

TRADEMARK REVOCATION: THE LIMITS OF MODIFIED USE

An Educational Analysis of Substantial
Identity in Trademark Law



Court: Intellectual Property and
Commercial Court (IPC Court)

Docket: Judgment 113 Xing Shang Su
No. 4 (2024)

Subject: Trademark Revocation
Action

Core Issue: Did the trademark owner
actually use the registered mark, or
did they alter it beyond recognition?

THE LEGAL FOUNDATION

Trademark Act, Article 63(1)(2)

A trademark registration shall be revoked if it has not been put to use, or such use has been suspended for **three continuous years** without justifiable reasons.



Substantial Identity
(Supreme Admin. Court Judgment
110 Shang No. 51)

Actual use must maintain the **Essential Identifying Features** of the registered mark.

- Identity Remains: Variations merely alter size, proportion, or font.
- Identity Lost: Core elements are deleted or major new elements are added.

DECONSTRUCTING THE DISPUTED MARK

What Exactly is Protected? (Reg. No. 01428901)

Solid Crown: The top leaf/crown portion is deliberately filled completely with black ink.



Empty Body: The lower semi-circle is intentionally left blank, creating a high-contrast, abstract shape.

Standard Text: Two simple horizontal characters placed directly beneath the graphic.

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Designated Goods: Class 05
(Agricultural Chemicals, Pesticides)

註冊第01428901 號
第005 類「黑穗病治療用化學製劑、農藥、農業用殺蟲劑、除草劑、誘蟲劑、驅鳥劑、除藻劑、展著劑、稻熱病用藥、農藥增效劑、土壤消毒劑、殺草劑、土壤殺菌劑、驅蟲劑、環境衛生用殺蟲劑、環境衛生用殺菌劑、驅蟻藥劑、環境衛生用消毒劑、殺蟲劑」商品

THE DISPUTE: TWO COMPETING NARRATIVES

We used it!

- The core brand name remains the same.
- The outer shape is just a common, unoriginal pineapple border.
- Adding English translations or product images does not change the core brand identity.

You created an entirely new mark.

- The original shape was an abstract, distinctive graphic.
- You completely filled the intentional empty space with new, complex graphics.
- You fundamentally rearranged the text layout.
- The resulting visual impression is completely severed from the original.

