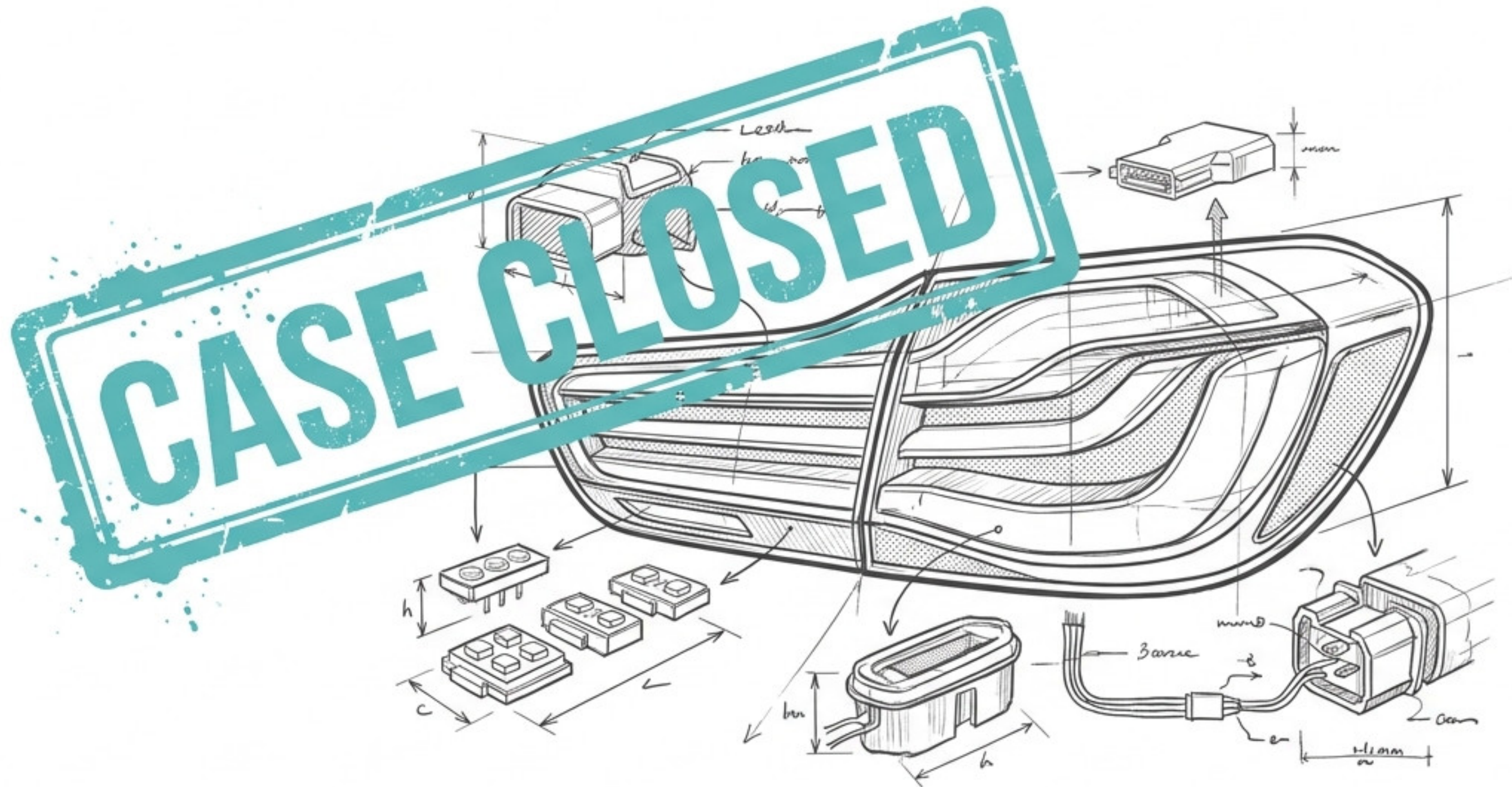




The Boundaries of Fair Use

An Analysis of the 'Mini & Wings'
Aftermarket Parts Trademark Dispute

Case Study based on actual judicial proceedings.

