ASIAN PATENT ATTORNEYS ASSOCIATION

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SPECIAL TOPIC REPORT- TAIWAN GROUP

Title: "Protection of Product Shapes/Configurations"

Following the Chairpersons' instruction email dated 26 May 2026, this Report will address a particular concern regarding the protection of product shapes/configurations: "right holders often face a gap in protection: after a product has been launched and it begins to achieve commercial success, counterfeit products may emerge at a point when the novelty required for design protection has already been lost, while the level of recognition necessary for trademark protection has not yet been established. In light of this reality, it is proposed that the Committee examines what anti-counterfeiting measures may be available in each jurisdiction under these circumstances."

In particular, this Report will answer the following six questions:

1. Whether such product shapes/configurations are protected under copyright law, unfair competition laws and/or passing-off doctrines;
2. Whether such product shapes/configurations are enforceable on the grounds of (i) copyright infringement, and/or (ii) unfair competition and/or passing off, through administrative, civil, or criminal actions;
3. Whether there are any precedents concerning the matters described in item 2 above;
4. Whether and how customs authorities and e commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations;
5. What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialized in this manner; and
6. Whether there may be difficulties even in enforcing trademark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations assuming that right holder can obtain these rights.

1. In Taiwan, product shapes/configurations are protected under the Copyright Act and Fair Trade Act apart from the Patent Act and the Trademark Act, if certain prerequisites are met.

(1) Copyright Act

In Taiwan, a product shape/configuration may be protected under the Copyright Act if it qualifies as an "artistic craftwork" falling within the category of "artistic work."[1] However, whether a work constitutes an artistic craftwork is determined by courts on a case-by-case basis,[2] especially since Taiwan abolished its copyright registration system in 1998. The fact that a work has been granted a design patent, received a foreign design award, or been registered for copyright in a foreign jurisdiction does not replace the court's case-by-case determination.[3]

Although it is difficult to identify from court decisions any consistent pattern as to what types of works the courts tend to recognize as artistic craftworks, judges usually consider the following factors in determining whether a work qualifies as an artistic craftwork and how wide the range of protection it should have:

a. The work must possess a minimum degree of originality and show a certain level of artistic skill or craftsmanship.[4]
b. The merger doctrine: where an idea or concept can be expressed in only one or a very limited number of ways, those limited forms of expression are not protected under copyright law.[5]
c. A shape/configuration that performs a utilitarian function and for which there is no alternative design, or for which alternative designs exist only at substantial additional cost to achieve the same function, is less likely to be protected under copyright law, although it may potentially be protected under the Fair Trade Act.[6]
d. Where a useful article is protected by copyright, the scope of protection does not extend to the functional features of the useful article.[7]
e. Where an artistic craftwork combines public-domain and original elements,

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[1] See Article 5.1.4 of the Copyright Act along with the Examples of Works under Article 5.1 of the Copyright Act, issued by the Taiwan IP Office.
[2] *Standard Foods Corp. v. Top Greats Biotech Co., Ltd.*, 101 Min-Gong-Shang 6, IPC Court (Oct. 2013); 103 Tai-Shang 1554, Taiwan's Supreme Court (July 2014) (upholding the IPC Court's decision).
[3] See: *KJC Communications v. Wei Lang Tech. Co., Ltd.*, 108 Min-Zhu-Shang 5, IPC Court (Mar. 2020); *Jiin Ming Indus. Co., Ltd. v. Onbi Baby Int'l Inc.*, 110 Min-Zhu-Shang-Yi 6, IPC Court (Mar. 2022).
[4] Ibid. See also: *Wu v. Robinmay Co., Ltd.*, 110 Min-Zhu-Su 115, IPC Court (Jan. 2022).
[5] *KJC Communications v. Wei Lang Tech. Co., Ltd.*, 108 Min-Zhu-Shang 5, IPC Court (Mar. 2020).
[6] *Céline Société Anonyme v. 2R Int'l Co., Ltd.*, 107 Min-Zhu-Shang 15, IPC Court (October 2019).
[7] *Yang v. Liverage Biomedical Inc.*, 107 Min-Zhuan-Su 54, IPC Court (May 2019).

copyright protection does not extend to similar elements derived primarily from the public domain.[8]

Since the 2010s, courts have rarely relied on two notions that were once highly influential in the early 1990s: namely, that an artistic craftwork must be a *single work*, and that an item produced by means of molds or machinery in quantities for mass production is an industrial product rather than an artistic craftwork.[9] These views are minority views now.

Nevertheless, we should not assume too readily that, under the courts' current case-by-case approach, the shape/configuration samples given by the Chairpersons would have a significant higher chance of qualifying as copyrightable works. In fact, given the factors discussed above, a conservative assessment may be warranted for many of the examples. Indeed, as will be discussed in Question 3, the IP & Commercial Court (hereafter the **IPC Court**) held in 2019 that three (if not three series of) Céline and Givenchy handbag designs were not copyrightable, even though it upheld Céline's claim under the Fair Trade Act in the same decision.[10]

(2) Fair Trade Act

a. Article 22—"symbol commonly known to the public"

Product shapes/configurations can be protected under the Fair Trade Act if they qualify as a "symbol commonly known to the public" (a.k.a. a "famous symbol"). Article 22.1 of the Act stipulates:

> No enterprise shall have any of the following acts with respect to the goods or services it supplies:
> (1) using in the same or similar manner in the same or similar category of

[8] See: *Ching Chee Enter. Co., Ltd. v. HoCheng Design Co., Ltd.*, 107 Min-Zhu-Shang 3, IPC Court (Feb. 2019); *Cirocomm Tech. Corp. v. Jiakang Tech. Corp.*, 113 Min-Zhuan-Shang 2, IPC Court (Nov. 2024).

[9] TIPO Explanatory Note No. Tai-81-Nei-Zhu 8124412 (Nov. 1992).
In 1997, TIPO issued another explanatory note that substantially modified the 1992 Explanatory Note. While moving away from the strict requirement of a "single work," it continued to maintain a presumption that works produced entirely through molds or mechanical processes do not qualify for copyright protection. TIPO Explanatory Note No. Tai-86-Nei-Zhu 8605535 (Apr. 1997).
Readers may notice a conceptual affinity between these opinions and the concerns of philosopher Walter Benjamin in his 1935 essay, "The Work of Art in the Age of Mechanical Reproduction." Both attach significance to the uniqueness and non-reproducibility of an artistic work.

[10] *Céline Société Anonyme v. 2R Int'l Co., Ltd.*, 107 Min-Zhu-Shang 15, IPC Court (October 2019). The decision was later upheld by the Supreme Court: 109 Tai-Shang 3129, Taiwan's Supreme Court (Apr. 2021).

merchandize, the personal name, business or corporate name, or trademark of another, or *container, packaging, or appearance of another's goods*, *or any other* ***symbol*** *that represents such person's goods,* ***commonly known to the public***, so as to *cause confusion* with such person's goods; or selling, transporting, exporting, or importing goods bearing such representation; or

(2) using in the same or similar manner in the same or similar category of services, the personal name, business or corporate name, or service mark of another, or *any other* ***symbol*** *that represents such person's business or services,* ***commonly known to the public***, so as to cause confusion with the facilities or activities of the business or service of such person. (Italics and highlights added.)

