

# TM5

Trade Mark Protection  
in Opposition and Appeal (Review)

## **Opposition: Typical Cases**




# Table of Contents

Typical Cases of CNIPA .....	4
CNIPA-1  V. 洛天依 .....	5
CNIPA-2 中智行 .....	8
CNIPA-3 好待百 V. 梦多咖喱 .....	11
Typical Cases of EUIPO .....	14
EUIPO-1 VDL E-Power .....	15
EUIPO-2 MESSI .....	17
EUIPO-3 HAWKERS .....	19
Typical Cases of JPO .....	21
JPO-1  V. UNI JAPAN .....	22
JPO-2 CHLOE V. CHLOEFRANCIS .....	25
JPO-3 チバニアン(Chibanian) .....	28
Typical Cases of KIPO .....	30
KIPO-1 LEONISA  V.  .....	31
KIPO-2 Merci  V.  .....	35
KIPO-3   V.  .....	38

Typical Cases of USPTO .....	40
USPTO-1 Target Brands, Inc. v. Hughes Brands, Inc. v. Hughes.....	41
USPTO-2 Hunter Industries, Inc. v. Toro Co.....	43
USPTO-3 Fiserv, Inc. v. Electronic Transaction Systems Corp.....	45

# Typical Cases of CNIPA

1. Title	 V. 洛天依	
2. Country	China	
3. Court	Trademark Office,CNIPA	
4. Case No.	22966772	
5. Date of the judgment	2019-09-12	
6. Parties: Plaintiff Defendant	Shanghai Henian Information Technology Co., Ltd. Kazuo Huiyou Food Co., Ltd (original defendant party: Beijing Tianzhigao Brand Management Consulting Co., Ltd.)	
7. Mark	Defendant (Disputed trademark)	Plaintiff (Cited trademark)
		
<b>8. Outline of the case</b>		
<p><b>The main causes stated by the plaintiff:</b> The disputed trademark "洛天依 LUOTIANYI" is similar to the trademark No.10666123"洛天依",etc. previously registered by the plaintiff used in connection with the similar goods or services, which violates the provisions of Article 30 of the Trademark Law. "洛天依" is an original virtual character created by the plaintiff, which has a fixed and unique appearance image and characteristics after a large number of practical use, and enjoys high popularity on the Internet. The application of the disputed trademark infringes the copyright, merchandising right of the plaintiff and the right to name of the 2-D idol, which violates the provisions of Article 32 of the Trademark Law.</p> <p><b>The main causes of the defendant in reply:</b> The evidence provided by the plaintiff is insufficient to prove that the disputed trademark infringes the copyright and merchandising right of the plaintiff. The goods and services designated by the two trademarks of both parties are obviously different and will not confuse consumers. The defendant has no subjective bad-faith intention and the application of the disputed trademark complies with the relevant provisions of the Trademark Law.</p> <p>The Trademark Office ruled that the application of the disputed trademark infringes the rights and interests of the character name of "洛天依", which violates the provisions of Article 32 of the Trademark Law "No application for trademark registration may infringe the existing prior rights of others."The registration application for the disputed trademark "洛天依 LUOTIANYI" shall not be approved.</p>		
<b>9. Summary of the judgment(Fact finding and opinions of the Courts)</b>		

Fact finding:

"洛天依", as an original virtual character created by the plaintiff, has a fixed and unique appearance image and characteristics after a large number of practical use, and enjoys high popularity on the Internet.

Opinions of the Trademark Office:

The Trademark Office deems that the designated goods of the disputed trademark "洛天依 LUOTIANYI" are Class 32 "Beer;Beer wort",etc. The cited trademarks,No.10666123, No.10666122, No.10666139 and No.10666138 "洛天依", are approved for Class 9 "Recorded discs", Class 16 "Printed matter", Class 28 "Game equipment" and Class 41 "Music education",etc. There are obvious differences in functions, use, sales channels, service contents and service methods between the designated goods of the disputed trademark and the approved goods and services of the cited trademarks. The designations of the distributed trademark are not similar to the ones of the cited trademarks.The trademarks are not used in connection with the similar goods or services.

According to investigation, "洛天依" is the world's first VOCALOID Chinese sound library and virtual image produced by Shanghai Henian Information Technology Co., Ltd. based on Yamaha's VOCALOID3 speech synthesis engine. The character of “洛天依”is a 15-year-old girl with gray hair, green pupil, who has jasper hair accessories and a Chinese knot on her waist. On July 12, 2012,Shanghai Henian Information Technology Co., Ltd.launched the "洛天依" character and sound library for the first time at the 8th China International Animation and Game Expo.In February 2016, "洛天依" appeared on Hunan TV Spring Festival Gala and became the first virtual singer to appear on the mainstream TV media in China. Then "洛天依" cooperated with a lots of singers for many times. "洛天依" has a large number of fans. The Weibo official account of "洛天依" provided by the plaintiff shows that she has 2.56 million followers and the number of Weibo’s Chaohua (super topics)with her name has been read 430 million times. "洛天依" not only cooperates with many artists on the Gala, grand ceremonies and shows, but also has successively endorsed famous brands such as KFC and Mirinda, enjoying high popularity. The character name "洛天依" is not a common collocation in Chinese which has strong originality and significance. The disputed trademark "洛天依 LUOTIANYI" is same as the character name, which is easy to cause the relevant public think that the goods designated for use are come from or have a specific connection with the plaintiff, thus causing confusion and misunderstanding. In this case, the defendant's registration application for "洛天依 LUOTIANYI" improperly takes advantage of the popularity and influence of character "洛天依"created by the plaintiff and infringes the rights and interests of the character name, which violates the provisions of Article 32 of the Trademark Law "No application for trademark registration may infringes the existing prior rights of others." According to Articles 32 and 35 of the Trademark Law, the disputed trademark "洛天依 LUOTIANYI" shall not be approved.

**10.Explanation and analysis**

"洛天依" is an original virtual character name created by the plaintiff, which belongs to the scope of legitimate rights and interests protected by Article 32 of the Trademark Law. The main protection requirements are that the name of the character enjoys high popularity, the applicant of disputed trademark is bad-faith filing, and the use of the disputed trademark on the designated goods or services is likely to cause the relevant public to mistakenly believe that it has been licensed by or has a specific connection with the prior rights holder.

In this case, "洛天依" is the name of a Chinese mainstream virtual singer which enjoys high popularity. The character name is not a common collocation in Chinese and has strong originality and significance. The registration of the disputed trademark likely makes the relevant public believe that the goods designated by the disputed trademark come from the goods of stakeholders related to the character name of "洛天依" or have a specific connection with them. The defendant improperly used the popularity and influence of the character created by the plaintiff, and squeezed out the commercial value and trading opportunities that the stakeholders related to the character name should enjoy. Therefore, the registration of the disputed trademark infringes the rights and interests of the plaintiff's "洛天依" character name, which violates the provisions of Article 32 of the Trademark Law "No application for trademark registration may infringes the existing prior rights of others."

### **11. Suggestions to applicants**

"洛天依" is not a name of natural person but a name of an electronically synthesized virtual character. It cannot claim the right of name or be protected by copyright. However, "洛天依" as a well-known virtual singer name, has high commercial value which has the legitimacy and necessity of protection. The plaintiff can claim the rights and interests of character names through Article 32 of Trademark Law, and fully prove the character name awareness to demonstrate the possibility of misunderstanding the relevant public.

## CNIPA-2 中智行

1. Title	"中智行" Trademark Opposition Case	
2. Country	China	
3. Court	Trademark Office, CNIPA	
4. Case No.	33953937	
5. Date of the judge	2020-10-09	
6. Parties: Plaintiff Defendant	Zhongzhixing technology co., ltd Xu Haojie	
7. Mark	Disputed trademark	Cited trademark (if any)
	中智行	
8. Outline of the case		
<p><b>The main causes stated by the plaintiff:</b> The plaintiff is a trip company on the basis of artificial intelligence driver and driverless technology. The disputed trademark infringes the plaintiff's right to the prior firm name and the defendant maliciously squatted the trademark "中智行" which previously used by the plaintiff. The defendant has applied for registration of more than 170 trademarks in various classes, many of which are identical with the prior firm name of others. The defendant's trademark registration applications are not for the purpose of use which violates the principle of good faith, disturbs the normal trademark registration order and harms the public interest.</p> <p>The defendant did not reply within the time limit.</p> <p>The Trademark Office ruled that the application for registration of the disputed trademark violates the Article 4 of the Trademark Law "malicious trademark registration application for non-use purpose". The registration application of the disputed trademark shall not be approved.</p>		
9. Summary of the judgment		
<p><b>Fact Finding</b></p> <p>The defendant, as a natural person has applied for registration of more than 170 trademarks in more than 20 classes of goods or services. And the goods or services he designated have a large industry span, including special classes with strong industry attributes and qualification requirements. And a large number of his trademark registration applications are suspected of copying and imitating firm names in emerging science and technology industries.</p> <p><b>Opinions of the Trademark Office</b></p> <p>According to the Trademark Office, the disputed trademark "中智行" is designated for use in class 39 "freight; River transportation", etc. The plaintiff claimed that the defendant maliciously squatted the trademark</p>		



previously used by the plaintiff and acquired certain influence, which infringed its right to the prior firm name. But the evidences provided by the plaintiff is insufficient to prove that the plaintiff had used the trademark and firm name of "中智行" in the same or similar services like "Freight, River transportation",etc. before the application date of the disputed trademark and acquired certain influence. The causes stated by the plaintiff are not groundless.

