



To the Chief Justice of the Supreme Court of the Republic of Indonesia:

Regarding: Intel Corporation v. Pt. Panggung Electric Corporation, Supreme Court of the Republic of Indonesia, Case Nos. 43 & 44/MEREK/2006/ PN.NIAGA.JKT.PST:

The International Trademark Association (INTA) respectfully submits herewith this brief to the Indonesian Supreme Court in order to assist on the issue of registration of marks in bad faith, a major issue in this dispute. INTA respectfully requests the Honorable Supreme Court to consider the content of this brief when taking its position on this case.

1. Identity and Expertise of INTA

INTA is a 128-year old not-for-profit organization dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. INTA has over 5,000 members in more than 190 countries. The association is global and crosses all industry lines, including manufacturers and retailers in industries ranging from aerospace to consumer goods. INTA currently has thirty-eight (38) members in the Republic of Indonesia.

Since 1916, INTA has acted in the capacity of advisor and has appeared as *amicus curiae* [“friend of the Court”] in several jurisdictions. INTA presents itself as a “friend of the Court” in this matter. Attached to this brief (as Appendix A) is a list of cases throughout the world in which INTA has submitted amicus briefs and similar types of submissions, including an amicus brief to the Indonesian Supreme Court on October 10, 2002 in the trademark case *Intel v. PT Panggung Electronics Industries* (590PK/PDT/2001).

INTA members are interested in the development of clear and consistent principles of trademark and unfair competition laws around the world. INTA actively participates in all trademark-related proposals at the World Intellectual Property Organization (WIPO) and has been an official non-governmental observer to WIPO since 1979. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty and is active in other international arenas including the Asia Pacific Economic Cooperation Forum (APEC), the Association of Southeast Asia Nations (ASEAN), the European Union (EU) and the World Trade Organization (WTO). INTA's membership is varied and extensive and it is

a balanced and reliable representative body. INTA's international membership enables it to bring a global approach to the issues at stake.

INTA respectfully submits herewith this brief in the hope that it may assist the Court by sharing the experience of this international group of trademark owners and practitioners. INTA believes that this case is significant to the development of international trademark law, with regard to the issue of determining the correct test for deregistration of a mark in the event of non-use. Specifically, INTA respectfully submits that it is the period of non use and not the exact date of last use which determines whether a trademark qualifies for deregistration.

2. INTA's Model Law Guidelines

INTA supports and encourages protection of legitimate trademark rights by prescribing minimum standards of use and has developed “**Model Law Guidelines – A Report on Consensus Points for Trademark Laws**” containing recommendations on provisions regarding cancellation of trademark registrations in the event of non-use. The relevant portions of the same are reproduced below:-

Proposal 1.2

Trademark registrations should be capable of cancellation at the application of any person if they are not used at any time within a continuous period [minimum three years; maximum five years] after the date when all procedures for registration of that mark have been completed [i.e. after exhaustion of any periods post-registration whereby the registration may be opposed provided that such periods comply with Proposal 6 below].

Rationale:

The time at which cancellation for non-use is possible should run from the date at which all registration procedures are completed rather than the date of application. It would be unfair to select the latter date because it is not until registration has been achieved that the trader can be confident that it has secured rights to the exclusive use of the mark and can sell goods under the mark without the risk of an infringement action. (This proposal extends but it is not inconsistent with TRIPS Article 15.3 which requires that “an application shall not be refused solely on the ground that the intended use has not taken place before the expiry of a period of three years from the date of application”). The non-use period has been set at three (3) to five (5) years because five (5) years is the standard in Europe as a result of the EC Harmonization Directive¹ (“the Directive”) and the period of three (3) years stipulated in TRIPS is a minimum standard.

¹ First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trademarks (89/104/EEC).

