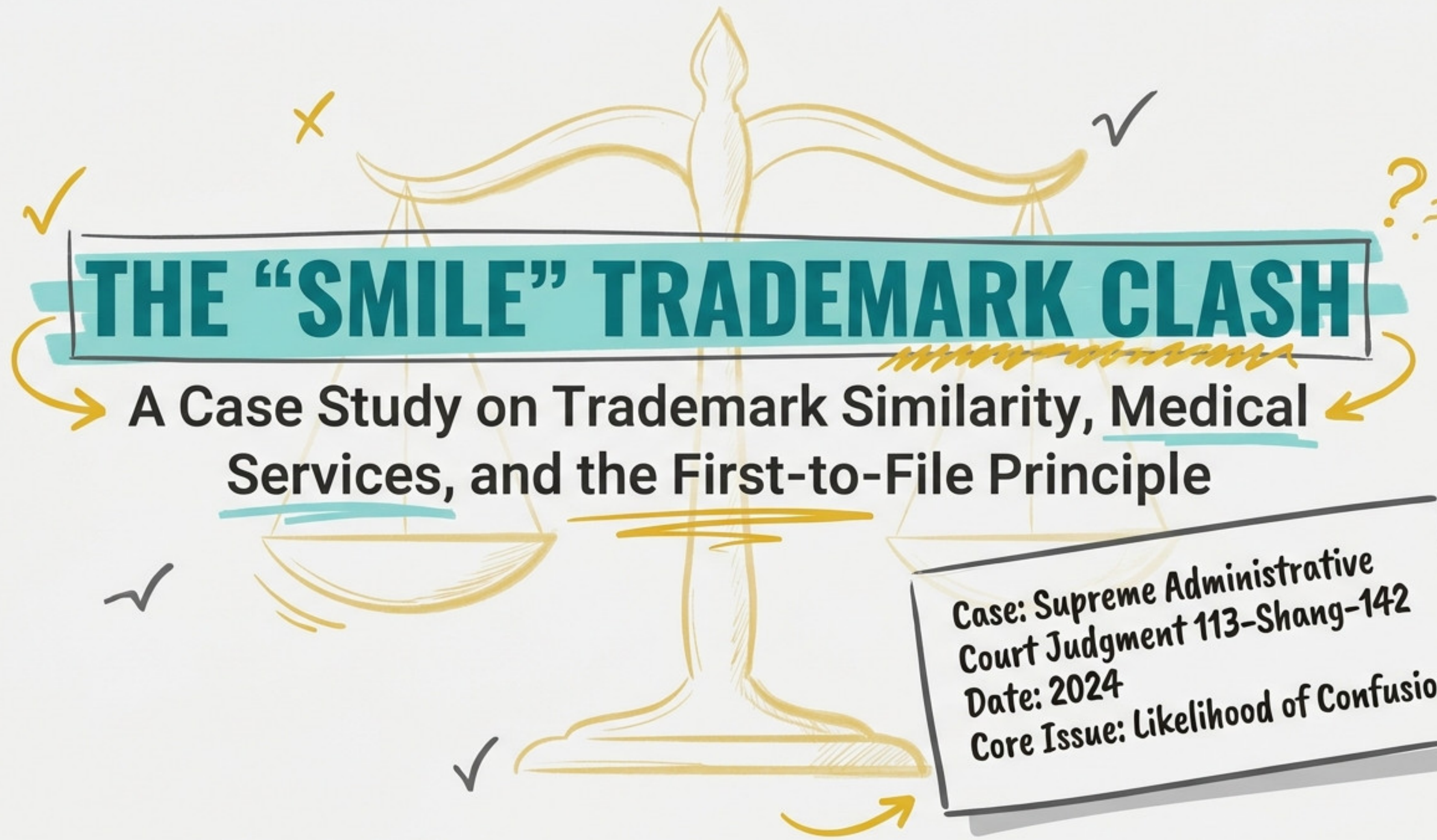




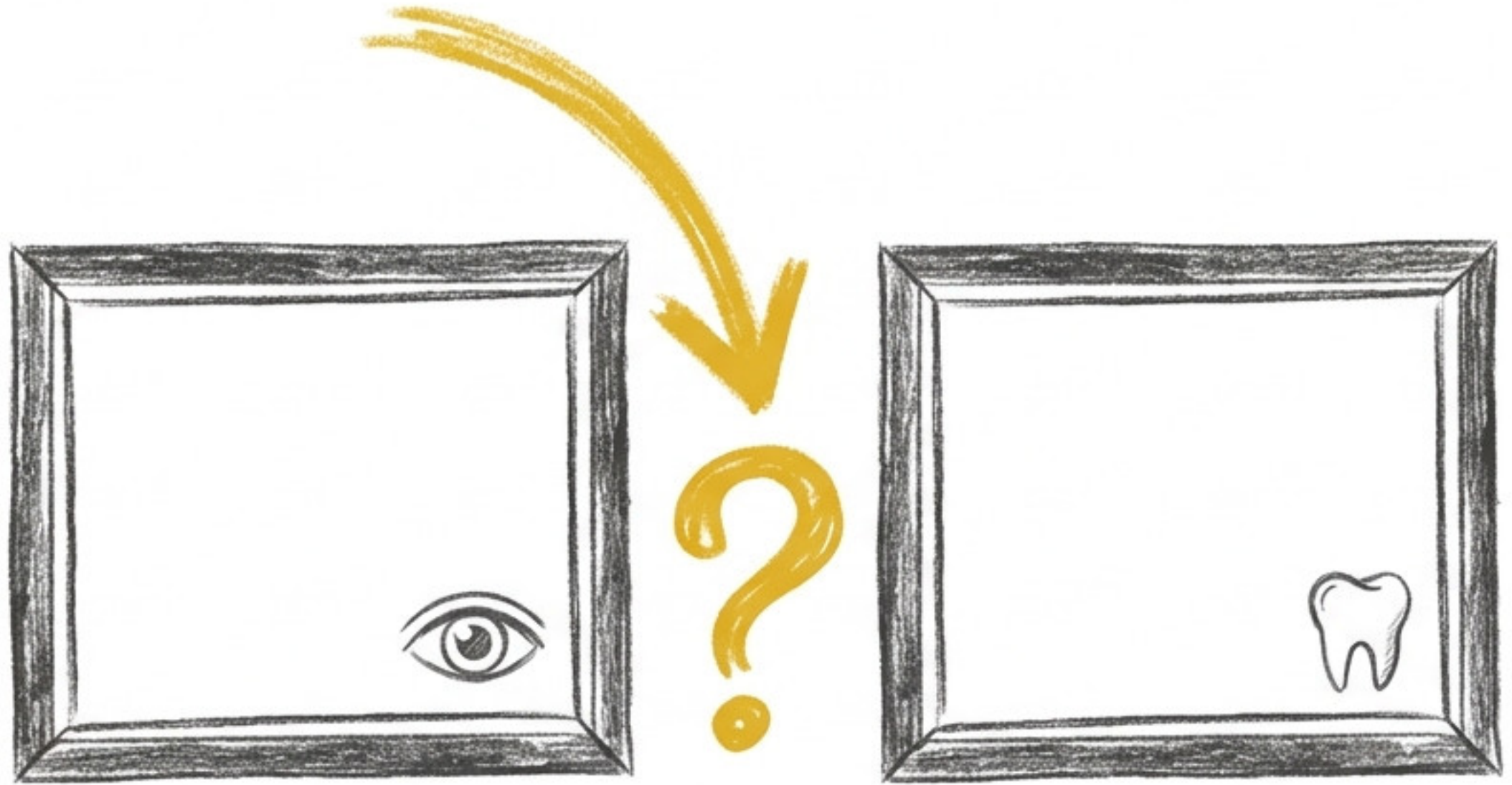
# THE “SMILE” TRADEMARK CLASH

A Case Study on Trademark Similarity, Medical Services, and the First-to-File Principle

Case: Supreme Administrative  
Court Judgment 113-Shang-142  
Date: 2024  
Core Issue: Likelihood of Confusion

# ONE WORD. TWO MEDICAL FIELDS.

Can an eye clinic register the trademark "SMILE" when a dental clinic already owns a "Smile" trademark?



## Evidence Box

The Legal Question: Does the new application violate Article 30, Paragraph 1, Subparagraph 10 of the Trademark Act?

Focus: Likelihood of Confusion among consumers.

