Protection of Prior Rights through Trademark Opposition/Invalidation Declaration Proceeding

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Trademark Review and Adjudication Board
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Legal basis: Article 32 of the Trademark Law: No application for trademark registration may infringe upon the existing prior rights of others,…

Procedure for protection: Opposition, Declaration of Invalidation

Subject requirements: Prior rights owners or interested parties

Time limit: within three months from the date of publication for a preliminarily approved and published trademark

within five years from the date of trademark registration
Types of prior rights: identifying marks with conflicting rights

- Copyright
- Name
- Trade name
- Design patent
- Likeness
- Other rights and interests
Copyright

General Requirements for copyright protection:

- A prior work that is within its term of protection
- The applicant is the copyright owner or an interested party to the work
- The disputed trademark is substantively similar to the work
- The trademark registrant may have access to the work
- The trademark registrant could not prove that it has independently created the work
Copyright

Case 1:

The disputed trademark

Designated to furniture and other goods

The fine art work

The Dream by Picasso
Copyright

Facts and affirmation:

a) The Dream is a well-known work by Picasso, who passed away on 8 April 1973, less than 50 years away from the date of the trial. The work is still within its term of protection.

b) The disputed trademark is of similar lines, composition and overall effect to the work The Dream. Therefore, the two are substantively similar.

c) Given the reputation of the work The Dream and its creator Picasso, and the similarities between the work and the trademark, it may be presumed that registrant of the disputed trademark had access to the work.

d) Registrant of the disputed trademark could not prove that it has independently created the mark.

Decision:

Registration rejected.
Copyright

Case 2

• The disputed trademark

Right claimant: MOTHERCARE UK LIMITED

• MOTHERCARE UK LIMITED acquired the copyright registration certificate for the work in 2012

• Designated to: prams, cars, funiculars, and pushchairs

• Trademark applicant: Qu from Hong Kong

• Qu acquired the copyright registration certificate for the mark in 2012
Copyright

Copyright ownership:
MOTHERCARE UK LIMITED filed the following evidences:
1. Evidence on the first publication of the work in 2005 in the UK.
2. Notarized and certified testimony of Daniel Weil, partner of the London studio of Pentagram Design Limited, on the designing and creation of the work as commissioned by MOTHERCARE UK LIMITED, concept of the design and ownership; accompanied with translation.
3. Notarized and certified affidavit of in-house attorney of the company on the first publication, continued publication of the work and reputation of the brand; accompanied with translation.

Comprehensive consideration: with no evidence to the contrary, it may be decided that MOTHERCARE UK LIMITED is the copyright owner of the work.
Copyright

- Other issues:
  - Whether it is a work?
    It consists of the letter M and a figure, which constitutes a work with certain creativity and visual aesthetics.
  - Whether the two are substantively similar?
  - The figurative component of the disputed trademark is composition and overall effect to the work.
  - Possibility of access?
    MOTHERCARE UK LIMITED submitted promotion materials and hospital guides issued in Hong Kong, which proved that products with the work had been in sale and publicity before registration of the disputed trademark. Qu may have accessed these materials.
  - Qu could not prove that he has independently created the mark.

Decision: Registration revoked.
• **Comments:**

Prevention of trademark registration with copyright is conditioned on validity of the work, substantive similarity, possibility of access and standing of the right owner, etc. Each of the conditions is of different weight in different cases, with different evidential requirements. For example, in the Picasso case, ownership and substantive similarity are easily identified due to the high reputation of the work, while the validity is the key point. In the MOTHERCARE UK case, ownership is the most difficult to identify. As copyright registration does not require substantive examination, registration per se does not guarantee copyright. In that case, there was a conflict of rights. The ownership may only be identified with proof of design, publication and use. This is a shared difficulty in such cases.
Right of Name and Right of Portrait

General Requirements for protection of right of name and right of portrait:

