

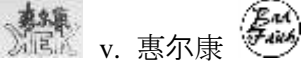











TM5 Bad Faith Project

Case Examples of Bad-Faith Trademark Filings
































Updated December 2019
in cooperation with INTA










































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Note :

【JPO-15】  v. 							
1. Title	 v. 						
2. Country	Japan						
3. Court	Intellectual Property High Court						
4. Case No.	2017(Gyo-ke)10080						
5. Date of the judgment	2017/12/25						
6. Parties : Plaintiff	Red Bull Aktiengesellschaft						
Defendant	Bruno Co., Ltd.						
7. Mark	<table border="1"> <tr> <td>Plaintiff (cited trademark = trademark in Use 2 (above), trademark in Use 1 (below))</td> <td>Defendant (disputed trademark)</td> </tr> <tr> <td></td> <td></td> </tr> <tr> <td></td> <td></td> </tr> </table>	Plaintiff (cited trademark = trademark in Use 2 (above), trademark in Use 1 (below))	Defendant (disputed trademark)				
Plaintiff (cited trademark = trademark in Use 2 (above), trademark in Use 1 (below))	Defendant (disputed trademark)						
							
							
8. Outline of the case	In the trial for invalidation, it was decided that the disputed trademark does not fall into the category which is likely to cause confusion in connection with the goods or services pertaining to a business of another person, and so the plaintiff filed suit against decision of trial for invalidation. The request was granted.						
9. Summary of the judgment	(xv) is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) through (xiv) inclusive).						
10. Tags							
①Type of trial	Suit against decision of trial for invalidation						
②Decision	Invalidation						
③Type of bad faith							
Free Ride	✓						
Imitation by agents or people who have a prior relationship							
Interference by a competing company							
Lack of intention to use							
Others							

1. Category

In this compilation, the cases are categorized according to the following five types.

- (i) *Free Ride*
- (ii) *Imitation by agents or people who have a prior relationship*
- (iii) *Interference by a competing company*
- (iv) *Lack of intention to use*
- (v) *Others*

2. “” : The case in which "Bad faith" was found in the disputed trademark.

3. “**disputed trademark**” : The mark which was disputed in the case.

I . Introduction

There is a common, global issue of so-called “bad faith trademarks”, which are trademarks that persons register or seek to register in bad faith for unfair purposes. One example is a person registering a trademark belonging to another person and taking advantage of the fact that the trademark had not yet been registered in the country/region concerned.

At the fourth TM5 Annual meeting held in December 2015, we, the TM5 Offices, agreed to compile a reference called “Case Examples of Bad-Faith Trademark Filings”. The reference containing case examples was released in May 2017.

This release was a successful outcome of the initiatives that we had advanced in terms of bad faith trademarks. This year, we are pleased to release an upgraded version of case examples. In this latest version, not only cases from the TM5 Offices but also cases from offices in other countries and regions were added.

The previous Case Examples consisted of 10 cases each from the TM5 offices, for a total of 50 cases. In this version, five more cases each from the TM5 offices have been added. These are listed as examples No.11 to 15 in each office’s section in Chapter II.

Cases from other countries and regions were collected from Asia, North America, Central and South America, Europe, and Africa, in full cooperation with the International Trademark Association (INTA). In this version, 93 additional cases were selected and listed. A list of contributors is provided in Appendix.

In addition, among the three original categories of bad faith, which were *Free ride*, *Immoral*, and *Lack of intention to use*, we reviewed the cases listed under “*Immoral*” and agreed to subdivide this category into two, setting up two new categories called “*Imitation by agents or people who have a prior relationship*” and “*Interference by a competing company*”. We also set up a category called “*Others*”. As a result, there are now five bad faith categories. We appropriately categorized not only the new cases added to this version but also re-categorized the original 50 cases into these five categories accordingly.

We hope the examples in this latest upgraded version, which is designed to assist trademark users

around the world to better understand bad faith trademarks, will be valuable in helping them to develop their trademark strategies.

China National Intellectual Property Administration

European Union Intellectual Property Office

Japan Patent Office

Korean Intellectual Property Office

United States Patent and Trademark Office

II. Case Examples



Case Examples of CNIPA

【CNIPA-1】



v. 惠尔康



1. Title	 v. 惠尔康 (Protection of unregistered well-known trademark “惠尔康”)	
2. Country	China	
3. Court	Supreme People’s Court of the People's Republic of China	
4. Case No.	[2014] Zhi Xing Zi No.9	
5. Date of the judgment	2014/10/9	
6. Parties : Plaintiff Defendant	Fuzhou Weitalong Nutritious Food Co., Ltd. Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
Where a trademark for registration to be used on identical or similar goods is a copy, imitation, or translation of a well-known trademark of another party which has not been registered in China and may easily cause confusion, it shall not be registered and shall be prohibited from use.		
9. Summary of the judgment		
<p><u>Fact Finding</u></p> <p>According to the facts found out by the original court, the evidences provided by Xiamen Huierkang during trademark review can prove that this company has been using the trademark “惠尔康” for a long time and has made great efforts on promotion thereof. The trademark “惠尔康” had a high brand awareness prior to the date of application. What’s more, Xiamen Huierkang and its affiliates used the trademark “惠尔康” earlier than Tianjin Huierkang(assignor of Trademark No. 701244), and the date it registered phonetic alphabet and figure of the Trademark for production and operation of food & beverage was also earlier than the date of registration application for Trademark No. 701244. Thus, it is reasonable and legitimate for the Company to use the trademark “惠尔康” in Chinese on its food & beverage products. The fact that the application for registration of</p>		

the Chinese trademark “惠尔康” was rejected shall not represent that the company has no right to use the trademark. Although there is similarity between the Chinese trademark “惠尔康” used by Xiamen Huierkang and Trademark No. 701244, there are also some sensible differences in the overall structure and the characteristics styles, therefore they are not the same trademark. Considering no evidence which can prove that Trademark No. 701244 has been used really and continuously for a certain period and certain brand awareness, there is no subjective intention and objective fact for use by Xiamen Huierkang of the trademark “惠尔康” that Xiamen Huierkang desires to seek for unfair interests by means of use of other persons’ trademarks, and such use will not lead confusion or misunderstanding. Accordingly, the Chinese trademark “夏尔康” actually used by Xiamen Huierkang is not a similar trademark with Trademark No. 701244 to the extent of infringement of trademark right; the claim made by Weitalong(assignee of Trademark No. 701244) that use by Xiamen Huierkang of the unregistered trademark “惠尔康” constituted an infringement of the right to Trademark No. 70244 lacks of relevant facts and legal basis; in addition, the cause stated by Weitalong that the unregistered trademark “夏尔康” used by Xiamen Huierkang may not be recognized as a well-known trademark due to such reason may not be accepted and then rejected by the Court.

Opinions of the Court

The disputed trademark and Trademark 701244 are different and independent trademarks in the fields of marks and designated commodities, and there was no extension or transfer of business reputation between the two trademarks. It has no legal basis for the claim made by Weitalong that indicates that the disputed trademark was an application for renewal or extension of Trademark No.701244. Whether transfer of Trademark No. 701244 is valid and effective is not the cause for the Trademark Review and Adjudication Board and the original court to judge registration of the disputed trademark is unfair and is irrelevant to the Case. The essential attribute of a trademark is a mark by which an operator distinguishes its own commodities or services from others. An operator that applies for trademark registration shall have real use intention, respect any prior legal rights acquired by others and abide by the basic principle of good faith. The evidence submitted by Xiamen Huierkang during trademark review and legal proceedings can prove that Weitalong had performed a serious of activities for trademark squatting against Xiamen Huierkang. Thus, it is improper for Weitalong to insist on registering the disputed trademark which is the same as the trademark “惠尔康” actually used by Xiamen Huierkang for the same or similar commodities. In fact, Trademark No. 701244 is not a trademark with certain goodwill through long-term use and promotion. After accepted by Weitalong, the Trademark No. 701244 was revoked for non-use in 3 consecutive years, and such transfer had been judged as invalid and null in another case. Therefore, the

causes for retrial applied by Weitalong with respect to the trademark are rejected by the Court.




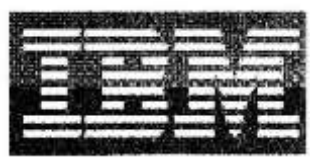
To sum up, the Trademark Review and Adjudication Board confirmed that the trademark “惠尔康” used by Xiamen Huierkang was a well-known trademark and it was the disputed trademark that copied and imitated the well-known trademark, based on which it decided to revoke the registration of the disputed trademark. Such ruling conforms to the Trademark Law; therefore, it is appropriate to maintain such ruling in the two original trials. Furthermore, the application submitted by Weitalong for retrial does not conform to the retrial conditions provided for in Article 63.2 of the Administrative Procedure Law of the People's Republic of China and Article 72 of the Interpretation of the Supreme People’s Court on Several Questions about Implementation of the Administrative Procedure Law of the People's Republic of China. Pursuant to Article 74 of the Interpretation of the Supreme People’s Court on Several Questions about Implementation of the Administrative Procedure Law of the People's Republic of China, it is hereby ruled as follows: to reject the application for retrial submitted by Fuzhou Weitalong Nutrition Food Co., Ltd.

10. Tags

① Type of trial	Suit for the decision of trial
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-2】



1. Title	 v. 	
2. Country	China	
3. Court	Trademark Office of the State Administration for Industry and Commerce	
4. Case No.	(2014) Shang Biao Yi Zi No. 00085	
5. Date of the judgment	2014/1/28	
6. Parties : Plaintiff Defendant	International Business Machines Corporation (IBM) Foshan Shunde Huineng Electromechanical Equipment Co., Ltd.	
7. Mark	Cited Trademark	Defendant (disputed trademark)
		
8. Outline of the case		
<p>The Trademark Office confirmed that the cited trademark was a well-known trademark for such commodities as “computer programs and software”. The disputed trademark was very similar visually with the cited trademark. Considering the originality and popularity of the Plaintiff’s trademark, the Trademark Office deemed that there was subjective intention of copy and imitation in the disputed trademark and that approval of the application for registration of the disputed trademark would mislead the consumers, which would further result in damage on the business reputation of the Plaintiff. Therefore, the Trademark Office refused the application for registration of the disputed trademark.</p>		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>Beijing Wan Hui Da Intellectual Property Agency, the agent of IBM (hereinafter referred to as the “Plaintiff”), challenges against Trademark No.9062752, “IBM 及图”, for which was applied by Guangzhou HuaQi Intellectual Property Deputize Ltd, the agent of Foshan Shunde Huineng Electromechanical Equipment Co., Ltd. (hereinafter referred to as the “Defendant”), and which was reviewed by the Trademark Office and publicized on the 1295th Trademark Announcement. The Trademark Office accepted the case pursuant to Article 30 of the Trademark Law of People’s Republic of China. The Defendant failed to reply within the required period.</p> <p><u>Opinions of the Trademark Office</u></p> <p>According to the facts and causes stated by the Parties, the Trademark Office deems that the Plaintiff, established in 1911 in the USA, is a world famous information technology and business solution company, consisting of such main departments as Global Technology Services Department, Global Business Consulting Service Department, Software Group, System and Technology Department and Global Financing Department. In 1979,</p>		

Shenyang Blower Works Group Corporation imported IBM370/138 mainframe, which was the first computer sold by IBM to Mainland China after the founding of New China. In 1992, ETC was established in Shanghai, mainly engaged in China General Spare Parts Center. In 2005, ISTC was established as the strategic base of IBM for order performance and manufacture. IBM had established 31 branches in China as of 2011, and at least 3 affiliates have the right to use the trademark “IBM”. As of September 30, 2011, IBM’s market value reaches up to USD214 billion and then became Top 2 technology company, surpassing the market value of Microsoft. The Plaintiff has successfully registered the trademark "IBM" for several kinds of commodities No. 9, 16, 37 and 42 and certain service items in China. The Plaintiff has made great efforts to publicize its trademark and products by means of magazines, newspaper, TV and other media. All such facts are supported by the copies of some advertisements, Annual Financial Statements and Audit Reports of IBM China from 2008 to 2010 which are provided by the Plaintiff. Trademark “IBM” owned by the Plaintiff has been widely known and enjoyed high reputation in China through long-term and wide promotion and use. Therefore, pursuant to Article 14 of the Trademark Law and the Provisions on the Recognition and Protection of Well-known Trademarks, the Trademark Office recognized the trademark “IBM” registered and used by the Plaintiff for such commodities as computer programs, computer software, computer hardware, computers and peripheral units as the well-known trademark.





The disputed trademark “IBM 及图” is more or less the same as Trademarks No. 1509898, No. 1767764 and No. 221321 in overall design and visual sense. Considering the originality and popularity of the Plaintiff’s trademark, the Trademark Office deemed that there was subjective intention of copy and imitation in the disputed trademark of which the Defendant applied for registration and that approval of the application for registration of the disputed trademark would mislead the consumers, which would further result in damage on the business reputation of the Plaintiff.

Pursuant to Articles 13.2 and 33 of the Trademark Law of the People’s Republic of China, the Trademark Office rules that the claims made by the Plaintiff are accepted and that the registration application for Trademark No.9062752, “IBM 及图” will not be approved.

10. Tags

① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-3】  妈妈世界 v.   (Protection of prior copyright “m”)

1. Title	 妈妈世界 v.  (Protection of prior copyright “m”)	
2. Country	China	
3. Court	The High People’s Court of Beijing	
4. Case No.	Administrative Judgment (2015) Gao Xing (Zhi) Zhong Zi No. 3963	
5. Date of the judgment	2015/12/25	
6. Parties : Plaintiff Defendant	Ou Yongwei Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Mothercare Limited	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
<p>Mothercare Limited legally owns the copyright to the works it claims; the disputed trademark is basically the same as, even substantially approximate with, the works to which Mothercare has the copyright from such aspects as factors, visual effect and design style; the works claimed by Mothercare has been released in public through trademark application, actual use and publicity; it is quite possible for Ou Yongwei to access the works of Mothercare; registration of the disputed trademark prejudices the prior copyright owned by Mothercare and violates Article 31 of the Trademark Law.</p>		
9. Summary of the judgment		
<p><u>Facts Finding</u></p> <p>On May 8, 2008, Ou Yongwei applied for registration of Trademark No.6708636, “妈妈世界及图”, which was approved on March 28, 2010 for such commodities as Class 12 “baby carriages; baby cars; baby strollers”. Mothercare submitted relevant evidence to initial publication of its works, publicity evidence, sales contracts, invoices, certificate of honor and other supporting documents at the stage of trademark review and, during legal proceedings, the Testimony, as well as translations thereof, issued by Daniel Veale , the partner of Pentagram Design Limited London Office, concerning his design and completion of the works claimed by Mothercare as appointed, ideas for design and title ownership, and the notarized Affidavit, as well as translations thereof, which was issued by Schonen Kelly , a business lawyer, concerning early and continuous publication all over the world of the works claimed by Mothercare and the brand awareness. In 2012, Mothercare was issued the Certificate of</p>		

Copyright Registration with respect to “MDolly 图形,” stating that the documents submitted by the Applicant Mother UK Limited met relevant requirements; with respect to “MDolly 图形” which was created by Pentagram Design Limited on February 23, 2005 and initially published in the UK on April 28, 2005, the Applicant legally owned the copyright as the copyright owner of such works, with the registration number Guo Zuo Deng Zi-2012-F-00071979, and the date of registration was September 28, 2012. In 2012, Ou Yongwei was issued the Certificate of Copyright Registration with respect to “妈妈世界及图”, stating that the documents submitted by the Applicant Ou Yongwei (from Hong Kong, China) met relevant requirements; with respect to “妈妈世界及图” which Ou created on February 2, 2007, the Applicant legally owned the copyright as the author, with the registration number Guo Zuo Deng Zi-2012-F-00074290, and the date of registration was October 25, 2012.

Judgment of the Court

The works of Mothercare is composed of two parts, English letter “m” and “human figure”, in which letter “m” is the initial of “mother” and has similar sound with “mom”, and the “human figure” depicts a cute baby. Overall, the design carries a good idea that babies are in good care from moms and has high originality; therefore, it is the works as defined in the Copyright Law. Mothercare has submitted sufficient evidence at the stage of registration review and during legal proceedings, which form a completed evidence chain proving the copyright owned by Mothercare to the works concerned. The disputed trademark includes Chinese characters “妈妈世界” and relevant figure which is also composed of “m” and “human figure”. Compared with the works claimed by Mothercare, they are very similar in appearance, factors and detail design, without any obvious difference; in other words, the two trademarks are substantially similar for the purpose of the Copyright Law. The works claimed by Mothercare has been released in public through trademark application, actual use and publicity. It is quite possible for the owner of the disputed trademark to access the works of Mothercare. Considering the “registration on a voluntary basis” principle adopted in China for copyright registration, the copyright registry made a formal examination only at the time of copyright registration; however, the evidence such as the Certificate of Copyright Registration submitted by Ou Yongwei cannot fully prove his independent creation and ownership of the copyright due to the originality. Accordingly, registration of the disputed trademark prejudices the prior copyright owned by Mothercare to its works and violates Article 31 of the Trademark Law. Thus, the disputed trademark shall be revoked pursuant to law.

10. Tags

① Type of trial	Suit for the decision of TRAB (Trademark Review and Adjudication Board) of SAIC
② Decision	Invalidation
③ Type of bad faith	

Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-4】 EXPEDITORS v. EI Expeditors International

1. Title	EXPEDITORS v. EI Expeditors International (Protection of trade name right “EI Expeditors International”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	(2015) Shang Biao Yi Zi No. 0000055470	
5. Date of the judgment	2015/11/3	
6. Parties : Plaintiff Defendant	Expeditors International of Washington, Inc. Xiamen Anshitong International Express Logistics Co., Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
		EI Expeditors International
8. Outline of the case		
<p>The distinctive part of the disputed trademark is identical with that of the Plaintiff’s firm name. Therefore, application for registration of the disputed trademark for logistics service constitutes infringement of the Plaintiff’s right to firm name.</p>		
9. Summary of the judgment		
<u>Basic Facts</u>		
<p>The Plaintiff, Expeditors International of Washington, Inc., put forward an objection to Trademark No.11876956, “EI EXPEDITORS INTERNATIONAL”, owned by Xiamen Anshitong International Express Logistics Co., Ltd., which was approved by the Trademark Office and publicized on the 1396th Trademark Announcement. The Trademark Office accepted the case in accordance with the Trademark Law. The Defendant replied within the designated period.</p>		
<u>Opinions of the Trademark Office</u>		
<p>The disputed trademark, “EI EXPEDITORS INTERNATIONAL”, is used for Class 39 “packing; marine transportation” and other services. The trademarks cited by the Plaintiff, No. 971630 “EXPEDITORS” and No.4600331 “EXPEDITORS TRADEFLOW”, which were registered early, are approved for Class 39 “freight broker” and Class 42 “interim use for the software unavailable online suitable for management of shipment, imports & exports and combined transportation”. Trademark “EXPEDITORS” is of a logo in foreign language without existing alphabetic combination and special meaning and has high originality. The evidence submitted by the Plaintiff shows that, as the trademark and main part of its firm name, “EXPEDITORS” has been known well in international logistics industry through publicity and use in several years. The Defendant that is engaged in the transportation business should be aware of the Plaintiff’s trademark and firm name. The “Marine Transportation; Vehicle Transportation” business to which the disputed trademark is applied is closely related</p>		

with the services supplied by the Plaintiff, and the distinctive part of the disputed trademark is identical with that of the Plaintiff's firm name; therefore, application for registration of the disputed trademark for logistics service constitutes infringement of the Plaintiff's right to firm name. In addition to the disputed trademark, the Plaintiff has applied for registration of several trademarks containing original logos and words identical with those early used by international famous logistics enterprises, but the Defendant fails to make a reasonable explanation about its originality for the disputed trademark during reply. Therefore, the Trademark Office deems that the Defendant's behavior constitutes intentional and obvious copy and cribbing of other party's trademark, violating of the principle of good faith and disturbs the fair order of market competition.

Pursuant to Articles 7, 30, 32 and 35 of the Trademark Law, the Trademark Office decides not to register Trademark No.11876956, "EI EXPEDITORS INTERNATIONAL".

10. Tags

① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-5】 GIORGIO ARMANI (乔治·阿玛尼) v. 乔治·阿玛尼



1. Title	GIORGIO ARMANI (乔治·阿玛尼) v. 乔治·阿玛尼 (Protection of right of name “GIORGIO ARMANI”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	Shang Ping Zi (2009) No. 29925	
5. Date of the judgment	2009/11/3	
6. Parties : Plaintiff Defendant	GA Modefine S.A. Hangzhou Xinchun Trading Co., Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
8. Outline of the case		
The focus issue of the Case is whether registration of the disputed trademark prejudices the prior right of personal name owned by GIORGIO ARMANI (乔治·阿玛尼).		
9. Summary of the judgment		
<u>Basic Facts</u>		
<p>With respect to the disputed trademark, the applicant submitted an application for registration on February 3, 2000. It was on April 28, 2001 that the trademark was approved, applied to Class 3 “soaps, decontaminants, polishes, cosmetic spice, cosmetics and perfumes”.</p> <p>Identity certificate of Mr. GIORGIO ARMANI, the copy of the right declaration, the original of the notarial deed and Chinese versions thereof which are submitted the Applicant can prove the fact that Mr. GIORGIO ARMANI has authorized the Applicant to protect his right of personal name in China. The copies of such articles related in the publications collected by the National Library of Chinese, the Foreign Textile Technology (Issue 14 in 1991 and Issue 14 in 1992), the Economic Guide (Issue 4 in 1996), the Jiangsu Textile (Issue 10 in 1992 and Issue 10 in 1997), the Chinese New Era (Issue 1 in 1998), the Music World (Issue 4 in 1999), the International Talent Exchange (Issue 10 in 1999), the Art of Life (Issue 1 in 2000) as the Fashion Trends of Autumn & Winter Clothing 1992/1993, Italian Designer GIORGIO ARMANI, the Fashion Trends of Spring & Summer Clothing 1992, the Fashion Trends of Autumn & Winter Clothing 1992/1993, the Fashion Dream, On Trend of Feminization of Men's Clothing, the Flame under Iceberg: GIORGIO ARMANI - the Fashion Design Master in Milan, I Love Brands, To Visit Italy - the Fashion Empire and the Western Fashion on Eastern Faces, which are submitted by the Applicant, can prove a fact that Mr. GIORGIO ARMANI, born in 1934, established GIORGIO ARMANI S.P.A. in Italy in 1975. Mr. GIORGIO ARMANI, as a famous designer enjoying excellent reputation</p>		

in the world fashion industry, is called “乔治·阿玛尼” in Chinese-speaking countries and regions.

Opinions of the Board

Relying on the awareness in the world fashion, Mr. GIORGIO ARMANI and his Chinese name have been popular in China before the application for registration of the disputed trademark was submitted. The Chinese characters and relevant design adopted by the disputed trademark are identical with well-known Chinese name of Mr. GIORGIO ARMANI. Obviously, the Defendant knowingly borrows the awareness of Mr. GIORGIO ARMANI in an inappropriate way, which violates the public standards of good faith, causes adverse effect on personal reputation of Mr. GIORGIO ARMANI and constitutes the infringement of the right to personal name of Mr. GIORGIO ARMANI. Although the Defendant claimed that the disputed trademark was not transliteration of the personal name “GIORGIO ARMANI” and was a coincidence even if they had similar pronunciation. However, the Defendant failed to make reasonable explanation which was known by relevant persons with respect to the originality of the disputed trademark. Thus, the Defendant’s defence cannot be supported. To sum up, registration of the disputed trademark violates the provisions of Article 31 of the Trademark Law in 2001 on “No application for trademark registration may infringe upon the existing prior rights of others”, and the Board hereby revokes the disputed trademark.

10. Tags

① Type of trial	Trademark dispute to the registration
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-6】 湘莲 XIANGLIAN v. XIANGLIAN



1. Title	湘莲 XIANGLIAN v. XIANGLIAN (Protection of GI “湘莲 XIANGLIAN”)	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	Shang Ping Zi (2008) No. 06137	
5. Date of the judgment	2008/6/30	
6. Parties : Plaintiff Defendant	Xiangtan Xianglian Association Fujian Wenxin Lianye Food Co., Ltd.	
7. Mark	Plaintiff	Defendant
	湘莲 XIANGLIAN 及图	
8. Outline of the case		
<p>The Defendant, locating in Fujian, had made business transactions of XIANGLIAN with Hunan lotus seed merchants prior to the registration of the disputed trademark. However, even if the Defendant was aware that XIANGLIAN was the geographical indication of lotus seed commodities, it still registered it as a trademark other than collective marks and certification marks, causing the public mistaking the nature and source of the products under the trademark. It is prohibited by Article 16.1 of the Trademark Law. Therefore, it is claimed to revoke the registration of the disputed trademark for lotus seed and similar commodities.</p>		
9. Summary of the judgment		
<u>Basic Facts</u>		
<p>1. With respect to the disputed trademark, Jianning Wenxin Lianye Co., Ltd. submitted an application for registration on November 26, 2001, which was approved on January 7, 2003, applied to Class 29 “lotus seeds, jelly and meat”. With the approval of the Trademark Office, the registered owner was changed into the Defendant, Fujian Wenxin Lianye Co., Ltd. nominally.</p>		
<p>2. The Plaintiff, Xiangtan XIANGLIAN Association, established on December 8, 2000, is a non-profitable social legal entity coordinating the development of XIANGLIAN industry in Xiangtan.</p>		
<p>3. According to the History of Xiangtan, the Chinese Culture on Lotus and the Xiangtan Agricultural Regionalization Report Set, lotus seeds in Xiangtan are generally called as XIANGLIAN. In general, lotus seeds in Hunan may also be called XIANGLIAN, the best of which is lotus seeds in Xiangtan. The word “XIANGLIAN” was first seen in the documents in the Southern Dynasties (420~589 A.D.). XIANGLIAN had been designated as tribute until Daoguang Dynasty. The aforesaid documents also record the quality characteristic, technical essential in cultivation of XIANGLIAN.</p>		

4. The comprehensive base for export of agricultural, sideline, local and livestock products (including XIANGLIAN) was put into operation in Xiangtan from 1976 to 1979. In 1982, Price Committee of Hunan Province issued documents to continue to implement the price subsidies for Hunan lotus seeds and other 3 exported commodities, and such commodities from Xiangtan, Hanshou and state-run provincial farms, as listed in the exhibit, may enjoy subsidies. In 1984, Wuhan Institute of Botany of Chinese Academy of Sciences issued the analysis report sheet for the elements contained in the XIANGLIAN products sent for inspection by Science Committee of Xiangtan, Hunan. In 1995, Xiangtan, a county of Hunan province, was named by the China naming, promotion and activity organization committee of the first batch of hundred hometowns of special products as “the Hometown of Chinese XIANGLIAN”. In 1996, Xiangtan People’s Government submitted a report on planning of XIANGLIAN industrial development project, subsidized interest and development of XIANGLIAN product series to the State Planning Commission (now the National Development and Reform Commission), SETC, the Ministry of Finance, the Finance Department of Hunan Province and Agricultural Bank of China.

5. There are 6 enterprises registered with Xiangtan Administration for Industry and Commerce Huashi Branch for XIANGLIAN process and sales on and prior to November 26, 2001(the registration date of the disputed trademark).

6. Before and after application for registration of the disputed trademark, the Defendant had made business transactions with Hunan lotus seed merchants.

7. According to the Chinese Local Products Dictionary published by the Commercial Press in March, 1991, XIANGLIAN spreads all over Hunan Province, especially the region of Dongting Lake. The Dictionary explains the quality characteristics, nutritious elements, cultivation characteristics and geographical scope of and with respect to XIANGLIAN.

Opinion of the Trademark Review and Adjudication Board

1. According to the evidence submitted by the Plaintiff and the Chinese Local Products Dictionary, XIANGLIAN spreads around Hunan, especially the region of Dongting Lake. The product has the characteristics of big seeds, white color, full flesh, cyan soap, strong fragrance, fresh taste and so on. The nutritious elements contained in it, including protein, fat and mineral substance, are different from the lotus seed produced in other regions. The above characteristics are mainly subject to the natural conditions (temperature, rainfall, humidity, sunshine, soil, water conservation, etc. in the living region) and the cultivation means. The title of “XIANGLIAN”, used since the Southern Dynasties, has already formed congruent relationship with its producing place Hunan. It satisfies the recognition condition of the geographic indication stipulated in Article 16.2 of the Trademark Law, and may be recognized as the geographic indication of lotus seed products. The disputed trademark is consisted of the characters “XIANGLIAN”, corresponding pronunciation and graph, and

the characters “XIANGLIAN” is the major reading and calling part of this trademark. The Defendant, locating in Fujian, had business transactions with the lotus merchants of Hunan before application for the registration of this trademark. It was aware that XIANGLIAN is the geographical indication of the lotus seed products, but it still registered it as the trademark other than the collective trademark and certification trademark. It is very easy to cause the public mistaking the product nature and source, falling into the scope of the prohibition in Article 16.1 of the Trademark Law. Therefore, the registration of the disputed trademark for lotus seeds and similar products shall be revoked.

2. Common name, including statutory and conventional generic name, is of standardized title generally accepted in the state or industry to reflect the fundamental difference between two categories of commodities. The evidence submitted by the Plaintiff cannot fully support that XIANGLIAN is the common name of lotus seeds generally accepted in the country or industry. Causes and evidence presented by the Plaintiff fails to prove that the dispute trademark infringes the existing prior rights as mentioned in Article 31 of the Trademark Law. To sum up, pursuant to Articles 16 and 43 of the Trademark Law and Article 41 of the Implementing Regulations of the Trademark Law, the Trademark Review and Adjudication Board hereby revokes the registration of the disputed trademark for some commodities.

10. Tags

① Type of trial	Trademark dispute to the registration
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-7】 海棠湾 v. 海棠湾



1. Title	海棠湾 v. 海棠湾 (“海棠湾” trademark case)	
2. Country	China	
3. Court	The Supreme People’s Court	
4. Case No.	Administrative Ruling (2013) Zhi Xing Zi No. 41 issued by the Supreme People’s Court	
5. Date of the judgment	2013/8/12	
6. Parties : Plaintiff Defendant	Li Longfeng Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Sanya Haitang Bay Management Committee	
7. Mark	Plaintiff (disputed trademark)	Defendant
	“海棠湾”	
8. Outline of the case		
<p>Li Longfeng, taking advantage of the huge influence from the government’s promotion of Haitang Bay Vacation Zone and the development program, applied for registration of many trademarks containing words “海棠湾” and registered a large amount of other trademarks without any reasonable grounds or intention of real use. It shall be identified as improper occupation of public resources and disturbance of the order of trademark registration due to lack of the legitimacy required for trademark registration. Therefore, it shall be revoked pursuant to Article 41.1 of the Trademark Law.</p>		
9. Summary of the judgment		
<p><u>Basic Facts</u></p> <p>Before Li Longfeng applied for registration of the disputed trademarks, the logo “海棠湾” had been a well-known place name in Sanya tourism resort and a name contained in large comprehensive development projects under the government plans through long-term promotion by relevant government authorities of Hainan province, and it has clear meaning and indication. As an individual person, Li Longfeng has applied for registration of the disputed trademark not only for such services as lease and management of real estates involved in the Case but also for Class 43 “restaurants, hotels and other commodities or services”. Additionally, Li Longfeng has also registered more than 30 trademarks for many categories of products or services, such as “香水湾” and “椰林湾”, many of which concern place names and scenes of Hainan Island.</p>		
<p><u>Opinions of the Court</u></p> <p>The Supreme People's Court deems that, for the purpose of examination and judgment on whether the disputed trademark is “registered by other unfair means” provided in Article 41.1 of the Trademark Law, it is necessary to verify whether means other than cheat that are applied, including disturbance of the order of trademark</p>		

registration, damage on public interests or unfair occupation of public resources. Pursuant to Article 4 of the Trademark Law, a civil subject applying for registration of a trademark shall have a real intention of use in order to meet his own demands for trademark use and the application shall be reasonable or legitimate.

Li Longfeng, taking advantage of the huge influence from the government’s promotion of Haitang Bay Vacation Zone and the development program, applied for registration of many trademarks containing words “海棠湾” and registered a large amount of other trademarks without any reasonable grounds or intention of real use. It shall be identified as improper occupation of public resources and disturbance of the order of trademark registration due to lack of the legitimacy required for trademark registration. Therefore, the registration shall be revoked pursuant to Article 41.1 of the Trademark Law.

10. Tags

① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【CNIPA-8】 WONDERWARE v. Wonderware



1. Title	WONDERWARE v. Wonderware	
2. Country	China	
3. Court	Trademark Review and Adjudication Board of the State Administration for Industry and Commerce	
4. Case No.	(2015) Shang Biao Yi Zi No. 0000007183	
5. Date of the judgment	2015/4/29	
6. Parties : Plaintiff Defendant	Invensys System Co., Ltd. Shenzhen Wondershare Information Technology Co., Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
The Defendant's application for registration of the disputed trademark has constituted bad-faith registration by illicit means of a trademark with a certain reputation already used by another party. If successfully registered, the disputed trademark will cause relevant consumers mistaking the sources of the parties' products and services.		
9. Summary of the judgment		
<u>Basic Facts</u>		
The Plaintiff, Invensys System Co., Ltd., put forward an objection to Trademark No. 10271361, "WONDERWARE" which is held by the Defendant, Shenzhen Wondershare Information Technology Co., Ltd. (formerly known as Shenzhen Fuxing Technology Co., Ltd.) and was reviewed by the Trademark Office and publicized on the 1335th Trademark Announcement. The Trademark Office accepted the Case in accordance with the Trademark Law. The Defendant replied within the designated period.		
<u>Opinion of the Trademark Office</u>		
The disputed trademark, "WONDERWARE", is approved to use for the services in Class 42 "computer programming; computer software design". Trademark No. 1747975 "WONDERWARE", early registered by the Plaintiff, is approved to use for the commodities in Class 9 "computer software (recorded)". The evidence submitted by the Plaintiff proves that the computer software products carrying the cited trademark have been actually used and have certain influence in relevant fields in China. In addition, the Plaintiff supplies relevant services together with the sold products. The disputed trademark contains identical words with those contained in the cited trademark, and the approved applicable services are closely related with the commodities of the Plaintiff. Therefore, the Defendant's application for registration of the disputed trademark has constituted bad-faith registration by illicit means of a trademark with a certain reputation already used by another party. If successfully registered, the disputed trademark will cause relevant consumers mistaking the sources of the		

parties' products and services.


Pursuant to Articles 32 and 35 of the Trademark Law, the Trademark Office decides not to register Trademark No. 10271361, "WONDERWARE".

10. Tags

① Type of trial	Opposition to the registration
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-9】 MEGAPULSE v. MEGAPULSE



1. Title	MEGAPULSE v. MEGAPULSE (Bad-faith registration of “MEGAPULSE” concerning contractual relationship)	
2. Country	China	
3. Court	The High People’s Court of Beijing	
4. Case No.	Administrative Judgment (2015) Gao Xing (Zhi) Zhong Zi No. 3601	
5. Date of the judgment	2016/1/11	
6. Parties : Plaintiff Defendant	Yancheng Cross Electronics Co., Ltd. (hereinafter referred to as “Cross”) Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Shanghai Qinling Wine Co., Ltd. (hereinafter referred to as “Qinling Wine”)	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
Cross is aware of the trademark “MEGAPULSE” owned by Qinling Wine by means of indirect transactions with Qinling Wine. However, Cross applied for registration of the disputed trademark for the same or similar commodities as such trademark “MEGAPULSE” owned by Qinling Wine, violating Article 15.2 of the Trademark Law.		
9. Summary of the judgment		
<p><u>Facts Finding</u></p> <p>Trademark No. 9928480 “MEGAPULSE” applied by Cross for registration on September 5th, 2011, was approved applicable to the commodities Class 9 “storage battery, battery cage and pulse activator”. Qinling Wine permits Jiangsu Xinyang No. 2 Electronic Elements Factory (“Xinyang No.2 Factory”) to manufacture and sell the pulse activator with the trademark “MEGAPULSE” which has been authorized by Qinling Wine. Xinyang No.2 Factory concluded a sales contract for pulse activator in electro mobiles with Cai Zhongliang, the legal representative of Cross without the consent of Qinling Wine. Cross submitted additional two copies of the “Power of Attorney” (both on September 28, 2009) during second instance, and the power of attorney bearing the official seal of Xinyang No.2 Factory indicates that “Mr. Cai Zhongliang is hereby authorized to sell pulse activator in electro mobiles manufactured by the Factory at the same price”. Thereafter, Qinling Wine further submitted one copy of the Certification issued by Xinyang No.2 Factory on November 10, 2015, indicating “On December 24, 2009, Xinyang No.2 Factory concluded a contract with Cai Zhongliang for sales of pulse activators in electro mobiles and mobiles with the trademark ‘MEGAPULSE’, which were manufactured by Xinyang No.2 Factory with Qinling Wine”.</p>		

Judgment of the Court

Pursuant to Article 15.2 of the Trademark Law in 2013, where an applicant for registration of a trademark identical with or similar to an unregistered trademark in prior use by another party on identical or similar goods has any contractual, business or other relationship except the relationship described in the preceding paragraph with the other party and knows the existence of the unregistered trademark, the trademark shall not be registered upon opposition from the other party. For the purpose of such paragraph, the applicant has created other legal relationship other than agency or representative with the other party prior to the date of application for the disputed trademark, through which the applicant knew about the other party's trademark and in bad faith registers the unregistered trademark in prior used by another party on identical or similar goods. The disputed trademark shall not be registered in such circumstance for violating the principle of good faith and constituting a registration in bad faith and hitchhiking.

The evidence submitted proves that, prior to the date of application for the disputed trademark, Qinling Wine authorized Xinyang No.2 Factory to manufacture and sell the pulse activators with the brand "MEGAPULSE"; thereafter, Xinyang No.2 Factory concluded a contract with Cai Zhongliang for sales of pulse activators in electro mobiles and mobiles under the trademark 'MEGAPULSE'; however, Cross failed to explain clearly that it had reasonable ground to apply for the disputed trademark. Since the letters contained in the disputed trademark are identical with the trademark "MEGAPULSE", a conclusion may be made that, prior to the date of application for the disputed trademark, Cross had been aware of the trademark "MEGAPULSE" from pulse activators on the basis of the legal relationship other than agency or representative. Considering the circumstance that storage batteries, pulse activators and other commodities to which the disputed trademark is applied constitute the same or similar commodities with the pulse activators under the trademark "MEGAPULSE" in prior use, application by Cross for registration of the disputed trademark has violated Article 15.2 of the Trademark Law in 2013. Although Cross submitted additional Power of Attorney during second instance, the Power of Attorney did not deny the fact that Xinyang No.2 Factory concluded a contract with Cai Zhongliang on December 24, 2009 for sales of pulse activators under the trademark "MEGAPULSE". The Power of Attorney was issued on September 28, 2009, and Xinyang No.2 Factory had other contractual relationship with Cai Zhongliang after September 28, 2009, therefore, relevant claims made by Cross lack for basis in fact and are hereby rejected by the Court.

10. Tags

① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-10】



v.

1. Title		
2. Country	China	
3. Court	The High People’s Court of Beijing	
4. Case No.	Administrative Judgment (2016) Jing Xing Zhong Zi No. 1896	
5. Date of the judgment	2016/5/31	
6. Parties : Plaintiff Defendant	Jiangsu Xianghe International Investment Co., Ltd. (“Xianghe”) Trademark Review and Adjudication Board of the State Administration for Industry and Commerce Cölner Hofbräu P. Josef Früh KG(“KG”)	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
Registration in bad faith by the agents of Xianghe and KG of the beer trademark “FRUH KOLSCH 及图” through collusion violates Article 15.1 of the Trademark Law.		
9. Summary of the judgment		
<p><u>Fact Finding</u></p> <p>Application for registration of Trademark No. 9150014 “FRUH KOLSCH SEIT 1904 及图”, submitted by Xianghe on February 25, 2011, was approved applicable to the commodities Class 32 “beer; malt beer; wort for beer”. KG owns the internationally registered trademark and Germany trademark of “FRUH KOLSCH 及图”.</p> <p>On its website, Xianghe stated itself as the general agent of Fruh Kolsch beer in China; its subsidiary Xianghe (Germany) GmbH performed auxiliary services for Xianghe in Germany with respect to agency business of Fruh Kolsch beer in China. Fruh Kolsch beer is called “福利红 Fruh Kolsch” in China. Fruh Kolsch top beer in Germany has existed for more than 100 years. The address of Xianghe (Germany) GmbH on its website is the same as that of Defudao Company, which is the agent of KG in China. On September 23, 2010, an email (inscriber is Jiangsu Xianghe International Investment Co., Ltd.) sent from an email box “xiang.×××” to the</p>		

personnel of KG, concerning sales of 5 liters of barreled Fruh Kolsch beer in China as an agent. Xianghe personnel had accepted training programs about Fruh Kolsch beer and were granted the training certificate by KG.

Judgment of the Court

Pursuant to Article 15.1 of the Trademark Law, where an agent or a representative applies for registration of a trademark of the principal or the represented party in the agent's or the representative's own name without authorization, the trademark shall not be registered and shall be prohibited from use upon objection from the principal or the represented party. Where a trademark agent, a representative or an agent or a representative under the distributorship or agency relationship applies, in its name, for registration of a trademark of the principal or the represented party without authorization, the People's Court shall determine it constitutes a bad-faith registration of the trademark of the principal or the represented party by the agent or the representative. In trial practice, bad-faith registration may occur during negotiation about the agency or representative relationship, namely, bad-faith registration prior to establishment of the agency or representative relationship. In such case, it shall be deemed as bad-faith registration by the agent or the representative. The applicant registering the trademark in bad faith through collusion with the aforesaid agent or representative may be deemed as the agent or representative. Registration in bad faith through collusion may be determined on the basis of special personal relationship between the applicant and the aforesaid agent or the representative.



Evidence submitted for the Case proves that, prior to the date of application for the disputed trademark, Xianghe negotiated with KG about Fruh Kolsch beer. Although it was Defudao Company that concluded a cooperation agreement with KG, Xianghe stated on its website that its subsidiary Xianghe (Germany) GmbH performed auxiliary services for Xianghe in Germany with respect to agency business of Fruh Kolsch beer in China and that the address of Xianghe (Germany) Co., Ltd. is the same as that of Defudao Company, therefore, a conclusion may be made that Xianghe also took part in bad-faith registration of the trademark of "Fruh Kolsch" owned by KG through collusion with Defudao Company. Accordingly, application for registration of the disputed trademark violates Article 15.1 of the Trademark Law.

10. Tags

① Type of trial	Suit for the decision of TRAB of SAIC
② Decision	Ruling to reject the trademark application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-11】 华为 NOVA v. VAVI 华为



1. Title	华为 NOVA v. VAVI 华为	
2. Country	China	
3. Court	Trademark Office	
4. Case No.	37015716	
5. Date of the judgment	2019/9/5	
6. Parties: Third-party Applicant	Huawei Technologies Co.,Ltd. Chen Hongmei	
7. Mark	Reference Trademark	Disputed Trademark
		
8. Outline of the case		
A case in which the applicant of the disputed trademark has obvious intention of imitating or copying third-party's trademarks and is determined as having been obtained contrary to ethics of business.		
9. Summary of the judgment		
The disputed trademark is extremely similar to the existing prior trademark of the third-party. The applicant has applied for registration of many trademarks which are identical with or similar to other parties' existing prior trademarks.		
The applicant of the disputed trademark has obvious intention of imitating or copying third-party's trademarks, which disputes the normal order of trademark registration management and harms the market order of fair competition.		
10. Tags		
① Type of trial	Examination	
② Decision	Refusal	
③ Type of bad faith		
Free Ride	✓	
Imitation by agents or people who have a prior relationship		
Interference by a competing company		
Lack of intention to use	✓	
Others		

【CNIPA-12】 MOTO RETA v. MOTO RETA



1. Title	MOTO RETA v. MOTO RETA	
2. Country	China	
3. Court	Trademark Office	
4. Case No.	18021136	
5. Date of the judgment	2018/3/29	
6. Parties:	Plaintiff	MOTORETA MODA INFANTIL SOCIEDAD LIMITADA
	Defendant	LEE EUNSIK
7. Mark	Plaintiff	Defendant (disputed trademark)
8. Outline of the case		
<p>A case in which the defendant's application of the trademark bears obvious intention of imitating and copying the opposer's trademarks, which violates the ethics of good faith and disputes the normal order of trademark registration management.</p>		
9. Summary of the judgment		
<p>The defendant's trademark is extremely similar to the trademark of the plaintiff which is original and was registered in Spain on Dec. 30, 2014.</p> <p>The defendant has applied for registration of nearly 900 trademarks on various goods. Most of them are refused because the trademarks are identical with or similar to other parties' existing prior trademarks. About 80 trademark applications had been opposed, most of which are identical with or similar to other parties' existing prior trademarks, and got the decision of no registration.</p> <p>The applicant of the disputed trademark has no intention to use and has obvious intention of imitating or copying third-party's trademarks, which disputes the normal order of trademark registration management and harms the market order of fair competition.</p>		
10. Tags		
① Type of trial	Opposition	
② Decision	No registration	
③ Type of bad faith		
Free Ride	✓	

Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【CNIPA-13】高山别庄 v. 高山别庄



1. Title	高山别庄 v. 高山别庄	
2. Country	China	
3. Court	Trademark Office	
4. Case No.	19638921	
5. Date of the judgment	2018/5/23	
6. Parties: Plaintiff Defendant	High Mountain Resort Shangri-La Hotel Co.,Ltd. Hangzhou Sanwu Technology Co.,Ltd.	
7. Mark	Plaintiff	Defendant(disputed trademark)
	高山别庄	高山别庄
8. Outline of the case		
A case in which the defendant who has specific relations with the plaintiff applied for registration of a trademark which is identical with the plaintiff's existing prior service mark without authorization.		
9. Summary of the judgment		
<p>The plaintiff submits evidences including the company registration information of defendant ,the investment and employment report of a shareholder of the defendant, the mail record between the plaintiff and the shareholder, the contract and invoice of conducting the plaintiff's hotel official website online and official account on Wechat,etc.</p> <p>The evidences prove that the shareholder of the defendant had business relationship with the plaintiff .Therefore the defendant would be aware of the plaintiff's existing prior service mark.</p> <p>Without authorization, the defendant who has specific relations with the plaintiff applied for registration of a trademark which is identical with plaintiff's existing prior service mark and the designated service is closely related to the service performed by the plaintiff.</p>		
10.Tags		
① Type of trial	Opposition	
② Decision	No registration	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship	✓	

Interference by a competing company	
Lack of intention to use	
Others	

【CNIPA-14】伊顿 v. 伊顿公学



1. Title	伊顿 v. 伊顿公学 (Eton College)	
2. Country	China	
3. Court	Trademark Office	
4. Case No.	3068234/3068235	
5. Date of the judgment	2019/6/20	
6. Parties: Plaintiff Defendant	Beijing Yongan Shida Trade Co.,Ltd. Etonhouse International Holdings Pte.,Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
		伊 顿
8. Outline of the case		
A case in which the defendant's registered trademark is determined as having been obtained contrary to ethics of good faith and being liable to cause confusion with services connected with another party's business.		
9. Summary of the judgment		
<p>The defendant's trademark is identical with the Chinese translation of Eton College which had become a well-known exclusive private school in Britain. The disputed trademark is designated to be used on service of education and children care which is liable to cause confusion with the quality or other characteristics of the service.</p> <p>Besides the disputed trademark, the defendant has applied for registration of several trademarks which are similar to or identical with the Chinese translation of famous Britain universities like University of Cambridge and University of Wolverhampton and the designated service is closely related to the service of education and children care.</p> <p>Based on a comprehensive evaluation of these facts, it may be recognized that the applicant of the disputed trademark lacks intention to use and violates the ethics of good faith, disputes the normal order of trademark registration management and harms the market order of fair competition.</p>		
10. Tags		
① Type of trial	Invalidation	
② Decision	Invalidation	
③ Type of bad faith		

Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【CNIPA-15】道奇 v. 道奇战斧



1. Title	道奇 v. 道奇战斧 DODGE TOMAHAWK	
2. Country	China	
3. Court	Trademark Office	
4. Case No.	14549887	
5. Date of the judgment	2019/6/13	
6. Parties: Plaintiff Defendant	FCA US LLC HongKong Jiabaolong Trading Co.,Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
8. Outline of the case		
A case in which the defendant's registered trademark has obvious intention of imitating or copying third-party's trademarks and is determined as having been obtained contrary to ethics of business.		
9. Summary of the judgment		
<p>The plaintiff's trademark is original and well-known. The trademark of the defendant consists of two main trademarks of the plaintiff. The defendant has applied for registration of nearly 260 trademarks on various goods and services, most of which are identical with or similar to other parties' existing prior famous trademarks.</p> <p>The applicant of the disputed trademark has obvious intention of imitating or copying third-party's trademarks and free-riding the reputation of the plaintiff, which disputes the normal order of trademark registration management and harms the market order of fair competition.</p>		
10. Tags		
① Type of trial	Invalidation	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride	✓	
Imitation by agents or people who have a prior relationship		
Interference by a competing company		
Lack of intention to use		

Others	
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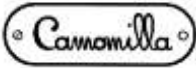

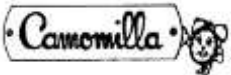
Case Examples of EUIPO

【EUIPO-1】 BALBCARE v. BALBCARE



1. Title	BALBCARE v. BALBCARE	
2. Country	European Union	
3. Court	Cancellation Division (EUIPO first instance)	
4. Case No.	9805 C	
5. Date of the judgment	2015/9/14	
6. Parties : Plaintiff Defendant	Balbpharm Industria de Cosméticos Ltda. 3B.Solutions	
7. Mark	Plaintiff	Defendant (disputed trademark)
	BALBCARE	BALBCARE
8. Outline of the case		
The Cancellation Division (CD) declared invalid the registration of the EUTM as it was applied for in bad faith. No appeal was filed before EUIPO Boards of Appeal		
9. Summary of the judgment		
<p>The Invalidity applicant is the owner of the Brazilian TM BALBCARE for nail care products in Class 3. It exported its products to the EU since 2011.</p> <p>In 2011 it signed a distribution agreement in the EU with the (future) EUTM proprietor, who applied for a FR mark BALBCARE in July 2011 and an EUTM in 2014.</p> <p>By late 2011, the distribution agreement was suspended.</p> <p>The owner of the Brazilian TM requested the invalidity of the EUTM because it was registered in bad faith. The Cancellation Division declared that the invalidity applicant cannot be expected to prove a negative fact, such as the absence of consent. A mere statement that the filing was made without its consent is generally sufficient.</p> <p>It is the EUTM proprietor who has to prove that the filing was authorized.</p> <p>The finding of bad faith does not require a contractual relationship at the time of filing. A direct or indirect relationship between the parties prior to the filing may be enough.</p> <p>The Cancellation Division declared the mark invalid. No appeal was filed.</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship	✓	
Interference by a competing company		
Lack of intention to use		
Others		

【EUIPO-2】 Camomilla v. CAMOMILLA

1. Title	Camomilla v. CAMOMILLA	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	Joint cases T-98/13 and T-99/13	
5. Date of the judgment	2015/7/9	
6. Parties : Plaintiff Defendant	C.M.T. - Compagnia Manifatture Tessili S.r.l. EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor (disputed trademark)	Invalidity applicant
		
		
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade marks above had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark Regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>The Court confirmed that the three factors set out in the judgment C-529/07, <i>Chocoladefabriken Lindt & Sprüng</i> (identity/confusing similarity of the signs; knowledge of the use of an identical or confusingly similar sign, and dishonest intention on the part of the EU trade mark proprietor) are only examples drawn from a number of factors which can be taken into account in order to decide whether the EU trade mark proprietor was acting in bad faith at the time of filing the application.</p> <p>For example, account may also be taken of the commercial logic underlying the filing of the EUTM application and the chronology of events relating to the filing (paras. 37-42).</p> <p>The Court recalled that the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the EU trade mark proprietor was acting in bad faith. In order to determine whether there was bad faith, consideration must be given to the EU trade mark proprietor's intention at the time when of filing of the EUTM application. It is a subjective factor which must be determined by reference to the objective circumstances of the particular case.</p> <p>However, the invalidity applicant only argued that the disputes between the parties proved the conscious and deliberate intention of the EU trade mark proprietor to appropriate the Camomilla mark, previously used and register by the invalidity applicant.</p>		

The Court found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as an EU trade mark acted in bad faith. It also found that there was no evidence showing that the invalidity applicant had the intention to exploit its national mark in in the market sectors at issue, nor that the EU trade mark proprietor knew about that intention at the relevant time (paras. 46-50). Good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the EU trade mark proprietor at the time of filing. Consequently, the invalidity applicant's observations, devoid of any evidence to support them, are not sufficient for proving bad faith from the EU trade mark proprietor (para. 51).

