

The Anatomy of a Trademark Dispute

When Does a Common Shape Become Infringement?



Source: Taiwan
Intellectual Property and
Commercial Court,
Criminal Judgment
112-Xing-Zhi-Shang-Yi-10

Date: 2023

The Legal Battleground

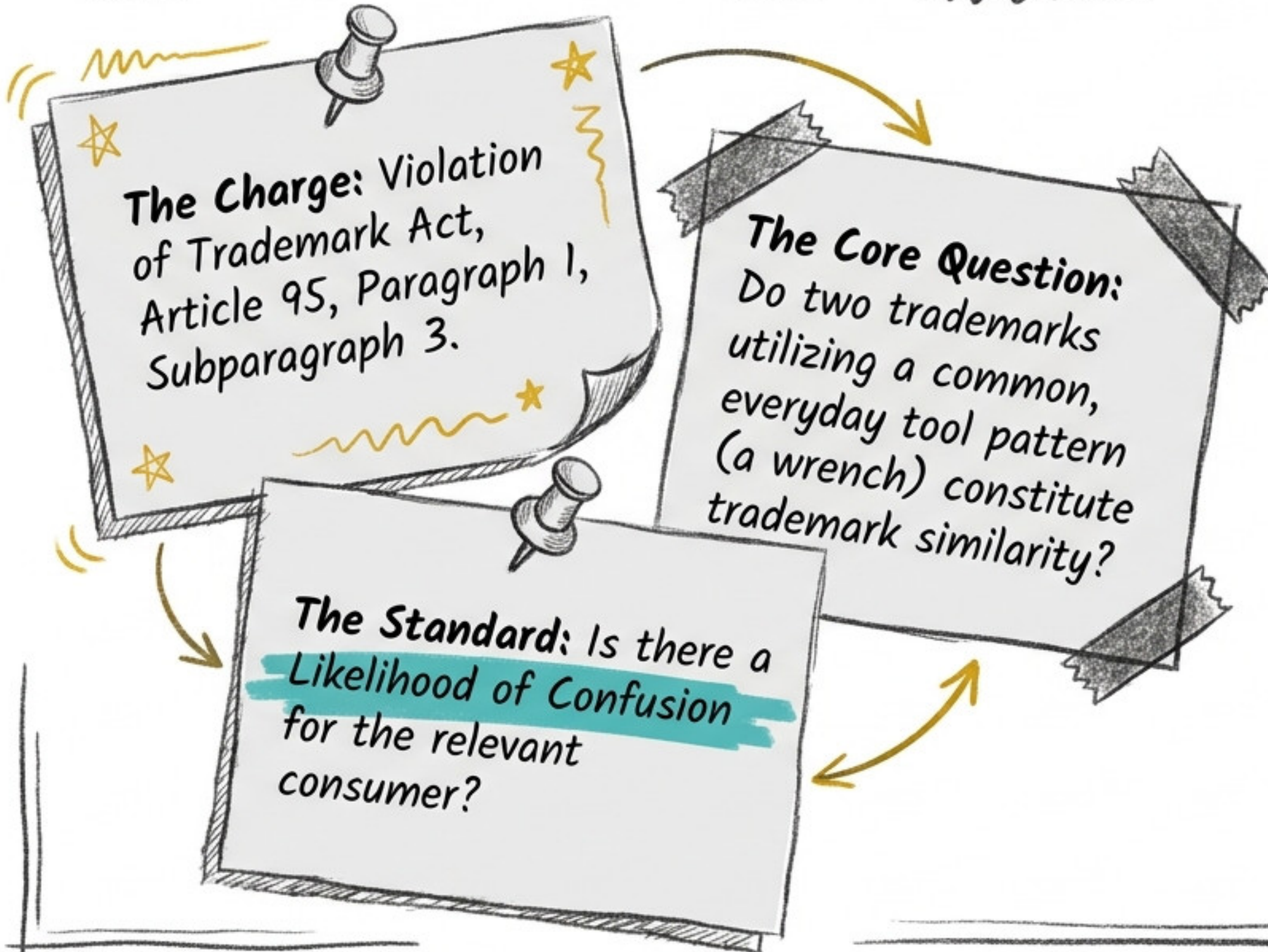


Exhibit A vs. Exhibit B

The Plaintiff



- **Registered Mark:** No. 01359382
- **Classes:** 7, 8, 9 (Hand tools, Wrenches, Torque Testers)
- **Design Feature:** A high-contrast letter "M" utilizing a wrench cutout in the negative space.

The Defendant



- **Registered Mark:** No. 01387309 (and usage variants)
- **Classes:** 8 (Pliers, Wrenches)
- **Design Feature:** The text "HETOK" with a wrench icon enclosed in square, featuring a specially designed gear-shaped 'O'.

Doctrine 1: Overall Observation

Consumers do not dissect trademarks.

Trademarks must be judged from the perspective of a consumer observing the mark as a whole (appearance, concept, and pronunciation).



