

Trademark Agent Qualification Dispute

THE '10-CASE' THRESHOLD

Understanding Case Definitions under
Trademark Act Article 109-1

Source: Intellectual Property and Commercial Court
Judgment 114 Xing Shang Su Zi No. 17 (Date: 2024)

**CASE
CLOSED**

The Grandfather Clause

The Primary Rule (Art. 6)

Elevate professional standards. Trademark agents must pass official competency exams or have 10+ years of official review experience.

The Transitional Exception (Art. 109-1)

Protects existing, highly experienced practitioners. Allows registration **WITHOUT** an exam if a strict historical volume threshold is met.

The Requirement: Must have processed at least 10 trademark registration or procedural cases annually for 3 consecutive years prior to May 1, 2024.

The Dispute: Calculating "Year 2"

Plaintiff's Claim

I processed 15 cases between May 2022 and April 2023. I exceed the 10-case threshold.

Defendant's Rebuttal (TIPO)

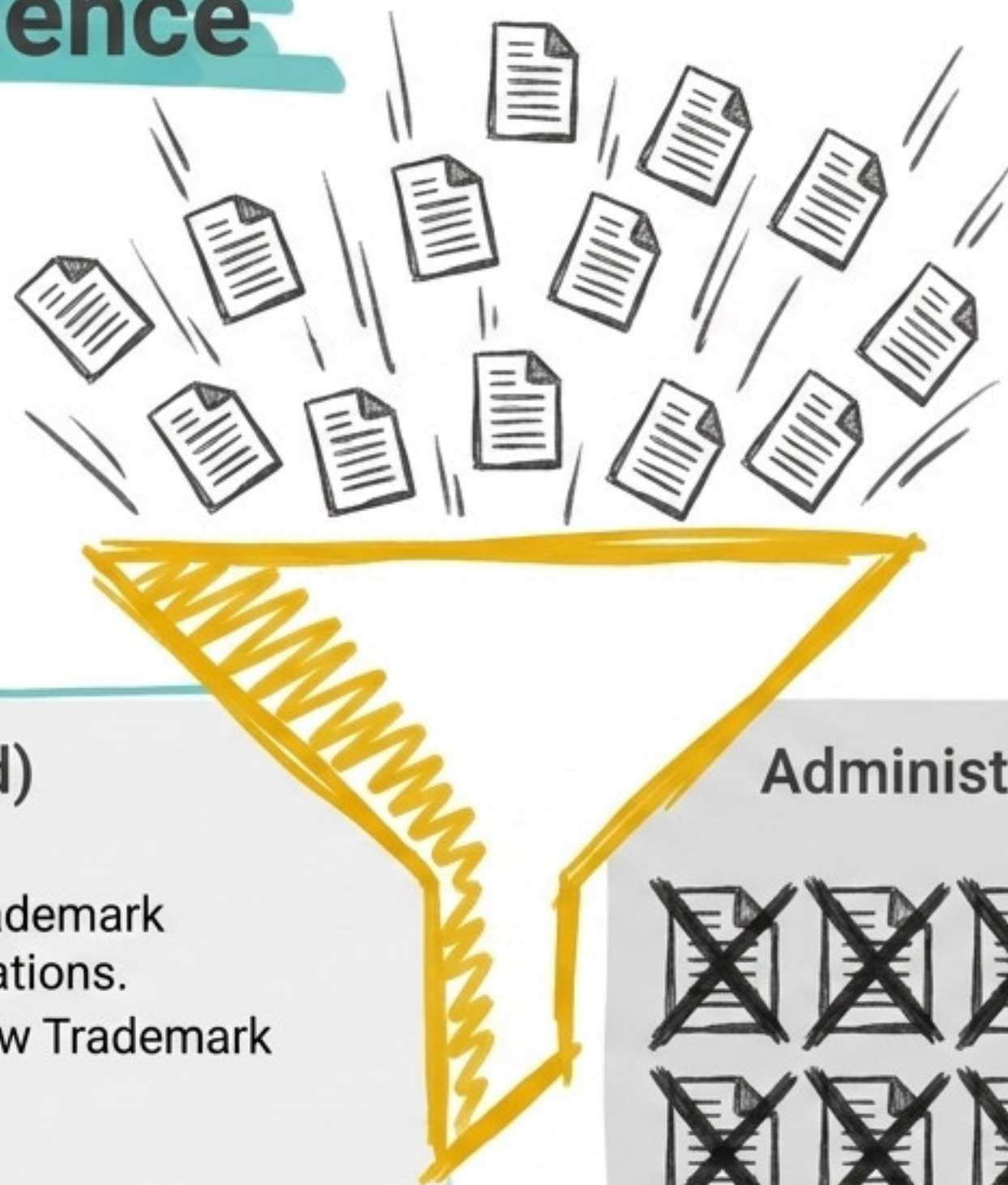
Only 4 of these qualify as independent procedural cases.