However, it should be noted that, under Article 22.2 of the same act, such symbols are not protected under the Fair Trade Act if they have already received trademark registration in Taiwan. This limitation was introduced in 2015, along with the requirement that the symbol be "commonly known to the public."

While the term "**symbol**" is not defined in the Fair Trade Act, the Supreme Court has stated that a symbol refers to "a characteristic that is distinctive or has acquired a secondary meaning, thereby able to indicate the source of goods or services and enable relevant enterprises or consumers to distinguish between different goods or services."[11] In practice, this concept partially overlap with what are known in other jurisdictions as unregistered trademarks, unregistered designs, and trade dress protection.

When a symbol is used together with a famous trademark, the Supreme Court has emphasized that the symbol's distinctiveness should be assessed independently through a "hypothetical removal" test: whether, if the famous trademark were removed, the relevant traders and consumers could identify the source of the goods solely on the basis of the symbol and rely on it in making their purchasing decisions.[12]

As for the requirement of being "**commonly known to the public**," the Supreme Court has indicated that the following factors should be considered: (1) the amount of advertising devoted to the symbol; (2) the length of time the symbol has been marketed, as well as sales volume and market share; (3) whether the symbol has been extensively reported in the media to an extent sufficient to create an impression of the symbol

[11] *Chang Chi Co., Ltd. v. Decathlon S.A.*, 95 Tai-Shang 1964, Taiwan's Supreme Court (Sep. 2006). See also *JINYAO Int'l Trade Co., Ltd. v. RIMOWA GmbH*, 110 Tai-Shang 3161, Taiwan's Supreme Court (Feb. 2022).

[12] *WEEY Co., Ltd. RIMOWA GmbH*, 109 Tai-Shang 2726, Taiwan's Supreme Court (Sept. 2021). *RIMOWA GmbH v. KGT Int'l Corp.*, 109 Tai-Shang 2369, Taiwan's Supreme Court (Dec. 2020).

among relevant enterprises or consumers; (4) the quality of the goods or services bearing the symbol; (5) the reputation and fair, objective market survey data; and (6) the views of the competent authorities.[13]

As to the requirement of "**causing confusion**," the Supreme Court has held that it refers to a situation where "there is a concrete risk of confusion when ordinary consumers exercise an average degree of attention and memory."[14] Further, the IPC Court has held that the scope of protection afforded to a famous symbol is not static, but varies with consumer recognition and market conditions. Where similar designs have become prevalent in the market, particularly in the case of simple and commonly used designs, protection should be limited to cases involving identical or highly similar designs so as not to unduly restrict fair competition.[15]

As such, the protection of product shapes/configurations under Article 22 of the Fair Trade Act is, if anything, even more case-specific than the protection under the Copyright Act. Broadly speaking, court decisions recognizing product shapes/configurations as famous symbols have been rare over the past decade.

b. Article 25—"Imitation to a Substantial Degree"

Further, Article 25, the Fair Trade Act's supplemental catch-all provision, provides that "in addition to what is provided for in this Act, no enterprise shall otherwise have any deceptive or obviously unfair conduct that is able to affect trading order."

Under Point 9 of the *Fair Trade Commission Disposal Directions (Guidelines) on the Application of Article 25 of the Fair Trade Act*:

> "**Imitation to a Substantial Degree** can Seek Civil Remedy. If an enterprise is injured by other enterprise's imitation to a substantial degree and Article 22 of the Fair Trade Act is no applicable because it does not meet the criteria as set forth in Article 22, such enterprise can still seek resolution through civil remedy under relevant provisions of the Fair Trade Act." (Emphasis added.)

Thus, as also shown in the judgments to be discussed in Question 3, even if Article 22 does not apply (e.g. because the shape/configuration does not constitute a famous

[13] *Chang Chi Co., Ltd. v. Decathlon S.A.*, 95 Tai-Shang 1964, Taiwan's Supreme Court (Sep. 2006).
[14] *JINYAO Int'l Trade Co., Ltd. v. RIMOWA GmbH*, 110 Tai-Shang 3161, Taiwan's Supreme Court (Feb. 2022).
[15] *WEEY Co., Ltd. v. RIMOWA GmbH*, 110 Min-Gong-Shang-Geng(1) 5, IPC Court (June 2022).

symbol), the defendant's conduct might still be caught by Article 25 if it involves *a substantial degree of imitating* a shape/configuration in a manner that seeks to free-ride on another party's efforts and achievements and thus affect the trading order.

It can be seen from decisions of Taiwan's Supreme Court that, in determining whether a conduct constitutes "**imitation to a substantial degree**," courts generally consider the following factors: (a) whether the copied appearance is "identical" or "highly similar"; (b) whether the conduct confers on the alleged copier a competitive advantage or benefit that is disproportionate to the labor and costs that the copier has invested; (c) whether the copied appearance gives the product a distinctive competitive feature and market position; and (d) whether, as a result of the copying, consumers or other transaction counterparties are likely to mistakenly believe that the two products originate from the same or related sources, belong to the same product series, or are otherwise affiliated.[16] As such, a high degree of similarity in appearance, standing alone, does not necessarily constitute "imitation to a substantial degree." Factor (c) has played an increasingly important role in cases since 2010, as shown by some examples in Question 3.

In addition, the Supreme Administrative Court has held that courts should examine the overall appearance of the product in the test of "imitation to a substantial degree;" in other words, the analysis should not be fragmented by separately examining individual aspects of the product.[17]

Moreover, since the 2010s, courts have attached higher importance to the requirement that the conduct be "**deceptive or obviously unfair and capable of affecting the order of trade**." In *Queena v. L'Hotel De Chine*, the Supreme Court held that Article 25 does not apply where the conduct involves no deception or obvious unfairness, causes no harm to effective competition in the market, or is otherwise insufficient to affect the order of trade (even though the products at issue may be similar in appearance.)[18] As such, courts might consider additional factors such as (1) whether the actor has engaged in conduct showing an affirmative intent to free-ride on or capitalize on another's reputation or market success; (2) whether the actor has actively deceived consumers or, by passively concealing material transaction information, created a likelihood of misleading them; and (3) whether the allocation of benefits or risks between the parties

[16] See: *TW Racing Parts Inc. Hung*, Taiwan's Supreme Court, 111 Tai-Shang 2080 (Dec. 2022); *Vita-Mix Corp. v. SHIVN FENG Enter. Co., Ltd.*, 101 Tai-Shang 993, Taiwan's Supreme Court (July 2012).
[17] *Magic Amah Household (Taiwan) Co., Ltd. v. FTC*, 94 Pan 2032, Supreme Administrative Court (Dec. 2005).
[18] *Queena Xiyue Hotel Co., Ltd. V. L'Hotel De Chine Corp.*, 109 Tai-Shang 2725, Taiwan's Supreme Court (Jan. 2021).

is obviously imbalanced.[19]

Judging from the court decisions, as will be discussed in Question 3, an Article 25 claim is more likely to prevail than an Article 22 claim, even though the examination of Article 25 claims is no less fact-intensive and highly dependent on the specific circumstances of each case.

