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Tommy Hilfiger invalidates a trademark piggybacking its iconic flag logo in actual use

Time: Dec 15 2020

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Ye Cai, Dec 15, 2020

As a rising fashion brand in China marketplace, Tommy Hilfiger (TH) has been constantly challenged by an increasing number of copycats. The infringer usually registers a mark that bears some resemblance to TH's word and/or device marks and deliberately altered the mark in actual use by highlighting the TOMMY part and/or colouring the device part to heighten the resemblance.

A local Chinese company, which acquired from a third entity through assignment a registered trademark for  (no. 12396976) in respect of "girdles (clothes)" on which Tommy Hilfiger does not have earlier trademark registration for its Flag logo , has been using the mark in a coloured form so that it mimics Tommy Hilfiger's Flag logo. Tommy Hilfiger initiated an invalidation action against the said mark and successfully invalidated the mark on the grounds of prior use and the similarities between the designated goods of the disputed trademark and its cited trademark.

The visual appearance of the disputed trademark  and TH's cited device  seems to be distinguishable. However, if the black and white mark is coloured exactly the way as Tommy Hilfiger's Flag logo (as shown in the photos below), the degree of similarities of the two marks would sharply increase.



Colored form of trademark no. 12396976 in actual use

The registrant of the disputed trademark also cunningly designated the only goods "girdles (clothes)", which is categorized in a different subclass from that of TH's designated goods "apparel", despite being highly relevant in the fashion industry. The intentional choice of goods aims to lower the possibility that the goods of the disputed mark being found similar to the key goods of TH's cited trademarks.

In order to overcome the above issues, we collected and furnished numerous proof on 1) the adverse party's actual use of the disputed mark in the same colour as TH's cited mark, 2) TH's use of the mark on "girdles (clothes)", and 3) the relevance of "girdles" and "apparel" in the fashion industry.

Though the CNIPA dismissed the invalidation, both Beijing IP Court and Beijing High Court overturned the CNIPA invalidation decision and ruled in favour of TH, citing Articles 30 and 32 of China Trademark Law. The court decision is based on the findings that:

- TH's mark is reputable on apparel in China;
- "Girdles (clothes)" shall be deemed as a similar item to "apparel";
- TH's mark had acquired certain influence on "girdles" through extensive use in China, and
- The adverse party deliberately acted in bad faith.

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The court of appeal handed down its decision on March 30, 2020.

On June 17, 2020, the CNIPA promulgated the “*Criteria for Determination of Trademark Infringement*”, in which Article 24.1 provides that:

The registrant of a registered trademark without specifying any colours may colour his/her trademark freely. However, where the colouring aims to free-ride other's registered trademark in respect of same or similar goods/services so that the coloured trademark is similar to the latter's registered trademark, thus is likely to cause confusion, it falls under the trademark infringement act as prescribed by Article 57.2 of the Trademark Law

There is no way to know for sure whether the CNIPA takes note from this particular case, but TH could definitely fall back on Article 24.1 to enforce its iconic flag logo in future trademark infringement cases, which is most welcome.