Where did the other 11 cases go?

Action: Application "Not Entertained" (Rejected) under Art. 8, Para. 1 of Management Regulations.

Evidence: Submitted an itemized list of 15 interactions with the agency.

Filtering the Evidence



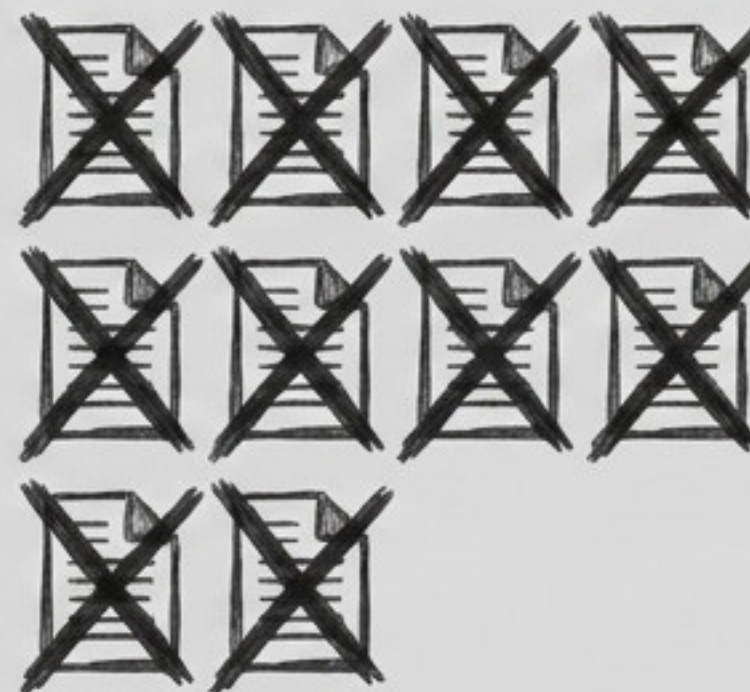
Independent Cases (Counted)



Cases 4 & 8: Trademark Renewal Applications.
Cases 7 & 9: New Trademark Registrations.

Status: Legally recognized as independent application acts.