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance of the trademark registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【EUIPO-3】 COLOURBLIND v. COLOURBLIND

1. Title	COLOURBLIND v. COLOURBLIND	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-257/11	
5. Date of the judgment	2015/2/26	
6. Parties : Plaintiff Defendant	Pangyrus Ltd. EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
	COLOURBLIND	
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark COLOURBLIND had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark Regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>The ‘COLOURBLIND’ product (consisting of an “experimental learning” toolbox’) was invented in 1991 by a physical person, a Mr C. (main shareholder and director of the EU trade mark proprietor at the time of the invalidity application), who in 1993 had set up the invalidity applicant’s company, Mr C. holding 99% of the latter’s shares. Although Mr. C. was closely and continuously involved, from 1991 until 2003, in activities leading to the use of ‘COLOURBLIND’ by the invalidity applicant first and later by another connected company, and was therefore necessarily aware of that use, the Court noted that such awareness on his part was not sufficient, in itself, to establish that the EU trade mark proprietor (whom Mr. C. controlled) acted in bad faith. The Court dismissed the invalidity applicant’s argument that Mr C.’s aim in filing the application for registration of the contested trade mark was to ‘lay his hands’ on the trade mark of a third party which he had had contractual or pre-contractual relations with. In that respect, the Court held that, due to the connections between Mr C. and the invalidity applicant (the former holding in the early 90’s 99% shares of the latter), the invalidity applicant could not be described as a third party in relation to Mr C. The Court also found that the main item of evidence relied upon by the invalidity applicant (a share purchase agreement) in order to argue that the rights in the contested mark had been assigned to it by Mr. C. only contained a generic reference to ‘warranties’ and ‘intellectual property’ and that there was no mention of ‘COLOURBLIND’ in that agreement. The Court went on to note that, even assuming that the sign ‘COLOURBLIND’ was covered by that agreement, all that was mentioned with regard to the invalidity applicant was its being the beneficial owner of rights in that sign, not that it had legal title to those rights [‘beneficial owner’ is a legal term from English law used to indicate where</p>		




specific property rights in equity belong to a person even though the legal title of the property belongs to another person]. The Court added that, if there was an agreement between Mr C. and the invalidity applicant concerning the use of ‘COLOURBLIND’, it is possible that, owing to its implied or informal nature, it was not mentioned in the mentioned share purchase agreement. The Court held that, in the light of the evidence produced, it could not be excluded that Mr C. considered himself to have rights in the sign ‘COLOURBLIND’ up until the moment of its transfer to the EU trade mark holder and that both the invalidity applicant and a third, connected company that had later made use of the sign were acting under an implied or informal agreement on the part of Mr C (paras. 78-135).

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance of the trademark registration
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	


【EUIPO-4】 Doggis v. Doggis



1. Title	Doggis v. Doggis	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-335/14	
5. Date of the judgment	2016/1/28	
6. Parties : Plaintiff Defendant	Mr. Davo Lledo EUIPO	
7. Mark	Plaintiff	Defendant(disputed trademark)
		 
8. Outline of the case		
The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.		
9. Summary of the judgment		
<p>The invalidity applicants invoked a number of earlier marks DOGGIS that they had registered in Chile and Uruguay. When they tried to register the mark DOGGIS in Spain, they found that it had been registered for the same services and with identical graphic element in Spain, in the EU, and also as an International Registration. They claimed that the EU mark had been applied for in bad faith. The Cancellation Division rejected the invalidity application, but the Board of Appeal declared the registration invalid. It found that, at the time of the EUTM application, the EUTM applicant was aware of the existence of the earlier figurative Chilean marks, identical to the sign applied for. The Board found that such a coincidence could not be the result of a fortuitous identity.</p> <p style="text-align: right;">The General Court confirms the findings of the Board of Appeal.</p> <p><i>✂The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.</i></p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride	✓	
Imitation by agents or people who have a prior relationship		

Interference by a competing company	
Lack of intention to use	
Others	

【EUIPO-5】 GUGLER v. GUGLER

1. Title	GUGLER v. GUGLER	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T 674/13	
5. Date of the judgment	2016/1/28	
6. Parties : Plaintiff Defendant	Gugler France OHIM	
7. Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
		GUGLER
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark above had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court did not examine the bad faith issue. The decision of the Board of Appeal denying that the EUTM was registered in bad faith remains valid.</p>		
9. Summary of the judgment		
<p>According to the Board of Appeal of the EUIPO, nothing in the facts of the case showed that Gugler GmbH filed the contested EUTM in bad faith, even though there had been previous business relations between the parties. The Board noted that in 2003, Gugler GmbH had already been producing and exporting the relevant products ‘under the name GUGLER’ for many years. Therefore, applying for an EUTM was an obvious and completely justified action which did not reveal bad faith.</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Maintenance of the trademark registration	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship	✓	
Interference by a competing company		
Lack of intention to use		
Others		

【EUIPO-6】 LLRG5 v. LLRG5



1. Title	LLRG5 v. LLRG5	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-306/13	
5. Date of the judgment	2015/6/16	
6. Parties : Plaintiff Defendant	Silicium España Laboratorios, SL EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
	LLRG5	
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark LLRG5 had been registered in bad faith. After EUIPO upheld the invalidity application, the EU trade mark proprietor brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>Mr. I had sought to register the word sign LLRG5 as an EU trade mark, acting as an intermediary of Mr. R, one of the shareholders of the invalidity applicant. Before the mark was granted, the intermediary requested EUIPO to register the assignment of the EU trade mark application to Mr. R. The change of proprietor was registered and published. Mr. R. and the invalidity applicant concluded an agreement that would confer to the latter an exclusive license which stated, inter alia, that Mr. R. would not authorize others to use the names “LLRG5” or “G5”. After Mr. R’s death, the invalidity applicant filed with EUIPO an application for registration of the transfer of the EU trade mark LLRG5, based on said agreement. The application was refused on the ground that the agreement did not state that Mr. R had actually transferred the contested mark to the invalidity applicant. Said EU trade mark had meanwhile been transferred to the EU trade mark proprietor MR C. The Board of Appeal found that Mr R, as beneficial applicant, had acted in bad faith when instructing an intermediary to file an application for registration of the contested trade mark. Before the General Court, the actual EUTM proprietor, Mr. C., put forward that Mr. R. had a legitimate interest in applying for the registration of that mark and disputed the probative value of matters that were taken into consideration by EUIPO when it concluded that the mark had been registered in bad faith (para. 40). The Court rejected this argument since the invalidity applicant produced a formal statement by its representative, made before a solicitor, as well as a set of documents which contained his opinion that the application for registration of the EU trade mark was made in</p>		

bad faith due to the fact that the filing was made without the knowledge of the invalidity applicant (paras. 42-43). With regard to the probative value of the statement, the Court pointed out that, although it did not fall within the category of self-supporting evidence, it was substantiated by the documents that were submitted to EUIPO (para. 46). The Court found that it was apparent from the case file that Mr. R. could not have been unaware that the invalidity applicant used the sign LLRG5 as its company name (para. 47). Furthermore, although it was not possible to establish with certainty what was the common intention between the parties with regard to the sign, no evidence was provided that could lead to the conclusion that Mr. R. had reserved rights to himself over that name (para. 52). Therefore, the EU trade mark proprietor did not prove the existence of the exclusive rights it alleged (Para. 58). The Court stated that Mr. R. did not give the invalidity applicant the possibility of considering whether it was appropriate to oppose the application for registration of the sign at issue, which led to the finding that the application could be held to be a “concealed act”, carried out through an intermediary, with the intention of preventing the invalidity applicant from being able to use the sign (para. 71). In this light, the application for registration of the contested mark was made in bad faith (para. 73).

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	





【EUIPO-7】 LUCEO v. LUCEA LED



1. Title	LUCEO v. LUCEA LED	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T825/14	
5. Date of the judgment	2016/7/7	
6. Parties : Plaintiff Defendant	Copernicus-Trademarks Ltd. EUIPO	
7. Mark	Plaintiff (disputed trademark)	Intervener
	LUCEO	LUCEA LED
8. Outline of the case		
The Cancellation Division (CD) and the Board of Appeal (BoA) declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.		
9. Summary of the judgment		
<p>Copernicus, represented by Mr A., filed an application for registration of the word mark LUCEO (Class 10, 12, 28) in September 2009. It claimed priority from an Austrian application for the word mark LUCEO filed in March 2009 for the same goods. Two months later it filed an opposition against the application for registration of the EUTM LUCEA LED (applied for by the intervener or invalidity applicant).</p> <p>The EUTM LUCEO was registered in October 2010. Subsequently, the intervener (who applied for the registration of the EUTM LUCEA LED) requested that the LUCEO EUTM be declared invalid, as Copernicus had acted in bad faith. Both the CD and the BoA found that the mark had been applied for in bad faith.</p> <p>The General Court (GC) confirms the findings of the Board of Appeal.</p> <p>Copernicus and Mr A. pursued an unlawful filing strategy, consisting in successively chaining together applications for registration of national trade marks in Austria and Germany seeking to claim priority for an application of an EUTM and to grant a blocking position to Mr A. in order to oppose applications for registration of EUTM filed by third parties (p. 35-39 of the judgment).</p> <p>The GC found this filing strategy incompatible with the objectives of the EUTM Regulation and qualified it as an abuse of law (p. 52). It also noted that Mr A. stated that he did not intend to use the mark at issue and was unable to indicate the name of the clients who expressed an interest in that mark and requested payment of 75 000 € from the intervener. Bad faith exists inter alia where trade mark applications are diverted from their initial purpose and filed speculatively or solely with a view to obtain financial compensation (p. 145).</p> <p style="text-align: center;"><i>✧The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The General Court confirmed this decision.</i></p>		

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	✓

【EUIPO-8】  v.  

1. Title	 v. 	
2. Country	European Union	
3. Court	Cancellation Division (EUIPO first instance)	
4. Case No.	9634 C	
5. Date of the judgment	2015/9/9	
6. Parties : Plaintiff Defendant	Thierry Khayat Sandys S.r.l.	
7. Mark	Plaintiff	Defendant(disputed trademark)
		
8. Outline of the case		
The Cancellation Division (CD) declares invalid the registration of the EUTM as it was applied for in bad faith. An appeal is pending before EUIPO Boards of Appeal		
9. Summary of the judgment		
<p>In May 2008, Mr. A.T., vice president of the bankrupt Tacchini Group, assigned the French mark VdeV reproduced above to H4T S.r.l. In December 2008, Ms. G.T. applied for registration of the VdeV mark in Italy. In June 2009 Ms. G.T. filed for a EUTM, with priority based on the Italian application.</p> <p>In 2012, Ms. G.T. transferred the Italian and the EU marks VdeV to SANDYS S.r.l., whose CEO is Mr. A. Tacchini., represented by a law firm where one of the partners is Ms. G.T.'s husband. Ms. G.T. worked with that law firm since 2010.</p> <p>The Cancellation Division had to establish two questions: (1) whether the current owner, SANDYS, is a bona fide owner, (2) whether Ms. G.T. applied for the EUTM independently and in good faith or whether she did so on behalf of the current owner.</p> <p>CD: it is strongly against honest commercial practice that a person who led a company into insolvency and had to sell its TMs, would acquire the same (with geographically extended protection) just by creating a new company. In view of all the circumstances taken together, the current owner SANDYS (whose CEO is Mr. A. Tacchini) should be considered to be the real applicant for the contested EUTM. Bad faith implies proving that at the time of filing, the EUTM owner was aware that it was causing harm to the invalidity applicant and that this harm was a consequence of its reproachable conduct from a moral o commercial point of view.</p> <p>Mr. A. Tacchini, CEO of the EUTM owner, must have been aware that it is ethically unacceptable and contrary to honest and fair commercial practices for his new company to own the CTM identical to the national marks that he transferred to a third party when his other company was insolvent.</p>		
<p><i>✧The Board of Appeal declared invalid the registration of the EUTM as it was applied for in bad faith. The</i></p>		

General Court confirmed this decision.

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	✓

【EUIPO-9】 SIMCA v. SIMCA



1. Title	SIMCA v. SIMCA	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-327/12	
5. Date of the judgment	2014/5/8	
6. Parties : Plaintiff Defendant	Simca Europe Ltd. EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
	SIMCA	
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark SIMCA had been registered in bad faith. After EUIPO upheld the invalidity application, the EU trade mark proprietor brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>According to the General Court, in order to establish bad faith account may be taken of the origin of the word or the sign which forms the mark at issue and of the earlier use of that word or sign in business as a mark, in particular by competing undertakings, and of the commercial logic underlying the filing of the application for registration of that word or that sign as an EU trade mark (para. 38 and 39). The mark SIMCA has been used for cars since 1930 and the invalidity applicant has trademark protection for SIMCA in different Member States as France, Germany, Spain etc. for goods in class 12. However, the mark has not been used since 1980 (para. 42). At the date of filing of the EUTM, the mark still had a certain degree of reputation among the public interested in cars. The EU trade mark proprietor knew this residual reputation of the SIMCA marks and was looking for an appropriate mark which was no longer used and which accordingly had no legal protection (paras. 45 - 53).</p> <p>The Court finally concluded that the real purpose of the EU trade mark proprietor was to ‘free-ride’ on the reputation of the invalidity applicant’s registered marks and to take advantage of that reputation (para 56). The judgement emphasizes that the clear and evident intention to take advantage of the residual reputation of the sign SIMCA on the motor vehicle market, to create an association with the earlier marks and to compete with those earlier marks if they were re-used by the invalidity applicant is to be considered as bad faith in the sense of Article 52 (1) (b) of the EU trade mark Regulation (para 63). This conclusion is not based on the “offer of compensation” to the invalidity applicant (para. 70). The fact that the EU trade mark proprietor had started the use of the registered SIMCA mark is not relevant (para. 74). Also the fact, that the EU trade mark proprietor worked in the past for the invalidity applicant is not decisive for the outcome (para. 79).</p>		

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【EUIPO-10】 URB v. URB



1. Title	URB v. URB	
2. Country	European Union	
3. Court	General Court of the European Union (EGC)	
4. Case No.	T-506/13	
5. Date of the judgment	2014/11/7	
6. Parties : Plaintiff Defendant	Urb Rulmenti Suceava SA EUIPO [OHIM at the time the judgment was rendered]	
7. Mark	EU trade mark proprietor(disputed trademark)	Invalidity applicant
	URB	
8. Outline of the case		
<p>An invalidity applicant claimed before EUIPO (called OHIM at the time) that the EU trade mark URB had been registered in bad faith. After EUIPO dismissed its request, the invalidity applicant brought an action before the General Court alleging inter alia that EUIPO had infringed Article 52(1) (b) of the EU trade mark regulation. The Court dismissed the appeal.</p>		
9. Summary of the judgment		
<p>The General Court recalled that, in assessing whether a mark has been registered in bad faith, account may also be taken of the commercial logic underlying the filing of the application for registration of an EU trade mark. Even in circumstances where several producers were using, on the market identical or similar signs for identical or similar products, capable of being confused with the sign for which registration was sought, the EU trade mark proprietor’s registration of the sign may still be in pursuit of a legitimate objective (para. 35).</p> <p>The Court held that it was understandable from a commercial point of view that the EU trade mark proprietor wished to extend the protection of the URB trade mark by registering it as an EU trade mark. In that respect, the evidence on file showed that, during the period which preceded the filing, the EU trade mark proprietor used the trade mark, through a connected company, and generated turnover from goods marketed under the trade mark in several Member States, which was a plausible incentive for filing an application for the registration of an EU trade mark (para. 41). The invalidity applicant did not establish that it was the EU trade mark proprietor’s intention to exclude it from the market (para. 44). The fact that the EU trade mark proprietor knew or should have known that a third party (i.e. the invalidity applicant in this case) has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the EU trade mark proprietor was acting in bad faith when filing the application (para. 47).</p>		
10. Tags		

① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance of the trademark registration
③ Type of bad faith (Free Ride ✓)	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

【EUIPO-11】 Mr. Arrigo Cipriani v. CIPRIANI



1. Title	Arrigo Cipriani v. Hotel Cipriani	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-343/14	
5. Date of the judgment	2017/6/29	
6. Parties : Plaintiff Defendant	Arrigo Cipriani Hotel Cipriani Srl	
7. Mark	Plaintiff	Defendant (Disputed trademark)
	Mr. Arrigo Cipriani	CIPRIANI
8. Outline of the case		
<p>The Defendant, Hotel Cipriani Srl, applied for the European Union trade mark for the word CIPRIANI in Classes 16, 35 and 42 (registered in 1997).</p> <p>The Hotel Cipriani in Venice had been established by the father of the Plaintiff in 1956. The shares in the company owning the hotel were later transferred to another company, which subsequently sold them to the Defendant.</p>		
9. Summary of the judgment		
<p>Mr Arrigo Cipriani requested that the disputed trademark be annulled on a number of grounds, <i>inter alia</i> because it had been applied for in bad faith. EUIPO's Cancellation Division and Board of Appeal rejected the invalidity request. Mr Cipriani brought an action before the General Court.</p> <p>The Defendant was also the proprietor of an <u>Italian</u> word mark CIPRIANI, registered in 1971 in Classes 29, 30, 32, 33 and 42.</p> <p>The General Court ruled that, extending the protection of a national mark by registering it as a European Union trade mark is part of an undertaking's normal commercial strategy. This cannot be assimilated to an act of bad faith at the time of application for registration of the European Union trade mark CIPRIANI in 1996.</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Refusal of invalidation	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship	✓	
Interference by a competing company		
Lack of intention to use		
Others		

【EUIPO-12】  v 

1. Title	Biernacka-Hoba v Formata Bogusław Hoba	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-23/16 (ECLI:EU:T:2017:149)	
5. Date of the judgment	2017/3/08	
6. Parties : Plaintiff Defendant	Ilona Biernacka-Hoba Formata Bogusław Hoba	
7. Mark	Plaintiff	Defendant (Disputed trademark)
		
8. Outline of the case		
<p>The case concerns an invalidity action between ex-spouses who had previously run a family business.</p> <p>The Plaintiff argues that both parties used to be the proprietor of a Polish trade mark which had expired, and that the new trade mark application came after their divorce but before the division of property between them, and therefore the right to the trade mark could not belong to the Defendant.</p>		
9. Summary of the judgment		
<p>The Plaintiff (former wife) filed a request for a declaration of invalidity against the EUTM ‘FORMATA’ registered by her former husband (the Defendant). She invoked her husband’s bad faith when registering the European Union trade mark. The Board of Appeal rejected the Plaintiff’s invalidity action.</p> <p>An action was filed before the General Court, claiming infringement of Article 52(1)(b) EUTMR.</p> <p>The General Court confirmed the Board of Appeal’s decision. The fact that the Defendant did not make any submissions before the EUIPO in reply to the invalidity request does not lead to a presumption of bad faith.</p> <p>It is the Plaintiff who has to prove that the Defendant acted in bad faith when applying for the disputed trademark. As regards the specific circumstances of the case, in particular the divorce of the parties and the division of property between them, the Plaintiff failed to submit sufficient evidence to demonstrate bad faith on the part of the Defendant.</p>		
10. Tags		
① Type of trial		
② Decision		
③ Type of bad faith		
Free Ride		

Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	



1. Title	Foodcare v Dariusz Michalczewski	
2. Country	European Union	
3. Court	Court of Justice	
4. Case No.	C-639/16 P (ECLI:EU:C:2017:367)	
5. Date of the order	2017/5/11	
6. Parties : Plaintiff Defendant	Dariusz Michalczewski Foodcare sp. z o.o.	
7. Mark	Plaintiff	Defendant (Contested trademark)
	<p>Dariusz Tiger Michalczewski</p>  	<p>T.G.R. ENERGY DRINK</p>

8. Outline of the case

Dariusz Michalczewski (the Plaintiff) is a well-known boxer also known as ‘Tiger’. He is the proprietor of several trade marks. In 2003, there was an agreement between him and Foodcare (the Defendant) whereby he authorised the company to use the image, nickname ‘Tiger’ as well as the trade marks he owned, in order to promote energy drinks. Following this agreement, the Defendant filed in 2007 an application to register the contested trade mark.

9. Summary of the judgment

The Defendant registered the trade mark ‘T.G.R ENERGY DRINK’. Following this registration, the Plaintiff filed an application for cancellation of the contested trade mark relying on the Defendant’s bad faith.

The Cancellation Division considered that bad faith had not been proved, because the level of similarity between the signs is so low that it is hard to see how the Defendant might have thought that the use of the contested trade mark could have caused harm to the former boxer.

The Board of Appeal considered however that the Cancellation Division did not take into account all the relevant factors when assessing the Defendant’s bad faith at the time of filing of the registration. Based on the assessment of all the relevant factors, bad faith was established.

The Defendant filed an action before the General Court, requesting the annulment of the Board of Appeal’s decision, based on Article 52(1)(b) EUTMR.



The General Court (*Case T-456/15; Judgment of 5 October 2016, ECLI:EU:T:2016:597*) confirmed the existence of bad faith, since the Board of Appeal did not err in taking into account as relevant factors to assess bad faith: (i) the

existence of direct contractual relations between the parties before the application to register the contested mark was filed and their content; (ii) the Defendant's intention to develop its commercial activity relying, in particular, on the image projected by the Plaintiff and his reputation, this being supported by the content of the contracts and the get-up of the packaging of the products marketed by the Defendant; (iii) the Defendant's intention to create at least an association between the sign 'Tiger Energy Drink' used on account of the parties' agreements, which enjoyed a considerable reputation, and the contested mark, this being supported by the strong similarity between the signs; (iv) the Defendant's intention to continue benefiting from the extent of the reputation enjoyed by the sign 'Tiger Energy Drink', while circumventing the contractual obligations arising from the agreements concluded with the Plaintiff, as supported by the content of the contracts.

The Defendant appealed the judgement in front of the Court of Justice. Yet, the Court of Justice found the appeal in part manifestly unfounded and in part manifestly inadmissible.

10. Tags

① Type of trial	
② Decision	
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

1. Title	Airhole Facemasks v industriesurf, SL	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-107/16 (ECLI:EU:T:2017:335)	
5. Date of the judgment	2017/5/16	
6. Parties : Plaintiff Defendant	Airhole Facemasks, Inc. industriysurf, SL	
7. Mark	Plaintiff (owner of an earlier US and CDN mark)	Defendant (Disputed trademark)
		
8. Outline of the case		
<p>The Defendant, a previous distributor of the Plaintiff’s goods in six member states of the European Union, registered on its own name as an EUTM a sign identical to the earlier (US and CDN) Plaintiff’s marks.</p> <p>It is undisputed that the Plaintiff had consented to the filing of the disputed EUTM, but the parties disagree on whether such consent extended to the filing of the contested mark <u>in the Defendant’s own name</u>.</p>		
9. Summary of the judgment		
<p>The Plaintiff requested the disputed EUTM to be declared invalid because it had been applied for in bad faith.</p> <p>The Cancellation Division found bad faith and declared the disputed mark invalid.</p> <p>The Board of Appeal annulled the decision of the Cancellation Division. It found that the Plaintiff had not proved that it had not consented to the filing of the disputed mark in the name of the Defendant, which excluded bad faith.</p> <p>The General Court annulled the decision of the Board of Appeal and found that the EUTM proprietor (Defendant) had acted in bad faith when it filed the contested mark.</p> <p>The General Court found that there was no indication suggesting that the Plaintiff had consented in a clear, specific and unconditional manner to that filing in the Defendant’s own name. This followed from (i) the correspondence between the parties before and after the filing and (ii) from the objective circumstances of the case such as the identity of the EUTM with the prior US and Canadian marks, the existence of an exclusive distribution agreement, which was in force at the time of filing and obliged the EUTM proprietor to request an express consent for the use of the Plaintiff’s logos and marks. According to the General Court, this allowed the EUTM proprietor to understand that the</p>		

filing of the contested mark followed the Plaintiff's commercial logic to extend the protection of its mark to the territory of the European Union.

The General Court also found that the EUTM proprietor had sought to usurp the Plaintiff's rights. As a matter of fact, the Defendant neither informed the Plaintiff of the filing and the subsequent registration of the contested mark, nor did it honour its obligation to transfer the contested mark to the Plaintiff, but threatened the very Plaintiff and its other distributors in the EU with infringement proceedings based on the contested mark.



10. Tags

① Type of trial	
② Decision	
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【EUIPO-15】

OutsourceIndia v



1. Title	Flatworld Solutions v Outsource Professional Services Ltd	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-340/16 (ECLI:EU:T:2018:314)	
5. Date of the judgment	2018/5/31	
6. Parties : Plaintiff Defendant	Flatworld Solutions Pvt Ltd, Outsource Professional Services Ltd	
7. Mark	Plaintiff (EUTM)	Defendant (Disputed trademark)
		
8. Outline of the case		
Bad faith was assessed <i>inter alia</i> on the basis of the previous commercial relations that existed between the two parties.		
9. Summary of the judgment		
<p>The EUTM proprietor (the Defendant) registered the EUTM above in 2008. In 2010, the Plaintiff registered its trade mark in the EU. Subsequently, the Plaintiff filed an application for a declaration of invalidity of the disputed trademark, pursuant to Article 52(1)(b) EUTMR.</p> <p>The Cancellation Division considered that the Defendant had intentionally sought to appropriate the Plaintiff's trade mark and thus acted in bad faith at the time of the registration.</p> <p>Following the Defendant's appeal, the Board of Appeal considered that the Defendant had not acted in bad faith or with dishonest intent.</p> <p>The Plaintiff appealed to the General Court, alleging infringement of Article 52(1)(b) EUTMR.</p> <p>The General Court annulled the Board of Appeal decision; it considered that the Defendant had acted in bad faith when it filed its trade mark application. Indeed, the Defendant knew that the Plaintiff was using that wording in its logo, in its non-registered mark and in its domain names. In particular, the Defendant contacted the Plaintiff specifically in order to establish collaboration in the European Union and, more specifically, in Germany, in developing the Plaintiff's business by making use of that wording. In addition, the Defendant filed, shortly after the termination of its pre-contractual relationship with the Plaintiff, the application for registration of the disputed mark. All of those factors demonstrate its bad faith, particularly as it had also registered its company and its mark in Germany and the United Kingdom beforehand.</p>		

10. Tags	
① Type of trial	
② Decision	
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

Case Examples of JPO

【JPO-1】 KUMA v. PUMA



1. Title	KUMA v. PUMA	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2012(Gyo-Ke)10454	
5. Date of the judgment	2013/6/27	
6. Parties : Plaintiff Defendant	Hokkaido Design Kabushiki Kaisha Puma SE	
7. Mark	Plaintiff (disputed trademark)	Defendant
8. Outline of the case		
A case in which the plaintiff's registered trademark is determined as having been obtained contrary to ethics of business and being liable to cause confusion with goods connected with another person's business.		
9. Summary of the judgment		
<p>The defendant's trademark had become a well-known, famous trademark widely recognized by traders and consumers in Japan as a trademark affixed to the defendant's sports shoes, clothing, bags, etc. The defendant's trademark may be recognized to have maintained such recognition as of the time of examination for registration of the trademark and thereafter.</p> <p>The defendant is a famous multinational company engaged in the global manufacturing and sale of sports shoes, clothing, bags, etc., that the defendant's trademark has been widely recognized among traders and consumers as a distinctive trademark that indicates the goods pertaining to the business of the defendant, that some of the designated goods of the plaintiff's trademark overlap with the goods for which the defendant's trademark has been used.</p> <p>Based on a comprehensive evaluation of these facts, it may be recognized that the applicant, which was aware that the defendant's trademark is famous, created the plaintiff's trademark consisting of four alphabetic characters "KUMA" intentionally written in almost the same manner as the defendant's trademark and a figure of a bear as a replacement of the puma used for the defendant's trademark in order to ensure that the overall configuration of the plaintiff's trademark looks extremely similar to that of the defendant's trademark so that traders and consumers who come across the plaintiff's trademark would associate the Trademark with the defendant's Trademark. The applicant created the Trademark, filed an application for registration of the</p>		



trademark, and had it registered for the illicit purpose of free-riding the reputation, honor, and customer appeal embodied by the defendant's trademark.

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-2】 ASRock v. Asrock



1. Title	ASRock v. Asrock	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2009(Gyo-Ke)10297	
5. Date of the judgment	2010/8/19	
6. Parties : Plaintiff Defendant	Kabushiki Kaisha Unister Y	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
A case in which the defendant's trademark to be a filing for the purpose of plagiarism is considered to have fallen under a trademark which is likely to cause damage to public policy.		
9. Summary of the judgment		
<p>The application for registration of the defendant trademark was concluded to be filed for the purpose of gaining unfair profit from assignment of trademark right or causing damages to ASRock Inc. and its dealers for the reasons that</p> <p>(i) It cannot be considered, or at least the possibility is extremely low, that the defendant has an intention to engage in business in Japan in the near future in relation to the designated goods pertaining to the Trademark.</p> <p>(ii) The defendant, although not substantially engaged in any business activities, has filed a large number of trademark applications relating to electronic equipment. Some of these applications are considered to be the intentional applications of the trademarks identical with, or similar to, the trademarks to be used by other companies in foreign countries.</p> <p>(iii) After the registration of the defendant's trademark, the defendant, although not doing business in Japan, sent a large number of warning letters to distributors of ASRock products bearing the plaintiff's trademark, including the plaintiff, requesting them to cease import and sale of the products and warning them that it may institute a criminal prosecution or an action seeking claim for damages unless they follow the request.</p> <p>As mentioned above, the court finds the defendant's trademark to be a filing for the purpose of plagiarism, with an unfair intention of registering the trademarks to be potentially used and filed for trademark registration in Japan by ASRock, Inc. as their respective trademarks. Even under the Japanese legal framework which adopts the first-to-file system for the trademark registration application without a requirement of actual use at the time of filing, such applications are unacceptable from the standpoint of the rule of reason, considering the commonsense understanding of the general public when seeking justice. In addition, such applications are considered as being</p>		

detrimental to the fairness in trademark order. Accordingly, the defendant's trademark is considered to have fallen under a trademark which is 'likely to cause damage to public policy,' without regard to whether the plaintiff's trademark and the mark 'ASRock' were well-known or famous, at the time of the filing thereof.

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【JPO-3】 COMEX v. comex





1. Title	COMEX v. comex	
2. Country	Japan	
3. Court	Tokyo High Court	
4. Case No.	2004(Gyo-Ke)219	
5. Date of the judgment	2005/1/31	
6. Parties : Plaintiff Defendant	Kentrading Brain Kabushiki Kaisha ROLEX societe anonyme COMEX societe anonyme	
7. Mark	Plaintiff (disputed trademark)	Defendant
		comex
		COMEX
8. Outline of the case		
A case in which the plaintiff's trademark to be a filing for the purpose of plagiarism is considered to have fallen under a trademark which is likely to cause damage to public order or morals.		
9. Summary of the judgment		
<p>The trademark "COMEX" filed by the plaintiff, when considering the background of filing the application and activities of the plaintiff after registration of the trademark, was made ahead seeking for benefit by taking the opportunity that the "COMEX" has not been registered in Japan designating goods of 'watches, parts and accessories of watches' in Japan, knowing the popularity of the "ROLEX/comex double named" watch made by ROLEX company, i.e., the defendant, and proof of high performance and confidence of the ROLEX diver's watches being embodied in the trademarks of "comex" and "COMEX", and thus it is clear, if the trademark "COMEX" is used for watches sold by the plaintiff, such a use will cause misleading of consumers as well as causing damages of the reputation embodied in the trademarks of "comex" and "COMEX" of ROLEX company through such a free riding activity, and further, if the trademark "COMEX" is used for relatively inexpensive diver's watches sold by the plaintiff, such a use will cause dilution of the trademarks of "comex" and "COMEX" of which rarity and fame are maintained by the use only by very few Submariner and Sea-Dweller.</p> <p>In the light of the above described circumstances, continued registration of the trademark "COMEX" shall be contrary to the order scheduled in the Trademark Act. From such an aspect, the trademark "COMEX" must be invalidated for the reason "the trademark is likely to cause damage to public policy".</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	

② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-4】 LAMBORGHINI v. Lamborghini



1. Title	LAMBORGHINI v. Lamborghini	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2011(Gyo-Ke)10426	
5. Date of the judgment	2012/5/31	
6. Parties : Plaintiff Defendant	Automobili Lamborghini S.p.A Kabushiki Kaisha Liberty Walk	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
<p>A case in which the defendant's trademark is determined as being obtained the purpose of gaining unfair profit, causing damage to another person, or other unfair purposes because the defendant filed the defendant's trademark while knowing that the plaintiff's trademark is well known among consumers, and also knowing that the defendant's trademark is similar to the plaintiff's trademark.</p>		
9. Summary of the judgment		
<p>The plaintiff is a car maker established in Italy in 1962. It is famous on a global level mainly for the high-end sports cars that it makes and sells. In Japan as well, the cars made by the plaintiff, such as "Countach," were called "supercars" and became popular in the 1970s. The plaintiff's trademark, "LAMBORGHINI," which represents part of the plaintiff's name, has been regarded as an indication of the plaintiff or the goods pertaining to the plaintiff's business and well known among car dealers and fans in Japan.</p> <p>Comparing the plaintiff's trademark and the defendant's trademark, nine out of the ten alphabetical characters forming the character part of the defendant's trademark are also used in the plaintiff's trademark. These trademarks are also similar in terms of sound because their sounds are different for only one sound element and the different sound elements between them are in the same vowel structure and therefore close to each other. In appearance, these trademarks are similar in whole, although they have a slight difference. Taking these matters into consideration as well as the actual conditions of trading including how the plaintiff and the defendant have used their trademarks, the plaintiff's trademark and the defendant's trademark are similar to each other.</p> <p>It is found that the defendant filed the application for registration of the defendant's trademark with respect to cars, etc. as the designated goods, while knowing that the plaintiff is a globally famous car maker and the</p>		





plaintiff's trademark is well known among consumers as indicating the goods pertaining to the plaintiff's business, and also knowing that the defendant's trademark is similar to the plaintiff's trademark, and the defendant has actually been making and selling custom buggies that resemble the cars made and sold by the plaintiff, while using trademarks such as "Lamborghini". Thus, it is found that the defendant uses the defendant's trademark for the purpose of gaining unfair profit, causing damage to the other person, or other unfair purposes.

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-5】 Manhattan passage v. ManhattanPortage



1. Title	Manhattan passage v. ManhattanPortage	
2. Country	Japan	
3. Court	Tokyo High Court the 18th civil chamber	
4. Case No.	2002(Gyo-Ke)593	
5. Date of the judgment	2003/11/20	
6. Parties : Plaintiff Defendant	Leisure Products Kabushiki Kaisha Manhattan Portage Ltd.	
7. Mark	Plaintiff (disputed trademark)	Defendant (cited mark)
	 <i>(‘ManhattanPortage’ combined trademark in other case)</i> 	 <i>(figure trademark in other case)</i> 
8. Outline of the case	<p>A case in which the plaintiff’s trademark is determined as being filed for the unfair purposes such as to prevent the foreign well-known trademark proprietors from entering into Japan, have them buy out expensively or sign a domestic agency contract.</p>	
9. Summary of the judgment	<p>The plaintiff’s trademark is constituted as illustrated upper left (see “disputed trademark”), has registered as the trademark designating goods including ‘leather, skin, tanned leather, etc.’</p> <p>The cited mark is constituted as illustrated upper right (see “cited mark”) and the defendant designed and used it for ‘messenger bags, softly-made hand bags, backpacks, etc.’ (hereinafter referred to as ‘the defendant’s goods’).</p> <p>The ‘ManhattanPortage’ combined trademark and the figure trademark in other cases are constituted as illustrated upper left. Their rights belong to ‘A’ who was the Representative Director of the plaintiff.</p> <p>The defendant started using its marks in the U.S. in April 1983 and obtained the U.S. trademark registrations in July 1997. The cited mark has been widely known at least in the field where bags are handled and among consumers of the goods in the U.S. before the application for registration of the plaintiff’s trademark was filed.</p> <p>The defendant and ‘A’ negotiated about transactions of the defendant’s goods. They basically agreed that A</p>	

would purchase the defendant's goods. However, 'A' (or the plaintiff) and the defendant did not reach definitive agreement as to exclusive distributorship of the defendant's goods in Japan.

Further, it is presumed that 'A' sufficiently recognized the reputation of the defendant's goods, and the plaintiff had not notified the relevant parties of the defendant about the plaintiff's application for registration of trademark combined with Portage in other case and the device mark in other case, and furthermore the plaintiff's trademark.

There was an unfair purpose in the behavior that 'A' filed the application for registration of the 'ManhattanPortage' combined trademark and the figure trademark in other case, since 'A' filed the application for registration of the plaintiff's trademark similar in appearance (also in sound for the application for registration of trademark combined with Portage in other case) in Japan, understanding that 'A' had no license to use these marks that had been well known in the U.S.

Further, when considering that the plaintiff's trademark closely resembles the 'ManhattanPortage' combined trademark and the figure trademark in other case, it should be concluded that there was an unfair purpose in filing the application for registration of the plaintiff's trademark as well as in filing the applications for registrations of the above mentioned two other trademarks.

Consequently, it shall be concluded that there is no error in the decision stating that filing of the application for registration of the plaintiff's trademark was made for the unfair purpose.

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

【JPO-6】 L’AIR DU TEMPS v. レールデュタン



1. Title	L’AIR DU TEMPS v. レールデュタン	
2. Country	Japan	
3. Court	the 3rd petty bench of the Supreme Court	
4. Case No.	1998(Gyo-Hi)85	
5. Date of the judgment	2000/7/11	
6. Parties : Appellant Appellee	SARL parfum Nina Ricci madras Inc.	
7. Mark	Appellee	Appellant (disputed trademark)
	(registered trademark) L’AIR DU TEMPS	レールデュタン
	(used trademarks) レール・デュ・タン	
	(used trademarks) L’Air du Temps	
8. Outline of the case		
Judgment upon case concerning the effect that ‘trademarks which are likely to cause confusion with goods or services connected with another person’s business’ as referred to in Article 4 (1) (xv) of the Trademark Act include trademarks that risk causing confusion in the broad sense of the term		
9. Summary of the judgment		
<p>(1) It is legitimate to assume that ‘trademarks which are likely to cause confusion with goods or services connected with another person’s business’ as referred to in Article 4 (1) (xv) of the Trademark Act, when the trademark is used for its designated goods or services, not only trademarks which are likely to cause misunderstanding that the goods, etc. are connected with another person’s goods or services, but also trademarks which are likely to cause such misunderstanding that the goods, etc. are connected with business of a proprietor having a close business relationship with the above mentioned another person, i.e., the business relationship of parent company or subsidiary company, or belonging to a group producing goods to which the same indication is attached (hereinafter, referred to as ‘liable to cause confusion in a broad sense’).</p> <p>Whether it is ‘likely to cause confusion’ or not is to be determined totally referring to attentiveness to be generally payed by dealers and consumers of the designated goods, etc. to which the trademark is attached, in light of the degree of similarity between the trademark and another person’s indication, the degree of well-known fame or uniqueness of another person’s indication, the degree of relationship in terms of nature, use, or purpose between the designated goods, etc. of the trademark and goods, etc. connected with another person’s business, and commonality between dealers and consumers in terms of goods, etc. and actual circumstances of</p>		

transaction.

(2)The appellee’s registered trademark is identical at least to the trademark ‘レール・デュ・タン’ in sound among the trademarks in use, also resembles in appearance, and further, in view of the spelling itself and designated goods of the appellant’s trademark, sound of “re-e-ru-du-ta-n” in French in terms of the appellee’s trademark. Therefore, it is concluded that the appellee’s registered trademark is identical to the appellant’s trademark in sound. Further, each trademark in use and the appellant’s trademark are unique marks and are famous as indicating one of perfumes of the appellant to consumers who are interested in dealers of perfumes and high-grade perfumes. Still further, among the designated goods of the appellee’s registered trademark, ‘cosmetic utensils, ornaments, head accessories, bags, and pouches’ are closely related to the perfume mainly in the use for decorating woman and thus not a little number of consumers overlap between both goods.



As indicated above, if the appellee’s registered trademark is used for ‘cosmetic utensils, ornaments, head accessories, bags, and pouches’, such use shall be likely to cause confusion in broad sense among the dealers and consumers as if the above described goods are those connected with the business of the proprietor having a close relationship with the appellant as described above.

10. Tags

① Type of trial	Suit against appeal decision
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-7】 MARIEFRANCE v. MARIE FRANCE



1. Title	MARIEFRANCE v. MARIE FRANCE	
2. Country	Japan	
3. Court	JPO trial and appeal department	
4. Case No.	Appeal No. 25958 (1995)	
5. Date of the judgment	1999/8/11	
6. Parties : Demandant	Zyasu International Kabushiki Kaisha	
7. Mark	Demandant (disputed trademark)	Cited mark
		
8. Outline of the case		
A case in which an application filed was appropriated a well-known trademark in France and applied as the use for unfair purpose		
9. Summary of the judgment		
<p>The demandant's trademark(disputed trademark) is constituted of laterally written alphabet letters of 'MARIE FRANCE' and designates goods including 'clothing made in France, coat made in France' and the like. And the alphabet letters of 'MARIE FRANCE' was well-known and famous as a title of magazine in France as of filing the application for trademark registration.</p> <p>Meanwhile, order of letters of the demandant's trademark is completely identical to that of the title of the French magazine, i.e., 'MARIE FRANCE', and thus the both marks are deemed as identical to each other from common sense. Because it is deemed impossible that the demandant could independently or coincidentally select and file the letters arranged in the same order without knowing the 'MARIE FRANCE' magazine, it is reasonable to consider that the demandant used the title of the 'MARIE FRANCE' magazine almost as it is appropriated.</p> <p>The demandant's trademark designates goods of 'clothing, coat, sweaters, nightwear, underwear, swim wears for ladies' and the like, the 'MARIE FRANCE' magazine runs information, etc., as to ladies' fashion, and, when considering that French fashion draws high interest also in Japan. Therefore it is assumed that consumers of ladies' fashion magazine and consumers of the designated goods of the demandant's trademark shall overlap each other to some extent. If so, in a case where the right proprietor of the 'MARIE FRANCE' magazine or a person related to the proprietor attempts to enter into Japanese market, it would be likely to cause confusion of the indicating source with the demandant's trademark, which in turn results in preventing them from entering to Japanese market.</p> <p>When taking the above into consideration, the demandant's trademark was filed as to be appropriated on almost the same trademark that is well-known and famous in a foreign country, and thus the application must be filed</p>		



with unfair purpose contrary to the fair and equitable principle.

10. Tags

① Type of trial	Appeal against an examiner's decision of refusal
② Decision	Decision for refusal
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

【JPO-8】 M.A.C MAKEUP ART COLLECTION v. M.A.C



1. Title	M.A.C MAKEUP ART COLLECTION v. M.A.C	
2. Country	Japan	
3. Court	Opposition to the Registration (Trial / Appeal at JPO)	
4. Case No.	Appeal No. 92239 (1998)	
5. Date of the judgment	2000/3/28	
6. Parties : Owner of TM Rights Opponent	Kabushiki Kaisha Trysail Make-up Art Cosmetics, Inc.	
7. Mark	Owner of TM Rights (disputed trademark)	Opponent (cited trademark)
		
8. Outline of the case		
<p>A case in which the trial examiners rendered a ruling that the trademark registration concerned in the opposition would be revoked. In this case, trial examiners admitted that the disputed trademark had been used for unfair intension, namely intension to prevent the foreign well-known trademark proprietors from entering into Japan, to cause dilution of the trademark and to gain unfair profit, etc.</p>		
9. Summary of the judgment		
<p>The disputed trademark is constituted of designed “M.A.C” and “MAKEUP ART COLLECTION” that are in two lines (see “disputed trademark”) and designates goods including “bags, pouches, cosmetics bags, fittings for bags, opening fittings for wallets, horse-riding equipment” and the like. The cited trademark, referred by the opponent, is constituted of letters of “M.A.C” (see “cited trademark”) and designates goods including “fragrance, cosmetics, tooth paste”.</p> <p>The cited trademark of the opponent is used as the trademark for “make-up cosmetics”, etc., which has been worldwide popular products among Canada, America, etc.</p> <p>The alphabet letters of “MAC” constituting the disputed trademark are perfectly identical to those of the cited trademark into detail in terms of the decoratively featured design. Further, the letters of “MAKEUP ART COLLECTION” written in the lower line is liable to cause consumers to recognize as if it has some relationship with the make-up cosmetics of the opponent’s business, and the designated goods of the disputed trademark also includes cosmetic bags where cosmetic bags are also the goods that the opponent sells.</p> <p>Taking the above into consideration, it is hard to presume that the disputed trademark accidentally coincides with the cited trademark. It is rather presumed that the owner of the disputed trademark filed the application and</p>		



obtained the registration thereof for the purposes of preventing the foreign proprietor from entering to Japanese market, enforcing the foreign proprietor to make an agency agreement in Japan, gaining unfair profit by diluting, or free riding on the consumer attracting power of the cited trademark to gain unfair benefit. Therefore, the disputed trademark must be considered as the trademark being used for the unfair purposes.

10. Tags

① Type of trial	Opposition to the Registration
② Decision	Ruling to revoke
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

【JPO-9】 SONY v. SONYAN




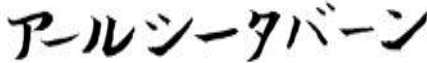
1. Title	SONY v. SONYAN	
2. Country	Japan	
3. Court	Tokyo High Court	
4. Case No.	1977 (Gyo-Ke) 133	
5. Date of the judgment	1978/4/26	
6. Parties : Plaintiff Defendant	SONY Corporation Y	
7. Mark	Plaintiff (cited mark)	Defendant (disputed trademark)
		
8. Outline of the case		
<p>A case in which the disputed trademark which contains therein another person's famous trademark as a main part thereof, was constituted to be invalid since it readily remind of and perceives another person's famous abbreviated name.</p>		
9. Summary of the judgment		
<p>The disputed trademark is constituted of letters of "SONYAN" (see "disputed trademark) and designates goods including "woven fabric, knit fabric, and other fabrics including felt".</p> <p>Incidentally, an invented word mark constituted of alphabet letters of "SONY" and a mark constituted of katakana characters of "ソニー" representing sound of "SONY" have been remarkably famous both domestically and internationally as the trademark for "electrical equipment" such as "transistor radio, television, tape recorder", etc. of the business of the plaintiff. In other words, it is admitted that both the "SONY" and "ソニー" have been well-known and famous in the public not only as the trademark for goods produced and sold by the plaintiff but also as the abbreviated name of the plaintiff at the time when the disputed trademark was filed. On the other hand, where a series of letters of "SONYAN" of the disputed trademark has no remarkable feature in font design, the first four letters among all the six letters are coincide with the plaintiff's invented word "SONY" and the last two letters "AN" following the first four letters are frequently intuitively recognized as giving a meaning of "one's", "having the nature of", or "of a race of" in the light of the benchmark of the English knowledge in Japan.</p> <p>When taking the above into consideration, the disputed trademark shall easily remind of and perceive the famous abbreviated name of "SONY" and shall highly possibly mislead the public to read the main portion as "SONY".</p> <p>Since the disputed trademark shall be considered as a trademark containing another person's famous abbreviated</p>		

name therein, and thus falls under Section 4 (1) (viii) of the Trademark Act, it should be constituted to be invalid.

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-10】 RC TAVERN / アールシータバーン v. アールシータバーン



1. Title	RC TAVERN / アールシータバーン v. アールシータバーン	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2012 (Gyo-ke) 10019	
5. Date of the judgment	2012/5/31	
6. Parties : Plaintiff Defendant	Dynac co.Ltd Y	
7. Mark	Plaintiff (plaintiff's trademark)	Defendant (disputed trademark)
		
8. Outline of the case		
<p>A case in which the disputed trademark is not considered as the actually used trademark or the trademark that the proprietor has the intention to use in the future at the time when the disputed trademark was decided to be registered</p>		
9. Summary of the judgment		
<p>The trademark in use by the plaintiff is constituted as illustrated above (see “plaintiff’s trademark”) and the disputed trademark, which designates services including “serving foods and drinks”, is constituted as illustrated above (see “disputed trademark”).</p> <p>When taking account of the fact that disputed trademark has a constitution identical to the plaintiff’s trademark in use except for the font design of the letters of ”アールシータバーン” and the sound of the disputed trademark is identical to the plaintiff’s, i.e., sound of “a-a-ru-si-i-ta-ba-a-n”, it is admitted that the disputed trademark is similar to the plaintiff’s trademark.</p> <p>In view of the facts that the plaintiff’s trademark is a coined phrase created by combining “RC” which is the initials of the name of the restaurant, “Rose & Crown”, operated by the plaintiff, with “Tavern,” which is an English word meaning a pub or bar, and it may be considered to be distinctive, and that the timing of advertisement and opening of the establishment is close to the date of filing an application for the disputed trademark, the defendant may be considered to have filed an application for the disputed trademark, which is similar to the plaintiff’s trademark in use, with the awareness of the existence of the plaintiff’s trademark in use.</p> <p>Where the defendant filed 44 applications for registration of trademarks in addition to the disputed trademark in a short period and obtained decisions of registrations thereof, the defendant has not been using any of the</p>		

obtained registered trademarks for designated services or the other business to date, and the designated services expand in a wide range, has no consistency, and further, with respect to 30 trademarks among the registered trademarks not in use, there are shops/restaurants and companies using similar trademarks and marks irrelevant to the defendant, and still further, with respect to at least 10 trademarks among the registered trademarks not in use, the applications for trademark registration was filed by the defendant after start of the use of the other persons' similar trademarks or marks.

In sum, the defendant filed applications for trademark registration designating various services with respect to another persons' trademarks or marks in use only for the purpose of collecting the registered trademarks.

Consequently, the disputed trademark is not considered as being the trademark in use that is used for goods or services connected with the defendant's business or the trademark that will be intentionally used for goods or services connected with the defendant's business in the future.

It is not admitted that filing of the disputed trademark was made for "any trademark to be used in connection with goods or services pertaining to the defendant's business of an applicant", and thus was registered contrary to main paragraph of Section 3 (1) of the Trademark Act".

