

Judicial Standard for the Well-Knownness of Trademarks in the Hotel Industry under the Case Law of the Taiwan Intellectual Property Court

Ping-Hsun Chen^{*} & Ting-Wei Huang[†]

Abstract

This article is intended to explore the judicial standard for the well-knownness of trademarks in the hotel industry based on the decisions issued by the Taiwan Intellectual Property Court (“TIPC”). The decisions relate to two internationally-famous hotels: Amanresorts International Pte Ltd. and Four Seasons Hotels (Barbados) Ltd. While the trademarks of both hotels are considered as well-known in the hotel industry by the TIPC, Amanresorts acquires more extensive protection than Four Seasons. The key issue is whether the owner of a well-known trademark intends to enter the business sectors other than what the well-known trademark is designated to. In the Amanresorts case, Amanresorts successfully requested the TIPO to revoke one registered trademark which uses “aman.” The revoked trademark was designated to architectural design services. The TIPC affirmed the TIPO’s ruling because Amanresorts has used “AMAN“ for its real estate business. Whereas, in the Four Seasons case, the TIPC affirmed the TIPO’s denial of the revocation of a trademark requested by Four Seasons because the challenged trademark was designated to gardening services which Four Seasons was found to have no intent to enter into. Comparing both cases, the key implication could be that a hotel has to extend to other business sectors so as to acquire a well-protected well-known trademark.

Keywords: Well-known trademark, Trademark Act, Four Seasons, Amanresorts

DOI: 10.6521/NTUTJIPLM.2014.3(2).4

^{*} Corresponding author. Assistant Professor, Graduate Institute of Intellectual Property, National Taipei University of Technology (Taiwan); J.D. 10’ & LL.M. 08’, Washington University in St. Louis School of Law; LL.M. 07’, National Chengchi University, Taiwan; B.S. 97’ & M.S. 99’ in Chem. Eng., National Taiwan University, Taiwan. Contact email: cstr@mail.ntut.edu.tw. This article is a revision of a conference paper previously presented at the 2013 MCU Tourism International Conference, Mar. 16, 2013, Ming Chuan University, Taipei City, Taiwan.

[†] LL.M. in IP 13’, Graduate Institute of Intellectual Property, National Taipei University of Technology (Taiwan).



I. Introduction

Taiwan began to protect well-known trademarks (as well as marks) in 1998 even before entering into the World Trade Organization (“WTO”) in 2002. The Trademark Act was amended in 1997 to satisfy the requirements of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) and Paris Convention for the Protection of Industrial Property (“Paris Convention”). In 2003, the Trademark Act was further amended to implement the protection on the dilution of well-known trademarks and to impose civil liabilities on a person who passes off well-known trademarks. While the governmental agency, Taiwan Intellectual Property Office (“TIPO”), has made the guidelines of well-known trademarks, it is necessary to look at the judicial branch because courts ultimately decide whether a trademark in question is a well-known trademark and to what extent the Trademark Act can protect such well-known trademark.

This article is intended to explore the judicial standard for the well-knownness of trademarks in the hotel industry. The study is based on the decisions issued by the Taiwan Intellectual Property Court (“TIPC”). Two internationally-famous hotels are involved in those decisions: Amanresorts International Pte Ltd. and Four Seasons Hotels (Barbados) Ltd. In both cases, the famous hotel tried to oppose a registered trademark that looks similar to its own well-known trademark. Amanresorts was troubled with one advertising company that registered a trademark “aman” and designated the trademark to architectural design services. There might be a scenario where that advertising company wanted to create an architectural design for commercial houses (or buildings) to mimic the style or image of Amanresorts. Four Seasons was also passed off by one advertising company that registered a trademark composed of “Four Seasons Villa&Resort” and designated the trademark to gardening services. While both Amanresorts’ trademark and Four Seasons’ trademark were considered well-known by the court, only Amanresorts successfully requested the TIPO to cancel the registration of “aman.”

In this article, Part II discusses the trend of well-known mark protection under international law. Part III introduces the legislative history of the Trademark Act on the well-known trademark protection. Part IV analyzes the court decisions about Amanresorts and Four Seasons and summarizes the judicial standard for well-knownness. Part IV also explains the implications of those two decisions.

II. Well-Known Mark Protection and International Law

The protection of well-known marks was first addressed internationally in Article 6*bis* of the Paris Convention for the Protection of Industrial



Property (“Paris Convention”) at the Revision Conference in the Hague in 1925.¹ Article 6*bis* includes three clauses²:

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.
- (2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.
- (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

Article 6*bis* mandates each treaty member to permit the owner of a well-known mark to oppose or request to cancel a registered trademark that is similar to such well-known mark and that may cause confusion to the extent where customers may associate such registered trademark with the source of such well-known mark. Article 6*bis*(3) specifically requires the unlimited period against bad-faith users of a well-known mark or trademark.