2. In Taiwan, product shapes/configurations can be enforceable on the grounds of (i) copyright infringement, and/or (ii) unfair competition and/or passing off, through legal actions.

(1) Copyright Act

Copyright infringement gives rise to both criminal and civil liabilities in Taiwan. As for administrative actions, complaints may be filed under the customs procedures, which we will discuss in Question 4. However, the Taiwan IP Office (**TIPO**) does not have the authority to investigate and sanction copyright infringement.

Given the greater deterrent effect of criminal liability, copyright owners frequently resort to **criminal enforcement**. Under Articles 91(1) and 91-1(1) of the Copyright Act, infringement of the right of reproduction or the right of distribution is punishable by up to three years' imprisonment, although fines are more commonly imposed in practice. Infringement of an author's moral rights is also a criminal offense, but carries a lighter penalty of up to two years' imprisonment.[20]

In view of a juristic person's duty to supervise its employees, Article 101.1 of the Copyright Act provides that, where the representative of a juristic person, or the agent, employee, or other servant of a juristic or natural person, commits the offenses in the performance of his or her duties, the juristic or natural person shall, in addition to the punishment imposed on the infringer under the relevant provisions, also be subject to a fine as prescribed therein.

Criminal offenses arising from copyright infringement involving an artistic craftwork are, in principle, prosecuted only upon complaint. A complaint may be withdrawn at any time before the conclusion of the trial at the court of first instance, in which case the withdrawal terminates the entire criminal proceeding. Therefore, copyright owners

[19] Ibid, suggested by the Supreme Court in a dictum.
[20] Article 93. In practice, however, punishment for moral right infringement is generally absorbed where the same conduct also infringes economic rights.

often use the withdrawal of a complaint as a bargaining chip in negotiations with infringers.[21]

The Copyright Act provides a relatively broad range of **civil remedies** compared with other areas of IP law, including:

a. Demand removal of infringement or prevention of infringement where there is likelihood of infringement (Art. 84).
b. Damages, which may be calculated by the lost profit or the infringer's profit. Where actual damages are difficult to prove, plaintiffs may request the court to award statutory damages of NT$10,000 to NT$1 million. For willful and serious infringement, the maximum may be increased to NT$5 million (Art. 88).
c. Moral right infringement can also lead to a damages claim, as well as a demand for appropriate measures necessary for the restoration of its reputation (Art.85).
d. Request for destruction or other necessary disposition of goods produced as a result of the infringing act, or of articles used predominantly for the commission of infringing acts (Art. 88-1).
e. Request publication of all or part of a judgment in a newspaper or magazine at the cost of the violating party (Art. 89).

(2) Fair Trade Act

Violation of the Fair Trade Act is subject to administrative investigation by the Fair Trade Commission (**FTC**), either upon complaint or *ex officio*, and may result in monetary penalties. However, since February 6, 2015, FTC's investigation does not extend to Article 22 violations, such as copying another party's product shape/configuration that have been used as a famous symbol.[22] As for copying conduct that does not fall under Article 22 but may constitute an Article 25 violation, the FTC's general position is that such conduct are to be addressed also by civil actions.[23]

As such, **civil remedies** for violations of Article 22 or Article 25 of the Fair Trade Act are currently the primary means of enforcement. Compared with those available under the Copyright Act, these remedies are more limited and include:

a. Demand removal of infringement or prevention of infringement where there is likelihood of infringement (Art. 29).

[21] This makes empirical research on artistic craftworks particularly difficult: many criminal cases do not result in an indictment or adjudication because the complaints are withdrawn following settlement, even though the defendants may in fact have committed copyright infringement.
[22] https://www.ftc.gov.tw/internet/main/doc/docDetail.aspx?uid=1210&docid=14019&mid=1201
[23] See: Point 9 of the *Fair Trade Commission Disposal Directions (Guidelines) on the Application of Article 25 of the Fair Trade Act.*

b. Damages, which may be calculated based on lost profits or the infringer's profits (Arts. 30 & 31.2). For willful and serious infringement, the damages may be increased to up to three times the amount of the actual damages (Art. 31.1).
c. Request of publication of the judgment in a newspaper or magazine at the cost of the violating party (Art. 33).

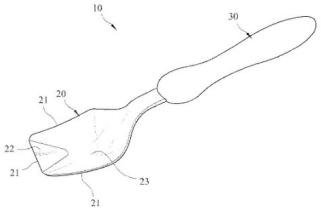
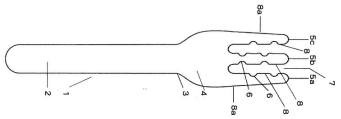
3. Precedents about the protection of product shapes/configurations through legal actions under the Copyright Act and Fair Trade Act in Taiwan

(1) Copyright Act

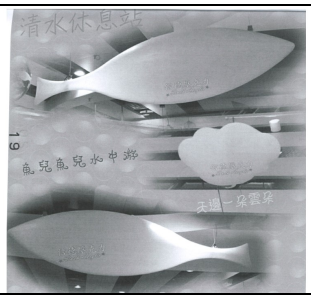
Summarized in the table below are the IPC Court's decisions over the past decade concerning product shapes/configurations claimed to constitute artistic craftworks that are particularly relevant to our topic. It can be seen that obtaining copyright protection for shapes/configurations *and* prevailing in infringement litigation is not easy.

Plaintiff's work[24]	Copyrightable?	Defendant's work	Infringing?
A tote bag featuring eight metal zippers as decorative elements, characterized by curved lines formed by zippers of varying lengths.[25]	**Yes**.		Found to be substantially similar. **But** the CEO of the infringing company was found not to have involved in the design.
A sky-lantern-shaped cup [26]  [27]	**Yes**.	 [28]	**No**, lacking substantial similarity due to "different overall impression."

[24] Unless otherwise indicated, the images in the table are sourced from court decisions.
[25] *Taiwan High Court Prosecutors' Office v. En-Suey Int'l Garment Co., Ltd.*, 103 Xing-Zhi-Shang-Su 54, IPC Court (Jan. 2015); 104 Tai-Shang 1575, Taiwan's Supreme Court (June 2015). Note this was a criminal action and the main defendant was the CEO of the defendant company.
[26] *Excellence Collection Ceramic Co. v. Taiwan Tobacco & Liquor Corp.*, 104 Min-Zhu-Su 65, IPC Court (May 2016). Sky lanterns are traditional Taiwanese paper lanterns that are typically made of a lightweight paper shell with a small fuel source suspended underneath. When the fuel is lit, the heated air inside the lantern causes it to rise and float into the sky.
[27] Image source: the copyright holder's website: https://www.excera.com.tw/en/products/node/1451458591000/
[28] Image source: https://www.p9.com.tw/forum/forumtopic.aspx?id=386770

Cellphone case[29]	**Yes**		**Yes**; plaintiff passed the access and the substantial similarity tests.
Céline bag[30] 	**No**, due to the functionality test.		But it constituted Fair Trade Act violation; *see below*.
 JP Design 3176583  JP Design 3158497	**No**, especially in view of a similar prior JP patent.[31]	 	* Plaintiff's Fair Trade Act claims (Arts. 22 & 25) were also dismissed.
Acrylic works[32] 	**No**, "The fish-shaped and lotus-shaped products merely present the basic shapes conventionally associated with such objects and lack	Plaintiff only gathered photos of the defendant's acrylic works.	