However, according to investigation, the defendant has applied for registration of more than 170 trademarks in more than 20 classes of goods or services, including dozens of trademarks are identical with or similar to others' firm names. The defendant has not submitted the evidences of the above trademarks' usage and creative sources, nor the evidences of his intention to use the trademarks. The number and the designated classes of the trademarks registration application obviously exceed the normal needs of market entities. Combined with the fact that the disputed trademark is identical with the original firm name characters of the plaintiff, it can be concluded that the defendant's registration application for the disputed trademark violates the Article 4 of the Trademark Law "malicious trademark registration application for non-use purpose". According to Articles 4 and 35 of the Trademark Law, the registration application of the disputed trademark shall not be approved.

#### **10. Explanation and analysis**

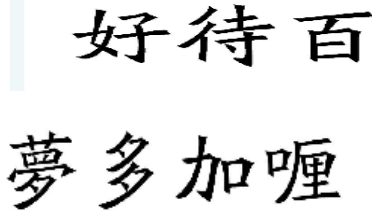
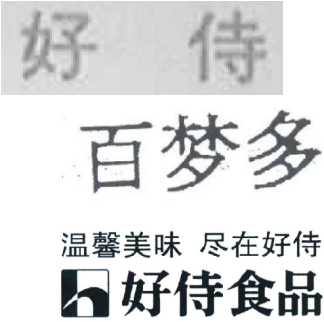
The focus of this case lies in how to judge whether the registration application of the disputed trademark is "malicious application not for the purpose of use" and how to grasp the two elements of "not for the purpose of use" and "malice". The basic situation such as the applicant's industry characteristics, business scope and qualifications, the number, class and time span of trademark registration application, the specific composition and actual use of the trademarks, as well as whether the applicant has malicious registration and other factors should be considered comprehensively to judge whether the registration application obviously inconsistent with the business practices, exceeds the normal business needs and actual business capabilities which has the intention to seek illegitimate interests.

In this case, the defendant, as a natural person, as a natural person, has applied for registration of more than 170 trademarks in more than 20 classes of goods or services. And the goods or services he designated have a large industry span, such as Class 33 liquor, Class 5 drugs, etc. And it includes special classes with strong industry attributes and qualification requirements, such as Class 7 metalworking machinery, Class 36 insurance consulting, Class 38 radio broadcasting services, etc. The number and classes of trademarks applied by the defendant obviously exceed the normal needs of market entities. And a large number of trademark registration applications are suspected of copying and imitating the firm names in emerging science and technology industries which have been opposed by many entities. It is difficult to regard it as coincidence that so many trademarks applied for registration by the defendant is quite similar to the trademarks or firm names previously used by others and has strong significance. Moreover, the defendant failed to prove that the disputed trademark was created independently or explained the creative source of the trademark design, nor did he submit the evidences of the use. Therefore, it can be concluded that the registration application of the disputed trademark violates the Article 4 of the Trademark Law "Malicious trademark registration application not for the purpose of use" and should not be approved for registration.

## 11. Suggestions to applicants

In 2019, the Trademark Law was revised for the fourth time, adding "malicious trademark registration applications not for the purpose of use shall be refused" in Article 4. This provision aims to resolutely curb malicious registration applications not for the purpose of use, stop hoarding trademark registration applications, and effectively regulate the order of trademark application for registration. While claiming other provisions, the plaintiffs can also pay attention to the overall situation of the defendants' registered trademark and trademark registration applications. And the plaintiffs can make full use of Article 4 of the Trademark Law to stop malicious trademark filing. The establishment of this provision requires a certain number of trademark registration application. However, there is no absolute standard of the quantity which should be considered from multiple dimensions such as "quality" and "quantity" of applied trademarks. When claiming this provision, in order to meet the requirements of the Article 4 of the Trademark Law, the plaintiff should not only inquire about the number of trademark registration applications of defendant, but also elucidate whether the disputed trademark applications of defendant matches its business needs and capabilities or obviously exceeds the business needs.

## CNIPA-3 好待百 V. 梦多咖喱

1. Title	"好待百" and "梦多加喱" Trademark Opposition Case	
2. Country	China	
3. Court	Trademark Office, CNIPA	
4. Case No.	33838169	
5. Date of the judge	2020-07-06	
6. Parties: Plaintiff Defendant	House Food Group Inc. Nanjing Yaosheng Trading Co., Ltd	
7. Mark	Disputed trademark	Cited trademark (if any)
		
8. Outline of the case		
<p><b>The main causes stated by the plaintiff:</b> The disputed trademarks and the cited trademarks have similar designated goods. The disputed trademarks "好待百" and "梦多加喱" are changes and splits of the cited trademarks. Using the disputed trademarks on the designated goods will easily makes consumers confuse and misunderstand the source of goods. The application of the disputed trademarks violates the provisions of Article 30 of the Trademark Law.</p> <p>The main evidences submitted by the plaintiff are the sales bill of "好侍百梦多" curry, the advertising of newspapers, journal, magazines and other related media, etc.</p> <p>The defendant did not reply within the time limit.</p> <p>The Trademark Office ruled that the disputed trademarks and the cited trademarks constitute similar trademarks on similar goods, and the disputed trademarks shall not be approved.</p>		
9. Summary of the judgment		
<p><u>Fact Finding</u></p> <p>The date of the cited trademarks applying for registration is before the date of the disputed trademarks' applications. The cited trademarks are designated for use in Class 30 and are all valid registered trademarks belong to the plaintiff.</p>		

### Opinions of the Trademark Office

According to the Trademark Office, the cited trademarks "好侍" and "百梦多" of the plaintiff have gained certain popularity in curry products industry after long-term publicity and use. And the disputed trademarks "好待百" and "梦多加喱" are similar in character composition to the cited trademarks "好侍" and "百梦多". Both the disputed trademarks and the cited trademark are designated for use in edible starch, curry powder, etc. The coexistence of the above trademarks will easily make consumers confuse and misunderstand the source of goods. So the trademarks of both parties constitute similar trademarks designated for use in similar goods. The registration applications for the disputed trademarks violates the provisions of Article 30 of the Trademark Law and shall not be approved.

### **10. Explanation and analysis**

The focus of this case lies in whether the trademarks of both parties constitute similar trademarks designated for use in similar goods. In trademark opposition procedures, when judging whether the trademarks are identical with or similar to each other should not only compare the marks themselves, but also comprehensively consider the application behavior of the applicant, the popularity of the cited trademark, and the actual use and other factors in specific cases.

Firstly, according to the evidences provided by the plaintiff, trademarks such as "好侍" and "百梦多" have been approved for the registration before the disputed trademarks applied for the registration, and are used in products such as "Curry" in the form of combination trademark. After long-term extensive publicity and use by the plaintiff, the trademark logo of "好侍百梦多咖喱" actually used in the past has gained certain popularity among the relevant public.

Secondly, in this case, the plaintiff not only applied trademarks like "好待百" and "梦多加喱" for registration, but also applied for "好待百梦多咖喱" and "好待白梦多咖喱". In the substantive examination procedure, "好待百" and "梦多加喱" are examined separately, which can be distinguished from the trademarks previously registered and used by the plaintiff. However, two separately registered trademarks belong to the same defendant party, and it cannot be ruled out that it has the intention to use trademarks in combination. From the aspect of the trademark applications of the defendant party, the application of the trademarks "好待百" and "梦多加喱" for registration has the suspicion of changing and splitting the them such as "好侍" and "百梦多" and the goods of "Curry", thus avoiding trademark examination, and has the intention of imitating and clinging to the well-known trademarks of the plaintiff. If the disputed trademarks "好待百" and "梦多加喱" are approved to be registered and then combined for use on designated goods by the defendant party, they are highly similar to the famous logo of "好侍百梦多咖喱" held by the plaintiff party. If the disputed trademarks are approved to be registered on the same or similar goods such as "curry powder (condiment)" and used in market operation activities, it can't be distinguished with the general attention of the relevant public, which easily makes consumers confuse and misunderstand the source of the goods.