Intellectual Property and Commercial Court
Criminal Judgment 111 Xing-Zhi-Shang-Yi No. 48
Date: Feb 2, 2023

The Incident & The Evidence

CASE DOSSIER

The Defendant:	Huang O-Cheng, representative of Taiwan Zhi Guang International Trade Co., Ltd.
The Action:	Listed and sold aftermarket vehicle lights online under the title: Brand New MINI COOPER S F55 F56 14 15 16 UK Flag Style LED Taillights
The Accusation:	Selling trademark-infringing goods via the internet, a potential violation of Trademark Act Article 97.
The Trigger:	The Trademark Owner's personnel purchased the item online, sent it back to the original factory for verification, confirmed infringement, and reported it to the police.

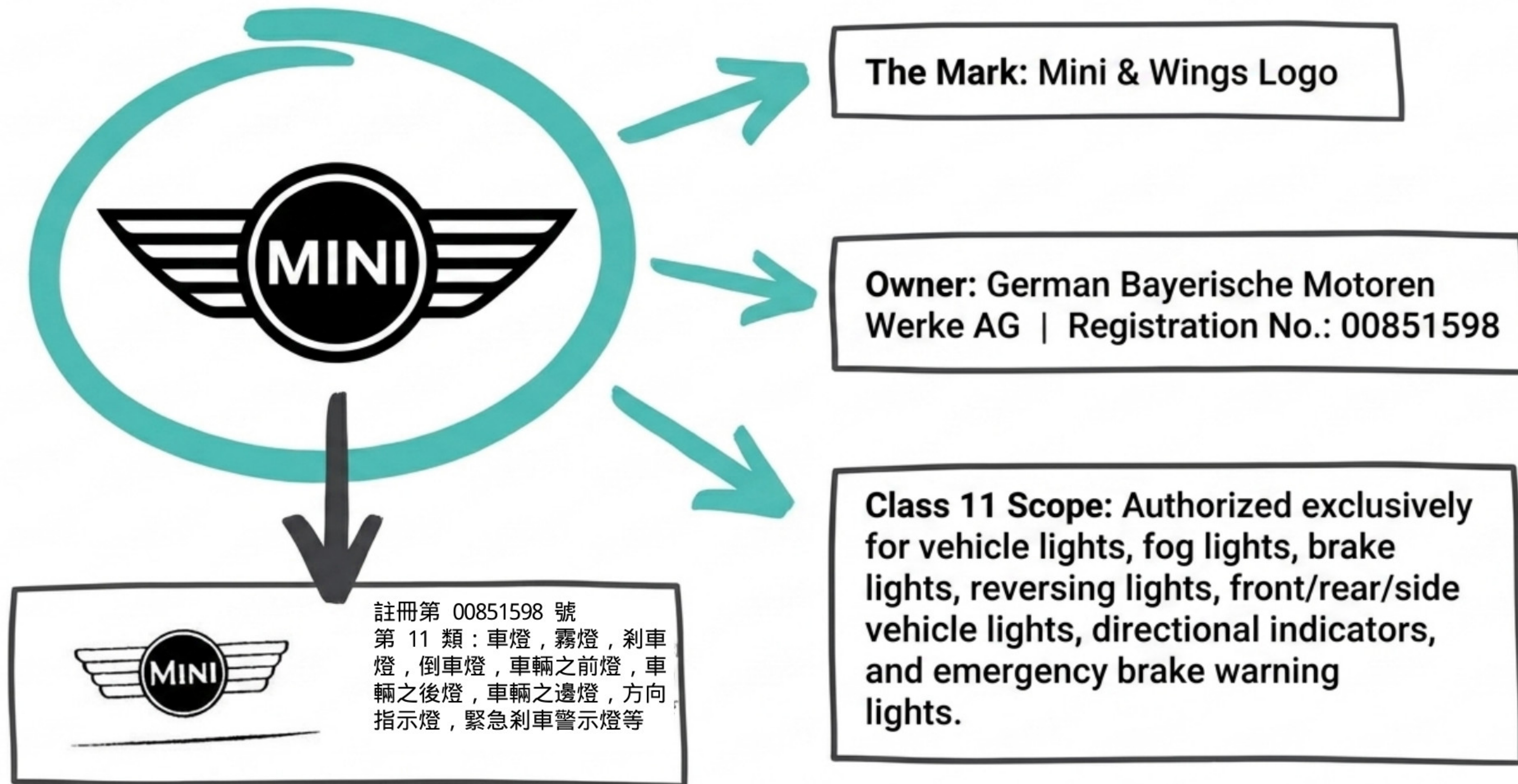


INFRINGING
PRODUCT

SOLD
ONLINE



The Protected Mark



The Accusation

“ The logo used on the product is highly similar to the registered mark and applied to identical goods (car lights).