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith (Lack of intention to use ✓)	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【JPO-11】 Chromax v. Chromax



1. Title	Chromax v. Chromax	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2011(Gyo-ke)10194	
5. Date of the judgment	2012/1/19	
6. Parties : Plaintiff Defendant	Aiemu Kabushiki Kaisha Xiuwei Co., Ltd.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	C h r o m a x	
8. Outline of the case		
It is considered that the application for registration of the disputed trademark was, without a just cause, filed by the plaintiff (importer) without the approval of the defendant (exporter in Taiwan).		
9. Summary of the judgment		
<p>Because the designated goods “golf balls”, etc., of the disputed trademark are included in the designated goods of the defendant’s trademark registered in Taiwan, such duplication is likely to cause confusion and mislead as to the respective origins of goods bearing the disputed trademark and of goods bearing the trademark of the defendant.</p> <p>Because a relationship of trust based on actual deeds had developed between the plaintiff and the defendant through their regular business dealing, the plaintiff clearly played the role of an agent selling the goods of the defendant in Japan. Therefore, the status of the plaintiff falls into the category of “agent or representative” as defined in Article 53-2 of the Trademark Act.</p> <p>In support of just cause as defined in the Trademark Act, the plaintiff only states that the value of the disputed trademark in Japan was increased by the plaintiff’s advertising, and the substantial expenditure thereby entailed, with a view to increasing the value of the disputed trademark. However, while it is a fact that the plaintiff did advertise in Japan the golf balls manufactured by the defendant, there is no evidence that the value of the trademark associated with the golf balls was increased by such advertising and the expenditure entailed therein or by the scale of them.</p> <p>On the basis of the above, it is concluded that the application for registration of the disputed trademark was, without a just cause, filed without the approval of the person who has the right pertaining to the trademark. Thus, the claim of the plaintiff is dismissed.</p>		
* Article 53-2 Where a registered trademark is a trademark pertaining to a right to a trademark (limited to a		



right equivalent to a trademark right) held by a person in a country party to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or a trademark similar thereto, and the designated goods or designated services thereof are goods or services pertaining to those right or goods or services similar thereto, and further, the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by their agent or representative or by their former agent or representative within one year prior to the filing date of the trademark registration, the person who has the right pertaining to the trademark may file a request for a trial for rescission of the trademark registration.

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-12】 のらや v. のらや



1. Title	のらや v. のらや (Noraya)	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2015(Gyo-Ke)10022, 10023	
5. Date of the judgment	2015/8/03	
6. Parties : Plaintiff Defendant	Kabushiki Kaisha NORAYA Y	
7. Mark	Plaintiff (former registered trademarks)	Defendant (disputed trademarks)
	のらや	のらや
		
8. Outline of the case		
<p>On the very day when the plaintiff's trademark rights, who is the franchiser, expired due to his negligence, the defendant, who is the franchisee, filed applications to register the plaintiff's former registered trademarks without notice to the plaintiff, and the trademarks were registered. Therefore, the plaintiff filed requests for a trial for rescission of the applications to register the defendant's trademarks, on the grounds that defendant's trademarks are likely to negatively affect public policy. As the requests were unsuccessful, the plaintiff began litigations requesting revocation of the trial decisions. These requests were granted.</p>		
9. Summary of the judgment		
<p>At the time of filing the applications in question, the plaintiff and the defendant were, respectively, franchisor and franchisee in a franchise contract relating to a restaurant by the name of “のやら” (Noraya). The contract imposed on the defendant an obligation under the fair and equitable principle to recognize the plaintiff's right in respect of its trademarks, and not to prevent the plaintiff from possessing and managing the right.</p> <p>The plaintiff had previously owned trademark rights of a trademark consisting of the letters “のらや” and another consisting of the figure of a cat, but these became extinct through expiration, the plaintiff being unaware of the need for renewal of a trademark right. On the day of extinction, the defendant, without prior notice to the plaintiff, unilaterally filed applications to register the trademarks and acquired the trademark rights. Such actions were contrary to the fair and equitable principle because they could have seriously damaged the plaintiff's business. The defendant alleges that the purpose of the applications was to prevent a third party from obtaining the trademark rights; however, if that had been the case, the defendant would only</p>		

have had to tell the plaintiff of the need to apply for renewal, yet the defendant did not do so. Furthermore, the defendant concealed the filing of the trademark applications from the plaintiff.

In addition, the defendant had a monthly obligation to pay for the foodstuffs provided by the plaintiff as well as to pay royalties. In this regard, the defendant, having been in ongoing negotiations with the plaintiff concerning the performance of the contract since immediately prior to the filing of the applications, used the applications as a means to gain a negotiating advantage.

Taking all of the above circumstances into account, it can be amply deemed that the defendant's purpose in submitting the applications was not to prevent a third party from registering the plaintiff's trademarks, but to profit unfairly by using the applications, or the fact that the trademarks would be registered by means of it, to gain a monetary advantage in negotiations with the plaintiff.

Therefore, in light of the purpose and circumstances of the applications in question, the trademarks fall under the category of "a trademark which is likely to negatively affect public policy" as set forth in item 7, paragraph 1, Article 4, of the Trademark Act. Consequently, the trial decisions should be revoked as being untenable.

* Article 4(1) Notwithstanding the preceding Article, no trademark may be registered if the trademark:
(vii) is likely to negatively affect public policy.

Examination guidelines for Trademarks (relating to Article 4(1)(vii))

1. Trademarks that are "likely to cause damage to public order or morality" are, for example, the trademarks that fall under the cases prescribed in (1) to (5) below.

((1) to (4) are not applicable in this case)

(5) Trademarks whose registration is contrary to the order predetermined under the Trademark Act and is utterly unacceptable for lack of social reasonableness in the background to the filing of an application for trademark registration.

10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-13】 Tarzan (ターザン) v. Tarzan



1. Title	Tarzan (ターザン) v. Tarzan	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2011(Gyo-ke)10400	
5. Date of the judgment	2012/6/27	
6. Parties : Plaintiff Defendant	Edgar Rice Burroughs Inc. Kabushiki Kaisha Starseiki	
7. Mark	Plaintiff	Defendant (disputed trademark)
	<p>T a r z a n</p> <p>(ターザン)</p>	<p>T a r z a n</p>
8. Outline of the case		
<p>The plaintiff requested a trial for invalidation of the registration of the defendant's trademark on the grounds that the trademark is likely to negatively affect public policy. The trial decision being not to invalidate the registration, the plaintiff filed suit against decision of trial for invalidation. The request was granted.</p>		
9. Summary of the judgment		
<p>The disputed trademark, "Tarzan", is the name of the hero of the Tarzan series of novels by the late American writer Edgar Rice Burroughs. The designated goods of the trademark are plastic processing machines and apparatus and others.</p> <p>The trial decision is correct in that even though contemporary Japanese consumers associate the word "Tarzan" with a heroic jungle adventurer, there is no evidence that the word was widely known as the title of certain works by Edgar Rice Burroughs, or as the name of the principal character in those works, or as constituting any of the marks managed by the appellant (plaintiff) at the time the examiner decided to register the trademark.</p> <p>The defendant was inspired to use the word "Tarzan" by a movement executed by an industrial robot manufactured by the defendant for the removal of molded resin products, and registered the disputed trademark with the intention of using the name "Tarzan" as the product name of the robot. However, we cannot think that such action of the defendant is taking a free ride on the image of "Tarzan" character and its power to attract customers.</p> <p>Although not widely known in Japan, through novels and other works of fiction, the name "Tarzan", which is a unique coined word, is consistently recognized overseas, mainly in the United States, as the name of a fictional character evoking a particular impression. Thus, because no other impressions are evoked by the word "Tarzan", and even though the word lacks the power to attract customers to the designated goods, maintaining registration in Japan of the trademark consisting solely of the word "Tarzan" will be contrary to the international faith.</p>		

At the time of the examiner’s decision to register the defendant’s trademark (July 6, 2010), the novels of Edgar Rice Burrows and their derivative works were still in copyright in Japan. The plaintiff acquired the rights to the Tarzan series from the estate of Edgar Rice Burroughs and has endeavored to maintain the value of the original Tarzan novel and its derivative works; for example, the plaintiff has promoted the various Tarzan works, featuring them on the plaintiff’s website, and has established an online archive containing the novels and other works of Edgar Rice Burroughs, including the Tarzan series. The plaintiff has also endeavored to maintain and manage the commercial value of the name “Tarzan” by registering trademarks globally and by licensing the use of those trademarks.

Where an original novel, for which a mark and a character having an enduring value appears, is in copyright, and where there exists an organization, such as the plaintiff, that has strived to maintain and manage the cultural and economic value of the mark and character, it is unreasonable in terms of fair business practice that a third party, in being the first to file an application to register the trademark for specific designated goods or services, may exclude the plaintiff, as a copyright managing corporation, from using its own trademarks, since the third party would be able to maintain its trademark right virtually indefinitely by renewal of the trademark registration.

Because the defendant has demonstrated no concern about maintaining the cultural and commercial value of the word “Tarzan”, it is not reasonable to approve the defendant’s exclusive use of the word “Tarzan” even though the disputed trademark would be used only for the defendant’s designated goods; therefore registration of the disputed trademark may be considered an unfair business practice and thus negatively affects public policy.

Taking all of the above points into account, it is concluded that the disputed trademark falls into the category of a trademark likely to negatively affect public policy.

* Article 4(1)Notwithstanding the preceding Article, no trademark may be registered if the trademark:
(vii) is likely to negatively affect public policy.

Examination Guidelines for Trademarks (relating to Article 4(1)(vii))

Article 4(1) (vii) (Contravention of public order or morality)

(vii) A trademark being likely to cause damage to public order or morality;

According to the Examination Guidelines for Trademarks, a trademark being likely to cause damage to public order or morality shall include those which are not unethical etc. in composition per se but which fall into the category as listed below.

- Trademarks which are liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for the designated goods or designated services.
- Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith.

10. Tags





② Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	

Interference by a competing company	
Lack of intention to use	
Others	

【JPO-14】

v.



1. Title	 v. 	
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2009(Gyo-ke)10274	
5. Date of the judgment	2010/1/13	
6. Parties : Plaintiff Defendant	Yugen Kaisha Uprise Product Commissioner of the Japan Patent Office	
7. Mark	Plaintiff (disputed trademark)	Defendant (cited trademark)
		
8. Outline of the case		
This case involves an opposition filed against the disputed trademark on the grounds of likelihood of confusion in connection with the goods or services pertaining to a business of another person. The plaintiff (Acid Black Cherry) appealed to the Intellectual Property High Court and, as a result, the trademark registration was maintained.		
9. Summary of the judgment		
<p>It is confirmed that the owner of the disputed trademark is the management company of the band “Acid Black Cherry”.</p> <p>The cited trademark, however, belongs to the prominent rock band the Rolling Stones, which has been active for over 40 years since their 1963 debut album release. The cited trademark first appeared on the jacket of the 1971 record album “Sticky Fingers”; and later appeared in connection with various digital music platforms and on CDs, as well as on concert advertisements and posters in Japan. Therefore, by the time the trademark application was filed, the cited trademark had been already widely recognized among music suppliers and consumers as the Rolling Stones’ trademark in connection with related goods and services. The cited trademark was still an issue at the time of trademark registration as well.</p> <p>Also, it has to be taken into account that the cited trademark is innovative figure and demonstrates a high degree of originality.</p> <p>However, both the disputed and cited trademarks differ not only in sound and concept but especially in</p>		

appearance. That is, the front side of the disputed trademark is a plane figure, with three black images drawn on the tongue, whereas the cited trademark is a plane figure which looks like a solid positioned slightly diagonally, with no images drawn on the tongue. Furthermore, the cited trademark is well known among music suppliers and consumers, and thus the difference between marks becomes more obvious for the music suppliers and consumers.

Moreover, due to a wide variety of choices in the music industry, it is common for consumers to check associated information carefully before purchasing CDs, attending concerts, etc. Since suppliers who related to the music industry are usually knowledgeable about music, it is highly doubtful that they would confuse the designated goods and services of the disputed trademark with those of the Rolling Stones' trademark.

Taking such considerations into account, the use of the disputed trademark, at the time of application filing and the registration process, did not cause confusion in connection with the goods and services pertaining to a business of the Rolling Stones, the person who has close business relationship with the Rolling Stones or belongs to its affiliated companies.

It follows from the above that the disputed trademark does not fall into the category which is likely to cause confusion in connection with the goods and services pertaining to a business of another person.

* Article 4(1) Notwithstanding the preceding Article, no trademark may be registered if the trademark:
 (xv) is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) through (xiv) inclusive);

10. Tags

① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【JPO-15】



1. Title		
2. Country	Japan	
3. Court	Intellectual Property High Court	
4. Case No.	2017(Gyo-ke)10080	
5. Date of the judgment	2017/12/25	
6. Parties : Plaintiff Defendant	Red Bull Aktiengesellschaft Bruson Co., Ltd.	
7. Mark	Plaintiff (cited trademark = trademark in Use 2 (above), trademark in Use 1(below))	Defendant (disputed trademark)
8. Outline of the case		
<p>In the trial for invalidation, it was decided that the disputed trademark does not fall into the category which is likely to cause confusion in connection with the goods or services pertaining to a business of another person, and so the plaintiff filed suit against decision of trial for invalidation. The request was granted.</p>		
9. Summary of the judgment		
<p>Company Red Bull (which is the inclusive name of Red Bull GmbH (headquarters), Red Bull Japan (the subsidiary in Japan) and those affiliated companies) uses the trademark in use 1 (herein after called ‘trademark 1’) etc. both on the surface of canned energy drink ‘Red Bull’ and for its advertisement; the design of the surface has not changed from the start of its sales until now. When looking at the overall structural outline, the basic composition of the defendant’s trademark and the cited trademark is almost similar and partially identical, so both trademarks are confusingly similar in their appearance. Also, they share almost identical concept, therefore, it can be confirmed that both trademarks share relatively high similarities.</p> <p>At the time of filing the application to register the defendant’s trademark, the number of sales of ‘Red Bull’ amounted to 176 million cans within the previous 8 years, occupying approximately 60% of the market share in Japan. Products identified by the trademark 1 can be found in various media, sports, and events, etc. and is used for products of many companies under the License Agreement with Company Red Bull relating to the trademark 1. The advertising expenditure totaled 7,960 million yen in 2013 alone.</p> <p>Company Red Bull became an F1 race sponsor for the first time in 1995, and the company’s racing team also won the F1 Suzuka Grand Prix. Both the trademark 1 and 2(=cited trademark) can be seen on the racing cars and</p>		

the drivers' sportswears, etc as well as on products for sale relating to race of car and motorcycle.

It follows from the above that at the time of filing the application to register the defendant's trademark, the trademark 1 was already widely recognized among the suppliers and consumers in Japan as an item associated with Company Red Bull products; such recognition has not changed up to today.

Furthermore, the cited trademark (= trademark in use 2) not only constitutes of the trademark 1 as an element thereof but also is an independently used mark very often, therefore it can be confirmed that the cited trademark is also widely recognized among suppliers and consumers not only of products of Red Bull energy drinks but also of products related to the automobile industry, both during the filing of the application to register the defendant's trademark and the registration process. Such status of the cited trademark has not changed.

The cited trademark is used for products related to automobiles and car races, whereas the designated goods of the defendant's trademark are related to the automobile supplies. Therefore, the designated goods of the defendant's trademark are related to the products which are well known for the cited trademark.

Since main consumers of the products bearing the defendant's trademark do not always check the trademark carefully when making a purchase, they may not notice small differences between the cited trademark (= trademark 2) and the defendant's trademark.

Taking such considerations into account, suppliers and consumers are likely to confuse the products of the defendant's trademark with those of Company Red Bull or any other affiliated company.

It follows from the above that the defendant's trademark falls into the category which is likely to cause confusion in connection with the goods or services pertaining to a business of another person. Therefore, the trial decision was incorrect.

* Article 4(1)Notwithstanding the preceding Article, no trademark may be registered if the trademark:
(xv)is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) through (xiv) inclusive);

10. Tags

①Type of trial	Suit against decision of trial for invalidation
②Decision	Invalidation
③Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

Case Examples of KIPO

【KIPO-1】 ALPINESTARS v. ALPENSTER



1. Title	ALPINESTARS v. ALPENSTER	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2012 (Heo) 2364	
5. Date of the judgment	2012/6/8	
6. Parties : Plaintiff Defendant	Alpinestars Research SRL Kolon Industries, Inc	
7. Mark	Plaintiff	Defendant (disputed trademark)
	ALPINESTARS	ALPENSTER
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant's recognizing the existence of the Plaintiff trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>The plaintiff has manufactured boots for motocross (A cross-country motorcycle race) and road racing since it was established as hiking and skiing boots manufacturer at the end of 1962 in Italy. The plaintiff has manufactured all kinds of technical protective gear for motorcycling including gloves, jacket and leather suit since 1990. Since then the plaintiff has diversified into action sports clothing and casual clothing. B) The plaintiff named the trademark 'ALPINESTARS', flower translated 'Stella Alpina'(A star of Alps) in alpine region near the manufacturer into English, and has put the trademark on the product as prior use trademark.</p> <p>Determination of 'unjust purpose' should be judged by taking into account whether the goods of certain person is well known to, famous and creative, how similar or identical are the certain person's trademark and registered one, whether the negotiation is done or what's contained between applicant and certain person, other relationship between two parties, whether the applicant prepared detailed project plan, identity or similarity of the product and closer economic relation and business status under Article 7(1)(xii) of Trademark Act.(See 2010 Hu 807 decision sentenced on July 15 in 2010 by Supreme Court)</p> <p>Given that whether the prior use trademark on 'motorcycle boots and action sports clothing' were notably recognized in Italy on June 16 in 2008, the application date of the registered trademark, beyond recognition that consumers indicate them as goods of certain person, the registered trademark is similar to prior use trademark, whether 'motorcycle athlete's boots, sports shoes, clothing only for sports, socks and necktie, class of goods of the registered trademark are identical or similar to 'motorcycle boots and action sports clothing', goods with prior use trademark, and whether there is closer economic relation between them and the defendant was aware of the existence of prior use product as large scale action sports clothing manufacturer, it is judged that defendant intended to make unfair profit based on high quality image and attraction to customers of prior use trademark by copying prior use trademark, well known trademark, and filed an application and registered the trademark</p>		

aiming at damaging the plaintiff, user of the prior use trademark..

10. Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-2】 なかっただコトに！ v. なかっただ コトに



1. Title	なかっただコトに！ v. なかっただ コトに (Naghata gotoni)	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2015 (Heo) 185	
5. Date of the judgment	2015/9/4	
6. Parties : Plaintiff Defendant	Graphico Inc (Joint owner of the trademark) Cardland Inc Chungmook Kim	
7. Mark	Plaintiff	Defendant (disputed trademark)
	なかっただコトに！	なかっただ コトに
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant recognising the existence of the Plaintiff's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>TV Shopping laboratory, Japanese legal entity, decided to launch soybean protein based diet dietary supplement and named the product as 'Naghata gotoni', which refers to 'forget everything that happened' to emphasize the feature of the product so called 'No matter how much you eat, you don't gain weight'. The laboratory filed an application of trademark registration for the prior use trademark 'Naghata gotoni', on June 5 in 2002 in Japan and registered the trademark on February 28 in 2003. And the entity has advertised and merchandised the supplement with prior use trademark through many home shopping channels across the nation since 2003.)</p> <p>Grapico, plaintiff, has developed and distributed products through pharmacy and general store since the Grapico was established on November 7 in 1996, Grapico has merchandised products with prior use through offline store and online store such as 「bibal mall.com」, 「www.jplug.com」 of Matsumotokiyoshi, pharmacy chain store, while promoting the products through various broadcasting media since it was received right of non-exclusive use of prior use trademark from TV Shopping laboratory on September 1 in 2008. Plaintiff signed an exclusive sales contract on the products with prior use trademark with Korean companies, Card land corporation and H&D corporation, on December 17 in 2013. Whether the applicant filed an application based on 'unjust purpose' should be judged by considering following situations. It is judged that the applicant filed and registered trademark to make unjust profit based on high quality image of prior use trademark and attraction to customers by copying prior use trademark and to damage plaintiff by diluting the value of the mark above. As shown above, the prior use trademark was well known to customers, as if they recognized 'Grapico', certain company, as the leading manufacturer of diet dietary supplement when the registered trademark was filed in Japan. It was not common for Korean company to file an application with only Japanese language trademark and the registered trademark, 'Naghata gotoni', which refers to 'forget everything that happened' was too similar to the</p>		





prior use trademark despite the trademark's creativity.

10. Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	


【KIPO-3】



1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2013 (Heo)174	
5. Date of the judgment	2013/7/11	
6. Parties : Plaintiff Defendant	Guangzhou Nandadi Textile Garment Co., Ltd RCRV, Inc	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant claimed invalidation trial of registration to Intellectual Property Tribunal against plaintiff, holder of trademark right (Case 2011 Dang No.1555). It is judged that the registered trademark was identical or similar to the prior use trademark 1, 2, which were recognized as indicating the defendant's product in U.S and Germany at the time of filing the application and the plaintiff filed and registered trademark to make unjust profit or damage defendant. Defendant claimed that the registration shall be invalidated under the Article 71(1)(i), 7(1)(xii) of the Trademark Act. The Intellectual Property Tribunal decided that the registration of registered trademark is invalid by accepting request for trial above as the registered trademark conforms Article 7(1) (xii) in connection with prior use trademark 1 and 2 on November 6 in 2012. Facts recognized with one consent, plaintiff's Exhibit No.1, 2, defendant's Exhibit No.2 or 24, intent of whole pleading. Plaintiff claimed that the registered trademark is irrelevant to prior use trademark, there is no unjust purpose on it and it is the changed one of the trademark which plaintiff has used before the application (hereafter called 'relevant trademark') According to 1 of defendant's exhibit No.6 or each record of No.18, it is acknowledged that plaintiff determined a mark as clothing as class of goods, filed applications from November 14 in 2006 to June 4 in 2008 in China, Korea, Benelux, Japan and the U.K and plaintiff manufactured jean with relevant trademark. Therefore, the registered trademark seems to be a changed one of relevant trademark as its mark is too similar to relevant one. However, plaintiff filed initial application (November 14 in 2006) after the plaintiff manufactured and distributed jeans with prior use trademark, the relevant trademark was similar to the prior use trademark as well as the registered trademark. The facts above demonstrates that plaintiff has unjust purpose as plaintiff's relevant trademark which has been used by plaintiff since November of 2006, is similar to the registered trademark despite of many circumstances above. The plaintiff's claim above has no grounds.</p>		

10. Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-4】  v. DR.PHARM 

1. Title	 v. <u>DR.PHARM</u>	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2015 (Heo) 6343	
5. Date of the judgment	2016/5/13	
6. Parties : Plaintiff Defendant	Hongchul Kim Wonsuk Choi	
7. Mark	Plaintiff 	Defendant (disputed trademark) 
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant recognising the existence of the Plaintiff's trademark, was using for "unfair intention".		
9. Summary of the judgment		
The plaintiff sold oriental medicine product at store called 'Noble Pharm' in 2002 and established ToPha Korea Inc on January 17 in 2007(since then the store name was changed into 'Dr. Pharm' on July 24 in 2009 and it was changed into 'Dr. Pharm. Inc Pharmaceuticals Inc' on March 31 in 2010, hereafter called Dr. Pharm Inc). The plaintiff has manufactured cosmetics such as BB cream, pore cleansing pack, iced snow skin toner with prior use trademark, which plaintiff and the company acquired, since the Dr. Pharm Inc was established. And has sold them on the internet shopping mall and exported through Noble Pharm or Dr. Pharm Inc. Defendant sold sunglasses at the store called 'Sampoong International' in duty free shop in October of 2005, merchandised cosmetics in duty free shop in March of 2009 and has established and run 'Sampoong International' which specializes in research, manufacturing, wholesale and retail and distribution since October 19 in 2011. Plaintiff or Dr. Pharm Inc provided cosmetics such BB cream with prior use trademark with defendant from March of 2009 to September of 2010 and allowed the defendant to sell them at defendant's own duty free shop. It is acknowledged that the registered trademark was identical or similar to prior use trademark, which was recognized as indicating product of plaintiff, Dr. Pharm Inc among customers home and abroad when the application is filed and defendant filed and registered the trademark based on unjust purpose to make unfair profit by go along with prior use trademark's credit, the registered trademark falls under Article 7(1) (xii) of the trademark Act.		
10. Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	

② Decision	Cancellation
③ Type of bad faith (Free Ride ✓)	
Free Ride	✓
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-5】 HUM v. Hum

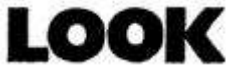




1. Title	HUM v. Hum	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2016 (Heo) 1628	
5. Date of the judgment	2016/7/22	
6. Parties : Plaintiff Defendant	Jongsik Kim YK038 Co.,Ltd	
7. Mark	Plaintiff (disputed trademark)	Defendant
	HUM	Hum
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant has run textile, clothing and fashion business since it was established on September 24 in 1997 and the defendant has manufactured and merchandised coat, jumper, jacket, pants, skirts and shirt since clothing brand 'Hum' was launched on January 20 in 2003. Defendant has promoted the brand 'Hum' by naming top celebrities for advertisement from November 29 of 2002 to the date of the registered trademark application. The news that TV star Boolam,Choi worked as advertisement model at Hum launch show on November 29 in 2002 was reported on December 10 in 2002 in daily newspaper Munhwaillo and on December 16 in 2002 in International Textile News(ITN), news that TV star Eungyung Im worked as advertisement model exclusively for Hum was reported on June 16 in 2003 in ITN, news that TV star Donggeun Lee, who became popular after starring in the TV drama called 'lovers in Paris', worked as advertisement model exclusively for Hum was reported on July 25 in 2004 in sports news, news that TV star Ahra Go worked as a model exclusively for Hum was reported on Feb 17 in 2006 in Fashionbiz, on Feb 20 in 2006 in chosun.com and on Aug 7 in 2006 in ITN. Advertisement photos that TV star Donggeun Lee in Hum clothes were released in Hum catalogue in 2004, Advertisement photos that TV star Ahra Go in Hum clothes were released in Hum catalogue in 2006. The news that the brand 'Hum' supported drama 'Yurihwa' and intended to increase awareness of the brand by exposing its store and clothes were reported on November 15 in 2004 in Fashionbiz and on December 13 in 2004 in ITN. The prior use trademark is recognized as indicating the defendant's product, the clothing, by domestic consumers on December 4 in 2008, the date of the registered trademark application, it is acknowledged that the registered trademark 'HUM' was identical or similar to prior use trademark 'Hum'. It is judged that the applicant, Myungohk, Ahn filed and registered trademark to make unfair profit based on high quality image of prior use trademark and attraction to customers by copying prior use trademark and to damage defendant, the user of the prior use trademark, according to 1 of defendant's Exhibit No.3 or 8 and intent of whole pleading.</p>		

10. Tags	
① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-6】 LOOK v. LOOK



1. Title	LOOK v. LOOK	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 2276	
5. Date of the judgment	2014/9/25	
6. Parties : Plaintiff Defendant	LOOK CYCLE INTERNATIONAL, societe anonyme Junglan Lee	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant recognising the existence of the Plaintiff's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Plaintiff manufactured ski equipment in 1951 in Nevers, France. Since then plaintiff has manufactured clipless pedal for bicycle by imitating skibinding since 1984 and carbon frame for bicycle since 1986. The company has manufactured bicycle and bicycle parts since the ski equipment manufacturing business was separated in 1994. Plaintiff has manufactured frame or pedal for bicycle with prior use trademark 1 and prior use trademark 2, in 1987 and 1991 respectively. News that FCU (France Cycling Union) signed exclusive use contract on clipless pedal with LOOK Cycle International, societe anonyme (hereafter called LOOK), the company (LOOK) signed various licensing contract based on source technology on safe pedal, exports 700,000 pedals, which accounts for 60% in domestic market, was (plaintiff's Exhibit No.11) reported on March 8 in 1992 in Le MONDE, French daily newspaper. News that the frame created by LOOK/ will be connected to a fork, with the same material of it, /and French champions who will participate in Barcelona Olympic Games, will have bicycles equipped with the frame(plaintiff's Exhibit No.12), was reported on June 10 in 1992. The newspaper on July 8 in 1997 said that 'the revolution was broken out in 1984' entitled 'automated pedal'. LOOK and Bernard Hinault invented automated pedal, after Cinelli, Italian company, tried to invent it. And all professional players and some amateurs (road bicycle and mountain bike players) use this mechanic system to release their feet when falling off (plaintiff's Exhibit No.13).' The fact above demonstrates that the prior use trademarks were well known to customers for parts of bicycles in France, recognized as indicating the product of the certain person at the time when of filing of the application for the registered trademark, the registered trademarks were too similar to the prior use trademarks and class of goods of the registered trademarks, bicycle related items including bicycle,</p>		



frame for bicycle and rim for bicycle, are all identical and the defendant was already aware of the existence of the prior use trademark as the defendant has merchandised and repaired bicycle. It is judged that defendant filed and registered trademark to make unfair profit based on business reputation of prior use trademark by copying the prior use trademark, well known to customers in France, and to damage plaintiff by diluting the trademark and interrupting plaintiff's business based on unfair purpose.

10. Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-7】



1. Title	~~~~ v. ~~~~	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014(Heo) 6209	
5. Date of the judgment	2015/1/9	
6. Parties : Plaintiff	Vans, Inc	
Defendant	Youngmi Kim	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant recognising the existence of the Plaintiff s trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Plaintiff has manufactured shoes, bags, wallet, belt, clothing, socks and hats with prior use trademark in U.S and Canada since 1971(plaintiff’s Exhibit No.9 and 20)) The catalog, published by plaintiff in the fall of 2008, contains a variety of cases of shoes with VANS(trademark) and prior use trademark, as shown in the picture(plaintiff’s Exhibit No.40). The catalog, published by plaintiff in spring of 2009, contains a variety of cases of shoes with VANS(trademark) and prior use trademark, as shown in the picture (plaintiff’s Exhibit No.41). Articles from Korea media reported on prior use trademark and product with prior use trademark before the date of the application for registered trademark are as follows. Skateboarding shoes, which are mounted on skate board, were first manufactured by VANS in 1966. OLD SKOOL, world’s first product, was manufactured by the company. The value of the skateboarding shoes has increased as shoes of VANS were distributed through ABC Mart, large shoes distributor, 4 years ago in Korea. VANS has been topped of 40 selling brands in ABC Mart (plaintiff’s Exhibit No.53, Yonhap News reported on October 31 in 2005)). e registered trademark is very similar to prior use trademark, the prior use trademark was recognized as plaintiff’s leading brand in Korea and had creativity with unique shape. And class of goods of the registered trademark contains footwear with prior use trademark. It is acknowledged that the registered trademark is a counterfeiting trademark of prior use trademark, recognized as indicating product of plaintiff and it was filed to damage plaintiff and make unjust profit by interrupting the conduct of business.</p>		
10. Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	
② Decision	Cancellation	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-8】 ROLEX v. POLEX 



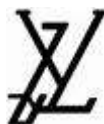

1. Title	ROLEX v. <i>POLEX</i>	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 7776	
5. Date of the judgment	2015/5/8	
6. Parties : Plaintiff Defendant	ROLEX SA EDAMIC Co.,Ltd.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	ROLEX	<i>POLEX</i>
	ROLEX	
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Defendant recognising the existence of the Plaintiff's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Montres Rolex SA, Plaintiff, has produced and merchandised high functioning and quality watch with prior use trademark since it was established in 1920 in Geneva, Switzerland. ⑥ The prior use trademark was voted as one of global top 100 brands by Interbrand, global brand consulting company, in 2000 to 2009, plaintiff has run official watch stores in 100 countries and merchandised watches with prior use trademark in department stores in major cities across the country. ⑦ Plaintiff made 78.1 billion 25.64 million in 2012 and 85.9 billion 48,74 million in 2013, news on the company and prior use trademark was frequently reported by Korea major media and internet site. ⑧ The prior use trademark is listed in 'frequently pirated trademark information' issued by KIPO and is frequently mentioned as an example to promote eradicating imitation of a well-known trademark ⑨ Brand awareness survey, plaintiff asked Korea Trademark & Design Association to conduct, showed that 94.2% of respondent said they have heard about watch trademark such as the prior use trademark. The registered trademark, such as, is alphabetical mark with somewhat designed last letter 'X', tilted slightly to the right, for example, the prior use trademark is general type alphabetical mark. However, 5 capital alphabets of both marks are arranged in order, first letter is 'P' and 'R' respectively, the rest letters 'OLEX' are identical. In particular, there is a stroke difference between letter 'P' and 'R'. The grounds mentioned earlier and intent of whole pleading of plaintiff's Exhibit No. 32-37 demonstrate that defendant filed trademark, similar to ' a watch brand, on May 31 in 2010, a year ago of application for the registered trademark and it had decision to reject the application. It is recognized that watch shops with prior use trademark have been in business in department stores in major cities in Korea and enjoyed high sales. It is judged that the defendant was well aware of</p>		

constitution and awareness of application at the time when of filing of the application for the registered trademark and filed an application and registered the trademark aiming at launching the similar kinds of product to one of the prior use trademark. It is judged that the registered trademark is likely to make customers confused with the resources by easily associating with prior use trademark, notably recognized as indicating the plaintiff's product, product with prior use trademark and business. Thus, the registration shall be invalidated without any dispute over plaintiff's remaining claim as the registered trademark falls under Article 7(1)(x) of the trademark Act.

10. Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



【KIPO-9】  v.  

1. Title	 v. 	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 1655	
5. Date of the judgment	2014/5/29	
6. Parties : Plaintiff	Sieun Ha	
Defendant	Louis Vuitton Malletier	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognizing the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>The grounds mentioned earlier and intent of whole pleading of defendant’s Exhibit No. 1 or 9 demonstrates that defendant (Louis Vuitton Malletier) has manufactured and merchandised bags including handbag since it was established by a designer, Louis Vuitton, in 1854. The prior use trademark of defendant was well known and famous mark worldwide for bags including handbag. It is clearly obvious that it was listed as ‘frequently pirated trademark home and abroad’ in ‘foreign trademark information’ and ‘frequently pirated trademark home and abroad’, which were issued annually by KIPO, in 1988 to 2003, at the time of filing and application for the registered trademark. The gist of a claim of class of goods of the registered trademark has no closer economic relation to product with prior use trademark. Provided, the relation is just considerable factor to judge ‘unfair purpose’ under Article 7(1) (xii). Thus, the closer economic relation is not an important factor to determine whether the claimed trademark falls under the Article above. Given awareness, greatness and creativity of prior use trademark, plaintiff’s trademark application history and that the registered trademark contains a large number of products, which have closer economic relation to product with prior use trademark, in addition to class of goods of gist of a claim products, plaintiff’s unjust purpose is fully recognized. It is judged that the registered trademark falls under Article 7(1) (xii) of the trademark Act even if class of goods of gist of a claim has no closer economic relation to product with prior use trademark. Thus, plaintiff’s claim above is not acceptable.</p>		
10. Tags		
① Type of trial	Suit for cancellation of the registration of a trademark	
② Decision	Cancellation	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-10】 LOUIS CASTEL v. LOUIS CASTEL





1. Title	LOUIS CASTEL v. LOUIS CASTEL	
2. Country	Korea	
3. Court	Patent Court	
4. Case No.	Patent Court 2014 (Heo) 1938	
5. Date of the judgment	2014/8/21	
6. Parties : Plaintiff Defendant	Deokbum Jung (Joint owner of the trademark) Younglak Choi Jaeyeop Lee	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
A case in which the court ruled that the trademark, which was filed by the Plaintiff recognising the existence of the Defendant's trademark, was using for "unfair intention".		
9. Summary of the judgment		
<p>Defendant is a CEO of VL & CO Inc, established on March 2 in 2007, approved the company to use prior use trademark at the time. VL & CO Inc has manufactured and merchandised bags, hats, belts, key holder, necktie and socks including golf clothing with prior use trademark. VL & CO Inc has manufactured and merchandised products since the later half of 2007. The company made 6,288,818,576 won the second half of 2007 and 2,958,985,254 won the first half of 2008, golf clothing was a major contributor to its revenue. VL & CO Inc opened high end brand store, direct management store, in Yangjae-dong, Seoul in September 2007. It opened 20 stores in Seoul, Ilsan, Daegu, Busan, Gangneung, Donghae(East sea), Pohang and Jeju island by the end of 2007, most of which were more than 100 m² and located in major business districts.</p> <p>*Determination on whether the applicant of the registered trademark has unfair purpose</p> <p>The facts recognized above and fact recognized based on defendant's Exhibit No. 1, No.67 and 68 are as follows. Prior use trademark was well known to customers home and abroad indicating it as certain person's product as golf clothing at the time of filing the application for the registered trademark. Prior use trademark 1, 'LOUIS' in French (LOUIS gold coin, its denomination is 20 franc) and 'CASTEL' (castle) are combined, which is an inventive combination. It has relatively high creativity, the registered trademark has same combination as the prior use trademark. Sunglasses, sports goggles and golf clothing with prior use trademark, the class of goods, were manufactured and merchandised by a single manufacturer at the time of filing the application for the registered trademark. In other words, sunglasses, sports goggles with the registered trademark are likely to be recognized as using similar product to 'golf clothing' and can lead to misunderstanding as if they are used by holder of prior use trademark right. The fact demonstrates that the applicant, Taesoo Lee, filed and registered trademark to make unfair profit based on business reputation of prior use trademark 1 by copying the prior use</p>		

trademark 1, well known to customers, and to damage defendant by diluting the trademark and interrupting defendant's business based on unfair purpose.

10. Tags

① Type of trial	Suit for cancellation of the registration of a trademark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【KIPO-11】 MK v. MK

1. Title	MK v. MK	
2. Country	The Republic of Korea	
3. Court	The Patent Court of Korea	
4. Case No.	2017Huh2604	
5. Date of the judgment	April 13, 2018	
6. Parties : Plaintiff Defendant	Ki Joon Kim Michael Kors (Switzerland) International GmbH]	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
It was determined that the disputed trademark was filed to take unfair advantage of goodwill in the prior mark by imitating the mark which is recognized at home and abroad as a sign which identifies products of Michael Kors International GmbH.		
9. Summary of the judgment		
<p>Comprehensively considering the revenue, advertising costs in relation to defendant's trademarks, the way how they have been used, the extent to which they have been exposed via various media (e.g. newspaper), the prior mark was deemed to have been known as a sign which indicates products of a certain person in the US and Korea. The designated goods of the disputed trademarks, artificial leathers and bags under Class 18 and sneakers, dresses, suits, neckties, scarfs, belts made of leather under Class 25, are similar to or have economic relation with those of the prior mark which are bags, wallets and scarfs. Furthermore composition motive and appearance of the prior and the disputed marks are so similar that it is reasonable to determine that the disputed marks are an imitation of the prior mark. Also, looking at how those marks have been used, it is difficult to distinguish the defendant's goods from the plaintiff's. Thus, it is considered that the defendant intended to take unfair advantage of goodwill in the trademark of Michael Kors.</p> <p>In conclusion, the Patent Court of Korea ruled that the registration was invalidated by comprehensively considering evidence provided by the defendant and ruled that the disputed marks were filed to free ride on the accumulated reputation on good quality and the brand power of the prior mark which had been known as an indication of products of Michael Kors by consumers and traders at home and abroad.</p>		

10. Tags	
① Type of trial	Invalidation Trial
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



【KIPO-12】 THEZARA v. ZARA



1. Title	THEZARA v. ZARA	
2. Country	Korea	
3. Court	The Patent Court of Korea	
4. Case No.	2017huh2109	
5. Date of the judgment	Sep 21, 2017.	
6. Parties : Plaintiff Defendant	Industria de Diseño Textil, S.A. (Inditex, S.A.) Byung Kwan Choi	
7. Mark	Plaintiff	Defendant (disputed trademark)
	ZARA	THEZARA
8. Outline of the case		
<p>The registration of the disputed trademark was invalidated as it was determined to be filed to take unfair advantage of goodwill in the prior mark by imitating the mark which had been recognized at home and abroad as a sign that indicates products of a certain person.</p>		
9. Summary of the judgment		
<p>Since the distinctive nature of “THE”, a definite article, included in the disputed trademark is very weak, “ZARA” in the mark serves as the principal part of the trademark, which makes the sound and concept of the plaintiff’s mark and the disputed mark identical.</p> <p>The designated goods of the both marks were also determined to be similar based on the following facts: (1) the defendant put the space between “THE” and “ZARA” in the trademark when using it for the signboard of a hotel and an advertisement website, (e.g. “THE ZARA”), (2) the plaintiff expanded his business to produce bedding and household products for hotels and motels in 2003, and (3) opened shops branded as “ZARA HOME” in Korea in 2008, in particular, bedding products marked with “THE ZARA” were found in certain hotels in operation. Since the defendant’s main consumers which are hotel and motel users are overlapped with plaintiff’s consumers who buy clothes, if the disputed mark is used for the signboard of accommodation facilities, and bedding and household products, general consumers are likely to be confused as to the source of services. All in all, the disputed mark is determined to be filed to take unfair advantage of goodwill in the prior mark.</p>		
10. Tags		
① Type of trial	Invalidation Trial	
② Decision	Invalidation	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

【KIPO-13】 Mango Monster v. Monster Energy

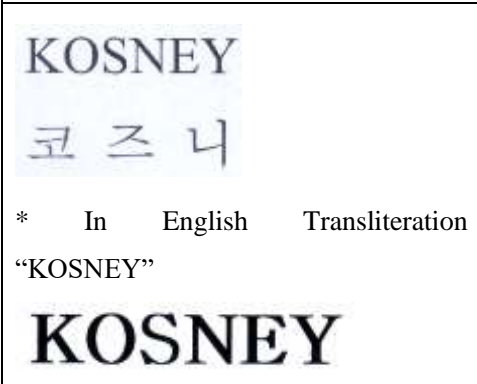

1. Title	Mango Monster v. Monster Energy	
2. Country	Korea	
3. Court	The Supreme Court	
4. Case No.	2016Hu2447	
5. Date of the judgment	Mar 15, 2017	
6. Parties : Plaintiff Defendant	Monster Energy Company Jung Hoon Lee	
7. Mark	Plaintiff	Defendant (disputed trademark)
		 * In English Transliteration “Mango Monster”
8. Outline of the case		
<p>The plaintiff argued that the disputed trademark is so similar to the prior mark that it can cause confusion as to the source of the goods, thereby deceiving consumers. And the plaintiff went on to say that the defendant filed the trademark to take unfair advantage. However the Patent Court of Korea and the Supreme Court ruled that there is no likelihood of confusion since the two marks were not similar.</p>		
9. Summary of the judgment		
<p>Both the disputed trademark and the prior service mark have 몬스터 (monster in Korean transliteration) or monster in common. But there existed multiple marks in relation to similar services such as ‘ICEMONSTER’, ‘티켓몬스터(Ticket Monster in Korean Transliteration)’, ‘클럽몬스터(Club Monster in Korean Transliteration)’, ‘CLUB MONSTER’, ‘MONSTER PIZZA’, ‘monster zym’, ‘bubble monster’ which have been either registered or published as a filed trademark. Thus, considering specific trading circumstances in relation to those multiple trademarks including monster or 몬스터 (monster in Korea transliteration), the distinctive nature of “monster” included in the mark is considered weak and it is inappropriate to grant an exclusive right to use it to a certain person. Thus, “몬스터” and “monster” cannot be considered a principal part of the mark which has distinctive nature.</p> <p>On the other hand, “MANGO” included in the registered service mark indicates ingredients of beverages or ice creams and “ENERGY” included in the service mark also indicates function of the designated goods, which are considered to be non-distinctive or whose distinctive nature is considered to be weak. Thus, looking at the words subject to judgment, the distinctive nature of the composite words is so insignificant that the two marks need to be compared with each other as a whole.</p> <p>The two marks are different based of the following facts: (1) one in Korean words and the other in English</p>		

words, (2) the number of letters composed of the trademarks, and (3) the font style. Also, the sound and concept of the registered service mark of “mango monster” are different from those of the disputed mark “monster energy”. Hence, the registered mark and disputed mark are different in appearance, sound and concept.

10. Tags	
① Type of trial	Invalidation Trial
② Decision	Dismissed
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

【KIPO-14】 Kosney v. KOSNEY



1. Title	Kosney v. KOSNEY	
2. Country	The Republic of Korea	
3. Court	The Patent Court of Korea	
4. Case No.	2010Huh2902	
5. Date of the judgment	Oct 20, 2010.	
6. Parties : Plaintiff Defendant	Prime International Sang Young Jeon	
7. Mark	Plaintiff	Defendant (disputed trademark)
	 <p>* In English Transliteration "KOSNEY"</p>	
8. Outline of the case		
<p>The plaintiff's prior service mark is widely known by consumers and traders in Korea as a service mark of a certain person and the designated goods of the disputed marks are similar or have economic relations with those of the prior service mark so that the disputed mark is likely to cause confusion as to the source of the services.</p>		
9. Summary of the judgment		
<p>The plaintiff's prior service mark had been used in shops which offer diverse living products from interior items such as bedding products, beads cushions, curtains and fabric items to living items such as bathroom products, clothing, shoes, accessories, stationary, dolls, music albums, sunglasses and hats. The disputed trademark's designated goods "clothing, shoes, hats and accessories" are the same as the products that are offered in the shop where the prior service mark is being used. As such, the disputed service mark is used in the same place targeting the same consumer range of the prior service mark. On top of that, considering the commonplace of the total fashion trend where a company promotes a brand and use it for a range of products including clothing, shoes, hats and accessories and display them at the brand's shop, if the disputed mark is used for the same kind of similar products to which the prior service mark is applied, consumers can be confused as to the source of the goods.</p>		
10. Tags		
① Type of trial	Invalidation Trial	
② Decision	Invalidation	
③ Type of bad faith		
Free Ride	✓	

Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

【KIPO-15】 GENTLE MONSTER v. GENTLE MONSTER

1. Title	GENTLE MONSTER v. GENTLE MONSTER	
2. Country	The Republic of Korea	
3. Court	The Intellectual Property Trial and Appeal Board	
4. Case No.	2016Dang1189	
5. Date of the judgment	Mar 3, 2017	
6. Parties : Plaintiff Defendant	I.I.Combined Keun A Sohn	
7. Mark	Plaintiff	Defendant (disputed trademark)
	GENTLE MONSTER	GENTLE MONSTER
8. Outline of the case		
<p>While the plaintiff argued that the disputed trademark was likely to cause confusion as to the source of the goods, thereby deceiving consumers and was filed to take unfair advantage, the IPTAB(The Intellectual Property Trial and Appeal Board) determined that the dispute trademark was not an imitation of the plaintiff's trademark since the plaintiff's trademark had not been widely known as a sign which indicate the goods of a certain person, the disputed trademark's designated goods were different from those of the plaintiff's and there existed multiple composition trademarks in which "Monster" and "Gentle" are combined.</p>		
9. Summary of the judgment		
<p>As the designated goods of the disputed and prior trademarks are "furniture and picture frames" and "sunglasses and glasses" respectively, the producers and traders in relation to these trademarks are those who engage in the furniture and optical businesses respectively. Thus, the shops and consumers of those products are different from each other. Thus, there is no economic relation between them. On the other hands, the meanings of the words "gentle" and "monster" are contradictory but considering the fact that there exist multiple registered trademarks composed of "monster" and "gentle", it is hard to see that the disputed trademark imitated the prior mark. Accordingly, it is determined that the disputed trademark does not cause confusion or deception as to the source of the goods among traders and consumers and was not filed to take unfair advantage of goodwill in the prior trademark.</p>		
10. Tags		
① Type of trial	Invalidation Trial	
② Decision	Validation	
③ Type of bad faith		
Free Ride	✓	
Imitation by agents or people who have a prior relationship		

Interference by a competing company	
Lack of intention to use	
Others	✓

Case Examples of USPTO

【USPTO-1】 NATIONSTAR MORTGAGE v. NationStar



1. Title	NATIONSTAR MORTGAGE v. NationStar	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91184456	
5. Date of the judgment	2014/9/30 [citation: Nationstar Mortg. LLC v. Ahmad, 112 USPQ2d 1361 (TTAB 2014)]	
6. Parties : Plaintiff Defendant	Nationstar Mortgage LLC Mujahid Ahmad	
7. Mark	Plaintiff	Defendant (disputed trademark)
	NATIONSTAR MORTGAGE	NationStar
8. Outline of the case		
<p>Opposition filed by Nationstar Mortgage (Opposer) against application for the mark NATIONSTAR for various real estate brokerage services filed by Mujahid Ahmad (Applicant) on the grounds of fraud, likelihood of confusion, and lack of bona fide intent to use.</p>		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) held that Applicant’s averments as to his use of NATIONSTAR for the services identified were fraudulent. The application contained a statement that “The applicant, or the applicant’s related company or licensee, is using the mark in commerce...” and was signed by the Applicant as Owner. Applicant provided specimens with a signed declaration under 37. C.F.R. Section 2.20 in response to an Office action. During the course of the opposition, the Applicant amended the application to an intent to use application.</p> <p>Opposer filed the opposition based on fraud, alleging that the Applicant did not use the mark for any of the identified services prior to filing the application, submitted a fabricated specimen, and knowingly made false statements as to use of mark with intent to deceive the USPTO.</p> <p>During the proceeding, the Board found that the Applicant’s testimony was characterized by contradictions and inconsistencies. For example, Applicant testified he is owner, president and sole person who runs NationStar Mortgage, Inc., yet did not know if the company had earned any income or had any revenue. Applicant admitted that NationStar Mortgage, Inc. did not have a bank account and had never rendered any payments. Applicant tried to dodge answering simple questions as to whether company had not done any business and had</p>		




filed any tax returns. Applicant did not answer the straightforward question whether he knew of or had placed a telephone directly listing under the name NATIONSTAR, and was unable or unwilling to identify who created business cards, postcards and flyers. The Board noted that oral testimony “should not be characterized by contradictions, inconsistencies and indefinitely but should carry with it conviction of its accuracy and applicability.” B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 583, 66 USPQ 232, 236 (CCPA 1945). The record established that Applicant could not lawfully hold himself out as a mortgage broker, insurance broker or real estate broker because he was not properly licensed at the time he filed the application.

The Board found that the applicant was not using the mark NATIONSTAR in commerce in connection with any of the services identified – the record at best establishes that Applicant may have rendered real estate agency services under the mark NATIONSTAR prior to the filing date; however, real estate agency services were not listed on the application. The law does not require “smoking gun” evidence of deceptive intent but instead has long recognized that direct evidence of deceptive intent is rarely available and deceptive intent may be inferred from the surrounding facts and circumstances. The surrounding facts and circumstances provide clear and convincing evidence that Applicant did not have a good faith reasonable basis for believing that he was using the NATIONSTAR mark in commerce for all the services identified in the application. Because the opposition was sustained on the grounds of fraud, the Board did not reach the additional grounds of likelihood of confusion and lack of bona fide intent to use the mark in commerce.

10. Tags

① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【USPTO-2】  v.  

1. Title	 v. 	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition Nos. 91171146 and 91171147	
5. Date of the judgment	2010/4/23 [citation: Taiwan Semiconductor Mfg. Co. v. Semiconductor Mfg. Int'l (Shanghai) Corp., 2010 TTAB LEXIS 117, 2010 WL 1791171 (TTAB Apr. 23, 2010)]	
6. Parties : Plaintiff Defendant	Taiwan Semiconductor Manufacturing Co., Ltd. Semiconductor Manufacturing International (Shanghai) Corporation	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
Opposition filed by Taiwan Semiconductor Manufacturing (Opposer) against the application for SMIC and Design for semiconductors and integrated circuits and other related goods filed by Semiconductor Manufacturing International (Shanghai) Corporation (Applicant) on the basis of a likelihood of confusion with the registered mark TSMC and Design for semiconductors and integrated circuits.		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) sustained the opposition on the grounds of likelihood of confusion. The Board considered a number of factors, including the similarities in the marks and goods and services and evidence of bad faith. With regard to evidence of bad faith, the Board found that Applicant's history with the opposer should be considered to determine Applicant's intentions. Applicant arrived on the scene thirteen years after opposer was founded, and within two years, a foreign court had issued an injunction prohibiting Applicant from soliciting or hiring certain classes of Opposer's employees. Opposer then filed four law suits against Applicant between December 2003 and August 2004, including multiple claims of patent infringement, unfair competition, trade secrets misappropriation, and interference with business relationships. As part of a settlement, Applicant agreed to pay opposer 175 million dollars and promised to cease and abstain from making statements that would suggest to third parties that SMIC's processes use or are derived from TSMC information.</p> <p>Based on this and other evidence, the Board found that Applicant had been complicit in multiple attempts to misappropriate and infringe Opposer's intellectual property rights. Moreover, Applicant's logo over the years had moved closer to Opposer's long established design logo. The Board found that Applicant's action, taken as</p>		

a whole, demonstrates a history of blatant disregard for Opposer's intellectual property rights. This factor, balanced with the similarities in the marks and the identical nature of the goods or services, led to a finding of likelihood of confusion.

