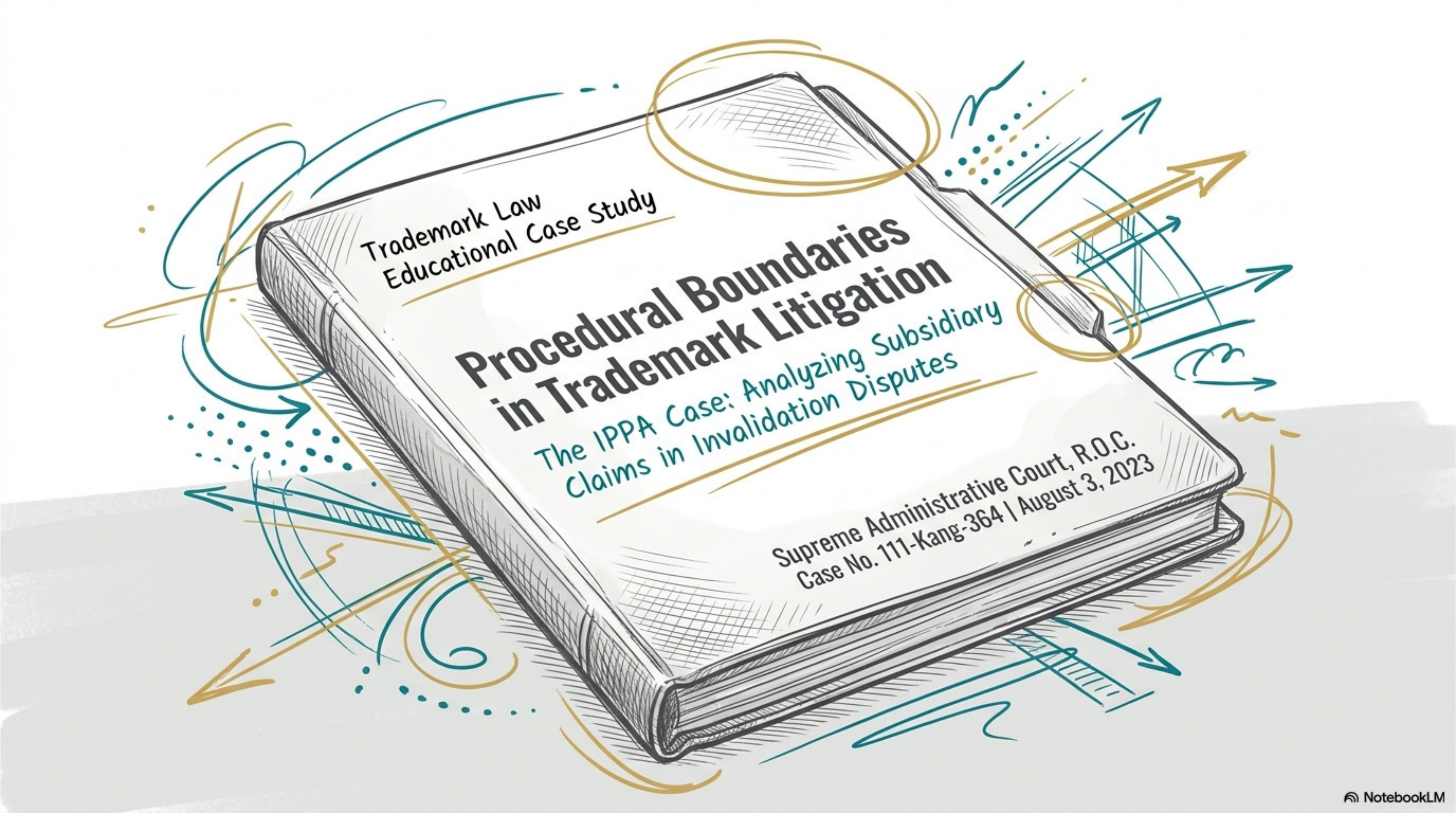




Trademark Law
Educational Case Study

Procedural Boundaries in Trademark Litigation

The IPPA Case: Analyzing Subsidiary
Claims in Invalidation Disputes

Supreme Administrative Court, R.O.C.
Case No. 111-Kang-364 | August 3, 2023

The Subject Matter



Registration No.: 01777139
Mark: IPPA and Design
Class 9: DVDs, TV films,
Movies, Audiovisual discs, etc.