Comprehensively considering the above situation, the two trademark cases are combined in one case, and it can



be judged that the disputed trademarks and the cited trademarks constitute similar trademarks designated for use in similar goods, and the registration of the disputed trademarks violates the provisions of Article 30 of the Trademark Law.

#### **11. Recommendations to Applicants**

It is a common form of malicious trademark registration application that applicants apply well-known trademarks for registration through changing and splitting them and submit application respectively to avoid trademark examination. In this circumstances, plaintiffs can claim rights via opposition procedures. They should fully prove the popularity of the their cited trademarks and the subjective intention of the defendant to imitate and cling to the their trademark (such as applying for a plurality of trademarks similar to the plaintiff's, deliberately confusing them in actual use, etc.).

## Typical Cases of EUIPO

## EUIPO-1 VDL E-Power

/1. Title	VDL E-POWER	
2. Country	European Union	
3. Court	General Court	
4. Case No.	T-755/20 / T-756/20	
5. Date of the judgment	10 November 2021	
6. Parties: Plaintiff Defendant	Nissan Motor Co. Ltd European Union Intellectual Property Office (EUIPO) Other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court: VDL Groep BV	
7. Mark	Opponent / Plaintiff	Applicant / Intervener
	 (UK figurative mark)  (FR figurative mark)	VDL E-POWER
<b>8. Outline of the case</b>		
<p>The applicant sought to register the words signs ‘VDL E-POWER’ (T-755/20) and ‘VDL E POWERED’ (T-756/20) as European Union trade marks for goods in Classes 7, 9, and 12, such as power installations, machine tools, motors and vehicles. An opposition was filed based on earlier UK and French figurative marks registered for goods in Classes 9 and 12, pursuant to Article 8(1) (b) EUTMR. The Opposition Division upheld the opposition based on the earlier UK figurative mark and refused registration of the marks applied for.</p> <p>The Board of Appeal however annulled the decision and upheld the applicant’s appeal. The Board found that the conflicting signs were visually and conceptually similar and had an average degree of phonetic similarity. The element ‘vdl’ of the mark applied for differentiated the conflicting signs, and had to be regarded as distinctive. The relevant public was composed of the English-speaking and French speaking general public and of professionals with expertise in the automobile industry. The level of attention of this relevant public was likely to be higher than average. Therefore, there was no likelihood of confusion on the part of that public. The opponent filed an action before the General Court, which was subsequently dismissed.</p>		
<b>9. Summary of the judgment (Fact finding and opinions of the Courts)</b>		
<p>In its judgment the General Court considered in particular the impact of the weak distinctive character of the earlier mark and of the common weak elements. The element ‘e-power’ refers to electric vehicles, electric motors and systems enabling vehicles or their components to run on electricity. Therefore, due to its connection to the goods in question, (vehicles, accessories or parts) it has, at most, a low degree of distinctiveness, insofar as it was clear that that term alludes to the type of energy ensuring the functioning of the goods in question or related to</p>		

those goods.

It follows that the visual and phonetic similarity between the conflicting signs and their low degree of conceptual similarity, on account of an element whose distinctiveness is merely low, are likely to be offset by the visual, phonetic and conceptual difference. That difference carries more weight in the global assessment of likelihood of confusion, all the more so given that the relevant public will have a higher than average level of attention. The Court confirmed that the low degree of distinctiveness of that element, the differences between the conflicting signs, and the level of attention of the relevant public ruled out likelihood of confusion on the part of that public.

#### 10.Explanation and analysis

Earlier marks with a low degree of distinctiveness enjoy a certain degree of protection as it has been underscored by jurisprudence. However, this protection has its limits when this element is included in a later composite mark which also includes more distinctive elements.

This judgment is in line with the approach taken by the European Intellectual Property Network in its Common Practice on Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components (CP5)). According to this practice a coincidence in an element with a low degree of distinctiveness will not normally on its own lead to likelihood of confusion. There may be likelihood of confusion only if the other components are of a lower (or equally low) degree of distinctiveness, or are of insignificant visual impact, and the overall impression of the marks is similar.

#### 11.Suggestions to applicants

Applicants are advised to make a prior search in the Office's databases for already existing earlier marks (EU and national) to prevent possible conflicts:


<https://euipo.europa.eu/eSearch/>

<https://www.tmdn.org/tmview/#/tmview>

Opponents, when relying on an earlier mark with low degree of distinctiveness, should be aware of the scope of protection of such earlier mark. They should thus prepare with arguments, possible evidence, why the relevant public would be likely to confuse the marks, especially if there are other, more distinctive differing elements.



## EUIPO-2 MESSI

1. Title	MESSI	
2. Country	European Union	
3. Court	Court of Justice	
4. Case No.	Joint Cases C-449/18 P and C-474/18 P	
5. Date of the judgment	17 September 2020	
6. Parties: Plaintiff	European Union Intellectual Property Office (EUIPO)	
Defendant	Opponent in the first Instance: J.M.-E.V. e hijos, S. R. L. Lionel Andrés Messi Cuccittini	
7. Mark	Applicant	Opponent
		MASSI
<b>8. Outline of the case</b>		
<p>Lionel Andres Messi Cuccittini, the applicant, applied to register the figurative mark ‘MESSI’ for various goods in Classes 9, 25 and 28 in 2011. The application was opposed by the owner of the trade marks ‘Massi’, a Spanish company that sells cycling equipment and clothing, registered for goods in the same classes. The opposition was upheld by the Office’s Opposition Decision and then by its First Board of Appeal. The General Court did not agree and concluded there was likelihood of confusion. This was also endorsed by the Court of Justice.</p>		
<b>9. Summary of the judgment (Fact finding and opinions of the Courts)</b>		
<p>The Opposition Division and the Boards concluded that both marks had the letters ‘M-SSI’ in the same order and therefore they are visually and phonetically almost identical. The goods were identical or highly similar. The conceptual difference would only be seen by a part of the relevant public interested in football, or sport in general.</p> <p>The General Court agreed with the comparison of the goods and the visual and aural comparison, but not with the conceptual comparison. It stated that Lionel Messi was a public figure known not only to football fans but also to ‘reasonably attentive and informed persons who read the press, watch the news on television, go to the cinema or listen to the radio, where he can be seen and where he is regularly talked about’. This was, in particular, the case</p>		

in connection with the relevant goods, namely sporting equipment.

And in this case the Court found that the conceptual difference between the signs effectively counteracted their visual and phonetic similarities, and therefore there was no likelihood of confusion on the part of the public.

#### **10. Explanation and analysis**

##### Analysis

Conceptual differences between two signs could counteract the visual and phonetic similarities between them, provided that at least one of those signs had a clear and specific meaning for the relevant public, so that that public was capable of grasping it immediately. This has been the approach since the ‘Picaro’ judgment<sup>1</sup>, where the Court of Justice considered the conflicting signs Picaro and Picasso and stated that conceptual differences between two signs could offset the visual and phonetic similarities between them. This applies to the earlier mark but also to the contested mark.



In the present case, indeed, the conceptual difference was enough to counteract the similarities. The Court found that it is only a negligible part of the relevant consumers that would have never heard of the Argentinian football player and accepted the impact of the reputation of the person whose name was applied for as the contested mark on the perception of the relevant public.

#### **11. Suggestions to applicants**

Famous applicants registering their names should be aware of this judgment and use it in their defense. However, they should also be aware of the difference European countries attribute to first names and surnames. Also, they should consider whether this fame is indeed of such extent that it gives their mark a clear and specific meaning which will differentiate it in the eyes of the relevant public from the mark in conflict.

<sup>1</sup> C-361/04, later confirmed inter alia by the judgment in C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al.

## EUIPO-3 HAWKERS

1. Title	HAWKERS	
2. Country,	European Union	
3. Court	General Court	
4. Case No.	<a href="#">T- 651/18</a>	
5. Date of the judgment	26 June 2019	
6. Parties: Plaintiff	Sonu Gangaram Balani Balani, Anup Suresh Balani Shivdasani, Amrit Suresh Balani Shivdasani	
Defendant	European Union Intellectual Property Office (EUIPO) Other party to the proceedings before the Board of Appeal of EUIPO: Play Hawkers, S.L.	
7. Mark	Applicant	Opponent
		
8. Outline of the case	<p>The applicants applied for the figurative mark 'HAWKERS' in 2016 for watches and jewelry in Class 14. An opposition was filed based on the earlier European trade mark registration, the figurative mark 'HAWKERS' in relation with goods in class 9, mainly glasses and sunglasses.</p> <p>The first instance and the Board of Appeal concluded that the marks are practically identical and the earlier mark is very well known in Spain for sunglasses. The goods are closely related and are directed at the general public, and therefore applicants could take advantage of the association with the earlier reputed mark. The contested trade mark was refused for the goods at issue as it could take unfair advantage of the reputation in Spain of earlier European Union trade mark.</p> <p>The applicants contested that the evidence filed by the opponent would be sufficient to establish the earlier mark's reputation, however, the General Court decided against them and confirmed the decision of the former instances.</p>	
9. Summary of the judgment (Fact finding and opinions of the Courts)	<p>The Court considered that the relevant factors to assess the existence of repute, that is to say, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, are merely illustrative. The opponent cannot be required to furnish proof of the reputation of a mark be based on all those elements.</p>	

The Court considered that the significant presence of the opponent's mark on the internet, together with the other evidence submitted, was sufficient to establish reputation and refused the application for all the goods applied for.

