

The Trademark Threshold

Defining the Limits of Well-Known Marks in Anti-Dilution Cases



An Educational Analysis of Supreme Administrative Court Grand Chamber Ruling 111-Da-1 (October 6, 2022)

Disputed Mark

GIOVANNI VALENTINO

Applicant: GIOVANNI VALENTINO
Reg. No. 01920292
Filed: May 3, 2017
Class 24 (Fabrics, linens, tapestries)

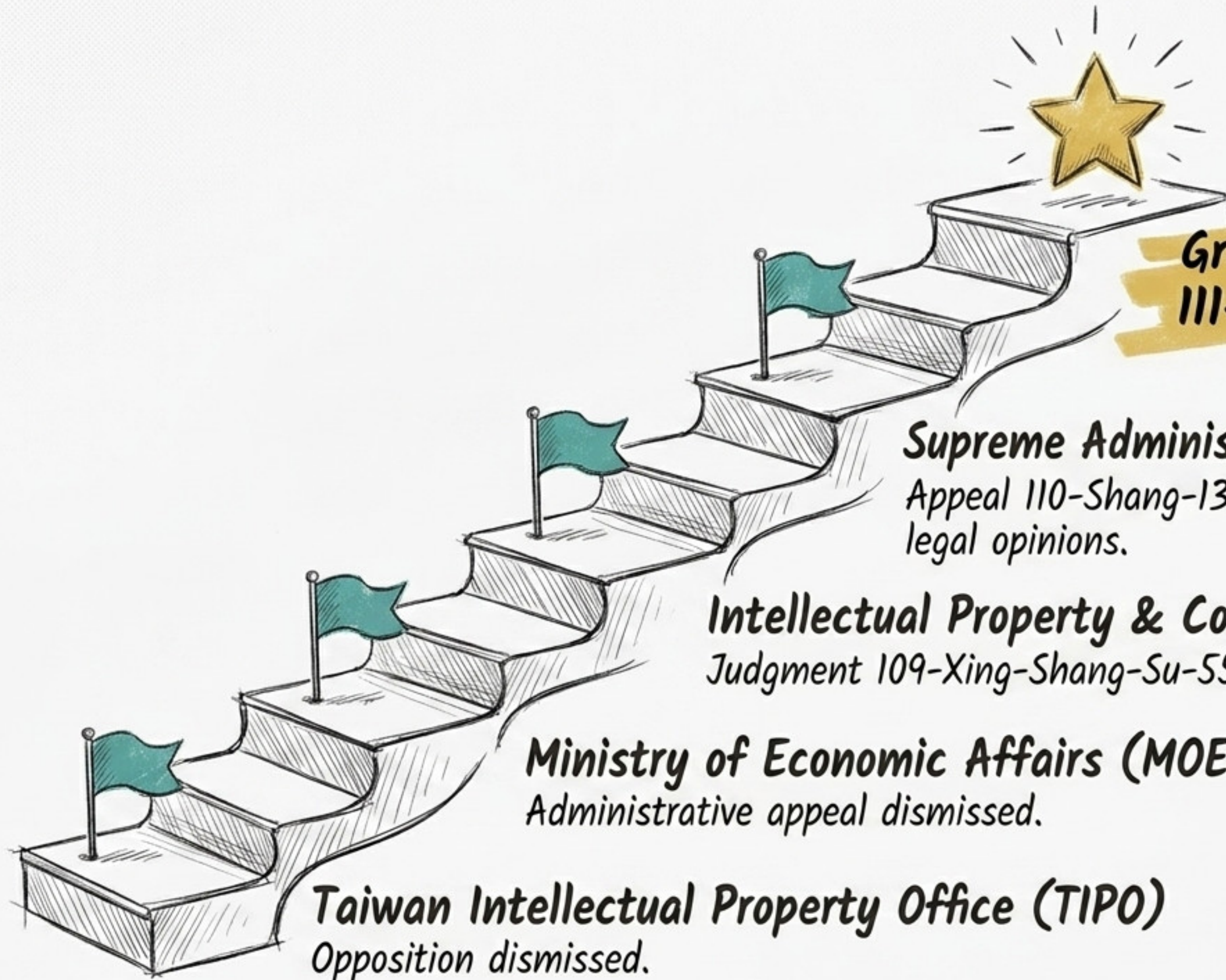


Cited Mark

VALENTINO

Opponent: VALENTINO
(Valentino S.p.A., Italy)

Action: Opposition filed under Trademark Act §30(1)(II).