**Can a plaintiff amend or add
a claim to revoke an ORIGINAL
trademark registration
approval while currently litigating an Invalidation
Unestablished decision?**

The Key Players



Player 1: The Registrant

Intellectual Property Promotion
Association (IPPA)

*The Japanese NPO that successfully
registered the disputed mark on
September 14, 2015.*



Player 2: The Defendant

Taiwan Intellectual Property
Office (TIPO)

*The government authority that
approved the mark and later dismissed
the invalidation challenge.*

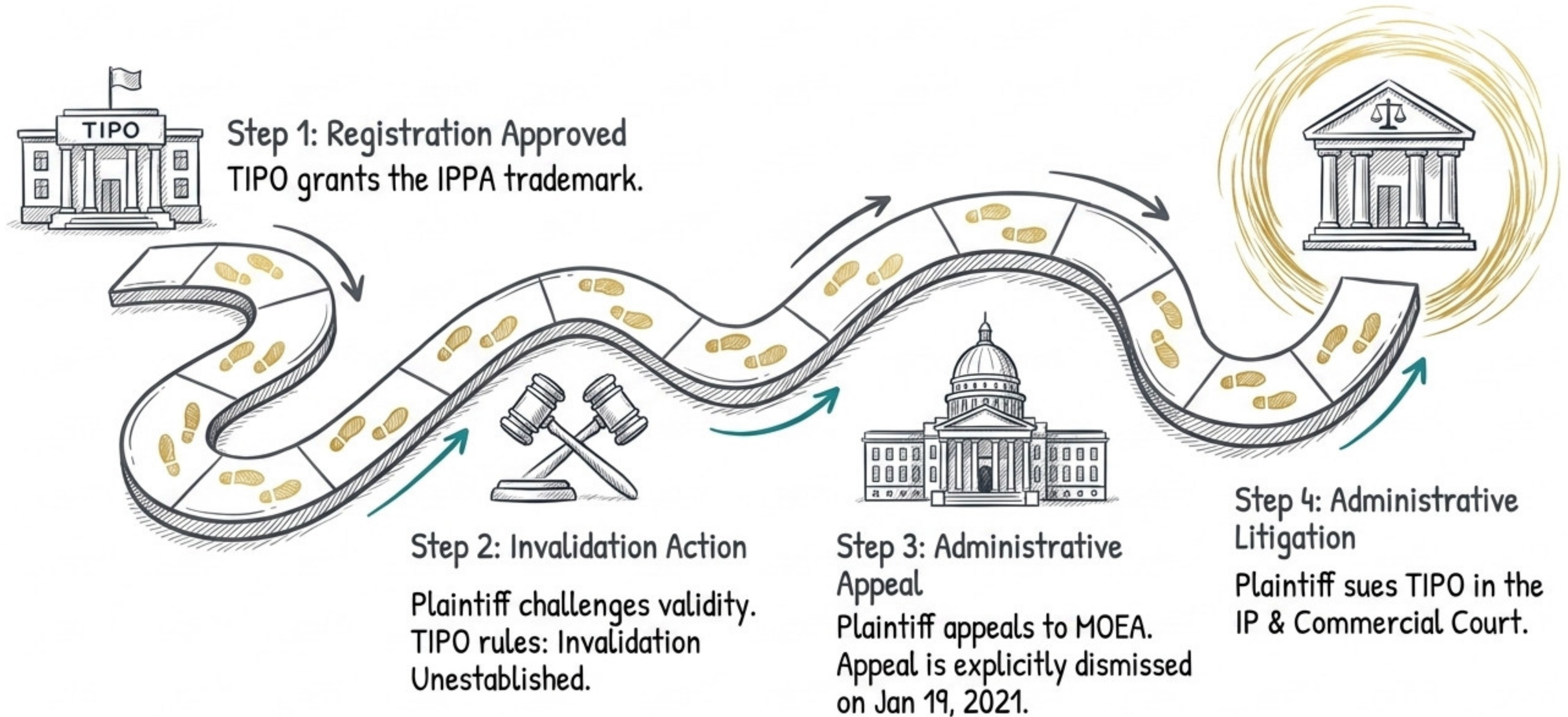


Player 3: The Plaintiff / Appellant

Yang O-Hui

*The third-party challenger seeking to
invalidate the trademark based on
Trademark Act Art. 29.1.1 and 30.1.6-8.*

How We Got Here: The Procedural Path



The Sudden Addition

At the end of the preparatory proceedings in the IP & Commercial Court, the Plaintiff executed a legal pivot, adding a Subsidiary Claim.