Near the end of the twenty century, the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) spoke about the well-known mark issue again in Article 16.³

Article 16(2) recites, “Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is

¹ See Leah Chan Grinvald, *A Tale of Two Theories of Well-Known Marks*, 13 VAND. J. ENT. & TECH. L. 1, 19 (2010).

² See World Intellectual Property Organization [WIPO], *Paris Convention for the Protection of Industrial Property*, http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html (last visited Nov. 7, 2014).

³ See Martin R.F. Senftleben, *Keyword Advertising in Europe-How the Internet Challenges Recent Expansions of EU Trademark Protection*, 27 CONN. J. INT’L L. 39, 65 (2011).



well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.”⁴ While Article 6*bis* of the Paris Convention addresses well-known marks in goods, Article 16 of the TRIPS extends the protection to well-known marks in services.⁵

Article 16(3) recites, “Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.”⁶ While Article 6*bis* of the Paris Convention applies to “identical or similar” goods, Article 16 of the TRIPS applies not only to “identical or similar” goods or services, but also to “dissimilar” goods or services.⁷

The TRIPS became effective on January 1, 1995.⁸ In 1999, the WTO and WIPO reached a Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (hereinafter, “Recommendation”).⁹ The Recommendation specifically addressed the issues of dilution of well-known marks. The drafting process of the Recommendation began in 1995 and went through three yearly sessions managed by the WIPO Committee of Experts on Well-Known Marks by the end of 1997.¹⁰ Later, the drafting process was

⁴ World Trade Organization [WTO], *PART II — Standards Concerning the Availability, Scope and Use of Intellectual Property Rights*, http://www.wto.org/english/tratop_e/trips_e/t_agm3_e.htm#2 (last visited Nov. 7, 2014) [hereinafter, WTO, *PART II*].

⁵ See Latha R. Nair, *Tracking the Protection of Well-Known Marks in India: A Befuddled Path to Nirvana?*, 101 TRADEMARK REP. 1419, 1421(2011).

⁶ WTO, *PART II*, *supra* note 4.

⁷ See Eugene C. Lim, *Dilution, the Section 22 Debacle, and the Protection of Business Goodwill in Canada: Some Insights from U.S. Trademark Law and Policy*, 101 TRADEMARK REP. 1232, 1242-43 (2011).

⁸ See WTO, *Overview: The TRIPS Agreement*, http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (last visited Nov. 8, 2014) [hereinafter, WTO, *Overview*].

⁹ See Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 Yale J. Int'l L. 405, 432 (2010).

¹⁰ See WIPO, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks: Preface*, http://www.wipo.int/about-ip/en/development_iplaw/pub833.htm (last visited Nov. 8, 2014) [hereinafter, WIPO, *Joint Recommendation*].



continued by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications from 1998 to 1999.¹¹

The Recommendation provides guidelines for determining whether a mark is well known. Article 2(1)(b) provides six necessary factors: “1. the degree of knowledge or recognition of the mark in the relevant sector of the public; 2. the duration, extent and geographical area of any use of the mark; 3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; 4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark; 5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities; 6. the value associated with the mark.”¹² Such six factors are not exclusive.¹³ According to Article 2(1)(a), a member state can consider additional factors.¹⁴ In terms of weighing of different factors, Article 2(1)(c) requires a case-by-case standard.¹⁵

Specifically for Factor 1, Article 2(2)(a) defines the factors for determining “relevant sector of the public”: “(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies; (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies; (iii) business circles dealing with the type of goods and/or services to which the mark applies.”¹⁶ But, these three factor are not a factor which must be considered according to Article 2(2)(a). Furthermore, Article 2(3)(a) excludes some factors from consideration¹⁷:

- (i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;
- (ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has

¹¹ *See id.*

¹² WIPO, *Publication 833: Part I (Determination of Well-Known Marks)*, http://www.wipo.int/about-ip/en/development_iplaw/pub833-02.htm#P90_4657 (last visited Nov. 8, 2014) [hereinafter, WIPO, *Publication 833: Part I*].