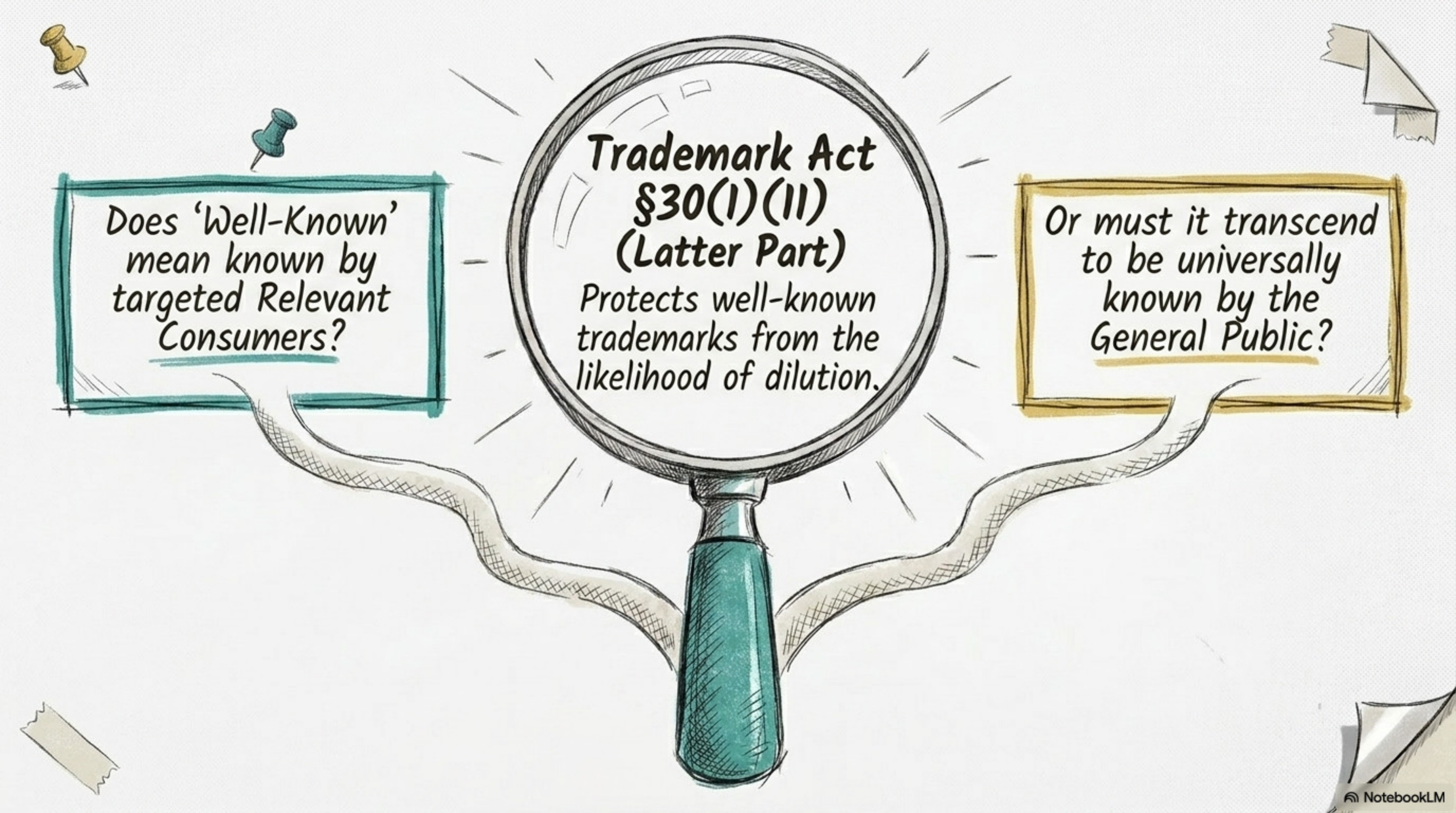
**Grand Chamber Ruling
III-Da-1 (Oct 6, 2022)**

Supreme Administrative Court (4th Chamber)
Appeal 110-Shang-138 identifies a severe split in
legal opinions.

Intellectual Property & Commercial Court
Judgment 109-Xing-Shang-Su-55 (Plaintiff's suit dismissed).

Ministry of Economic Affairs (MOEA)
Administrative appeal dismissed.

Taiwan Intellectual Property Office (TIPO)
Opposition dismissed.