Impact: It causes a Likelihood of Confusion among consumers regarding the source of the product.



The Defense

1

These are aftermarket parts. We never claimed they were original in the product or marketing.

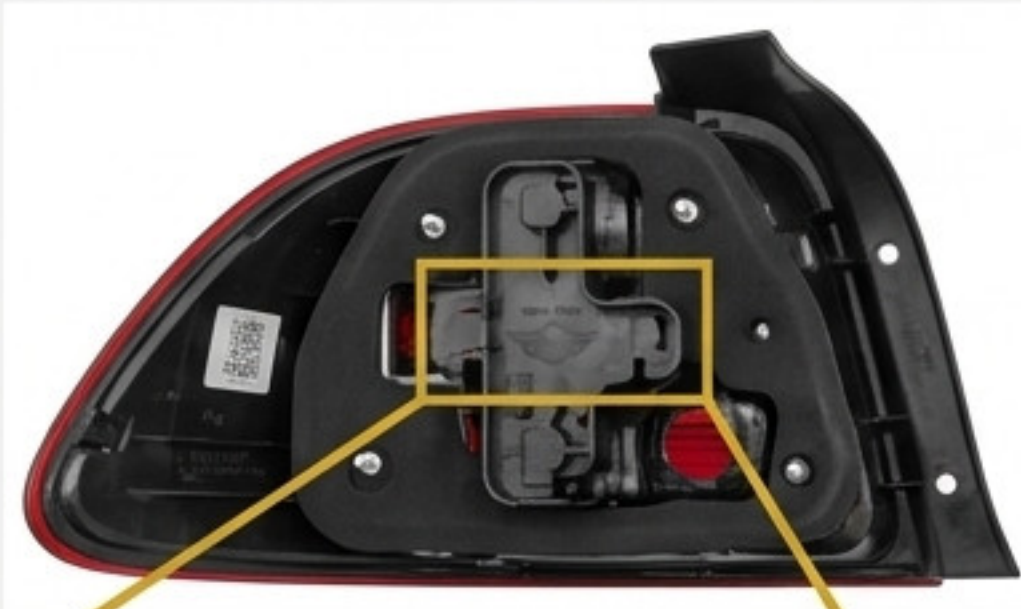
2

The logo isn't completely identical to the registered trademark.

3

The trademark owner acting as the purchaser is playing "player and referee." The verification lacks third-party objectivity!

Forensic Analysis: Likelihood of Confusion



The Alteration.

The central 'MINI' text was deliberately rubbed off and blurred by the manufacturer.

The Core Identifying Feature.

The black plastic backplate still clearly displays the design's main axis: four tapering feather lines forming wings on each side of the circle.

The Court's Finding: Despite the missing text, the overall composition and visual impression remain highly similar. Under isolated, holistic observation at different times and places, a consumer with ordinary knowledge would instantly form an impression of a relationship (same source, affiliation, or authorization) with the original brand.

The Primary Function of a Trademark = Source Identification.

Descriptive Fair Use

Using a mark to describe one's OWN product's shape, quality, nature, or origin in an honest manner.

Nominative Fair Use

Using another's mark to indicate the source of that OTHER product.

The Aftermarket Exception:
The classic example is using the mark to show that your own aftermarket parts are **COMPATIBLE** with the trademark owner's product.

Connecting Question: Did the defendant's product meet the strict requirements of Nominative Fair Use?

Flaw 1: The Product Layout



Strong Source Indicator:

The logo sits just below the text "Made in Poland". It is not a generic decoration. Its placement and prominent design give consumers a strong impression of source identity, constituting trademark use.

The Missing Context:

There is NO descriptive text (e.g., "Compatible with..", "Fits...") placed next to the logo.