¹³ *See id.*

¹⁴ *See id.*

¹⁵ *See id.*

¹⁶ *Id.*

¹⁷ *Id.*



been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

But, particularly for Factor (ii), according to Article 2(3)(b), “a Member State may, for the purpose of applying [Article 2(2)(d)], require that the mark be well known in one or more jurisdictions other than the Member State.”¹⁸

One scenario where a mark must be considered well-known is vested in Article 2(2)(b) reciting, “Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.”¹⁹ There are two guidelines that limit the holding of “not well-known.” Article 2(2)(c) states, “Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.”²⁰ Article 2(2)(d) states, “A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies [Article 2(2)(c)], known, in any relevant sector of the public of the Member State.”²¹

III. Taiwan’s Legislation on the Protection of Well-Known Trademarks

A. 1997 Amendment

The Trademark Act (*shang biao fa*, in Mandarin) did not include any provisions specifically for protecting well-known trademarks until 1997. The 1997 amendment dealt with the issues of conflicting marks. The main purpose of the amendment was to fulfill the requirements of Taiwan’s accession to the WTO.²² Taiwan had to amend IP laws to comply with the TRIPS because protecting well-known marks was one obligation under the TRIPS.

The 1997 amendment added one condition of ineligible registration into Article 37.²³ The newly-added condition was that a trademark cannot be registered if it is the same as, or similar to, other’s well-known trademark or mark to cause likelihood of confusion to the public. The new clause gave the

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.*

²² See LEGISLATIVE YUAN OF TAIWAN, LI FA YUAN GONG BAO (VOL. 86 NO. 6) 238 (Taipei City, Taiwan, Legislative Yuan of Taiwan 1997).

²³ See LEGISLATIVE YUAN OF TAIWAN, LI FA YUAN GONG BAO (VOL. 86 NO. 7) 267 (Taipei City, Taiwan: Legislative Yuan of Taiwan 1997).



TIPO the authority to cancel or deny the registration of a trademark that is the same as, or similar to, a well-known trademark or mark.

B. 2003 Amendment

The 2003 amendment introduced the protection against the dilution of a well-known trademark. Article 37 was amended and renumbered as Article 23.²⁴ The purpose of the amendment was to comply with the Recommendation.

The condition newly added by the 1997 amendment was revised again to extend “the public” to “the relevant public,” so the determination of likelihood of confusion is based on the view of the relevant public. In addition, Article 23 further provided another condition where a trademark cannot be registered if it is the same as, or similar to, other’s well-known trademark or mark so as to likely dilute the distinctiveness or reputation of such well-known trademark or mark.

Moreover, the 2003 amendment added Article 62 to provide one cause of action for the owner of a well-known registered trademark to stop an infringing use.²⁵ Under Article 62, a person is liable for trademark infringement if, without a trademark owner’s consent, he knows other’s well-known registered trademark and uses the words in that well-known trademark as a name of his own company, a trade name, a web address name, or other mark that represents a business entity or source so as to dilute the distinctiveness or reputation of such well-known trademark or mark. The clause requires actual dilution.²⁶

C. Current Law

The Trademark Act was amended again in 2011, and the provisions related to well-known trademarks or marks remained unchanged except for the civil liability clause. Article 23 of the 2003 amendment is now Article 30, while Article 62 of the 2003 amendment is now Article 70. The clause against an infringing use of a well-known trademark does not require “actual dilution.” Only likelihood of dilution is required.²⁷

IV. Analysis of Judicial Decisions regarding Well-Known Trademarks in the Hotel Industry

²⁴ See LEGISLATIVE YUAN OF TAIWAN, LI FA YUAN GONG BAO (VOL. 92 NO. 23) 239-44 (Taipei City, Taiwan: Legislative Yuan of Taiwan 2003).

²⁵ See *id.* at 296-97.

²⁶ See *id.* at 296-97.

²⁷ See LEGISLATIVE YUAN OF TAIWAN, LI FA YUAN GONG BAO (VOL. 100 NO. 45) 315 (Taipei City, Taiwan: Legislative Yuan of Taiwan 2011).



A. General Standard for the Well-Knownness of a Trademark

In Part IV, two cases are analyzed: Administrative Decisions 2011 Xing Shang Su Zi No. 73 (Taiwan Intellectual Property Court 2011) (hereinafter, “Amanresorts court”)²⁸ and 2008 Xing Shang Su Zi No. 83 (Taiwan Intellectual Property Court 2008) (hereinafter, “Four Seasons court”).²⁹ The standard elaborated here relates to how the TIPC determines the likelihood of confusion and the dilution of distinctiveness and reputation caused by opposed trademarks.