3. Summary of Procedural and General History of the case

According to the court documents relating to the case:-

The Appellant, Intel Corporation (“Intel”) is incorporated in Delaware, USA. It was established in 1968 and since then has used the name and trademark “INTEL” with respect to microprocessors and, in general, computers, communication equipment, consumer electronics and the internet. Intel’s mark is famous worldwide and is registered as a trademark for a wide variety of goods, in particular in class 9, in many countries throughout the world. On 1 December 1984, Intel registered the trademark “INTEL” in Indonesia in class 9 with respect to “micro computers, micro controlling tools and micro processing tools” under number IDM12162. Intel is also the owner of Indonesian registration no.451597 in class 9 for cameras, etc dated 14 August 2000 and Indonesian registration no.564223 in class 9 for computers, etc dated 25 February 2004. It also has Indonesian registrations in classes 14, 16, 18, 21, 25, 28, 36, 38 and 42 dated between 1998 and 2002.

The Appellee, Pt Panggung Electric Corporation (“PEC”) is incorporated in Indonesia. On 4 November 1986 PEC registered in Indonesia the mark “INTEL” for “radio, radio cassette recorder, tuner receiver, transceiver, black and white television, color television, audio tape deck, video cassette recorder, video camera, video cassette player, video disc, compact disc player, video turntable, audio turntable, etc” in class 9 under number 363074. On the same date PEC registered in Indonesia the mark “INTEL” for various goods in classes 7, 10, 11, 15 and 20 under numbers 363073 and 363075-8.

Intel became aware of PEC’s registrations and in January 1993 commenced action to cancel those registrations on the basis of its prior rights. The Court issued its decision in favour of PEC and Intel filed an appeal to the Supreme Court of Indonesia which was also unsuccessful. Intel’s further and final appeal was also rejected and the INTA amicus brief filed in support of this appeal appears not to have been considered by the court.

On 16 May 2006, Intel commenced action (number 43) to cancel PEC’s registrations numbered 363073 and 363075-8 for the mark “INTEL” in classes 7, 10, 11, 15 and 20, and action (number 44) to cancel PEC’s registration number 363074 in class 9, on the grounds of non-use of the registered trademark in respect of the registered goods.

The relevant provisions of the Trade Mark Law No. 15 of 2001 pertaining to the cancellation of a registered trademark for non-use of the registered mark are Articles 61 and 63 as follows:

Article 61 (2):

Deregistration of a trademark registration on the initiative of the Directorate General may be made if:

- a. the trademark has not been used for three (3) years consecutively in trading of goods and/or services as of the registration date or the last use, unless there are reasons acceptable to the Directorate General

Article 63:

Deregistration of the trademark based on reasons as referred to in Article 61 paragraph (2) items (a) and (b) can also be filed by a third party in terms of a suit to the Commercial Court.

On 13 September, 2006, the Commercial Court of Central Jakarta gave a decision against Intel on the following grounds:

1. the evidence submitted by Intel established that PEC had not used the "INTEL" mark on the registered goods over the past three (3) years. Intel submitted as evidence:
 - a. a market survey conducted in 160 stores in 6 large towns in Indonesia;
 - b. independent investigation of several of PEC's branch offices; and
 - c. a review of Yellow Pages 2000-2006.
2. the evidence submitted by PEC failed to establish any use of the "INTEL" mark on the goods over the past three (3) years.
3. Intel failed to argue that the trademark had not been used as of the registration date or the last use in accordance with Article 61.
4. If it is to be from the registration date, the non-use must be from 4 November 1986 which is the registration date of PEC's registrations.
5. Taking into account Exhibit T-3 being the judgment of the District Court of Central Jakarta dated 16 September 1993, there was proof that PEC used the trademark on electronic goods at least in 1993.
6. Intel failed to establish the date of last use of the "INTEL" mark by PEC on electronic goods. Therefore the term of non-use from the date of last use referred to in Article 61 cannot be calculated and this term of non-use is only estimation.
7. Therefore Intel's case is obscure and not proven.

Thus, despite a clear factual finding of non-use for three (3) consecutive years as of registration date or latest use, the Court held against Intel only because of “failure” to clearly mention “the latest use of the brand by the Defendant” thereby rendering the “calculation of term as mentioned in Article 61” difficult.