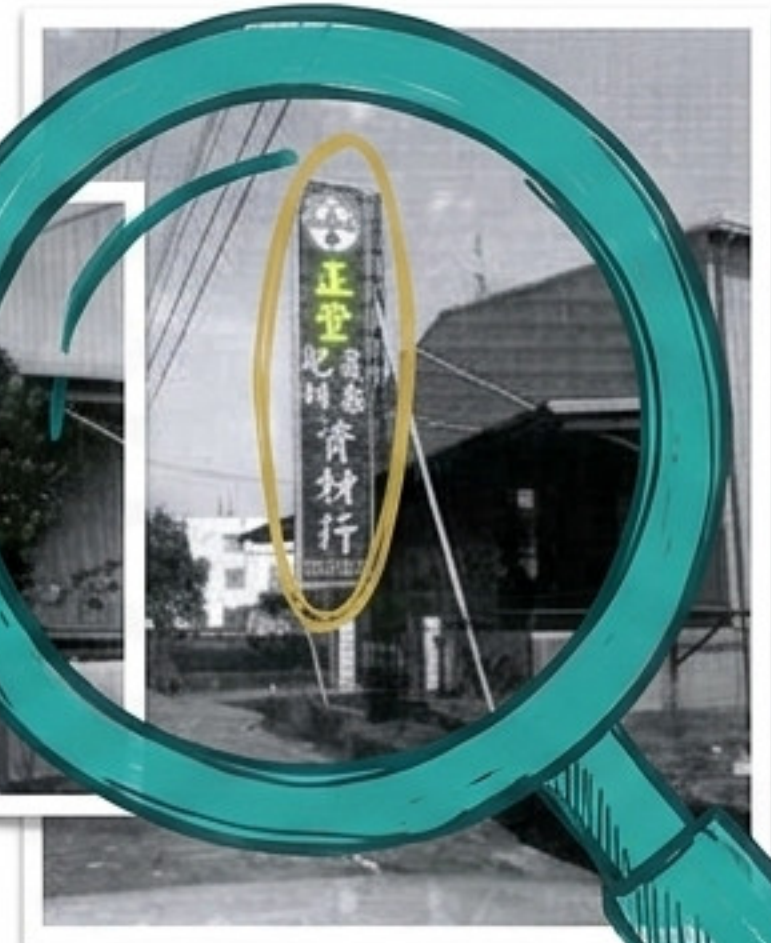
EVIDENCE I: THE SIGNBOARDS

Redesigning the Text Structure



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VS



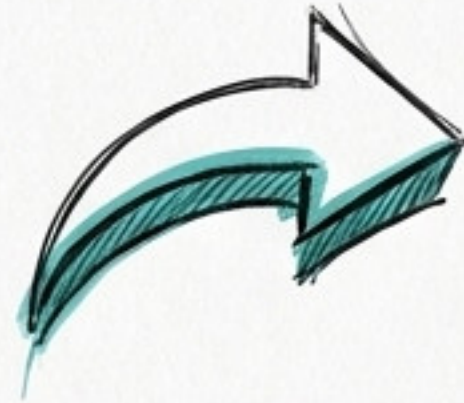
- **Cross-Shaped Layout:** The text was entirely rearranged from a simple horizontal line into a complex top-to-bottom / left-to-right cross formation.
- **Addition of English:** The foreign word 'CHENGFONG' was inserted directly into the center of the graphic.
- **The Verdict:** The unique abstract impression of the original mark was destroyed. The consumer sees a complex cross-logo, not the simple registered mark.

EVIDENCE II: THE PRODUCT PACKAGING

Filling the "Empty Space"



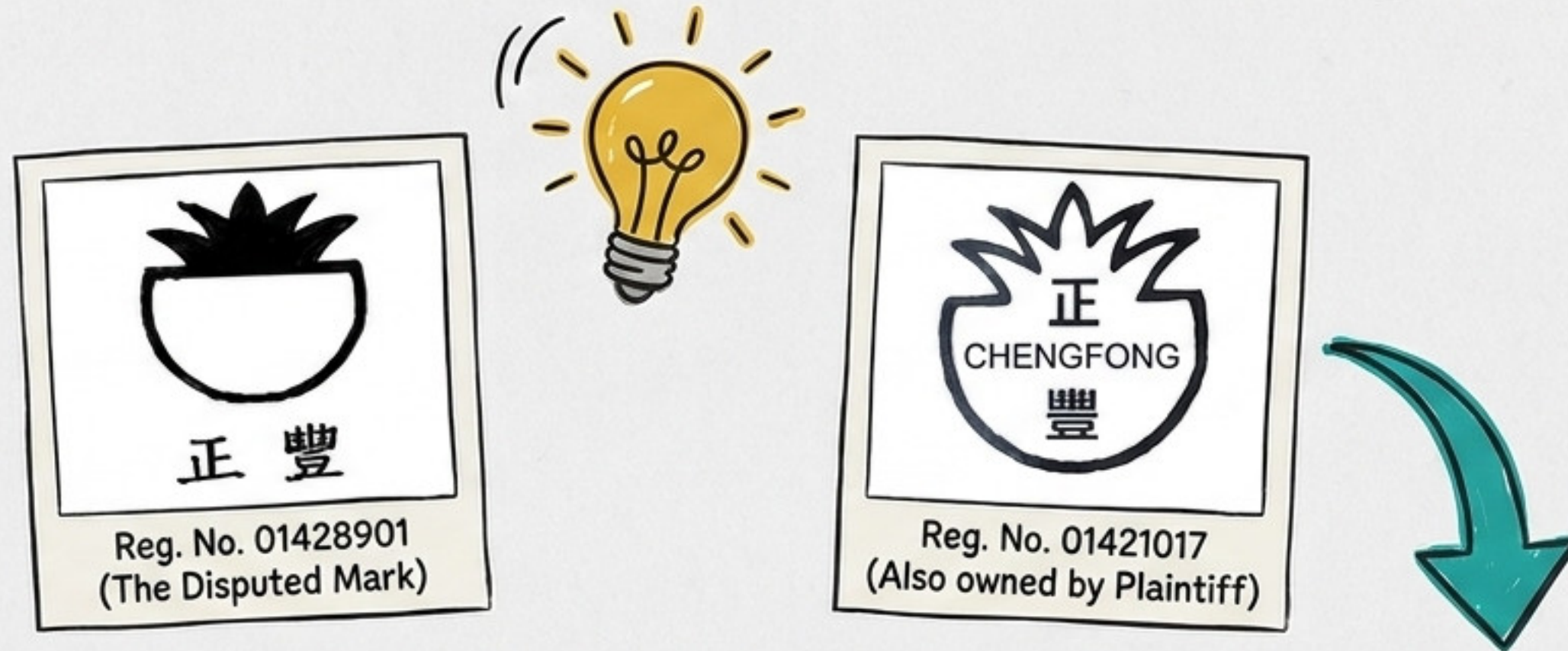
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- **Graphic Saturation:** The originally "empty" body of the graphic was saturated with detailed, literal illustrations of insects, soil, and crops.
- **Text Alteration:** The original simple text was removed or combined with product-specific variations.
- **The Verdict:** Adding major illustrative elements to a space deliberately designed as "blank" alters the overall visual identity. Substantial Identity is irrevocably lost.