[29] *ALTO Co., Ltd. v. PTowKing Co.*, Ltd., 106 Min-Zhu-Su 36, IPC Court (May 2018).
[30] *Céline Société Anonyme v. 2R Int'l Co., Ltd.*, 107 Min-Zhu-Shang 15, IPC Court (October 2019).
[31] *KJC Communications v. Wei Lang Technology Co., Ltd.*, 108 Min-Zhu-Shang 5, IPC Court (Mar. 2020). KJC is a Japanese company. Their fork and spoon designs also obtained copyright registration in the US Copyright Office. The IPC Court held that foreign registrations and patents do not, in themselves, guarantee the copyrightability of a work.
[32] *Liu v. HwaSheng Acrylic Co., Ltd.*, 110 Min-Zhu-Shang-Yi 5, IPC Court (Dec. 2021).

	aesthetic appeal.”		

(2) Fair Trade Act

a. Article 22—“symbol commonly known to the public” (“famous symbol”)

Only a limited number of court decisions have found that the shapes/configurations of products constitute a “symbol commonly known to the public.” We will therefore discuss only the representative case: RIMOWA’s “pleated grooves design” applied on suitcases.

Since the mid-2010s, RIMOWA brought a series of civil lawsuits in Taiwan against quite a number of suitcases manufacturers/sellers, based on the said design which was identified as consisting of “multiple parallel grooves roughly one inch wide extending along the surface of the suitcase, multiple parallel ridges between the grooves, and differences in brightness and reflection of the ridges and grooves.” The IPC Court has maintained a largely consistent view across these cases, holding that the above features constitute a “symbol commonly known to the public.” Of course, this does not mean that the defendants’ suitcase in every case ultimately passed the similarity and confusion test and was found to infringe.



The RIMOWA’s “pleated” suitcase design[33]

[33] *RIMOWA GmbH v. Chao*, 104 Min-Gong-Su 9, IPC Court (Sept. 2016).

The following are two suitcases that the IPC Court found violating the Fair Trade Act:


[34]

Examples of suitcases that the IPC Court found *not* violating the Fair Trade Act:



[35]


[36]


[37]

The IPC Court's main reasons for finding that the "pleated grooves design" constitutes a famous symbol include: (1) its long-standing and continuous use since 1950; (2) substantial sales and advertising expenditures; (3) its registration as a trademark in jurisdictions including the US, the EU, and Germany, supporting its distinctiveness; (4) decisions by courts in Korea and Germany recognizing the design as a famous symbol;

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[34] *RIMOWA GmbH v. Chao*, 104 Min-Gong-Su 9, IPC Court (Sept. 2016); 109 Tai-Shang 10, Taiwan's Supreme Court (Nov. 2020); 110 Min-Gong-Shang-Geng(1) 1, IPC Court (June 2022). This case was settled in March 2023 during the second appellate proceeding at the Supreme Court.

[35] *RIMOWA GmbH v. WEEY Co., Ltd.*, 105 Min-Gong-Su 3, IPC Court (Sept. 2018); 109 Tai-Shang 2726, Taiwan's Supreme Court (Sept. 2021); 110 Min-Gong-Shang-Geng(1) 5, IPC Court (June 2022).

[36] Ibid.

[37] Ibid.

and (5) the design features have remained consistently present and have not been diluted by other companies offering luggage with similar appearances.

However, in every appeal to the Supreme Court arising from these cases, the Supreme Court vacated and remanded the IPC Court's decision, holding that the IPC Court's reasoning was inadequate because it had failed to assess the design's distinctiveness independently through the above-mentioned "hypothetical removal" test. The Supreme Court also emphasized that, with respect to the "causing confusion" requirement, the concrete-risk test should be applied, particularly given the apparent differences in price, sales channels, and target customers between the RIMOWA suitcases and those of the defendants.[38]

Interestingly, in its decisions on remand, the IPC Court, after conducting the "hypothetical removal" test, still affirmed that the "pleated grooves design" constitutes a famous symbol. The IPC Court further found that RIMOWA had suffered from "post-sale confusion," which it held should likewise fall within the scope of conduct prohibited under Article 22 of the Fair Trade Act.[39] Some of these decisions were further appealed to the Supreme Court for a second review, but all of the appeals were ultimately settled by around 2023, leaving us without an opportunity to know the Supreme Court's position on these issues.

Particularly, it remains unclear whether the Supreme Court considered the IPC Court's application of the "hypothetical removal" test to be well-founded. This question is of particular importance in Article 22 cases, because a product shape/configuration is rarely marketed on its own without a trademark, making it difficult to determine which contributes more in identifying the product source and influencing the consumer's purchasing decisions. If the "hypothetical removal" test is applied strictly, it will be even more difficult for a product shape/configuration to qualify as a famous symbol.

All in all, the path to protection for shapes/configurations under Article 22 remains fraught with challenges, although the IPC Court has indeed begun to take positive steps.

b. Article 25—"Imitation to a Substantial Degree"

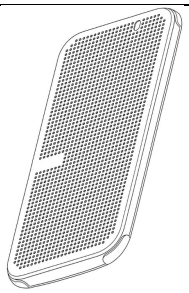
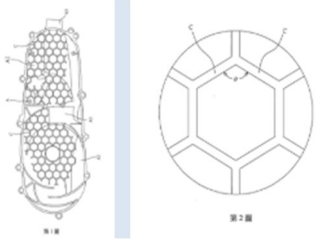
[38] *JINYAO Int'l Trade Co., Ltd. v. RIMOWA GmbH*, 110 Tai-Shang 3161, Taiwan's Supreme Court (Feb. 2022). *WEEY Co., Ltd. RIMOWA GmbH*, 109 Tai-Shang 2726, Taiwan's Supreme Court (Sept. 2021). *RIMOWA GmbH v. KGT Int'l Corp.*, 109 Tai-Shang 2369, Taiwan's Supreme Court (Dec. 2020). *Chao v. RIMOWA RmbH*, 109 Tai-Shang 10, Taiwan's Supreme Court (Nov. 2020).

[39] "Post-sale confusion" refers to a situation in which potential consumers who see the defendant's product may mistake it for the genuine product and, as a result, perceive the quality of the genuine product to be inferior and refrain from purchasing it.

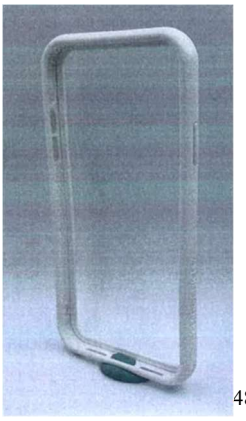
In the table below, we have selected several representative cases since the 2010s in which the plaintiffs asserted the Article 25 claims. Among them, *Céline v. 2R* will be discussed in greater detail afterwards.