#### 10.Explanation and analysis

The opponent is free, in principle, to choose the form of evidence which it considers useful to submit, since the law does not list the forms, prescribe the amount of or attribute the probative value to the evidence which the opponent should submit in order to demonstrate the existence of the earlier mark's reputation.

Where the requirements of reputation are met, the contested application may also be refused for goods which are found dissimilar and would lead to dismissing the opposition when assessing "only" likelihood of confusion (or double identity) under Article 8(1) EUTMR.

#### 11.Suggestions to applicants

Applicants are advised to make a prior search in the Office's databases for already existing earlier marks (EU and national) to prevent possible conflicts:

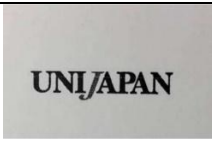
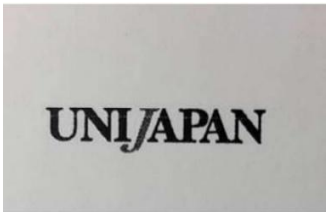
<https://euipo.europa.eu/eSearch/>

<https://www.tmdn.org/tmview/#/tmview>

The argument that the applicant did not know of the reputed mark's existence or that it did not act in bad faith is irrelevant for the application of Article 8(5) EUTMR. Contrary to Article 8(1) EUTMR where a similarity or identity of the goods and services is required, the trade mark application may also be refused for dissimilar goods under Article 8(5) EUTMR.

Opponents should carefully select evidence to establish reputation, being mindful of the fact that the means of evidence provided in jurisprudence and the guidelines is illustrative. The importance and probative value of the evidence is assessed on the case-by-case basis.

## Typical Cases of JPO

1. Title	 <b>UNI JAPAN</b> V.	
2. Country	Japan	
3. Court	Japan Patent Office	
4. Case No.	2019-900178	
5. Date of the judgment	2020-03-18	
6. Parties: Plaintiff Defendant	UNI JAPAN UNI JAPAN Co, Ltd.	
7. Mark	Plaintiff (Opponent's Mark)	Defendant (The Trademark)
	Opponent's Mark 1 ユニジャパン  Opponent's Mark 2 	<b>UNI JAPAN</b>
8. Outline of the case		
A case where a Trademark consists of Alphabetic characters of "UNI JAPAN". Because "UNI JAPAN" falls under "a famous mark indicating a non-profit organization undertaking a business for public interest", the Trademark falls under Article 4(1)(vi) of the Trademark Act, and it is not acknowledged that the Trademark is approved by the Opponent that is another person, it is determined that the Trademark falls under Article 4(1)(viii) of the Trademark Act.		
9. Summary of the judgment (Fact finding and opinions of the Courts)		
<u>Fact finding:</u> It is acknowledged that the Opponent or the like has used "ユニジャパン (YUNI JAPAN)" and the Opponent's Mark 1 and the Opponent's Mark 2 consisting of the characters of "UNI JAPAN" as indicated in the attachment as marks indicating the Opponent or the like for the business for holding "Tokyo International Film Festival" that is one of the world big 11 film festivals and is known as the largest international film festival in Asia and the film-related information transmission business, that the characters of "ユニジャパン (YUNI JAPAN)" are posted as the abbreviation name of the Opponent or the like many times in the newspapers published since November 1991 to the time of the decision for registration of the Trademark, and that the Opponent or the like is the promotor of "Tokyo International Film Festival" and the attendance and the number of participant companies		

of the film festival are large. In light of all the above, it is reasonable to say that both of the Opponent's Mark 1 and the Opponent's Mark 2 are widely known as the marks indicating the abbreviation name of the Opponent or the like in the field related to film culture and film industry promotion at the time of the application for the registration of the Trademark and the time of the decision for registration of the Trademark. Accordingly, it should be said that the Opponent's Mark acquired prominence as the abbreviation name of the Opponent at the time of the application for the registration of the Trademark and the time of the decision for registration of the Trademark.

Judgment by the Body:

(1) Regarding applicability of Article 4(1)(vi) of the Trademark Act

The Opponent is an incorporated foundation authorized as a "public interest incorporated foundation" on July 1, 2010. In addition, it should be said that the Opponent's Mark has acquired prominence as the mark indicating the abbreviation name of the Opponent at the time of the application for the registration of the Trademark and the time of the decision for registration of the Trademark.

Regarding the appearance, the distinctiveness caused from the difference between the appearances of the Trademark and the Opponent's Mark is feeble or the appearances of the Trademark and the Opponent's Mark are similar to each other. The Trademark and the Opponent's Mark have the same pronunciation and the same idea. Therefore, in light of impression, memory, association, or the like given to traders and consumers by the appearances, the pronunciations, and the ideas of the Trademark and the Opponent's Mark, it is reasonable to say that the Trademark and the Opponent's Mark are similar to each other.

Therefore, the Opponent's Mark is a mark that falls under "a famous mark indicating a non-profit organization undertaking a business for public interest" described in Article 4(1)(vi) of the Trademark Act, and the Trademark is a trademark similar to the Opponent's Mark.

Then, it can be said that the Trademark is a mark indicating a non-profit organization undertaking a business for public interest and is a trademark similar to the famous mark. Accordingly, the Trademark falls under Article 4(1)(vi) of the Trademark Act.

(2) Regarding applicability of the Trademark to Article 4(1)(viii) of the Trademark Act

The Opponent's Mark 2 consists of Alphabetic characters of "UNI JAPAN," it should be said that the Opponent's Mark had acquired prominence as the abbreviation name of the Opponent at the time of the application for the registration of the Trademark and the time of the decision for registration of the Trademark. Therefore, the Opponent's Mark 2 falls under the "famous abbreviation name" described in Article 4(1)(viii) of the Trademark Act.

The Trademark consists of Alphabetic characters of "UNI JAPAN", and the Opponent's Mark 2 consists of Alphabetic characters of "UNI JAPAN." The Trademark and the Opponent's Mark have a common spelling and give rise to the same pronunciation of "ユニジャパン (YUNIJAPAN)" according to the constituent characters. Then, the Trademark has the common spelling to the Opponent's Mark 2 that is the prominent abbreviation name of the Opponent, and the constituent characters of the Trademark and the Opponent's Mark 2 give rise to the same pronunciation. Therefore, it is reasonable to say that the prominent abbreviation name of the Opponent is evoked and associated.

Therefore, it can be said that the Trademark is objectively grasped as including the prominent abbreviation name of the Opponent in its configuration. It is acknowledged that the holder of the Trademark right is different from the Opponent, and it is not acknowledged that the holder of the Trademark right is approved by the Opponent who is different from the holder of the Trademark right. According to the above, the Trademark is a trademark including the famous abbreviation name of another person in its configuration and is not approved by the person concerned. Accordingly, the Trademark falls under Article 4(1)(viii) of the Trademark Act.

**10.Explanation and analysis**

**11.Suggestions to applicants**



**JPO-2 CHLOE V. CHLOEFRANCIS**

1. Title	<p style="text-align: center;"><b>CHLOE</b> <span style="margin-left: 100px;">CHLOEFRANCIS</span></p> <p style="text-align: center;">V.</p>	
2. Country	Japan	
3. Court	Japan Patent Office	
4. Case No.	2018-900048	
5. Date of the judgment	2019-05-23	
6. Parties: Plaintiff Defendant	Chloe S.A.S. Jay Jay Japan Inc.	
7. Mark	Plaintiff (Cited Trademark)	Defendant (The Trademark)
	<p style="text-align: center;">Cited Trademark 1</p> <p style="text-align: center;"><b>CHLOE</b></p> <p style="text-align: center;">Cited Trademark 2</p> <p style="text-align: center;"><b>Chloé</b></p> <p style="text-align: center;">Cited Trademark 3</p> <p style="text-align: center;"><b>Chloé</b></p>	<p style="text-align: center;">CHLOEFRANCIS</p>
8. Outline of the case		
A case where it has been determined that it should be said that the opponent's trademark is widely recognized in the fashion field, the degree of originality of opponent's trademark is high and the degree of the similarity with the Trademark of opponent's trademark is high, and traders having contact with the Trademark associate the well-known and prominent opponent's trademark, and there has been a risk of confusing the source thereof.		
9. Summary of the judgment (Fact finding and opinions of the Courts)		

Fact finding:

It is acknowledged that the opponent's trademark had already been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark used for the opponent's product at the time of the registration application of the Trademark and that the state had continued at the time of the decision of registration of the Trademark. Since the characters of "Chloe" or "CHLOE" (including ones with no accent aigu) according to the opponent's trademark are not described in English, French, German, and Italian dictionaries, it can be said that the degree of the originality is relatively high.