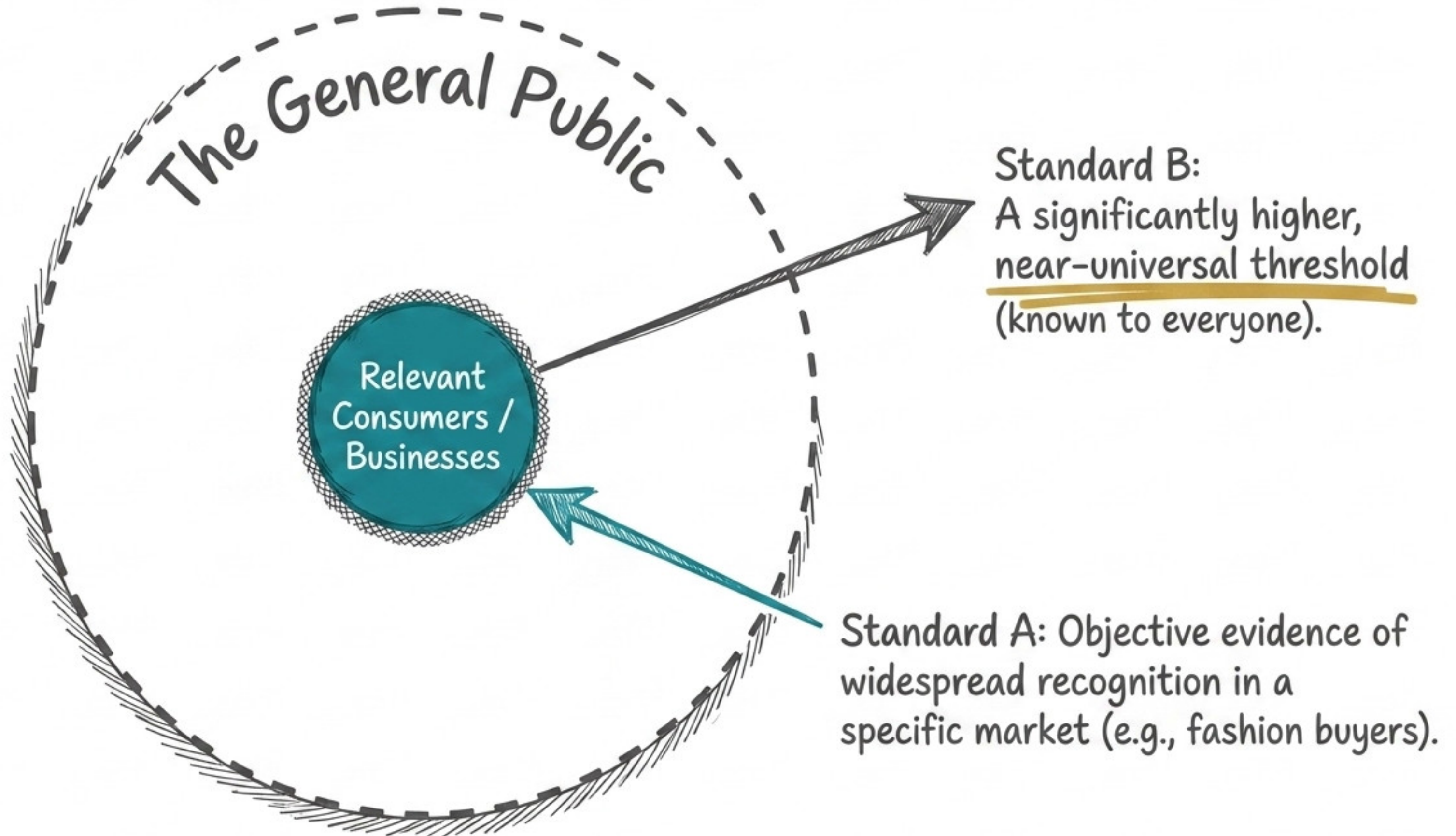
Trademark Act §30(1)(II) (Latter Part)

Protects well-known
trademarks from the
likelihood of dilution.

Does 'Well-Known'
mean known by
targeted Relevant
Consumers?

Or must it transcend
to be universally
known by the
General Public?

Visualizing the Gap: The Burden of Proof



The Grand Chamber's Resolution



A “Well-Known Trademark” under the latter part of Trademark Act §30(1)(II) only requires objective evidence of widespread recognition among relevant businesses or consumers.



It DOES NOT need to reach the level of being universally known by the general public.



Holding:
Ruling
111-Da-1

Pillar I: Statutory Rules



Enforcement Rules §31 explicitly defines 'well-known' as recognized by relevant consumers.

The statute makes zero distinction between the first and latter parts of §30(1)(11).

Pillar II: Legislative Intent



The 2003 amendments introducing anti-dilution provisions never indicated an intent to raise the fame threshold to the 'general public'. Fame must be assessed by the relevant public's perception.