The Court's Conclusion:

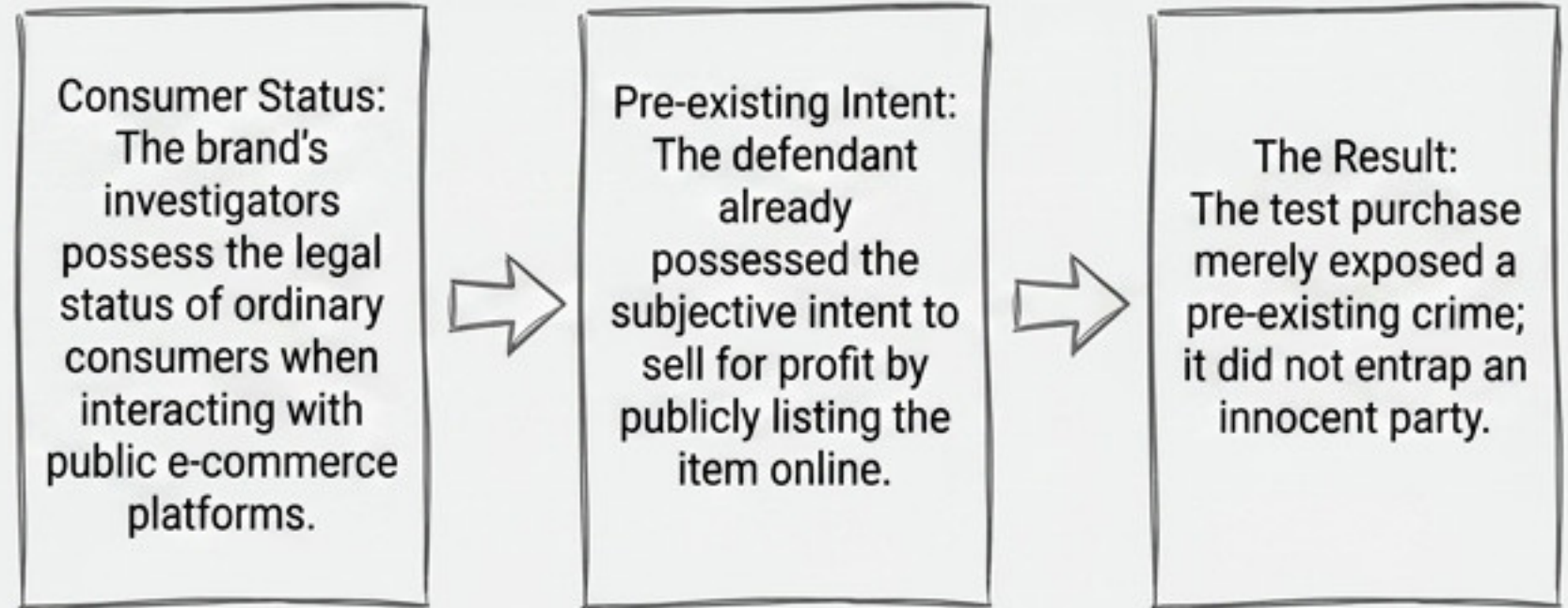
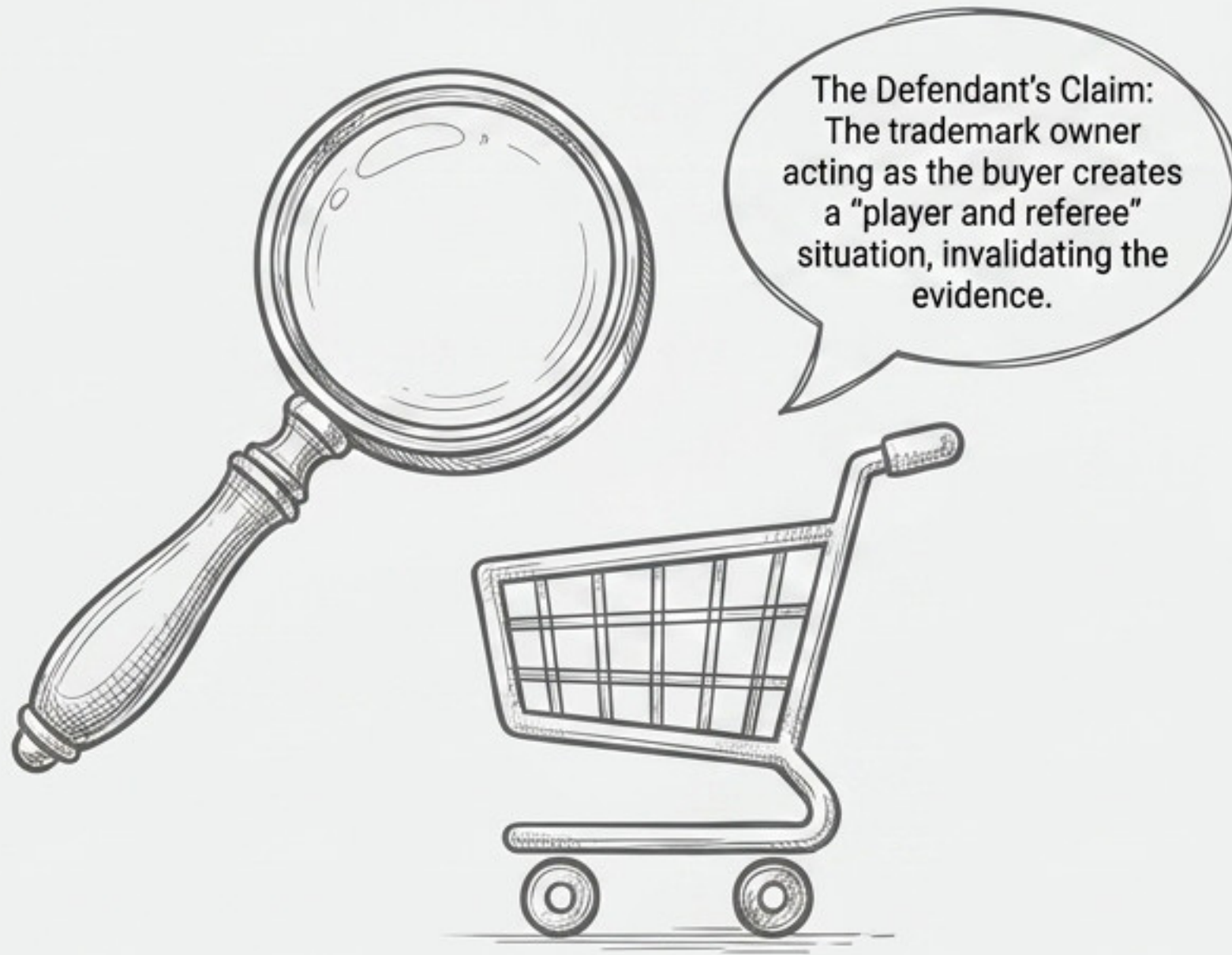
Without explanatory text, consumers cannot know the logo merely indicates compatibility. Therefore, placing the bare logo on the part exceeds the necessary and reasonable scope of Nominative Fair Use.