10. Tags	
① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

【USPTO-3】 CHIRO-KLENZ v. SUPER CHIRO TEA



1. Title	CHIRO-KLENZ v. SUPER CHIRO TEA	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91193427	
5. Date of the judgment	2012/3/30 [citation: Edom Labs. Inc. v. Lichter, 102 USPQ2d 1546 (TTAB 2012)]	
6. Parties : Plaintiff Defendant	Edom laboratories, Inc. Glenn Lichter	
7. Mark	Plaintiff	Defendant (disputed trademark)
	CHIRO-KLENZ	SUPER CHIRO TEA
8. Outline of the case		
Opposition filed by Edom Laboratories against the application SUPER CHIRO TEA for herbal teas for medicinal purposes on the grounds of likelihood of confusion with the registered mark CHIRO-KLENZ for herbal teas for medicinal purposes filed by Glenn Lichter, alleging bad faith.		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) held that Applicant’s mark SUPER CHIRO TEA is likely to cause confusion with Opposer’s mark CHIRO-KLENZ, finding that Applicant acted in bad faith in adopting its mark. In assessing a likelihood of confusion, the Board considered a number of factors, including the similarity of the marks and the goods, as well as extensive evidence of bad faith. In addition to copying Opposer’s trade dress, evidence was introduced that the packaging of Applicant’s SUPER CHIRO TEA tea included a tag line: “FROM THE ORIGINAL MAKERS OF CHIRO-KLENZ”. Moreover, Applicant owns domain name www.chirolenzforless.com, re-directs visitors to his www.superchirotea.com website, and uses testimonials from CHIRO-KLENZ on his website to promote SUPER CHIRO TEA. Evidence was further introduced that Applicant substituted delivery of SUPER CHIRO TEA for an order of CHIRO-KLENZ. In addition, Applicant’s SUPER CHIRO TEA product comparison page has in small print: “Not affiliated with Edom Laboratories, Inc., the owner of the TM CHIRO-KLENZ”, but also says “from the Original Formulators of CHIRO-KLENZ Tea.” Applicant also had a pattern of bad faith actions leading up to this opposition, including having filed a petition to cancel Opposer’s CHIRO-KLENZ registration.</p> <p>The Board held that SUPER CHIRO TEA is similar in sight, sound, meaning and commercial impression to Opposer’s mark CHIRO-KLENZ, and that the goods are legally identical and available to the same classes of consumers through similar trade channels. The Board determined that Applicant has been trading off the goodwill in Opposer’s mark to Opposer’s detriment, and that “bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator’s expectation of confusion.”</p>		

10. Tags	
① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-4】 AUDITORIO TELMEX v. TELMEX



1. Title	AUDITORIO TELMEX v. TELMEX	
2. Country	United States	
3. Court	Court of Appeals for the Federal Circuit	
4. Case No.	No. 2010-1558	
5. Date of the judgment	2012/7/11[citation: Estrada v. Telefonos De Mexico, S.A.B. de C.V., 447 F. App'x 197 (Fed. Cir. 2011)]	
6. Parties : Plaintiff	Telefonos de Mexico	
Defendant	Andres Estrada	
7. Mark	Plaintiff	Defendant (disputed trademark)
	AUDITORIO TELMEX	TELMEX
8. Outline of the case		
<p>Opposition filed by Telefonos de Mexico (Opposer) against Andres Estrada (Applicant) on the grounds that the mark AUDITORIO TELMEX for arena and entertainment services are likely to be confused with the common law mark TELMEX for telecommunication services. Opposition was sustained and appealed to the Court of Appeals for the Federal Circuit.</p>		
9. Summary of the judgment		
<p>The Court of Appeals for the Federal Circuit (Court) upheld the decision of the Trademark Trial and Appeal Board (Board), concluding that substantial evidence supported the Board's finding of Applicant's bad faith, which supported a likelihood of confusion. These facts included that Opposer began using the mark TELMEX in the United States for telecommunication and telephone calling card services prior to the filing date of both opposed applications. Although Opposer's mark was in use in the United States, Opposer had no significant market share and no proof of reputation or fame in the United States. Nevertheless, Opposer is a major telecommunication company based in Mexico, and began offering it services in Mexico in 1947. Opposer has used its TELMEX mark throughout all of Mexico, on billboards, on pay phones, in printed media, etc. Opposer also provides telecommunication services to several countries in Central and South America and sponsors a large arena under the AUDITORIO TELMEX mark in Guadalajara, Mexico. For 30 years, Applicant had lived in Mexico and resided 10 miles away from the arena. Although Applicant lived near the arena for three decades, he denied any prior knowledge of Opposer's mark. Applicant further claimed that he had made up the mark. Applicant continued to be evasive in his discovery responses, alleging that he had never used a phone booth, pay phone or public phone, and thus did not have any exposure to the TELMEX mark. Based on this evidence, the Board found that the circumstances lead to "inescapable conclusion" that Applicant filed in bad faith.</p> <p>Although Applicant on appeal challenged the Board's findings on other likelihood of confusion factors such as the strength of the TELMEX mark, the similarity of the marks, and the similarity of the services, the Court</p>		

upheld the Board’s decision, concluding that substantial evidence supported the Board’s findings of likelihood of confusion based on these factors, along with Applicant’s bad faith.

10. Tags

① Type of trial	Appeal of Opposition Decision
② Decision	Opposition decision upheld (application denied)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-5】 UVF861 v. UVF861



1. Title	UVF861 v. UVF861	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Cancellation No. 92057088	
5. Date of the judgment	2015/6/29[Citation: UVeritech, Inc. v. Amax Lighting, Inc., 115 USPQ2d 1242 (TTAB 2015)]	
6. Parties : Plaintiff Defendant	Uveritech, Inc. Amax Lighting, Inc.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	UVF861	UVF861
8. Outline of the case		
<p>This case involves a cancellation proceeding between a U.S. seller (Petitioner) and its foreign manufacturer (Respondent) over ownership of the mark UVF861 for light bulbs and fixtures. Petitioner argued that the goods were manufactured to its order, and therefore it owned the mark. Respondent argued that as manufacturer it owned the mark because Petitioner was a mere distributor.</p>		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) found that the Petitioner was the rightful owner of the mark. Although this proceeding was brought on the ground of likelihood of confusion, the actual issue in this case was ownership of the mark. Although usually there is a presumption that the manufacturer is the owner of a disputed mark, this may be rebutted. In this case, since there was a neglect of formalities in defining the business relationship, the Board looked at the following relevant factors:</p> <ol style="list-style-type: none"> (1) which party created and first affixed the mark to the product; (2) which party's name appeared with the trademark on packaging and promotional materials; (3) which party maintained the quality and uniformity of the product, including technical changes; (4) which party does the consuming public believe stands behind the product, e.g., to whom customers direct complaints and turn to for correction of defective products; (5) which party paid for advertising; and (6) what a party represents to others about the source or origin of the product. <p>The Board found that testimony and evidence in the case established that the Petitioner designed the bulbs and conceived the mark UVF861. In addition, the Petitioner contracted, although not in a written document, with Respondent to manufacture the bulbs under the mark according to Petitioner's specification to be compatible with Petitioner's equipment. Moreover, it was Petitioner's decision to market bulbs under UVF861 and</p>		

Petitioner controlled technical changes to bulbs. At one point, due to quality concerns, Petitioner transferred production to another manufacturer, yet Respondent never alleged infringement. When quality problems arose, customers approached Petitioner not Respondent. The literature distributed with the Petitioner's bulbs had the Petitioner listed as the manufacturer. There was no evidence introduced regarding advertising of the product, so this factor was neutral. As a result, the Board found that the Petitioner was the owner of the mark.

10. Tags

① Type of trial	Petition for cancellation of trademark registration
② Decision	Cancelled
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-6】Benny Goodman Collection THE FINEST QUALITY v. BENNY GOODMAN



1. Title	Benny Goodman Collection THE FINEST QUALITY v. BENNY GOODMAN	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Application Serial No. 77600412	
5. Date of the judgment	2012/7/11 [citation: In re Jackson Int'l Trading Co., 103 USPQ2d 1417 (TTAB 2012)]	
6. Parties : Plaintiff Defendant	Jackson International Trading Co. Kurt D. Bruhl GmbH & Co. KG	
7. Mark	Plaintiff (disputed trademark)	Defendant
8. Outline of the case		
<p>An application for the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrances, cosmetics, leather, and clothing filed by Jackson International Trading Co. was refused by the Examining Attorney (Examiner) under Section 2(a) of the Trademark Act for falsely suggesting a connection with the musician Benny Goodman. Appealed to the Trademark Trial and Appeal Board (Board).</p>		
9. Summary of the judgment		
<p>The Board upheld the Examiner and found that Benny Goodman has fame or renown such that the use of that name as a trademark by an unauthorized user will falsely suggest a connection with the musician Benny Goodman.</p> <p>Under Section 2(a), the Examiner needed to prove:</p> <ol style="list-style-type: none"> (1) the mark sought is the same as or a close approximation of the name or identity previously used by another person or institution; (2) the mark would be recognized as such because it points uniquely and unmistakably to that person or institution; (3) the person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and (4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services. <p>The applicant did not contest that the mark is a close approximation of the late bandleader Benny Goodman. The Board held that the public would perceive the mark as pointing unmistakably to the late bandleader, for</p>		

several reasons. The record showed that the Estate of Benny Goodman continues to protect its IP rights today. For example, the bennygoodman.com website provides that “CGM Worldwide is the exclusive representative for the Estate of Benny Goodman...The words and the signature “Benny Goodman” are trademarks owned and protected by the Estate of Benny Goodman...Any use of the above, without the express written consent of the Estate, is strictly prohibited.” Moreover, a search for “Benny Goodman” on the Internet produced excerpts from sources such as the Britannica Concise Encyclopedia, Music Encyclopedia, U.S. History Companion, Columbia Encyclopedia, The Fine Arts Dictionary, and Filmography showing that Benny Goodman was a famous jazz clarinetist, composer and bandleader, and that he is known as “The King of Swing,” “The Professor,” “Patriarch of the Clarinet,” and “Swing’s Senior Statesman.” The record also included excerpts from the last.fm, Amazon.com, and Borders.com websites, showing that sales of Benny Goodman recordings continue to this day. These facts also showed that the late bandleader remains famous.

The Board noted that it is commonplace for performers and owners of well-known marks to expand their product lines to incorporate a diverse set of goods, and that licensing of commercial trademarks for use on collateral products such as clothing, linens, etc. which are unrelated to those goods on which the marks are normally used has become common practice. The Board concluded that, in the context of applicant’s fragrances, cosmetics, leather goods and clothing, consumers would view the mark as pointing only to Benny Goodman, the bandleader, composer and clarinetist.

10. Tags

① Type of trial	Appeal of examiner's decision of refusal
② Decision	Refusal upheld (application denied)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-7】 FLANAX v. FLANAX



1. Title	FLANAX v. FLANAX	
2. Country	United States	
3. Court	Court of Appeals for the Fourth Circuit	
4. Case No.	No. 15-1335	
5. Date of the opinion	2016/3/23[citation: Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697 (4th Cir. 2016)]	
6. Parties :		
Original Plaintiff	Bayer Consumer Care AG	
Original Defendant	Belmora LLC	
7. Mark	Plaintiff	Defendant (disputed trademark)
	FLANAX	FLANAX
8. Outline of the case		
<p>This case involves the question of whether the Lanham Act permits the owner of a foreign mark well-known among U.S. consumers, but not registered or used in the United States, to seek cancellation of the registration for a mark used to misrepresent the source of goods as those produced by the foreign trademark owner, to pursue a false-association claim based on the domestic trademark owner’s passing off of its products as those of the foreign mark owner, and to pursue related false-advertising claims.</p>		
9. Summary of opinion		
<p>Bayer owns a Mexican registration and uses the mark FLANAX for pain relievers in Mexico. Bayer asserts that its FLANAX mark is also known to U.S. consumers, although Bayer does not sell its FLANAX product in the United States. After Bayer’s FLANAX mark became known to U.S. consumers, Belmora registered and began using the FLANAX mark in the United States, also for pain relievers. Belmora’s advertising and packaging included language that suggested that Belmora’s FLANAX product came from Bayer.</p> <p>Bayer first filed a Trademark Trial and Appeal Board (TTAB or Board) action seeking cancellation of Belmora’s FLANAX registration for misrepresentation of source under Section 14(3). The TTAB granted Bayer’s petition for cancellation and ordered Belmora’s FLANAX registration cancelled. The TTAB decision was reviewed in the United States District Court for the Eastern District of Virginia after Belmora sought review in the Court of Appeals for the Federal Circuit and Bayer elected to proceed in district court. At the district court, Bayer added claims under Section 43(a) for false designation of origin and false advertising.</p> <p>The district court found that use of a mark in the United States was required to bring a claim under Section 43(a) or to petition to cancel a mark for misrepresentation of source under Section 14(3). Thus, it dismissed Bayer’s unfair competition and false advertising claims under section 43(a) of the Lanham Act because Bayer did not</p>		

allege prior use of its own FLANAX mark in the United States. The district court also held that the Board erred in not dismissing Bayer’s misrepresentation of source ground under Section 14(3) because Bayer did not allege prior use of its own FLANAX mark in the United States.

The Court of Appeals for the Fourth Circuit reversed. The Fourth Circuit found that Bayer has a cognizable false-association claim by following the plain, broad statutory language found in the Lanham Act. Additionally, the Fourth Circuit clarified past precedent that seemingly imposed a requirement not present in the statutory language of Section 43(a) that a plaintiff must plead rights in a trademark in order to have a cognizable false-association/unfair competition claim. It held: “In sum, the Lanham Act’s plain language contains no unstated requirement that a Section 43(a) plaintiff have used a U.S. trademark in U.S. commerce to bring a Lanham Act unfair competition claim. The Supreme Court’s guidance in Lexmark does not allude to one, and our prior cases either only assumed or articulated as dicta that such a requirement existed. Thus, the district court erred in imposing such a condition precedent upon Bayer’s claims.”

10. Tags	
① Type of trial	Appeal of cancellation of the registration of a trademark
② Decision	Pending, remanded for consideration by district court
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-8】 IWATCH v. SWATCH



1. Title	IWATCH v. SWATCH	
2. Country	United States	
3. Court	U.S. Court of Appeals for the Federal Circuit	
4. Case No.	No. 2014-1219	
5. Date of the judgment	June 4 2015[citation: M.Z. Berger & Co., Inc. v. Swatch AG, 787 F.3d 1368 (Fed. Cir. 2015)]	
6. Parties :		
Applicant (Appellant)	M.Z. Berger & Co.	
Opposer (Appellee)	Swatch AG	
7. Mark	Applicant (Appellant) (disputed trademark)	Opposer (Appellee)
	IWATCH	SWATCH
8. Outline of the case		
Swatch opposed the application for the mark IWATCH on grounds of likelihood of confusion with SWATCH for watches and a lack of bona fide intent to use. The opposition was sustained on a lack of bona fide intent to use, but no likelihood of confusion was found. Case appealed to the Court of Appeals for the Federal Circuit.		
9. Summary of the judgment		
<p>The Court of Appeals for the Federal Circuit (Court) upheld the decision of the Trademark Trial and Appeal Board (Board), finding a lack of bona fide intent to use but no likelihood of confusion. In its determination, the Court considered a number of facts showing a lack of genuine intent to use the mark. Although the applicant applied for watches, clocks, and other items, the testimony of record showed that Applicant never intended for the mark to be used on any goods other than watches. With respect to watches, the applicant lacked a genuine plan to commercialize the iWatch on watches because the documents produced related solely to the prosecution of the application for registration. In fact, the only documents produced were (i) a trademark search (a couple of days prior to filing), (ii) internal email concerning the application, and (iii) internal emails forwarding images of watches and a clock bearing the iWatch mark (in response to USPTO request for additional information). In addition, the employees told inconsistent stories about the company’s intent to commercialize the mark on watches. Although the company has a long history in the watch business, Applicant’s inaction with the potential iWatch product diminished the value of the evidence of a long history in the business. Rather, the testimony from Berger indicated that intent was to merely reserve the mark: “if we decided to do a – either a technology watch or information watch or something that would have that type of characteristics that would be a good mark for it.”</p> <p>The Court noted that “bona fide” should be read as a fair, objective determination of intent, consistent with the</p>		

definition of “use in commerce” (a bona fide use of a mark in the ordinary course of trade, and not merely to reserve a right). The intent requirement requires not only subjective good faith, but also objective evidence of intent: although the bar is not high, circumstances must indicate that the intent was firm. The Court agreed with the Board that even though the mark was intended to be used with a “smart” watch, Applicant Berger did not have a bona fide to use the mark in commerce, evidenced by the facts that it had never made such a watch, took no steps following the application to develop such a watch; and that there was no nexus between Berger’s general capacity to produce watches and the capacity required to produce a “smart” watch.

10. Tags

① Type of trial	Appeal of opposition decision
② Decision	Opposition decision upheld (application denied)
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【USPTO-9】 L'OREAL v. L'OREAL PARIS



1. Title	L'OREAL v. L'OREAL PARIS	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91184456	
5. Date of the judgment	2012/3/20 [citation: L'Oreal S.A. v. Marcon, 102 USPQ2d 1434 (TTAB 2012)]	
6. Parties : Plaintiff Defendant	L'Oreal Paris and L'Oreal USA, Inc. Robert Victor Marcon	
7. Mark	Plaintiff	Defendant (disputed trademark)
	L'OREAL	L'OREAL PARIS
	L'OREAL PARIS	
8. Outline of the case		
<p>Robert Victor Marcon (Applicant) filed for the mark L'OREAL PARIS for aloe vera drinks.</p> <p>L'Oreal S.A. and L'Oreal USA, Inc. (together Opposer) opposed the application on the basis of likelihood of confusion with and dilution of its registered L'OREAL and L'OREAL PARIS marks for cosmetics, and a lack of intent to use in commerce.</p>		
9. Summary of the judgment		
<p>The Trademark Trial and Appeal Board (Board) sustained the opposition on the grounds of likelihood of confusion and lack of bona fide intent to use the mark in commerce, and decided it therefore was unnecessary to decide the issue of dilution. With respect to likelihood of confusion, Opposer introduced significant evidence showing fame of its mark in connection with cosmetics. The Board also considered evidence of bad faith as part of its likelihood of confusion analysis. The Board found that Applicant has a pattern of filing intent-to-use applications to register various well-known marks, and that it is highly unlikely that adoption of marks was an unintended coincidence. The Board found that bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion.</p> <p>With regard to lack of bona fide intent to use, Applicant's lack of documentary evidence or any other objective evidence that he can/will use the mark, lack of capacity or experience needed to manufacture or otherwise offer the identified goods, vague allusions to use the mark through licensing or outsourcing, and failure to take any concrete actions or to develop any concrete plans for use, combined with his pattern of filing intent to use applications for disparate goods under the well-known marks of others, demonstrates that Applicant lacks the requisite bona fide intent to use his mark in commerce for aloe vera drinks. As a result, the Board sustained the opposition on likelihood of confusion and lack of bona fide intent to use.</p>		

10. Tags	
① Type of trial	Opposition to the registration
② Decision	Opposition sustained (application denied)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

【USPTO-10】 MISTER SOFTEE(a registered sound mark) v. a sound mark



1. Title	MISTER SOFTEE(a registered sound mark) v. a sound mark	
2. Country	United States	
3. Court	United States District Court for the Eastern District of New York	
4. Case No.	No. 1:15-cv-04770-SJ-SMG	
5. Date of the judgment	2016/6/27[citation: Mister Softee, Inc. v. Konstantakakos, No. 1:15-cv-04770-SJ-SMG (E.D.N.Y. June 27, 2016) (unpublished order), objections overruled via unpublished order (Aug. 11, 2016)]	
6. Parties : Plaintiff Defendant	Mister Softee, Inc. and Mister Softee of Queens, Inc. Dimitrios Konstantakakos and 3 DDD Ice Inc.	
7. Mark	Plaintiff	Defendant
	MISTER SOFTEE (a registered sound mark)	

8. Outline of the case

Plaintiffs Mister Softee, Inc. and Mister Softee of Queens, Inc. (together Plaintiffs) brought this action in the United States District Court for the Eastern District of New York (Court) under the Lanham Act for trademark infringement, false designation of origin, and trademark dilution, and common law unfair competition and unfair trade practice. Plaintiffs allege that defendant Dimitrios Konstantakakos owns 3 DDD Ice Inc. (together Defendants), which operates an ice cream truck that infringes on plaintiffs' trademark by playing Mister Softee's jingle, a registered trademark. Plaintiffs seek an award of injunctive relief and attorney's fees.

9. Summary of the judgment

Since Defendants failed to appear or otherwise defend the court action, the Plaintiffs moved for entry of a default judgment. The Court awarded a default judgment. As noted in the record, Mister Softee owns multiple registered trademarks, including "Mister Softee" and the Mister Softee musical jingle ("Sonic Mark") that are used in connection with mobile ice cream truck businesses that sell ice cream, frozen desserts, novelties, and other products, and only authorized licensees are permitted to use Mister Softee's trademarks. Plaintiffs claimed that the Mister Softee marks have been extensively promoted and are associated in the public mind with plaintiffs' products, and that the Sonic Mark in particular is famous and widely recognized as designating plaintiffs' products.

The Court found that bad faith has been established by Plaintiffs' unchallenged allegations in the complaint that Defendants "willfully intended to trade on Mister Softee's reputation," and may also be inferred from Defendants' intentional copying of Plaintiffs' Sonic Mark. The inference of bad faith is further supported by Defendants' knowledge of an almost identical trademark infringement suit against the former owner of the

infringing truck. These elements of bad faith, balanced with the similarities in the marks and the goods and services, led the Court to conclude that Plaintiffs have sufficiently alleged the elements of trademark infringement and false designation of origin pursuant to the Lanham Act. An injunction was awarded.

Moreover, under the Lanham Act, the court in exceptional cases may award reasonable attorney fees to the prevailing party. 15 U.S.C. §1117(a). Exceptional circumstances include willful infringement, and thus, a finding of willfulness determines the right to attorneys' fees. When a defendant has defaulted, then by virtue of its default it is deemed to be a willful infringer. Because defendants have defaulted, they were deemed to be willful infringers, and this case is as a result "exceptional" for the purpose of determining plaintiffs' entitlement to attorney's fees.

10. Tags

① Type of trial	Suit for infringement of a trademark
② Decision	Injunction and attorney's fees awarded
③ Type of bad faith (Free Ride ✓)	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-11】 QUIRK and QUIRK WORKS TO SAVE YOU MONEY v. QUIRK and QUIRK AUTO PARK

1. Title	Daniel J. Quirk, Inc. v. Village Car Co., 120 USPQ2d 1146, 1151 (TTAB 2016)	
2. Country	United States	
3. Court/Agency	Trademark Trial and Appeal Board (USPTO)	
4. Case No.	Cancellation No. 92057667	
5. Date of the judgment	September 27, 2016	
6. Parties : Plaintiff Defendant	Daniel J. Quirk, Inc. Village Car Co.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	QUIRK and QUIRK WORKS TO SAVE YOU MONEY	QUIRK and QUIRK AUTO PARK
8. Outline of the case		
The Trademark Trial and Appeal Board (Board) dismissed a petition for cancellation of registrations for the marks QUIRK and QUIRK AUTO PARK for “automobile dealership” because Daniel J. Quick, Inc. (Petitioner) failed to prove its claim of fraud on the USPTO.		
9. Summary of the judgment		
<p>Daniel J. Quick, Inc. (Petitioner) petitioned to cancel registrations for the marks QUIRK and QUIRK AUTO PARK for automobile dealerships owned by Village Car Company (Respondent) on the basis of fraud. Petitioner claimed that the application oaths in Respondent’s registrations for the marks were executed fraudulently because Respondent knew of and failed to disclose Petitioner’s allegedly prior superior rights in the marks QUIRK and QUIRK WORKS TO SAVE YOU MONEY for automobile dealerships. The parties agreed to Accelerated Case Resolution (ACR), where they stipulated that the Board may resolve any genuine issues of material fact and that the evidentiary record submitted with their cross-motions for summary judgment would form the trial record.</p> <p>Fraud in obtaining a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with the application with the intent to deceive the USPTO. To prove fraud, the Petitioner has to prove:</p> <p>(1) Petitioner was the user of the same or a confusingly similar mark at the time the oath was signed; (2) Petitioner had legal rights superior to Respondent’s rights at the time Respondent signed the applications for registration;</p>		

(3) Respondent knew that Petitioner’s rights in the mark were superior to Respondent’s and either believed that a likelihood of confusion would result from Respondent’s use of its mark or had no basis for believing otherwise; and that

(4) Respondent, in failing to disclose these facts to the USPTO, intended to procure a registration to which it was not entitled.

Fraud must be proven with clear and convincing evidence. An applicant who holds an honest, good faith belief in its right to register a mark and signs an application with the statutorily-prescribed ownership statement, which is phrased in terms of subjective belief, will not be found to have committed fraud. In this case, the Board found that Petitioner failed to prove that it had superior rights in the mark QUIRK, and thus Petitioner’s fraud claim failed on this basis.


The Board nevertheless went on to address the question of fraudulent intent. The Board held that even if the Petitioner had superior rights, there was no evidence of fraudulent intent. The Board found that Respondent believed that Petitioner’s rights were local and limited to southern Massachusetts and therefore had no prior right to use the mark in interstate commerce, and that even though inaccurate, Respondent’s belief did not amount to fraud. Moreover, the mere act of signing the declaration was not evidence of fraudulent intent, as asserted by Petitioner. Although Respondent, during prosecution, disclosed its knowledge of Petitioner’s marks to the USPTO, the Board rejected Petitioner’s contention that this was evidence of deceptive intent. Rather, the Board held that Respondent’s unprompted disclosure during prosecution as demonstrating the opposite of bad faith.

Finally, Petitioner claimed that deceptive intent should be inferred from Respondent’s president’s education, intellect and experience in signing important legal documents, as “he would also be able to appreciate the legal consequences – and pitfalls – of signing the oaths while withholding personal knowledge of information to the contrary.” However, the Board held that these facts were, by themselves, insufficient to give rise refused to an inference of bad faith.

10. Tags	
① Type of trial	Cancellation Proceeding
② Decision	Cancellation dismissed
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-12】 SEAL TEAM PHYSICAL TRAINING INC. v. SEAL TEAM or SEALs



1. Title	In re Seal Team PT Inc., 2016 WL 3679432 (T.T.A.B. 2016) (not precedential)	
2. Country	United States	
3. Court/Agency	Trademark Trial and Appeal Board (USPTO)	
4. Case No.	Application Serial No. 86420547	
5. Date of the judgment	June 30, 2016	
6. Party : Appellant	Seal Team PT Inc.	
7. Mark	Appellant (disputed trademark)	Defendant
		None (<i>ex parte</i> appeal)
8. Outline of the case		
The Trademark Trial and Appeal Board (Board) upheld a refusal to register SEAL TEAM PHYSICAL TRAINING INC. under Section 2(a) of the Trademark Act for falsely suggesting a connection with elite units of the United States Department of the Navy known as the SEAL TEAM or SEALs.		
9. Summary of the judgment		
<p>Seal Team PT Incorporated (Applicant) filed an application for SEAL TEAM PHYSICAL TRAINING INC. for “consulting services in the fields of fitness and exercise; physical fitness instruction.” The Examining Attorney refused the mark under Section 2(a) of the Trademark Act for falsely suggesting a connection with elite units of the United States Department of the Navy known as SEALs. Registration was also refused on likelihood of confusion with the collective membership mark SEAL for “indicating membership in an organization of applicant that develops and executes military missions involving special operations strategy, doctrine, and tactics.” Applicant appealed to the Board.</p> <p>Section 2(a) prohibits registration of a mark that that may falsely suggest a connection with persons, institutions, beliefs, or national symbols. “Institutions” include government agencies. The examining attorney must prove that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant’s goods or services, a connection with the person or institution would be presumed.</p>		

Although Applicant argued that the term “Inc.” signified that it is not a governmental entity and the term “Team” is a reference to the team-oriented nature of its training program and therefore does not point to the Navy, the Board found that the addition of matter to the name of an institution does not avoid the commercial impression that the mark is a close approximation of the institution. As to the second element, the submission by Applicant of two registrations owned by the same third party which incorporate the term “Seal Team,” was insufficient to defeat the contrary evidence of media coverage showing a unique and unmistakable association of “SEAL Team” with elite units of the U.S. Navy. The third element was not disputed.

Finally, with regard to the fourth element, the Board considered whether a connection with the U.S. Navy SEALs would be presumed when Applicant’s mark is used with physical fitness instruction. Applicant argued that since the services were commercial services for the general public, no rational person would believe they were joining the U.S. Navy SEALs or be training by active duty SEALs. However, the Board stated that was not the focus of the inquiry for that prong of the test, rather the focus was whether a connection would be presumed.


To that end, Applicant offered physical training using Navy SEAL training methods and had trained individuals seeking to qualify as Navy SEALs. Applicant’s website states that its founder is a former Navy SEAL, that Applicant offers Navy SEAL type workouts by trainers who may be former Navy SEALs, and that its members include current and former members of the military. The Board found that “[g]iven the Navy SEAL outreach and recruitment efforts as well the Navy SEAL website providing the general public with Navy SEAL workouts and the Navy SEAL Challenge website and Facebook page, the public would assume that the Navy has an interest in sponsoring, approving, or supporting activity related to physical training services such as Applicant’s to foster interest in Navy SEALs and from which it might occasionally draw a Navy SEAL candidate.” Accordingly, the public would presume a connection in that the Navy approves or endorses Applicant’s services. The Board did not reach likelihood of confusion.

10. Tags

① Type of trial	Ex parte appeal of refusal
② Decision	Refusal upheld
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-13】 SUPERMAN and SUPERWOMAN v. SUPER WOMAN OF REAEL ESTATE



1. Title	DC Comics v. Deanna Rivetti, 2017 WL 3670303 (T.T.A.B. 2017) (not precedential)	
2. Country	United States	
3. Court/Agency	Trademark Trial and Appeal Board (USPTO)	
4. Case No.	Opposition No. 91219851	
5. Date of the judgment	August 17, 2017	
6. Parties : Plaintiff Defendant	DC Comics Deanna Rivetti	
7. Mark	Plaintiff	Defendant (disputed trademark)
	 SUPERMAN and SUPERWOMAN	SUPER WOMAN OF REAL ESTATE
8. Outline of the case		
The Trademark Trial and Appeal Board (Board) sustained an opposition filed by D.C. Comics to register SUPER WOMAN OF REAL ESTATE for real estate procurement for others, holding that the opposed mark would likely dilute D.C. Comics’ famous SUPERMAN, SUPERWOMAN, and Superman’s blue bodysuit marks with the letter “S” inside a five-sided shield on the chest and a red cape.		
9. Summary of the judgment		
Deanna Rivetti (Applicant) filed an application to register the mark SUPER WOMAN OF REAL ESTATE for “real estate procurement for others,” disclaiming REAL ESTATE. D.C. Comics (Opposer) filed an opposition based upon likelihood of confusion and dilution by blurring based on its marks SUPERMAN, SUPERWOMAN and Superman’s blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape for a variety of goods and services, including entertainment, advertising and promotional services and action figures. To prove dilution a plaintiff must establish: (1) [the plaintiff] owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff’s famous mark; (3) the defendant’s use of its mark began after the plaintiff’s mark became famous; and (4) the defendant’s use of its mark is likely to cause dilution by blurring or by tarnishment. The Applicant conceded that Opposer’s marks were famous and that Applicant commenced use of its mark after the marks became famous. The second element was met because Applicant based her application on use in commerce.		

Regarding the final prong, under Section 43(c)(B)(i)-(vi) of the Trademark Act, the following non-exhaustive factors may be considered to determine whether a mark is likely to cause dilution by blurring:

- (i) The degree of similarity between the mark or trade name and the famous mark;
- (ii) The degree of inherent or acquired distinctiveness of the famous mark;
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- (iv) The degree of recognition of the famous mark;
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark; and
- (vi) Any actual association between the mark or trade name and the famous mark.

Although the Board does not usually consider trade dress in assessing likelihood of confusion with regard to word marks, in this case the Board found that “based on the manner in which Applicant used her mark, the overall similarity of the marks is immediately apparent,” and that Applicant’s mark projects a similar, if not identical, commercial impression as the Opposer’s marks. The Board also found that Opposer’s marks are inherently distinctive, there was no evidence in the record of any third-party uses of Opposer’s marks, and that Opposer’s marks have attracted widespread recognition as a source of Opposer’s goods and services.

With regard to the fifth factor, the Board found that “[c]onsidering applicant’s use of blue bodysuit with the letters ‘SW’ inside a five-sided shield on the chest and a red cape, which are extremely similar to the SUPERMAN indicia, the only possible conclusion that we can reach is that Applicant intended to create an association with Opposer’s SUPERMAN character and marks.” Finally, as to whether there had been any actual association between the marks, “[s]everal times a month since July 2011 ... clients, other agents, brokers, and prospective clients’ have ‘referred directly or indirectly to Opposer, Opposer’s Superman, Supergirl or Super Woman characters, or Opposer’s Marks in connection with Applicant’s Mark.’” Based on its assessment of all of these factors, the Board sustained the opposition on dilution by blurring and did not decide the remaining claim of likelihood of confusion.

10. Tags

① Type of trial	Opposition
② Decision	Opposition granted
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-14】 TAO v. TAO VODKA



1. Title	Tao Licensing LLC v. Bender Consulting Ltd., 125 USPQ2d 1043, 1053 (TTAB 2017)	
2. Country	United States	
3. Court/Agency	Trademark Trial and Appeal Board (USPTO)	
4. Case No.	Cancellation No. 92057132	
5. Date of the judgment	December 7, 2017	
6. Parties : Plaintiff Defendant	Tao Licensing, LLC Bender Consulting Ltd. d/b/a Asian Pacific Beverages	
7. Mark	Plaintiff	Defendant (disputed trademark)
	TAO	TAO VODKA
8. Outline of the case		
<p>The Trademark Trial and Appeal Board (Board) granted a petition to cancel TAO VODKA for alcoholic beverages excluding beer on the grounds of likelihood of confusion with TAO for restaurant and nightclub services and due to lack of use of its mark in commerce prior to the deadline for filing the statement of use.</p>		
9. Summary of the judgment		
<p>Tao Licensing, LLC (Petitioner) petitioned to cancel TAO VODKA for alcoholic beverages on the basis of lack of use of the mark in commerce prior to the deadline for filing a statement of use, likelihood of confusion with TAO for restaurant and nightclub services, lack of bona fide intent to use, and dilution.</p> <p>Under Section 45 of the Trademark Act, a trademark is in use when the goods bearing the mark are sold or transported in commerce. Prior to filing a Statement of Use on April 24, 2012, Bender Consulting Ltd. (Respondent) had imported and distributed samples of the goods but had not actually sold any goods in commerce. Even though some of the samples were sent to a potential distributor, the Board found that “the record as a whole reflects that Respondent was not yet using or even ready to use the mark in the ordinary course of trade, but was merely exploring such use at some point in the future.” The Board concluded that respondent did not use the mark TAO VODKA in commerce prior to the Statement of Use deadline (September 20, 2012).</p> <p>The Board considered a number of factors in assessing likelihood of confusion, including the similarities in the marks and relatedness of the goods and services, the fame of the TAO mark, and bad faith on the part of the Respondent. Prior to filing to register TAO VODKA, Respondent had unsuccessfully approached Petitioner to sell Petitioner Kai Vodka. The Board found bad faith based on: Respondent’s selection and adoption of TAO</p>		

VODKA for the same product as Kai Vodka after Petitioner declined to purchase Kai Vodka; Respondent’s adoption of a font very similar to that used by Petitioner; and the nature of the “business proposal” Respondent made to Petitioner to sell its registration at a high price and to supply petitioner with large volumes of vodka.. Weighing all of the factors, including the finding of bad faith, the Board concluded that confusion was likely.

In the interest of judicial economy, the Board did not reach the remaining claims of lack of bona fide intent to use the mark or dilution. The Board granted the petition to cancel TAO VODKA for alcoholic beverages on the grounds of likelihood of confusion with TAO for restaurant and nightclub services and due to lack of use of its mark in commerce prior to the deadline for filing the statement of use.

10. Tags

① Type of trial	Cancellation Proceeding
② Decision	Cancelled Registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

【USPTO-15】 BONNIE CASHIN and BONNIE CASHIN FOUNDATION v. BONNIE CASHIN



1. Title	The Trustees of the Bonnie Cashin Foundation v. Stephanie Day Lake, consolidated with Coach, Inc. v. Stephanie Day Lake, 2016 WL 6777611 (T.T.A.B. 2016) (not precedential)	
2. Country	United States	
3. Court/Agency	Trademark Trial and Appeal Board (USPTO)	
4. Case No.	Opposition Nos. 91213081 and 91213082	
5. Date of the judgment	October 12, 2016	
6. Parties : Plaintiffs Defendant	The Trustees of the Bonnie Cashin Foundation, and Coach, Inc. Stephanie Day Lake	
7. Mark	Plaintiffs	Defendant (disputed trademark)
	BONNIE CASHIN and BONNIE CASHIN FOUNDATION	BONNIE CASHIN
8. Outline of the case		
The Trademark Trial and Appeal Board (Board) upheld an opposition on the basis of lack of bona fide intent to use the mark BONNIE CASHIN for backpacks, handbags, umbrellas and clothing.		
9. Summary of the judgment		
<p>This case involved consolidated opposition proceedings filed by The Trustees of the Bonnie Cashin Foundation, Lucia Keller and David Baum (“The Foundation”) and Coach, Inc. (collectively “Opposers”) on a variety of grounds against the mark BONNIE CASHIN filed by Stephanie Lake (“Applicant”) for backpacks, handbags, umbrellas and clothing. Bonnie Cashin was the name of an American clothing designer who has since deceased.</p> <p>Opposers moved for summary judgment arguing that Applicant lacked the necessary bona fide intent to use the mark in commerce when she filed her intent to use application under Section 1(b) of the Trademark Act. (The motion for summary judgment only moved forward with the Foundation opposition since this ground was not originally pleaded in Coach’s notice of opposition).</p> <p>Summary judgment may dispose of a case when there is no genuine dispute as to any material fact, thus leaving the case to be resolved as a matter of law. In considering a summary judgment, all evidence must be viewed in a light favorable to the nonmoving party, in this case Applicant. To prove bona fide intent to use, “[a]n applicant’s bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark “in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.””</p>		

During discovery, Applicant failed to produce any documents or corroborating evidence to support an intent to use the mark and admitted that at the time she applied to register the mark she had no concrete plans to commercialize the goods. Applicant had not finalized a business strategy, decided on specific channels of trade or volume of the goods to be distributed in commerce, developed product mock-ups, conducted consumer research or commenced advertising. In fact, Applicant testified in a deposition that her first step towards launching a brand was filing for the mark. The Board granted the motion for summary judgment on lack of intent to use and the mark was refused registration.

10. Tags

① Type of trial	Opposition Proceeding
② Decision	Opposition granted
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

Case Examples of Other Countries/Regions

ARGENTINA

ALL BLACKS v. ALL BLACK'S



1. Title	ALL BLACKS v. ALL BLACK'S	
2. Country	Argentina	
3. Court	Supreme Court	
4. Case No.	N-87.XXXIV. Fallos: 324:951	
5. Date of the judgment	2001/04/03	
6. Parties: Plaintiff Defendant	New Zealand Rugby Football Union Inc. Ceballos, Aníbal Germán	
7. Mark	Plaintiff	Defendant (disputed trademark)
	ALL BLACKS	ALL BLACK'S
8. Outline of the case		
A case in which the Defendant's trademark registration is considered to be unlawful since it was a <i>slavish imitation</i> of the foreign trademark that belonged to a third party.		
9. Summary of the judgment		
<p>The Court of Appeals partially revoked the first instance decision. The Lower Court declared the Defendant's trademark registration for "ALL BLACK'S" to be null and void. The Court of Appeals considered the Plaintiff's right to request the nullity to be extinguished since the mark had been registered more than 10 years before the court action had been filed.</p> <p>However, the Court of Appeals confirmed the Lower Court's decision that rejected the renewal of such mark for "shirts, underwear, socks, footwear and sports gear, manufacturing of natural fur and imitation". Both the Lower Court and the Court of Appeals considered that the Defendant could not ignore the existence of the term "ALL BLACKS" and his registration as a trademark was a slavish imitation obtained in bad faith.</p> <p>The Supreme Court revoked the Court of Appeals decision. The Supreme Court ruled that the "ALL BLACKS" was a well-known National New Zealand rugby team. Moreover, the Supreme Court mentioned that the rugby sport was also well-known in Argentina. Such Supreme Court held that the public would be confused and the Defendant would obtain a benefit from the fame of the New Zealand's rugby team. The Supreme Court also stated that the Defendant's mark was a slavish imitation of a designation that belonged to a third party. Therefore, the Supreme</p>		

Court considered that since the registration was obtained in bad faith the corresponding nullity action could not lapse.	
10. Tags	
① Type of trial	Lawsuit for nullity
② Decision	Nullity
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

CHRISTIAN DIOR v. CHRISTIAN DIOR




1. Title	CHRISTIAN DIOR v. CHRISTIAN DIOR	
2. Country	Argentina	
3. Court	Supreme Court	
4. Case No.	C-140.XX. Fallos: 310:712	
5. Date of the judgment	1987/31/03	
6. Parties: Plaintiff	Christian Dior S.A.	
Defendant	Mampar S.A.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	CHRISTIAN DIOR	CHRISTIAN DIOR
8. Outline of the case		
A case in which the Defendant's trademark application is rejected since it was considered a <i>slavish imitation</i> of the foreign trademark that belonged to a third party.		
9. Summary of the judgment		
<p>The Court of Appeals confirmed the first instance decision. It considered the opposition filed against the Plaintiff's trademark application for CHRISTIAN DIOR in class 11 to be ungrounded. The Court also rejected the Defendant's application for CHRISTIAN DIOR in the same class opposed by the Plaintiff. Moreover, the Court of Appeals ordered the Defendant to cease use of DIOR and CHRISTIAN DIOR for "bathroomscreens".</p> <p>The Court of Appeals mentioned that the Plaintiff's mark was well-known and, therefore, the principle of specialty could not be strictly applicable. The Court of Appeals stated that the Defendant tried to confuse the public when advertising the mark in brochures for "bathroom screens". Said Court also asserted that the Defendant's application was a <i>slavish imitation</i> of the Plaintiff's mark and concluded that the Defendant acted in bad faith.</p> <p>The Supreme Court confirmed the Court of Appeals decision. The Supreme Court also ruled that it was reasonable to consider that the trademark law was applicable to situations that involved goods of different classes.</p>		
10. Tags		
① Type of trial	Lawsuit for Ungrounded Opposition / Cease of use	
② Decision	Rejection of Defendant's trademark application / Cease of use	
③ Type of bad faith		

Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

LA VACHE QUI RIT v. LA VACA QUE RIE



1. Title	LA VACHE QUI RIT v. LA VACA QUE RIE	
2. Country	Argentina	
3. Court	Supreme Court	
4. Case No.	Fallos: 253:267	
5. Date of the judgment	1962/07/23	
6. Parties: Plaintiff	Fromageries Bel Societé Anonyme	
Defendant	Ivaldi, Enrique	
7. Mark	Plaintiff	Defendant (disputed trademark)
	LA VACHE QUI RIT (& DESIGN)	
8. Outline of the case		
A case in which the Defendant's trademark registration is considered to be unlawful since it was a <i>slavish imitation</i> of the foreign trademark and could take advantage of its prestige.		
9. Summary of the judgment		
<p>On January 23, 1924 the Plaintiff registered the trademark LA VACHE QUI RIT (& design) (in Spanish LA VACA QUE RIE) in France to protect food products and, in particular, cheese. The foreign trademark featured the same design of the Defendant's Argentine registration for LA VACA QUE RIE (& design) granted in 1927 to cover only "cheese" in class 22. The Plaintiff requested it to be null and void. The Defendant argued that at the time of registration he ignored the existence of the Plaintiff and that any possible similarity between the confronted marks had been by chance.</p> <p>The Court of First Instance rejected the complaint. The Lower Court held that the prior registration of the foreign trademark by a third party would make the foreign holder lose their rights. Moreover, the Lower Court mentioned that the identity or similarity of the marks was not relevant so as to determine the rights of the parties.</p> <p>The Court of Appeals revoked the First Instance decision. The Court ruled that it would be a <i>miraculous coincidence</i> that the design of the Defendant's mark and the sequence of the words were similar to the Plaintiff's mark. Moreover, the Court stated that the Plaintiff was unknown in Argentina and that the Defendant was an important industrialist who virtually hadn't used the mark. The Court concluded that the Defendant's registration was a <i>slavish imitation</i> and declared the registration to be null and void.</p>		

The Supreme Court confirmed such decision. It held that the *slavish imitation* of a foreign trademark which could be likely to take advantage of its prestige was unlawful.

10. Tags

① Type of trial	Lawsuit for Nullity
② Decision	Nullity
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

XERODERM v. XERODERM



1. Title	XERODERM v. XERODERM	
2. Country	Argentina	
3. Court	Division II of the Federal Court of Appeals in Civil and Commercial Matters of the City of Buenos Aires	
4. Case No.	4511/1995	
5. Date of the judgment	1999/11/26	
6. Parties: Plaintiff Defendant	Laboratoires Pharmaceutiques de La Roche Posay Neodermos S.R.L.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	XERODERM	XERODERM
8. Outline of the case		
A case in which the Defendant's trademark application is considered to be unlawful since it was a <i>slavish imitation</i> of the foreign trademark that belonged to a third party.		
9. Summary of the judgment		
<p>The Plaintiff filed a complaint requesting that the opposition filed against their trademark application for XERODERM in classes 3 and 5 be declared ungrounded. The Plaintiff also claimed the nullity of the opposing trademark application for XERODERM in class 3.</p> <p>The Plaintiff's mark XERODERM had been used in several European countries for a skin product and had been registered in France and WIPO (including Germany, Austria, Benelux, Spain, Italy, Morocco, Portugal and Switzerland).</p> <p>The Court of First Instance admitted the complaint and ordered the nullity of the Defendant's trademark application for XERODERM. The lower court mentioned that the Defendant's application was a <i>slavish imitation</i> of the foreign trademark given the fact that it could not ignore its existence.</p> <p>On appeal, the Federal Court of Appeals confirmed the lower court's decision. The Court held that XERODERM was an evocative trademark since it was closely related to the name of a condition (XERODERM - XERODERMIA). Moreover, the Court pointed out that the Plaintiff did not prove that XERODERM was a well-known trademark.</p>		

However, the Court stated that the Defendant argued that it was a company with knowledge of dermatology developments. Therefore, the Court of Appeals concluded that it was reasonable to accept that the Defendant should have known of the existence of the Plaintiff -one of the most important French companies- and their foreign mark XERODERM.



10. Tags

① Type of trial	Lawsuit for ungrounded opposition and nullity
② Decision	Nullity
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

ARMENIA

BUMMY v. BUMMY



1. Title	BUMMY v. BUMMY	
2. Country	Armenia	
3. Court	Administrative Court	
4. Case No.	VD/0455/05/17	
5. Date of the judgment	2018/02/19	
6. Parties: Plaintiff	Astghik Mkrtchyan	
Defendant	Armenian Intellectual Property Agency	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case		
<p>A case in which the court upheld the <i>ex officio</i> refusal of the applicant’s trademark application as filed in bad faith, because a similar trademark was already in use by a third party outside Armenia.</p>		
9. Summary of the judgment		
<p>The Plaintiff is an individual who filed the stylized word BUMMY for personal care products in class 3. The application was refused by the trademark office <i>ex officio</i>, based on an unregistered composite trademark including the word BUMMY in an identical stylization used by the company Efpoy Tekstil ve Kimya in Turkey for identical goods. The website of Efpoy where the mark was advertised was the only evidence of use. Efpoy was not party to the proceedings. The use was discovered and cited by the examiner of the trademark office. There was no evidence that the cited mark had ever been used in Armenia or that it was well-known or famous there.</p> <p>The court dismissed the suit and upheld the refusal, finding that the trademark shall not be registered if it is liable to be confused with a trademark in use abroad, provided that the applicant was acting in bad faith when she filed the application. The action of the applicant is in bad faith if she “knew or could have known” about the existence of such a trademark. The court said that in the current case the applicant had filed a trademark “about the existence of which [she] could have known by performing a simple search of the trademark to be filed in the Google search engine”.</p>		
10. Tags		

① Type of trial	Suit against decision of the trademark office to refuse the application <i>ex officio</i>
② Decision	Maintenance of refusal
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

AUSTRALIA

CLIPSAL v CLIPSO



1. Title	Clipsal Australia Pty Ltd v Clipso Electrical Pty Ltd (No 3)	
2. Country	Australia	
3. Court	Federal Court of Australia	
4. Case No.	[2017] FCA 60	
5. Date of judgment	3 February 2017	
6. Parties: Applicant	Clipsal Australia Pty Ltd	
Respondent	Clipso Electrical Pty Ltd	
7. Mark	Applicant	Respondent (disputed trade mark)
	CLIPSAL	CLIPSO
8. Outline of the case		
A case in which the respondent's registered trade mark is determined as having been obtained dishonestly and short of acceptable commercial behaviour, and therefore should be removed from the Trade Mark Register.		
9. Summary of the judgment		
<p>The first use of the Applicant's trade mark dated back to 1920 when the Applicant's founder developed an adjustable one-size metal conduit fitting. The CLIPSAL business expanded over time and an increasing range of electrical accessories were marketed largely under the CLIPSAL mark; sales in 2011 in Australia were more than \$500 million.</p> <p>In around 2005 to 2006, the director of the Respondent set up a business importing electrical accessory products from China into Australia, under the name HEM Electrical Accessories. The business was successful. The director decided to begin manufacturing such goods himself (via manufacturers in China) under the brand ROYO but was unsuccessful in registering that trade mark; so, in May 2008 he conceived the CLIPSO brand name, giving evidence that this was formulated as the word 'clip' was used frequently in the electrical accessories market, and this was registered.</p> <p>Based on evaluation of the facts, it was determined that it was inconceivable that the director could have remained ignorant of the CLIPSAL brand as the market leader and the evidence of the source of the word 'clip' was implausible. The CLIPSO mark was registered while fully aware of the existence of the CLIPSAL trade mark, and the intention was to trade off its reputation to sell the Respondent's similar goods. This conduct was dishonest. The behaviour also falls short of</p>		

acceptable commercial behaviour as it was not commercially appropriate to sell competing products into the market under a very similar name, with the actual intention of misleading consumers into thinking that they are buying a different product.