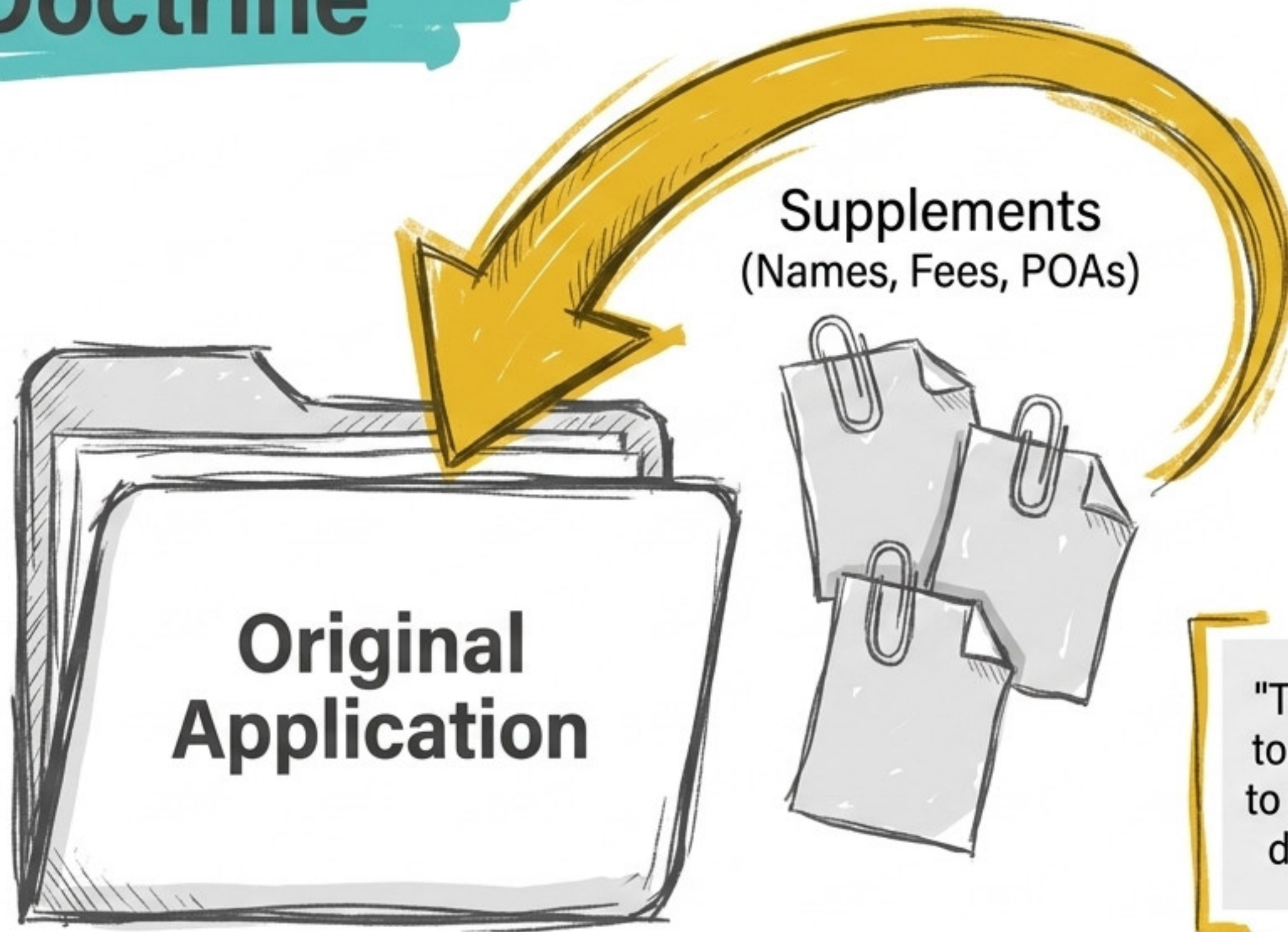
Administrative Supplements (Discarded)



Cases 1, 2, 3, 13, 14, 15: Supplementing Powers of Attorney.
Cases 5, 6: Supplementing missing fee payments.
Cases 10, 11, 12: Correcting company/product names.

Status: Rejected as independent cases.

The "Same Application Act" Doctrine



The Court affirmed TIPO's standard:

Administrative tasks are merely statutory prerequisites required to complete the original registration announcement.

"These are subsequent corrections made to fulfill legal requirements... They belong to the same application act and cannot be double-counted as independent cases."