On 11 October 2006, Intel filed an appeal in this Court against the said decision. PEC also filed cross-appeals against the first instance decisions, challenging the findings of fact relating to non-use and the non-use periods.

The more general and significant issue that arises for consideration in this case, and with regard to which INTA seeks to assist this Court as *amicus curiae*, is the manner of applying the legal provision relating to deregistration and in particular, the manner of computing the three (3) year period.

4. The History of the provision

The Indonesian Trade Mark Act of 1961 already contained a provision similar to the actual one. This Act was in part based on the former Dutch Trade Mark Act of 1893 as amended in 1956. The Dutch Act of 1893 has for a long period been valid in Indonesia at the time "Nederlandsch Indië", the predecessor of Indonesia, was part of the Kingdom of The Netherlands. Art. 3 section 1 of the Dutch Act of 1893 provided that the right to exclusive use of a trademark to distinguish one's products belongs to the person who has made use of it for such purpose in the Kingdom for the first time, but only for those products for which he has been using it and no longer than three years after the last use. So the exclusive right to use lapsed if no use had been made for more than three years after the last use. The Supreme Court of The Netherlands decided in 1940 in the *Trybol*-case that this provision was equally valid for registered trademarks. With respect to the burden of proof it was the general point of view that in principle the burden of proving non-use rests with the person invoking non-use. However since it was felt that the trademark owner was in a better position to provide data with respect to the use and since having to prove negative facts would be a *probatio diabolica*, the Supreme Court of The Netherlands decided in 1957 in the *Elkington*-case that if the person invoking lapse of rights gives good reasons why he thinks the mark has not been used, the courts could ask the trademark owner to provide data regarding his use. A simple denial by the trademark owner of the position by the person invoking non use would be disregarded by the court.

5. International Principles on non-use

The international principles and yardsticks governing non-use as a ground for deregistration of a mark are fairly well settled and unanimous. As a member of the Paris Convention for the Protection of Industrial Property and a signatory to the World Trade Organization's TRIPS Agreement, Indonesia has an international obligation to rationally apply and give effect to these principles.

A list of twenty eight (28) countries and a short statement of their relevant provisions on cancellation action on the ground of non-use are included in Appendix B to this brief. The laws in each of those jurisdictions show that the key element of the non-use provision is that after the mark is registered and has not been used for a prescribed consecutive period, it can be cancelled for non-use. The exact date of last use has no bearing on the issue.

6. Application of Article 61(2) in the light of International Principles

INTA respectfully submits that the Commercial Court failed to appreciate that it is the period of non use and not the exact date of last use which determines whether a trademark qualifies for deregistration. Article 61(2) imposes a mandatory condition that a period of 3 (three) consecutive years of non-use must have passed before a trademark can be deregistered. The exact date of last use is irrelevant as long as this mandatory condition is satisfied. Having regard to the purpose of the provision – that is to provide the ability to remove trademarks which have not been used for the specified three [3] year period, it is apparent that the words “as of the registration date or last use” occurring in Article 61(2) are intended to only emphasize this condition and have no other significance.

The Commercial Court erred in coming to the conclusion that the suit was obscure merely because the exact date of last use could not be established. This conclusion of the Commercial Court, even after giving a factual finding of non-use for three (3) consecutive years, is inconsistent with both the language and intent of Article 61(2). It is also inconsistent with the international approach in this regard.

The insistence on the exact date of last use inevitably leads to absurd consequences. For instance, even in a situation where the Defendant has abandoned its trademark and three (3) consecutive years of non-use have passed, an action under Article 61(2) would be unsustainable for want of the exact date of last use. In such a situation, and even otherwise, the establishment of the exact date of last use would often be an impossible and unnecessary burden on the applicant for cancellation. This difficulty would often be even more pronounced, for example, in the case of a trademark which had not been used for an even longer period of, say, twenty (20) years or more. In such cases, there is a real prospect that there would no longer be any evidence in existence which shows the actual date of last use.

Indeed, in the non-class 9 action in the present case, the Commercial Court held that there was never any use of the mark at all, so the date of last use is not even applicable.