Flaw 2: The E-Commerce Listing



The Court's View: By using the brand's exact naming conventions without adding clear statements distancing themselves from the original manufacturer, the seller failed to use Honest Commercial Practices. It demonstrates a clear intent to free-ride on the original brand's fame.

Dismissing the “Trap Purchase” Defense



Legal Conclusion: The transaction constitutes a Legally Completed Sale. The evidence is entirely valid.

The Final Verdict



The Ruling:

Original judgment revoked. Defendant found GUILTY.

The Statute:

Violation of Trademark Act Article 97 (Selling infringing goods via internet).

The Penalty:

2 months imprisonment (commutable to a fine calculated at NT\$1,000 per day).

Asset Forfeiture:

All seized infringing goods (the taillights) are confiscated.

Unrecovered illegal criminal proceeds totaling NT\$9,923 are confiscated (or their value pursued for recovery).

Key Takeaways & Lessons (歸納判決重點與啟示)



1. **Similarity Overrides Alteration:** Simply rubbing out the text of a famous logo does not bypass infringement. If the overall visual impression (e.g., the wing shape) remains confusingly similar, it is an infringement.



2. **Context is King for Fair Use:** To claim 'Nominative Fair Use' for aftermarket compatibility, the product **MUST** include clear, explanatory text (e.g., 'Fits [Brand]'). A standalone symbol is not enough.



3. **Honest Marketing is Required:** E-commerce listings for third-party parts must contain clear disclaimers of non-affiliation. Using exact brand names without disclaimers is considered illegal 'free-riding'.



4. **Trap Purchases are Valid:** Evidence gathered via test purchases by brand owners is fully admissible if the seller already publicly displayed the intent to sell the items online.