Judgment by the Body:

(1) Degree of similarity between the Trademark and the opponent's trademark

A The Trademark

The Trademark consists of Alphabetic characters of "CHLOEFRANCIS" in horizontal writing. The spelling of the characters of "CHLOE" in the first half of the configuration is the same as that of prominent characters of "Chloe", from which accent aigu is removed, is not described in general dictionaries and the like, and is understood as a coined word which does not have a specific meaning. Furthermore, the characters of "FRANCIS" in the second half has meaning of "a name of a man in English".

Then, it is understood that the Trademark consists of the characters (word) of "CHLOE" and the characters (word) of "FRANCIS", and the entire configuration of the Trademark is not known as a trademark having a specific meaning. Therefore, the Trademark does not have a specific idea. Then, from the character part of "CHLOE" in the configuration, the well-known and prominent "Chloe" is easily recognized in relation to the designated goods "Shoes and boots [other than special footwear for sports]". Therefore, although traders and consumers having contact with the Trademark focus attention on the character part of "CHLOE" and are strongly impressed, the Trademark simply gives rise to the pronunciation of "kuroe" from the character part of "CHLOE" in addition to the pronunciation of "kuroefuransisu" caused from the entire constituent characters, and it is reasonable to understand that this causes the idea of "the Chloe brand related to the business of the opponent".

B The opponent's trademark

The opponent's trademark consists of Alphabetic characters of "Chloe" or "CHLOE" in horizontal writing, corresponds to the character part, and gives rise to the pronunciation of "kuroe". Since the opponent's trademark has been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark indicating the opponent's product, it is reasonable to understand that the opponent's trademark gives rise to the idea of "the Chloe brand related to the business of the opponent".

C Degree of similarity between the Trademark and the opponent's trademark

The Alphabetic character part "CHLOE" that is the main portion of the Trademark and the opponent's trademark have common spelling except for a point of whether or not accent aigu is included. Therefore, since appearances of the trademarks are close to each other and both trademarks have the pronunciation of "kuroe" and the idea of "the Chloe brand related to the business of the opponent", it can be said that the degree of the similarity between both trademarks is high.

(2) Relationship between the designated goods of the Trademark and the opponent's product, commonality of consumers, and other actual trade conditions

The opponent's product includes "shoes", and it is obvious that this is included in the designated goods "Shoes and boots [other than special footwear for sports]" of the Trademark. Therefore, consumers of the two trademarks coincide with each other. Furthermore, the Trademark consists of the Alphabetic characters of "CHLOEFRANCIS" which are horizontally written in series. However, the holder of the trademark provides a space between "CHLOE" and "FRANCIS" and uses the characters of "CHLOE FRANCIS".

(3) Risk of confusion about the source

According to the above facts, the opponent's trademark had been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark indicating the opponent's product at the time of registration application and the decision of registration of the Trademark, and it can be said that the degree of the originality of the opponent's trademark is relatively high. Furthermore, it can be said that the degree of the similarity between the Trademark and the opponent's trademark is high. Then, the designated goods of the Trademark and the opponent's product include the same goods and have common consumers. In consideration of this, in a case where the Trademark is used for its goods designated at the time of the registration application and the decision of registration of the Trademark, traders and consumers coming into contact with this associate and recall the well-known and prominent opponent's trademark and wrongly recognize the goods as goods relating to the business of a person who has an economic or organizational relation with the opponent, and it should be said that there has been a risk of causing confusion about the source. Therefore, the Trademark falls under Article 4(1)(xv) of the Trademark Act.

**10.Explanation and analysis**

**11.Suggestions to applicants**

**JPO-3 チバニアン(Chibanian)**

1. Title	チバニアン (Chibanian)	
2. Country	Japan	
3. Court	Japan Patent Office	
4. Case No.	2017-900179	
5. Date of the judgment	2017-11-01	
6. Parties: Plaintiff	INTER-UNIVERSITY RESEARCH INSTITUTE CORPORATION RESEARCH ORGANIZATION OF INFORMATION AND SYSTEMS	
Defendant	MURAYAMA, Akira	
7. Mark	Plaintiff (Cited Trademark)	Defendant (The Trademark)
		チバニアン (Chibanian)
<b>8. Outline of the case</b>		
A case where it is determined that the Trademark was registered while violating Article 4(1)(vii) of the Trademark Act, with regard to the designated goods of "Printed matter", since traders and consumers who see it may falsely recognize as a book and a literature made by the public institution.		
<b>9. Summary of the judgment (Fact finding and opinions of the Courts)</b>		
<p>1 According to the evidence and reasons submitted by the opponent, the following facts can be acknowledged.</p> <p>(1) The opponent is an Inter-University Research Institute Corporations, and national universities, national museum and institutes and prefectural museums including National Institute of Polar Research belonging to the opponent (joint research team) have developed the research on the geological stratum which was found along Yoro River in Ichihara-city, Chiba (Chiba section), Chiba section is the geological stratum which indicates the final geomagnetic reversal occurred in the earth about 770000 years ago, this is defined as "チバニアン (Chibanian)" which means "Chiba era", Chiba section is a candidate of "Global Boundary Stratotype Section and Point (GSSP)" as a geological stratum representing a boundary between geological ages, and the application was made to International Union of Geological Sciences on June 7, 2017.</p> <p>(2) Although the name of "チバニアン (Chibanian)" is a Latin word of "Chiba era", the name of "チバニアン (Chibanian)" is a coined word which was selected from among a plurality of candidates by National Institute of Polar Research which is a member of the joint research team.</p>		

(3) In a case where "Chiba section" is approved as the GSSP by International Union of Geological Sciences, "Chiba section" may be named as "チバニアン (Chibanian)" and may be an academic term which specifies a single era of the geological age.

(4) From October 16, 2015 to the time of the registration application of the Trademark, the facts of (1) and (3) were reported in national newspapers and local newspapers and NHK news on March 28, 2016, were introduced in the websites and were mentioned in the dictionaries on the websites as a current-events term. Accordingly, the characters of "チバニアン (Chibanian)" have been generally recognized as the name of "Chiba section" in some degree in Japan.

(5) The registration of the Trademark was filed on August 25, 2016, after the news report in (4), by the holder of the Trademark.

## 2 Applicability of Article 4(1)(vii) of the Trademark Act

The Trademark consists of the standard characters of katakana of "チバニアン (Chibanian)" as described in No. 1, and the characters which indicate the name of "Chiba section" are a coined word made by the joint research team as described in 1(2).

As described in 1(4), before the registration application of the Trademark, many news reports have been made that "Chiba section" was applied to the international institution as a candidate of the geological stratum representing the boundary between the geological ages (Global Boundary Stratotype Section and Point (GSSP)). Therefore, it can be acknowledged that the facts of 1(1) and (3) have been widely known in general.

"Chiba section" which is the name of "チバニアン (Chibanian)" is applied to the international institute as a candidate of the GSSP by the joint research team including public institutions such as national universities and national museums and institutions and has high public interest. In a case where it is assumed that the word of "チバニアン (Chibanian)" which is the name of "Chiba section" be an academic term for specifying a single era of the geological age in a case where "Chiba section" is approved as the GSSP to the international institutions.




Then, in a case where the holder of the Trademark uses the Trademark for "Printed matter" in Class No. 16, traders and consumers who see it may falsely recognize as a book and a literature regarding the Chiba section (GSSP) made by the joint research team which is the public institution. In addition, this may disturb the order of business transaction and violates public benefit, and it being likely to cause damage to public order.