In INTA's respectful submission, it would be incongruous and utterly contrary to the object sought to be achieved by a provision such as Article 61(2), to require

that the Plaintiff satisfy a meaningless additional burden to establish the exact date of last use even when demonstrably, such use (if at all) took place more than three (3) years previous. For sustaining a non-use action, the only question to be posed is whether there has been non-use for a consecutive period of 3 years. This is the test which is applied across jurisdictions. INTA submits that this is the only rational approach and imperative to provide a means for legitimate brand owners to recover their marks, to prevent unfair warehousing of marks and to prevent accumulation of “deadwood” on trademarks registers around the world.

CONCLUSION

INTA hopes that by submitting this brief in its capacity of *amicus curiae*, it will be able to assist the Supreme Court in developing some consistent guidelines to reduce the number of similar cases; to ensure that the lower courts correctly implement Article 61(2) in a manner consistent with international standards in cases relating to non-use.

Sincerely,

A handwritten signature in black ink, appearing to read "Alan C. Drewsen". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

Alan C. Drewsen
Executive Director

APPENDIX A

The International Trademark Association has filed the following *amicus*-type submissions in cases before European courts:

- Letter of submission to Bovemij Verzekeringen N.V. on June 17, 2005 in the case *Bovemij Verzekeringen N. V. v. Benelux Merkenbureau* (ECJ - C-108/05).
- Letter of submission to Schering-Plough Ltd. on December 5, 2003 in the trademark case *Schering-Plough Ltd v. European Commission and EMEA* (CFI T-133/03).
- Letter of submission to Merck Inc. on April 4, 2003 in the trademark case *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B.V. and MSD (Norge) A/S* (EFTA Court E-3/02).
- Letter of submission to Praktiker Bau - und Heimwerkermärkte AG on March 20, 2003 in the trademark case *Praktiker Bau – und Heimwerkermärkte AG* (ECJ C-418/02).
- Letter of submission to Shield Mark on November 1, 2001 in the trademark case *Shield Mark v. J. Kist* (ECJ C-283/01).
- Letter of submission to Libertel Groep B.V. on July 6, 2001 in the trademark case *Libertel Groep B.V. v. Benelux Merkenbureau* (ECJ - C- 104/01)/
- Letter of submission to Glaxo Wellcome Limited on October 10, 2000 in the trademark case *Glaxo Wellcome Limited v. Dowelhurst Limited and Swingward Limited* (ECJ - C-143/00).

The International Trademark Association filed the following *amicus curiae* briefs before the United States Supreme Court and other United States Federal Courts:

- *Contessa Premium Foods, Inc. v. Berdex Seafood, Inc. et. al.*, 126 S. Ct. 472 (2005) (petition for certiorari).
- *Test Masters Educational Services, Inc. v. Singh and Singh v. Test Masters Educational Services*, 428 F.3d 559 (5th Cir. 2005).
- *KP Permanent Make-Up, Inc, v. Lasting Impression Inc. and MCN International Inc.*, 125 S. Ct. 542 (2004).

- *JSL Corp. v. Visa International Services Ass'n; Dastar Corporation v. Twentieth Century Fox Film Corporation, SFM Entertainment LLC and New Line Home Video, Inc.*, 540 U.S. 806 (2003).
- *Mosely v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).
- *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).
- *Wai-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000)
- *College Sav, Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999).
- *Dickinson v. Zurko*, 527 U.S. 150 (1999).
- *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).
- *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).
- *KMart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988).
- *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996).
- *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996).
- *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994).

The International Trademark Association has filed the following *amicus-type* submissions and affidavits in jurisdictions outside Europe and the United States:

- Factum to the Supreme Court of Canada on July 4, 2005 in the case of *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Les Boutiques Cliquot Ltee, Mademoiselle Charmante Inc. and 3017320 Canada Inc.*
- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on August 15, 2005 in the trademark case *Tungsway Food & Beverage Holdings, Pte Ltd v. PT Istana Pualam Kristal*.
- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on November 30, 2004 in the trademark case *French Connection Ltd v. DB Mirchandani* (No.26/Trademark/2004/PN.NIAGAJKT.PST).
- Letter of submission to the Supreme Court of Justice of Paraguay on March

26, 2003, in the trademark case *Tabacalera Boquerón SA. vs. Nobleza Piccardo SACI and/or BAT and/or BAT BRANDS Limited* (Report No. 47/97, Inter-Am. C.H.R., OEA/Ser.L./V/II95 Doc. 7 rev. at 225(1997)).

- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on April 11, 2004, in the trademark case *Davidoff & Cie S.A. v. N.V. Sumatra Tobacco Trading Company* (53/MEREK/2002/PN.N1AGA.JKT.PST).
- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia, on December 23, 2002 in the trademark case *Intel v. Hanitio Luwi* (3535K/PDT/2001).
- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on October 10, 2002 in the trademark case *Intel v. PT Panggung Electronics Industries* (590PK/PDT/2001).
- Brief of *amicus curiae* in the Supreme Court of Korea on September 27, 2003 in the trademark case *Prefel v. Jae Ik Choi* (2001-HU-1358-10 December 2002).
- Letter of submission to the Beijing High Court, Intellectual Property Tribunal on October 11, 2000 in the trademark case *Ikea Inter-Systems Inc. v. Beijing Cinet co Ltd*, (2000) Gao Zhi Zhong Zi No. 76.
- Affidavit to the Moscow City Court (Russia) on April 9, 1998 in the trademark case *Heublein Inc. v. Appeals Chamber of Rospatent* (Civil case No. 3-7/98).
- Affidavit to the Supreme Court of South Africa (Durban and Coast Local Division) on November 8, 1995 in the trademark case *McDonald's Corporation v. DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited* (1997 1 SA 1 (A)).

APPENDIX B

The following are provisions on cancellation action on the ground of non-use in twenty-eight (28) jurisdictions around the world:

Andorra

If a mark is not used without good reason for any period of five (5) consecutive years before the cancellation action is presented, it becomes vulnerable to cancellation for non-use.

Antigua

Local Applications: if the registered proprietor is not engaged in any business related to the goods, in respect of which the trademark is registered, for any period of five (5) consecutive years following registration, registration becomes vulnerable to a cancellation action. Non-use is counted from the filing date of the original trademark application.

U.K. Extensions: not applicable.

Armenia

Registration becomes vulnerable to cancellation if the trademark is not used for any five (5) successive year period, unless the registered proprietor can prove that non-use is not due to his fault. Non-use may be counted from the date of registration.

Australia

A registered trademark may be cancelled at any time on the basis of lack of intention to use as at the date of filing of the application for registration. An application for the removal of a trademark from the Register on the ground of non-use may be made at any time after the filing date in respect of the application for registration, but not before five (5) years has passed from that filing date. A trademark may be removed from the Register if there is no use of the mark in the preceding three (3) years ending one (1) month prior to the filing date of the application to remove.

Azerbaijan

A mark may become subject to cancellation proceedings if it is not used for any period of five (5) consecutive years following registration. Advertising,

publication in Azeri newspapers, and presentation of goods with the mark at exhibitions in Azerbaijan constitute valid use. Non-use may be counted from the grant date of the original trademark registration.

Bangladesh

If the mark has not been used for any consecutive period of five (5) years, one (1) month and one (1) day subsequent to registration, it becomes vulnerable to a cancellation action. Non-use may be counted from the grant date of the original trademark registration.

Belarus

Registration becomes vulnerable to a cancellation action, after a period of five (5) years of non-use. The period of non-use may be counted from the filing date of the original trademark application.

Brazil

If the mark is not used for any period of five (5) consecutive years after registration, it becomes vulnerable to a cancellation action. The period of non-use may be counted from the grant date of the original trademark registration.

China

If there is no use of the mark for any period of three (3) consecutive years after registration, registration is considered void and any person can apply for cancellation. The period of non use may be counted from the date of registration of the original trademark.

Czech Republic

If the mark is not used for any period of five (5) consecutive years prior to the initiation of the cancellation proceeding, it becomes vulnerable to an application for cancellation.