10. Tags

① Type of trial	Application for cancellation of trade mark
② Decision	Cancellation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

MR CAR KEYS v MR AUTO KEYS





1. Title	Mr Car Keys Pty Ltd v Paul John Jones	
2. Country	Australia	
3. Court	Australia Trade Marks Office	
4. Case No.	[2018] ATMO 52	
5. Date of judgment	16 April 2018	
6. Parties: Opponent Applicant	Mr Car Keys Pty Ltd Paul John Jones	
7. Mark	Opponent	Applicant (disputed trade mark)
	MR CAR KEYS	MR AUTO KEYS
8. Outline of the case		
<p>A case in which the Applicant's trade mark application is determined as having been filed as part of conduct that falls short of proper standards as they were aware of the Opponent's trade mark, and therefore registration was refused.</p>		
9. Summary of the judgment		
<p>The Opponent is a specialised automotive locksmith operation that supplies, cuts and programs keys for almost all makes and models of automobile. It asserts it has been using the trade mark MR CAR KEYS since November 2009. The Opponent applied to register its trade mark in February 2016, 46 days after the filing date of the Applicant's disputed trade mark.</p> <p>Since about December 2015, the Applicant has marketed, advertised, offered for sale and sold encoded automotive keys and automotive locksmith services including services related to the cutting of replacement encoded automatic automotive keys in Australia, under and by reference to the Applicant's disputed trade mark.</p> <p>Between October 2015 and December 2015, the Applicant utilised the Opponent's Goods and Services, purchased goods from the Opponent and visited the Opponent's premises. In visiting the Opponent's premises and during interactions with the Opponent's staff the Applicant was likely to have been exposed to the MR CAR KEYS logo trade mark. The Applicant was also likely to have been exposed to the similar trade mark which appears on the roadside signage, and the large signage above the door of the premises. Therefore, it was found that the Applicant was aware of the Opponent's trade marks as a result of its exposure to those trade marks on invoices and by attendance at the Opponent's premises and the application was made by a person not adopting proper standards.</p>		

10. Tags	
① Type of trial	Application to oppose registration of trade mark
② Decision	Registration refused
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	



v



1. Title	Australian Drafting & Design Pty Ltd v Raj Gohil	
2. Country	Australia	
3. Court	Australia Trade Marks Office	
4. Case No.	[2018] ATMO 18	
5. Date of judgment	13 February 2018	
6. Parties: Opponent	Australian Drafting & Design Pty Ltd	
Applicant	Raj Gohil	
7. Mark	Opponent	Applicant (disputed trade mark)
	 (unregistered)	
8. Outline of the case		
A case in which the Applicant's trade mark application is determined as having been filed as part of conduct that falls short of proper standards as they were aware of the Opponent's trade mark, and therefore registration was refused.		
9. Summary of the judgment		
<p>The Opponent runs an agency that provides drafting services, recruitment services, and engineering services. Since 1994 the Opponent has provided its services under the above trade mark.</p> <p>On 17 September 2008 the Applicant executed a sub-contractors agreement with the Opponent that bore the Applicant's trade mark. The Opponent's trade mark appeared on stationery which the Applicant saw on a regular basis including upon time slips which he completed and returned to the Opponent. On 23 November 2015 the agreement was terminated for breach on the basis that the Applicant allegedly had dealt with one of the Opponent's clients directly. Two days later, the Applicant applied to register the disputed trade mark.</p> <p>As the Applicant was a sub-contractor for the Opponent for a period of some eight years and upon the adverse termination of that relationship an application to register a trade mark substantially identical to the trade mark used by his former employer in relation to services which are also the 'same kind of thing' as those then offered by his former employer was made,</p>		

this is behaviour likely to fall short of the standards of acceptable commercial behaviour observed by a reasonable and experienced persons.	
10. Tags	
(1) Type of trial	Application to oppose registration of trade mark
(2) Decision	Registration refused
(3) Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

BEACHES AND BUSH v



1. Title	Beaches and Bush Properties Pty Ltd v Beaches and Bush Properties Pty Ltd	
2. Country	Australia	
3. Court	Australia Trade Marks Office	
4. Case No.	[2018] ATMO 6	
5. Date of judgment	16 January 2018	
6. Parties: Opponent Applicant	Beaches and Bush Property Pty Ltd Beaches and Bush Property Pty Ltd	
7. Mark	Opponent	Applicant (disputed trade mark)
	BEACHES AND BUSH	
8. Outline of the case	A case in which the Applicant's trade mark application is determined as having been filed in good faith as the application was honestly made to protect the Applicant's rights as appropriate, and therefore registration was allowed.	
9. Summary of the judgment	<p>The Opponent is a real estate agency established in 2000 and based on the South Coast of New South Wales, Australia. It has used the Opponent's trade mark since at least October 2000 in respect of private, commercial and industrial real estate. Its advertisements include regional television commercials, radio and newspaper advertisements, active website, Facebook page, Twitter page, Instagram account and LinkedIn account.</p> <p>The Applicant is a real estate agency based in Queensland, Australia. It has used the disputed trade mark since March 2014. Its advertisements include social media, active website and third party real estate websites.</p> <p>On 2 October 2015 the director of the Opponent telephoned the Applicant to let them know she was of the belief that the business was trading under the Opponent's trade mark. On 14 October 2015 the Applicant filed the application for the disputed trade mark.</p> <p>The evidence was that the Opponent was not aware of the Applicant which was understandable given the Applicant and Opponent trade in completely different geographical markets. The phone</p>	

call alleging infringement and the decision of the Applicant to protect its rights in the disputed trade mark by seeking registration does not amount to an action that was unscrupulous, underhanded or unconscientious in character, rather it was an appropriate response taken by a business that traded under an unregistered trade mark to protect its rights in the mark it had adopted and traded under.

10. Tags	
① Type of trial	Application to oppose registration of trade mark
② Decision	Registration allowed
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

HEMOSTYP v HEMOSTYP



1. Title	Critical Health Products Pty Ltd v Westcoast Surgical and Medical Supplies Pty Ltd	
2. Country	Australia	
3. Court	Australia Trade Marks Office	
4. Case No.	[2017] ATMO 80	
5. Date of judgment	2 August 2017	
6. Parties: Opponent	Critical Health Products Pty Ltd Westcoast Surgical and Medical Supplies Pty Ltd	
Applicant		
7. Mark	Opponent	Applicant (disputed trade mark)
	HEMOSTYP (unregistered)	HEMOSTYP
8. Outline of the case		
A case in which the Applicant's trade mark application is determined as having been filed as part of conduct that falls short of proper standards as they were aware of the Opponent's trade mark through a prior business arrangement, and therefore registration was refused.		
9. Summary of the judgment		
<p>The Opponent is a company established in 2008 that, amongst other things, distributes health care products imported from the United States. From late 2012 the Opponent imported and distributed a haemostatic gauze product known as HEMOSTYP. The HEMOSTYP product is produced by United Health Products, a company based in Nevada, U.S.A.</p> <p>In December 2013 the Opponent appointed the Applicant as its exclusive distributor of the HEMOSTYP product in Australia. This agreement was terminated on 7 April 2015. Shortly after the Applicant sought to apply to register the disputed trade mark for goods that are the same or the same kind of thing as the HEMOSTYP product which would have had the practical effect of creating legal complications for the Opponent seeking to continue to distribute the HEMOSTYP product.</p> <p>Although there was no evidence of written distribution agreements between the Applicant and the Opponent, the evidence establishes that the Applicant was a former distributor of the Opponent's HEMOSTYP wound dressing product sold under the HEMOSTYP Trade Mark. A person standing in the Applicant's shoes should have known that it should not apply for the registration of a trade mark deceptively similar to that used by its former business partner and that the Applicant's conduct falls short of the standards of acceptable commercial behaviour observed by reasonable and</p>		

experienced persons.	
10. Tags	
① Type of trial	Application to oppose registration of trade mark
② Decision	Registration refused
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

AUSTRIA

FEELING v. FEEL




1. Title	FEELING/FEEL	
2. Country	Austria	
3. Court	Supreme Court	
4. Case No.	4Ob98/14m	
5. Date of the judgment	2014/09/17	
6. Parties: Plaintiff	Not disclosed	
Defendant	Not disclosed	
7. Mark	Plaintiff (disputed trademark)	Defendant (unregistered sign)
	FEELING	FEEL
8. Outline of the case		
<p>A case in which the Plaintiff's registered trademark was registered for the purpose of speculating with it. The Plaintiff buys and sells trademarks to have them in stock. The Defendant, who sells cars, was first suspected to free ride with a trademark mark only slightly differing from the Plaintiff's trademark. Plaintiff based his proceedings against Defendant on such trademark. Defendant filed a counterclaim requesting the invalidation of Plaintiff's trademark.</p>		
9. Summary of the judgment		
<p>The Plaintiff's trademark FEELING is protected for cars, wheels for cars and wheel rims for cars. The Defendant used the word "FEEL" for advertising a specific car type. Whilst the Plaintiff requested prohibitory injunction of the use of "FEEL", since it sounds similar to "FEELING", the Defendant countered that "FEEL" was descriptive. Furthermore, the Defendant argued that the registration of "FEELING" was a case of bad faith trademark filing since the company only speculates with trademarks and cannot prove genuine use of such trademarks.</p> <p>The court decided that the Defendant used the trademark "FEEL" not in a way that it would be distinctive. In addition, the court determined that the Plaintiff speculated with (in particular, descriptive) trademarks which have not been genuinely used. The purpose of a trademark, however, is that it is actually used for goods and services in the course of business. An indication of speculation with trademarks is the filing of several trademarks without a reasonable business model.</p> <p>The court ruled that the Plaintiff speculated with trademarks, consequently deeming the filings as bad faith filings.</p>		

10. Tags	
① Type of trial	Counterclaim in infringement proceedings
② Decision	Dismissal (infringement proceedings), Invalidation of trademark (counterclaim)
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	✓
Others	

Cafe Museum v. CAFÉ MUSEUM



1. Title	CAFÉ MUSEUM	
2. Country	Austria	
3. Court	Higher Patent and Trademark Senate	
4. Case No.	Om 2/12	
5. Date of the judgment	2012/03/14	
6. Parties: Plaintiff	Not disclosed	
Defendant	Not disclosed	
7. Mark	Plaintiff (business name)	Defendant
	Cafe Museum	
8. Outline of the case		
<p>The Plaintiff let the restaurant “Cafe Museum” to the Defendant on lease. The sign “Café Museum” is considered to be a well-known sign for the business of the Plaintiff. After the termination of the lease agreement by the Defendant, the Defendant applied for the trademark CAFÉ MUSEUM & <i>device</i> for goods such as sweets, cakes and catering for guests. In question was a potential filing in bad faith by the Defendant.</p>		
9. Summary of the judgment		
<p>The Plaintiff requested cancellation of the trademark CAFÉ MUSEUM & <i>device</i> on the grounds of bad faith filing. The Higher Patent and Trademark Senate held that the use of the trademark was potentially misleading when it comes to differentiating between the trademark of the Defendant and the business name of the Plaintiff. Furthermore, the Defendant allegedly acted in bad faith when he filed the trademark application after having terminated the lease agreement. The Senate ruled that the Defendant is filing in bad faith when there is a breach of loyalty duties. As the trademark application was filed during the termination period of the lease agreement, those duties still had to be considered and the Plaintiff would have been obliged to inform the lessor (Plaintiff) of the prospective filing of the same trademark, even if used for different lines of business. Furthermore, the fact that the lease agreement had already been terminated by the Defendant before the filing of the trademark application indicated the existence of bad faith and allowed for the conclusion that the Defendant wanted to interfere with the Plaintiff’s market position once the lease agreement was terminated.</p>		
10. Tags		
① Type of trial	Suit against decision of patent office for cancellation of a trademark	

② Decision	Invalidation (Confirmation of decision of the first instance)
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

BRAZIL



HIMEDIA v. HIMEDIA



1. Title	HIMEDIA v. HIMEDIA	
2. Country	Brazil	
3. Court	31ª Federal Court of Rio de Janeiro – Brazil	
4. Case No.	0098824-29.2017.4.025101	
5. Date of the judgment	2018/6/13	
6. Parties: Plaintiff Defendant	HIMEDIA LABORATORIES PVT. LTD. BIOSYSTEMS COMÉRCIO IMPORTAÇÃO E EXPORTAÇÃO DE PRODUTOS PARA LABORATÓRIOS LTDA.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	HIMEDIA (word mark)	HIMEDIA (word mark)
8. Outline of the case		
<p>A case in which the Plaintiff argues that the Defendant registered in bad faith the Plaintiff's well-known trademark since the Defendant knew it belonged to the Plaintiff and due to the business relations kept by the parties at the time the registration was filed.</p>		
9. Summary of the judgment		
<p>The Plaintiff had a registration for the trademark HIMEDIA since 1998 in India. On 2004, the Plaintiff signed a business agreement with the Defendant for commercial representation of its products in Brazil. On September 28, 2004, the Defendant filed a trademark application for HIMEDIA mark in Brazil, without the Plaintiff's consent, which was granted by the BPTO.</p> <p>Therefore, the Plaintiff filed this lawsuit requesting the adjudication of the trademark registration, based on Article 6 <i>bis</i> and <i>septies</i> of the Paris Convention (CUP) as well as Article 166 of the Brazilian Industrial Property Law, and due to its prior registration for the HIMEDIA trademark in India and the bad faith of the Defendant.</p> <p>The court ruled in favor of the Plaintiff, alleging that it could be verified that there was commercial bad faith in the conduct of the Defendant in its act of filing an application for a trademark that, in several other countries, belonged to the company from which it imported the products identified by the sign and with whom it maintained a business relationship based on trust. The court decision said: "Article 166 of the Brazilian Industrial Property Law and Article 6 <i>septies</i> of the CUP must be applied in this case, in order for the trademark to be adjudicated by its actual owner".</p>		

10. Tags	
① Type of trial	Suit aiming at the adjudication of a trademark filed in bad faith by a commercial representative.
② Decision	Adjudication
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

VOGUE v. CAFFE VOGUE

1. Title	VOGUE v. CAFFE VOGUE	
2. Country	Brazil	
3. Court	1 st Specialized Court of the 2 nd Federal Court of Appeals– Brazil	
4. Case No.	0088731-75.2015.4.02.5101	
5. Date of the judgment	2017/10/23	
6. Parties: Plaintiff	ADVANCE MAGAZINE PUBLISHERS, INC. and CONDE NAST BRASIL HOLDING LTDA.	
Defendant	MT CAFÉ LTDA. and the BPTO – INSTITUTO NACIONAL DE PROPRIEDADE INDUSTRIAL - INPI	
7. Mark	Plaintiff (disputed trademark)	Defendant
	 (composite mark)	 (composite mark)
8. Outline of the case		
A case in which the Plaintiff aimed to nullify the trademark CAFFE VOGUE, granted by the BPTO to the 1 st Defendant. The Plaintiff claims that the Defendant’s trademark reproduces its well-known trademark VOGUE.		
9. Summary of the judgment		
<p>The 1st instance judge dismissed the action because it found that the Plaintiff had not been able to prove the Defendant’s bad faith in filing the application for CAFFE VOGUE, since it was filed in a different class, to distinguish restaurant services and, therefore, could not be confused with the Plaintiff’s trademark VOGUE, which distinguishes magazines.</p> <p>The Court of Appeals maintained the 1st instance decision. According to them, the Defendant’s trademark CAFFE VOGUE is sufficiently distinct from Plaintiff’s trademark VOGUE, since it has a figurative form completely different from the Plaintiff’s.</p> <p>Moreover, the Court found that the Plaintiff had not been able to prove that the trademark VOGUE was well-known in the food market, only in the fashion and magazines market. Therefore, it is not possible to say that the Defendant filed its trademark in bad faith, since there is no risk of confusion by the consumers of such trademarks.</p>		
10. Tags		
① Type of trial	Suit aiming to nullify a trademark filed in bad faith by reproducing the well-known trademark VOGUE.	
② Decision	Trademark maintained	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

TYLENOL v. TYLOL



1. Title	TYLENOL v. TYLOL	
2. Country	Brazil	
3. Court	2 nd Specialized Court of the 2 nd Federal Court of Appeals– Brazil	
4. Case No.	0102470-52.2014.4.02.5101	
5. Date of the judgment	2017/03/27	
6. Parties: Plaintiff Defendant	JOHNSON & JOHNSON PHARMASCIENCE LABORATÓRIOS LTDA. and the BPTO – INSTITUTO NACIONAL DE PROPRIEDADE INDUSTRIAL - INPI	
7. Mark	Plaintiff (disputed trademark)	Defendant
	TYLENOL (word mark)	TYLOL (word mark)
8. Outline of the case		
A case in which the Plaintiff aimed to nullify the trademark TYLOL, granted by the BPTO to the 1 st Defendant. The Plaintiff claims that the Defendant’s trademark reproduces its famous trademark TYLENOL to distinguish the same services.		
9. Summary of the judgment		
<p>The 1st instance judge ruled in favor of the Plaintiff, decreeing the nullity of Defendant’s trademark TYLOL, considering that the Defendant acted in bad faith, aiming to take advantage of Plaintiff’s trademark fame and prestige when filing a mark similar to the Plaintiff’s that would likely cause confusion among consumers, since both distinguish the same products. In addition, the judge condemned the 1st Defendant to restrain from using the trademark TYLOL under penalty of a fine of R\$ 10.000,00 (ten thousand reais).</p> <p>The Defendants then filed an Appeal to try to alter the decision and keep its trademark. However, the 2nd specialized Court of Appeals of the 2nd Federal Court maintained the 1st instance’s decision of nullity of the Defendant’s trademark TYLOL.</p>		
10. Tags		
① Type of trial	Suit aiming to nullify a trademark filed in bad faith by reproducing the trademark TYLENOL.	
② Decision	Nullity	
③ Type of bad faith		
Free Ride	✓	
Imitation by agents or people who have a prior relationship		
Interference by a competing company		
Lack of intention to use		
Others		

DERMYCASE vs. DERMICASE



1. Title	DERMYCASE vs. DERMICASE	
2. Country	Brazil	
3. Court	São Paulo Court of Appeal - TJSP	
4. Case No.	9072285-38.2000.8.26.0000	
5. Date of the judgment	April 24 th , 2018	
6. Parties: Plaintiff	Laboratórios Prima Ltda.	
Defendant	Brasterapia Industria Farmacêutica Ltda.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	DERMYCOSE	DERMICOSE
8. Outline of the case		
<p>A case in which the applicant of the “Dermycose” trademark filed a lawsuit against the Defendant, requesting that the court determine that the Defendant refrain from using the sign “Dermicose” to identify its products as well as be condemned to indemnify the Plaintiff due to the infringement of Plaintiff’s trademark.</p>		
9. Summary of the judgment		
<p>The Plaintiff argued, especially, that the Defendant is from the pharmaceutical industry and uses a similar sign (“Dermicose”) to identify a similar product. The lower court granted the lawsuit and the judge determined that the Plaintiff refrain from using the mark “Dermicose” and indemnify the Plaintiff in the amount of R \$ 111,347.65. The parties did not agree with this decision and filed an appeal to the São Paulo Court of Appeal. The Defendant requested for the dismissal of the lawsuit and the Plaintiff requested an increase of the value of the indemnification.</p> <p>In accordance with the judgment of the lower court, the Court of Appeal upheld the prior decision. Based on the Brazilian Constitution and on the Brazilian Intellectual Property Law, the Court recognized not only that the trademark owner has the legitimacy to protect it but that it is possible for the applicant to request third parties to refrain from using the mark already filed within the Brazilian PTO in accordance with the principle of anteriority.</p> <p>In accordance with the Court, the Plaintiff deserved the protection conferred by the Law guaranteeing the maintenance of exclusivity obtained with considerable effort and investment in the market. The Court also emphasized that even if the packaging of medicines and its active principles were different, the similarity of the name, varying only from letter “T” through “Y”, obviously created confusion among consumers.</p> <p>With regard to indemnification, the Court of Appeal established that once infringement of the trademark is proven,</p>		

material damages are presumed, as they are a natural consequence of the confusion between the two establishments and the deviations of clientele. Despite this, the Court of Appeal understood that the value stipulated by the lower court was in accordance with damages suffered by the Plaintiff, based on an expert's report.

10. Tags

① Type of trial	Trademark Infringement
② Decision	Indemnification and Cessation of Use of a Trademark
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

CANADA

IRRESISTIBLES v. IRRESISTIBLES



1. Title	Julia Wine Inc. v. Les marques metro, S.E.N.C.	
2. Country	Canada	
3. Court	Federal Court	
4. Case No.	2016 FC 738	
5. Date of the judgment	2016/6/30	
6. Parties: Plaintiff	Julia Wine Inc.	
Defendant	Les marques metro, S.E.N.C.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	IRRESISTIBLES	IRRESISTIBLES IRRESISTIBLE IRRESISTIBLES & Design
8. Outline of the case	A case in which the Plaintiff's registration for the "Irresistibles" trademark for use in connection with wines was opposed by the Defendant as likely to cause confusion with the Defendant's "Irresistibles" trademarks.	
9. Summary of the judgment	<p>The Defendant's "Irresistibles" mark and its derivatives were known well enough in Canada on the date on which the statement of opposition was filed on March 7, 2011.</p> <p>The Defendant had started using a version of its mark around 2002 in connection with various food products and that decided on the final version, "Irresistibles," in September 2007. Since then, the Defendant's mark was used for about 1100 food products in 370 stores, mainly in Quebec and Ontario, for sales since October 2003 totaling over \$940 million. In addition, since 2011, almost 6.5 million flyers advertising "Irresistibles" products were distributed in Canada.</p> <p>The Plaintiff argued that wine was a type of ware that was distinct from the Defendant's products. However, the Defendant's marks extended to fruit juices, non-alcoholic beverages, sauces, marinades, and the fact that wines could be considered a natural extension of this range of products marketed by the Defendant could not be excluded.</p> <p>In addition to filing the "Irresistibles" mark, the Plaintiff also filed multiple registration applications on the same day, related to other well-known marks in identical or related fields in Canada. The Defendant argued that the Plaintiff was filing applications for the purpose of undermining the Defendant's rights over its trade-marks, since the Plaintiff had adopted a modus operandi that consisted of filing registration applications related to well-known</p>	

marks in identical or related fields in Canada.


The Court ruled that the Plaintiff's attempt to benefit from the established reputation of a significant number of well-known marks is the type of situation that the opposition rule aimed to prevent.

10. Tags

① Type of trial	Appeal at the Federal Court from a Decision of the Registrar of Trademarks.
② Decision	Dismissal of Appeal of Trademarks Opposition Board's Decision
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

BUGATTI v EB BUGATTI & DESIGN



1. Title	Bugatti International S.A. v Bugatti Hotels & Resorts Ltd.	
2. Country	Canada	
3. Court	Trademarks Opposition Board	
4. Case No.	2017 TMOB 60	
5. Date of the judgment	2017/5/30	
6. Parties: Plaintiff Defendant	Bugatti Hotels & Resorts Ltd. (Applicant to the Trademark application) Bugatti International S.A. (Opponent to the Trademark application)	
7. Mark	Plaintiff (disputed trademark)	Defendant
	BUGATTI	EB BUGATTI & DESIGN 
8. Outline of the case		
<p>A case in which the Plaintiff’s registration for the “Bugatti” trademark for use in association with a range of hospitality and real estate services including hotel services was opposed by the Defendant as likely to cause confusion with the Defendant’s “Bugatti” trademark.</p>		
9. Summary of the judgment		
<p>The Defendant is a car manufacturer of vehicles described as the fastest roadsters ever which sell for over \$2 million each. The use of the trademark Bugatti has been well established in connection with luxury automobiles, with media attention in Canadian publications and auto blogs, as well as sales of the automobiles.</p> <p>The Plaintiff, Bugatti Hotels and Resorts Ltd., is a company based in Toronto (“Bugatti Hotels Toronto”) that applied for the trademark “Bugatti” for use in association with a range of hospitality and real estate services including hotel services and subsequently assigned the trade-mark application to Bugatti Hotels & Resorts Ltd., a company based in Seychelles (“Bugatti Hotels Seychelles”).</p> <p>There was evidence illustrating that the Plaintiff found the use of the Bugatti trademark desirable because of the global fame and reputation of the Bugatti mark as a luxury brand. The Plaintiff intended and expected that its use of the Bugatti trademark would be perceived and immediately understood by consumers to be the same as the Defendant’s Bugatti trademark, and as a result the business would enjoy the same cache and goodwill associated with the Defendant’s Bugatti trademark. There was also evidence that the Plaintiff had registered numerous domain names associated with other well-known brands.</p> <p>The Trademarks Opposition board ruled that the Plaintiff’s application must be rejected as the Plaintiff had applied for the trademark in bad faith.</p>		

10. Tags	
① Type of trial	Opposition at the Trademark Opposition Board
② Decision	Rejection of Trademark Application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

CHILE

ANN TAYLOR v. ANN TAYLOR



1. Title	ANN TAYLOR v. ANN TAYLOR	
2. Country	Chile	
3. Court	Supreme Court	
4. Case No.	Reg. N° 945761	
5. Date of the judgment	2017/09/27	
6. Parties: Plaintiff	ANNCO, INC	
Defendant	HOLZER Y CÍA. S.A. DE C.V.	
7. Mark	Plaintiff	Defendant (disputed trademark)
	ANN TAYLOR	ANN TAYLOR
8. Outline of the case		
A case in which the Defendant's registered trademark was obtained by copying a trademark created and positioned in the market by the Plaintiff.		
9. Summary of the judgment		
<p>The Plaintiff's trademark is a well-known and famous trademark in its country of origin (United States). The trademark ANN TAYLOR was created by the Plaintiff in 1954.</p> <p>The Plaintiff filed a nullity action based on similarities between the Defendant's trademark and the Plaintiff's alleging that the Defendant had copied his trademark with the purpose of profiting from its fame. According to ANNCO, INC., the Defendant, Mr. Hozler, legal representative of HOLZER Y CÍA. S.A. DE C.V., contacted ANNCO, INC. on several opportunities to establish commercial relations, but ANNCO, INC. did not agree. This denial drove the Defendant to register the trademark ANN TAYLOR wherever it wasn't already registered by its creator.</p> <p>The Chilean Trademark Office (INAPI) solved this suit by annulling the registration ANN TAYLOR stating that the Plaintiff had made clear that: (1) The Plaintiff is the creator of the trademark, (2) It wasn't a coincidence that the Defendant chose the words ANN TAYLOR to register the mark, and (3) Maintenance of the trademark registration would result in consumer confusion.</p> <p>The decision was appealed by the Defendant, but the Intellectual Property Court of Appeal arrived at the same conclusion.</p>		

Finally, the decision was reviewed by the Supreme Court, who decided to confirm the sentence issued by the Intellectual Property Court of Appeal.

10. Tags

① Type of trial	Nullity Action Against the Registration of a Trademark
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

COLOMBIA

HEXAGON v. HEXAGON





1. Title	HEXAGON v. HEXAGON	
2. Country	Colombia	
3. Court	Council of State (Contentious Supreme Court)	
4. Case No.	11001-03-24-000-2011-00108-00	
5. Date of the judgment	2017/12/15	
6. Parties: Plaintiff	HEXAGON INDUSTRIAS E COMERCIO DE APARELHOS ORTOPEDICOS LTDA	
Defendant	Superintendence of Industry and Commerce (CTO)	
7. Mark	Plaintiff (disputed trademark)	Third Party with legal interest
	HEXAGON	
8. Outline of the case		
<p>A case in which a registered trademark in Colombia registered on behalf of a Third Party with legal interest in Class 35 Int., was identical to the Plaintiff's registered trademark in Brazil, having been obtained contrary to the ethics of business and good faith, as it was proven that the parties had a business relationship. The registrant (Third Party with legal interest), was the Plaintiff's authorized distributor in Colombia when filing the application.</p>		
9. Summary of the judgment		
<p>HEXAGON INDUSTRIAS E COMERCIO DE APARELHOS ORTOPEDICOS LTDA was the owner of trademark HEXAGON (Word) in Brazil, and said company contacted the Third Party with legal interest (ZIE LTDA), in order to reach an agreement and execute a distribution contract in Colombia. The distribution agreement was sent and signed between said companies on May 16, 2006.</p> <p>The Third Party with legal interest filed the application for trademark HEXAGON in Colombia without authorization of the Plaintiff for the illicit purpose of free-riding the reputation, honor, and customer appeal embodied by the Plaintiff's trademark.</p> <p>Based on a comprehensive evaluation of these facts, the Council of State recognized that the applicant was aware of the existence of the Plaintiff's trademark, as the first was the second's expressly authorized distributor in Colombia, as evidenced in the distribution agreement signed between said companies on 2006.</p> <p>The Council of State ordered the CTO annul the Third Party with legal interest's registration for the trademark HEXAGON & design No. 386993 in Class 35 Int.</p>		

10. Tags	
① Type of trial	Suit against decision for trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

GS OIL v. GS OIL



1. Title	GS OIL v. GS OIL	
2. Country	Colombia	
3. Court/authority	Superintendencia of Industry and Commerce (CTO)	
4. Case No.	14194773	
5. Date of the judgment:	Resolution No. 93911 dated 2015/11/30	
6. Parties: Plaintiff Defendant	GS HOLDING CORP REGIRDOS S.A.S	
7. Mark	Plaintiff (disputed trademark)	Defendant
	GS HOLDING CORP 	REGIRDOS S.A.S 
8. Outline of the case	<p>A case in which the Defendant's trademark filed in Colombia, in Classes 4, 35 and 37 Int., was confusingly similar to the Plaintiff's registered trademark in Peru, having been filed contrary to ethics of business and good faith, as it was proved that the parties had a business relationship. (The Defendant was the authorized distributor of the Plaintiff in Colombia).</p>	
9. Summary of the judgment	<p>The Defendant filed the application for Trademark GS OIL without authorization of the Plaintiff on September 4th, 2014, for the illicit purpose of free-riding the reputation, honor, and customer appeal embodied by the Plaintiff's trademark, and the Plaintiff filed an Andean opposition based on its Peruvian registration for trademark GS & Design and simultaneously filing an application for the identical trademark in Colombian in order to demonstrate real interest in the Colombian market.</p> <p>Based on a comprehensive evaluation of these facts, it was recognized that the applicant was aware of the existence of the Plaintiff's trademark, as the first was its distributor expressly authorized in Colombia, as evidenced in the distribution certificates issued by the Plaintiff on January 13, 2013.</p> <p>The CTO acknowledged the Defendant's bad faith and rejected the trademark registration GS OIL in Classes 4, 35, 37 Int.</p>	
10. Tags		
① Type of trial I	Suit against decision for trial for invalidation	
② Decision	Invalidation	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

KLAYSA v. LAY'S



1. Title	KLAYSA v. LAY'S	
2. Country	Colombia	
3. Court	Council of State (Contentious Supreme Court)	
4. Case No.	11001-03-24-000-2013-00126-00	
5. Date of the judgment	2016/05/12	
6. Parties: Plaintiff	PEPSICO., INC	
Defendant	Superintendence of Industry and Commerce (CTO)	
7. Mark	Plaintiff (disputed trademark)	Third Party with legal interest
	LAY'S	KLAYSA
8. Outline of the case		
<p>A case in which the trademark in Colombia, in Class 29 Int., on behalf of the Third Party with legal interest's, was confusingly similar to the Plaintiff's registered trademark in Colombia having been obtained contrary to ethics of business and good faith, in agreement with Article 136 literal a) Decision 486/2000.</p>		
9. Summary of the judgment		
<p>The Plaintiff filed a timely opposition against the Defendant's application, based on the aforementioned legal provisions.</p> <p>In the administrative instance, the CTO concluded that the application on behalf of the Third Party with legal interest, was not confusingly similar to the marks previously registered by the Plaintiff with respect to the same goods and decided to grant the Defendant's application.</p> <p>The Plaintiff filed a Nullity Claim before the Council of State against the Resolutions that granted trademark KLAYSA on behalf of the Third Party with legal interest.</p> <p>Based on a comprehensive evaluation of these facts, the Council of State ratified the CTO's decision, mainly arguing that there was no risk of confusion between the subject trademarks, and that the bad faith of the Defendant when filing the application, also alleged by the Plaintiff, was not proved by the later.</p>		
10. Tags		
① Type of trial I	Suit against decision of trial for invalidation	
② Decision	Invalidation	

③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

COSTA RICA

Tim Hortons v. Tim Hortons



1. Title	Tim Hortons v. Tim Hortons	
2. Country	Costa Rica	
3. Court	Administrative Registry Court	
4. Case No.	2014-0318-TRA-PI	
5. Date of the judgment	2015/1/13	
6. Parties: Plaintiff	TIM HORTONS INTERNATIONAL S.A	
Defendant	Jenny Reyes Duran	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
<p>A case in which the Defendant was seeking registration for a trademark. An opposition was filed by the Plaintiff based on non-registered trademarks. The opposition was rejected by the Trademark Office, but the Administrative Registry Court ruled that the Defendant's trademark was well-known and therefore, the application was filed in bad faith.</p>		
9. Summary of the judgment		
<p>The Defendant filed an application for the trademark TIM HORTONS to protect in class 43 "Services for providing food and drink; temporary accommodation". The application was approved by substantive examination and its notice of publication was published on the Official Gazette.</p> <p>During the period for oppositions, TIM HORTONS INTERNATIONAL S.A. filed an opposition based on non-registered trademarks. This process enables an opponent to file an opposition even though they do not have a registered trademark in Costa Rica, if a) the trademark is currently in use in the country, and b) there is an identical or confusingly similar well-known, famous trademark.</p> <p>The TMO rejected the opposition as they do not consider the trademark TIM HORTONS is well-known in Costa Rica. Against this resolution, the Plaintiff filed an appeal at the Administrative Registry Court.</p> <p>With the evidence filed, including trademark certificates in different countries, photos, articles, international declarations of notoriety, the Administrative Registry Court concluded that the TIM HORTONS trademark is famous, and considering that the trademark applied is exactly identical, the application was filed in bad faith.</p>		

10. Tags	
① Type of trial	Opposition Against Decision of Trademarks Office
② Decision	Rejection of Trademark Application Due to Bad Faith
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

DESIGUAL v. DESIGUAL



1. Title	DESIGUAL v. DESIGUAL	
2. Country	Costa Rica	
3. Court	Administrative Registry Court	
4. Case No.	2010-0909-TRA-PI	
5. Date of the judgment	2012/1/19	
6. Parties: Plaintiff Defendant	INTS IT IS NOT THE SAME, GMBH Angulo Opuesto S.A.	
7. Mark	Plaintiff	Defendant (disputed trademark)
8. Outline of the case	<p>A case in which the Defendant was the holder of a trade name registration for DESIGUAL, and the Plaintiff filed a trademark application for DESIGUAL in class 25 along with a nullity action against the trademark registration of the Defendant. The Trademark Office ruled that the trademark DESIGUAL was not well-known in Costa Rica, and therefore, rejected the nullity action. The Administrative Registry Court reverted this decision.</p>	
9. Summary of the judgment	<p>The Defendant had a registration for the trade name “DE 2 IGUAL” to protect “a commercial establishment dedicated to the commercial activity of shoe stores, that is to say the sale of shoes, boots, men’s shoes, women’s shoes and children’s shoes”.</p> <p>INTS IT IS NOT THE SAME, GMBH filed a trademark application for Dezigual in class 25 for “garments made for women, men and children; footwear; millinery”, along with a nullity action against this trademark registration, alleging Dezigual is a famous trademark, and as such, it must be protected. The Trademark Office rejected this nullity action and considered there was no sufficient proof that the trademark is well-known.</p> <p>Against this resolution of the TMO, the Plaintiff filed an appeal at the Administrative Registry Court, which ruled that the Plaintiff was right, the trademark Dezigual is well-known and although the trade name “DE 2 IGUAL” was in use in Costa Rica for several years, the notoriety of the trademark Dezigual took precedence.</p>	
10. Tags		

① Type of trial	Nullity Against Trademark Registration
② Decision	Nullity Confirmed
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

CUBA

BLUETOOTH vs BLUETOOTH



1. Title	BLUETOOTH vs BLUETOOTH	
2. Country	Cuba	
3. Court	Cuban Intellectual Property Office	
4. Case No.	2015-1396 (no. of the application file)	
5. Date of the judgment	2017/12/28	
6. Parties: Plaintiff	Bluetooth SIG, Inc.	
Defendant	International IP Holdings, LLC	
7. Mark	Plaintiff (disputed trademark)	Defendant
	BLUETOOTH	BLUETOOTH
8. Outline of the case		
An opposition against the filing of a famous and well-known trademark worldwide whose recognition in Cuba could be under question given the US embargo on trade with Cuba.		
9. Summary of the judgment		
<p>Under consideration was the notion that BLUETOOTH was a well-known trademark in other countries for telecommunication services, in particular for wireless technologies. The opponent's evidence of its well-known character were considered to try to demonstrate its well-known character locally for telecommunications services and for users of mobile phones and electronic devices. It was highlighted that the mark has presence in Cuba through devices imported to the country and the number of users of those devices and through documents of the sole telecommunications company of Cuba, all of which were considered to have contributed to a degree of awareness and notoriety at a local level.</p> <p>Due to the similarity of the signs, it was likely that there was a risk of association between the signs, regardless of whether the Plaintiff had any presence in Cuba.</p> <p>The bad faith claim was rejected on autonomous grounds since, according to Cuban Law, it was a ground for nullity (as it goes against registered marks) and not for opposition (which would imply an expectation of a right, instead of a right per se).</p>		

Having said this, the applicant filed 23 trademarks for different goods and services, all of which were registered or used abroad by different owners and some are well-known trademarks within the relevant sectors in other countries. 17 of the 23 applications (74%) received oppositions filed by third parties on a similar basis. Further research showed that the applicant did not have trademark rights using those signs nor had it performed activities under those trademarks in other countries. These facts together with the well-known character of BLUETOOTH in the relevant sector led to the conclusion that there was “imitation and taking unfair advantage of the reputation” of the opponent, and that the filings were made “to facilitate, in an evident manner, an act of unfair competition” as they were intended to cause confusion among the target audience and to obtain exclusive rights for trademarks which could not be subject to a real and effective use at a national level.


10. Tags

① Type of trial	Opposition
② Decision	Opposition (Cuban PTO)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

ECUADOR

MARC JACOBS vs MARC JACOBS



1. Title	MARC JACOBS vs MARC JACOBS MAS LOGOTIPO	
2. Country	Ecuador	
3. Court	Ecuadorian PTO	
4. Case No.	Iepi-2017-30829	
5. Date of the judgment	2018/01/09	
6. Parties: Plaintiff Defendant	MARC JACOBS TRADEMARKS LLC YANG SURONG	
7. Mark	Plaintiff (disputed trademark)	Defendant
	MARC JACOBS	
8. Outline of the case		
MARC JACOBS TRADEMARKS LLC filed an Andean opposition against the registration of their trademark MARC JACOBS on behalf of a third party.		
9. Summary of the judgment		
<p>The Plaintiff's trademark is a well-known luxury clothing and accessories trademark. Despite the fact that the trademark MARC JACOBS was not registered in Ecuador, the Ecuadorian PTO recognized MARC JACOBS TRADEMARKS LLC previous rights in another Andean country. The Authority considered that the trademark filed by YANG SURONG is identical to the famous luxury brand MARC JACOBS.</p> <p>The trademark was denied on the basis that Andean law prohibits the registration of a trademark that may cause confusion among consumers. This resolution is an important precedent by which the Ecuadorian PTO recognized the rights of Marc Jacobs Trademarks LLC even though the trademark was not registered or used in Ecuador.</p>		
10. Tags		
① Type of trial	Andean Opposition	
② Decision	Registration Denial	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship		
Interference by a competing company		

Lack of intention to use	
Others	✓

FINLAND

Humsecgrid v. HUMSECGRID



1. Title	HUMSECGRID	
2. Country	Finland	
3. Court	Supreme Administrative Court of Finland	
4. Case No.	KHO:2017:155	
5. Date of the judgment	2017/10/11	
6. Parties: Plaintiff	Kuopio Innovation Oy	
Defendant	not disclosed	
7. Mark	Plaintiff (disputed trademark)	Defendant
	Humsecgrid (abbreviation for Human Security Grid)	HUMSECGRID
8. Outline of the case		
A case in which the Defendant's trademark was found to have been filed in bad faith due to the Defendant's knowledge of and previous involvement with the Plaintiff's project of the same name.		
9. Summary of the judgment		
<p>On October 11, 2017, the Supreme Administrative Court of Finland (the Court) handed down judgment KHO:2017:155, in which it confirmed Market Court decision no. 502/15, July 14, 2017, holding that Kuopio Innovation Oy may oppose the (undisclosed) Defendant's registration of the trademark HUMSECGRID on the grounds of bad faith under Section 14(1).7 of the Finnish Trademarks Act.</p> <p>In 2012, the Defendant registered the Finnish trademark HUMSECGRID in Classes 41, 42, and 45. Kuopio Innovation Oy claimed that it had been filed in bad faith as the Defendant had been involved in a project called Humsecgrid (abbreviation for Human Security Grid) in which the trademark was developed in co-operation with other participants of the project and used in events related to the project.</p> <p>The Court stated in accordance with a decision by the General Court of the European Union (SA.PAR. v. OHIM - Salini Costruttori (GRUPPO SALINI), T-321/10, para. 28, July 11, 2013) that "in order to assess whether or not a trademark applicant acted in bad faith, it is necessary to examine the intentions of the applicant such as they may be inferred from objective circumstances and from his specific actions, from his role or position, from the awareness he possessed of the use of the earlier sign."</p>		

In line with a decision of the Court of Justice of the European Union (CJEU) (Verein Radetzky-Orden, C-442/07, paras. 16, 22, 24, Dec. 9, 2008), the Court found that the fact that Kuopio Innovation Oy was a nonprofit association was immaterial in the assessment of whether its use of the mark constituted trademark use.

The Court also referred to another decision of the CJEU (Chocoladenfabriken Lindt & Sprüngli, C-529/07, para. 34, June 11, 2009) stating that filing a trademark in bad faith is an absolute ground for refusal. Thus, it was immaterial whether Kuopio Innovation Oy's claims were based on its own prior use or the prior use of a third party.

Furthermore, the Court found that the provision may apply even if the earlier mark is not established in the market. Therefore, the Court concluded that the Defendant had filed the trademark in bad faith and that the trademark registration would therefore be revoked.

The judgment diverges from judgment KHO:2010:75 of November 3, 2010, in which the Court held that a party must base its claims on its own prior use.



10. Tags

① Type of trial	Bad Faith as an Absolute Ground for Refusal of Trademark Registration
② Decision	Opposition
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

FRANCE

IT COSMETICS v. IT COSMETIQUE





1. Title	IT Cosmetics	
2. Country	France	
3. Court	Tribunal de Grande Instance de Paris	
4. Case No.	16/17537	
5. Date of the judgment	23/02/2018	
6. Parties: Plaintiff Defendant	L'Oreal SA Guinot SAS	
7. Mark	Plaintiff	Defendant (disputed trademarks)
	IT COSMETICS	IT BEAUTE
		IT PARFUM
	IT SKIN	
		IT COSMETIQUE
	IT BEAUTY	
8. Outline of the case		
<p>Guinot SAS (Applicant) filed for the disputed marks for perfumes and cosmetics.</p> <p>L'Oreal S.A. opposed the application on the basis of likelihood of confusion with and dilution of its registered IT, IT COSMETICS, IT SKIN and IT BEAUTY marks for cosmetics, and a lack of intent to use in commerce.</p>		
9. Summary of the judgment		
<p>The Plaintiff's trademarks are constituted by the wording "IT" paired with generic terms such as "COSMETICS" and "BEAUTY" which have been acquired by the Plaintiff together with the acquisition of the company IT COSMETICS on September 1st 2016.</p> <p>The disputed trademarks are constituted by the combination of the word "IT" together with "BEAUTE", "PARFUM" and "COSMETIQUE" which are the French translation of the terms incorporated in the Plaintiff's trademarks and had been registered between the 26th and the 28th of July 2016, shortly after the announcement of the abovementioned acquisition.</p> <p>The Defendant is a famous multinational company engaged in the global manufacturing and sale of cosmetics and beauty products as well as perfumes.</p>		

Based on the fact the Defendant operates in the same industry as the Plaintiff and on the wide publicity of the acquisition that L’Oreal has engaged, the Plaintiff could not have ignored this acquisition and as a consequence that L’Oreal would be exploiting the trademark “IT COSMETICS” from the acquisition date onwards. Moreover, the Defendant had not been able to prove any reason why he would have registered the disputed trademarks. For this reason, the Defendant’s trademarks were judged as registered in bad faith.

10. Tags

① Type of trial	Cancellation Proceedings / Invalidity Action
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

Pigeon proper v. clean pigeon

1. Title	Pigeon proper v. clean pigeon	
2. Country	France	
3. Court	Tribunal de Grande Instance de Paris	
4. Case No.	15/14028	
5. Date of the judgment	15/09/2016	
6. Parties: Plaintiff Defendant	Pigeon Propre SARL Clean Pigeon SARL	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
<p>Clean Pigeon SARL filed an application for the disputed trademark for goods against winged animals. Pigeon Propre SARL opposed the application on the basis of likelihood of confusion with its registered trademark “PIGEON PROPRE” for the same goods, claiming the non-ignorance of Clean Pigeon SARL at the time of application.</p>		
9. Summary of the judgment		
<p>Pigeon Propre SARL is a company specialized in the development and commercialization of anti-winged animal products since 1996 and owns the “PIGEON PROPRE” trademark since 2014.</p> <p>S.T. had been an employee of Pigeon Propre SARL from 1999 to 2007 before leaving it and creating company Clean Pigeon SARL in 2011 which specialized in the same sector in which Pigeon Propre SARL operates. S.T. registered during the same year, in the name of Clean Pigeon SARL, the disputed trademark for anti-winged animal goods.</p> <p>Based on the long-standing working relationship between S.T. and Pigeon Propre SARL, the latter claims that S.T. could not have ignored the usage of the company’s name as an unregistered trademark and therefore that S.T. had registered the trademark “CLEAN PIGEON” in bad faith, taking advantage of Pigeon Propre’s reputation.</p> <p>The Court rejected the claim of Pigeon Propre SARL on the ground that the longstanding working relationship between Pigeon Propre SARL and Clean Pigeon, through its founder, does not prove that the latter had applied</p>		

for the disputed trademark in bad faith. Indeed, no proof has been brought by Pigeon Propre SARL that the disputed trademark had been registered with the purpose of effectively hindering its commercial activity, independently from the existence of a prior trademark right. The Court validated the disputed trademark on the ground that there was no proof showing that Clean Pigeon SARL registered the trademark for purposes other than legitimate use.

10. Tags

① Type of trial	Infringement Action
② Decision	Validation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

Parnasse v. Parnassea

1. Title	Parnasse v. Parnassea	
2. Country	France	
3. Court	Tribunal de Grande Instance de Paris	
4. Case No.	15/02897	
5. Date of the judgment	31/03/2016	
6. Parties: Plaintiff Defendant	Société Parisienne De Parfums Et De Cosmetiques SAS Louis Vuitton Malletier SA	
7. Mark	Plaintiff	Defendant (disputed trademarks)
	PARNASSE	LOUIS VUITTON PARNASSEA
		PARNASSEA
8. Outline of the case	<p>Louis Vuitton Malletier's application for the disputed trademark was deemed in good faith as its only purpose was to launch new products under this name and not to damage Société Parisienne de Parfums Et De Cosmetiques (SPPC) nor any other competitor.</p>	
9. Summary of the judgment	<p>SPPC owns the "PARNASSE" trademark for goods in classes 3, 18 and 25 including leather products since 1994. The "PARNASSE" trademark had, however, been used only for a few seasons and abandoned afterwards until 2012.</p> <p>Louis Vuitton Malletier had sent a letter to SPPC in May 2013 informing them about their interest in buying the "PARNASSE" trademark and about their awareness that the trademark had been abandoned. For this reason, Louis Vuitton Malletier was ready to engage in legal action to pronounce annulation of the trademark. The day after sending, Louis Vuitton Malletier filed an application for the disputed trademarks for leather goods.</p> <p>SPPC took Louis Vuitton Malletier to Court claiming bad faith of the disputed trademark on the grounds that the latter was aware of the existence of the prior mark, but knowingly ignored it. Based on extensive proof submitted by Louis Vuitton Malletier showing that the disputed trademarks had been used to market a new bag collection in May 2013, the Court validated the disputed trademark on the grounds that they had been registered with the purpose of identifying the products of the new collection. Thus, the trademark application could not be considered as filed in bad faith.</p>	
10. Tags		
① Type of trial	Infringement Action	
② Decision	Validation	

③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

GERMANY

Glückspilz (“Lucky Devil”/”Lucky Dog”)

1. Title	Glückspilz (“Lucky Devil”/”Lucky Dog”)	
2. Country	Germany	
3. Court	Bundesgerichtshof (Federal Court of Justice)	
4. Case No.	I ZB 69/14	
5. Date of the judgment	15 October 2015	
6. Parties: Plaintiff	N.N.	
Defendant	N.N.	
7. Mark	Appellant	Defendant/Owner
		GLÜCKSPILZ
8. Outline of the case		
<p>The Bundesgerichtshof found that the relevant point in time at which bad faith must be established for refusal of a trademark’s registration or later cancellation is not the date of the registration of a trademark, but that of the trademark’s application.</p> <p>Furthermore, enforcing claims based on a registered trademark before courts only against decorative uses of the mark is, without further evidence, not sufficient to indicate lack of intention to use the trademark properly.</p>		
9. Summary of the judgment		
<p>The Defendant was an owner of the registered word mark “GLÜCKSPILZ” with respect to goods in Nice classes 18, 21 und 25. The term “Glückspilz” means “lucky dog” or “lucky devil” and is thus a very common and oft-used term in general in the German language in humorous as well as in in serious contexts.</p> <p>The appellant requested cancellation of the trademark claiming that the application had been filed in bad faith. The Federal Patent Court found in favor of the appellant. One indication of bad faith was that the Defendant had registered various word marks with equally common terms, such as “Lucky Devil” without using them as trademarks. Furthermore, the Defendant had approached competitors using the term “Glückspilz” as decorative embellishments on floor mats with cease and desist letters to enforce its alleged rights before courts. Finally, the Defendant had not established that it intended to use the registered mark for proper trademark purposes in the future. These clues showed that the only intention of the Defendant was to improperly use an exclusive barrier effect against competitors who used the sign for embellishments.</p> <p>The Bundesgerichtshof annulled the decision and returned the matter to the Federal Patent Court.</p>		

The Federal Patent Court had rightly assessed the matter insofar as it focused on the date of the trademark's application, not the date of its registration. Thus, the Bundesgerichtshof overturned its own set of case law, which, until this decision (cf decision of 2 April 2009, Case I ZB 8/06), had found the date of the decision on registration was the relevant date to assess evidence as to whether the trademark application was made in bad faith.

The Bundesgerichtshof did not, however, concur with the rest of the reasoning put forth by the Federal Patent Court. The German Patent and Trademark Office and the Federal Patent Court should have made less sweeping observations and statements relating to the Defendant using the trademark as a decorative embellishment rather than as a trademark in a proper way. Furthermore, the office and the court had not considered additional contentions by the Defendant referring to other forms of use. Therefore the evidence was considered insufficient to establish lack of intention to use at the time of the application of the trademark.

Additionally, the behavior of the Defendant did not indicate that it's *only* intention at the time of the trademark application was to improperly use an exclusive barrier effect of the trademark against its competitors. Enforcing rights against competitors using a trademark in a decorative way rather than as a trademark may not be successful but would not indicate improper intention without additional evidence. The fact that the Defendant had registered various common terms equal to "Glückspilz" was also not sufficient evidence to indicate the Defendant was pursuing improper intent by registering the trademark in question.

