



JURISDICTION IN TRADEMARK AGENCY DISPUTES

A Legal Case Study on Mandate Contracts vs.
Intellectual Property Rights

Educational Legal Briefing

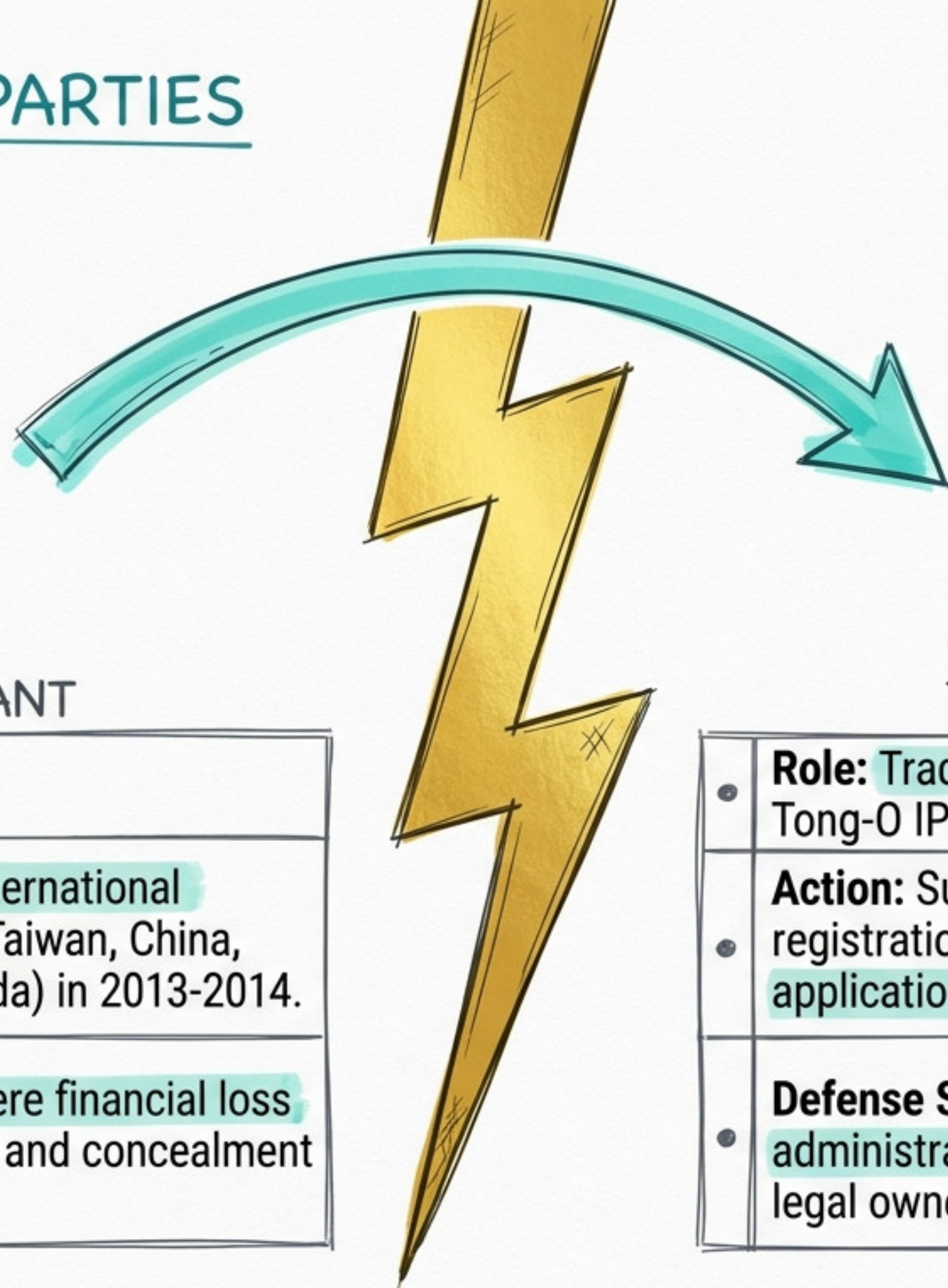
Source: Intellectual Property and
Commercial Court, Civil Ruling 111
Min-Shang-Shang No. 8 (Date: 2022)

THE DISPUTING PARTIES



THE APPELLANT

•	Role: The <u>Brand Owner</u> .
•	Action: Commissioned <u>international trademark registrations</u> (Taiwan, China, Hong Kong, US, EU, Canada) in 2013-2014.
•	Core Claim: Suffered <u>severe financial loss</u> due to agents' negligence and concealment of application failures.