Denmark

If there is no use or use of the mark has been suspended within the jurisdiction for a five (5) year period following completion of the registration procedure, the mark becomes vulnerable to a cancellation action. The period of non-use is calculated from the date of the finalisation of the registration procedure, i.e.:

- two (2) months from the date of publication, if no opposition is filed, or
- the date of the final decision on opposition proceedings.

Egypt

If the mark is not used for any period of five (5) consecutive years following registration, it becomes vulnerable to a cancellation action. The period of non use may be counted from the registration date of the original trademark registration.

Republic of Estonia

If the trademark is not used for any period of five (5) successive years following registration, it becomes vulnerable to the application of revocation. Non use may be counted from the date of entry in the Register.

Finland

If the mark is not used for any period of five (5) consecutive years after registration, it becomes vulnerable to a cancellation action. Non use may be counted from the grant date of the original trademark registration.

France

If the mark is not used for any period of five (5) consecutive years after registration, it becomes vulnerable to an action for cancellation. The period of non use may be counted from the date of registration.

Germany

If the mark is not used for any period of five (5) consecutive years following registration, it becomes vulnerable to cancellation. The term of non-use is counted from the date of final registration. If no opposition is filed then the date of final registration is the date of the preliminary registration. In case of opposition the final registration date is the date when the opposition proceedings are terminated. This date is published in the "Markenblatt".

Republic of Iceland

The registration of a trademark may be revoked if there has been no genuine use of the trademark within the period of five (5) years following the date of publication of the registration of the registration.

North Korea

If a mark is not used for any period of five (5) consecutive years following registration it becomes vulnerable to cancellation. The period of non-use may be counted from the filing date of the original trademark application.

South Korea

Registration becomes vulnerable to cancellation if the mark is not used for a period of more than three (3) consecutive years prior to the filing date of a non-use cancellation action. The period of non use may be counted from the filing date of the cancellation action.

Kuwait

If the mark is not used for any period of five (5) consecutive years after registration, it becomes vulnerable to a cancellation action. Non-use can be counted from the date of registration.

Liechtenstein

Registration becomes vulnerable to cancellation if the mark has not been used for any period of five (5) consecutive years following registration. Use within the territory of the European Economic Area or Switzerland is equivalent to use in Liechtenstein. The period of non-use is counted from the grant date of the original trademark registration.

Mexico

If the mark is not used for any period of three (3) consecutive years following registration, it becomes vulnerable to a “lapsing” action. The administrative procedure for “lapsing” of a trademark may also be declared ex officio. The period of non-use is calculated from the date on which the publication of the registration in the Gazette becomes effective.

New Zealand

If a mark is not used or use is suspended for any period of three (3) consecutive years it becomes vulnerable to cancellation. The period of non-use is calculated from the grant date of the original trademark registration.

Russian Federation

If there is no use of the mark during a three (3) year period immediately prior to the cancellation action, registration becomes vulnerable to cancellation. The period of non-use may be calculated from the date of registration.

Hong Kong

If the mark is not used for any period of three (3) consecutive years from any date following registration it becomes vulnerable to a cancellation (revocation) action.

Malaysia

The mark will become vulnerable to an application for cancellation if for up to one (1) month before the date of the application for cancellation a continuous period of not less than three (3) years had elapsed during which the trademark was a registered trademark and during which there was no use in good faith of the trademark (in relation to the goods and/or services for which it had been registered) by the registered proprietor or registered user of the trademark for the time being.

Singapore

If there has been no use of a trademark for a continuous period of five (5) years ending one (1) month before the filing date of the application for cancellation, the registration will be vulnerable to cancellation. The trademark must be registered for a period of five years before a cancellation action can be filed for non-use.

USA

Affidavits showing use or justifiable non-use must be filed before the end of the sixth (6th) year of the first registration term and within the year prior to expiration of the term of registration, otherwise registration is cancelled automatically.

In addition the mark is vulnerable to cancellation if there is no use for any period of three (3) consecutive years after registration.