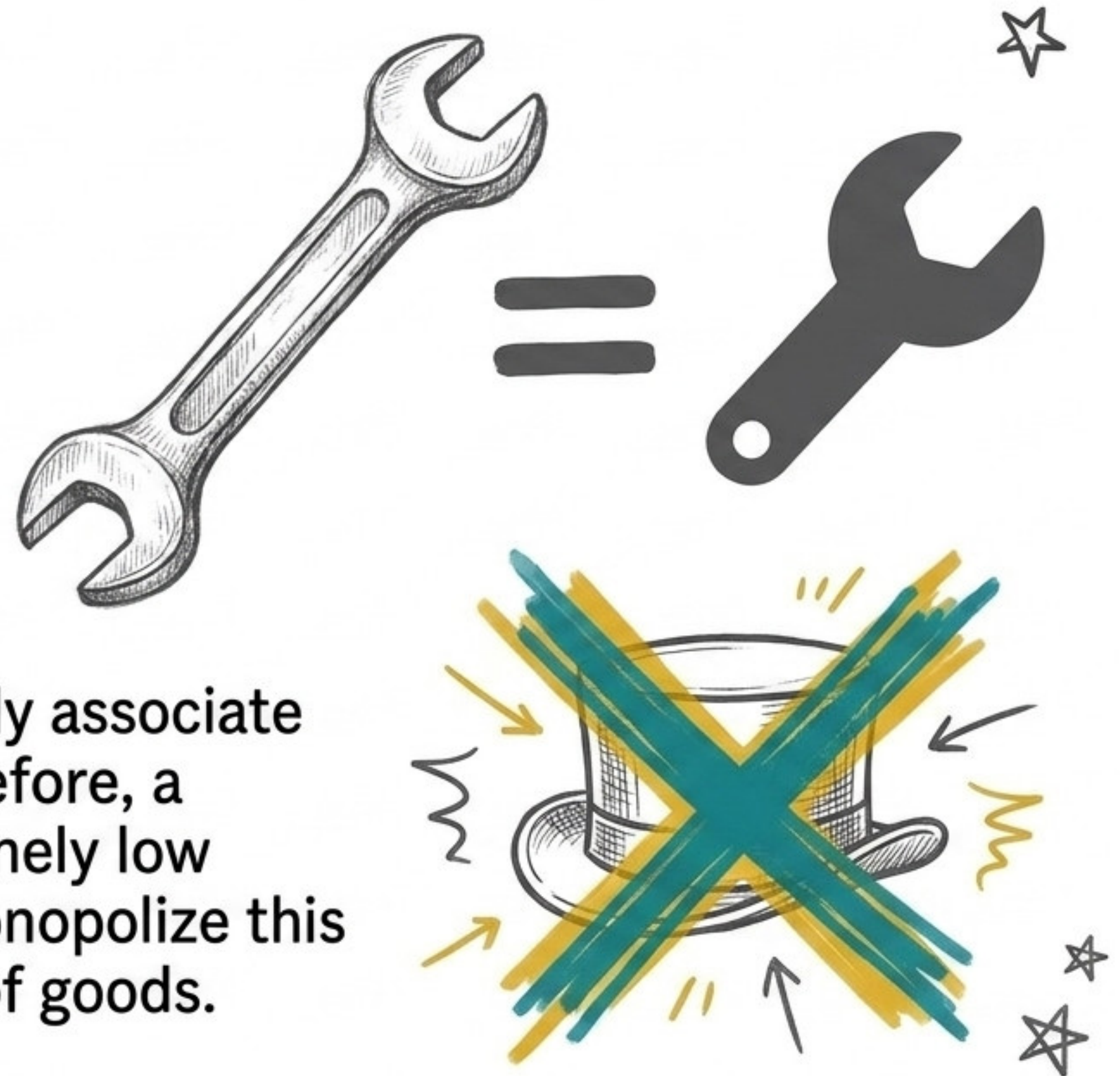
Application to Case: The Plaintiff's overall visual impression relies heavily on the "M" shape. The Defendant's overall impression relies heavily on the word "HETOK" and the distinct gear-shaped "O", visually separating the two.

Doctrine 2: Descriptiveness vs. Distinctiveness

A wrench on a wrench
is just a wrench.

The wrench pattern is a common shape for hand tools. When applied to actual wrench products, it functions merely as a **Descriptive Sign**.