Plaintiff's product[40]	Defendant's product	Court holdings: violating Article 25?
 (cream bottle)[41]	Almost identical in terms of bottle shape, label, and the wording on the label, according to the judgment.	**Yes**. The parties' bottles were identical, and the English wording, font size, and colors on the labels were nearly identical, including the same wording and grammatical errors, constituting imitation to a substantial degree.
 (juice blenders)[42]		**No**. The plaintiff failed to prove that the asserted appearance possessed any particularly **distinctive or unique features**, nor could it establish that relevant consumers had become widely familiar with the product appearance. **The mere similarity between the appearances of the parties' products was insufficient by itself to establish imitation to a substantial degree**. Moreover, the trademarks used on the parties' products are different enough to enable consumers to distinguish between them, such that there is no likelihood of source confusion.

[40] All images in the table are sourced from court decisions.
[41] *Dah Chuan Int'l Co., Ltd. v. Great Aroma Int'l Co., Ltd.*, 99 Min-Gong-Su 6, IPC Court (June 2011).
[42] *Chen Ping Business Co., Ltd. v. Vita-Mix Corp.*, 100 Min-Gong-Shang 1, IPC Court (Nov. 2011); 101 Tai-Shang 289, Taiwan's Supreme Court (Mar. 2012).

 43		**No**. Similar rationale to that in the previous case (the juice blender case). Notably, the defendant's other shoes products were found infringing the device trademark (Reg. 01070672) of plaintiff (Camper S.L.) 
 (cell-phone case)[44]		**Yes**. The plaintiff established that no identical or similar products were on the market prior to the introduction of its product, thereby proving **its distinctive competitive features**. The plaintiff also won a design patent claim; for more details, see Question 6.
 (scooter engine cover)[45]		**No**. **Mere imitation of a product appearance to a substantial degree does not necessarily constitute unfair competition absent proof of free-riding on another's efforts**. The plaintiff failed to prove that its design had a **distinctive competitive feature**. Moreover, the similarity in design could well have resulted from the need to accommodate the engine's structure. Meanwhile, the plaintiff's utility model (M485184) claim was also dismissed due to non-infringement.

[43] *Camper S.L. v. A-Chi Int'l Co., Ltd.*, 102 Min-Shang-Shang 14, Taiwan IP Court (2014); 105 Tai-Shang 927, Taiwan's Supreme Court (June. 2016).
[44] *HTC v. Shiang-Yu Phone Cover Expert Co., Ltd.*, 104 Min-Zhuan-Su 17, Taiwan IP Court (2017).
[45] *Gizmo Plastics Tech. Inc. v. China Ocean Enter. Co., Ltd.*, 106 Min-Zhuan-Su 104, IPC Court (Oct. 2018).

 46		**Yes**. For a detailed discussion, see below (the Céline case).
 (mouth wash bottle)[47]		**No**. The parties' products differed significantly in shape, and the defendant's product bore its own trademark and product name. The labels and color schemes also differed, making consumer confusion unlikely and **causing no adverse impact on competition**. Notably, the plaintiff's design patent (D174865) claim was also dismissed due to non-infringement.
 48		**Yes**. In addition to the substantial similarity, the plaintiff proved that the defendant launched a similar product shortly after the plaintiff's launch, indicating an intent to free-ride, and that this caused **actual consumer confusion**. Accordingly, the court found that the defendant's conduct disrupted the trading order.

As the above cases show, in Article 25 cases involving claims of product shape/configuration copying, the IPC Court has increasingly emphasized whether the plaintiff's shape/configuration has a distinctive competitive feature and whether the defendant's copying adversely affects the trading order. A mere showing of high degree of imitation does not warrant a favorable finding under Article 25.

[46] *Céline Société Anonyme v. 2R Int'l Co., Ltd.*, 107 Min-Zhu-Shang 15, IPC Court (October 2019).
[47] *Shallop Int'l Co., Ltd. v. Galien Indus. Co., Ltd.*, 111 Min-Zhuan-Shang 43, IPC Court (June 2023).
[48] *Evolutive Labs Co., Ltd. v. Devilcase Co., Ltd.*, 110-Min-Gong-Su 9, IPC Court (June 2023); 112 Min-Gong-Shang 2, IPC Court (May 2024) (appellate decision).

Céline v. 2R

Among the above cases, the Céline bag case is particularly noteworthy, not only because it involved a well-known brand and a famous design, but also because the court addressed both the Fair Trade Act claims and the Copyright Act claim.[49]

There were actually two separate plaintiffs in this case: Céline and Givenchy. Their Article 25 claims, based on the theory of imitation to a substantial degree, were upheld by the IP Court, which awarded NT$6 million in damages and injunctive relief. The decision was later affirmed by the Supreme Court in 2021.[50]



Céline Luggage (left); Givenchy Pandora (middle); and Givenchy Antigona (right).[51]



The defendant's bag products.

However, the IPC Court did not find Céline's and Givenchy's copyright claims persuasive, holding that the bag designs did not qualify as copyrighted works since they were primarily functional and therefore lacked the requisite artistic quality of an artistic craftwork. The judge panel stated: "Apart from enhancing the perceived quality and texture of the product, so as to attract the eyes of relevant consumers and stimulate their desire to buy, the overall shape and design [of the bags] are for the primary purpose of facilitating effectively the portability and [other inherent] functions of bag-shaped appliances, rather than to convey a thought or feeling with artistic skills."

[49] *Céline Société Anonyme v. 2R Int'l Co., Ltd.*, 107 Min-Zhu-Shang 15, IPC Court (October 2019).
[50] 109 Tai-Shang 3129, Taiwan's Supreme Court (Apr. 2021).
[51] Photo source: the IPC Court decision; same below.

The judge panel did not find that the bags qualified as a "symbol commonly known to the public" under Article 22 of the Fair Trade Act, either. Its main reasons included: (1) the lack of market surveys in Taiwan proving that the bags were commonly known; (2) the relatively limited amount of advertising on these bags in Taiwan; (3) the lack of specific sales figures in Taiwan, or, the figures fluctuated significantly from year to year; (4) the fact that online media coverage was not necessarily objective or impartial; and (5) the inability of social-media metrics, such as views and follower numbers, to substantiate the *duration of marketing activities, sales volume, or market share* in Taiwan. This holding, together with the copyright holding, was upheld by the Supreme Court.

4. Actions of customs authorities and e-commerce platforms against counterfeiting involving such product shapes/configurations

(1) Taiwan Customs Administration (TCA)

In our report for the 2025 Kuala Lumpur Annual Meeting, we summarized Taiwan's customs border anti-counterfeiting regime (hereinafter the "border measures"). Concerning border measures against counterfeits infringing copyright, the relevant legal framework consists of the **Copyright Act** and regulations promulgated by the Customs Administration.