Deep Dive: Application No. 111022784

Plaintiff's Argument: Argued that deleting Class 14 ("mechanical watch oscillators") and changing the company name in Year 2 were "substantive pre-registration splits" that should generate new case counts.

Year 1

Year 2



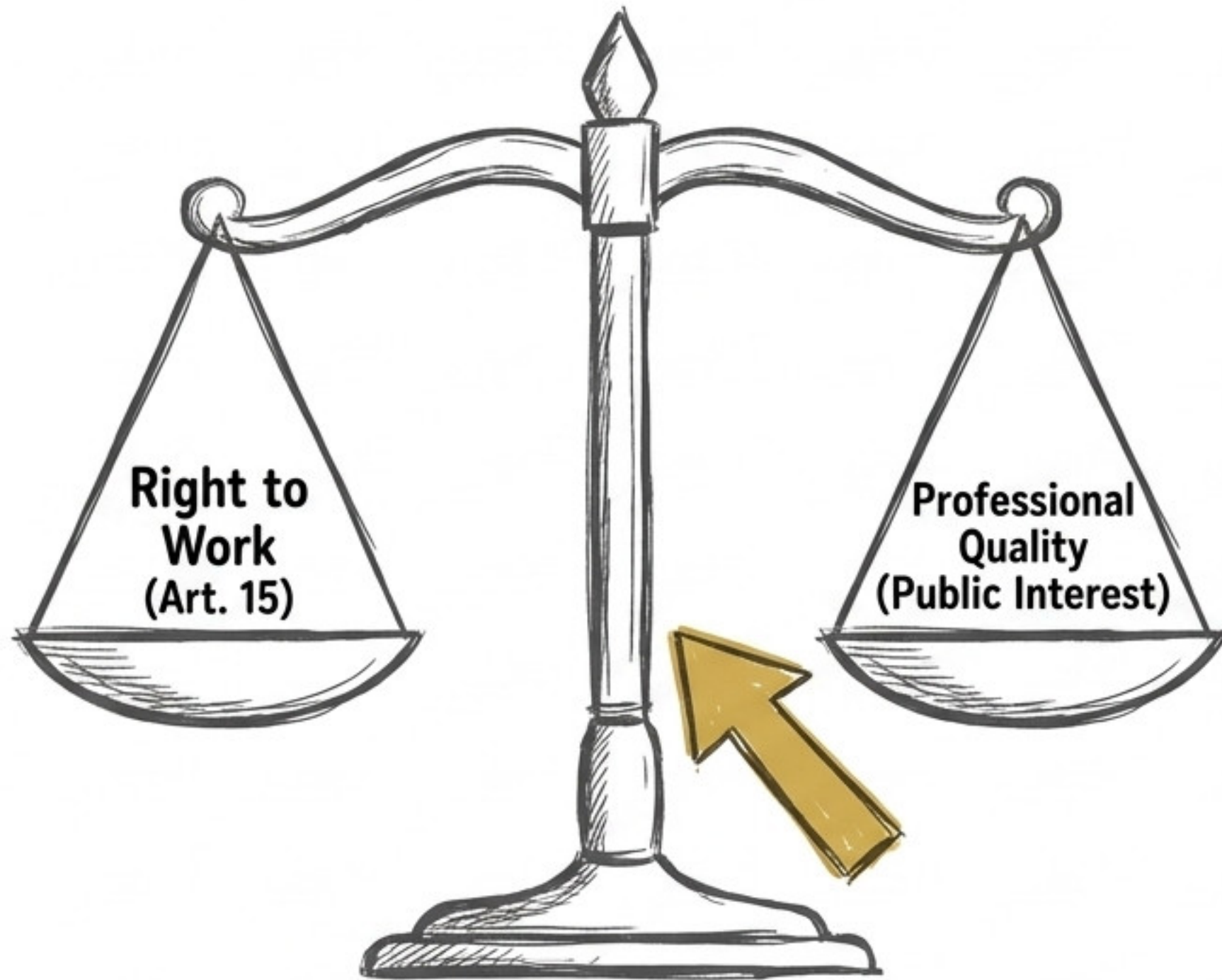
April 2022: Original application filed.



