

Cases of Review and Adjudication and Lawsuit Involving Trademark Composed of Combination of Colours

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Case 1

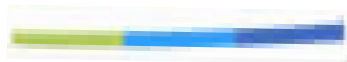
The English applicant, the Standard Chartered PLC, filed, on 18 April 2002, an application with the Trademark Office for registration of a device trademark (See Fig. 1 below; hereinafter referred to as the trademark in point) in goods of class 16 of the International Classification, such as “paper, card board, book, magazine, and stationery”. The applicant stated in the application that the trademark in point was one composed of combination of colours. Upon examination, the Trademark Office issued the Trademark Refusal Notification No. ZC 3150995BH1 on 4 March 2003, and refused the

trademark registration application under Articles 11, paragraph one (3) and 28 of the Trademark Law on the grounds that “the device was too simple to have its distinctive character, and could not play the distinguishing role when used as a trademark”.

Dissatisfied with the refusal decision, the applicant applied to the Trademark Review and Adjudication Board (the TRAB) for reexamination on 21 March 2003. After hearing the case, the TRAB held that the trademark, composed of five colours, had been rendered distinguishable by the arrangement of these colours; when used on goods, such as paper,



附圖 1
Fig.1



附圖 2
Fig.2



附圖 3
Fig.3



附圖 4
Fig.4



附圖 5
Fig.5

評委的評審員往往只能依靠各自對顏色組合商標的認識，獨自或經所在處部分或全體人員討論後作出准駁的結論。這樣，即使完全相同的顏色組合商標，在不同類別上的註冊申請也會面臨不同的審查結論。

實例三中的申請人同時在相同商品上申請註冊的另兩件顏色組合商標亦先後被商標局和商標評審委員會駁回，然而，申請人僅就實例三中的駁回複審決定向法院提起訴訟。該案也成為中國首例關於顏色組合商標的商標行政訴訟案。在一審判決中，法院認可了商標局和商標評審委員會關於申請商標缺乏顯著特徵的判斷，但並未對涉案商標之所以缺乏顯著特徵的理由進行詳細的分析和說明。我們期待二審法院在審理中對判定

顏色組合商標是否缺乏顯著性以及是否通過使用產生了顯著性等問題闡明看法，以便商標局、商標評審委員會在審查、審理顏色組合商標的註冊申請時加以參考，同時也使商標申請人在決定是否申請註冊顏色組合商標、申請被駁回後是否複審、是否向法院起訴等問題時能有所指引。■

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¹ 見該標準第五部分第四條之（一）項。

² 該標準第二部分“商標顯著特徵的審查”中第五條“其他缺乏顯著特徵的”項下已經出現了“單一顏色”，在顏色組合商標的審查標準中再出現類似內容明顯不妥。

the trademark in point could distinguish the origin of goods, so it had its distinctive character to an extent; hence, it should be approved for registration. The TRAB made, on 27 June 2005, the “Device” Trademark Refusal Reexamination Decision (No. Shangpingzi 1821/2005) under Article 27 of the Trademark Law that the trademark in point was approved for preliminary examination and publication. Then, the TRAB transferred the case to the Trademark Office for it to go through the matters of preliminary examination and publication of the trademark registration application. According to the reexamination decision, the Trademark Office preliminarily examined and published the application on 28 August 2005, and approved and published the trademark registration on 28 November of the same year (respectively see the Trademark Gazette, issues 989 and 1001, No. 3150995).

Case 2

The Japanese applicant, the Shimano Inc., filed, on 25 March 2002, an application with the Trademark Office for registration of a device trademark (See Fig. 2 on page 81; hereinafter referred to as the trademark in point) in goods of class 25 of the International Classification, such as “shoes, boots, clothing, and waterproof clothing”. The applicant stated in the application that the trademark in point was one composed of combination of colours. Upon examination, the Trademark Office issued the Trademark Refusal Notification No. ZC 3124469BH1 on 29 July 2003, and refused the trademark registration application under Articles 11, paragraph one (3) and 28 of the Trademark Law on the grounds that “the trademark in point lacked distinctive character, and should not be registered as a trademark”.