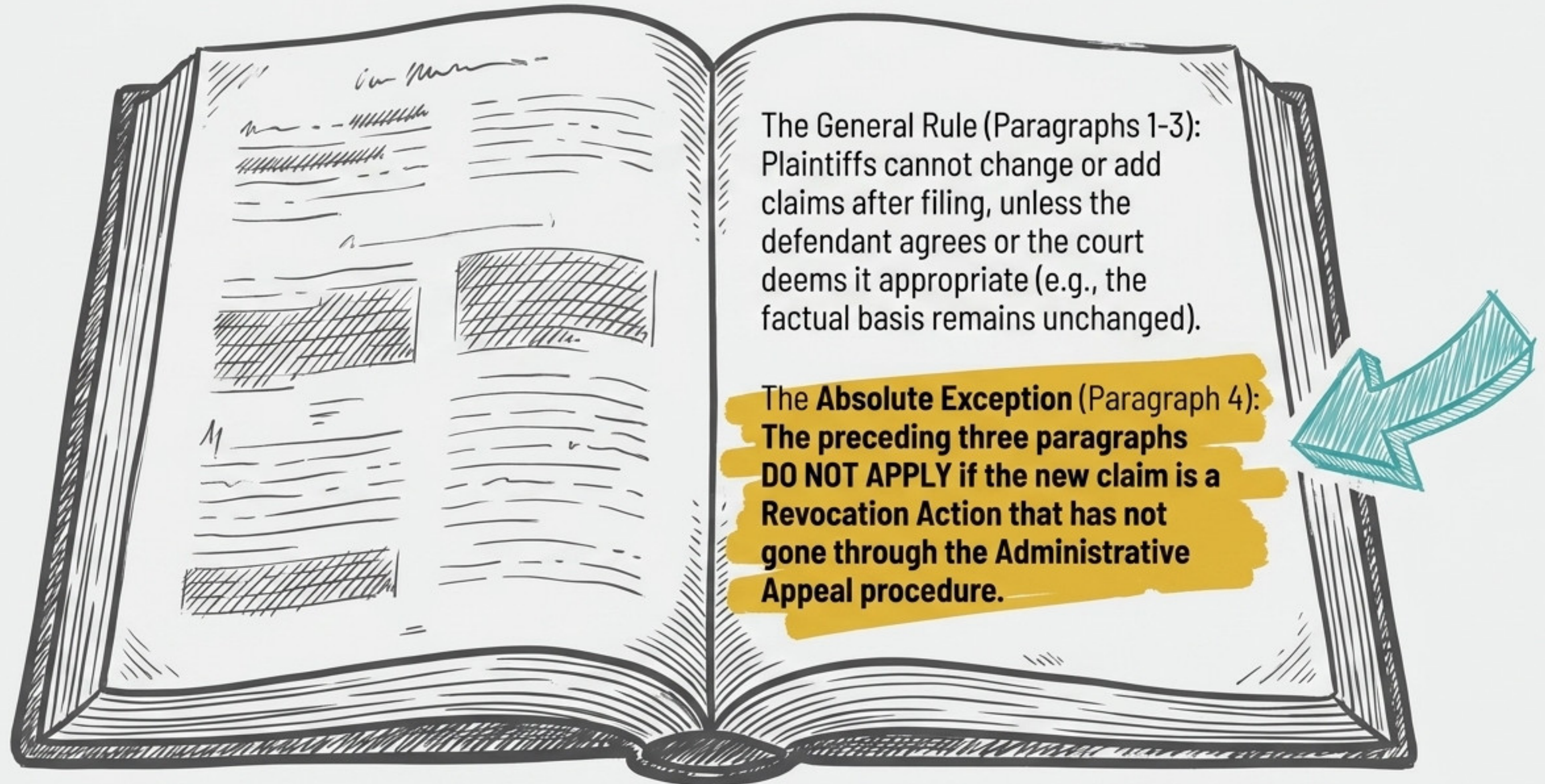


Revoke the administrative decision that originally approved the registration of the IPPA trademark.



The Procedural Flaw: This newly added claim targeted the original registration, a distinct administrative act that had never gone through its own mandatory Administrative Appeal stage.