10. Tags

① Type of trial	Appeal Before the Bundesgerichtshof Against a Decision by the Federal Patent Court
② Decision	Appeal Allowed and the Matter was Returned to the Federal Patent Court for Further Trial
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

Hop on Hop off



1. Title	Hop on Hop off	
2. Country	Germany	
3. Court	Federal Patent Court	
4. Case No.	26 W (pat) 64/08	
5. Date of the judgment	12 November 2012	
6. Parties: Appellant	N.N. Cancellation Procedure, Appeal Against Cancellation.	
7. Mark	Cancellation Applicant	Trademark Owner
		Hop on, Hop off
8. Outline of the case		
<p>The Federal Patent Court found that the trademark owner had filed the trademark in question primarily to use the exclusive barrier effect to block competitors. Given this background, it would, in this specific case, not be relevant that the trademark owner intended to use the trademark for trademark purposes.</p>		
9. Summary of the judgment		
<p>The trademark owner registered the trademark “Hop on, hop off” for “city tours” and “sightseeing tours”. At the time of the application, however, he was fully aware of the fact that the slogan was already used by sightseeing tour providers in Berlin (and apparently also in Sweden, though irrelevant for the German trademark) for a particular system of city tours. The German Patent and Trademark Office cancelled the trademark on grounds of bad faith because it found that the trademark owner only sought trademark protection of the slogan to use the trademark not just as the designation of its services, but first and foremost as an improper means of competing by obtaining an injunction based on the registered trademarked in order to push competitors out.</p> <p>The Federal Patent Court upheld the cancellation decision by the German Patent and Trademark Office. The court found that the trademark owner at the time of the application of its trademark knew that another provider of city tours intended to use the already known slogan “Hop on, hop off” for city tours in Cologne. The trademark owner had already tried to prevent, without success, a business license being issued to the competitor by the district administration of Cologne. This and the fact that the trademark owner approached the competitor and filed for an injunction two months after its registration sufficed to show that the predominant motivation for obtaining the trademark right had been to eliminate the competitor from the market and not the use as a designation of its own services. Therefore, even in cases where a trademark owner successfully proves its intention to properly use a trademark, the trademark may still be cancelled by the trademark authorities and/or courts if other anti-competitive motives prevail.</p>		

10. Tags	
① Type of trial	Appeal Before the Federal Patent Court Against a Decision by the German Patent and Trademark Office
② Decision	Cancellation Decision Upheld
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

AKADEMIKS v. AKADEMIKS



1. Title	AKADEMIKS	
2. Country	Germany	
3. Court	Federal Court of Justice	
4. Case No.	I ZR 38/05	
5. Date of the judgment	2008/01/10	
6. Parties: Plaintiff Defendant		
7. Mark	Plaintiff	Defendant (disputed trademark)
	AKADEMIKS	AKADEMIKS
8. Outline of the case		
A case in which the Defendant’s registered trademark was determined to have been registered in Germany to hinder the use and registration of a trademark previously registered in the USA.		
9. Summary of the judgment		
<p>The Plaintiff operates in the segment “Urban Street Wear” and in particular manufactures and sells “Hip Hop Fashion”. The Plaintiff registered its first trademark containing “AKADEMIKS” for clothing items on 1999/06/04 in the USA. After their launch in the USA in Spring 2000, the goods sold under the Defendant’s trademark very successfully. Subsequently, various trademarks were registered with the OHIM in 2002 and in 2003 with the German Patent and Trademark Office.</p> <p>The Defendant registered the disputed trademark for clothing items, shoe wear and headgear on 2000/10/18 in Germany.</p> <p>The Plaintiff argued that the trademark in Germany was registered in bad faith because the Defendant should have known that the Plaintiff planned to use the trademark in Germany and because the Defendant also imitated the characteristics of the goods.</p> <p>The result was that the Defendant knew of the Plaintiff’s trademark when registering the disputed trademark because they both operated in a market which focuses on developments in the US market. The Defendant also should have anticipated that the Plaintiff planned to operate in the German market with the trademark in the near future. This is because, typically, fashion companies successful in the US will be marketed in Germany soon</p>		

after this success and because companies normally try to establish themselves in their domestic market before going abroad. The Plaintiff's trademark was particularly successful and became known to experts outside of the US, which is why a launch in Germany was expected.

10. Tags

① Type of trial	Main Injunction Proceedings
② Decision	Cancellation, Injunction
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

HONG KONG



v. Mastercard

1. Title	易聯支付科技有限公司 v. Mastercard	
2. Country	Hong Kong	
3. Court		
4. Case No.	302230190	
5. Date of the judgment	17 th December 2017	
6. Parties: Plaintiff	易聯支付科技有限公司	
Defendant	MASTERCARD INTERNATIONAL INCORPORATED	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case	<p>On 23 April, 2012 易聯支付科技有限公司 (the Applicant) filed an application (“the subject application”) under the Trademarks Ordinance (“the Ordinance”) for the registration of the mark “Payeco”. Although the subject mark is represented in blue and orange colors, there is no color claim in the subject application. So the distinctiveness of the subject mark did not depend on a particular color scheme. Registration was sought in respect of “Financial services” for class 36, “Providing telecommunications equipment (including mobile phones, telephones) for confirming payment transactions” in class 38, and “Providing design and development of computer hardware and software for supporting applications by financial service institutions” for class 42.</p>	
9. Summary of the judgment	<p>The subject application, the Notice of Opposition and the Counter-statement were all filed in Chinese. Pursuant to a joint request by the parties, the Registrar gave the direction that the language of the proceedings change from Chinese to English.</p> <p>Both parties were treated as not intending to appear at the hearing. Both the Opponent and the Applicant had not filed any written submissions. In the Notice of Opposition, the Opponent sought to oppose registration of the subject mark pursuant to sections 11(5)(a), 11(5)(b), 12(3), 12(4), 12(5)(a) and 12(5)(b) of the Ordinance.</p>	

Counter-statement

The Applicant asserted that the subject mark is dissimilar to the Opponent’s Mark, which usually consists of two interlocking circles in red and orange colors with the overlapping area depicting a number of horizontal bars and the word “MasterCard” prominently displayed across the circles. The subject mark consists of two blue and yellow circles with the word “PayEco” prominently written on the circles. There are shadows underneath the circles, but no horizontal bars in the overlapped area.

It was asserted that the Defendant’s Mark had a substantial reputation and is recognized as well-known throughout the world due to the consistency of use of the mark over the years. The Defendant submitted that the subject mark is very similar to the Defendant’s Mark, in particular, the interlocking circles of the subject mark are confusingly similar to the Defendant’s Mark; further, the subject services are identical or similar to or are associated with the Defendant’s Goods and Services; therefore, the subject services are very likely to be perceived by the public as being provided by or connected with the Defendant. On the other hand, it was the Applicant’s view that the subject mark, which consists of a device of blue and yellow circles with shadows underneath and the word “PayEco” prominently written on the device, is dissimilar to the Defendant’s one.



The opposition against the subject application failed as none of the Defendant’s grounds of opposition had been accepted.

10. Tags

① Type of trial	
② Decision	
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

HUNGARY



1. Title	AUTÓ 2	
2. Country	Hungary	
3. Court	Supreme Court	
4. Case No.	Pfv. IV.20.710/2008/5.	
5. Date of the judgment	2008/10/08	
6. Parties: Plaintiff	Unpublished	
Defendant	Hungarian Patent Office	
7. Mark	Plaintiff (disputed trademark)	Defendant
		
8. Outline of the case	The disputed trademark was not registered in bad faith.	
9. Summary of the judgment	<p>The Respondent is the proprietor of the trademark “a2 AUTO2” (registration number: 155462). The Applicant requested the Authority to declare the trademark invalid and alleged (1) a lack of distinctive capacity, (2) the bad faith of the Respondent and finally, (3) a violation of the right to the name. The Office refused the claim. The first instance also refused the claim to reverse the decision in its final judgment.</p> <p>The Supreme Court affirmed the judgment of the first instance. The Supreme Court established that, without a doubt, the trademark was distinctive in relation to other goods or services, hence it could not be the reason for declaring the trademark invalid.</p> <p>The Court also ruled that the Respondent did not act in bad faith when it filed the application for the trademark, since the position of D. G. (managing director of the respondent) as an editor and the producer of the television program provided him due cause to seek the protection of a trademark. It does not constitute bad faith per se on his side that he was aware of the fact that later the Applicant published a newspaper with a similar title.</p> <p>The Court also ruled that it was not proved by the Applicant that a civil law partnership was established by the parties, hence the name “Autó2” did not constitute the name of a partnership. As a consequence, the violation of the right to a name could not be established.</p>	

10. Tags	
① Type of trial	Invalidation Procedure
② Decision	Maintained the First Instance Judgment
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



1. Title	AFRICANA	
2. Country	Hungary	
3. Court	Hungarian Intellectual Property Office (HIPO)	
4. Case No.	SZTNH M0902930	
5. Date of the judgment	25/02/2011	
6. Parties: Plaintiff Defendant	Hungarian Patent Office	
7. Mark	Plaintiff (disputed trademark)	Defendant
	AFRICANA colored figurative trademark	-
8. Outline of the case		
The disputed trademark was not registered as the HIPO found the registration to be made in bad faith.		
9. Summary of the judgment		
<p>The application of AFRICANA for a colored figurative trademark (disputed trademark) was rejected for class 30 “chocolates, cocoa, etc.”.</p> <p>The applicant of the disputed trademark had many previous word trademarks and figurative trademarks containing the word “AFRICANA” which were all registered for goods at class 30. The person making later observation (observer) of the disputed trademark contacted the owner to purchase or license the already registered AFRICANA trademarks. The owner declined the negotiations, however the owner had not used the trademarks in Hungary.</p> <p>The observer filed deletion requests against the already registered trademark based on non-use. The HIPO declared that as the owner had not used the trademarks, the protection of such trademarks was invalid. The disputed trademark was filed for application during the process of the deletion procedure of the already registered trademark but before the decision was made by HIPO.</p> <p>During the registration procedure of the disputed trademark, HIPO declared that the aim of registering the disputed trademark was to circumvent the obligation to use regarding prior trademarks and that it is against the abuse of rights principle, therefore the application of the disputed trademark was made in bad faith.</p>		

10. Tags	
① Type of trial	Registration procedure
② Decision	Not registered
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

INDIA

VOLVO v. VOLVO



1. Title	VOLVO v. VOLVO	
2. Country	India	
3. Court	High Court of Delhi	
4. Case No.	CS (OS) No. 1492/2005, Citation-2011(45)PTC207(Del)	
5. Date of the judgment	13.12.2010	
6. Parties: Plaintiffs	Aktiebolaget Volvo and Ors.	
Defendants	Kishore Purohit and Ors.	
7. Mark	Plaintiff	Defendant(disputed trademark)
	VOLVO	VOLVO
8. Outline of the case		
<p>A case where the Court passed an order restraining the Defendants from use of the trademark VOLVO with respect to mixers, grinders, juicers and their parts. The Court also directed the Defendant to withdraw the trademark application so filed before Trademarks Registry seeking registration of the trademark VOLVO on account of the same being dishonest and taking unfair advantage of the reputation of the trademark of the Plaintiff.</p>		
9. Summary of the judgment		
<p>The Plaintiff was in the business of manufacturing cars as well as heavy commercial vehicles such as trucks, buses and construction equipment, driving systems for marine and industrial applications, aircraft engines and space propulsion components. Plaintiffs also created a range of VOLVO Merchandise goods to support their core business and had used the trademark VOLVO in relation to belts, buckles, bags, watches, pens, clothing and a range of other accessories.</p> <p>VOLVO is stated to be a Latin word which Plaintiff No. 1 had adopted for its business, and it was asserted that it had all the trappings of an invented mark. It was further asserted that VOLVO did not convey anything in its ordinary significance and it was neither a geographical indication nor a surname and its mark has now come to be associated exclusively and solely with the Plaintiff. The Plaintiff claimed tremendous goodwill and reputation in the mark VOLVO.</p> <p>In July 2005, the Plaintiff was informed of the trademark application No. 1304378 filed by Defendants before the Registrar of Trademarks for registration of the mark VOLVO in class 7 with respect to mixers, grinders, juicers and their parts. The Plaintiff filed an Opposition to registration of the mark VOLVO by the Defendants. On making enquiry, the Plaintiff came to know of the use of the trademark VOLVO by the Defendants for manufacturing, selling and using mixers, grinders, juicers, etc.</p>		

The Court observed that the name VOLVO, on account of its extensive use by the Plaintiffs since 1915, had become associated exclusively with the Plaintiff's companies and the products being manufactured and sold by them. The Court further observed that trademark publication and use of the mark VOLVO by Defendants for the mixers, grinders and juicers being manufactured and sold by him was dishonest and that the Defendant wanted only to cash in on the tremendous goodwill and reputation which was vested in the trademark VOLVO, belonging to the Plaintiff. The name VOLVO has no connection with the products being manufactured by Defendant No. 1 and, therefore, it was difficult to deny that the purpose of Defendant No. 1 in using this mark for selling the products manufactured by him was to gain an unfair advantage by using the reputed and well-established trademark of the Plaintiff.

There is a strong probability that a consumer who came across mixers, grinders and juicers being sold under the name VOLVO assumed that these are the products being manufactured and/or sold by the Plaintiff which owns the trademark VOLVO and that he/she may purchase the product manufactured by Defendant No. 1 on the assumption that, coming from the Plaintiff's company, the products are likely to be of a superior quality. If the products manufactured by Defendant No. 1 and being sold by him under the name VOLVO are not found to be of a superior quality or their quality is not found to be of the standard expected by the consumer from the Plaintiff companies, that may affect the credibility and reputation of the Plaintiff since the consumer may believe that the quality of the products being manufactured by the Plaintiff has gone down.

With the above observation, the Court restrained the Defendant from selling, distributing or marketing any products using the mark VOLVO or any other mark which is similar to VOLVO owned by the Plaintiff. The Court also directed the Defendant to withdraw trademark application No. 1304378 pending before the trademark registry within 30 days of the decision.

10. Tags

① Type of trial	Suit for Permanent Injunction Restraining Infringement of Trademark and Passing Off
② Decision	Defendant Restrained from Use as Well as Registration of the Mark VOLVO
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

EGO v. EGO



1. Title	EGO v. EGO	
2. Country	India	
3. Court	The Intellectual Property Appellate Board(IPAB)	
4. Case No.	ORA/49/2008/TM/DEL	
5. Date of the judgment	01.05.2009	
6. Parties: Appellant Respondents	A.V.R. Engineers Rajinder Singh, trading as Master Metal Industries and The Registrar of Trademarks	
7. Mark	Applicant	Respondent (disputed trademark)
	EGO	EGO
8. Outline of the case		
<p>A case in which the Respondent No.1's registered trademark was determined to have been obtained contrary to the ethics of business as the user's claims in the application were false. The case also highlighted that the objective of maintaining a Trademark Register was to show to the public that the goods they are buying belong to or are manufactured and sold by a particular person.</p>		
9. Summary of the judgment		
<p>The Applicant engaged in the business of manufacturing, marketing and sale of C.P. bathroom fittings, valves, cocks and industrial valves of all types since the year 1984. The Applicant adopted the trademark EGO honestly and bonafidely and had been using the same since 1984 continuously, uninterruptedly and exclusively as proprietor and owner. The Applicant was the prior adopter, user and registered proprietor of the trademark EGO.</p> <p>The Respondent No. 1 is an ex-commissioned agent of the applicant and worked for the Applicant till 2001. The Respondent No. 1 had fraudulently and illegally obtained the impugned registration of the trademark "EGO" under No. 1047896 in class 11 with respect to valves, cocks and pipe fittings for water supply and sanitary purposes included in class 11.</p> <p>The Applicant placed on the record documents to establish that Respondent No. 1 was their commissioned agent till the year 2001 and also was aware of the applicant's use of the trademark. The Tribunal sustained the plea of fraud against Respondent No. 1.</p> <p>The Tribunal further observed that Respondent No. 1 also obtained registration by contravention of the provisions of Section 18 of the Trademarks Act, 1999. Upon perusing the impugned Trademark Journal advertisement, it was clear that the application for registration had been made in the year 2001 and claiming users since 1998, whereas from the purchase orders, it was seen that the Respondent had not been placing orders until 2001.</p>		

From the above, it was clear that what the user claimed in the application was not with bonafide intention.

In view of the above, the Tribunal allowed the application for cancellation and directed the Registrar to cancel the trademark No. 1047896 in class 11 from the Register of Trademarks.

10. Tags

① Type of trial	Cancellation proceedings before Intellectual Property Appellate Board (IPAB)
② Decision	Respondent No.1's impugned registration was cancelled
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

JAGUAR v. JAGUAR



1. Title	JAGUAR v. JAGUAR	
2. Country	India	
3. Court	Intellectual Property Appellate Board(IPAB)	
4. Case No.	OA/21/2008/TM/KOL, Citation - MIPR2013(2)187	
5. Date of the judgment	30.04.2013	
6. Parties: Appellant Respondents	M/s. Jaguar Cars Limited M/s. Manufacture Des Montres Jaguar S.A. and Deputy Registrar of Trademarks	
7. Mark	Appellant	Respondent (disputed trademark)
	JAGUAR	JAGUAR
8. Outline of the case		
<p>A case wherein the Respondent No. 1 claimed to be the proprietor of JAGUAR for watches and filed a trademark application for registration of trademark JAGUAR in class 14. The Appellant aggrieved by the dismissal of the Appellant's opposition against the said application, filed appeal before IPAB. The IPAB allowed the appeal of the Appellant holding that the application of Respondent No. 1 for registration of JAGUAR if allowed will dilute the distinctiveness associated with the Appellant's well-known trademark JAGUAR.</p>		
9. Summary of the judgment		
<p>The Appellant filed the present appeal seeking appeal of the order of the Deputy Registrar of Trademarks, Kolkata that dismissed the Appellant's opposition under No. Cal 55349 of the Respondent No. 1's application 557229 for the registration of trademark JAGUAR in class 14 with respect to "watches and parts thereof but excluding clocks".</p> <p>The Appellant is the owner of the trademark JAGUAR for cars and also for watches. The Respondent No. 1 had filed an application for registration of the impugned mark for watches on 21.08.1991 on a 'proposed to be used' basis. The Appellant coined the mark JAGUAR in 1938 and filed an application for watches in 1996. The Appellant held over 800 registrations worldwide for cars and other merchandise including watches under the trademark JAGUAR. As per the Appellant, the trademark 'JAGUAR' had been upheld as a well-known mark in numerous cases and in diverse jurisdictions including Japan, France, China etc.</p> <p>The Tribunal observed the main purpose of a trademark registration is to protect the distinguishing power of the trademark. The Act seeks to protect the commercial value of a mark that is registered. An infringer slowly whittles away the trademark's distinctiveness. Why was the Appellant herein so agitated? Their primary fear was that 75 years of brand building was being diluted by the use of an identical mark albeit for non-competing goods and thereby losing its capacity to signify a single source. The strength of the Appellant mark JAGUAR was not</p>		

in dispute. It was an instantly recognizable brand. The question was whether its reputation extended to products other than cars and automobiles. In India such protection is extended by the concept of a well-known mark. One of the legal effects of the various provisions relating to well-known marks embodied in the Act is that the registrar shall not register a trademark which is identical to an earlier trademark (which subsumes the concept of well-known mark) in a manner that is likely to have the effect of depreciating the value of goodwill attached thereto. These provisions have to be co-jointly read with the concept of trans-border reputation in India. The Appellant's apprehension here was that the Respondent No. 1 was enticing customers in India on the strength of the Appellant's fame, which would depreciate the value of the goodwill attached to the JAGUAR car, which in some jurisdictions would be regarded as reputation leeching and would be outlawed.

The Tribunal further observed that just because JAGUAR was a common dictionary word, it gave no license for any person to freely grab it for adoption and abuse without any regard to the market realities of how big that word has grown across nations. This was a good example of free riding on someone else goodwill.

As far as trademark classification is concerned, the Tribunal opined that classification is only an administrative tool for the registry for search purposes and is not a failproof test to eliminate likely market confusion.

In view of the above reasons, the Tribunal passed an order for refusal of application No. 695799 in Class 14.

10. Tags

① Type of trial	Appeal against the order of the Deputy Registrar
② Decision	Application for registration of JAGUAR in class 14 was refused
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

MAGGI v. MAGGI



1. Title	MAGGI v. MAGGI	
2. Country	India	
3. Court	Intellectual Property High Court	
4. Case No.	OA/12 to 14 & 19/2010/TM/MUM and M.P. No. 29/2010 Citation-2013(56) PTC94 (IPAB)	
5. Date of the judgment	31.05.2013	
6. Parties: Appellant	Societe Des Produits Nestle	
Respondents	Swaraj Industrial and Domestic Appliances Pvt. Ltd. & Ors.	
7. Mark	Appellant	Respondents (disputed trademark)
	MAGGI	MAGGI
8. Outline of the case		
A case in which the Respondents adoption was held to be contrary to honest trade practices and aimed at trading upon the goodwill and reputation of the Appellant.		
9. Summary of the judgment		
<p>The Appellant was aggrieved by the order dated 19.9.2009 passed by the Senior Examiner of Trademarks four oppositions and allowing Respondent No. 1 applications to proceed for registration as per trademark procedure.</p> <p>The Respondent No. 1 filed an application for registration of the trademark MAGGI in Class-11 with respect to electronic goods e.g. electric fans, heaters, geysers, bulbs, tube-lights, torches, exhaust fans, emergency lights, transformers, electric fittings, stabilizers, regulators, electric hot plates for cooking, fridges, air conditioners, water coolers etc., under Application No. 52532. The application was filed on 10.01.1990 claiming user since January, 1984. The said application was advertised in the Trademarks Journal No. 1129 dated 16.06.1996. This was opposed by the Appellants herein on various grounds.</p> <p>The Respondent No. 1 filed another application for registration of trademark MAGGI under No. 522533 in class-21 with respect to Domestic utensils, household articles etc. all being goods included in class 21 in January, 1990 and claiming users since January, 1984. This was advertised in Trademark Journal No. 1129 dated 16.6.1996. This was opposed for registration by the Appellants.</p>		

The Respondent No. 1 also filed an application for registration of the trademark MAGGI on January 1990 under No. 522531 in class-7 with respect to washing machines, grinding machines, mixers, juicers and slicer attachments and parts thereof claiming users since January 1984. The same was advertised in the Trademarks Journal No. 1129 dated 16.06.1996. The Appellants opposed said registration.

Respondent No. 1 on 22.03.1994 filed an application for registration of trademark MAGGI under No. 622735 in Class 8 with respect to hand tools and implements (hand-operated) and cutlery claiming users since August, 1992. It was advertised in the Trademark Journal No. 1299 dated 21.07.2003. The same was opposed by the Appellants herein.

The Senior Examiner of Trademarks heard all the four matters together and passed a common order whereby the objections under Sections 9 and 11 of the Act were rejected as the possibility of confusion among the public was less significant. Though the marks were identical, the goods were different. The Senior Examiner of Trademarks further observed that the objection under Section 11(2) were not accepted, as the opponents (appellants) had not proved that their trademark is a well-known trademark and therefore the objection under Section 11(10) was also not accepted. The Respondent No. 1's adoption was held not to be in bad faith.

After hearing both parties and upon consideration of evidence on record, the IPAB observed that Respondent No. 1 had no reason or explanation for adopting the trademark, MAGGI. The Appellants had established their business under the trademark MAGGI in India and abroad. The Appellants goods bearing the trademark MAGGI had thus acquired a good reputation and goodwill among the public and in trade. The Respondents adoption in such circumstances could not be said to be honest and it was only to trade upon the goodwill and reputation of the Appellants. IPAB further observed that permitting the Respondent No. 1 to carry on business under the trademark MAGGI would be approving their dishonest and willful conduct. This would also amount to encouraging the Respondent to practice fraud against the public. When the Respondents had no reason for their adoption, such adoption would not be allowed to be used or registered.

In view of the abovementioned observations, IPAB set aside the impugned order of the Senior Examiner and allowed the appeals.

10. Tags

① Type of trial

Appeal against the order of the Trademarks Registry (Senior Examiner of Trademarks)

② Decision	Order of the Senior Examiner of Trademarks was set aside
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

SONY v. abt SONY



1. Title	SONY v. abt SONY	
2. Country	India	
3. Court	Intellectual Property Appellate Board (IPAB)	
4. Case No.	OA/49/2007/TM/KOL, Citation- MIPR2014(1)95	
5. Date of the judgment	2013/10/25	
6. Parties: Appellants Respondents	M/s. Sony Kabushiki Kaisa & Anr. Mr. Purushottam Agarwal & Ors.	
7. Mark	Appellant	Respondent (disputed trademark)
	SONY	abt SONY
8. Outline of the case		
<p>An Appellant set up a wholly-owned Indian subsidiary SONY INDIA PVT. LTD. and was using the trademark "SONY" on all its products related to electronics, whereas the Respondent was admittedly using the trademark "abt SONY" in relation to undergarments. The Tribunal observed that incautious, ignorant and upcountry consumers were likely to be deceived. The main concept of both the marks hinged on SONY and therefore it was clear the Respondents were trying to take unfair advantage of the famous mark SONY to the detriment of the reputation of the Appellant and were going against honest practice in industrial or commercial matters.</p>		
9. Summary of the judgment		
<p>The Appellant herein were aggrieved by the refusal of the opposition filed by them against the registration of the trademark application No. 1255896 of the respondent by the Deputy Registrar of Trademarks and filed an appeal to oppose the order and decision dated 3rd July, 2007 permitting the registration of the respondent's trademark "abt SONY" in class 25.</p> <p>The Appellants were the registered proprietor of the trademark "SONY" in India in classes 3, 9, 14, 21 and 25. Appellants also claimed "SONY" was an internationally well-known trademark used and registered in over 200 countries. According to a survey conducted by Harris Interactive in 2006, Sony was registered as the "Best Brand" in the USA for the 7th consecutive year with an estimated brand value of over US \$15 billion.</p> <p>Appellants stated that they were the world leader in commercial, industrial electronic and entertainment businesses and had aggressively expanded their business outside Japan.</p>		

The Tribunal observed that the Deputy Registrar erred in holding that the Appellants were only dealing in electronic goods - ignoring the spillover effect of the goodwill and reputation of a well-known mark that travels across borders and across all type of goods. The Tribunal further observed that the essential features of the Respondent mark abt SONY include the whole of the appellants mark "SONY" with 'abt' used as a prefix in conjunction with SONY which is merely an alibi. The public and consumer will ask for SONY garments and not 'abt', possibly thinking it originates from SONY trademark owners. Incautious, ignorant and upcountry consumers were likely to be deceived. The main concept of both the marks hinged on SONY. It was clear the Respondent was trying to take unfair advantage of the famous mark SONY to the detriment of the reputation of the Appellant and was against honest practice in industrial or commercial matters. The inclusion of the word SONY in the Respondent's mark very prominently was completely and out rightly dishonest as the impugned mark included the whole of the Appellant's mark and stood out very prominently. These were unacceptable commercial behaviors and unfair on the basis of bad faith.

In view of the above, the Tribunal allowed the Appeal and the application No. 1255896 in class 25 was refused registration.

10. Tags

① Type of trial	Appeal before IPAB against the order of Deputy Registrar
② Decision	Deputy Registrar's impugned order was appealed
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

IRELAND

MARIE CLAIRE v. MARIE CLAIRE

1. Title	MARIE CLAIRE NETHERLANDS BV v. MARIE CLAIRE S.A AND BRANDWELL	
2. Country	Ireland	
3. Court	High Court of Ireland	
4. Case No.	No. 582SP _ 2013	
5. Date of the judgment	April 1, 2014	
6. Parties: Plaintiff Defendant	Marie Claire Netherlands BV. Marie Claire S.A and Brandwell	
7. Mark	Plaintiff (disputed trademark)	Defendant
	MARIE CLAIRE	MARIE CLAIRE
8. Outline of the case	A case law on trademark applications made in bad faith. The Irish High Court set out eighteen principles to be considered in assessing whether or not a trademark application was made in bad faith.	
9. Summary of the judgment	<p>In 1993, Brandwell applied to register the trademark Marie Claire for class 25. The application was opposed by two separate proceedings. In 1997, while these oppositions were pending, one of the opponents made its own Irish application for the same class. This Class 25 application was subsequently assigned to Marie Claire BV, the publisher of a magazine called Marie Claire. Marie Claire S.A. and Brandwell (the “opponents”) opposed this application at the Irish Patents Office on the basis that it was made in bad faith by the applicant. For that reason, the request of registration was rejected.</p> <p>In this judgment the Irish High Court provided a very full judicial consideration of what amounts to a trademark application made in bad faith.</p> <p>The judge undertook a comprehensive review of the case law on trademark applications made in bad faith and then went on to list a total of eighteen principles that he derived from the case law. The principles are the following:</p> <p>(1) Bad faith includes dishonesty;</p>	

- (2) Bad faith includes dealings that fall short of the standards of acceptable commercial behavior observed by reasonable and experienced people in a particular area;
- (3) A relevant factor in determining whether there is bad faith is whether there has been a failure by the person against whom a charge is levelled to address that charge;
- (4) Awareness that a party has been using an identical or similar mark for an identical or similar product in a least one EU Member State is not per se conclusive as to bad faith;
- (5) Consideration must be given to an applicant's intention at the time of filing an application for registration; intention to prevent a party from marketing a product may be an element of bad faith;
- (6) A key issue is whether a mark is being used for its essential purpose, being to aid consumers in distinguishing products;
- (7) The fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that such a sign enjoys some level of legal protection is a relevant factor when determining whether an applicant has acted in bad faith;
- (8) A person is presumed to have acted in good faith unless the contrary is proved;
- (9) An allegation of bad faith is a serious allegation which must be proved by cogent evidence on the balance of probabilities;
- (10) It is not enough when seeking to establish bad faith to prove facts that are also consistent with good faith;
- (11) Where a third party cannot maintain a relative ground of objection to registration, bad faith involves some breach of legal or moral obligation by the third applicant towards the third party;
- (12) Bad faith may exist where an applicant has sought or obtained registration of a trademark for use as an instrument of extortion;
- (13) Bad faith is not pertinent in a situation where there is a bona fide conflict between the trademark rights, or perceived rights, of different traders;
- (14) It is not bad faith for a party to seek a trademark where third parties are using similar marks and/or are using them for similar goods or services;
- (15) The fact that one party is aware of and has previously clashed with another is not the same as saying the trademark application by one of those parties is made in bad faith;
- (16) Seeking to protect one's commercial interests where one considers that one's activities do not impinge on the core activity of another is not bad faith;
- (17) Bad faith is the opposite of good faith; it generally involves (but is not limited to) actual or constructive fraud; it may merely involve a design to mislead or deceive or some other sinister motive; and
- (18) In determining whether there is bad faith, knowledge of third party use, an intention to prevent a third party marketing a product and the lack of intention to use a trademark, as well as extent of the reputation of

the third party's sign at the time of the application, are all relevant.

Having set out this very comprehensive list of principles, the judge was satisfied that the application by Marie Claire BV to register the mark MARIE CLAIRE was not tainted by bad faith. Instead, it was an “honest application by Marie Claire Netherlands to register a genuinely disputed mark.” Accordingly, the judge overturned the decision of the Patents Office that found Marie Claire BV to have acted in bad faith in making the application. These differing conclusions by the Irish Patents Office and the Irish High Court on the same evidence highlight the subjective nature of bad faith. It would appear that the High Court applied (4), (13), (14), and (15) of the above principles to the facts whereas the Patents Office applied (2), (5), and (7). Since the concept requires no less than eighteen principles to enunciate it properly, it is inevitable that there is abundant room for debate in any given case.

Like many other trademark laws, the Irish Trademarks Act requires the trademark applicant to state that the mark is being used or that there is a bona fide intention to use the mark. The Irish court characterized this as “a procedural requirement, not a substantive ground of objection.” (As noted in the eighteen-point list above, however, a lack of intention to use the mark can feature in a bad faith analysis.) In any event, there was no evidence before the Irish court of an absence of a bona fide intention to use the mark. The Court therefore rejected this ground of opposition.

Despite its successful defense of the first two opposition grounds, the applicant's mark was rejected in view of its perceived conflict with earlier rights. In a relatively straightforward application of the three-part test for passing off, the judge was satisfied that, through the substantial sales and promotion of their products in Ireland since 1992, the opponents had developed the requisite goodwill attaching to the mark MARIE CLAIRE.

10. Tags

① Type of trial	Suit in order to obtain the invalidation of the trademark
② Decision	
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

ISRAEL

SUJOK 

1. Title	Cancellation of the Trademark SUJOK	
2. Country	Israel	
3. Court	Trademark Registrar	
4. Case No.	Motion for cancellation of trademark No. 190390	
5. Date of the judgment	29/11/2016	
6. Parties: Cancellation Applicant Trademark Owner	Zvi Alfisher Yoad Puttermilech	
7. Mark	Cancellation Applicant	Trademark Owner (disputed trademark)
	_____	SUJOK
8. Outline of the case		
<p>Sujok is a combination of 2 words in Korean – “Su” and “Jok”, which means the palm of the hand and the foot respectively. Sujok is a technique of alternative medical treatment invented and developed by Prof. Jae Woo Park from South Korea.</p> <p>The cancellation applicant founded and owns Tehila College, where the Sujok technique has been taught and practiced. At the time the trademark owner applied for registration of the trademark, the cancellation applicant had been teaching the Sujok technique in his college in cooperation with Dr. Park, the inventor of Sujok.</p> <p>The cancellation applicant claimed that the application for registration of the trademark was filed in bad faith, since it was filed in order to become the sole owner of the trademark and to gain monopoly over the Sujok technique, preventing others from practicing or teaching Sujok, including Tehila College.</p> <p>The trademark owner contended that his application had been filed with Dr. Park’s knowledge and blessing. The fact that the trademark was registered only under the trademark owner’s name was due to technical reasons and did not derive from bad faith.</p>		
9. Summary of the judgment		
<p>The circumstances indicate that the fact that the trademark was registered only under the trademark owner’s name and not as a joint registration with Dr. Park was not due to technical reasons.</p> <p>Therefore, it appeared that the application of the trademark had been filed in order to become the sole owner of the trademark and to gain monopoly over the Sujok technique, preventing others from practicing or teaching Sujok.</p> <p>Based on a comprehensive evaluation of these facts, the trademark was cancelled.</p>		

10. Tags	
① Type of trial	Motion for cancellation of trademark
② Decision	Trademark was cancelled
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

ITALY

MANZANA v. BALORU MANZANA



1. Title	MANZANA v. BALORU MANZANA	
2. Country	Italy	
3. Court	Intellectual Property Court of Milan,	
4. Case No.	R.G. 21371/2012 _ Decision n. 5794/2016	
5. Date of the judgment	May 10, 2016	
6. Parties: Plaintiff	Not disclosed	
Defendant	Baloru s.a. and Uniontrade S.r.l.	
7. Mark	Plaintiff (disputed trademarks)	Defendant
8. Outline of the case	A case in which a Plaintiff registered in bad faith three trademarks exactly identical to three of a Defendant's trademarks, which were well known in Ecuador for several years and under development also in Italy.	
9. Summary of the judgment	<p>Baloru (the Defendant) is one of the most important Ecuadorean companies involved in the sector of production and commercialization of different kinds of fruit or vegetable juices, through different trademarks registered and used since 1970 in Ecuador, Latin America and U.S.A., including the three trademarks "MANZANA", "BALORU MANZANA" and "SABOR TROPICAL" shown above.</p> <p>When a lot of Ecuadorean people began to move to Europe in the first years after 2000, Baloru decided to extend</p>	

its business also to Europe and in particular in Italy: for this reason, Baloru filed and registered in the EU and in Italy the trademarks “BALORU MANZANA” and “MANZANA” in 2007 and “SABOR TROPICAL” in June, 2010.



The Plaintiff filed and registered three identical (or extremely similar) trademarks in Italy between August 2010 and March 2011 (in particular, the Plaintiff registered the trademark “TROPICAL” in Italy earlier than Baloru). Therefore, the Plaintiff decided to start a lawsuit against Baloru and its distributor Uniontrade, claiming damages for unfair competition and for infringement of its trademarks. Baloru and its distributors asked the Court for the invalidation of the Plaintiff’s trademarks, filed in bad faith, and for damages.

The Court recognized that the Plaintiff’s trademarks had been registered in bad faith and only to usurp the rights of Baloru in Italy. Therefore, the Court established that the Plaintiff’s trademarks were void and that its behavior was illicit.

10. Tags

① Type of trial	Suit to obtain the invalidation of trademarks and damages arising from counterfeiting and unfair competition behaviors
② Decision	Invalidation of the trademarks
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

HAVAIANAS v. HAVENA

1. Title	HAVAIANAS v. HAVENA	
2. Country	Italy	
3. Court	Intellectual Property Court of Turin	
4. Case No.	R.G. 635/2012	
5. Date of the judgment	July 11, 2014	
6. Parties: Plaintiff Defendant	Alpargatas S.A. Asian Trade S.r.l.	
7. Mark	Plaintiff (disputed trademarks)	Defendant
		
8. Outline of the case		
A case in which the Defendant registered in bad faith a trademark with awareness that this trademark caused confusion with goods connected with the Plaintiff's business.		
9. Summary of the judgment		
<p>Alpargatas (the Plaintiff) is one of the most important Brazilian companies involved, since 1962, in the sector of production and commercialization of flip-flops all over the world under the brand "HAVAIANAS".</p> <p>In 2010, the Italian Authority seized several flip-flops branded "HAVENA CLUB", produced and sold by Asian Trade (the Defendant) that were identical to Alpargatas' flip-flops under different aspects, among which was a very confusing figurative trademark.</p> <p>In 2011, Alpargatas and Asian Trade reached a settlement agreement under which Alpargatas undertook to cease the commercialization of the contested flip-flops and to withdraw, cancel and not use in the future the contested figurative trademarks.</p> <p>The day before the signature of the agreement, Asian Trade filed a new figurative trademark (that was not mentioned in the agreement) very similar to the previous ones and extremely similar to the well-known trademark "HAVAIANAS" of Alpargatas.</p> <p>When Alpargatas discovered the above new filing, it opened a law suit against Asian Trade in order to obtain a declaration of invalidity of the new trademark and claimed compensation for damages.</p>		

The Court explained that the contested trademark (and new one) had been registered by Asian Trade with awareness of its similarity to Alpargatas' trademarks and, moreover, in full awareness that this trademark caused confusion with goods connected with the Plaintiff's business. Therefore, the Court established that the last trademark, filed by the Defendant a day before the signature of the settlement agreement and not mentioned in it, had to be considered void for bad faith.

10. Tags

① Type of trial	Suit in order to obtain invalidation of the trademark and damages
② Decision	Invalidation of the trademark
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

KENYA

KENYA BOYS CHOIR v. KENYAN BOYS CHOIR



1. Title	In the Matter of Trademark No. 67586 “KENYA BOYS CHOIR” (Words) and opposition proceedings thereto by KENYAN BOYS CHOIR	
2. Country	Kenya	
3. Court	Kenya Industrial Property Institute Tribunal	
4. Case No.	N/A	
5. Date of the judgment	27 th February 2015	
6. Parties: Proprietor Applicant(s)	Joseph Muyale Inzai Kenyan Boys Choir: i. Henry Wanjala ii. Sylvester Matete Makob iii. Cliff Njora Njugun iv. Masambaya Fredrick Ndukwe v. Geoffrey Sauke	
7. Mark	Proprietor (disputed trademark)	Applicants
	“KENYA BOYS CHOIR”	“KENYAN BOYS CHOIR”
8. Outline of the case		
<p>This case was instituted through a cancellation application filed by the Kenyan Boys Choir (the Applicants) against trademark application number 67586 “Kenya Boys Choir” (Words) (the Trademark). The Trademark had been registered in Classes 16 and 41 under the name of Joseph Muyale (the Proprietor). The Applicants premised their application on, among others, the grounds that the registration of the Trademark was fraudulent or carried out in bad faith.</p>		
9. Summary of the judgment		
<p>The Kenyan Boys Choir was started in 1997 as the Aquinas High School Choir and with the Proprietor as the choir master and the Applicants as members. Its name was later changed to the Kenyan Boys Choir. The choir grew in size and stature and began to take part in several tours and performances using the name Kenyan Boys Choir. In 2010, the Proprietor successfully applied for and obtained registration of the mark “KENYA BOYS CHOIR”.</p> <p>The Applicants filed the trademark cancellation application on the grounds that they were the owners of the similar “THE KENYAN BOYS CHOIR” and “THE BOYS CHOIR OF KENYA” names and that they had obtained</p>		

registration of these names as business names. The Applicants argued that the Proprietor’s intention in registering the Trademark was to ride on the goodwill that the choir had garnered in Kenya and especially in the United States of America and to block the Applicants from obtaining bona fide registration of their marks.

The Registrar noted that the trademark registration application form filled by the Proprietor contained a claim for protection of several variants of the term “Kenya Boys Choir”. The Registrar was of the view that this conduct by the Proprietor indicated an attempt to bar the Applicants from using their name and any possible variants of the words ‘Kenya Boys Choir’. The Registrar also noted that the Proprietor and the Applicants (Kenyan Boys Choir) had entered into a tripartite agreement dated 18th February, 2010 with the Universal Music Classical Management & Production Limited of London and the Proprietor. This tripartite agreement related to a tour that the Kenyan Boys Choir was scheduled to undertake out of the country. The court noted that the Proprietor had signed this agreement, not as a member or proprietor of the Applicants (Kenyan Boys Choir) that he claims to have founded and legally owned but in his individual capacity as Joseph Muyale Inzai, T/A as the Musical Arts Academy of Nairobi. On this basis, the Registrar expressed the view that the Proprietor’s attempt to get exclusive rights over the Trademark and its variations demonstrated that the registration of the Trademark was not made in good faith and that a proprietary right obtained through bad faith cannot be protected. The Registrar went further to state as follows:

“...the claim for proprietorship of a trademark should be a justifiable one and that where such a claim cannot be made by the proprietor of the mark in good faith, then such a mark would be liable for expungement from the Register of Trademarks.”

Based on this, the Registrar ordered for the expungement of the mark from the Register of Trademarks.

10. Tags

① Type of trial	Application for the expungement of a mark from the Register
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

LATVIA

SAP HANA VS. HANA

1. Title	SAP HANA VS. HANA	
2. Country	Latvia	
3. Court	Patent Office of the Republic of Latvia, Board of Appeal	
4. Case No.	RIAP/2017/M 70 122-Ie	
5. Date of the judgment	28/06/2017	
6. Parties: Plaintiff	SAP SE	
Defendant	GRIGORIOUS HOLDINGS SIA	
7. Mark	Plaintiff	Defendant (disputed trademarks)
	SAP HANA	HANA
8. Outline of the case		
The Board of Appeals ruled that the Disputed Trademark had been registered with no factual intent to use on the part of the Defendant and had been registered in bad faith for malevolent economic purposes.		
9. Summary of the judgment		
<p>This case concerns a suit brought by the Plaintiff, a capital company registered in Germany, against the Defendant. The Defendant is a company registered in Latvia associated with the infamous Michel Gleissner, an entrepreneur who has made a business by registering high-profile trademarks that are similar or identical to high-value domain names, products and companies. The Disputed Trademark (<i>M 70 122</i>), the Plaintiff claimed, was very similar to its own trademark (<i>EUTM 009873365</i>). The Plaintiff argued that the registration of the Disputed Trademark may be used to exploit the European trademark system, as a previously-registered national mark such as the Disputed Trademark may be used to press a claim for a European Trademark against the legitimate interests of the real brand or product owner.</p> <p>Evidence was brought forth that the Defendant had not been engaged in any commercial activity since it was established. The only public action that the Defendant had taken for the duration of its existence as a company was the submission of trademark applications to the Patent Office of the Republic of Latvia. The applied-for marks were similar or identical to high-value, internationally recognizable trademarks or brand names. The Plaintiff noted that the Defendant was a party to more than two dozen concurrent proceedings with respect to the registration of such trademarks.</p> <p>The Court, outside of any bad faith considerations, noted that the Disputed Trademark had the potential to confuse</p>		

potential consumers, especially in consideration of the fact that the Defendant attempted to register the Disputed Trademark in the same category of goods and services as the marks of the Plaintiff. When evaluating whether the Defendant had acted in bad faith, the Court adjudged that the evidence was clear that it had the intention to malevolently exploit the similarity of the Disputed Trademark to the marks of the Plaintiff for economic gain. Furthermore, the Board concluded that the Defendant had no intention to commercially use the Disputed Trademark. The final determination was that the registration of the Disputed Trademark was done in bad faith, and thus considered invalid.

10. Tags

① Type of trial	Suit to oppose the registration of a trademark
② Decision	Registration of the Disputed Trademark held to be invalid
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

MALAYSIA

v.

1. Title	GS Yuasa Corp v. GBI Marketing Malaysia Sdn Bhd	
2. Country	Malaysia	
3. Court	Kuala Lumpur High Court (Intellectual Property)	
4. Case No.	24IP-48-12 OF 2015	
5. Date of the judgment	2 November 2016	
6. Parties: Plaintiff Defendant	GS Yuasa Corp GBI Marketing Malaysia Sdn Bhd	
7. Mark	Plaintiff	Defendant (disputed trademark)
	 (TM No. 98013472) (TM No. 00005524)	 (TM. No. 05005790)
8. Outline of the case	The Plaintiff applied to the High Court (“Court”) to expunge Defendant’s Trademark from the Register of Trademarks.	
9. Summary of the judgment	<p>The Plaintiff was a joint venture between Japan Storage Battery Co Ltd (“JSB”) and Yuasa Corp (“YC”). The Plaintiff was the first user of the trademark, “GS” (Plaintiff’s Trademark) in Malaysia. The Plaintiff’s Trademark was coined by adopting the first letters of the name of JSB’s founder. Since the 1960s, JSB has used the Plaintiff’s Trademark in Malaysia and sold storage batteries bearing the Plaintiff’s Trademark for cars and motorbikes to a distributor in Malaysia. The Plaintiff also registered the two trademarks depicted above in Class 9.</p> <p>The Defendant’s Trademark was registered by Osima Batteries Ind Sdn Bhd (‘OBI’) on 18 April 2005. The Defendant’s Trademark was later assigned and transferred by OBI to the Defendant. Plaintiff claimed that the Defendant was part of an “<i>international conspiracy</i>” which fraudulently applied for and obtained registration of trademarks in Malaysia and Indonesia for storage batteries which were deceptively and/or confusingly similar to the Plaintiff’s Trademark.</p> <p>The Court was of the view that the Plaintiff’s business was adversely affected by the use of the Defendant’s Trademark. The Defendant’s Trademark was likely to deceive and/or confuse the public to think that the Defendant’s goods bearing the Defendant’s Trademark originated from or were associated with the Plaintiff. Accordingly, the Defendant’s use of the Defendant’s Trademark caused grievance to the Plaintiff.</p>	

Based on a comprehensive evaluation of evidence and facts, the Court ordered that the Defendant's Trademarks be expunged from the Register of Trademarks on the following grounds:

- a) The original registration of the Defendant's Trademark had been obtained by fraud on the Registrar by OBI. Evidence showed that OBI had actual knowledge of the Plaintiff's Trademark and that it was not the common law owner of the Defendant's Trademark. OBI had copied or uplifted the Defendant's Trademark from the Plaintiff's Trademark. The Court also found that OBI, the Defendant and an Indonesia-based company had conspired to register trademarks in Malaysia and Indonesia which are deceptively and/or confusingly similar to the Plaintiff's Trademark;
- b) The trademarks in question shared a striking similarity, namely the alphabets 'G' and 'S' which were featured most prominently in the marks. The goods of interest by the Plaintiff and Defendant were the same. The use of the Defendant's Trademark on the Defendant's products was therefore likely to deceive and/or confuse the public to think erroneously that the Defendant's goods originate from or were associated with the Plaintiff; and
- c) The Defendant's Trademark was not distinctive of the Defendant's goods on the date of filing the suit as the Defendant had not produced any documentary evidence on the sales of the Defendant's goods. There was also a real likelihood of deception and/or confusion for use of the Defendant's Trademark.

Premised on the above, the Court ordered that the Defendant's Trademark be expunged (removed) from the Register.

10. Tags

① Type of trial	Suit to expunge (remove) registered trademark
② Decision	Invalidation (Expungement)
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

MYANMAR



STANDING CHINTHAY v. SITTING CHINTHAY & SITTING CHINTHAY & TWO

1. Title	K. E. Mohamed Ebrahim & Anr. v. The Taj Mahal Stationery Mart	
2. Country	Myanmar	
3. Court	Supreme Court	
4. Case No.	Civil Appeal 11 of 1950	
5. Date of the judgment	23.08.1952	
6. Parties: Appellants Respondents	K. E. Mohamed Ebrahim & Anr The Taj Mahal Stationery Mart	
7. Mark	Appellant	Respondent (disputed trademark)
	STANDING CHINTHAY (Lion) device mark	SITTING CHINTHAY device mark & SITTING CHINTHAY & TWO DRAGONS device mark
8. Outline of the case		
<p>The Appellants-Plaintiffs were engaged in the business of import and wholesale of various classes of goods, including exercise books under a “Standing Chinthay (Lion)” device mark. The said trademark is well-known. The Respondents began selling stationary articles such as exercise books and pocket notebooks in Rangoon and other parts of Burma using a “Sitting Chinthay” device as well as a “Sitting Chinthay & Two Dragons” device, which the Appellants claimed were fraudulent and a colorable imitation of the Appellant’s Chinthay trademark.</p> <p>The Appellants filed a suit for passing off before the Trial Court. The Respondent argued that the said Lion device was a common mark used almost everywhere in Burma and there could not be any exclusive rights therein. Further, there was no scope for confusion or deception. The Trial Court, however, decreed that the suit granted an injunction against the Respondent with respect to both the marks and for all articles of stationary.</p> <p>On appeal, the Appellate Civil Court reversed the order of the Trial Court holding that, although there was exclusive right over the device mark with respect to exercise books, this did not give the Plaintiffs a monopoly over all kinds of stationery. Furthermore, the Respondent’s device mark, which consisted of additional prominent features such as the Two Dragons Device could not be mistaken for the Appellants’ mark. The injunction therefore was limited to only exercise books with respect to the Sitting Chinthay Device only. The Appellants therefore filed an appeal before the Supreme Court which slightly modified the decree.</p>		
9. Summary of the judgment		
<p><u>Appellate Civil Court:</u></p> <p>The Appellate Court noted that since there was no system of registration of trademarks or a statutory title to a trademark in Myanmar, the rights of parties in such cases must be determined by Common Law. It did not make any difference if the customers did not know the name of the entity selling a product under a trademark</p>		

so long as they were able to identify the goods under that mark from goods from other sources. The exclusive right over the Chinthay trademark with respect to exercise books did not give the Appellants a monopoly of the said trademark over all kinds of stationery.

Supreme Court:

The Supreme Court agreed with the Appellate Civil Court’s finding that the Respondent’s trademark consisted of additional features, which were prominent, and could not be mistaken for the Appellants’ mark. It, however, noted that there was sufficient evidence to show that the Appellants had established rights to the Chinthay trademark with respect to diaries in addition to exercise books.

The Supreme Court affirmed the decision of the Appellate Court subject to the variation that the Appellants were entitled to relief with respect to the impugned Chinthay mark for exercise books as well as diaries.