THE DOUBLE REGISTRATION DILEMMA

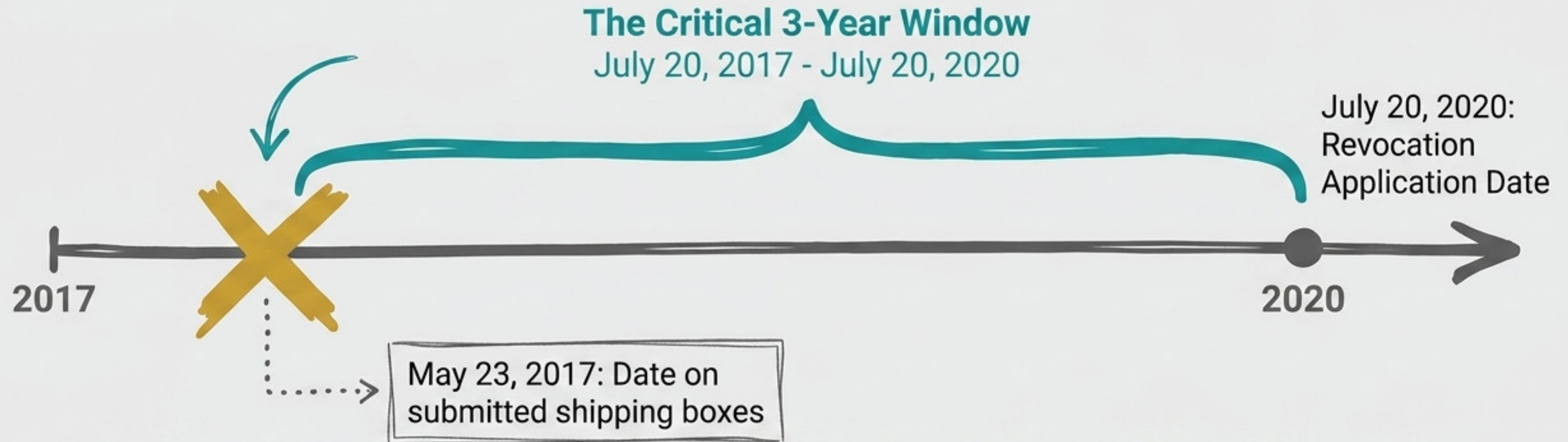
Plaintiff's Own Actions Contradict Their Argument



- The Plaintiff actually registered a second mark (Right) that perfectly matches the modified signboard design!
- Court's Logic: If the two designs were truly "substantially identical," there would have been no need to register them both separately.
- Using the design of the second mark cannot count as legally using the first mark.