The Rulebook: Administrative Litigation Act, Art. 111

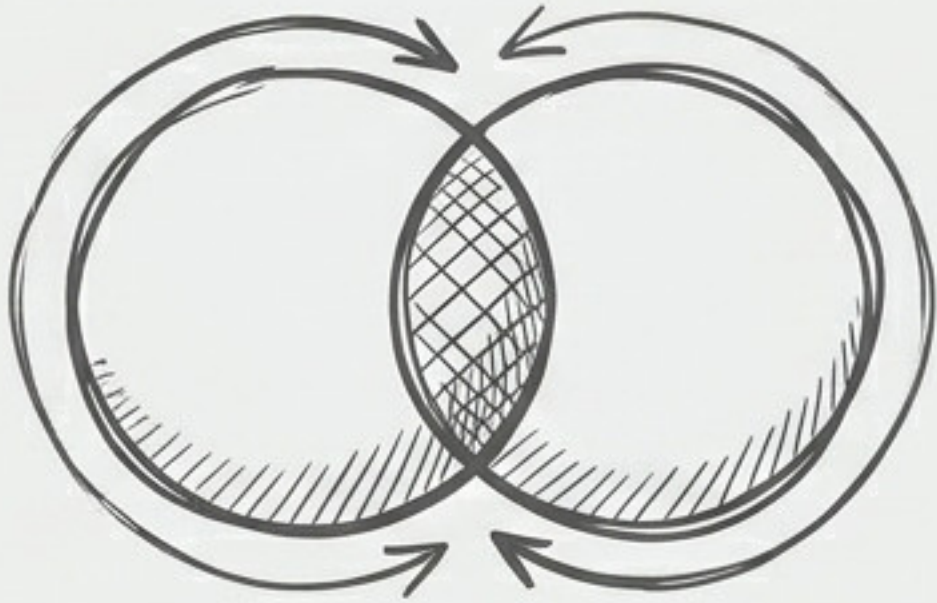


The General Rule (Paragraphs 1-3): Plaintiffs cannot change or add claims after filing, unless the defendant agrees or the court deems it appropriate (e.g., the factual basis remains unchanged).

The **Absolute Exception** (Paragraph 4):
The preceding three paragraphs DO NOT APPLY if the new claim is a **Revocation Action** that has not gone through the **Administrative Appeal** procedure.

Clash of Perspectives

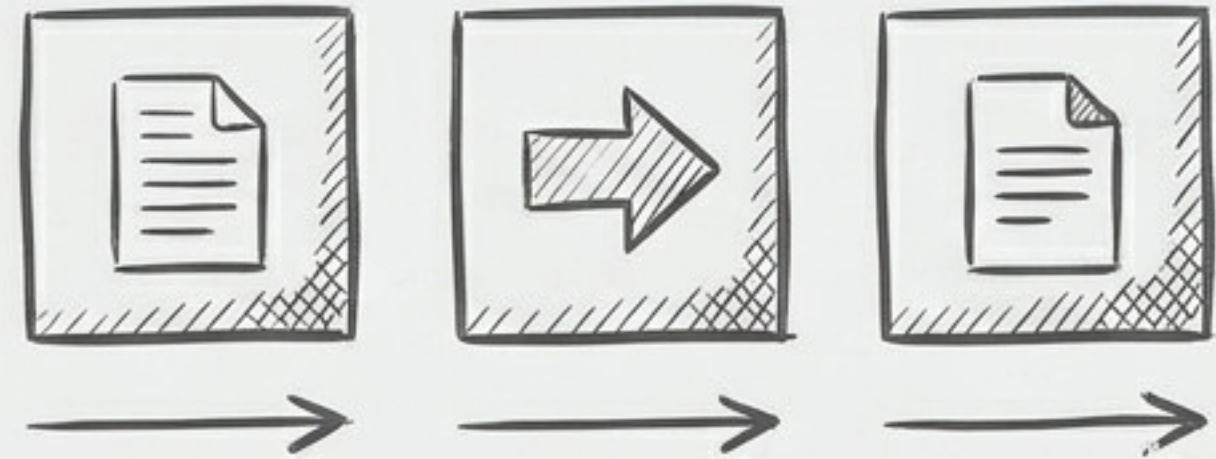
Plaintiff's Argument



Substantive Connection

The original registration and the invalidation decision are inherently linked. Because the invalidation went through an Administrative Appeal, the prerequisite for the original registration is practically satisfied.