10. Tags

① Type of trial	Appeal against the decree of Civil First Appeal
② Decision	The Supreme Court affirmed the decision of the Appellate Civil Court.
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

RANGOON OPTICAL WORKS v. RANGOON OPTICAL WORKS



1. Title	Ko Maung v. B Lall	
2. Country	Myanmar	
3. Court	Civil Appellate Court	
4. Case No.	Civil 2 nd Appeal 17 of 1962	
5. Date of the judgment	09.06.1962	
6. Parties: Appellants Respondents	Ko Maung Ngwe (Defendant in the first instance) Mr. B. Lall (Plaintiff in the first instance)	
7. Mark	Appellant	Respondent (disputed trademark)
	RANGOON OPTICAL WORKS	RANGOON OPTICAL WORKS

8. Outline of the case

The Plaintiff (Respondent) had been selling spectacles in the cities of Prome & Paungde under the trademark RANGOON OPTICAL WORKS for the past 20 years and filed a suit against the Defendant (Appellant) for using the trademark RANGOON OPTICAL WORKS for spectacles. The Trial Court refused the injunction on the grounds that Rangoon was a geographical term that was not distinctive and that the Plaintiff could not claim a proprietary interest in the same. On appeal, the First Appellate Court reversed the ruling on the grounds that the term “RANGOON OPTICAL WORKS” was descriptive and distinctive and the Plaintiff had acquired goodwill and reputation therein, entitling protection. The Defendant therefore preferred an appeal to the Civil Appellate Court, which was dismissed.

9. Summary of the judgment

The Appellate Court noted that, although there was a bar on registration in the UK and Indian Trademark Statutes against names that indicate the place of manufacture and sale, a word was not a geographical term merely because it was the name of a place on Earth. The Court noted that it was settled law that geographical names disconnected from the origin of the goods were not indicative of the place of manufacture and were in fact distinctive.

The Court held that a name may become a trade denomination and, as such, the property of a particular person who first used it for an article of manufacture. The Plaintiff had been using RANGOON OPTICAL WORKS for the past 20 years on spectacles manufactured by him in Prome. The Defendant’s subsequent use was clearly intended to deceive the public and misappropriate the goodwill and reputation of the Plaintiff.

10. Tags	
① Type of trial	Appeal from a decision of the District Court
② Decision	The Appellate Court affirmed the decision of the Trial Court and granted injunction to the Plaintiff.
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	


Trademark depicting elephant and lion with “Ko Kyaw”

1. Title	U Kyaw v. U Ba Aye	
2. Country	Myanmar	
3. Court	Criminal Appellate Court	
4. Case No.	Criminal Appeal 252 of 1959	
5. Date of the judgment	18.07.1962	
6. Parties: Appellants Respondents	U Kyaw U Ba Aye	
7. Mark	Appellant	Respondent (Disputed trademark)
	Two animals, viz., elephant and lion with “Ko Kyaw” printed between the pictures of the two animals	Two animals, viz., elephant and lion with “Ko Kyaw” printed between the pictures of the two animals
8. Outline of the case		
<p>The Appellant (Complainant) claimed to be the owner of the trademark depicting “two animals, viz., elephant and lion with the name Ko Kyaw printed between the pictures of the two animals” on a mechanical lighter. The Appellant’s mark was in use for 3-4 years and was registered for 2 years prior to the complaint. A suit was filed in trial court alleging that the Respondent was selling and manufacturing mechanical lighters with an identical mark, which amounted to an offence under Section 483 of the Penal Code. The accused (Respondent) claimed that he had merely bought the impugned lighters and did not manufacture the same.</p> <p>The trial court acquitted the Respondent on the grounds that the Appellant was unable to prove beyond reasonable doubt that he was the exclusive owner of the trademark or that the accused was manufacturing the mechanical lighters under the said trademark. The Appellant thereafter filed a Revision before the Appellate Court, which upheld the decision of the Trial Magistrate.</p>		
9. Summary of the judgment		
<p>The Appellate Court noted that it was settled law that in Burma there is no method by which a trademark may be registered, but property in, or right with respect to the mark, may be acquired by the owner. Therefore, the fact that the Complainant had obtained his mark and registered was not a relevant factor and did not give him any right of property over the mark. There were many other persons using similar/identical mark with respect to mechanical lighters as submitted by a witness. The aforesaid also corroborated the accused Respondent that he had only bought the lighters and had not manufactured it, thus, there was no intention to defraud on the part of the accused.</p>		

10. Tags	
① Type of trial	Appeal from decision of Trial Court
② Decision	The Appellate Court affirmed the decision of the Trial Court on merits
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

NEW ZEALAND

TOMTOM And v TOM TOM



1. Title	TOMTOM COMMUNICATIONS LIMITED V TOMTOM INTERNATIONAL B.V.	
2. Country	New Zealand	
3. Court	High Court	
4. Case No.	[2015] NZHC 3333	
5. Date of the judgment	2015/12/18	
6. Parties: Appellant Respondent	TOMTOM COMMUNICATIONS LIMITED AND GAYLENE RUTH HOSKING TOMTOM INTERNATIONAL B.V.	
7. Mark	Appellant (disputed trade mark)	Respondent
	TOMTOM And 	TOM TOM
8. Outline of the case		
<p>A case in which the Court agreed with the earlier decision of the Assistant Commissioner and held that there was no evidential basis for the contention that the respondent was attempting to game the system with successive applications in a bid to put the appellant to significant costs and swamp the appellant in the market place. Therefore, there was no evidence of bad faith.</p>		
9. Summary of the judgment		
<p>The appellant, Ms. Hosking, began trading under the name TomTom in 1998 and was the registered owner of the TOM TOM mark. TomTom Communications was incorporated in 2001 and had used the mark under license since then. It provided a number of services such as public relations, media strategies, communications, promotion and branding advice.</p> <p>The respondent was a global company head-quartered in the Netherlands that provides navigation and mapping products and services. The respondent began selling portable navigation devices in New Zealand in 2007 and quickly began to expand the goods and services it provided to the New Zealand market.</p> <p>The appellant alleged, among other grounds of opposition, that the respondent's application had been made in bad faith. This allegation was based on the fact that the respondent applied to register that same marks in 2006 and 2007 only to withdraw the applications following</p>		

opposition from the appellants and then go on to make the application for which this case was concerned. The appellant alleged bad faith arose from the abandonment and re-filing for the same core goods and services with knowledge that there was a significant amount of evidence of deception and confusion and the new application failed to address these issues. It was alleged the respondent was aware that it would benefit from filing new applications by putting the appellants to significant cost and swamping the appellants in the market place due to the respondent's size and resources.

The Court agreed with the Assistant Commissioner's earlier finding that there was no evidence to justify the inference that the appellant was relying on. There was no evidential basis for the contention that the respondent was attempting to game the system with its successive applications.

10. Tags

① Type of trial	Appeal of decision to grant respondent's applications.
② Decision	Unsuccessful
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

1. Title	ZOGGS INTERNATIONAL LTD V SEXWAX INC	
2. Country	New Zealand	
3. Court	High Court, Wellington	
4. Case No.	[2013] NZHC 1494	
5. Date of the judgment	2013/6/20	
6. Parties: Appellant Respondent	ZOGGS INTERNATIONAL LTD SEXWAX INCORPORATED	
7. Mark	Appellant (disputed trade mark)	Respondent
		
8. Outline of the case		
<p>An appeal against the decision of the Assistant Commissioner, who ruled that appellant’s application had been made in bad faith. The appellant was successful in overturning this decision and it was held that the application had not been made in bad faith as there was no evidence to show that there was any arrangement between the appellant and the respondent that the application at issue could have breached. The Court found that at most the evidence was indicative of communications made on which there was no reliance or change of position.</p>		
9. Summary of the judgment		
<p>The respondent trades as its primary product Mr Zog’s Sex Wax which was held to have a reputation in the surfing market in New Zealand. The respondent’s owner deposed that he had used the name Zog in connection with this business for 38 years.</p> <p>The appellant was established in Australia in 1992 and originally sold swimwear goggles with the name Zoggs being an abbreviation of goggles. From 1994 the goggles were sold in New Zealand. The appellant then began manufacturing and marketing swimwear aimed at the recreational swimming pool market under the name “Zoggs Toggs” and eventually as Zoggs. The appellants application in dispute was for the registration of Zoggs in class 25 to replace the Zoggs Toggs mark.</p>		

The Assistant Commissioner had upheld the respondent's objection to the appellant's application on the basis that, among other things, it was made in bad faith.

The respondent's allegations of bad faith were based on several underlying facts. In 1992, the appellant had approached the respondent prior to its Australian registration for goggles to obtain an agreement that the respondent would not oppose the registration. The respondent alleged that as the appellant had at that time promised to limit its products to swimming goggles it did not oppose the initial registration in class 9. Despite this and assurances that ZOGGS would not be used in relation to surfing, the respondent alleged that the application and further investigations showed that this was not true and this amounted to bad faith.

The appellant argued that the 1992 conversation was concerned with Australia only, that a 2009 assurance that it would not move into the surfing items covered by class 25 related only to its proposed US application and that no formal agreement ever existed that it would limit its goods and business reach and inform the respondent of developments. The Assistant Commissioner found that the appellant had made the application in bad faith because it had been aware since 1992 of the respondents branding, that the respondent believed until 2007 that the appellant would limit its ZOGGS trade mark to swimming goggles as agreed in the 1992 agreement, and that before filing in New Zealand, the appellant had indicated that the ZOGGS brands would not be used in relation to surfing products in class 25.

The Court allowed the appeal against the finding of bad faith. The Court found that the Assistant Commissioner was wrong to hold that the 2009 email related strictly to the ZOGGS brand and not strictly the appellants US application. Furthermore, the email was not in fact relied on by the respondent. The Court held that an offer made during negotiations which is not accepted cannot be held to be binding on the appellant so as to support a finding of bad faith for acting against it. The Court also found that the 1992 agreement did not suggest it went beyond the Australian application. Ultimately, there was no evidence to show that there was any arrangement between the appellant and the respondent that the application at issue could have breached. The Court found that at most the evidence was indicative of communications made on which there was no reliance or change of position (except the 1992 registration).

10. Tags

① Type of trial

Appeal of decision to grant respondent's applications.

② Decision	Unsuccessful
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

THE COOK



1. Title	COOK BROTHERS INTERNATIONAL LTD V ORARI STREET PROPERTIES INVESTMENTS LTD	
2. Country	New Zealand	
3. Court	Intellectual Property Office	
4. Case No.	[2014] NZIPOTM 9	
5. Date of the judgment	2014/2/17	
6. Parties: Applicant Opponent	COOK BROTHERS INTERNATIONAL LTD ORARI STREET PROPERTIES INVESTMENTS LTD	
7. Mark	Applicant (disputed trade mark)	Opponent
	THE COOK	
8. Outline of the case		
A case where the applicant applied to register a trade mark for a tavern. The application was made in bad faith as it was not the owner of the trade mark at the time and it would deprive the owner of the mark of the benefit of the registration.		
9. Summary of the judgment		
The Opponent had purchased a building which was trading as The Captain Cook Tavern. The building was subject to a lease. Two companies, DB Breweries Limited and Stab in the Dark Limited, entered into a sublease for the premises and eventually, upon the ending of the earlier lease, DB Breweries entered into a new lease for the premises on its own. The Applicant later purchased the business of the Captain Cook Tavern from DB Breweries. The Applicant believed this included the trade mark but later discovered the mark was not registered and accordingly applied to register it. The Applicant maintained that when the lease was due to expire it was looking for a solution that would allow it or a new owner to operate the business but could not find a resolution. It then considered options such as using the Cook brand at a new premises or selling it. The Applicant maintained that simply owning the building did not give the Opponent the right to the trade mark and such a matter should have been stipulated in the lease agreements. The Opponent submitted that the application was made in bad faith because the Applicant was not the proprietor of the mark and the		

application was made to block other traders and prevent such a trader from using the mark at the premises of The Cook. The Opponent alleged that the Applicant had knowledge at the time of application that it would be unable to continue to occupy the premises of The Cook/The Captain Cook.

The Examiner held that the application was made in bad faith. This was based on a number of findings. The Examiner found that the applicant was not the owner of the opposed mark as Stab in the Dark Limited had a prior assertion to ownership and the applicant was not incorporated as a company at the time it bought the Tavern and alleged to have gained the rights to the mark. The Examiner found that Stab in the Dark Limited was operating the Tavern not the applicant and it did not consent to the sale of the Tavern nor to the trade mark application. Ultimately, registration of the mark would deprive Stab in the Dark Limited of the benefit of the registration of the opposed mark. The Examiner found that in those circumstances, the conduct of the applicant was short of reasonable standards of commercial behavior and was, therefore, made in bad faith.

10. Tags

(1) Type of trial	Opposition of registration of trade mark
(2) Decision	Successful
(3) Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

CLIMATE PRO v CLIMATE PRO



1. Title	SAFE-R INSULATION (NZ) LTD V JOHNS MANVILLE CORPORATION	
2. Country	New Zealand	
3. Court	Intellectual Property Office	
4. Case No.	[2014] NZIPOTM 20	
5. Date of the judgment	2014/4/29	
6. Parties: Applicant Opponent	JOHNS MANVILLE CORPORATION SAFE-R INSULATION (NZ) LTD	
7. Mark	Applicant	Opponent (disputed trade mark)
	CLIMATE PRO (Common law right)	CLIMATE PRO
8. Outline of the case		
<p>A case where the opponent registered CLIMATE PRO in relation to insulation products after its distributorship relationship ended with the applicant. It was held that the opponent must have known of the rights the applicant had in the mark and that it would block the applicant from the benefit of registration and disrupt the applicant's business. The applicant was successful in its argument that the application was made in bad faith.</p>		
9. Summary of the judgment		
<p>The applicant had been selling insulation products in New Zealand through distributors, including those branded CLIMATE PRO. It was the owner at common law of the CLIMATE PRO trade mark in relation to residential insulation in New Zealand. The opponent, who was the owner of the trade mark at issue, had been since 1998 a distributor of the applicant's CLIMATE PRO products in New Zealand. The opponent ceased to be the distributor by, at the latest, 5 September 2012. On that date the opponent applied to register the trade mark CLIMATE PRO in New Zealand and sought to negotiate new terms with the applicant. The applicant alleged that after registration the opponent threatened the applicant's other New Zealand distributor with an allegation it was infringing the CLIMATE PRO mark. The applicant alleged that as the opponent had been distributing the applicant's products in New Zealand it could not claim to be the owner of the CLIMATE PRO mark.</p> <p>The Assistant Commissioner agreed with these facts and held that due to the relationship</p>		


between the parties, the opponent knew of the applicant's ownership of the CLIMATE PRO mark and ought to have known that registration of the CLIMATE PRO mark would deprive the applicant of the benefit of registration and disrupt the applicant's business. The Assistant Commissioner found that the opponent's application for registration of the CLIMATE PRO mark was conduct that fell short of reasonable standards of commercial behavior and was made in bad faith.

10. Tags	
(1) Type of trial	Application for declaration of invalidity
(2) Decision	Successful
(3) Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

**and MSpa v MSpa**

1. Title	BAKER V ORIENTAL RECREATIONAL PRODUCTS (SHANGHAI) CO LTD	
2. Country	New Zealand	
3. Court	Intellectual Property Office	
4. Case No.	[2016] NZIPOTM 15	
5. Date of the judgment	2014/4/29	
6. Parties: Applicant Opponent	ORIENTAL RECREATIONAL PRODUCTS (SHANGHAI) CO LTD PAUL BAKER	
7. Mark	Applicant	Opponent (disputed trade mark)
	 And MSpa	MSpa
8. Outline of the case		
<p>A case where the applicant sought a declaration of invalidity due to, among other grounds, the application being made in bad faith. It was held that the application had been made in bad faith as the opponent knew at the time of registration that the applicant used the  mark for the relevant goods. Ignorance as to the illegality of his actions was not enough to stop that conduct from being below the reasonable standards of commercial conduct.</p>		
9. Summary of the judgment		
<p>The applicant had sold portable spa pools under the MSpa trade mark in New Zealand since 2007. It had registered trade marks in a number of countries worldwide. It alleged that it had approached the opponent through an intermediary in 2012 with the intention to secure him as a partner to handle the after sales service in New Zealand. The opponent filed the trade mark application in question four days before initial contact with the applicant. The parties subsequently signed an agreement authorizing the opponent's company as the authorized sales agent for the applicant's products.</p> <p>The opponent's evidence could not be admitted. However, it could be determined that the opponent claimed to have taken what he described as a prudent business decision to protect the applicant's intellectual property and marketing investment by registering the trade mark</p>		

in dispute.

The Assistant Commissioner held that at the time of the application for registration the opponent knew that the applicant used the trade mark  for the goods that he was intending to distribute. The Assistant Commissioner acknowledged that the opponent may not have known that the intellectual property in the trade mark was owned by the applicant and that it was not open to him to assert ownership. However, the fact that the opponent may have thought that his actions were acceptable was not a defence of the conduct that fell below the reasonable standards of commercial conduct. The Assistant Commissioner found that the opponent had acted in bad faith in making the application.

10. Tags

① Type of trial	Application for declaration of invalidity
② Decision	Successful
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

ECOTRICITY V ECOTRICITY

1. Title	YATES V ECOTRICITY GROUP LTD	
2. Country	New Zealand	
3. Court	Intellectual Property Office	
4. Case No.	[2018] NZIPOTM 3	
5. Date of the judgment	2018/1/12	
6. Parties: Applicant Owner	Ecotricity Group Ltd Alistair Yates	
7. Mark	Applicant	Owner (disputed trade mark)
	ECOTRICITY	ECOTRICITY
8. Outline of the case		
A case in which the owner's registered trade mark was directed to stay on the register and the applicant's application for a declaration of invalidity was declined as the grounds for a breach of faith were not made out.		
9. Summary of the judgment		

The applicant was a British renewable energy generator and supplier. The applicant had applied for a New Zealand trade mark for ECOTRICITY but had been blocked by the owner's registered mark.

The owner was the co-founder of the New Zealand company Ecotricity Limited which retailed renewable energy to commercial and residential customers in New Zealand. The owner owned the New Zealand trade mark ECOTRICITY.

The applicant alleged that, in addition to the owner's mark being likely to confuse or deceive customers, the owner's mark had been made in bad faith. This was based on allegations that the owner had sought from the applicant, and been refused, permission to register the ECOTRICITY mark in New Zealand and had sought to obtain without payment the applicant's trade mark, business model, materials and association.

The applicant's claim was not made out. It was held that there was no real evidence of bad faith. The owner's evidence was that he had come up with the mark independently. The Assistant Commissioner held that even if the owner had not come up with the mark independently, this alone would not have been enough to establish bad faith. The Assistant Commissioner further held that contact between the parties that occurred six months after the owner's application for the trade mark (and 12 days after its acceptance) was not evidence of an intention to obtain the mark in bad faith and was nothing more than an intention by the owner to cooperate for mutual benefit. It was held that the owner's conduct was not evidence of dealings that fall short of reasonable standards of commercial behavior (the relevant test in New Zealand).

10. Tags

① Type of trial	Application for declaration of invalidity
② Decision	Unsuccessful
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

PAKISTAN

Power Sonic v Power Sonic



1. Title	Javed Akhtar Chauhan v JKS (Private Limited) and others	
2. Country	Pakistan	
3. Court	High Court of Sindh	
4. Case No.	H.C.A No. 357 of 2015	
5. Date of the judgment	2016/06/08	
6. Parties: Plaintiff Defendant	Javed Akhtar Chauhan JKS (Private Limited) and others	
7. Mark	Plaintiff	Defendant (disputed trademark)
	Power Sonic	Power Sonic
8. Outline of the case		
A case in which the Plaintiff's registered trademark was determined as having been obtained contrary to the ethics of business and liable to cause confusion with goods connected with another person's business.		
9. Summary of the judgment		
<p>The Appellant established a business relationship with Power Sonic Corporation, a US-based company ("the Company") in 2002. The Appellant was the distributing agent of the Company's batteries. Counsel for the Company stated that sometime in 2011, the Appellant started delaying payments to the Company and eventually stopped paying them altogether. The Company then appointed JKS Private Limited (the Respondent No. 2) as their official distributor in 2013. During this time, the Appellant registered a mark identical to the Company's mark. Based on this registration, the Appellant sought an injunction from the Court against the import of the Company's goods. This was the first time that the Company became aware of the Appellant's registration (a colorful imitation of the Company's mark). As a countermeasure, the Company made an application through Respondent No. 2 asking for a declaration against the deceptively similar mark. The Learned Single Judge refused to grant the Appellant's injunction application and allowed the Company's application for declaration against the local registration of their Trademark. The Appellant then appealed. The Court, after listening to both sides, concluded that this was a simple case of dishonest adoption and cited sub-section (4) of Section 14 of the 2001</p>		

Ordinance stating that applications for registration of a trademark which were made in bad faith have to be Power Sonic refused by the Trademarks Registry.

10. Tags	
<input type="checkbox"/> Type of trial	Suit for trademark infringement and passing off
<input type="checkbox"/> Decision	Appeal
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

PARAGUAY

CHOCOCHIPS vs. CHOCOCHIPS



1. Title	EL TRIGAL S.A. vs. BAGLEY ARGENTINA S.A. ON NULLITY OF TRADEMARK REGISTRATION	
2. Country	Paraguay	
3. Court	Final Judgement: Supreme Court of Justice	
4. Case No.		
5. Date of the judgment	June 23 rd , 2006	
6. Parties: Plaintiff Defendant	El Trigal S.A. Bagley Argentina S.A.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	CHOCOCHIPS	CHOCOCHIPS
8. Outline of the case		
9. Summary of the judgment	<p>On date June 23rd, 2006, EL TRIGAL S.A. filed a nullity action against Trademark Registration No. 290.090, trademark “CHOCOCHIPS”, in the name of BAGLEY ARGENTINA S.A. Said Company alleged that it was the owner of such mark in its country of origin, Uruguay, as of the date September 27th, 1988, and that the same had made its trademarks known (advertised) by different means and had utilized its trademark since 1986 in Uruguay and in other countries.</p> <p>The Claimant also sustained that the mark CHOCOCHIPS was notorious in Paraguay since its first import in the year 2004, and also that the mark was registered in several countries, including Paraguay; however, such registration had lapsed by the time the trademark in the name BAGLEY ARGENTINA S.A. was registered and the nullity action was filed. According to the Claimant, such a <i>slip</i> (namely, the non-renewal of the trademark) was taken advantage of by the Defendant, who <i>in bad faith</i>, registered the trademark in its own name.</p> <p>The Defendant responded to the Claimant’s action alleging that TRIGAL S.A. was not the creator of the mark CHOCOCHIPS given the fact that the Defendant itself, BAGLEY ARGENTINA S.A., had had the trademark registered since the year 1980. The firm also alleged that the same had not acted “in bad faith”, due to the fact that it had applied for registration of the mark three years after</p>	

the registration of the name of EL TRIGAL S.A. had lapsed.

The court determined that what was to be resolved was the following: 1) Which firm had the best right to the mark; and 2) Whether the Defendant had acted in bad faith upon registration of the mark.

After analyzing the applicable legislation, the doctrine and the evidentiary material submitted during the case, the Court concluded that, *undoubtedly and unmistakably*, EL TRIGAL S.A. was the original owner of the mark CHOCOCHIPS.

The Court placed particular importance on the provisions of the Paris Convention and the fact that EL TRIGAL

S.A. had already made consistent and continuous use of the trademark throughout the Paraguayan territory.

The nullity action was accepted due to the fact that the Claimant proved that it had a better rights over the term CHOCOCHIPS due to the fact that the firm was the legitimate owner in its country of origin. Even though the registration had lapsed in Paraguay, it had still been used without opposition in businesses related to the field. Such circumstances should have been known by the Defendant and proved its *lack of good faith*.

The Resolution was revoked by the Civil Court of Appeals but confirmed by the Supreme Court of Justice.

10. Tags

① Type of trial	
② Decision	
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

PERU

BIOTRONIK v. BIOTRONIK



1. Title	Opposition filed by BIOTRONIK SE & Co. KG against trademark application "BIOTRONIK" (word mark) in the name of Flores Haboud Tamer Ricarte	
2. Country	Peru	
3. Competent authority (administrative proceeding)	Peruvian Trademark Office	
4. Case File No.	616641-2015	
5. Date of the decision	2015/12/23	
6. Parties: Applicant Opponent	Flores Haboud Tamer Ricarte BIOTRONIK SE & Co. KG	
7. Mark	Applicant (disputed trademark)	Opponent
	BIOTRONIK	BIOTRONIK
8. Outline of the case		
<p>The opponent, a German manufacturer of cardio- and endovascular medical devices, was the owner of the trademark BIOTRONIK in various countries around the world, including the US and several countries of the European Union. Until the 1st April 2015 the authorized distributor of the opponent in Peru was BIOMEDICAL DISTRIBUTORS S.A.C. – BIOMEDIST, and even though the commercial relationship with BIOMEDICAL DISTRIBUTORS S.A.C. – BIOMEDIST had been terminated by the opponent, the Applicant, who was the general manager of BIOMEDICAL DISTRIBUTORS S.A.C. – BIOMEDIST, filed – without any authorization by the opponent – an application for the trademark BIOTRONIK in his own name.</p> <p>The Applicant's trademark BIOTRONIK was opposed, among others, on the grounds of bad faith/unfair competition in the sense that the Applicant's mark was filed in bad faith with the evident purpose of appropriating the mark of a third party with full knowledge of the fact that said mark was of a third party's property.</p>		
9. Summary of the judgment		
The Peruvian Trademark Office determined that from the evidence provided by the opponent, it had been proven that the Applicant's act, in particular the filing of the application for the		

“BIOTRONIK” trademark, evidenced bad faith and was to be regarded as an intent to perpetrate, facilitate or consolidate acts of unfair competition.

According to the Peruvian Trademark Office, the Applicant did file the application for the “BIOTRONIK”

trademark with the evident purpose of appropriating the mark of a third party in full knowledge of the fact that said mark was of a third party’s property.

Furthermore, in its decision, the Peruvian Trademark Office also pointed out that the Applicant did file the application for the “BIOTRONIK” trademark, taking advantage of a preexisting business relationship with

BIOTRONIK SE & Co. KG, and in doing so the Applicant was seeking to appropriate a sign that was liable to be confused with the one previously held by BIOTRONIK SE & Co. KG.



10. Tags

① Type of trial	Trademark opposition brought before the Peruvian Trademark Office through administrative proceeding
② Decision	Refusal of trademark application
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	



v. P.F. CHANG'S



1. Title	Opposition filed by P. F. Chang's China Bistro, Inc. against trademark application "P.F. CHANG'S" and logo (composite mark) in the name of Veronica Pflucker Pinillos	
2. Country	Peru	
3. Competent authority (administrative proceeding)	Peruvian Trademark Office	
4. Case File No.	456557-2011	
5. Date of the decision	2012/05/28	
6. Parties: Applicant Opponent	Veronica Pflucker Pinillos P. F. Chang's China Bistro, Inc.	
7. Mark	Applicant (disputed trademark)	Opponent
		
8. Outline of the case		
<p>The opponent, a known American restaurant chain with more than 200 restaurants worldwide, was the owner of the trademark P.F. CHANG'S in various countries around the world, including the US. The Applicant filed in her own name a trademark that, in an identical manner, reproduced the words and graphical elements of the opponent's registered mark, identifying the same services that were covered by the opponent's registered mark.</p> <p>The Applicant's trademark, P.F. CHANG'S, was opposed, among others, on the grounds of bad faith/ unfair competition in the sense that the Applicant's mark was filed in bad faith with the evident purpose of appropriating the mark of a third party in full knowledge of the fact that said mark was of a third party's property.</p>		
9. Summary of the judgment		
The Peruvian Trademark Office determined that from the material provided by the opponent it was proven that the Applicant's act, in particular the filing of the application for the P.F. CHANG'S trademark, evidenced bad faith.		

The position of the Peruvian Trademark Office was that there was sufficient evidence indicating that by the time the Applicant filed the application for P.F. CHANG'S trademark, the Applicant may have had previous

knowledge of the existence of the opponent's trademark P.F. CHANG'S, and also may have known that the identity between the conflicting marks was not the result of mere coincidence. According to the Peruvian Trademark Office, the Applicant's filing of a trademark that, in identical manner, reproduced the words and graphical elements of the opponent's registered mark was intended to cause harm to the opponent, since the evident purpose was to appropriate the mark of a third party.

Further, the decision to reject the trademark applied for was sustained based on the fact that the Peruvian Trademark Office had determined that the Applicant's trademark did affect the existing copyrights of P. F. Chang's China Bistro, Inc.

10. Tags

① Type of trial	Trademark opposition brought before the Peruvian Trademark Office through administrative proceeding
② Decision	Refusal of trademark application
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



v.




1. Title	Nullity action filed by Panasonic Corporation against trademark registration “PERUSONIC” and logo (composite mark) in the name of Video Disc Center S.R.L.	
2. Country	Peru	
3. Competent authority (administrative proceeding)	Peruvian Trademark Office	
4. Case File No.	383137-2009	
5. Date of the decision	2014/03/31	
6. Parties: Petitioner Defendant	Panasonic Corporation Video Disc Center S.R.L.	
7. Mark	Defendant (disputed trademark)	Petitioner
		
8. Outline of the case		
<p>The Petitioner, one of the leading manufacturers of batteries in the world, was the owner of several trademarks that include the term PANASONIC to identify Class 9 goods, among other batteries. The Petitioner was also the owner of the well-known trademark PANASONIC (whose well-known status has been acknowledged by the Peruvian Trademark Office via Resolution 622-2005/INDECOPI, dated 14th June 2005). For many years the Petitioner had been using the colors yellow and green to identify batteries and the packaging thereof. The Defendant was an importer of batteries PERUSONIC. Previously, the Defendant distributed batteries branded with the mark PANASONIC.</p> <p>The Petitioner filed a nullity action against trademark registration N° 117398 “PERUSONIC” and logo (composite mark) owned by the Defendant on the grounds of bad faith.</p>		
9. Summary of the judgment		

<p>The Peruvian Trademark Office determined that there was sufficient evidence indicating that by the time the Defendant applied for the registration of the mark PERUSONIC, the Defendant knew of the existence of the Petitioner's trademark PANASONIC, given the fact that the mark PERUSONIC imitated, in an identical manner, the graphic design and color composition of the PANASONIC mark, and identified in the same Class 9 of goods (batteries), was not the result of mere coincidence. The Defendant obtained registration of the mark</p>	
<p>PERUSONIC with clear intention to cause harm to the commercial activities of the Petitioner in the Peruvian market, evidencing bad faith.</p> <p>According to the Peruvian Trademark Office, from the available material, it had been proven that the Defendant acted in bad faith.</p>	
<p>10. Tags</p>	
① Type of trial	Nullity action brought before the Peruvian Trademark Office through administrative proceeding
② Decision	Nullification of trademark registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

PHILIPPINES

LE CORDON BLEU ECOLE DE CUISINE MANILLE vs.



1. Title	ECOLE DE CUISINE MANILLE (CORDON BLEU OF THE PHILIPPINES), INC. vs. RENAUD COINTREAU & CIE and LE CORDON BLEU INT'L., B.V.	
2. Country	Philippines	
3. Court	Supreme Court of the Philippines	
4. Case No.	G.R. No. 185830	
5. Date of the judgment	June 5, 2013	
6. Parties: Petitioner Respondents	Ecole De Cuisine Manille (Cordon Bleu of the Philippines), Inc. Renaud Cointreau & CIE and Le Cordon Bleu Int'l., B.V.	
7. Mark	Petitioner	Respondents (disputed trademark)
	LE CORDON BLEU ECOLE DE CUISINE MANILLE	
8. Outline of the case		
<p>In this case, the Petitioner filed an opposition to the trademark application of the Respondent for the mark “LE CORDON BLEU & DEVICE”, claiming that it was the owner and first user in the Philippines of the subject mark. The Petitioner likewise argued that the Respondents’ use of the subject mark would create confusion for consumers as well as cause injury and damage to its business reputation. The Petitioner was the alleged senior user of the trademark since 1948.</p>		
9. Summary of the judgment		
<p>The Respondents filed applications and registrations of the trademark “LE CORDON BLEU & DEVICE” in various jurisdictions, including the Philippines in 1990. The Respondents were likewise the owners of LE CORDON BLEU, a culinary school of worldwide acclaim, having trained students from more than 80 nationalities, including the directress of the Petitioner. When the opposition was filed, the Petitioner had no existing application or registration of the “LE CORDON BLEU” mark. In fact, its application for the “LE CORDON BLEU ECOLE DE CUISINE MANILLE” mark was only filed in 1992, or after the Respondents’ application.</p>		

The Supreme Court, adopting the previous decisions of the Court of Appeals and the Office of the Director

General of the Intellectual Property Office, held that the Respondents' right to register the subject mark could not be barred by the Petitioner's alleged prior use thereof as early as 1948 for its culinary school LE CORDON

BLEU MANILLE in the Philippines because its appropriation of the mark was done in bad faith. Furthermore, at the time when the opposition was filed, the Petitioner had no certificate of registration that would put the Respondents on notice that the former had appropriated or had been using the subject mark.

The Respondents were proven to be the true and lawful owners of the subject mark and thus entitled to have the same registered under their name. The Respondents' Le Cordon Bleu culinary school had been using the subject mark in France since 1895, prior to Ecole's averred first use of the same in the Philippines in 1948. In fact, Ecole's directress had trained in Cointreau's Le Cordon Bleu culinary school in Paris, France.



10. Tags

① Type of trial	Opposition to a trademark application
② Decision	Allowed registration of the trademark
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



VS.



1. Title	FREDCO MANUFACTURING CORPORATION vs. PRESIDENT AND FELLOWS OF HARVARD COLLEGE (HARVARD UNIVERSITY)	
2. Country	Philippines	
3. Court	Supreme Court of the Philippines	
4. Case No.	G.R. No. 185917	
5. Date of the judgment	June 1, 2011	
6. Parties: Petitioner	Fredco Manufacturing Corporation	
Respondent	President and Fellows of Harvard College (Harvard University)	
7. Mark	Petitioner	Respondent (disputed trademark)
		

8. Outline of the case

In this case, the Petitioner filed a petition for cancellation of the registered trademark, “HARVARD VE RI TAS SHIELD SYMBOL”.

9. Summary of the judgment

The mark “HARVARD” was a well-known name and mark internationally, including in the Philippines. The Respondent’s “HARVARD” mark was rated as one of the most famous marks in the world and had been

registered in at least 50 countries. The mark had established a considerable goodwill worldwide since the founding of the Respondent’s school, Harvard University, more than 350 years ago. Thus, it was easily

recognizable as the trade name and mark of Harvard University of Cambridge, Massachusetts, USA, which is one of the leading educational institutions in the world. As such, even before Harvard University applied for registration of the mark “HARVARD” in the Philippines, the mark was already protected under Art. 6*bis* and 8 of the Paris Convention.

Fredco’s registration of the “HARVARD” mark and its identification of origin as from “Cambridge, Massachusetts” falsely suggested that Fredco or its goods were connected with the well-known institution Harvard University, where there was no connection whatsoever. Thus, Fredco’s registration of the mark in 1988 should not have been allowed in the first place. Add to that the fact that Fredco’s registration of the “HARVARD” mark was already cancelled in 1998 when it


failed to file the required affidavit for use of the continued registration of its mark. Hence, at the time of filing of Fredco's Petition for Cancellation,

Fredco was no longer the registrant or presumptive owner of the mark "HARVARD".

Based on the above arguments, the Supreme Court denied Fredco's petition for cancellation and ruled that being a well-known name and mark, Harvard University had exclusive ownership over the subject mark to the exclusion of all others.

10. Tags

① Type of trial	Petition for cancellation of trademark registration
② Decision	Denied petition for cancellation of trademark registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



1. Title	BIRKENSTOCK ORTHOPAEDIE GMBH AND CO. KG (formerly BIRKENSTOCK ORTHOPAEDIE GMBH vs. PHILIPPINE SHOE EXPO MARKETING CORPORATION	
2. Country	Philippines	
3. Court	Supreme Court of the Philippines	
4. Case No.	G.R. No. 194307	
5. Date of the judgment	November 20, 2013	
6. Parties: Petitioner Respondent	Birkenstock Orthopaedie GMBH and Co. KG (formerly Birkenstock Orthopaedie GMBH) Philippine Shoe Expo Marketing Corporation	
7. Mark	Petitioner (disputed trademarks) <p style="text-align: center;">Birkenstock</p> 	Respondent <p style="text-align: center;">Birkenstock</p>
8. Outline of the case		
<p>In this case, Philippine Shoe Expo filed notices of opposition against the trademark application of Birkenstock Orthopaedie for the trademarks “BIRKENSTOCK” and “BIRKENSTOCK BAD HONNEN-RHEIN & DEVICE COMPRISING OF ROUND COMPANY SEAL AND REPRESENTATION OF A FOOT, CROSS AND SUNBEAM”.</p>		
9. Summary of the judgment		
<p>In this case, Petitioner Birkenstock Orthopaedie was able to establish that it was the true and lawful owner of the mark “BIRKENSTOCK” as it submitted evidence related to the history and origin of “BIRKENSTOCK” and its use of the name and mark in commerce since its first adoption in Europe in 1774, long before the Respondent was able to register the same in the Philippines. The subject marks had also been registered by the Petitioner in various countries worldwide.</p> <p>In contrast, the Respondent, aside from its cancelled registration for the mark “BIRKENSTOCK” (due to failure to file the required declaration of actual use), presented only sales invoices and advertising materials, which were not conclusive evidence of its claim to ownership of the mark “BIRKENSTOCK”.</p>		

In view of the foregoing, the Supreme Court found Petitioner Birkenstock Orthopaedie to be the true and lawful owner of the mark “BIRKENSTOCK” and that it was entitled to its registration, and that Respondent Philippine Shoe Expo acted in bad faith by registering in its name, especially when the same was used for similar goods.

10. Tags

① Type of trial	Consolidated Oppositions to the trademark applications
② Decision	Allow registration of trademarks
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

IN-N-OUT BURGER vs. IN N OUT

1. Title	IN-N-OUT BURGER, INC. vs. SEHWANI, INCORPORATED AND/OR BENITA'S FRITES, INC.	
2. Country	Philippines	
3. Court	Supreme Court of the Philippines	
4. Case Nos.	G.R. Nos. 171053 and 179127	
5. Date of judgments	15 October 2007 and 24 December 2008	
6. Parties: Petitioner Respondents	IN-N-OUT BURGER, INC. SEHWANI, INCORPORATED AND/OR BENITA'S FRITES, INC. (licensee of Sehwani)	
7. Mark	<p>Petitioner</p> 	<p>Respondents (disputed trademark)</p> 
8. Outline of the case		
<p>In this case, IN-N-OUT Burger, Inc. filed a complaint for unfair competition and cancellation of trademark registration against the “IN N OUT” mark registered under the name of Respondent Sehwani Incorporated.</p>		
9. Summary of the judgment		
<p>The Supreme Court, in affirming the judgment of the Office of the Director General of the Intellectual Property Office against the Respondent, discussed that it could not give credence to the Respondent’s claims of good faith and that they had openly and continuously used the subject mark since 1982. In fact, the Respondent had the burden of proof to show that it had no fraudulent intent to use the “IN-N-OUT” mark. However, no evidence of prior use, as early as 1982, was provided.</p> <p>Furthermore, Respondent failed to explain why they were using the marks of the Petitioner, particularly “DOUBLE DOUBLE” and “IN-N-OUT Burger and Arrow Design”. The wrappers, receptacles and receipts of the Respondent also used the “IN-N-OUT” mark of the Petitioner. These acts clearly showed bad faith on the part of the Respondent.</p> <p>In addition, IN-N-OUT-Burger, Inc. was the true and lawful owner of the subject mark given the worldwide registration of the “IN-N-OUT” mark. Moreover, the IPO had already declared in a</p>		

previous *inter partes* cases that the “IN-N-OUT BURGER AND ARROW DESIGN” mark of Petitioner was an internationally well-known mark. Thus, IN-N-OUT-Burger, Inc. had the right to use its tradename and mark “IN-N-OUT” in the Philippines to the exclusion of all others.



On the matter of unfair competition, it was held that the Respondent Sehvani’s use of “IN-N-OUT BURGER” in business signages, when it had registered with the IPO as the mark “IN N OUT”, revealed fraudulent intent to deceive purchasers, especially since they were engaged in the same industry. The Respondent was also giving their products a similar appearance that would likely influence purchasers to believe that their products were those of the Petitioner. From the above, it could not be doubted that the Respondent was unlawfully using and appropriating the “IN-N-OUT” mark.

10. Tags

① Type of trial	Complaint for unfair competition and Cancellation of trademark registration
② Decision	Guilty of unfair competition and cancellation of registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

BIG MAC vs. BIG MAK



1. Title	MCDONALD'S CORPORATION and MCGEORGE FOOD INDUSTRIES, INC. vs. L.C. BIG MAK BURGER, INC., FRANCIS B. DY, EDNA A. DY, RENE B. DY, WILLIAM B. DY, JESUS AYCARDO, ARACELI AYCARDO and GRACE HUERTO	
2. Country	Philippines	
3. Court	Supreme Court of the Philippines	
4. Case No.	G.R. Nos. 143993	
5. Date of judgment	August 18, 2004	
6. Parties: Petitioners Respondents	MCDONALD'S CORPORATION and MCGEORGE FOOD INDUSTRIES, INC. L.C. BIG MAK BURGER, INC., FRANCIS B. DY, EDNA A. DY, RENE B. DY, WILLIAM B. DY, JESUS AYCARDO, ARACELI AYCARDO and GRACE HUERTO	
7. Mark	Petitioners 	Respondents (disputed trademark) 
8. Outline of the case		
<p>In this case, McDonald's Corporation and its Philippine franchisee, McGeorge Food Industries, Inc., filed a complaint for trademark infringement and unfair competition against L.C. Big Mak Burger, Inc. and its incorporators, since the registration application for the mark "BIG MAK" was a colorable imitation of McDonald's registered "BIG MAC" mark for the same food products.</p>		
9. Summary of the judgment		
<p>Respondents' use of the aurally and visually similar "BIG MAK" mark on hamburgers, and even on non-hamburger food products, could not excuse their infringement of McDonald's registered "BIG MAC" mark.</p> <p>McDonald's promotion of its "BIG MAC" mark had built goodwill and reputation for its mark, being one of the easily recognizable marks in the market. This fact, thus, increased the likelihood that consumers would mistakenly associate McDonald's hamburgers and business with those of L.C. Big Mak and its "BIG MAK" mark.</p> <p>On the issue of unfair competition, since L.C. Big Mak chose to use the "BIG MAK" mark on hamburgers, the latter had obviously clothed their goods with the general appearance of McDonald's goods. In fact, there was also no notice to the public that the "BIG MAK" hamburgers were products of the Respondents, and not those of the Petitioners who had exclusive use of the</p>		

“BIG MAC” mark. This act alone showed Respondents intent to deceive the public. Thus the Respondents were also liable for unfair competition.



10. Tags

① Type of trial	Complaint for trademark infringement and unfair competition
② Decision	Guilty of trademark infringement and unfair competition
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

RUSSIA

CRISTAL v. CRISTALINO



1. Title	CRISTAL v. CRISTALINO	
2. Country	Russia	
3. Court	The Supreme Court of the Russian Federation after consideration of the decision of the Intellectual Property Rights Court	
4. Case No.	SIP-427/2016	
5. Date of the judgment	2017/04/26	
6. Parties: Plaintiff Defendant	Champagne Louis Roederer LLC "NORDEX"	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case	A case in which the Defendant's registered trademark was determined to be liable to cause confusion with goods connected with another person's business.	
9. Summary of the judgment	<p>The Plaintiff's trademark was a well-known trademark widely recognized by traders and consumers in Russia as a trademark affixed to the Plaintiff's goods, namely sparkling wines. The Plaintiff's trademark could be recognized to have maintained such recognition with intensive use.</p> <p>Based on a comprehensive evaluation of these facts, it was be recognized that the Defendant, which was aware that the Plaintiff's trademark was famous, created the trademark consisting of ten alphabetic characters "CRISTALINO" to intentionally use a similar combination of letters.</p> <p>It was established by the Court that the registration and use of the Defendant's trademark may lead to dilution of the famous Plaintiff's trademark with prior use and that the disputed trademark should therefore be annulled.</p>	
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	

② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	



VACHERON CONSTANTIN v. VACHERON CONSTANTIN

1. Title	VACHERON CONSTANTIN v. VACHERON CONSTANTIN	
2. Country	Russia	
3. Court	General Committee of the Supreme Arbitration Court (currently abrogated)	
4. Case No.	A40-73286/10-143-625	
5. Date of the judgment	2012/04/24	
6. Parties: Plaintiff	Richemont International S.A. and VACHERON & CONSTANTIN	
Defendant	S.A. Tessir Partners LTD	
7. Mark	Plaintiff	Defendant (disputed trademark)
	 VACHERON CONSTANTIN	VACHERON CONSTANTIN
8. Outline of the case		
A case in which the Defendant's registered trademark was determined to be liable to cause confusion with goods connected with another person's business.		
9. Summary of the judgment		
<p>The Plaintiff's trademark was a well-known trademark widely recognized by traders and consumers in Russia as a trademark affixed to the Plaintiff's goods, namely jewelry and watches. The Plaintiff's trademark could be recognized to have maintained such recognition through intensive use.</p> <p>The Defendant's mark was registered with respect to clothing and headwear.</p> <p>Based on a comprehensive evaluation of these facts, it was recognized that the Defendant, which was aware that the Plaintiff's trademark was famous, created the trademark copying the verbal part of the Plaintiff's trademark in order to benefit from the reputation of the Plaintiff's trademark. Traders and consumers who came across the Defendant's trademark would associate the Trademark with the Plaintiff's trademark.</p> <p>It was established by the Court that the disputed trademark should be annulled, as it was created for the purpose of free-riding the reputation of the Plaintiff.</p>		
10. Tags		
① Type of trial	Suit against decision of trial for invalidation	
② Decision	Invalidation	

③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

SERBIA



v.





1. Title	Chocolate Hot Brown & Standing Girl Device v. Chocolate Hot & Standing Girl Device	
2. Country	Serbia	
3. Court	Court of Commerce in Belgrade	
4. Case No.	P. 1260/18	
5. Date of the judgment	2018/4/23	
6. Parties: Plaintiff Defendant	Sun System Kft. Sun Service doo	
7. Mark	Plaintiff	Defendant (disputed trademark)
8. Outline of the case	<p>The Plaintiff filed a bad faith action claiming that the Defendant knew that the Plaintiff had been using the relevant mark for many years for tanning lamps but nevertheless applied to register an almost identical mark for identical goods.</p>	
9. Summary of the judgment	<p>The court denied the bad faith claim (the decision was appealed and is therefore not yet final) because it found that the Respondent had started to import and distribute products marked with the relevant sign in March 2011, which was before the Plaintiff's products became officially available on the local market in early 2012. The court ignored the fact that the Defendant filed the trademark application only in September 2012 (at that time the Plaintiff's products were already available on the local market) and that the Defendant's representative admitted during his testimony that he knew about the Plaintiff and its products, and even that he considered them to be "well-known". The court also ignored the Appellate Court's instructions that it was irrelevant for determination of bad faith, on the part of the Respondent, who placed the relevant products into circulation first.</p>	
10. Tags		
① Type of trial	Court action for transfer of trademark on the grounds of bad faith	

② Decision	Claim denied (not final)
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

Kolid Sunday v. Sunday every day is a celebration (device)



1. Title	Kolid Sunday v. Sunday every day is a celebration (device)	
2. Country	Serbia	
3. Court	Court of Commerce in Belgrade	
4. Case No.	P. 1881/16	
5. Date of the judgment	2018/4/16	
6. Parties: Plaintiff Defendant	Kolid Internacional dooel Kolid International doo	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case		
<p>The Plaintiff filed a bad faith action claiming that the Defendant knew that the Plaintiff had been using the relevant mark for many years for cakes and biscuits, but nevertheless applied to register an almost identical mark for identical goods. However, at the time of filing of the application, the Defendant was owned by the same persons who owned the Plaintiff and they later sold the company to the current owner. Also, at around the same time when the disputed trademark was registered in Serbia, the Plaintiff registered the mark in Macedonia and in a number of other countries using the Madrid System, but it did not attempt to register it in Serbia, which suggests that it knew that the Defendant filed the relevant application in Serbia and that it agreed to such filing.</p>		
9. Summary of the judgment		
<p>The court granted the bad faith claim (the decision was appealed and is therefore not yet final), but it did not provide any reason for finding it in bad faith. Instead, in the reasoning of the judgment, the court elaborated only on the alleged well-known character of the mark.</p>		
10. Tags		
① Type of trial	Court action for transfer of trademark on the grounds of bad faith	
② Decision	Claim granted (not final)	
③ Type of bad faith		
Free Ride		
Imitation by agents or people who have a prior relationship	✓	
Interference by a competing company		

Lack of intention to use	
Others	

SINGAPORE



and A&F vs.



A & F




1. Title	Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd	
2. Country	Singapore	
3. Court	Intellectual Property Office of Singapore	
4. Case No.	[2016] SGIPOS 6	
5. Date of the judgment	16 August 2016	
6. Parties: Plaintiff Defendant	Abercrombie & Fitch Europe SAGL (Opponent) MMC International Services Pte Ltd (Applicant)	
7. Mark	Plaintiff (disputed trademark)	Defendant
		

8. Outline of the case

The Opponent filed an opposition against the application mark on the grounds of bad faith. The Applicant was unable to provide any reason for its choice of A&F and the moose device. The opposition succeeded and the application was refused.

9. Summary of the judgment



The Applicant sought to register the mark  for goods in class 09 on 4 June 2013. The application was accepted and published on 30 January 2014 for oppositional purposes. The Opponent opened opposition proceedings on the grounds that the application's mark was confusingly similar to the Opponent's mark and that the mark was filed in bad faith. The Opponent's marks were registered in classes 03, 14, 18, 24, 25, and 35.

While assessing the issue of bad faith, the Hearing Officer highlighted that "there may be a fine line between being inspired by another's trademark as opposed to blatant copying or copying with some modifications made to the mark". The Hearing Officer took into consideration the fact that

the Opponent was able to explain how its marks were conceptualized but the Applicant failed to do so.



The manner of use of the mark by the Applicant on the goods in question was also taken into consideration. The Applicant appeared to use only the Moose device on the frame of spectacles and the Application Mark which consisted of the device of the moose and the words "A&F", on the thin film on the lenses.

Taking the facts at issue into consideration, the Hearing Office found that the application was filed in bad faith.

10. Tags

① Type of trial	Opposition
② Decision	Opposition succeeded
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

A1 v. AOne

1. Title	A1 v. AOne	
2. Country	Singapore	
3. Court	Intellectual Property Office of Singapore	
4. Case No.	[2017] SGIPOS 2	
5. Date of the judgment	10 January 2017	
6. Parties: Plaintiff Defendant	AUDI AG Lim Ching Kwang	
7. Mark	Applicant	Proprietor (disputed trademark)
		
8. Outline of the case		
<p>The Defendant's registration of a mark reproduced the entire list of goods contained in the Alphabetical List of the Nice Classification for its specification under class 12. The Applicant filed for revocation of the registration in Class 12 on the grounds that it had not been used in Singapore for a continuous period of 5 years; and that it be declared invalid for a lack of bona fide intent to use the Mark for all the goods filed.</p>		
9. Summary of the judgment		
<p>The Mark was registered on 5 October 2009 with respect to Classes 7 and 12. These proceedings concern only Class 12.</p> <p>The specification in Class 12 reproduces the entire list of goods contained in the Alphabetical List of the Nice Classification for that class.</p> <p>The Plaintiff asked that the Defendant's mark be (a) revoked on the grounds that it had not been used in Singapore for a continuous period of 5 years; and (b) declared invalid on the basis that it was applied for in bad faith.</p> <p>On the non-use ground, the Registrar found that there was use of the Mark but only with respect to torque rod bushes. The registration in Class 12 was therefore revoked, save for the following goods: Torque rod bushes.</p>		

With respect to the bad faith claim, it was alleged by the Applicants that, regard for the overwhelmingly wide scope of the specification for which the Mark is registered, it was patently obvious that there could not be any realistic or bona fide intention on the Proprietor's part to use the Mark for all the Goods and consequently, the conclusion must be that the Mark was registered in bad faith.