Dissatisfied with the refusal decision, the applicant applied to the Trademark Review and Adjudication Board (the TRAB) for reexamination on 15 August 2003. After hearing the case, the TRAB held that the trademark in point was composed of a narrow strip of three colours, and consumers were not likely to treat it as a trademark when it was used on the designated goods; hence it could not play the distinguishing role it should; so it lacked distinctive character. As for the applicant’s claim that the trademark in point had acquired its distinctive character through use, the TRAB held that the evidence from the applicant was insufficient to prove that the trademark in point had become distinctive in China through use. For this reason, the trademark in point should not be preliminarily examined and published. Under Articles 11, paragraph one (3) and 28 of the Trademark Law, the TRAB issued, on 30 March 2005, the “Device” Trademark

Refusal Reexamination Decision (No. Shangpingzi 0547/2005) that the application for registration of trademark in point was refused, and would not be preliminarily examined and published. The applicant was also notified that if it was dissatisfied with the above decision, it might institute proceedings in the Beijing No. 1 Intermediate People’s Court within 30 days from the date of receipt of the decision. The applicant did not do so within the time limit, and the TRAB’s refusal decision has taken effect.

Case 3

The applicant, the Sweden Kampman AB, filed, on 8 January 2002, an application with the Trademark Office for registration of a trademark composed of combination of colours (See Fig. 3 on page 81; hereinafter referred to as the trademark in point) in goods of class 8 of the International Classification, such as “saw blades (parts of hand tools)”. Upon examination, the Trademark Office issued the Trademark Refusal Notification No. ZC 3063748BH1 on 27 August 2002, and refused the trademark registration application under Articles 11, paragraph one (3) and 28 of the Trademark Law on the grounds that “the trademark in point was too simple to have its distinctive character as a trademark”.

Dissatisfied with the refusal decision, the applicant applied to the TRAB for reexamination on 13 September 2002. Upon hearing the case, the TRAB held that the trademark in point, which was composed of combination of two colours, had so simple a device that the average consumers would not recognise it as a trademark; hence, the trademark in point lacked its distinctive character it should have, and it was a sign not registrable as a trademark as mentioned in Articles 11, paragraph one (3) of the Trademark Law. The registration application should be refused. Under Article 28 of the Trademark Law, the TRAB made, on 20 December 2004, the “Device” Trademark Refusal Reexamination Decision (No. Shangpingzi 6429/2004) to have refused the application for the registration of the trademark composed of colours, and not to preliminarily examine, and publish it.

Dissatisfied with the TRAB’s said Decision, the applicant instituted administrative proceedings in the Beijing No. 1 Intermediate People’s Court. The applicant stated that it was the world best known saw blades manufacturer, and that the trademark in point was its own created combination of colours of “orange and blue” painted on the whole saw blade products, and the colours were not generic colour for saw blades. When buying saw blade products, consumers could see that the product was one made by the applicant,

not from any other manufacturer, with the help of the unique combination of colours even if they stood far away from the products. Therefore, the trademark in point became distinctive. Besides, the goods on which the applicant used the trademark in point were widely marketed in China, and considerably reputable. These products had been imitated in bad faith. The applicant argued that the TRAB made the re-examination decision without ascertaining the facts, with erroneous application of law and in undue procedure. For that matter, it requested the court to revoke the reexamination decision under the law.

Upon hearing the case, the Beijing No. 1 Intermediate People's Court held that combination of colours might be used as one form of trademarks, distinct enough from any other signs. The trademark in point, composed of combination of colours of orange and blue, was so simple that it could not show the origin of goods or service. Also, the evidence from the plaintiff could not prove that the trademark in point had acquired its distinctive character, and enjoyed considerable repute. Therefore, the court ruled, on 16 December 2005, to have upheld the TRAB's refusal reexamination decision. The applicant, dissatisfied with the ruling of first instance, appealed to the Beijing Higher People's Court. The case is now pending.

To the Chinese Trademark Law amended in 2001 has been added the provision on trademarks composed of combination of colours. Since then, applications for registration of trademarks of the kind have been constantly on the rise. As the examination practice of the recent five years shows, there are applications for registration of trademarks composed of combination of colours that have been preliminarily examined and published in the phase of substantive examination, but such applications are not many. The applicant involved in case 1 also applied for registration of a trademark composed of combination of colours exactly identical with the trademark shown in Fig. 1 in "financial service and banking service" of class 36 and in goods, such as "equipment for financial card transaction and financial data settlement, computer, and telephone" of class 9 of the International Classification, and the application was preliminarily examined and published in the phase of substantive examination by the Trademark Office, and granted the registration and published (respectively see the Trademark Gazette, issue 892/904, No. 3150996, and the Trademark Gazette, issue 894/906, No. 3150994). There are a few cases in which the TRAB, in the procedure of reexamination of refusal of trademarks