Nov-Dec 2022: Narrowed product scope & corrected company name translation.

Ruling: These are not new cases. They are supplementary actions tied inextricably to the Year 1 application.

Defense 1: Constitutionality & Right to Work



Plaintiff's Argument:

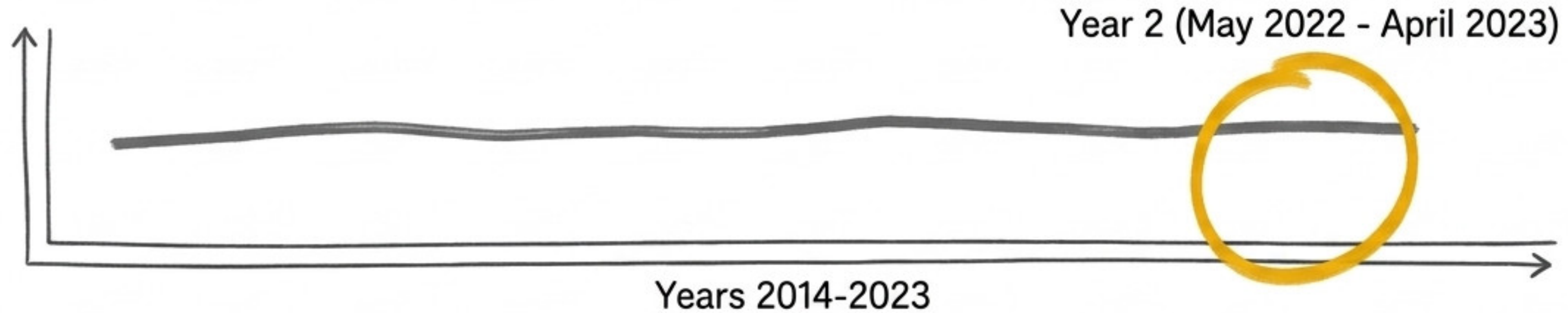
Requiring exactly 10 cases lacks a substantial connection to professional ability and unconstitutionally infringes on the Right to Work for existing practitioners.

Court's Verdict: Constitutional.

The mechanism ensures agents possess high-level expertise and ethical standards. The grandfather clause is a transitional accommodation, not a right.

Setting a numeric baseline (10 cases) is a proportionate and reasonable standard to prove substantial practical experience.

Defense 2: The Pandemic Hardship Claim



Plaintiff's Argument:

Year 2 fell during the peak of global COVID-19 disruptions. The 10-case rule should be relaxed under the Bailout and Economic Stimulus Special Act.

Court's Verdict: Invalid.

TIPO's annual report data proved that trademark renewals, transfers, and changes from 2021-2023 remained entirely stable compared to 2014-2020.

There is no statistical evidence that trademark proxy businesses suffered operational crises justifying a waiver of statutory requirements.

The Final Decision



DISMISSED

Plaintiff's Suit Dismissed.

The applicant failed to provide documentation of passing the official exam, lacked sufficient official review experience, AND failed to meet the strict legal definition of processing 10 independent cases annually during the transitional period. TIPO's refusal to entertain the application was entirely lawful.

Key Takeaways & Lessons



Quality Over Paperwork

Administrative supplements (correcting names, paying fees, submitting POAs) do not equal substantive proxy experience. Lawmakers require the completion of distinct legal procedures.



Strict Transitional Boundaries

Grandfather clauses designed to protect existing workers are strictly interpreted exceptions. Numeric thresholds cannot be bypassed using generalized excuses like the pandemic.



Certification is King

With the enforcement of the amended Trademark Act, the era of unregulated practice is over. Future practitioners must secure formal certification through TIPO's capability exams.