- Owner of the name or likeness is an existing natural person
- The applicant is the name or likeness owner or an interested party. The disputed trademark is substantively similar to the work.
- The disputed trademark is identical to the name or the recognized translation thereof. The name includes the genuine name, pen name, stage name or pseudo name. The trademark contains the identical likeness or one with distinctive features so that the public would identify as the likeness of the right owner.
- Registration of the disputed trademark would or might prejudice the right of name/likeness of the right owner.
- The trademark registrant did not acquire approval of the name/likeness owner.
Right of name

Case 1

Invalidation applicant: Tom Ford

Designated goods: glasses frames, glasses
Right of name

Facts and affirmation:

a) Before application date of the disputed trademark, Tom Ford, a reputed dress designer, created a brand with his name. The brand enjoys high reputation in the fashion industry, as well as among the relevant public in China.

b) The 汤姆•福特 in the disputed trademark is the corresponding translation of the name Tom Ford

c) The designated goods such as glasses are common consumer products in the fashion industry, to which Tom Ford belongs

d) Registration of the disputed trademark might infringe Tom Ford’s right over his name, as well as mislead the public

e) Registrant of the disputed trademark did not provide a reasonable explanation

Conclusion:

Registration of the disputed trademark might infringe Tom Ford’s right over his name, and shall therefore be declared invalid.
Right of name

• Case 2
• Declaration of invalidation

Invalidation applicant:
Storm Model Management Limited

Trademark registrant: Jing
Designated goods: clothing, footwear, etc.
Right of name

- **Facts and affirmation:**
  
  ➢ Whether the Applicant is an interested party?

  In the trial proceedings, the authorization of Kate Moss on authorizing Storm Model Management Limited as her agent in dealing with the disputed trademark is not sufficient to prove that company has any substantial rights over the name Kate Moss. Therefore, the company may not be identified as an interested party to the name in question.

  In the appellate proceedings, Kate Moss produced a more specific authorization to the effect that “I license my rights in my name, likeness, biography, designation and trademark to Storm Model Management Limited. The Applicant, Storm Model Management Limited, is thereby of direct commercial interests to the name.

  ➢ Kate Moss is a famous British model who had been the brand ambassador for Ports Clothing in 2002. The cooperation was reported in Chinese media. Jing, the trademark registrant, is a practitioner in the clothing industry. He could not provide a reasonable explanation for the use of the identical English letter combination to that of the name Kate Moss. The registration has infringed her right of name.

  Decision: registration revoked.
Right of name

- Case 3
- Ex officio examination (examination during registration)

Trademark registrant: Chen
Designated goods: electronic bicycles

Decision:
奥巴马 is the commonly used Chinese equivalent for the name of the current US President, Barack Obama. Registration of the trademark would result in negative political impact. According to Article 10, Paragraph 1, Subparagraph 8 of the Trademark Law, marks detrimental to socialist morality or mores or having any other adverse effect may not be used as trademarks.
Comments:

Rights of name/likeness are moral rights which are not transferrable or licensable. But when a name or likeness acquires commercial value, the value so generated shall belong to the right owner and be free from illegitimate use of others. For example, Tom Ford and Kate Moss are all well-known names in their respective area, the reputation of which is known in China. The commercial value so generated shall be attributed to them. Registration of relevant trademarks in these areas without authorization shall be prohibited. In addition, an interested party may only acquire a standing with express authorization with respect to the substantive rights rather than the case.

When the use of another’s name as a trademark results in negative impacts not limited to specific individuals, the registration is detrimental to the public interest or public order, and shall be restricted by the Trademark Law. For example, registration of the name of a foreign president would bring negative political effects, and shall therefore be prohibited.
Right of Trade Name

- **General Requirements for protection of right of trade name:**
  - The trade name was registered and used before the filing date of the disputed trademark
  - The trade name has a certain reputation among the relevant public in China
  - The designated goods or services of the disputed trademark are of close connection with the industry of the trade name
  - Registration of the disputed trademark may result in confusion and prejudice of the trade name owner’s rights
Case 1

The opposed trademark

Trademark registrant: Shanghai Rotork Automation Instrumentation Co. Ltd.

