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Taiwan

Is using a trademarked common word infringing the owner's trademark rights? Analysis of Taiwan Intellectual Property Court Decision (2016 Minshangsuzi No. 9 Decision)

Common words can be registered as trademarks under certain circumstances. Yet, the common word trademark owner is not unrestricted when trying to claim monopoly over that common word. The Taiwan courts opined that trademark infringement can only be established by judging the level of consumer confusion caused by the trademark actual use.

If another party applies a mark including the same word at a later date, the prior common word trademark owner cannot claim that the other party has malicious intent and is piggybacking off the prior trademark on the only basis of both trademarks contain a part of identical words. The owner also cannot assume that the other party is intentionally or knowingly infringing the trademark. The Taiwan Intellectual Property Court confirmed the above principle in the Taiwan Intellectual Property Court 2016 Minshangsuzi No. 9 Decision.

Case Facts

	Plaintiff's Trademarks	Defendant's Trademarks
Trademarks		

Registration Date	1 st September, 2007; 16 th September, 2007	16 th May, 2013
Trademark holder	TutorABC Inc. (麥奇數位股份有限公司)	Wells English (威爾斯美語股份有限公司)
Classes	Classes 35, 41, 42	Classes 35, 41, 42

The plaintiff, TutorABC Inc. (麥奇數位股份有限公司) alleged that the defendant, Wells English (威爾斯美語股份有限公司) registered a trademark “Tutor Well” that was similar to the Plaintiff’s registered marks such as “TutorABC”. TutorABC Inc. filed a civil lawsuit before the Taiwan Intellectual Property Court and the court ruled in favour of the plaintiff.

Opinion of the Taiwan Intellectual Property Court

1. The plaintiff has introduced plenty of evidence of actual confusion with date and time, showing that consumers mistook the defendant’s services for those of the plaintiff because of the similarity of marks. The defendant did not rebut and the court held that the defendant and plaintiff’s marks were similar enough to cause confusion in commercial use.
2. The defendant tried to prove that consumers could distinguish plaintiff and defendant’s marks by providing Internet evidence from social media platforms that included customer reviews and comparisons between different online English tutoring services. However, it could not be inferred that relevant consumers were familiar with the defendant’s trademark.
3. The court was of the opinion that the word “Well” in the defendant’s trademark was linked to the company name of the defendant, “Wells (威爾斯)”, and “Tutor” is a word associated with online English tutoring services. Therefore, the defendant was reasonably justified in combining “Tutor” and “Well” as a trademark for use in online English tutoring services. The defendant should not be considered acting in bad faith.

Wisdom’s Commentary and Suggested Strategies

The crucial deciding factor of this case was that the plaintiff was able to present multiple evidences proving the existence of likelihood of actual consumer confusion between his trademarks and the defendant’s allegedly infringing mark, whereas the evidences raised by the defendant cannot

prove that relevant consumers were familiar with the marks. The court then ruled that the defendant's use of trademark would lead to likelihood of confusion on consumers and the defendant had infringed the plaintiff's trademark rights.

It is important to note that when using a common word as a trademark, "evidence of actual confusion" and "level of consumer familiarity with the trademark" are two key issues in infringement litigations.

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