As noted in our 2025 Report, copyright holders may use the Customs-Port-Trade Single Window to pursue both pre-emptive recordation and incident-based enforcement. For pre-emptive recordation, the applicant is required to provide a written description enabling Customs officers to distinguish genuine goods from infringing goods. The Customs Administration also recommends submitting photos or catalogues of genuine products, counterfeits, or side-by-side comparisons. On its website, Customs even provides examples of effective descriptions, such as stating that "the nose of the genuine product is round, whereas that of the counterfeit is triangular," apparently referring to counterfeit dolls or similar products.

However, the *Operational Directions for Customs Authorities in Implementing Measures for Protecting the Rights and Interests of Patent and Copyright (2014)* state that copyright protection at the border is "primarily on the ground of complaints." This suggests that, in real practice, copyright enforcement based on pre-emptive recordation with Customs is less commonly seen than trademark enforcement at Customs. On the

other hand, incident-based enforcement of artistic craftwork copyright is also uncommon, as it generally depends on detailed pre-investigation or reliable intelligence regarding a particular shipment.[52]

Although the **Fair Trade Act** itself does not provide for customs border measures, border seizure of counterfeit products incorporating shapes/configurations based on the Fair Trade Act may nevertheless be available, as Article 29 of the Act permits an injured party to seek preventive relief where infringement is likely to occur, similar to the remedies available under the Trademark Act and Patent Act, including a preliminary injunction under the Code of Civil Procedure that may be enforced by Customs.

A well-known example of Taiwan Customs' protection of product shapes/configurations involved an anti-counterfeiting campaign of the Japanese company Sanrio at the turn of 2000. At that time, Customs notified Sanrio on at least five occasions of the seizure of imported counterfeit *Hello Kitty* cat dolls, with the total number of seized items reaching 125,960 units. These seizures enabled Sanrio to petition the court for provisional protective measures. The court subsequently upheld Sanrio's claims under Taiwan's Trademark Act and Fair Trade Act, recognizing that the six distinctive features of the *Hello Kitty* cat dolls had acquired the status of a famous symbol protected under the Fair Trade Act. The court also affirmed that the scope of Sanrio's "Hello Kitty & Device" trademark rights extended to the three-dimensional embodiment doll of the mark. Notably, Taiwan's Trademark Act did not recognize three-dimensional marks as registrable subject matter until 2003.[53]

(2) <u>E-commerce platforms</u>

In our report for the 2019 Taipei Annual Meeting, we discussed the limitation of liability provisions for Internet service providers (ISPs) under Taiwan's Copyright Act, with one of the key topics being the notice-and-takedown procedure. According to TIPO's own words, this procedure is designed "to promptly eliminate infringement through the ISP's cooperation in removing infringing content and to prevent the expansion of

[52] This may explain why the Taiwan Customs Administration (TCA), between 2023 and 2024, reported no inbound copyright infringement cases (although some cases may instead have been classified under the more readily identifiable trademark infringement categories where the same goods also infringed trademark rights.) Instead, statistics indicate that most copyright enforcement actions against imported goods are carried out by the police after the goods have entered Taiwan. See our Country Report for the 2025 Annual Meeting in Kuala Lumpur.

[53] *Sanrio Co., Ltd. v. You Chia Co., Ltd.*, 88 Su 1226, Taiwan Shihlin District Court (July 2001); 90 Shang 1032, Taiwan High Court (Nov. 2002). Sanrio's trademark involved in this dispute was Reg. 00124953 "Hello Kitty and Device".

damages."[54] Since 2019, the provisions of the Copyright Act concerning the notice-and-takedown procedure have remained unchanged. Instead of repeating the details of the notice-and-takedown procedure, we would like to highlight several points relevant to the present discussion.

First, e-commerce platforms generally retain considerable discretion regarding the format and formal requirements of notices. Some provide online forms for submitting complaints, while others require formal notices to be sent by email or even in writing. Some platforms may also require complainants to submit separate notices when multiple types of rights are asserted simultaneously (e.g., trademark and copyright) or when multiple rights are involved (e.g., several trademark registrations).

Second, all major e-commerce platforms provide information on their websites regarding IP protection measures and complaint procedures. With respect to the types of IP rights covered, such information generally includes patents, trademarks, and copyrights, but does not mention violations of the Fair Trade Act.

Third, in view of the above, for counterfeit cases involving product shapes/configurations that constitute violation of the Fair Trade Act, the more appropriate approach would be for an attorney to directly send a notice to the platform asserting the relevant legal claims (at a minimum, requesting removal of the listings).[55] In addition, where such cases also involve copyright infringement, given that Taiwan abolished its copyright registration system since 1998, an effective approach would likewise be to have an attorney issue a letter, so as to provide more comprehensive supporting materials, such as URLs identifying the location of the copyrighted works, original images, or other evidence establishing the claimant's ownership of the copyright.

Fourth, the anonymity of online infringers on e-commerce platforms presents an additional challenge to anti-counterfeiting enforcement. This obstacle, however, is possible to be overcome through the investigative powers and resources available to law enforcement authorities, particularly those of the well-known *IP Rights Investigation Corps (IPRIC) of the National Police Agency* (also known as the "IP Protection Police").

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[54] See: https://www.tipo.gov.tw/tw/copyright/768-4914.html.

[55] Requests for disclosure of the identity of infringers are usually denied by platforms on the grounds of compliance with personal data protection laws.

For example, in an enforcement action involving counterfeit figurines of the famous Japanese character "Doraemon," the IPRIC purchased a counterfeit Doraemon figurine from an anonymous seller account on the e-commerce platform "Yahoo Taiwan Auction." This purchase enabled the IPRIC to obtain evidence proving that the defendant had imported the counterfeit figurines from Mainland China and resold them in Taiwan.[56] Although the relevant investigation records are not publicly available, it is very likely that, during the investigation, the IPRIC exercised its authority under Article 133 of the Taiwan Code of Criminal Procedure to request Yahoo Taiwan Auction (whose operator is a Taiwan entity) to disclose the seller's personal information, including IP address.

While the said Doraemon case involved trademark rights only, similar anti-counterfeiting actions based on copyright should also be feasible, since copyright infringement also gives rise to criminal liability.

5. Legal strategies to protect shapes/configurations once the product has already been commercialized in this manner

(1) Choosing among claims and enforcement actions

As the above discussion shows, a "famous symbol" claim under Article 22 of the Fair Trade Act may be relatively difficult to establish, whereas copyright claims and claims of "imitation to a substantial degree" under Article 25 of the Fair Trade Act are comparatively more straightforward.

On the other hand, criminal liability for copyright and trademark infringement requires proof of intent, resulting in a higher evidentiary burden than in civil proceedings. Moreover, given the seriousness of criminal liability, prosecutors and judges may also tend to take a more cautious approach. Therefore, based on experience, pursuing copyright claims and Article 25 claims under the Fair Trade Act through civil proceedings is generally more efficient for protecting shapes/configurations where the product has already been commercialized but a three-dimensional trademark has not yet been registered.

(2) Warning letter

[56] *Taiwan Pingtung District Prosecutors Office v. Huang*, 105 Zhi-Yi 5, Taiwan Pingtung District Court (Apr. 2017). A more recent example is *Taiwan Yunlin District Prosecutors Office v. Wu*, 110 Zhi-Yi 3, Taiwan Yunlin District Court (May 2021).

