertisements and some other documents, in relation to the goods on which the

	<p>trademark has been attached, is likely to make consumers feel confused and erroneously believe that the goods are promoted by the proprietor of the trademark rights or its authorized users, appointed commercial agents or dealers, these kinds of conducts belong to using another person's trademark in bad faith. Since the intent to infringe another person's trademark rights is obvious according to the circumstances of the specific case, criminal provisions of the Trademark Act shall be applied to penalize those conducts (Criminal Judgement of the Supreme Court, 1993 Tai Shang Zi No. 5380).</p> <p>3. In this case, the defendant bought packaged drugs from the Taiwan company A and opened their original packaging to repackage them in smaller quantities. The defendant also asked a contract manufacturer, who didn't know aforementioned conducts done by the defendant, to produce packing boxes with the name of company A and its trademark on them, which is enough to make consumers to erroneously believe that the packaging of the drugs sold by the defendant is the original one accomplished by company A and cause likelihood of confusion. Accordingly, the defense of exhaustion of the trademark rights cannot be sustained.</p>
<p>Keywords</p>	<p>Exhaustion, likelihood of confusion</p>

<p>Trademark at issue</p>	
<p>Registered No. 01519170</p>	
	<p>Class 5: Western medicine.</p>