Designated services: blacksmithing, grinding

Rights claimant: Rotork PLC
Right of Trade Name

Facts and affirmation:

➢ Before filing of the disputed trademark, the 罗托克 and Rotork trade names of Rotork PLC have been used in China on electric actuators, and have gained high reputation. The products were used in major national construction projects such as Daya Bay Nuclear Power Plant and the West-East natural gas transmission. In addition, a number of Chinese power, chemistry and water processing enterprises are using Rotork electric actuators manufactured by Rotork PLC or its related companies.

➢ Before filing of the disputed trademark, Rotork PLC established two subsidiaries in Shanghai, namely, Rotork Controlling (Shanghai) Co. Ltd. and Rotork Valve Control Tech (Shanghai) Co. Ltd., for manufacture and sale of electric actuators, etc. The trademark registrant is also in Shanghai, with the identical trade name and overlapping scopes of operation.

➢ The disputed trademark is designated to blacksmithing, metal treating and metal casting. The valves, shells and other parts of the electric actuators manufactured by Rotork PLC or its related companies all require metal treating. Should the disputed trademark be registered, the public may be misled to assume that the services are from Rotork PLC or its related companies. Rotork PLC’s trade name would therefore be infringed.

Decision: Registration rejected.
Case 2

The opposed trademark

PPR

- Designated goods: clothing, footwear, headgear
- Filing date: 31 March, 2011
- Trademark applicant (Respondent in this case): An enterprise company in Shanghai

- Opposition applicant: PPR France
- One of the grounds:
- PPR is an trade name prior used by the applicant with high reputation in China. Registration of the disputed trademark would prejudice the applicant’s trademark. Registration of the disputed trademark shall be rejected.
Facts and affirmation:

Evidences submitted suggest that the Applicant was founded in France in 1963, and renamed to Pinault-Printemps-Redoute in 1994, and then to PPR in 2005. Pinault-Printemps-Redoute is the largest distributor in Europe, which owns a number of chain stores for up-scale luxury goods, clothing, beauty products, entertainment and household products. It is a top 500 company. The applicant has gain high reputation in the clothing and luxury industry in China. The respondent’s trade name is identical to the Applicant’s, and the designated goods such as footwear and headgear are closely related to the clothing and luxury industry. Registration of the opposed trademark would lead to association by the public of the respondent to the applicant, which would infringe the applicant’s prior trade name. The filing for registration of the disputed trademark violates article 32 of the Trademark Law.

Decision:
Registration rejected.
Comments:

Protection of a prior trade name is not conditioned on registration in China, but reputation in China. Internet evidence is admissible in proving reputation of a trade name. For example, in the PPR case, the applicant submitted an article titled Introduction of the Major French Enterprises from the website of the Economic Counsellor of the French Embassy, reports in newspaper and on the internet, as well as library search results. In case that the authenticity of the internet evidence is in question, it may be notarized. Evidence obtained from outside the territory of China shall be notarized and certified. Evidence in a foreign language shall be accompanied with Chinese translation.
Design Patent Right

- General Requirements for protection of design patent right:
  1. Prior design patent right owned by another;
  2. The disputed trademark is used on identical or similar products to those of the design patents;
  3. The disputed trademark is within the claims of the design rights, i.e., the mark is identical or similar to the design;
  4. Registrant of the disputed trademark did not acquire approval of the right owner.
- Case

- Designated goods: rice

- Design patent

- Design patent for rice package
Facts and affirmation:

The Applicant’s design patent for the rice package was granted on 27 June 1998, prior to the filing date of the disputed trademark, as well as the granting date of the Respondent’s design patent. The Applicant’s design patent is still within the term of protection. Therefore, the Applicant’s design patent constitutes a valid prior right. The distinctive element of the said design patent for package, the wheel shape, is similar to that in the disputed trademark. The design patent of the applicant is actually used on rice products, and so is the disputed trademark. The two are used on similar goods. Therefore, registration of the disputed trademark infringed the applicant’s valid prior right.
• **Comments:**

• To prevent registration of a trademark with a design patent, it shall be proved that the prior acquisition of the patent, i.e., the granting date shall be earlier than the filing date and date of use of the disputed trademark. In addition, the patent shall remain valid during the proceedings, from filing of the claim to conclusion of the proceedings.