# MEET THE PARTIES

## The Challenger

Status: Disputed Application  
(No. 110880106)

SMILE

### Designated Field:

Class 44 - Medical services  
(Ophthalmology & Eye  
Surgery)

## The Defender

Status: Cited Registered Mark  
(No. 01108399)



### Designated Field:

Class 44 - Dental medical &  
pharmaceutical preparation,  
medical consultation

Is there a  
likelihood of  
confusion?

# THE RULE OF LAW

## Trademark Act: Article 30(1)(10)

A trademark shall not be registered if it is:

1. Identical or similar to another person's registered trademark.
2. Designated for use on identical or similar goods/services.
3. Likely to cause confusion among relevant consumers.

*The Court must evaluate all three criteria to reject the application.*

# ISSUE 1: ARE THE MARKS SIMILAR?

## anatomy of a logo

**Appellant's Claim:**  
"Ours is plain text.  
Theirs is a graphic face.  
They look completely  
different visually!"



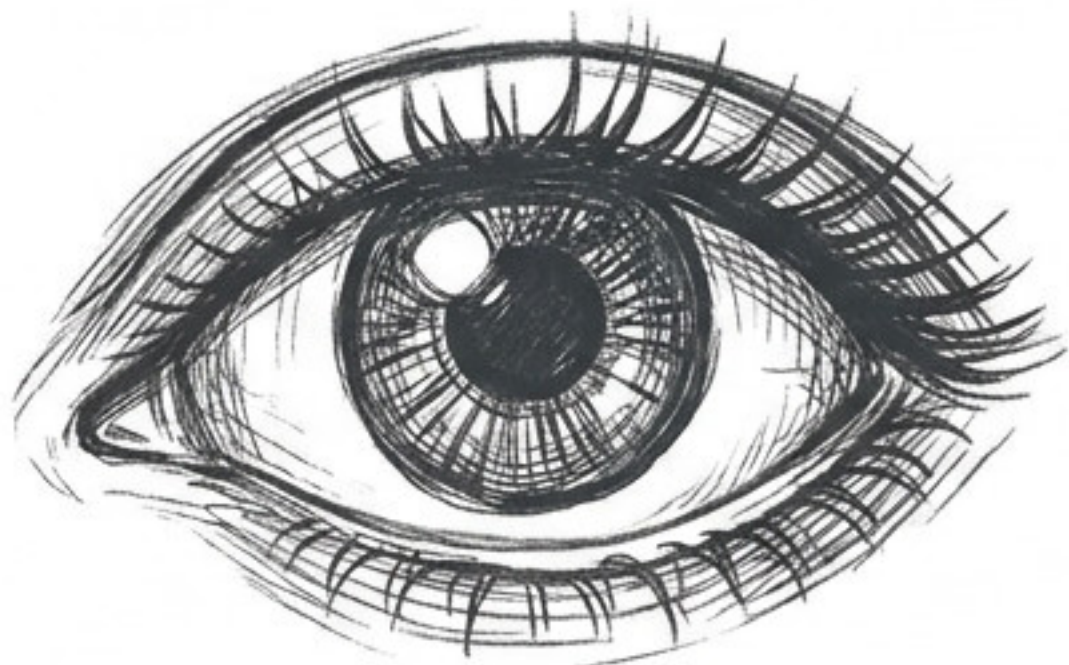
**Dominant Portion:** The word "Smile". This drives how consumers pronounce, remember, and call out the brand.

**Subordinate Portion:** The background graphic design.

**The Court's Ruling:** Principle of Overall Observation vs. Dominant Portion.

✓ Despite the graphic differences, the core identifier is identical. ✓  
High similarity in appearance, pronunciation, and concept.

