Excellent Performance Award Laureates of Trademark Law Firms Winning Trademark Lawsuits of Defence in 2009

Litigation Involving A Dispute over "夢達莉嬌 MONDALIJIO" Trademark

Trademark law firm: China Patent Agent (H. K.) Ltd.

The case involved the "**夢特嬌**" (translated from the mark "MONTAGUT") mark and the associated marks. The proprietor of the "**夢特嬌**" mark, the French corporation of Bonnetrie Cevenole S. A. R. L. having its business scope covering design, manufacture and sale of garments, filed applications for, and was granted, the registration of the marks of "MONTAGUT", the "flower device" and the combination thereof, and the mark of "**夢特嬌**" between 1986 and 1991. With its efforts made to develop the market for its products, the business had made all its products of garments, shoes, socks and leatherwear bearing said marks widely popular among consumers in mainland China from the early 1990s. In 1997, a company from the Taiwan region of China, which had been licensed said trademark by Bonnetrie Cevenole S. A. R. L., filed, without authorisation from the French corporation, applications for registration of over 20 marks, such as "**夢達莉嬌**" (pronounced "meng da li jiao" in Chinese), "MONTERJIO" and "MONDALIJIO", the "flower device" and the combination thereof. In August 2008, the company from Taiwan assigned these registered marks to the Huizhou City-based Shengmalong Knitwear Co., Ltd. (Shengmalong for short). Discovered, in 2002, that Shengmalong's use of the marks in respect of garment products had created confusion with its "**夢特嬌**" mark and other associated marks, the Bonnetrie Cevenole S. A. R. L. appointed CPA to take action on its behalf to cease Shengmalong's act of infringement.

Upon appointment, the attorneys-at-law of CPA started to act with the strategy of bringing a civil action against the infringement to gather or collect evidence of the Taiwan business's registration of the marks in bad faith, and filing a request with the China Trademark Review and Adjudication Board (TRAB) for cancellation of the marks it had registered by unfair means on account of the different jurisdictions and law provisions in Taiwan and the mainland. Besides, considering that five years had passed from the time when application for the registration of the marks in suit was approved and Shengmalong's use of them was discovered, they requested the TRAB to have established the "**夢特嬌**", "MONTAGUT", and the "flower device" marks as well-known marks, while furnishing the evidence showing that the Taiwan business had secured its registration of the marks in suit by unfair means in bad faith. In doing so, they made it possible for the request filed with the TRAB for cancellation of the marks in suit to have met the requirement under the Trademark Law for the purpose after initiation of the trademark registration prosecution.

As recommended by the CPA lawyers, the French business had gather considerable evidence, including, among other things, its advertisements using the word "MONTAGUT" and the "flower device" in France in the 1940s, records of registration of the "MONTAGUT" and the "flower device" marks in over 80 countries and regions, records of the "**夢特嬌**", "MONTAGUT" and the "flower device" marks used in respect of nearly 10 classes of goods in mainland China, and records of promoting and marketing the products bearing said marks from the early 1990s. Especially they made available the valid evidence showing the nationwide promotion and evidence proving the Taiwan business's act of taking a "free-ride" by securing the registration of the marks in suit in bad faith. Evidence that had been collected from the Taiwan region was notarised or certified as recommended by the CPA counsels to bring it in compliance with the procedural requirements of the administrative and judicial authorities in the mainland.

It was on the basis of the above evidence that the TRAB, in the trademark review and adjudication proceedings, established, as well-known marks, the registered marks of "MONTAGUT", the "flower device" and "**夢特嬌**" the French corporation used first in respect of the goods of garments, and cancelled, in November 2004, over 20 marks registered by unfair means, such as "**夢達莉嬌**", "MONTERJIO", "MONDALIJIO" and the "flower device" and the combination thereof. Dissatisfied with these decisions, Shengmalong instituted an administrative litigation. In June 2005, the Beijing No. 1 Intermediate People's Court made the first-instance judgments and, in March 2006, the Beijing Higher People's Court made the final judgments to have upheld the adjudicative decisions made by the TRAB. Thus, the toughest issue arising from trademark infringement and unfair competition which Bonnetrie Cevenole S. A. R. L. had encountered in the mainland were addressed to its satisfaction once and for all. ■ (Xiao Hai)

One of the marks in dispute