The Registrar held that the mere registration of a large variety of goods and services was a rather common practice of companies trying to obtain a trademark registration. It did not involve conduct that departs from accepted principles of ethical behavior or honest commercial and business practices. It was legitimate for businesses to seek registration of a mark, not only for the categories of goods and services marketed at the time of filing the application but also for other categories of goods and services which it intended to market in the future. There was, therefore, no bad faith in applying for a broader specification than one in which a trader currently trades. A possible or contingent intention to use the mark at some future date may suffice.

10. Tags

① Type of trial	Revocation and Invalidation
② Decision	Partially Invalidated
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

Gucci v GUCCITECH

1. Title	Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd) [2018] SGIPOS 1	
2. Country	Singapore	
3. Court	Intellectual Property Office of Singapore	
4. Case No.	Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd) [2018] SGIPOS 1	
5. Date of the judgment	23 January 2018	
6. Parties: Plaintiff	GUCCIO GUCCI S.P.A (Opponent)	
Defendant	GUCCITECH INDUSTRIES (PRIVATE LTD) (Applicant)	
7. Mark	Opponent's mark	Applicant's mark
	GUCCI	
8. Outline of the case:		
<p>The opposition succeeded on the grounds that the use of the Application Mark would dilute unfairly the highly distinctive character of the Opponent's GUCCI mark and that the Applicant would enjoy an unfair advantage.</p> <p>However, no bad faith was found.</p>		
9. Summary of the judgment		
<p>The Applicant was incorporated as a company in Singapore in 2010 and its corporate name included the Opponent's mark GUCCI in its entirety. The Applicant did not deny knowledge of the Opponent's trademark GUCCI, but they claimed that they did not believe that their conduct was unfair. The IP Adjudicator found that the Opponent's GUCCI mark was both well-known in Singapore and well-known to the public at large in Singapore. Furthermore, the marks in question and the goods at issue were found to be similar such that there was a likelihood of confusion.</p> <p>The use of the Application Mark would dilute unfairly the highly distinctive character of the Opponent's mark and would give the Applicant an unfair advantage. However, the IP Adjudicator also took the view that the</p> <p>Opponent failed to establish that the application had been filed in bad faith. The IP Adjudicator found that while the Applicant appeared to have taken a gamble on how the facts and laws would be interpreted, "it was not so unreasonable a gamble as to justify a finding of bad faith" and therefore the opposition failed on the grounds of bad faith.</p>		
10. Tags		
① Type of trial	Opposition	

② Decision	Opposition succeeded on grounds of similarity of marks but no bad faith found
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

SPAIN

OCTANAJE vs. OCTANAJE MAGACINE



1. Title	OCTANAJE MAGACINE	
2. Country	Spain	
3. Court	Court of Appeal of Madrid	
4. Case No.	Appeal n° 3/2016	
5. Date of the judgment	2017/10/23	
6. Parties: Plaintiff	ASOCIACIÓN DE EMPRESARIOS DE ESTACIONES DE SERVICIO DE LA COMUNIDAD DE MADRID (AEESCAM)	
Defendant	ABEIRO PROYECTOS E INVERSIONES, SL (ABEIRO)	
7. Mark	Plaintiff (disputed trademark)	Defendant
	OCTANAJE	OCTANAJE MAGACINE

8. Outline of the case

A case in which the Defendant's registered trademark was determined to have been registered contrary to

objective standards of ethical behavior and only aimed to force the position of AEESCAM in a conflict between them and to impede the activity of AEESCAN, consisting of the publication, since 1975, of a magazine addressed to professionals of the automotive sector under the sign "Octanaje".

Background

- "Octanaje" was a sign used by AEESCAM since 1975 as the title of a magazine addressed to the automotive sector.
- The ownership of the publication, with its title and a distinctive sign, was transferred by its creator to AEESCAM in 2008.
- In May 2008, AEESCAN contracted a printer and in 2009 ABEIRO was subrogated in the contract with the first printer.
- At the beginning of 2010, due to some contractual defaults regarding the distribution of the magazine, AEESCAM terminated the contract with ABEIRO.
- On 1 March 2011, ABEIRO filed a trademark application at the SPTO for the denomination "OCTANAJE MAGAZINE" in class 16 with respect to "printed publications". Previously, AEESCAM had asked ABEIRO about proceedings with the registration of the trademark to its name (AEESCAM).

On May 2011, ABEIRO published the magazine with no references to AEESCAM.

9. Summary of the judgment	
Relevant findings	
<p>1. The invalidity action based on bad faith did not require a previous registration owned by the Plaintiff.</p> <p>2. The success of an invalidity action did not depend on the existence of oppositions against the trademark application.</p> <p>3. The bad faith of the application was justified by the fact that the title of the magazine had been used prior to the intervention of ABEIRO and, this company, as a consequence of the differences in the professional relationship, used the application as a reaction against AEESCAM to force its position in the conflict and to impede its development of its normal activity.</p>	
10. Tags	
① Type of trial	Appeal against decision for trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

HISPANO SUIZA vs. HISPANO SUIZA, FÁBRICA DE AUTOMÓVILES, S.A.

1. Title	HISPANO SUIZA	
2. Country	Spain	
3. Court	Spanish Supreme Court	
4. Case No.	Appal n°.70/2017	
5. Date of the judgment	2017/02/08	
6. Parties: Plaintiff Defendant	LA HISPANO SUIZA FÁBRICA DE AUTOMÓVILES, S.A. DELMAR 04, S.A.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	HISPANO SUIZA	HISPANO SUIZA, FÁBRICA DE AUTOMÓVILES, S.A.

8. Outline of the case

The Plaintiff requested that the Commercial Court of Barcelona not only declare that the owner of the HISPANO SUIZA trademark must be La Hispano Suiza, Fábrica de Automóviles S.A., but also requested the invalidity of the Spanish trademark No. 2.901.221 “HISPANO SUIZA” because it had been registered in bad faith by the Defendant. On the other hand, the Defendant requested the revocation of the trade name HISPANO SUIZA, FABRICA DE AUTOMOVILES, S.A.

Background

Relevant

facts:

1. La Hispano Suiza Fábrica de Automóviles S.A. was a company constituted in 1904 and was dedicated to car manufacturing and was the past owner of several trademarks which had expired. The company was the owner of the Spanish trade name No. 111.027 "La Hispano Suiza Fábrica de Automóviles S.A.", which expired the moment the Defendant applied for the Spanish trademark application No. 2.901.221 “HISPANO SUIZA”.
2. DELMAR 04, S.A., the Defendant in this proceeding, was a company which owned the Spanish trademark No. 2.901.221 HISPANO SUIZA.
3. The Plaintiff, La Hispano Suiza Fábrica de Automóviles S.A., filed a claim before the Commercial Court of Barcelona requesting invalidity of the “HISPANO SUIZA” trademark because supposedly it had been requested in bad faith by the Defendant. The Commercial Court

dismissed this claim.

4. The Plaintiff decided to appeal this decision before the Court of Appeal of Barcelona which upheld in part the appeal filed by the Plaintiff because the Court understood that requirements were needed to understand the existence of unfair competition. However, the decision confirmed that although the knowledge of the “Hispano Suiza” trademark might have been evident in a substantial part of the national territory, the Court of Appeal did not consider it was a consequence of the use of the trade name ‘La Hispano Suiza, Fábrica de Automóviles, S.A.

5. Despite this favorable decision, La Hispano Suiza Fábrica de Automóviles S.A., decided to appeal this decision before the Spanish Supreme Court.

9. Summary of the judgment

Relevant findings:

1. Ultimately, the Spanish Supreme Court dismissed the appeal filed by the Plaintiff because it considered the new registration of the Hispano-Suiza trademark could not suppose any use of the prestige and reputation that could be associated, by means of that sign, with the business activity of the Applicant, because at that time, the Plaintiff, La Hispano Suiza Fabrica de Automoviles, S.A., did not have a relevant position in the vehicle market for the manufacture and sale of automobiles from which the Defendant could take advantage of its registration.

2. With respect to the bad faith alleged by the Plaintiff, the Spanish Supreme Court ratified that, in this case, the requirements were not met due to the fact that although the trademark HISPANO SUIZA might be associated with the historical sign related to the vehicles, the Plaintiff did not have a registration in force because they were expired.

3. The Supreme Court understood that the activity of the manufacture and sale of cars ceased more than 80 years ago, and it was not possible for that business activity to gain a position in the market from which the Defendant would benefit with its trademark registration.

10. Tags

① Type of trial	Appeal against a decision of the Court of Appeal of Barcelona
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

NEW YORK FAIR & LOVELY



1. Title	NEW YORK FAIR & LOVELY	
2. Country	Spain	
3. Court	Appeal Court of Barcelona	
4. Case No.	Appeal No. 663/2015	
5. Date of the judgment	2016/12/27	
6. Parties: Plaintiff	UNILEVER PLC y UNILEVER NV	
Defendant	TECHNOPHARMA LIMITED	
7. Mark	Plaintiff	Defendant (disputed trademark)
		“NEW YORK FAIR & LOVELY”
8. Outline of the case		
<p><u>Background</u></p> <p>1. UNILEVER had FAIR & LOVELY trademark registrations in many countries around the world (mainly in the areas of the Persian Gulf, India, Caribbean and Latin America). As a matter of fact, the mark was very famous in India, where its products were leaders in the market for decades. However, UNILEVER’s FAIR & LOVELY mark had barely any presence in the EU (just a minor presence in the UK), which was the case for the last 40 years.</p> <p>2. The Defendant was a direct competitor of the Claimant. They were involved in several disputes around the world and knew each other perfectly.</p> <p>3. The Defendant registered the mark NEW YORK FAIR & LOVELY in the EU. The Applicant opposed the said mark on the basis of the UK national mark. The opposition was upheld, however, the original EUTM application was converted to several national marks, including a Spanish one.</p> <p>4. Even though the Defendant registered the mark in Spain, it had not used it for 12 years.</p> <p>5. The Claimant filed an action claiming that said mark had been filed in bad faith.</p>		
9. Summary of the judgment		
<p>Relevant findings</p> <p>1. The fact that both parties were direct competitors made it reasonable to believe that the Defendant knew the Claimants and their marks, even if they were just reputed in a market so far from the EU in India.</p> <p>2. The fact that the Claimant had ignored the Spanish mark, regarding the FAIR & LOVELY mark, for over 40 years, was not relevant.</p>		

3. The Defendant had a clear intention to hamper the access of the Claimants to the Spanish market. Even if the Claimants were not present in Spain for over 40 years, it may be reasonable that they would be in the future (since they were present in some 40 countries).

4. FAIR & LOVELY were distinctive terms in Spain. The fact that both marks shared the term may not be a coincidence.

10. Tags

① Type of trial	First instance and appeal procedures (Court procedures)
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

CAFÉ DEL MAR

1. Title	CAFÉ DEL MAR	
2. Country	Spain	
3. Court	Mercantile Court No. 2 of Alicante (Spanish EUTM Court), Appeal Court of Alicante (Spanish EUTM Appeal Court)	
4. Case No.	Judgment no. 206/11 Appeal no. 198/12	
5. Date of the judgment	First instance: July 12, 2011 Appeal: April 27, 2012	
6. Parties: Plaintiff	PLAINTIFF: CAFÉ DEL MAR, S.C., CAN GANGUIL, S.L., CARLOS ANDREA GONZÁLEZ, JOSÉ LES VIAMONTE	
Defendant	DEFENDANT: RAMÓN GUIRAL	
7. Mark	Plaintiff	Defendant (disputed trademark)
		“CAFÉ DEL MAR”
8. Outline of the case		
<p>Preliminary Note: We do note that the decisions in this case were rendered more than 3 years ago. In any case we have included this case in the compilation because it is one of the most interesting cases dealing with bad faith in Spain.</p> <p><u>Background</u></p> <p>Mr. Les, Mr. Guiral and Mr. Andrea were friends for several decades and initiated a common project identified with the sign CAFÉ DEL MAR. The project became a real success, and the bar CAFÉ DEL MAR gained a remarkable reputation in Ibiza, Spain and the whole world.</p> <p>Within this common project, Mr. Les and Mr. Andrea were in charge of public relations and the daily operation of the CAFÉ DEL MAR bar, whereas Mr. Guiral was in charge of administrative stuff (contracts, official permissions, accountancy, etc.), for which he was granted the Power of representation by Mr. Les and Andrea.</p> <p>All of the benefits of the common project were distributed in equal part (1/3). The partners/friends set up several companies to articulate the project, in all of them, they had an equal part (1/3). At a certain point Mr. Guiral started registering on his ow behalf CAFÉ DEL MAR trademarks,</p>		

paying said registration with the common funds of the project CAFÉ DEL MAR and the companies created around it.

9. Summary of the judgment

Relevant findings:

1. The fact that one of the partners (the Defendant, Mr. Guiral) could have had a prominent role in the common project did not enable him to register the trademarks CAFÉ DEL MAR (the sign identifying the common project) on his own behalf.
 2. By proceeding in this way, Mr. Guiral had acted in bad faith and in fraud of his partner’s rights.
 3. The fact that the benefits of the common project had always been distributed in equal parts was irrelevant. What was relevant was that the Defendant had appropriated for himself something (the CAFÉ DELMAR marks) that legitimately belonged to the three partners.
 4. The fact that Mr. Guiral had Power of Attorney was irrelevant. Power of Attorney was granted so that Mr. Guiral could act legitimately, protecting his partner’s rights and not in detriment to them.
 5. The Defendant claimed that his partners had been reckless for almost 10 years and had not shown any interest in the status of the trademarks or whether they were registered or not. The sole thing they allegedly were interested in, was that the benefits were distributed properly.
- The rulings concluded that the Defendant’s arguments were not well founded. It was not that the Plaintiffs were reckless. The fact was that, given the long friendship and relations they had for over 20 years with the Defendant, they entrusted everything to him, and were thus not interested in any aspect that was alien to the duties they had been charged with (public relations and the like).
6. The Defendant took unfair advantage of that close friendship.
 7. The sign CAFÉ DEL MAR was jointly owned by the 3 partners/the 3 founders of the common project.

10. Tags

① Type of trial	First instance and appeal procedures (Court procedures)
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

SWEDEN

COCOZ vs.

COCOZ



COCOZ

1. Title	COCOZ vs. COCOZ	
2. Country	Sweden	
3. Court	Swedish Patent and Market Court at Stockholm District Court	
4. Case No.	PMA 11046-16	
5. Date of the judgment	2017/02/07	
6. Parties: Plaintiff Defendant	H.F. 2-Feeling-Good Sweden	
7. Mark	Plaintiff (invalidity applicant)	Defendant (disputed trademark)
	COCOZ	COCOZ
8. Outline of the case		
The Defendant's lack of evidence with regard to the motives of the decision to apply for registration, in light of the Plaintiff's submission, resulted in an invalidation of the registration.		
9. Summary of the judgment		
<p>The Patent and Registration office registered the figurative trademark COCOZ. The proprietor of the trademark was 2-Feeling-Good Sweden. The Plaintiff, who owned a private company called Lifa Webbyrå, applied for invalidation of the trademark registration. The trial court maintained the trademark, a decision that the Plaintiff appealed.</p> <p>The Plaintiff stated that they had developed the logotype the Defendant registered as a figurative trademark. The court found that the facts of the case supported this claim. The court thereafter pointed to the fact that the Defendant applied for registration of an identical logotype the same year that the Plaintiff developed theirs. It was considered unlikely by the court that two identical logotypes of this kind would be developed independently of each other. Thus, the court concluded that the Defendant exploited the logotype developed by the Plaintiff through their application. Given these circumstances and that the Defendant did not present any evidence showing any commercial motives for their application, the court stated that the purpose of applying must, to some extent, have been to affect the Plaintiff's use of the sign. In sum, the Defendant was found to have applied in bad faith.</p>		
10. Tags		



① Type of trial	Suit against decision of trial for invalidity
② Decision	Invalidation
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

CLIMATE POSITIVE vs. CLIMATE POSITIVE

1. Title	CLIMATE POSITIVE vs. CLIMATE POSITIVE	
2. Country	Sweden	
3. Court	Swedish Patent and Market Court at Stockholm District Court	
4. Case No.	PMÅ 14239-16	
5. Date of the judgment	2017/02/01	
6. Parties: Plaintiff Defendant	Falun Energi & Vatten Ecode Elementica Data Center Construction	
7. Mark	Plaintiff (invalidity applicant)	Defendant (disputed trademark)
	CLIMATE POSITIVE	CLIMATE POSITIVE
8. Outline of the case		
<p>The court maintained the disputed trademark registration, finding that the relevant public would not have reason to perceive the disputed trademark as a sign of the Plaintiff's services and therefore there was a lack of a reason for invalidation.</p>		
9. Summary of the judgment		
<p>The Defendant applied for registration of the trademark CLIMATE POSITIVE, which was registered by the Swedish Patent and Registration Office. The Plaintiff applied for invalidation of this registration on several grounds, including the assertion that it was filed in bad faith. The trial court rejected the Plaintiff's application, and the Plaintiff appealed.</p> <p>The Plaintiff argued that they had been developing the brand CLIMATE POSITIVE for an extensive period of time and that the Defendant was well aware of this fact. They stated that the main owner of the Defendant company had attended events in which the CLIMATE POSITIVE- concept was presented. The Plaintiff claimed that the Defendant's purpose in registering the mark was to obstruct the Plaintiff's further use of the sign.</p> <p>The court found that the investigation did not support that the Plaintiff had used the term CLIMATE POSITIVE in such a manner as described at the time of the Defendant's application, nor that the relevant public had reason to perceive CLIMATE POSITIVE as a sign of the</p>		

Plaintiff's services. The court therefore concluded that it lacked reason to invalidate the trademark registration.	
10. Tags	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Maintenance
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

SVENSKA RESEBOLAGET vs.

1. Title	SVENSKA RESEBOLAGET vs. 	
2. Country	Sweden	
3. Court	Court of Patent Appeals (PBR)	
4. Case No.	PBR 15-023	
5. Date of the judgment	2016/08/12	
6. Parties: Plaintiff Defendant	SRB Travel Group Svenska Resebolaget I Kungälv	
7. Mark	Plaintiff (Invalidity Applicant)	Defendant (disputed trademark)
	SVENSKA RESEBOLAGET	
8. Outline of the case		
The burden of proof with regard to applications filed in bad faith lied with the Plaintiff, who in this case was unable to show that the application was filed in bad faith. The court thereby ruled to maintain the trademark registration.		
9. Summary of the judgment		
<p>The Swedish Patent and Registration office registered the figurative trademark SVENSKA RESEBOLAGET in 2002 with the Defendant as its proprietor. The Defendant was a subsidiary of the Plaintiff's company until 2010.</p> <p>During the time that the Defendant was a part of the Plaintiff's operations, the trademark was used by all companies in the group. The registration was not renewed, and the protection lapsed in 2012. In 2013, the Defendant applied for a new registration of the trademark. The Swedish Patent and Registration office registered the trademark; a decision that was appealed by the Plaintiff.</p> <p>The Plaintiff argued that the Defendant knew, at the time of application and during an extensive time beforehand, that the Plaintiff used the trademark. They also contended that the Defendant had committed themselves to cease the use of the trademark in a contract prior to the application for registration. The Defendant claimed that they were the proprietor of the trademark even before they became a subsidiary to the Plaintiff's company, and that the Plaintiff's use of the trademark was granted by the Defendant. Furthermore, they argued that the contract did not encompass this</p>		

trademark, since it only regarded trademarks owned by the Plaintiff.

The court found that the facts of the case did not elucidate whether the Plaintiff used the trademark SVENSKA RESEBOLAG after the cooperation with the Defendant ended. Furthermore, the court pointed to the fact that the Plaintiff had not shown that the title to the trademark was transferred to the Plaintiff nor that the Defendant in any way agreed not to use the trademark. In light of these circumstances, and since no other facts which would indicate that the Defendant was acting in bad faith were presented, the court ruled to maintain the trademark registration.

10. Tags

① Type of trial	Suit against decision of trial for invalidity
② Decision	Maintenance
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

BERGLÖFSLÅDAN vs. BERGLÖFSLÅDAN and BERGLÖFSLÅDAN ORIGINAL



1. Title	BERGLÖFSLÅDAN vs. BERGLÖFSLÅDAN and BERGLÖFSLÅDAN ORIGINAL	
2. Country	Sweden	
3. Court	Court of Patent Appeals (PBR)	
4. Case No.	PBR 14-063 & 14-064	
5. Date of the judgment	2015/12/14	
6. Parties: Plaintiff	Swede Rehandling Systems	
Defendant	SRS MoveTech World Wide	
7. Mark	Plaintiff (Invalidity Applicant)	Defendant (disputed trademark)
	BERGLÖFSLÅDAN	BERGLÖFSLÅDAN BERGLÖFSLÅDAN ORIGINAL

8. Outline of the case

The Defendant in the case was, as per their own statement, already the proprietor of the trademark BERGLÖFSLÅDAN CUSTOM, and that the disputed trademarks BERGLÖFSLÅDAN and BERGLÖFSLÅDAN ORIGINAL were applied for with the purpose of extending the existing protection for the sign BERGLÖFSLÅDAN. This fact led the court to conclude that the circumstances at the time of the earlier registration needed to be taken into account. The court argued that the circumstances at that time opposed the notion that the application was filed with a legitimate intent. Thus, the court declared invalid the contested trademarks.

9. Summary of the judgment

The Plaintiff had applied for the disputed trademark to be declared invalid on the basis that, *inter alia*, the application was filed in bad faith. The Plaintiff argued that it was evident that the application for registration of the trademark was filed to obstruct existing and emerging actors in the relevant markets from using the established denotation BERGLÖFSLÅDAN. The Defendant stated that they had used the sign BERGLÖFSLÅDAN since 1997 and that they owned the trademark registration BERLÖFSLÅDAN CUSTOM as of 2004. The contested application was filed as an extension of previous protection, as per their statement.

The Court stated that, as the disputed trademark registration was applied for as part of previous protection, there was reason to also consider the circumstances at the date of the earlier registration (that was 2004).

<p>The court found that the facts of the case showed that the Defendant had knowledge of the origin of the sign BERGLÖFSLÅDAN, including how and when it came into being (which was established over 50 years ago),</p>	
<p>as well as knowing that other actors on the market used the sign BERGLÖFSLÅDAN for certain goods for a long time before they started using the sign. The Defendant also knew that other actors used the sign at the time of application for registration of the earlier trademark BERGLÖFSLÅDAN CUSTOM. The court argued that these circumstances contested the notion that the registration was made as part of a normal line of business with legitimate commercial interests. The Defendant could, however, still be regarded as having a legitimate interest for applying for registration. However, given evidence put forth by the Defendant, the court concluded that no evidence provided sufficient support to show it had a legitimate interest.</p>	
<p>In sum, the Defendant was considered to have acted in bad faith.</p>	
<p>10. Tags</p>	
① Type of trial	Suit against decision of trial for invalidation
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

TAIWAN

Pizza Hut, 熱到家 v. 熱到家 Co.,Ltd



1. Title	“re-dau-jia” Co., Ltd v. Intellectual Property Office (Intervener Pizza Hut)	
2. Country	Taiwan	
3. Court	Supreme Administrative Court	
4. Case No.	最高行政法院 98 年度判字第 321 號判決 (Supreme Administrative Court Decision No. 2009-Pan-321)	
5. Date of the judgment	2006.3.26	
6. Parties: Plaintiff Defendant	Pizza Hut “re-dau-jia” Co., Ltd	
7. Mark	Plaintiff (disputed trademark)	Defendant
	Pizza Hut,熱到家	熱到家 Co.,Ltd
8. Outline of the case	The applicability of reasonable burdens of proof for establishing a presumption of bad faith.	
9. Summary of the judgment	<p>Pizza Hut used “熱到家(re-dau-jia)” as a trademark (and an advertisement slogan) for its products in Taiwan. The appellant filed an application for the “熱到家” mark designating restaurant services in Class 43. Pizza Hut filed an opposition against the “熱到家” mark.</p> <p>Taiwan is a first-to-register jurisdiction and, generally, rights are based on registration rather than use. However, there <i>is</i> protection for unregistered famous trademarks, or where a mark is pre-emptively registered by a third party for the purposes of counterfeiting or imitating the mark. Nevertheless, it’s always challenging for the opposing party to prove that the Applicant knows of the existence of the opposing party’s mark and that the application was filed with the intent to counterfeit or imitate that trademark.</p> <p>In this case, Pizza Hut was unable to provide evidence proving the above facts. The court determined that the Applicant knew of the opposing party’s trademark by operating in the same industry. Therefore, if a squatter was operating in the same business as the opposing party, the</p>	

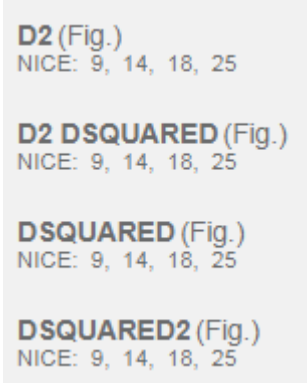








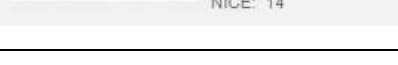
opposing party did not need to provide evidence proving that the Applicant was aware of the opposing party's mark through a certain relationship.

10. Tags

① Type of trial	Appeal dismissal
② Decision	Registering a similar trademark to a prior-used one while operating a business in the same industry will establish a presumption of bad faith.
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

THAILAND

D2 v.  

1. Title	Belmont Brands Limited v. Mr. Boonyasak Wattanaharuthai	
2. Country	Thailand	
3. Court	Thai Supreme Court	
4. Case No.	9972/2558	
5. Date of the judgment	28 August 2015	
6. Parties: Plaintiff Defendant	1. Belmont Brands Limited 2. Dsquared2 TM SA 1. Mr. Boonyasak Wattanaharuthai 2. Domon (1987) Co., Ltd. 3. Ms. Bussaba Wattanaharuthai	
7. Mark	Plaintiff (disputed trademark) 	Defendant         
8. Outline of the case	<p>The Claimants (Plaintiffs) began using their marks worldwide before the Registrant (Defendant) filed for registration of its marks in Thailand, which were similar to the Claimants' marks (not yet registered in Thailand).</p> <p>The Claimants brought an action under the law of passing off with a request to cancel the Defendant's registrations.</p>	

9. Summary of the judgment

1. The Claimants began using their marks worldwide before the Registrant filed for registration of its marks in Thailand, which were similar to the Claimants' marks (not yet registered in Thailand). Based on the weight of use evidence, it was held that the Claimants had better rights to the marks.
2. As the marks were used by the Claimants internationally (but not registered or applied for in Thailand yet with respect to the relevant goods), but were registered in Thailand under the Registrant's name and were similar, this fact gave the Claimants a legitimate standing to file for cancellation claiming better rights, even though the Claimants had not registered or applied for registration of their marks in Thailand. The Claimants had the right to file the cancellation petition.
3. A similarity or connection between the goods to which the parties' marks were used made it likely that concurrent use of such marks by different parties would lead to consumer confusion as to the origins of the goods. As the Claimants had better rights to their marks, the Court ordered to cancel the Registrants' trademark registrations.
4. While the parties' marks were not identical, the Defendants use of their marks in a manner similar to the Claimants' use of their marks showed that the Defendants had the intention to pass off their goods as the Claimants'.
5. As the Claimants' marks were not registered in Thailand, they were only entitled to remedies under the law of passing off.
6. The Defendants were ordered to cease using all trademarks, product forms and designs which were rightful intellectual property of the Claimants.
7. The Defendants ordered the Claimants to pay THB 100,000 (approximately USD 3,125) per month in damages, calculated from the court case filing date, until the Defendants had ceased using the trademarks, product forms and designs which were the rightful intellectual property of the Claimants.

10. Tags

① Type of trial	Suit based on passing off with a request to invalidate
② Decision	Passing-off - Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	

Interference by a competing company	
Lack of intention to use	
Others	

UK

32 vs. 32Vegas

1. Title	32	
2. Country	United Kingdom	
3. Court	Court of Appeal	
4. Case No.	[2012] EWCA Civ 19	
5. Date of the judgment	2012/01/24	
6. Parties: Respondent Appellants	32 Red Plc (A Gibraltar Company) (1) WHG (International) Limited (A Gibraltar Company); (2) WHG Trading Limited (A Gibraltar Company); (3) William Hill PLC	
7. Mark	Claimants/ Respondents (disputed trademark)	Defendants / Appellants
	32	32Vegas
8. Outline of the case		
A case in which the Appellants alleged bad faith in making the application to register a trademark due to lack of genuine intention to use the mark.		
9. Summary of the judgment		
<p>The Appellants (together, "WH") were in the business of online gaming services, the Respondent ("Red") was an online casino operator. Red had operated an online casino "32Red" since 2002 and subsequently registered the "32Red" trade and device marks. In 2008, WH acquired an online casino "32Vegas" and used signs and devices based on the casino's name. Red brought proceedings against WH for infringement of its registered trademarks. For the purposes of this summary, the relevant mark was UKTM for the number "32" (the "Mark"), however Red also had a Community trade and device marks for "32Red" (together the "CTMs"). WH disputed the validity of the Mark on a number of grounds, including a claim that (i) Red applied for the registration in bad faith "to prevent other traders in the market place from using the number 32 and therefore from trading or from entering the market for the supply of casino and gaming services and similar." and (ii) that Red did not have a genuine intention to use the Mark.</p> <p>In the first instance, the judge decided that whilst it was clear that Red made the application to strengthen its position in the forthcoming litigation against William Hill Online and with</p>		

an intention to enjoy the monopoly to use the Mark for online casinos and related services, such considerations "are not necessarily indicative of bad faith". The application was made "for good tactical reasons of this nature, in a context where [Red] believed

(...) that the use by William Hill Online of the [32Vegas] signs infringed the [CTMs], and where no commercially significant use had been made by anybody else of marks incorporating the figure 32, let alone the figure 32 in isolation, in the field of online gambling.". The judge also found that in respect of lack of intention to use, even though there was no evidence of use of the mark "32" on its own by Red to designate its online casino, the presumption of good faith applied and there was not sufficient evidence to rebut that presumption.

The judge referred to some uses of the figure 32 in a broken circle and concluded that such uses of the figure 32 "may in due course provide a springboard for increasing use of the figure 32 alone".

The Court of Appeal ("CA") upheld the decision of the judge. CA stated that the Appellants' submissions failed to show a lack of genuine intention to use the mark by Red at the time of application.

10. Tags

① Type of trial	Appeal
② Decision	Appeal dismissed
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	✓

Alexander



1. Title	Alexander	
2. Country	United Kingdom	
3. Court	Appeal to Appointed Person	
4. Case No.	O-036-18	
5. Date of the judgment	2017/12/18	
6. Parties: Applicant Opponent	CKL Holdings NV Paper Stacked Limited	
7. Mark	Applicant (disputed trademark)	Opponent
	ALEXANDER	
8. Outline of the case		
A case in which the Applicant's application was determined to have been made in bad faith due to lack of intention to use the mark.		
9. Summary of the judgment		
<p>The Applicant sought to register the mark "ALEXANDER" in relation to mirrors and picture frames in class 20, but the Opponent opposed the registration on the ground of bad faith in making the application. The Opponent argued that the Applicant had no genuine intention to use the mark and that it had a track record of several hundred trademark filings in various territories, many of which comprise of common first names.</p> <p>The Applicant denied the allegation and said that it had acted lawfully when filing the application. The Opponent submitted evidence showing that the sole director of the Applicant company, Mr Michael Gleissner, held directorship of over 1200 UK companies, which included Trump International Ltd and EUPIO International Ltd. Further, that Mr Gleissner's companies, in addition to their applications for trademarks for common names, had registered or applied for more distinctive marks such as EUIPO and TESLA, BAIDU, ENRON, PAN AM, among others. The Opponent also showed that with respect to UKTMs, 6 out of 8 applications were opposed, in contrast with a usual opposition rate of 4.5% and adduced evidence of Mr Gleissner's pattern of registrations, such as articles, searches and entries on the LinkedIn profile of the Trademark Manager at one of Mr Gleissner's companies. The Applicant responded with its own submission but no supporting evidence.</p> <p>The Hearing Officer had to answer the following questions to conduct the relevant</p>		

assessment: "(1) what, in concrete terms, was the objective that [the Applicant] had been accused of pursuing? (2) was that an objective for the purposes of which the contested application could not properly be filed? (3) was it established that the contested application was filed in pursuit of that objective?". In relation to the second question, the test was for dishonesty or falling short "of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined".

The Appointed Person stressed that the question of bad faith was a separate one from whether a mark was

capable of being registrable and that "[t]he objection is absolute in the sense that it is intended to prevent abusive use of the system for acquiring title to a trademark by registration." It does not require the person challenging the application to be personally aggrieved.

Based on the evidence submitted by the Opponent and the written observations filed on behalf of the Registrar (which showed that as of November 2017 Mr Gleissner's entities were a party to 5% of the contested TM cases before the UKIPO), the Appointed Person determined that the prima facie case of bad faith was made out and the Applicant failed to rebut it.

10. Tags

① Type of trial	Appeal to Appointed Person
② Decision	Appeal dismissed – application rejected
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	✓
Others	

CHINAWHITE



1. Title	CHINAWHITE	
2. Country	United Kingdom	
3. Court	Court of Appeal	
4. Case No.	[2004] EWCA Civ 1028	
5. Date of the judgment	2004/07/27	
6. Parties: Appellant	Harrison	
Respondents	Teton Valley Trading Co	
7. Mark	Appellant (disputed trademark)	Respondents
	CHINA WHITE	
8. Outline of the case		
<p>A case in which bad faith in making an application to register a trademark was established based on the Appellant's belief and surrounding facts (i.e. knowledge that a club and a drink under the same name as the mark applied for had been used by the Respondents).</p>		
9. Summary of the judgment		
<p>In March 1999, the Appellant applied to register the CHINA WHITE mark “beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages” in Class 32, and “alcoholic beverages (except beers) including cocktails” in Class 33. The Respondents' licensees run a night club called "CHINA WHITE" (the "Club") at the premises occupied by the Respondents.</p> <p>In the first instance, the Hearing Officer found that at the date of the application, the Respondents enjoyed a reputation in the Club. Mr Rymer, a bar manager, was instructed, as part of his duties, to create and develop a signature cocktail which would be white in colour and oriental in flavour and call it "CHINA WHITE". MR Rymer and his team came up with the cocktail which went on sale early December 1998. Also in December, Mr Rymer and others signed a confidentiality agreement with respect to the recipe for the "CHINA WHITE" cocktail. The Respondents informed Mr Rymer that they had plans to bottle the drink and that when that happened, he would be rewarded with bonus payments.</p> <p>The Appellant was approached by Mr Rymer, who told him about a drink that he had developed,</p>		

the derivative of which was to be served at a new venue to be called "CHINA WHITE". Mr Rymer told the Appellant that he would be working as a barman at the Club, but that he was not bound by any formal contract.

The Appellant claimed that he believed that the drink was the sole property of Mr Rymer. The Hearing Officer determined that under the circumstances, the Appellant should not have accepted Mr Rymer's assurances at face value. The Appellant was aware that Mr Rymer was a barman at the Club and that he had developed a drink called CHINAWHITE, the derivative of which was to be served at the Club. The Hearing Officer found that these facts would have led a reasonably informed businessman in the relevant field to question Mr Rymer further and not to turn a blind eye, adding that conducting a trademark registry and Companies House search was not enough.

The Officer's decision was upheld by the judge. At the appeal to the Court of Appeal ("CA"), the Appellant argued that the words "made in bad faith" required dishonesty. This argument was rejected by the CA who explained that this was not a test under the Trademark Act 1994, and that "[n]o doubt an application made dishonestly will be made in bad faith, but it does not follow that if dishonesty is not established, bad faith cannot have existed." The CA clarified that the correct test is "whether the knowledge of the Applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards." The CA found that whilst there was no evidence of deliberately avoiding questions (in the sense of having considered them but deciding not to ask), the Hearing Officer correctly took into account the belief of the Applicant and the surrounding facts and was right to come to a conclusion that bad faith had been established.

10. Tags	
① Type of trial	Appeal
② Decision	Appeal dismissed - Opposition successful - Bad faith
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	✓
Interference by a competing company	
Lack of intention to use	
Others	

One Max



1. Title	One Max	
2. Country	United Kingdom	
3. Court	Appeal to Appointed Person	
4. Case No.	O-486-17	
5. Date of the judgment	2017/10/06	
6. Parties: Applicant Opponent	ONE MAX LTD HTC CORPORATION	
7. Mark	Proprietor (disputed trademark)	Opponent
	ONE MAX	
8. Outline of the case		
<p>A case in which, based on the facts and evidence, the Opponent showed that the Proprietor's TM applications were made in bad faith, with the knowledge that the Opponent was about to launch a product under the identical name as the mark.</p>		
9. Summary of the judgment		
<p>The Managing Director of One Max Ltd ("One"), then a long-time dormant company, became aware in June 2013 that HTC Corporation ("HTC") was planning to launch a new product to be called HTC One Max and decided to make TM applications for both a logo and words "One Max" with respect to goods (such as mobile phones and tablets) in class 9 and services in class 42, which were outside One's area of activity. HTC opposed the marks on the basis of the application being made in bad faith and the Hearing Officer decided in its favour, holding that One's applications were simply blocking ones.</p> <p>One appealed the decision, arguing that: (i) the Officer failed to take into account the fact that ONE MAX was a pre-existing company name and part of a domain name registered since 2008; (ii) One in fact had been trying, though without success, to establish a type of telecoms business; (iii) One's registrations were a means to protect its own business and (iv) that the standard of bad faith had not been proven.</p> <p>The Appointed Person stressed the reasoning behind the bad faith provision was to tackle illegitimate applications and not to serve "as a proxy for addressing a fear that [the mark] may later be illegitimately used". He further explained that "[i]t is important to distinguish between a situation where an Applicant has no real basis for being entitled to protection for the mark and</p>		

situations where it has an arguable basis, albeit one which may be unjustified." The Appointed Person clarified that this, however, does not mean that a bad faith allegation can be defeated on the basis of some tenuous and poorly substantiated justification. Instead, the assessment requires looking at the evidence as a whole.

The Appointed Person further explained that "[i]f it is plain that an Applicant has, in substance, no legitimate basis for acquiring the weapon or that it is illegitimately directed at a third party, the fact that it can point to a fig- leaf reason for saying that it wants it to defend its own patch and not to embark on an unjustified raid on the business of others, is not enough (...)". In the present case, the Appointed Person held that the Hearing Officer took into account all relevant evidence, considered and evaluated it appropriately. The Appointed Person agreed that One's argument that the application was not done with a blocking intention was difficult to reconcile with One's actions and chronology of events.

10. Tags

① Type of trial	Appeal to Appointed Person
② Decision	Appeal dismissed
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

Roadrunners



1. Title	Roadrunners	
2. Country	United Kingdom	
3. Court	Appeal to Appointed Person	
4. Case No.	O-094-17	
5. Date of the judgment	2017/02/28	
6. Parties: Proprietor Applicant	Roadrunners Gatwick Limited Road Runners (East Grinstead) Limited	
7. Mark	Proprietor (disputed trademark)	Applicant
	ROADRUNNERS	
8. Outline of the case		
<p>A case in which the Applicant challenged the Proprietor's trademark registration on the grounds of bad faith, successfully arguing that the intention to register the trademark was to illegitimately block its use by the Applicant.</p>		
9. Summary of the judgment		
<p>The Proprietor registered a UKTM "ROADRUNNERS" with respect to the "[a]rrangement of taxi transport; taxi services; taxi transport; transport of travellers by taxi" in class 39.</p> <p>The Hearing Officer held that the mark was applied for in bad faith and should be invalidated. The Officer found that "the intention behind the trademark application was to gain further protection for the established Roadrunners mark owned by [the Proprietor] in Redhill and Reigate. This included the prospect of taking infringement action in order to prevent [the Applicant] from continuing to trade under the Roadrunners name."</p> <p>The Proprietor appealed the decision, arguing that the findings made were outside the scope of the pleadings and that the evidence was insufficient for the Officer to find that the application was made in bad faith.</p> <p>The Appointed Person reiterated the principles of bad faith set out in the <i>Red Bull</i> case by Arnold J. With respect to the grounds of appeal, the Appointed Person found that the Hearing Officer's findings were within the scope of the pleaded case and in reliance on evidence available to the</p>		

Officer. As to the more general claim of the Proprietor that it was for a person alleging bad faith to prove it and not for the person accused of it to disprove it, the Appointed Person accepted this argument in principle but stressed that this was subject to a prima facie case of bad faith having been made out. Once the person challenging the mark adduced specific evidence and made out a prima facie case, it was for the proprietor to adequately rebut it.

The Proprietor also invoked an argument that the mark applied for was in order to legitimately protect its business and goodwill. The Appointed Person admitted difficulty in making a fine distinction between "impermissible appropriation or denial of third party right amounting to bad faith and permissible assertion of a bona fide claim to a trademark right of one's own" and stressed that it must be borne in mind that bad faith is not to be invoked "to make general adjudications as to commercial morality."

The Appointed Person determined that, on the facts and in light of evidence available, the application was indeed made in bad faith with a view to illegitimately block use by another party.



10. Tags

① Type of trial	Appeal to Appointed Person
② Decision	Appeal dismissed – registration invalidated
③ Type of bad faith	
Free Ride	
Imitation by agents or people who have a prior relationship	
Interference by a competing company	✓
Lack of intention to use	
Others	

UKRAINE

Mando v. MANDO



1. Title	Mando v. MANDO	
2. Country	Ukraine	
3. Court	Court of general jurisdiction, Solomjanskyj district of Kyiv, Ukraine	
4. Case No.	760/15975/15-П	
5. Date of the judgment	2016/03/14	
6. Parties: Plaintiff Defendants	Halla Holdings Corporation Ukrainian State Service of Intellectual Property, Atsekhovskyy Anatoliiy	
7. Mark	Plaintiff	Defendant (disputed trademark)
		
8. Outline of the case	<p>Trademark legislation in Ukraine does not foresee refusal of bad-faith applications or cancellation of bad-faith trademark registrations as such. However, in accordance with Article 6.2.5 of the Trademark Law, a trademark registration cannot be registered in Ukraine if it is misleading or may mislead as to the producer of goods, services or producers of goods or provider of services. In the reported case, the contested trademark was cancelled as the court ruled that it may mislead as to the producer of the goods.</p>	
9. Summary of the judgment	<p>The Plaintiff in the reported case is Halla Holdings Corporation, a part of Hall Group, a South Korean industrial conglomerate and producer of auto parts. In 2013, Halla Holdings filed two trademark applications for the verbal stylized mark Mando, which were refused for protection by the Ukrainian IPO on the basis of an earlier registration for the MANDO verbal mark registered in the name of a Ukrainian individual with respect to identical or similar goods and services.</p> <p>The Plaintiff filed a trademark invalidation action against the cited trademark arguing that it was registered in bad-faith and that it was free riding on the reputation of the Plaintiff's mark. In their legal arguments, the Plaintiff referred to Articles 6.2.5 and 6.3.2 of the Ukrainian Trademark Law. The Plaintiff also argued that at the moment of filing the contested trademark for registration with the Ukrainian IPO, the Plaintiff was a famous producer of auto parts in many countries around the world, and that their goods had been imported into Ukraine over a period of years. The contested trademark</p>	

would mislead consumers as to the producer of goods. A consumer would consider that it was the Plaintiff who was the producer of the contested trademark.

The court upheld the invalidation action and ordered cancellation of the contested trademark on the Ukrainian trademark register. The court's decision included a reasoning that the Defendant's trademark may indeed mislead consumers as to the producer of the goods in view of the Plaintiff's reputation in the business of auto parts.

10. Tags

① Type of trial	Trademark cancellation action against bad-faith trademark registration
② Decision	Cancellation of bad-faith trademark registration
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

URUGUAY

F1 v. F1 FORMULA 1



1. Title	F1 v. F1 FORMULA 1	
2. Country	Uruguay	
3. Court	Patent and Trademark Office	
4. Case No.	440.692	
5. Date of the judgment	2017/7/11	
6. Parties: Plaintiff Defendant	Alberto Scasso Volonté Formula One Licensing B.V.	
7. Mark	Plaintiff (disputed trademark)	Defendant
	F1	F1 FORMULA 1
8. Outline of the case		
A case in which the Plaintiff's application was determined as contrary to ethics of business and liable to cause confusion with goods connected with another person's business.		
9. Summary of the judgment		
<p>The mark applied for was not sufficiently different from the previously registered trademark owned by the opposing party and thus its registration could not be granted. Moreover, the mark for which registration was sought gave the impression of belonging to the family of trademarks of the opposing party.</p> <p>As for the goods and services protected by the conflicting signs, the application sought to distinguish services in international classes 35 and 41, which the opposing party's prior trademark registrations covered, with the ensuing risk of direct confusion among consumers.</p> <p>With respect to the specialty principle established under Article 11, paragraph 1, of Law 17,011, which was invoked by the Applicant in support of his application, it should be noted that "this legal principle admits two basic exceptions: (1) when the mark applied for is identical or similar to an existing mark that covers goods or services that are similar but are included in different classes; [and] (2) when the Applicant seeks to register a famous mark."</p> <p>In this case, there was also a risk of indirect confusion between similar marks that distinguish competing goods. The goods under international class 9 for which the Applicant sought registration competed with the products under international class 16 covered by the opposing party's prior registration; likewise, the services under international class 42 competed with those</p>		

under international class 38; this thus gave rise to a risk of indirect confusion.

As to whether or not the preexisting trademark was a famous mark, it was sufficiently proven in these proceedings that it was.

In the case of different goods and services that did not compete with each other, the mark applied for could lead consumers to believe that such goods and services originated from one of the companies that participated in or sponsored the famous sports competitions organized and commercialized by the opposing party.

With respect to invalidity on the grounds of unfair competition, such grounds would have applied “when the new mark for which registration is sought ... gives the examiner cause to presume ‘bad faith,’ ‘unfairness,’ or intent to misappropriate or unduly profit from another’s mark or prestige.”

The word mark applied for made the hypothesis of unfair competition likely. The application for a mark similar to the preexisting trademarks of the opposing party was not mere coincidence, rather it was one in series of applications for marks that were purposefully similar to the opposing party’s trademarks.

This allowed for the assertion that in filing the contested application, the Applicant had acted in bad faith as he had abused the trademark application procedure by filing applications with the intent of misappropriating a mark that he had not created, thus contravening fair industrial and market practices.

10. Tags

① Type of trial	Opposition proceeding
② Decision	Rejection
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

VIETNAM

SNAPCHAT vs. SNAPCHAT



1. Title	SNAPCHAT vs. SNAPCHAT	
2. Country	Vietnam	
3. Court/Other Authorities	National Office of Intellectual Property of Vietnam (“NOIP”)	
4. Case No.		
5. Date of the judgment	6 June 2018	
6. Parties: Plaintiff Defendant	Snap Inc. at 63 Market Street, Venice, California 90291, United States Mr. Nguyen Hung Cuong at No. 13 lane 612/50, De La Thanh Street, Ba Dinh District, Hanoi, Vietnam	
7. Mark	Plaintiff	Defendant trademark) (contested
	SNAPCHAT	SNAPCHAT
8. Outline of the case	<p>A case in which the Defendant’s registered trademark was determined to be confusingly similar to the Plaintiff’s trademark, which was well known before the filing date of the Defendant’s trademark. The Defendant’s trademark filing aimed to take advantage of the reputation and goodwill attached to the Plaintiff’s trademark.</p>	
9. Summary of the judgment	<p>On 6 June 2018, the NOIP issued a decision on invalidation of the Defendant’s registration No. 245540 for “SNAPCHAT” for the services “<i>Information transmission, computer-aided transmission of messages and images; communication transmission by using terminals (namely: computers, workstations); paging services</i>” in Class 38 and “<i>Providing search engines for the Internet; providing means of searching for others; providing online websites according to customers’ requirements</i>”. In the invalidation action, the Plaintiff successfully argued that:</p> <p>(i) The Plaintiff was the owner of the trademark “SNAPCHAT” for various goods/services, including but not limited to goods and services in Classes 09, 36, 38, 41, 42 and 45, which was well known in many countries in the world and Vietnam prior to the filing date of the Defendant’s trademark;</p> <p>(ii) The Plaintiff’s mobile application “SNAPCHAT” was introduced in the App Store (for iOS operating system) in September 2011 and on Google Play (for Android operating system) several years earlier and had been provided to users all over the world and in Vietnam since then, with users in over 70 countries in the world;</p>	

(iii) The Plaintiff’s trademark “SNAPCHAT” had earned well-known status and was used by many celebrities. Thus, the Defendant’s filing of an identical trademark for the same services may cause adverse effects to the Plaintiff and cause confusion to consumers between the two parties’ trademarks.

The Defendant failed to respond to the invalidation action within the time allotted.

Upon reviewing the invalidation action together with the supporting evidence/information, the NOIP agreed with the Plaintiff’s request for invalidation, and decided to invalidate the Defendant’s trademark “SNAPCHAT” for

all services, reasoning that the Defendant’s trademark failed to meet the criteria for protection because it was confusingly similar to the trademark of the Plaintiff—a company with well-known status and reputation with regard to the trademark SNAPCHAT around the world, as shown by its large number of consumers.

Furthermore, since the Plaintiff’s trademark was well known and familiar to many people, the act of registration and use of the Defendant’s trademark “SNAPCHAT” would cause confusion to consumers.

10. Tags

① Type of trial	Invalidation action against a trademark registration
② Decision	Invalidation
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

Hyundai vs. Hyundai for electric bicycles



1. Title	Hyundai vs. Hyundai for electric bicycles	
2. Country	Vietnam	
3. The competent authority issuing decision	Ministry of Science and Technology	
4. Case No.	15/KL-Ttra	
5. Date of the decision	18 January 2016	
6. Parties: Plaintiff Defendant	Hyundai Motor Company Vietnam Hyundai Electronics Co., Ltd.	
7. Mark	Plaintiff	Defendant
	HYUNDAI	HYUNDAI for electric bicycles
8. Outline of the case		
<p>The Defendant used a registered trademark of the Plaintiff to distribute electric bicycles. The Plaintiff had never manufactured and distributed such goods. The Defendant also used the Plaintiff's trademark in/on its trade name, business means and its domain name <hyundai-ebikes.vn> to cause confusion, implying a relationship between the Defendant and the Plaintiff.</p>		
9. Summary of the judgment		
<p>The act of trading electric bicycles bearing the "HYUNDAI" sign, which was confusingly similar to the registered trademark of the Plaintiff, was an infringement of their trademark rights.</p> <p>The use of the "HYUNDAI" sign, <i>which was</i> confusingly similar to the registered trademark of the Plaintiff, in the trade name (i.e. Vietnam Hyundai Electronics Co., Ltd.) and <i>business means</i>, was an infringement of trademark rights.</p> <p>The registration and use of the domain name <hyundai-ebikes.vn>, which was mainly constituted by the trademark of the Plaintiff, caused confusion as to the relationship between the Plaintiff and the Defendant. These acts were regarded as <i>acts of unfair competition in industrial property</i>.</p> <p>Based on a comprehensive evaluation of these facts, it could be recognized that the Defendant, which was aware that the Plaintiff's trademark was famous, deliberately distributed and promoted electric bicycles bearing the Plaintiff's trademark in order to ensure that traders and consumers misunderstood that the Plaintiff manufactured and distributed such goods. The Defendant used the Plaintiff's trademark for the illicit purpose of taking advantage of the reputation of the Plaintiff's</p>		

trademarks.	
10. Tags	
① Type of trial	Complaint about infringement of trademark rights and <i>unfair competition</i>
② Decision	Sanction of administrative violations and forced cessation of trademark infringement
③ Type of bad faith	
Free Ride	✓
Imitation by agents or people who have a prior relationship	
Interference by a competing company	
Lack of intention to use	
Others	

Appendix

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September 19, 2018

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