THE TIMELINE TRAP

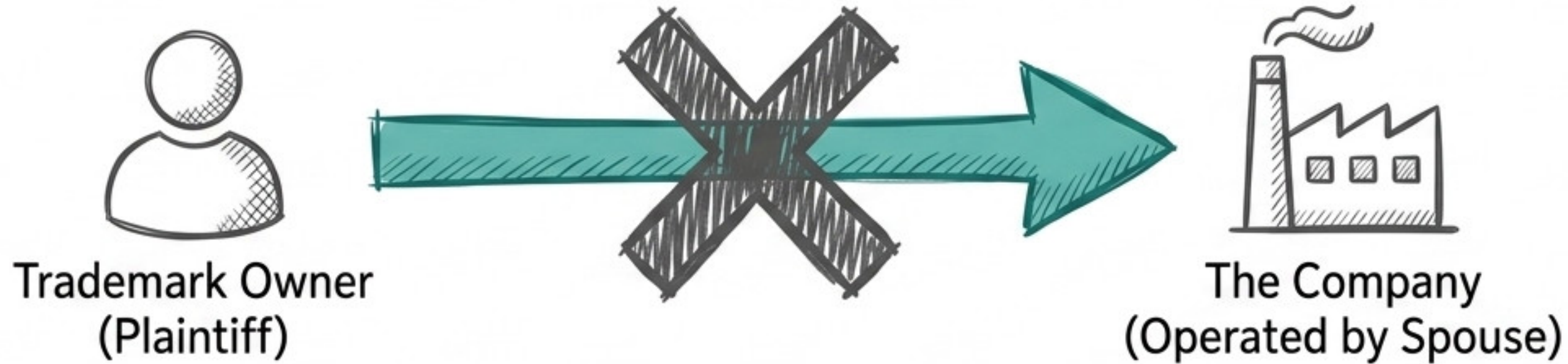
Evidence Must Fit the Statutory Window



Key Takeaway: Even if the mark was identical, timing is absolute. The law requires use within the three years immediately preceding the revocation action. Evidence from just two months before that window opens is legally irrelevant.

THE CORPORATE VEIL

Principle of Separate Legal Entities



The Argument:
Plaintiff claimed the mark was technically used by the corporate entity operated by her spouse.

The Legal Reality:

- A natural person and a corporation are distinct legal entities.
- No License: The plaintiff provided zero evidence of formal trademark authorization to the company.
- Leadership Gap: Official records proved the spouse was not the formal legal representative of the company during the critical 3-year window.
- Conclusion: A company's use does not automatically equal the owner's use.

SUBSTANTIAL IDENTITY MATRIX

Why the visual evidence failed the test

Visual Element	Registered Mark (Baseline)	Actual Market Use	Status
Crown Graphic	Solid ink, clean edges	Maintained shape	✓
Body Graphic	Empty / High Contrast	Filled with insects, crops, soil	✗
Text Content	Core Characters Only	Added "CHENG FONG" translation	✗
Text Layout	Horizontal at bottom	Cross-shaped internal integration	✗

The sum of modifications transformed the mark from an abstract symbol into a complex illustration. Identity is irrevocably lost.



JUDGMENT HIGHLIGHTS & KEY TAKEAWAYS

Lessons for IP Management



Use It As You Registered It: Modernizing or localizing a brand (e.g., adding English translations or product graphics) requires filing a new trademark application.



Negative Space Matters: In abstract marks, empty space is considered a deliberate design feature. Filling it changes the identity.



Watch the Clock: Maintain meticulous, date-stamped records of commercial use. The 3-year statutory clock is unforgiving.



Paperwork is Protection: If you own a mark personally but use it through a company, execute and officially record a formal licensing agreement. Do not rely on “informal family operations.”