THE APPELLEES

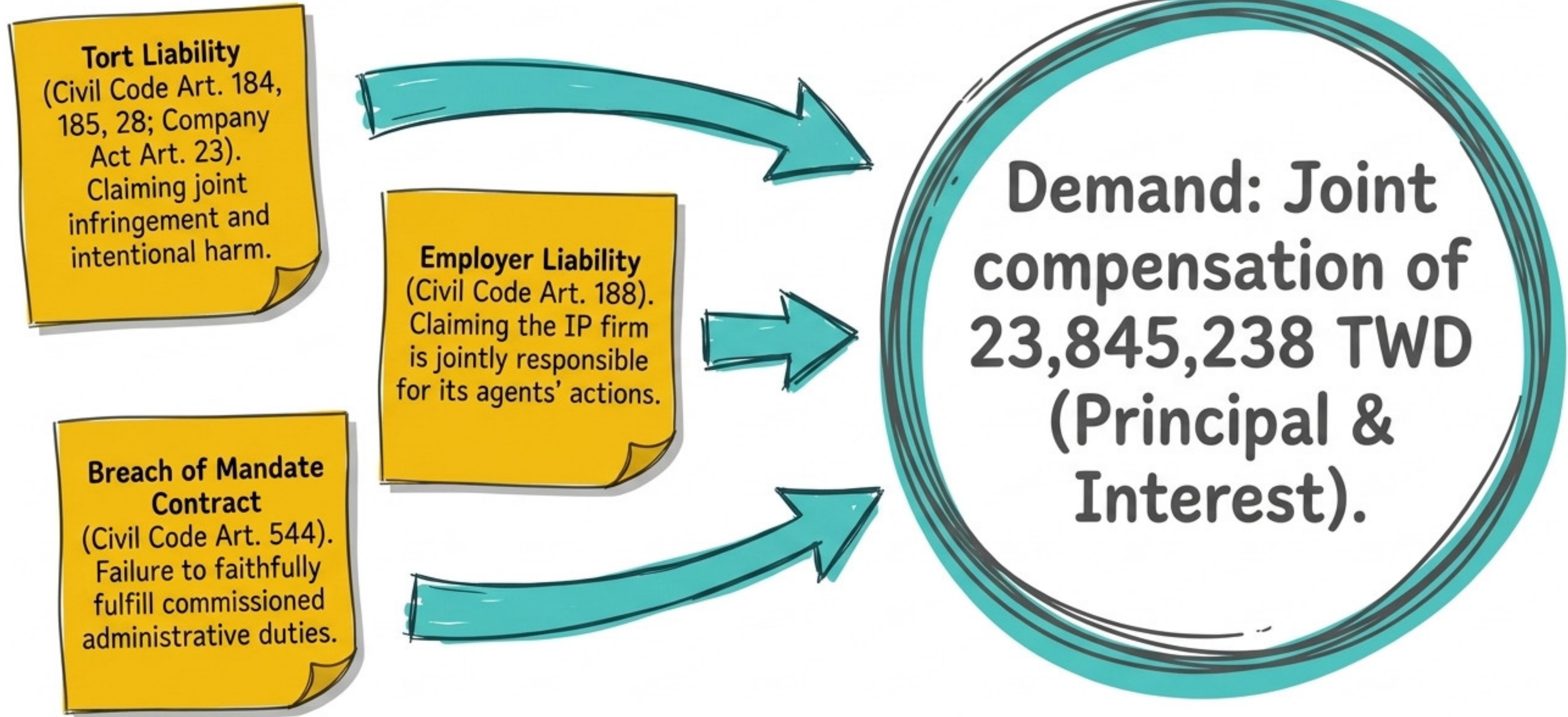
•	Role: <u>Trademark Agents</u> (Shih & Chiu) & Tong-O IP Services.
•	Action: Successfully <u>executed Taiwan registrations</u> ; <u>severely delayed foreign applications</u> .
•	Defense Stance: The dispute centers on <u>administrative service execution</u> , not the legal ownership of Intellectual Property.

ANATOMY OF THE DISPUTE



The Core Grievance: The agents actively concealed these foreign application failures from the brand owner when queried in 2019.