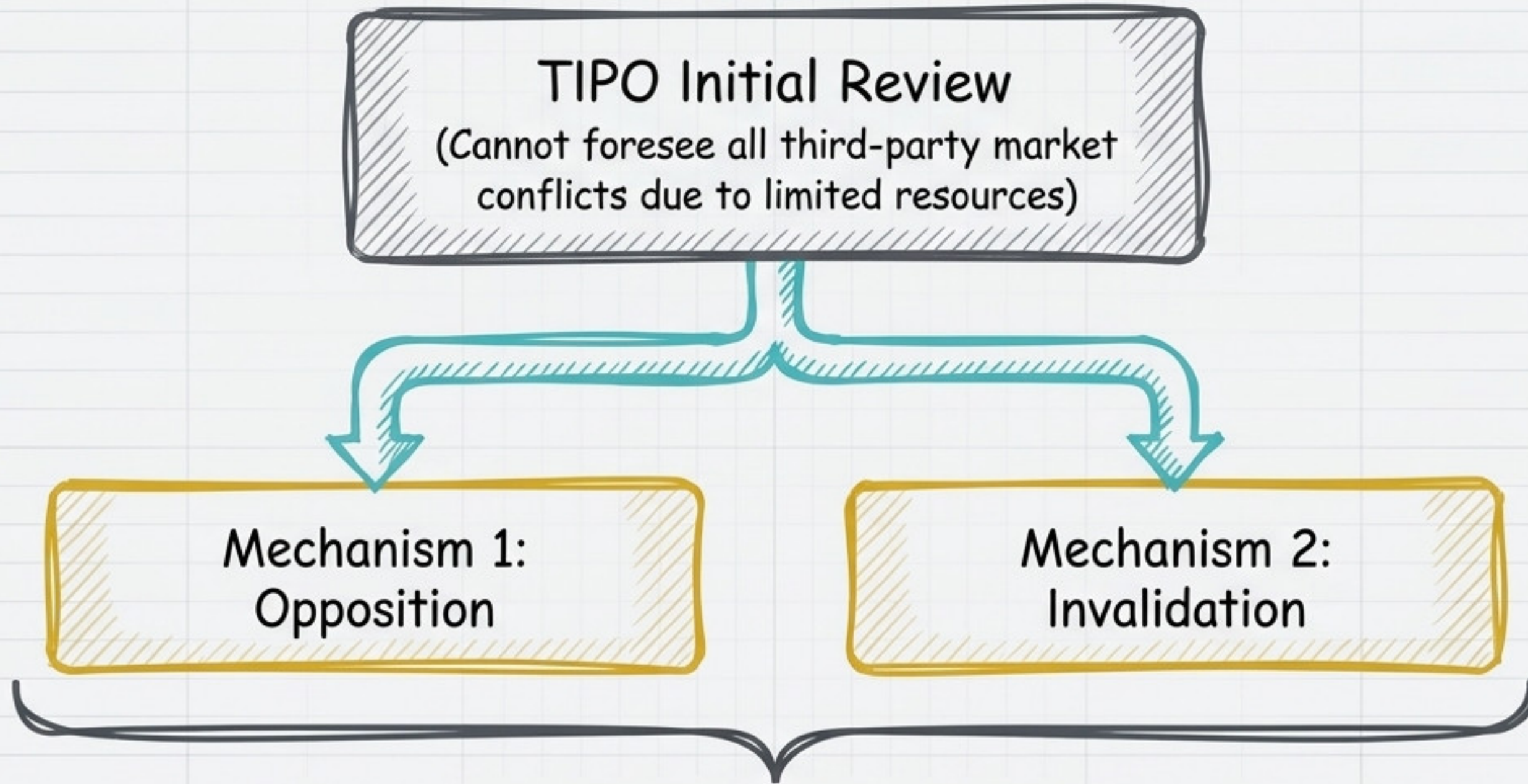
The Court's Position



Strict Procedural Independence

An added claim is an independent action. If a claim requires an Administrative Appeal, it must physically go through one. Per Art. 111.4, neither party consent nor substantive **relation** can legitimize bypassing this requirement.

The Architecture of Trademark Law



The Structural Logic: Trademark law provides specific, exclusive mechanisms for third parties to challenge registrations. You must use these dedicated pathways. You cannot invent a direct revocation lawsuit to bypass them.

The Supreme Administrative Court's Verdict

APPEAL DISMISSED.



- ✓ **Appealing an Invalidation Unestablished decision** is fundamentally **different** from appealing the Original Registration Approval.
- ✓ **They are distinct administrative acts** requiring distinct procedural remedies.
- ✓ **The Plaintiff's added subsidiary claim** was unlawful, uncorrectable, and strictly forbidden by Art. 111, Paragraph 4.

Key Takeaways & Strategic Insights



Procedure Overrides Shortcuts: You cannot bypass the Administrative Appeal requirement for a Revocation Action by attempting to piggyback it onto an existing litigation as a subsidiary claim.



Distinct Administrative Acts: The original trademark registration and a subsequent invalidation decision are entirely separate administrative acts. Exhausting legal remedies for one does not clear the procedural path for the other.



Respect the Statutory Framework: The courts strictly enforce procedural boundaries to maintain system stability. Always utilize the designed statutory mechanisms (Opposition/Invalidation) exactly as intended by the Trademark Act.