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Taiwan

Taiwan IP Court Clarifies Proof of Use in Trademark Non-use Cancellations: the IFIXIT CORPORATION Case

The non-use cancellation of IFIXIT trademark offers a glimpse of the Taiwan Intellectual Property Court's take on proof of use in trademark non-use cancellations, especially regarding generic and specific description of goods and services.

Case Fact

The renowned electronics equipment teardown and repair U. S. company IFIXIT CORPORATION (hereinafter "IFIXIT") requested for non-use cancellation (revocation) of the registered trademark "IFIXIT" owned by a natural person (hereinafter "contested mark") in Taiwan. The Taiwan Intellectual Property Office (IPO) accepted proof of use submitted by the trademark owner, ruling against the cancellation. After an appeal was also rejected, IFIXIT proceeded with an administrative proceeding. The Taiwan Intellectual Property Court (IP Court) overturned the rulings of the Petitions and Appeals Committee and the IPO, and declared partial cancellation of the contested mark in its *2018 Xingshangsuzi No. 134 Administrative Judgement*.

The IPO and the Petitions and Appeals Committee Ruling against the Cancellation

The Petitions and Appeals Committee confirmed the IPO decision and maintained the contested mark. The Committee held that the trademark owner has in fact showed genuine use for "SDS adapter," and that "SDS adapter" is of the same nature as the designated good "hand tools" of the contested mark. The Committee inferred that the contested mark is also used on other designated goods that are of similar nature, e.g., "screwdriver bits" and "wrenches," and maintained the IPO's decision against the cancellation.

The IP Court Declaring Partial Cancellation

The IP Court ruled for the cancellation for the reasons below:

1. The IP Court pointed out that the trademark owner only submitted proof of use for a single product “SDS adapter,” and that the IPO also admitted to not inspecting each item in the contested mark’s designated goods. According to the decision made at the 2010 Taiwan Judicial Yuan Intellectual Property Law Symposium¹, in the event that the trademark owner is unable to submit proof of use for all designated goods, the trademark registration for those goods which proof of use was not provided shall be revoked.
2. In addition, although the “SDS adapter” is a specific description of goods under the more generic description of goods “hand tools” in Class 8, its uses differ from the other designated goods also listed under “hand tools”, e.g., “screwdriver bits” and “wrenches”. The fact that the IPO and the Petitions and Appeals Committee considered that the trademark is used in all other specific goods under “hand tools” has already violated the *Supreme Administrative Court 2017 No. 163 Administrative Judgement*, stating that “the actual goods or services used shall correspond with those designated in the trademark registration. When the trademark is used on a specific good, it should be considered that the trademark is used on a more generic good as well, but not vice versa.” (For more information on specific and generic description of designated goods and services, take a look at [Wisdom News Volume 19](#))

In view of the reasons above, since proof of use for the designated goods other than “hand tools” was not submitted, the IP Court ruled that the trademark registration for those designated goods shall be cancelled.

Key Takeaways from the Decision

1. To prove the use of preserving the trademark rights, trademark owners shall provide proof of use for every designated goods and services in a non-use cancellation.
2. When determining “use of preserving the rights,” the concept of identity of the trademark shall not be expanded. One cannot claim the use of trademark on every specific goods under a generic good with the proof of use of only some of the specific goods.

¹ The purpose of the Taiwan Judicial Yuan Law Symposium is to make up for the inconsistency in the use of the law by the courts, and to brainstorm and unify legal opinions in order to bring consistency to the trials. The decisions made at the Symposium serve as a guide for future situations involving identical or similar facts, or similar legal issues.