## ISSUE 2: EYES VS. TEETH



**Ophthalmology Medical Services**  
(Specialized eye surgery)

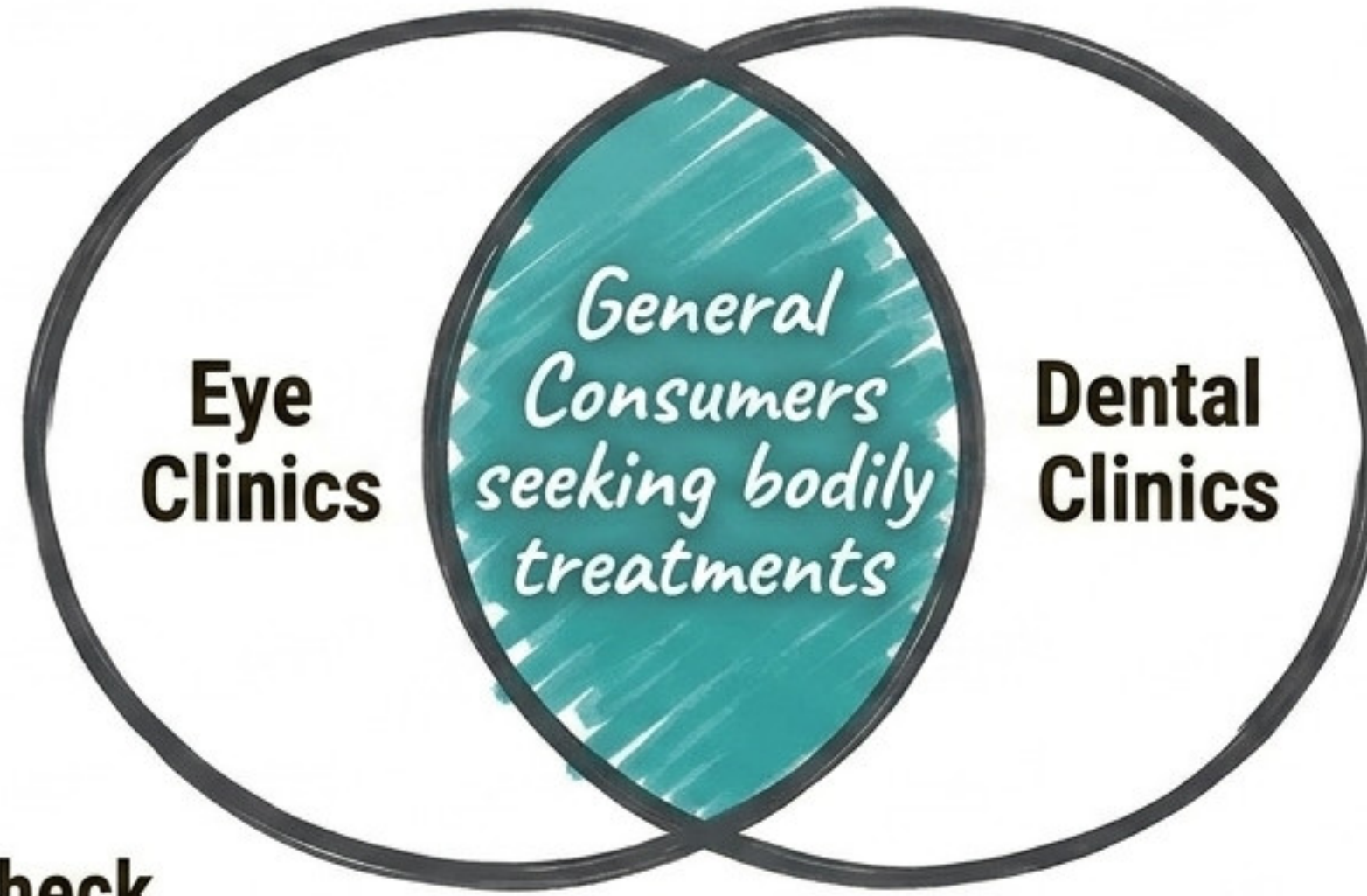


**Dental Medical Services**  
(Tooth extraction and care)

**Appellant's Defense:** "These are entirely different medical specialties requiring completely different training. Consumers will never confuse an eye surgeon with a dentist."

*Does specialized medicine mean separate markets?*

# CONSUMER PERCEPTION TRUMPS SPECIALIZATION



## The Court's Reality Check

- ✓ Both belong to the same official registry group (Class 4403: Medical therapies).
- ✓ Both provide treatments for human ailments using professional techniques.
- ✓ Market Reality: Comprehensive hospitals and joint clinics frequently offer both eye and dental care under one roof.