Sending a warning letter before formally initiating legal action is also a strategy worth considering. As for notification strategies involving e-commerce platforms, these were discussed in the previous question and will not be repeated here.

One important caveat, however, is that the FTC imposes restrictions on warning letters. Before sending a warning letter to "one's own or another enterprise's trading counterparts or potential trading counterparts" alleging that another enterprise has infringed IP rights, the right holder must first comply with certain preliminary procedures; otherwise, the issuance of the warning letter may itself constitute a violation of the Fair Trade Act. Notably, one of the preliminary procedures is to "notify the allegedly infringing manufacturer, importer, or agent, and requesting that the infringement cease, either before or simultaneously with the issuance of the warning letter." However, this notification requirement may be dispensed with where the right holder "has exercised all reasonably possible due diligence to provide such notification, where notification is objectively impossible, or where there is concrete evidence that the party to be notified is already aware of the infringement dispute."[57]

(3) Preparing evidence

As discussed above, claims under the Copyright Act and the Fair Trade Act (particularly the latter) are subject to relatively intensive, case-specific and contextual examination by the courts. As such, the collection and preservation of evidence are important both before and throughout the enforcement process.

Against this background, we draw below, particularly from the actual cases discussed above, some practical observations concerning the preparation and preservation of evidence.

a. **The design-development records** for the product/configuration should be properly preserved. If the right holder can prove that the final design was selected from among multiple design alternatives based on aesthetic considerations, this may help counter defenses based on the merger doctrine or the utilitarian-function doctrine in litigation.

[57] See: *Fair Trade Commission Disposal Directions (Guidelines) on the Reviewing of Cases Involving Enterprises Issuing Warning Letters for Infringement on Copyright, Trademark, and Patent Rights*; available at https://www.ftc.gov.tw/internet/english/doc/docDetail.aspx?uid=746&docid=2715.

b. **Evidence showing consumer awareness of the shape/configuration**. If the product is promoted in a manner that consistently emphasizes its aesthetic characteristics and, where appropriate, its distinctive features, then evidence generated through such promotional efforts may help strengthen copyright and Fair Trade Act claims when enforcement becomes necessary. As noted above, a "famous symbol" protected under the Fair Trade Act must either be distinctive or have acquired secondary meaning. In cases involving "imitation to a substantial degree," proving the product's distinctive competitive features may likewise improve the likelihood of success.

   The RIMOWA cases suggest that, where a product shape/configuration is used together with a trademark, especially a well-known trademark, the right holder may consider devoting some efforts to building consumer awareness of the shape/configuration *itself*. This is particularly relevant when addressing the hypothetical-removal test that the court may apply. It may also be worth giving the shape/configuration an appropriate Chinese name to help establish and reinforce consumer recognition. If the name itself first acquires distinctiveness or secondary meaning, it may also be registered as a word mark, thereby helping to strengthen the source-identifying power of the shape/configuration. Further, when a dispute arises, a market survey should be considered, as suggested by the Céline case.

   Needless to say, evidence showing that the product shape/configuration has acquired distinctiveness among the Taiwanese public, or at least among the relevant consumers, would also help support registration of the shape/configuration as a three-dimensional trademark.

c. **Evidence of actual confusion and intent to free-ride**. As noted above, in recent Article 25 cases under the Fair Trade Act, courts have considered whether the defendant's conduct was "deceptive or obviously unfair and capable of affecting the order of trade." As suggested by *Queena v. L'Hotel De Chine*, the court may consider, among other factors, (1) whether the actor has engaged in conduct showing an affirmative intent to free-ride on or capitalize on another's reputation or market success; and (2) whether the actor has actively deceived consumers or, by passively concealing material transaction information, created a likelihood of misleading them. In the second cellphone court decision mentioned in Question 3 (*Evolutive Labs Co., Ltd. v. Devilcase Co., Ltd.*), one of the important reasons for finding an Article 25 violation was exactly the occurrence of actual consumer confusion.

Some types of evidence may have a relatively narrow window of opportunity for collection. For instance, factual confusion caused by promotional activities intended to free-ride at a particular time or place (like a trade show), may be difficult to establish after the event. In some cases, evidence-gathering must even begin at the stage when the relevant IP rights are being created. Needless to say, all these require right holders to have a relatively high level of awareness of IP management and strategic planning.

6. Whether there may be difficulties even in enforcing trademark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations assuming that right holder can obtain these rights?

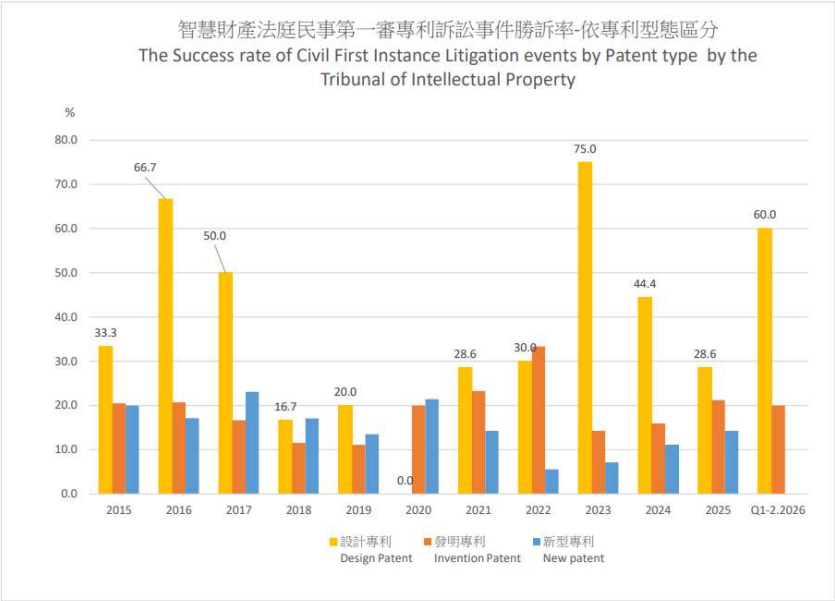
Over the years, Taiwan's courts have developed a body of case law, showing that enforcing a registered three-dimensional trademark or a design patent against the imitation of product shapes/configurations generally does not present any unusual difficulties. We have selected several representative cases for discussion.

(1) Design patents

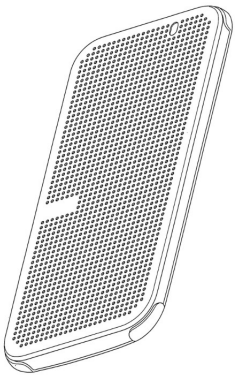
Design protection in Taiwan is governed by the Patent Act. Since design patents are granted only after substantive examination in Taiwan, they generally offer greater certainty and are more effective to enforce than especially utility model patents, which are not substantively examined before grant.

