

China: Oppositions-Reputation a Factor in Assessing Similarity of Marks

On October 24,

2002, a Mr. Lin filed an application with the China Trademark Office (“CTMO”)

for the following alligator design: covering

“garments, shoes, neckties, shirts, t-shirts, socks, woolen fabric jacket

(clothes), knitwear, underwear, pants, etc” in Class 25. The CTMO rejected the

application citing a prior registration in the name of Lacoste (France)

(“Lacoste”) for an alligator design trademark () covering identical goods in Class 25. [More](#)

On October 24, 2002, a Mr. Lin filed an application with the China Trademark Office (“CTMO”) for the following alligator design: covering “garments, shoes, neckties, shirts, t-shirts, socks, woolen fabric jacket (clothes), knitwear, underwear, pants, etc” in Class 25. The CTMO rejected the application citing a prior registration in the name of Lacoste (France) (“Lacoste”) for an alligator design trademark () covering identical goods in Class 25. Lin appealed the decision to the Trademark Review and Adjudication Board (“TRAB”), which overturned the rejection and allowed the mark to proceed to publication. Upon publication, on November 20, 2007 Lacoste opposed, arguing that (1) the opposed mark is similar to the cited one and (2) the Lacoste mark is a well-known trademark warranting heightened protection. The CTMO considered reputation evidence in ruling in Lacoste’s favor on the first argument, but did not find it necessary to address whether the Lacoste mark was a well-known trademark. The opposition was successful and the application was rejected. Lin appealed to the TRAB, which upheld the CTMO decision. The TRAB concluded that the marks differed only slightly, mostly in orientation and that “the two marks, when used on similar goods, are likely to cause confusion and misidentification among consumers.”

Lin appealed this decision further to the Beijing No. 1 Intermediate Court, which affirmed the TRAB decision and further noted that the marks were similar in overall appearance and visual effect. In

particular, the court pointed out that because consumers do not often get the opportunity to compare the marks side by side, the similar overall impression of the applicant's mark was likely to confuse consumers.

On further appeal to the Beijing Higher Court, Lin argued that the TRAB had been inconsistent in its approach to assessing the similarity of the marks and, moreover, had committed procedural error in taking into account Lacoste's reputation evidence in assessing similarity of the marks. The court noted that in the initial ex officio proceeding before the CTMO (and the TRAB), Lacoste was unable to intervene or provide evidence. In the opposition, however, additional facts were brought into play, as Lacoste was procedurally permitted to file submissions relating to reputation. Given the differences in evidence provided, the court concluded that the TRAB's opposition decision rejecting the application was justifiably in disagreement with its decision to approve the mark for publication at the examination stage. Accordingly, in addition to upholding the earlier rejection decision based on the similarity of the marks, the court also explicitly found it appropriate to take into account "the reputation and distinctiveness of the cited mark" for clothing, affirming the decisions of the first instance court and the TRAB. This case may indicate a trend toward recognizing the importance of reputation evidence in considering whether marks are confusingly similar, at least in the inter partes context. It also means that reputation evidence can be taken into account without considering whether the mark is a "well-known" mark, which appears to involve a much higher standard of proof. (Analogous reasoning was applied in a recent TRAB opposition decision rejecting a third party effort to register STUART WEITZMAN in Class 3, on the ground that the name STUART ALLAN WEITZMAN had acquired substantial reputation worldwide.)

Primary Contacts

John P. Margiotta