

# Wisdom News

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**Wisdom News will bring you the latest patent and trademark trends around East Asia  
(Taiwan, China, Japan, Hong Kong etc.).**

## Taiwan

### **Taiwan Patent Act: Relaxation of Rules Regarding Grace Period**

The Economics Committee of the Legislative Yuan (Taiwan) has passed the Third Reading on partial articles of the Taiwan Patent Act on 30th December, 2016. This amendment is concerning the relaxation of rules on grace period, and the details are as follows:

1. For invention patent and utility model patent, the grace period for non-prejudicial disclosures will change from 6 months to 12 months. (The grace period of design patent continues to be 6 months.)
2. Under the current Patent Act, a grace period is only available when “the invention was publicly disclosed as a result of conducting a test; in a printed publication; displayed at an exhibition held or recognized by the Government; or publicly disclosed without the consent of the applicant”. The proposed amendment of the Patent Act will provide an applicant with a grace period when he/she publicly discloses the invention intentionally or unintentionally.
3. Remove the current regulation that the declaration of grace period for non-prejudicial disclosures must be made on the filing date of patent application. In other words, the declaration is not required when filing the patent application.

Wisdom will keep you updated on any further developments.

(Reference: [Taiwan Intellectual Property Office](#) )

## Japan

### “Medical machines and apparatus”- Similarity of Goods: Japan Intellectual Property High Court: Administrative Litigation (2015 [Gyo-Ke] 10134)

	The Subject Trademark	Cited Mark
Trademark	デュアルスキャン Dual Scan	D u a l S c a n
Designated Goods	Class 9 Body weight scales with body fat measurements; Body weight scales with body composition scales; Body weight scales	Class 10 Body-fat monitors; Body composition scales
Trademark Right Holder	Tanita Corporation	Omron Healthcare Co., Ltd.

#### 【Abstract】

This is a Japanese trademark case of judging the similarities of goods in different classes. The owner of the cited mark “Dual Scan”, Omron Healthcare Co., Ltd. (the Opposer, the Plaintiff) has requested for a trial for invalidation of the trademark “デュアルスキャン Dual Scan” (“the Trademark”) of Tanita Corporation (the Applicant, the Defendant). The Japan Patent Office (JPO) found the designated goods of the Trademark are not similar to that of the cited mark under Article 4, paragraph (1), item (xi) of the Japan Trademark Act and dismissed the request for trial. The Opposer then filed the suit for cancelling the JPO trial decision with the Intellectual Property High Court.

#### 【Core Issue】

The core issue of the High Court trial is whether the designated goods of the Trademark, “Body weight scales with body fat measurements; Body weight scales with body composition scales; Body weight scales” and that of the cited mark, “Body-fat monitors; Body composition scales” are similar and would consumers be confused by the goods.

#### 【Summary of Japan Intellectual Property High Court Judgement】

According to the “Examination Guidelines for Similar Goods and Services”, the marks are presumed

as not similar since they are in different class and similar group codes. The cited mark is in Class 10 “medical machines and apparatus”, and the similar group code is “10D01”; and the Trademark is in Class 9 “surveying apparatus and instruments”, and the similar group code is “10C01”.

However, there is a wide variety of "medical machines and apparatus" and some are easily for consumers to acquire. In the foreseeable future, technological advancements would lead to the production of high-performance products at a much lower price. Together with the change in transaction forms, consumers could conveniently purchase the machines and apparatus used for medical purpose. There is a chance that they will be misled or confused as to the source of goods after using the products. Depending on where the trademark is actually used (e.g. specific state of use), there are cases where it is not appropriate to presume that designated goods are not similar merely because they belong to different classes in the Examination Guidelines for Similar Goods and Services.

**The two trademarks shall be regarded as similar trademarks since they might confuse customers in the following ways:**

1. Weight scales are not limited to clinical use and are also used at schools, corporates and gyms. People who need household body weight scales are consumers and they can easily acquire body scales for medical purposes. Other than medical personnel, school officials and employees of fitness-related companies and human resources departments are also the customers of composition scales and body weight scales for medical purposes.
2. Although medical personnel would pay more attention to the specifications of the scales than the rest of the general public, they are frequently exposed to both the products of the plaintiff and defendant, i.e. products for medical purposes and those for household use. As the two Parties dominate the market for household weight scales, medical personnel may face difficulties in differentiating the source of the products for medical purposes from that of the products for household use.
3. It is difficult for the general consuming public to identify weight scales for medical uses and household uses. Even though the scales for medical uses are more accurate than that of household uses, they have the similar function – determining user's body composition. A non-medical professional could not easily distinguish the difference of “body weight scales with body fat measurements; body weight scales with body composition scales; body weight scales” and “body-fat monitors; body composition scales” in terms of performance.

**Since the two trademarks might be confusingly similar to their consumers, the High Court**

rescinded JPO's decision.

(Article 4, paragraph (1), item (xi) of the Japan Trademark Act: “Notwithstanding the preceding Article, no trademark shall be registered if the trademark is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (referring to goods or services designated in accordance with Article 6(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(1)); the same shall apply hereinafter), or goods or services similar thereto;”)

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