Pillar III: Global Standards



WIPO Joint Recommendation (1999):

Article 2(a)(iii) explicitly states Member States shall not require a mark to be known by the general public.

Article 4(1)(ii) makes the general public standard entirely optional for dilution.

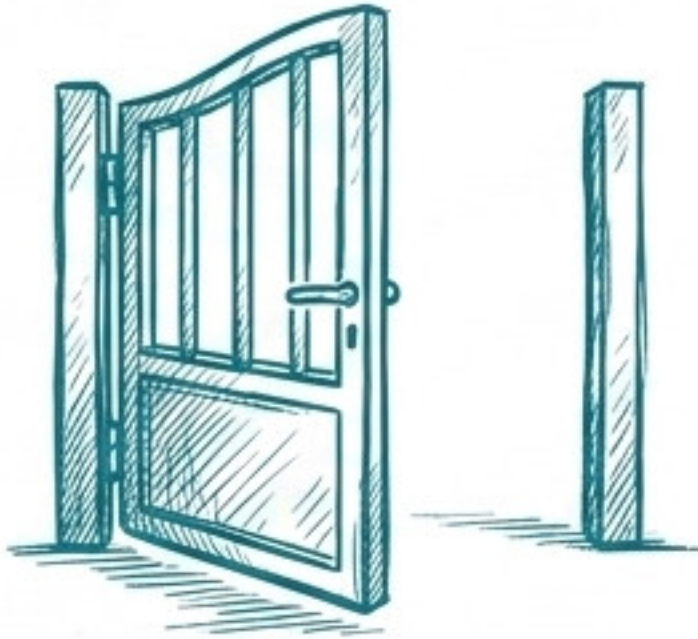
Pillar IV: Systemic Harmony



Administrative and Civil standards must align.
Trademark Act §70(2) (Civil Infringement) uses identical terminology for dilution without elevating the definition of 'well-known'.

The Synthesis Framework: Definition vs. Assessment

The Definition

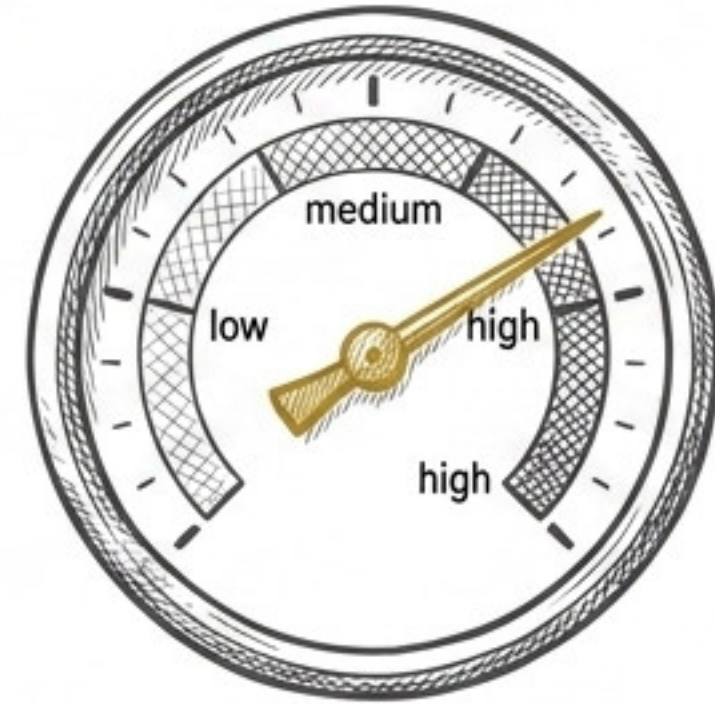


Step 1: The Gateway

Is it a well-known mark?
Yes, if known to relevant consumers.
(A static legal threshold).



The Assessment



Step 2: The Diagnostic

Is there actual likelihood of dilution?
Evaluated dynamically using multiple factors:

- ☒ Degree of fame
- ☒ Similarity of marks
- ☒ Extent of use in other sectors
- ☒ Inherent distinctiveness
- ☒ Intent to associate



Strategic Takeaways & Implications

1. The Universal Standard

Trademark Act §30(1)(11) definitively rejects the "general public" requirement for anti-dilution protection, relying solely on relevant consumers.

2. Global & Local Alignment

Ruling 111-Da-1 seamlessly harmonizes Taiwan's administrative trademark examination with civil infringement standards and WIPO guidelines.

3. The True Battlefield

Legal strategy must shift from debating the definition of a well-known mark to rigorously contesting the multifactor test for actual likelihood of dilution.