

## REVIEW OF LEGISLATION

### Follow-up questions by the European Communities and their member States

#### Addendum

By means of a communication from the Permanent Delegation of the European Commission, dated 11 October 2002, the Secretariat has received a copy of the following follow-up questions that the European Communities and their member States have communicated to the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu. These questions supplement those posed by the European Communities and their member States in document IP/C/W/367.

#### CHINESE TAIPEI

##### A. TRADEMARKS AND GEOGRAPHICAL INDICATIONS

1. Under Chinese Taipei Trademark Law geographical indications (GIs) are protected as "certification marks" under Article 73 of the Trademark Law. Article 16 TRIPS forbids the use of identical or similar marks for identical or similar goods or services only when this results in a likelihood of confusion. We figure out that certification marks are subject to the same protection that is granted to ordinary trademarks. Hence under Chinese Taipei Trademark Law, the protection of a certification mark, which contains or is composed of a GI, is subject to the test of likelihood of confusion. Please explain how this is compatible with Article 23.1 TRIPS which does not make the protection of a GI dependant of the likelihood of confusion test. Indeed, Article 23.1 TRIPS forbids the use of translations or the use of "kind", "type", "style", "imitation" as such, without any test of confusion.

2. Subparagraph 6, Article 37 and Article 52 of the Trademark Law is in line with Article 22.3 TRIPS in that a trademark application shall be refused or invalidated when it contains or consists of a GI that is likely to mislead the public. Article 23.2 TRIPS provides in an enlarged protection for wines and spirits. Trademark applications for wines or spirits containing or consisting of GIs not having such origin, shall be refused regardless of whether they are misleading or not. Please indicate where the TRIPS provision of Article 23.2 has been implemented in your law.

3. In reply to EC question 12, Chinese Taipei mentions that Subparagraph 7, Article 37 of the Trademark Law is in conformity with Article 16.3 TRIPS. Subparagraph 7, Article 37 states "No application may be filed for registration of a trademark design which is identical or similar to another's famous mark, thus causing the public to confuse or misidentify it". Article 6bis Paris Convention and Article 16.3 TRIPS refer to *liable* to create confusion and *likely* to be damaged.

Please confirm that for the protection granted to well-known mark it is sufficient that confusion is *likely* to occur.

B. COPYRIGHT

4. Please indicate what the criminal prosecution standards are in cases of copyright infringements. What are the thresholds to be reached for initiating criminal investigations? Is there need for "intent of commercial gain" in order to impose criminal actions (which would i.e. allow infringement by government entities)? Please specify whether your Copyright law might be modified in order to include "intent of commercial gain" as a prosecution condition.

C. PROTECTION OF UNDISCLOSED INFORMATION

5. From the Attachment B of Chinese Taipei's replies, we understand that the actual legislation provides that in principle information held or kept by administrative bodies *should be disclosed* unless restrictions apply (one of such restrictions being "trade secrets"). Please indicate whether the Pharmaceutical Affairs Law will be amended so as to specifically exclude certain sensitive materials from disclosure as it is required by Article 39.3 TRIPS? If so, please specify what governmental body will have the discretion to determine which data should be disclosed and which not. Also, please specify which criteria would determine what data can be disclosed or not.

6. In reply to EC question 30 under II it is mentioned that the period of data exclusivity (non-reliance by the marketing authority on the data filed by the first applicant to approve subsequent applications by generic manufacturers) is of seven years. However, Attachment B stipulates that five years after the new drug license is granted, a generic drug applicant needs only to submit bioequivalence data for the marketing authorisation review rather than results from local clinical trial tests of the same standard that were submitted by the original application. Hence, please do confirm that the "data exclusivity period" is limited to five years only.

D. ENFORCEMENT

7. The Tobacco and Alcohol Administration Law (TAAL) and the Regulations governing the Labeling of the Alcoholic Products came in effect on 1 January 2002 (with a transitional period of 18 months for their application). Article 13 of the Regulations stipulate that "where alcohol product is labeled with geographical indication, a certificate of the geographical indication issued by the government of the country of origin or a chamber of commerce authorized by such government shall be submitted for examination by the central competent authority before the alcohol product is declared to custom or released from factory". To that end Chinese Taipei has requested the European Communities to provide a list of names of the government authorities or chambers of commerce in the EU member States which will issue the required certificate. The relevant lists are forthcoming, however please indicate what negative consequences for the EU exporters there would be, should such lists not be timely submitted to the competent authority.

8. The EU industry is particularly concerned by the ineffective enforcement efforts vis-à-vis persistent manufacturing and exportation of pirated software, video games and other optical media (especially compact disc piracies). From the statistics received in Attachment D, it appears that for the year 2001 of the IPR cases received (3,426) only 1,197 were prosecuted. For 2001, of the 1,616 IPR cases where final judgments were rendered only 680 cases lead to a sentence of 6 months or less and no more than 6 cases to a sentence between 2 and 3 years of imprisonment. In view of the figures re. above please indicate whether Chinese Taipei complies with the provision of Article 61 where it is

stated that "remedies available shall include imprisonment and/or monetary fines sufficient to provide a *deterrent*, consistently with the level of penalties applied for crimes of a corresponding gravity" (emphasis added).

---