THE LEGAL GROUNDS FOR SUIT



THE FIRST INSTANCE RULING



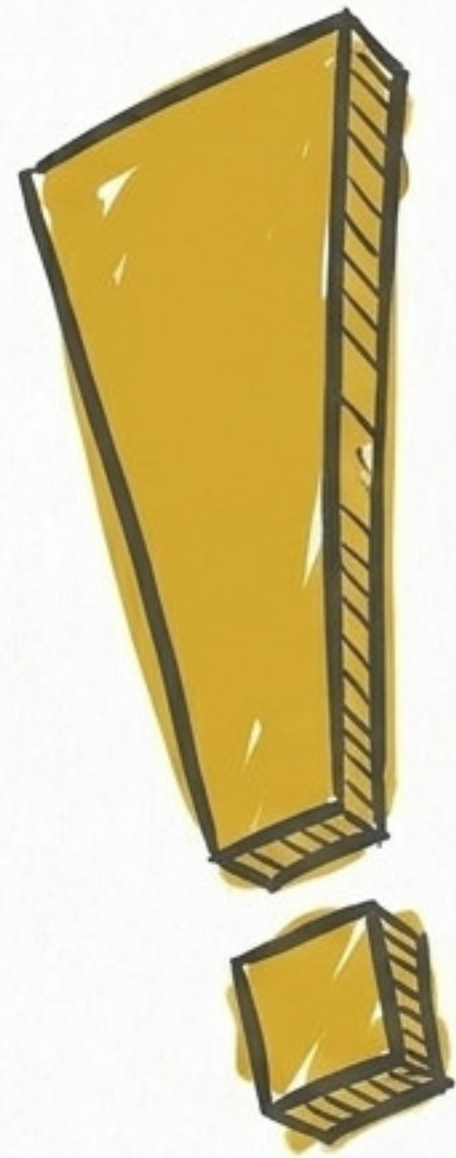
Agent Chiu & Firm:
Found guilty of
operational
operational negligence
(omitting foreign
applications).
Ordered to pay
200,000 TWD.

Agent Shih:
Completely Dismissed.
Lack of
evidence proving
intentional harm,
breach of good morals,
or direct mandate for
foreign filings.

Result: Appellant dissatisfied with the 200,000 TWD award,
escalates to the Appellate Court.



THE CRITICAL QUESTION: JURISDICTION



Before evaluating the merits of the appeal, the court must answer a fundamental procedural question:

Does the Intellectual Property and Commercial Court possess the statutory authority to hear this specific case?