***Ruling: Highly Similar Services.***

## THE PLOT TWIST: WHAT DOES "SMILE" MEAN?



**Appellant's Defense:** "SMILE is already famous in our specific field! It isn't just a facial expression, it stands for:"

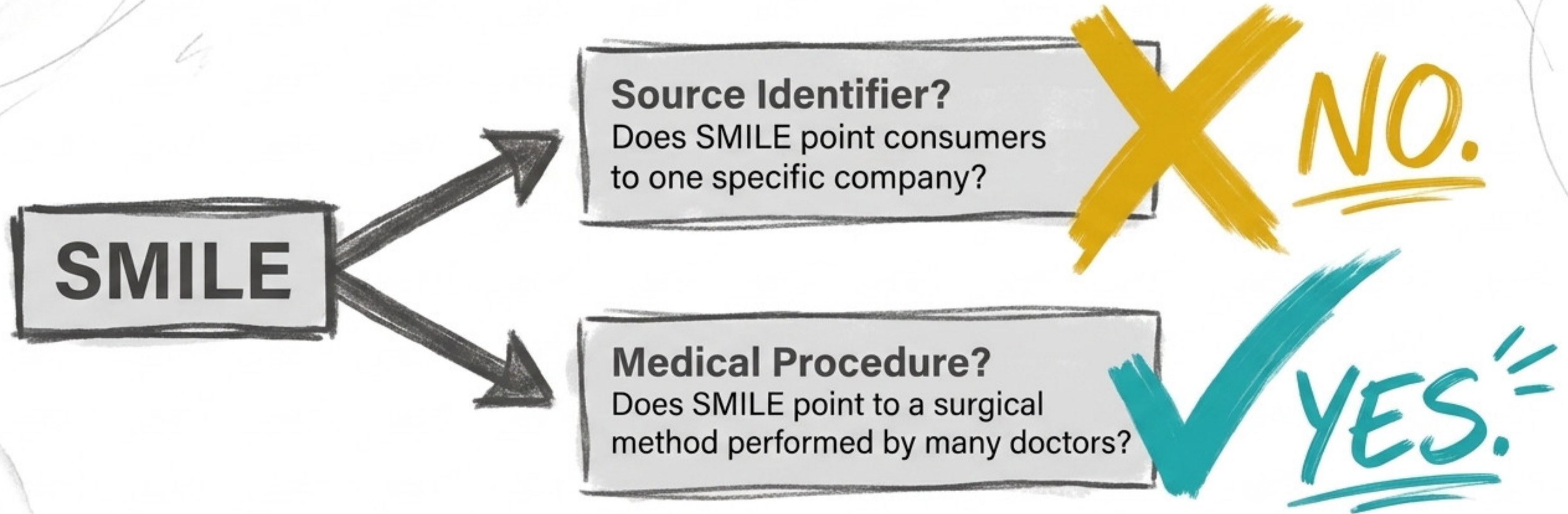
**Small  
Incision  
Lenticule  
Extraction**



**S.M.I.L.E.**

(A highly specific, widely used type of laser eye surgery).

# DESCRIPTIVE TERMS CANNOT BE BRANDS



## The Court's Ruling:

Because "SMILE" describes the surgical method itself, it lacks the distinctiveness to act as a unique brand identifier. Extensive marketing of a surgical acronym does not equal extensive marketing of a trademark.

# PROTECTING THE PRIOR REGISTRANT



## THE FIRST-TO-FILE PRINCIPLE

- ✓ Taiwan's Trademark Act operates on a strict "First-to-File" system.
- Allowing a later application to register a highly similar mark in an overlapping service category would:
  - Rob the prior registrant (the dental clinic) of their established rights.
  - Cause consumers to falsely assume a franchise or corporate affiliation exists between the two clinics.

# FINAL JUDGMENT & STRATEGIC TAKEAWAYS

APPEAL REJECTED (SUPREME ADMINISTRATIVE COURT JUDGMENT 113-SHANG-142)

## The Dominant Portion

Visuals Matter Less Than Words: Adding a generic background graphic to a word does not make it a distinct trademark if the word remains the primary way consumers pronounce and remember it.

## Class Overlap

Consumer Perspective is Key: Even highly specialized medical fields (Eyes vs. Teeth) are deemed "highly similar" if general consumers access them through similar channels like joint clinics.

## Generic Acronyms

- ✗ Method Does Not Equal
- ✓ Brand: Using an industry acronym for a procedure is descriptive. It cannot easily translate into protected, exclusive trademark rights to overcome a prior registration.