Therefore, with regard to "Printed matter" in Class No. 16, the Trademark falls under Article 4(1)(vii) of the Trademark Act

## 10.Explanation and analysis

## 11.Suggestions to applicants

## Typical Cases of KIPO

1. Title		
2. Country	Republic of Korea	
3. Court	Korean Intellectual Property Office (KIPO)	
4. Case No.	40-2017-00001	
5. Date of the judgment	2017.8.25	
6. Parties: Claimant Applicant	Asia Consulting Development Ltd. Jin Yong KIM	
7. Mark	Claimant	Applicant
		
8. Outline of the case		
9. Summary of the judgment (Fact finding and opinions of the Courts)		
<p>Legal basis for judgement</p> <p>Article 7(1)12 of the former Trademark Act (the version before being revised by law No. 14033 of Feb 29, 2016) prohibits registration of a trademark that is identical with or similar to any trademark (except for a geographical indication) that is recognized as indicating the goods of particular person among domestic or foreign consumers for unfair purposes such as obtaining unfair profits or inflicting harms on the particular person.</p> <p>The purpose of this provision is to protect any trademark which has not been registered in Korea but has been recognized as indicating the goods of a particular person among domestic and foreign consumers (herein after referred to as a trademark subject to imitation) by means of prohibiting registration of a trademark that is imitating the trademark by a third party who intends to take advantage of the fact that the said trademark has not been registered in Korea, with aim to freeride on the goodwill embodied in it, damage its value or inflict harm to the owner of the trademark subject to imitation by disturbing his/her business and etc.</p> <p>Accordingly, in order for the applied-for trademark in this case to meet the requirements under this provision, the trademark subject to imitation must be recognized as indicating the goods of a particular person among domestic and foreign consumers and the applicant must use a trademark identical with or similar to the said trademark for</p>		

unfair purposes. The following criteria must be examined:

- ① Whether the trademark subject to imitation is recognized as indicating the goods of a particular person among domestic and foreign consumers based on the period, method, way and scope of use and commercial activities in relation to the trademark and whether it is well-known to a significant degree by the standards of objectively measurable social norms;
- ② Whether there exist the unfair purposes will be determined by comprehensively considering well-knownness and creativity of the trademark subject to imitation, the degree of similarity between the applied-for trademark and the trademark subject to imitation, negotiation records concerning the trademarks between the applicant and the owner of the trademark subject to imitation, relationship between the two parties, evidence to show the applicant has specifically prepared for a business to use the applied-for mark, the identity/similarity or economic links between goods for which the applied-for trademark and the trademark subject to imitation are registered, commercial activities of goods and etc.; and
- ③ The above examination must be conducted based on the date of application for registration of the applied-for mark. (See Supreme Court Decision 2012hu672 dated Jun 28 2012).

Detailed judgement



Based on the such criteria, the applicant's trademark 'LEONESSA' and the claimant's prior registered trademarks 'LEONISA' and 'Leonisa' were examined as follows:

- ① In the visual aspect, the applicant's trademark is a combined trademark which is composed of a figure depicting the profile of a female lion walking to the right on top of the stylized English letters 'LEONESSA'.

The claimant's prior registered trademark no. 1 "LEONISA" is composed only of the capital English

letters and prior registered no. 2 "Leonisa" is composed of a circled capital letter 'L' and cursive English letters 'Leonisa' which are located side by side. All in all, they look different considering composition, writing style and number of letters and combination of a figure;

- ② In the conceptual aspect, the applicant's trademark can be conceptualized as a female lion by the figure in the trademark and the word 'LEONESSA' which means a female lion in Italian, so it could be recognized as such but the word could also be perceived as a coined word since the word is not familiar to average Korean consumers and 'LEONISA' in the claimant's trademarks is a coined word as it is not listed in the dictionary. Therefore, the applicant's trademark and the claimant's prior registered trademarks are considered dissimilar and hard to be compared to each other; and

- ③ In the phonetical aspect, the applicant's trademark is pronounced as /leonesa/, /leonessa/ or /lionesa/ and the



claimant's trademarks are pronounced as /leonisa/, such that they all have four syllables. In particular, if the applicant's trademark is pronounced as /leonesa/, except for the third vowels of the words /e/ and /i/, the rest of syllables are exactly identical, so their sounds are considered similar. Today, the phonetical similarity has the most significance when determining similarity of trademarks given the circumstances where products are frequently advertised by audio media such as radio or ordered through a telephone driven by the wide distribution of advertising media such as broadcasting and telephone (See Supreme Court Decision 97Hu3050 dated Nov 26 2002 and Supreme Court Decision 2001Hu3415 dated Sep 30 2005). Although the two parties' trademarks look different and their concepts are hard to be compared to each other, they are phonetically similar such that there is a likely of confusion and misunderstanding as to the source of the products. (See Supreme Court 97hu3050 dated Feb 25, Supreme Court 2001hu3415 dated Nov 26, 2002, Supreme Court 2004hu2628 dated Sep 30, 2005)

Next, well-knownness of the prior registered trademarks were assessed by comprehensively considering the evidence submitted by the claimant as follows:

- ① LEONISA S.A., an associate company of the claimant, was established in 1956 and is headquartered in Colombia. As a result of using the prior registered trademarks over six decades, these trademarks became Latin America's number one best-selling female underwear brand and more than 40 million products are produced and sold worldwide annually;
- ② In the judgment issued by the Colombian State Court in 2014, it was found that the prior registered trademarks were recognized as well-known;
- ③ The prior registered trademarks have been registered in the US, the EU and Japan;
- ④ In 2016, LEONISA S.A. spent 700 billion won for advertising its products and the prior registered trademarks have been continuously advertised and promoted through magazine, catalogue, website ([www.leonisa.com](http://www.leonisa.com)), Instagram, commercials and etc.; and
- ⑤ The products with the prior registered trademarks have been on the domestic online shopping malls and the information and articles about the said trademarks have been posted in blogs and media in Korea. Considering these facts, the prior registered trademarks have been recognized as indicating the products of a particular person with regard to female underwear among at least Colombian consumers at the time of filing an application for registration of the trademark in question.

In addition, whether the applicant's trademark was filed for the unfair purposes was assessed as follows:

- ① The applicant's trademark is similar to the claimant's marks;
- ② The goods 'clothes, dresses and pants' for which the applicant's trademark are registered are similar to or have an economic link with the goods 'clothes containing female underwear' for which the claimant's trademarks are registered;

③ All in all, it is difficult to see it as a simple coincidence that the applicant decided to use a trademark similar to the claimant's prior registered trademarks in relation to the goods similar to those for which the claimant's prior registered trademarks were registered;

④ In light of the today's internet environment in which product information is disseminated in real-time, it is judged that the applicant had known the existence of the claimant's prior registered trademarks before filing an application for registration of the trademark in question. Thus, it is determined that the applied-for trademark was filed for unfair purposes such as gaining unfair profit by taking advantage of the quality image or consumer attraction power of the claimant's prior registered trademarks by imitating them.

In conclusion, the applicant's trademark is similar to the claimant's trademarks which are recognized as indicating the goods of a particular person with regard to female underwear among consumers in Colombia and the goods for which the applicant's trademark is registered are also similar to those for which the claimant's prior registered trademarks were registered, therefore it is determined that the applicant filed the trademark for unfair purposes such as obtaining unjust profits by freeriding on the reputation of the prior registered trademarks under Article 7(1)12 of the former Trademark Act.

#### 10.Explanation and analysis

#### 11.Suggestions to applicants

메르시 비앙  
 KIPO-2 **Merci merci** v. **Merci bien**

1. Title	메르시 비앙 <b>Merci merci</b> vs <b>Merci bien</b>	
2. Country	Republic of Korea	
3. Court	Korean Intellectual Property Office (KIPO)	
4. Case No.	40-2019-256	
5. Date of the judgment	Sep 20 2019	
6. Parties: Claimant Applicant	August Storck KG Sun Young LEE	
7. trademark	Claimant	Applicant
	<b>Merci merci</b>	메르시 비앙 <b>Merci bien</b>
8. Outline of the case		
9. Summary of the judgment (Fact finding and opinions of the Courts)		
<p>A. Legal basis for judgement</p> <p>The purpose of Article 34(1)13 of the Trademark Act is to protect any trademark which has not been registered in Korea but has been recognized as indicating the goods of a particular person among domestic and foreign consumers (herein after referred to as a trademark subject to imitation) by means of prohibiting registration of a trademark that is imitating the trademark by a third party who intends to take advantage of the fact that the said trademark has not been registered in Korea, with aim to freeride on the goodwill embodied in it, damage its value or inflict harm to the owner of the trademark subject to imitation by disturbing his/her business and etc.</p> <p>Accordingly, in order for the applied-for trademark in this case to meet the requirements under this provision, the trademark subject to imitation must be recognized as indicating the goods of a particular person among domestic and foreign consumers and the applicant must use a trademark identical with or similar to the said trademark for unfair purposes. The following criteria must be examined:</p> <p>① whether the trademark subject to imitation is recognized as indicating the goods of a particular person among domestic and foreign consumers based on the period, method, way and scope of use and commercial activities in relation to the trademark or whether it is well-known to a significant degree by the standards of objectively measurable social norms;</p>		

② whether there exist the unfair purposes will be determined by comprehensively considering well-knownness and creativity of the trademark subject to imitation, the degree of similarity between the applied-for trademark and the trademark subject to imitation, negotiation records concerning the trademarks between the applicant and the owner of the trademark subject to imitation, relationship between the two parties, evidence to show the applicant has specifically prepared for a business to use the applied-for trademark, the identity/similarity or economic links between goods for which the applied-for trademark and the trademark subject to imitation are registered, and commercial activities of the goods concerned; and

③ The above examination must be conducted based on the date of application for registration of the applied-for trademark. (Supreme Court Decision 2011hu3896 dated May 9 2013).