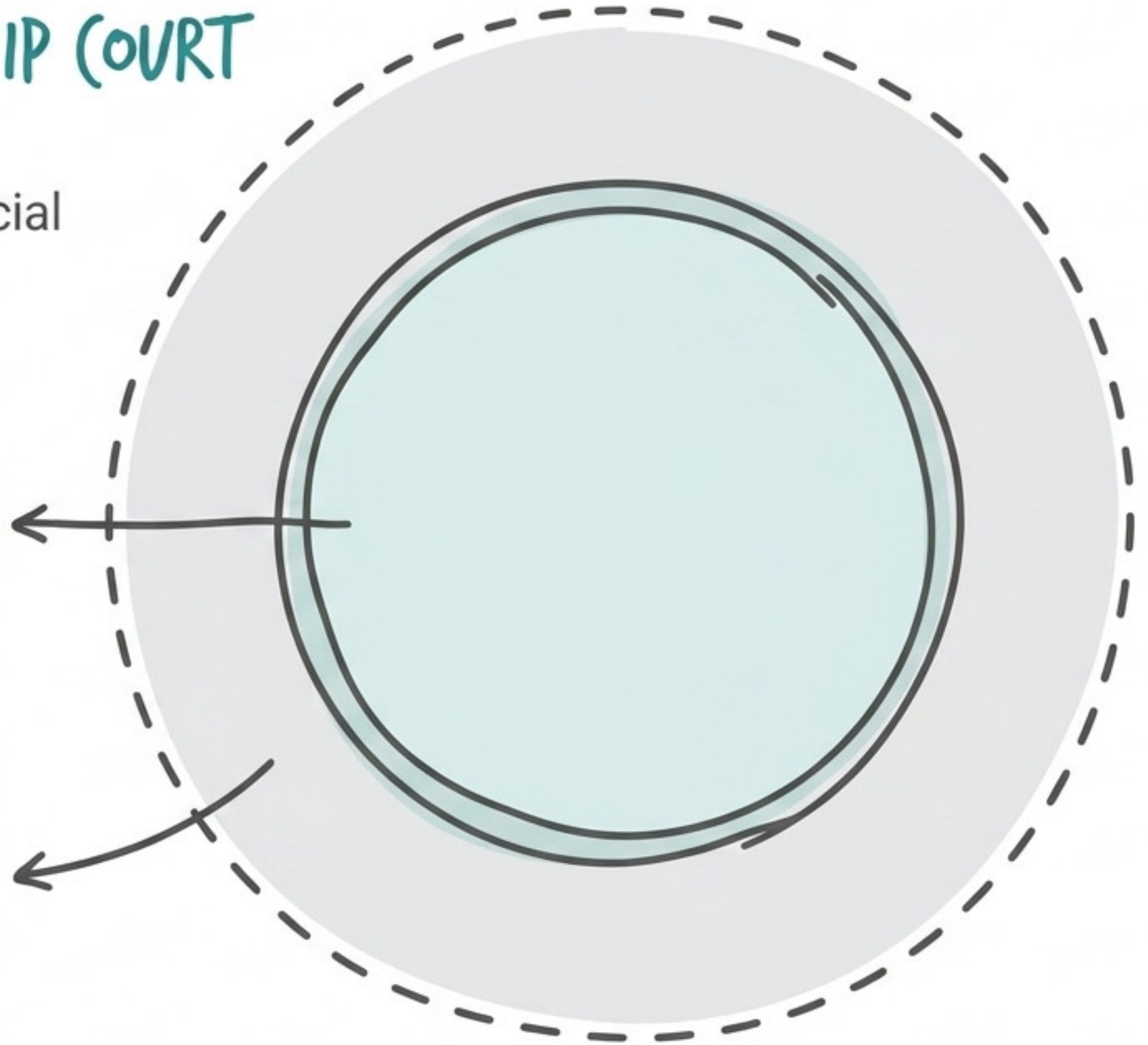
Supreme Court Civil Ruling (65 Tai-Kang No. 162): The presence of jurisdiction is a matter the court must investigate *ex officio* based on the facts claimed by the plaintiff, **strictly** applying jurisdictional law, regardless of whether the plaintiff's core claim is ultimately established.

STATUTORY BOUNDARIES OF THE IP COURT

Governed by Intellectual Property Case
Adjudication Act Art. 7 & IP and Commercial
Court Organization Act Art. 3.

Disputes directly arising from IP
rights (Trademark Act, Patent Act).
Rights ownership, validity, and
infringement.
Damages from the improper exercise
of IP rights.

General torts and negligence.
General contract and mandate
disputes.
Administrative failures.



DIAGNOSING THE CLAIMS: A JURISDICTIONAL MISMATCH

IP Court Requirement	Appellant's Actual Claim
Dispute over Intellectual Property right ownership or legal validity.	Dispute over an agent's failure to file administrative paperwork.
Infringement of IP rights by a third party.	Breach of a Mandate Contract between a client and their hired agent.
Based on Trademark Act protections.	Based strictly on the Civil Code (General Torts & Employer Liability).

Diagnostic Conclusion: The claims do not rely on the constitutive elements or effects of IP law.

THE FINAL RULING

The Intellectual Property and Commercial Court ruled it **LACKS JURISDICTION**.



The core dispute is a general civil matter (breach of mandate contract and general torts).

It does not involve the protection, ownership, or infringement of a trademark right itself.

It is not an improper exercise of IP rights under the Judicial Yuan's designated scope.



Official Order: Case transferred *ex officio* to the Taiwan High Court Taichung Branch.

JUDGMENT SUMMARY & STRATEGIC TAKEAWAYS

1

Context vs.
Core Law

Trademark agency disputes are typically Mandate Contract and General Tort issues.

Just because a trademark is involved does not make it an IP rights case.

2

Strict Statutory Limits.

The IP Court's jurisdiction is strictly limited to cases where the constitutive elements and effects of IP laws are the actual subject of the lawsuit.

3

Venue is Dictated by the Claim.

Plaintiffs cannot force a case into specialized IP Courts merely through association. The specific legal basis of the claim (e.g., Civil Code vs. Trademark Act) strictly dictates the judicial venue.