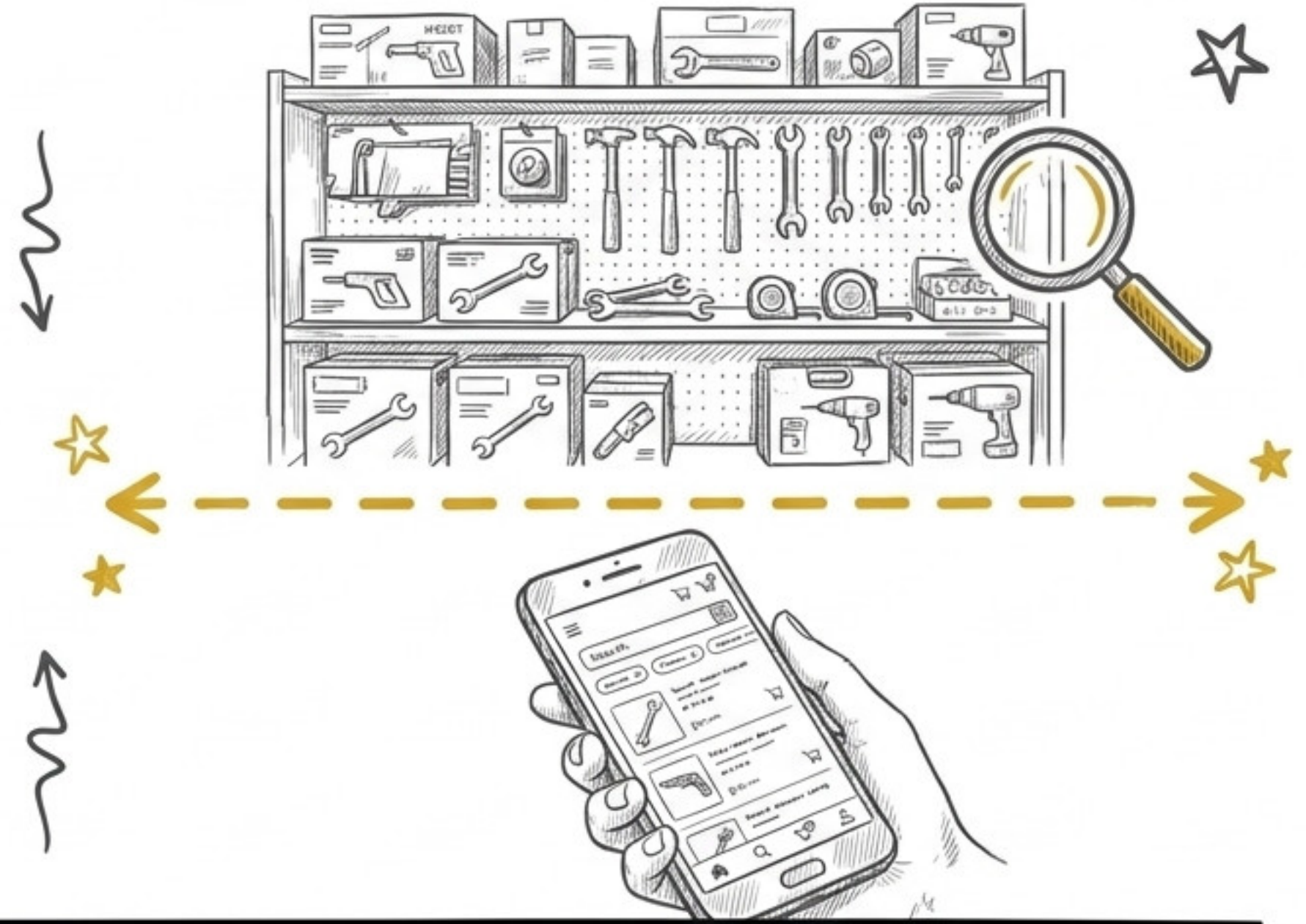
Application to Case: Consumers instantly associate the shape with the product itself. Therefore, a generic wrench shape possesses extremely low **Distinctiveness**. No single brand can monopolize this shape to indicate the exclusive source of goods.



Doctrine 3: Observation in Isolation

Market Reality Checklist

- ✓ The Defendant's text ('HETOK') visually overpowers their small wrench icon.
- ✓ The Plaintiff rarely uses the 'M' alone, typically combining it with the text 'MATATAKITOYO' (reducing independent commercial strength).



Conclusion: Simulating real market transactions—observing the marks in isolation at different times and places—a consumer with ordinary knowledge would not assume a shared source, franchise, or licensing relationship.



Doctrine 4: The Absence of Mens Rea

Criminal trademark violation requires subjective intent (Mens Rea).

The Evidence: Upon receiving an infringement notice, the Defendant continued using the logo—but did so under the professional advice of a patent and trademark agency while applying for their own registration.



The Ruling:

Relying on professional legal counsel negates the subjective criminal intent to violate the Trademark Act.





Final Judgment: Appeal Dismissed



The Blueprint for Compliance

1. **Descriptive Limits:** Incorporating the literal shape of your product into your logo provides weak protection (Low Distinctiveness).
2. **Context is Key:** Textual elements (like 'HETOK') often dominate generic visual icons in a consumer's Overall Observation.
3. **Seek Counsel:** Documented reliance on IP professionals serves as a strong shield against Mens Rea (criminal intent).

Source: Taiwan Intellectual Property and Commercial Court, Criminal Judgment 112-Xing-Zhi-Shang-Yi-10 (2023).