composed of combination of colours, has reversed the Trademark Office's refusal decision and approved trademarks in point for preliminary examination and publication (e.g. case 1), and there are more cases in which the TRAB has rejected applicant's reexamination requests and disapproved trademarks in point for preliminary examination and publication. The applicant involved in case 2 filed an applications for registration of other two trademarks composed of combination of colours identical with the trademark shown in Fig. 2 in goods of classes 12, 25 and 28 (see Figs. 4 and 5 on page 81). Two trademark registration applications passed the substantive examination of the Trademark Office, and were approved for preliminary examination and publication (the trademark shown in Fig. 4, see the Trademark Gazette, issue 974/986, Nos. 3124472 and 3124473), and the remaining 7 applications were refused by the Trademark Office. The applicant did not request reexamination of two of them, but did of the other 5 applications including the one involved in case 2, which were also refused upon reexamination by the TRAB. The applicant did not institute proceedings in the court.

Regarding the examination of whether a trademark composed of combination of colours has distinctive character, it is provided in the Standards for Trademark Examination and Adjudication jointly issued by the Trademark Office and the TRAB on 31 December 2005 that "any trademark composed of combination of colours includes only the natural colours of the goods on which it is used, or the generally or commonly used colours of the goods per se or their package and venue of service provision, and the applicant only explains, in writing, the combination of colours, without submitting any sample of the colours, it shall be determined as lacking distinctive character".¹ This provision contains two paragraphs: 1) "inclusion only of the natural colours of the goods on which a trademark is used" is explained with the example of the "light green" colour used on goods of mustard; and 2) "inclusion only of the generally or commonly used colours of the goods per se or their package and venue of service provision" is explained with the examples of four combinations of colours used on the goods and services of laundry card, computer, hairdressing, and integrated circuit card. Unlike other parts of the Standards, this provision does not specify any exceptions, that is, it does not make it clear what trademarks composed of combination of colours have distinctive character. As is shown in the several cases of applications for registration of trademarks composed of combi-

nation of colours approved for registration by the Trademark Office and approved for registration or refused by the TRAB after refusal by the Trademark Office, the aforesaid Standard seems to have offered no explicit guidance. For one thing, “the natural colour of the goods” is often of one colour, and a trademark of one colour is obviously not a trademark of combination of colours.² Next, there are few applications for registration of trademarks composed of combination of colours of the kind are generally or commonly used colours of the goods per se or their package and venue of service provision. What are commonly seen are combinations of colours that are not directly necessarily associated with the goods or services on which they are used as trademarks. The applications in cases 1 and 3 are such examples. According to the Standards, it seems that these combinations of colours should not be determined as devoid of distinctive character. However, in fact, many trademarks of the type are refused by the Trademark Office in the phase of examination and by the TRAB in the phase of reexamination. For that matter, this writer believes that so far the Trademark Office and TRAB have not offered any relatively definite opinions that can serve as a frame of reference on the matter of whether a trademark composed of combination of colours has distinctive character. As a result, in the practice of examination and hearing, the examiners of the Trademark Office and TRAB often have to make their refusal decision alone or after discussion with their colleagues in the same division according to their own understanding of the trademark composed of combination of colours. Consequently, different examination conclusions are likely to be drawn in respect of applications for registration of trademarks composed of exactly the same combination of colours in different classes of goods or services.

The other two applications filed by the applicant in-

involved in Case 3 for registration of trademarks composed of combination of colours in identical goods have been refused by the Trademark Office and the TRAB. The applicant has brought an action in the court directed only to the refusal re-examination decision in Case 3, and this is the first trademark administrative lawsuit involving a trademark composed of combination of colours. In the ruling of first instance, the court accepted the judgement of the Trademark Office and the TRAB that the trademark in point lacked distinctive character, but did not analyse and explain why. We hope that the court of second instance comments, in its hearings of the case, on whether or not trademarks composed combination of colours lack distinctive character and whether or not they will become distinctive through use for the reference of the Trademark Office and the TRAB in their examination of applications for registration of trademarks of the kind, and for the guidance of the trademark registration applicants in their decision on whether to apply for registration of trademarks composed of combination of colours, whether to apply for reexamination after refusal of their applications, and whether to bring an action in the court. ■

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¹ See 4 (1) of Part V of the Standards of Trademark Examination and Adjudication.

² Since the matter of “single colour” appears in section 5 on other cases of lack of distinctive character in Part II, Examination on Distinctive Character of Trademarks of the Standards, it is inappropriate for the same matter to appear again in the Standards of examination of trademarks composed of combination of colours.

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