Statistics by the IPC Court show the effectiveness of design patent enforcement. In civil litigation before the Court (the vast majority of which consists of infringement actions), design patents have usually achieved higher success rates than both invention patents and utility model patents. For instance, the success rate for design patent holders reached 75% in 2023, and reached 60% during the first half of 2026.[58]

[58] Sourced from Taiwan's IP & Commercial Court (https://ipc.judicial.gov.tw/en/dl-62169-cfaac33012b34366884808b67e42eacf.html)



Under the Taiwan Patent Act, in cases of willful infringement, the court may, upon the request of plaintiff, increase the damages awarded up to three times the amount.[59] The courts have generally been considered relatively favorable toward design patent owners in this regard. For example, in *HTC v. Shiang-Yu Phone Cover Expert Co., Ltd.*, where the design at issue concerned a protective phone case with a set of holes, HTC, a Taiwanese mobile phone brand owner, was awarded treble damages for both its design patent claim and its Article 25 claim under the Fair Trade Act, the latter addressing the defendant's dead copying that started before the grant of the design patent. In addition to the damages award, the IPC Court also granted injunctive relief including the destruction of the infringing products as well as the tooling and molds used for manufacturing such products.[60]

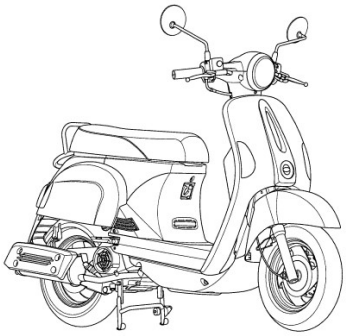


TW Design Patent D162739

[59] Article 97.2 of the Patent Act. Damages may be calculated based on the lost profits of the patent owner, the profits obtained by the infringer, or reasonable royalties (Article 97.1 of the Patent Act).
[60] *HTC v. Shiang-Yu Phone Cover Expert Co., Ltd.*, 104 Min-Zhuan-Su 17, Taiwan IP Court (Mar. 2017).

In litigation involving other issues, the IPC Court has likewise shown an inclination to explore ways to enhance the protection afforded to designs. For example, in *Kwang Yang v. Sheng Hsiang*, the Court held that "the creator's perspective," rather than "the consumer's perspective," should be the preferred standard of review when determining whether the accused product is similar to the patented design.[61] In this case, the product to which the plaintiff's design was applied was a scooter, whereas the accused product was an electric scooter. The Court not only awarded Kwang Yang, a famed Taiwanese scooter brand, damages of NT$5 million, but also sanctioned the defendant's failure to comply with the Court's disclosure orders by deeming the damages amount to be as claimed by the plaintiff.

Although the "consumer's perspective" approach (an approach closer to the standard commonly applied in trademark infringement analysis) remains the prevailing view of the Court, the legal exploration reflected in *Kwang Yang* is nevertheless noteworthy. Moreover, this approach may have further potential for development in addressing issues concerning cross-boundary protection between physical product designs and designs in the metaverse.



TW Design Patent D130968 "Scooter"



Defendant's e-scooter

(2) Registered three-dimensional trademarks

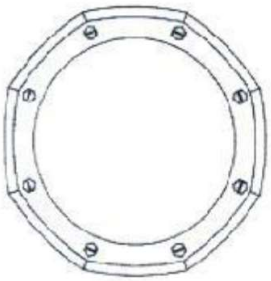
Since the 2003 amendment to the Taiwan Trademark Act, three-dimensional marks became eligible for trademark registration in Taiwan. As of the end of July 2026, according to the public database of the Taiwan IP Office, there were 849 valid registered three-dimensional trademarks and 151 pending applications. These figures indicate that a considerable number of applicants are still striving to persuade the TIPO that their three-dimensional marks satisfy the registrability requirements, particularly the distinctiveness requirement.[62]

[61] *Kwang Yang Motor Co., Ltd. v. Sheng Hsiang Electric Scooter Co., Ltd.*, 105 Min-Zhuan-Su 62, Taiwan IP Court (July 2017).

[62] Trademark applicants should note that the TIPO revised its *Examination Guidelines for Non-*

Leaving aside issues relating to the registration of three-dimensional trademarks, once such a mark is successfully registered, its enforcement in Taiwan does not face any significant obstacles compared with that of traditional trademarks, although there are relatively few court decisions on infringement disputes where three-dimensional trademark are involved.[63]

Nevertheless, there are several noteworthy cases. In early 2025, Taiwanese media widely reported on a criminal enforcement action brought by Audemars Piguet against the infringement of its registered three-dimensional trademark (Reg. No. 01330698) covering the octagonal bezel with exposed screws used on its Royal Oak collection.



Audemars Piguet's TW Trademark Reg. 01330698



the seized watches

The defendant was alleged to have sold watches of other brands that had been modified with counterfeit bezels through online platforms and a physical retail store in Taiwan. Following the execution of a search warrant, the police seized counterfeit modified watches and counterfeit bezels with an estimated market value exceeding NT$60 million (reaching USD 2 million).

The police's intention to present the case as a representative example of the protection of three-dimensional trademarks was apparent. To that end, they even prepared a "crime flowchart" (shown below, English translation added) illustrating the infringing scheme and distributed it to the media for use in their coverage.[64]

Traditional Trademarks in 2025, with the revised Guidelines taking effect on August 1 of that year. Under the revised Guidelines, applications for three-dimensional trademarks are required to include a more detailed verbal description of the elements comprising the three-dimensional shape.

[63] One such case is *Camper v. T.B.M.* The IPC Court dismissed the Spanish footwear company Camper's claim based on a three-dimensional trademark, Reg. No. 1507267, covering the shape of the outer sole frame and the bubble pattern. The reason was that the registration postdated the defendant's sale of the shoes in question. Nevertheless, the court upheld Camper's claim of infringement of its traditional trademark. *Camper, S.L. v. T.B.M. Footwear Inc.*, 102 Min-Shang-Shang 14, IPC Court (Dec. 2014). This decision was upheld by the Supreme Court; 105 Tai-Shang-927, Taiwan's Supreme Court (June 2016).

[64] See the TYE News' report dated February 4, 2025 at https://tyenews.com/2025/02/800147/. See also the Liberty Times' report on the same day at



(3) Expanded Protection of Trademark Act

A side point worth noting is that, before Taiwan's Trademark Act recognized three-dimensional marks as registrable subject matter in 2003, Taiwan's courts had developed the principle that converting a two-dimensional trademark into a three-dimensional product could itself constitute trademark infringement. By extending the scope of protection afforded to two-dimensional trademarks, this doctrine has proved effective in combating counterfeit figurines and dolls, as shown by the Hello Kitty case discussed in Question 4.

Notably, the doctrine has continued to be adopted by the courts even after the introduction of three-dimensional trademark registration. For example, in a 2022 decision, the IPC Court held that a batch of pens seized at the port storage area with pen toppers in the shape of the "Sumikko Gurashi" dolls infringed the registered two-dimensional trademark covering the same character.[65]



TW Trademark Reg. 01777443

(END)

https://news.ltn.com.tw/news/society/paper/1629819?utm_source=NEWS&utm_medium=2&utm_campaign=MOREPAGE.

[65] *Liu v. Tang Cai Ltd. Co.*, 111 Xing-Zhi-Shang-Yi 3, IPC Court (Apr. 2022).