#### B. Detailed judgement

In order to determine whether the applied-for trademark was filed for unfair purposes such as gaining unfair profit or inflicting harm on the particular person under Article 34(1)13, it was assessed as follows:

메르시 비앙

① The applicant's trademark 'Merci bien' and the claimant's prior registered trademarks 'merci' and '메르씨' commonly have the French word 'merci' which means 'thank you' and is relatively familiar to Korean consumers, so it is difficult to determine that the applicant imitated the claimant's trademarks;

② If the applicant's trademark is pronounced as /meleusi biang/, it has five syllables which are not so difficult to be pronounced in one breath, such that the whole words are highly likely to be recognized as a single word by general consumers and traders in Korea; and





③ On Nov 23, 2015, the applicant was granted registration for the trademark in question, seeking protection for clothes and shoes for women (No. 40-1196055), which are clearly distinctive from chocolate for which the claimant's prior registered trademarks were registered, so it is difficult to determine that there exists an economic link between the goods concerned considering the purpose, efficacy, producers and selling methods and places of the goods.

④ Given the producers, consumers and selling places, purpose and commercial activities of products and common perception as well as the fact that the recent trend in the fashion industry has become the total fashion, 'functional cosmetics and toiletries' covered by the applied-for trademark are deemed to have economic relations with 'shoes for women and clothes' covered by the applicant's another trademark which had been registered before the trademark applied for was registered. Thus, it would be difficult to determine that the applicant filed the application for registration of the trademark in issue for unfair purposes such as obtaining unfair profit by

exploiting intangible assets such as goodwill and customer attraction power embodied in the claimant's prior registered trademarks, rather it is deemed that the applicant filed the trademark to expand her business

#### C. Conclusion

In conclusion, it is difficult to determine that the applicant filed the application for registration of the trademark in issue for unfair purposes in accordance with Article 34(1)13.

1. Title	<b>DAK</b>  vs <b>I'm DAK</b>	
2. Country	Republic of Korea	
3. Court	Korean Intellectual Property Office (KIPO)	
4. Case No.	40-2017-3649	
5. Date of the judgment	2018.7.19	
6. Parties: Plaintiff Defendant	Danish Crown A/S wiseUX global	
7. Mark	Plaintiff	Defendant
	<b>DAK</b> 	<b>I'm DAK</b>
8. Outline of the case		
<p><b>The main causes stated by the plaintiff:</b> In this case, not only the appearance of the essential part of the applied mark is similar to those of the pre-registered marks ‘<b>DAK</b>’ and ‘’, but also the sounds of the conflicting marks, which are considered significant for a word mark, are the same. Thus, the applied mark cannot be registered under Article 34(1)7.</p> <p><b>The main causes of the defendant in reply:</b> Even if the applied trademark contains the word 'DAK', it is deemed to be dissimilar to the pre-registered trademarks in the overall appearance, sound, and meaning when observed as a whole in consideration of the filed mark’s composition, designated products and recognition of actual consumers.</p>		
9. Summary of the judgment(Fact finding and opinions of the Courts)		
<p>The appearance, sound and meaning of the filed trademark ‘<b>I'm DAK</b>’ are examined to see if it is similar to the pre-registered trademarks ‘<b>DAK</b>’ and ‘’.</p> <p>① First, in the appearance, the letters ‘I’m’ and ‘DAK’ in the said trademark are written horizontally and separated with a space, and in the figure part, the alphabet ‘D’ is rotated 180 degrees and combined with a color and figures. Whereas, one pre-registered trademark consists of only English capital letters ‘DAK’ and the other pre-registered trademark is combined with a design. All in all, the overall appearance of the said mark is different from the pre-registered marks due to the difference in the number of letters, fonts, figures, and color combination, etc.</p> <p>② In the meaning, alphabet ‘D’ of the applied mark is somewhat stylized but it is not enough to overwhelm the recognition of the letters. As a whole, it is recognized as ‘I’m DA</p>		

K' because 'I'm' is an abbreviation of 'I am'. Since 'DAK' in the conflicting marks is considered a coined word, the meaning thereof cannot be compared with each other.

③ In the sound, the filed trademark as a whole is pronounced as 'I'm dak', 'I'm dark' or 'I'm 'D/di/' 'E/i/' 'K/kei/'', and the words 'I'm' and 'DAK' separated with a space do not create any special meaning. Even if it is recognized as a whole, 'I'm' is only an abbreviation of the subject 'I' representing the first person and the verb 'am', so its main meaning is deemed to lie in the 'DAK' part. Thus, the filed mark can be separated and abbreviated with only the main word 'DAK'. Then, its sound is the same as that of the pre-registered marks as pronounced 'dak', 'dark' or 'D/di/' 'E/i/' 'K/kei/'. Although the filed mark is dissimilar to the pre-registered marks in the appearance and meaning, they are extremely identical in terms of sound, which is considered the most important factor in judging the similarity of trademarks since it can confuse consumers or traders as to the source of the goods if the trademarks are used for the similar or identical goods.

Next, when it comes to the designated goods of the filed trademark and the pre-registered trademarks, their designated goods share similarities in terms of production and sales while having the common characteristics and consumer base. Specifically, the filed trademark is used for frozen chicken meat, chicken and packaged chicken meat, which cover the designated goods of the pre-registered trademarks, chicken meat. Also, the applied trademark is used for processed chicken, dried chicken, processed chicken breast food, chicken sausage, chicken yakitori, chicken sausage, chicken steak, chicken broth, chicken patties, bacon, edible protein which are similar to the pre-registered marks' designated goods -- processed meat food, jerky, mashed sausage, and ham. Ham, bacon, sausage, bottled livestock products, canned livestock products, and jerky all fall under Class 29 which includes chicken meat and processed meat food.

Hence, the filed trademark cannot be registered under Article 34(1)7 of the Trademark Act since the said mark is similar to the previously registered trademarks and used for the same or similar goods thereof.

#### **10.Explanation and analysis**

Even if the appearance and meaning of conflicting trademarks are different as a whole, if their essential parts are the same or similar, they are considered similar marks since they can cause a likelihood of confusion or misunderstanding as to the source of goods/services for general consumers.

#### **11.Suggestions to applicants**

Even if conflicting trademarks are deemed to be different in overall comparison, it could be judged to be similar if the essential parts, which are the most important part of a trademark, are the same. Thus, when searching previously registered marks, it is necessary to focus on the similarity of essential parts of trademarks as opposed to the similarity of the trademarks as a whole. In particular, since the similarity of sound is especially significant, you need to pay attention to whether sounds of the essential parts of trademarks are similar or not.

# Typical Cases of USPTO



**USPTO-1 *Target Brands, Inc. v. Hughes***

1. Title	<i>Target Brands, Inc. v. Hughes</i> , 85 USPQ2d 1676, 1678 (TTAB 2007)	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91163556	
5. Date of the judgment	30 November 2007	
6. Parties: Plaintiff	Target Brands, Inc.	
Defendant	Shaun N.G. Hughes	
7. Mark	Opponent / Plaintiff	Applicant / Intervener
		ULTIMATE POLO
<b>8. Outline of the case</b>		
<p>Applicant sought to register ULTIMATE POLO for sun protective shirts based on a claim of acquired distinctiveness, and included a disclaimer as to exclusive rights in POLO. Opposer asserted the designation is highly descriptive, that Applicant used the designation in a descriptive way, and that Applicant’s evidence of acquired distinctiveness was insufficient to support registration. The case highlights the use of (1) stipulations of factual matters the parties did not dispute and (2) evidence the parties agreed the Trademark Trial and Appeal Board (“Board”) should consider to resolve any remaining issues of fact. This approach can be considered one form of Accelerated Case Resolution (“ACR”) at the Board.</p>		
<b>9. Summary of the judgment (Fact finding and opinions of the Courts)</b>		
<p>Opposition sustained, registration refused. Based on the stipulated facts and evidence of record, the Board found the mark is highly descriptive- a combination of the laudatory term “ULTIMATE” and the generic term “polo,” which is the name of a class of shirts. Opposer’s case focused on the question of acquired distinctiveness, because an applicant that relies on a claim of acquired distinctiveness is considered to have admitted that the designation is not inherently distinctive. Opposer contended that applicant did not enjoy substantially exclusive use of ULTIMATE POLO due to Opposer’s use of the identical designation for polo shirts and third-party usage of the identical designation for shirts, including polo shirts, and that applicant’s evidence fell short of proving acquired distinctiveness. The Board’s primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has held that highly descriptive terms require a greater quantity of evidence of acquired distinctiveness.</p> <p>The Board found the cumulative effect of Opposer’s use and third-party uses of “ultimate polo” was so extensive that Applicant’s use fails to qualify as “substantially exclusive” as required under the Trademark Act to establish acquired distinctiveness.</p> <p>The Board noted with approval the parties’ utilization of stipulated evidence in light of the savings in time and</p>		

expense for the parties as well as the judicial economy afforded the Board thereby. The Board has recently commenced a pilot program that involves conferencing with the parties involved in selected trial cases and discussing with the parties the value to them and to the Board, when parties stipulate to facts and the introduction of specific evidence into the record.

#### **10. Explanation and analysis**

Agreement of parties: Although the parties did not adopt the summary judgment model of ACR, the parties agreed to forego trial and stipulated to the entire record as well as to 13 paragraphs of facts. The parties' stipulations included applicant's dates of first use, channels of trade for applicant, extent and manner of applicant's use, recognition by others of applicant's use, as well as the dates, nature and extent of descriptive use by the Opposer's parent company; the admissibility of business records, government documents, marketing materials and Internet printouts. Such extensive agreement allowed the Board to reach a decision based on the stipulated record and reduced the pendency of this proceeding.

#### **11. Suggestions to opposers and applicants**

The Board encourages expedited proceedings. The Board in this case noted its approval of the parties' utilization of stipulated evidence that saved time and expense. Stipulations between parties can help build a record without extensive discovery and motions or costly preparation of witness testimony.

**USPTO-2 Hunter Industries, Inc. v. Toro Co.**

1. Title	<i>Hunter Industries, Inc. v. Toro Co.</i> , 110 USPQ2d 1651, 1653 (TTAB 2014)	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91203612	
5. Date of the judgment	31 March 2014	
6. Parties: Plaintiff Defendant	Hunter Industries, Inc. The Toro Company	
7. Mark	Opponent / Plaintiff	Applicant / Intervener
	PRECISION DISTRIBUTION CONTROL	PRECISION
<b>8. Outline of the case</b>		
<p><b>Substantive issues:</b> Applicant sought to register PRECISION for irrigation spray nozzles, rotating nozzles and soil moisture sensors. Opposer asserted its prior “use analogous to trademark use” and prior common law use of PRECISION DISTRIBUTION CONTROL for irrigation sprinklers, and likelihood of confusion. Applicant countered that Opposer’s use was not continuous or current and Opposer’s asserted mark is descriptive, not distinctive. The Plaintiff relying on common law use instead of a registration, bears the burden of proving that its asserted mark is distinctive.</p>		
<b>9. Summary of the judgment (Fact finding and opinions of the Courts)</b>		
<p>Opposition sustained on the grounds of likelihood of confusion. Appeal to district court dismissed per stipulation, No. 14-CV-4463 (D.Minn. Jan. 20, 2016). The parties elected to adopt a form of the Trademark Trial and Appeal Board’s (“Board”) Accelerated Case Resolution (“ACR”) process to streamline pre-trial and trial procedures and reduce the pendency of this proceeding. The Board found that Opposer’s mark was not descriptive and Opposer had established acquired distinctiveness through documentary and testimonial evidence prior to Applicant’s filing date, thus overcoming Applicant’s argument that Opposer’s mark was descriptive, not distinctive and therefore weak. The Board went on to find a likelihood of confusion based on an analysis of multiple factors under the test for likelihood of confusion.</p>		
<b>10. Explanation and analysis</b>		
<p><b>Agreement of parties:</b> Parties’ stipulation under ACR included only one stipulation of fact, but provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, and streamlined the methods for introduction of evidence during trial. As the sole stipulation of fact, the parties agreed that they are unaware of any actual confusion between the PRECISION mark and “Precision Distribution Control.” Therefore, the Board had to make findings of fact as to many issues, before applying the law to those</p>		

facts. However, the parties' stipulation of limits on pretrial procedures allowed the case to proceed more quickly to trial; and the parties' stipulations regarding the methods for introducing evidence helped minimize objections as to improper procedural submission of evidence. Even though the parties submitted a large amount of evidence, the stipulations still improved the efficiency of the proceeding.


The record was limited to pleadings, Applicant's trademark application file (by operation of law), and certain testimony and evidence from each party after evidentiary rulings related to Opposer's motions to strike certain evidence and testimony.

The Board compared the marks, goods, channels of trade and classes of purchasers for the goods, strength of Opposer's mark and considered third-party uses of PRECISION DISTRIBUTION CONTROL and the stipulation as to no actual marketplace confusion in reaching its decision that there is a likelihood of confusion. The stipulated absence of evidence of actual confusion did not prevent the Plaintiff from prevailing, because the standard is the likelihood of confusion, not the presence or absence of actual confusion.

#### **11. Suggestions to opposers and applicants**

There are many different types of efficiencies parties may agree to under the broad umbrella of ACR and Board attorneys are available to discuss with parties the potential benefits of stipulations of many different types, any of which can be used to narrow issues for consideration in opposition proceedings. Conferences with the parties focus on procedures on which the parties can agree, rather than pushing the parties toward a particular approach. As this case illustrates, parties still have the option to appeal a Board decision to an appropriate court, even after having agreed to use ACR efficiencies

**USPTO-3 Fiserv, Inc. v. Electronic Transaction Systems Corp.**

1. Title	<i>Fiserv, Inc. v. Electronic Transaction Systems Corp.</i> , 113 USPQ2d 1913, 1916 (TTAB 2015)	
2. Country	United States	
3. Court	Trademark Trial and Appeal Board	
4. Case No.	Opposition No. 91214266	
5. Date of the judgment	27 February 2015	
6. Parties: Plaintiff Defendant	Fiserv, Inc. Electronic Transaction Systems Corporation	
7. Mark	Opponent / Plaintiff	Applicant / Intervener
	POPMONEY  	PMONEY
8. Outline of the case		
<p>Applicant sought to register PMONEY, in standard characters, for electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic payments. Opposer asserted its prior registrations of POPMONEY in standard character and stylized forms, for financial services including electronic funds transfer, electronic payment processing, peer-to-peer electronic payments, etc., as well as software for initiating electronic funds transfers and payments and software as a service to allow the same, and likelihood of confusion. The case illustrates the most efficient uses of ACR and stipulations to streamline proceedings.</p>		
9. Summary of the judgment (Fact finding and opinions of the Courts)		
<p>Opposition sustained on the grounds of likelihood of confusion. Priority of use is removed as an issue when the Opposer relies on registrations, rather than common law rights in unregistered marks. The parties stipulated to many factual matters and to the introduction of evidence for the Board to use to decide the case. Multiple factors under the test for likelihood of confusion were considered and discussed in the decision.</p>		
10. Explanation and analysis		
<p><u>Agreements of parties:</u> The parties elected to adopt the Trademark Trial and Appeal Board’s (“Board”) Accelerated Case Resolution (“ACR”) procedure to streamline pre-trial and trial procedures and reduce the pendency of this proceeding. After the Defendant in a Board trial files its answer to the Plaintiff’s initial pleading, the parties are required to have a conference focused on discussing possible settlement and planning for discovery and trial. They are required to discuss ACR during that conference. In this case, the parties readily agreed to use ACR. They filed a stipulation to proceed with ACR and utilized conferences with a Board attorney to discuss their various stipulations and then later to resolve a dispute as to the stipulation of facts. Through their ACR stipulations the parties agreed to forego discovery and motion practice, waived disclosures, stipulated to facts and attached documents, and filed their respective briefs together with additional evidence. The</p>		

parties also utilized the procedures provided by the Board's standard protective order, which facilitated the filing of confidential information in stipulations and briefs for only the Board to view. Only redacted copies of filings with confidential information became part of the record that the public can view. The case proceeded fully briefed within a year and was decided by the Board two months later.

**Likelihood of confusion:** The likelihood of confusion analysis focused on the Opposer's pleaded POPMONEY registration in standard characters as the most relevant mark. Services of the parties were held to be identical in part, therefore the degree of similarity between the marks required to support a finding of likelihood of confusion is less. The POPMONEY mark was found to be inherently distinctive with some success in the marketplace, although not a famous mark. The Board found no evidence that the shared terms "P" plus "MONEY" in the marks are commonly used by third parties. On balance, the Board found the factors favored finding a likelihood of confusion.

#### **11. Suggestions to opposers and applicants**

For parties to an opposition proceeding, stipulations of fact are efficient, and may provide an excellent substitute practice for jurisdictions that do not permit discovery. By agreeing to the ACR procedure early in the proceeding, and participating in regular conferences with the Board attorney assigned to manage the case, the parties avoided expensive and time-consuming motion practice which resulted in a clean and concise record.