The Amanresorts court held that Amanresorts’ “AMAN” (Fig. 1(a)) and “AMANRESORTS” (Fig. 1(b)) are well-known registered trademark. The holding was based on three pieces of evidence. First, the court found that Amanresorts had filed trademark applications in several countries (e.g., Tailand, Malaysia, Australia, German, and European Union) and acquired registered trademarks in those countries. Second, the court found the business record provided by Amanresorts proved that Amanresorts had a successful business in the hotel industry. Amanresorts provided its hotel booking records, revenue records, award records, and publications and also demonstrated that it had established hotels or resorts in several countries (e.g., Tailand, Indonesia, Bhutan, India, Sri Lanka, Morocco, and United States). Third, the court relied on two authors’ travel articles that show Amanresorts is famous in the hotel industry.



(a)



(b)

Figure 1: Amanresorts’ well-known trademarks.

The Four Seasons court held that Four Seasons’ trademarks, “FOUR SEASONS” (Fig. 2(a)), “四季” (*si ji*, in Mandarin) (Fig. 2(b)), and Four Seasons-figure mark (Fig. 2(c)), are well-known. The decision was based on three reasons. First, Four Seasons had filed trademark applications in our country and several other countries (e.g., United States, China, European Union, Canada, Australia, German, Japan, and Korea). It also acquired trademark rights. Second, Four Seasons had established 4 hotels and 31 resorts around the World. In addition, several locations (e.g., Bangkok, Chiang Mai, Hong Kong, Shanghai, and Tokyo) where Taiwan travelers

²⁸ Administrative Decision 2011 Xing Shang Su Zi No. 73 (Taiwan Intellectual Property Court 2011) [智慧財產法院行政判決 100 年度行商訴字第 73 號].

²⁹ Administrative Decision 2008 Xing Shang Su Zi No. 83 (Taiwan Intellectual Property Court 2008) [智慧財產法院行政判決 97 年度行商訴字第 83 號].



often visit had Four Seasons' hotels. Travel agencies in Taiwan often promoted travel plans that feature a stay in a Four Seasons' hotel. Third, Four Seasons had launched a series of commercial advertising in one Taiwan magazine since 1999.

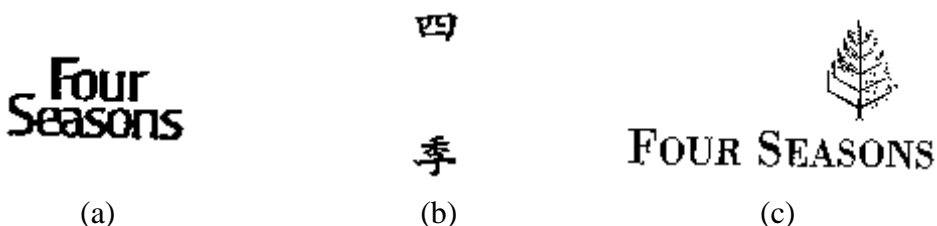


Figure 2: Four Seasons' well-known trademarks.

The evidence adopted to demonstrate that both Amanresorts and Four Seasons owned well-known trademarks is similar in those two courts. To prove well-knownness of a trademark or mark, it is sufficient for the owner to show trademark applications and registrations, business activities, or travel articles. So, the determination of a well-known mark under the Taiwan Intellectual Property Court's jurisprudence may comply with Taiwan's duties under the international IP treaties.

To recognize either of those trademarks as a well-known trademark is not enough, whether the law can stop others from imitating those trademarks is more important to the owners. Under Article 3(1) of the Recommendation, a "Member State shall protect a well-known mark against conflicting marks, business identifiers and domain names, at least with effect from the time when the mark has become well known in the Member State."³⁰ Article 4(1)(a) defines one category of conflicting trademarks as a "mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration, liable to create confusion, of the well-known mark, if the mark, or an essential part thereof, is used, is the subject of an application for registration, or is registered, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies."³¹ This category focuses on identity or similarity of the goods and/or services between a conflicting mark and a well-known mark.

Article 4(1)(b) defines a second category of conflicting trademarks as a "mark, or an essential part thereof, constitutes a reproduction, an imitation, a

³⁰ WIPO, *Publication 833: Part II (Scope of Protection)*, http://www.wipo.int/about-ip/en/development_iplaw/pub833-03.htm#TopOfPage (last visited Nov. 8, 2014) [hereinafter, WIPO, *Publication 833: Part II*].

³¹ *Id.*

translation, or a transliteration of the well-known mark, and where at least one of the following conditions is fulfilled: (i) the use of that mark would indicate a connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and would be likely to damage his interests; (ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark; (iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.”³²

Article 4(1)(b) disregards identity or similarity of the goods and/or services between a conflicting trademark and a well-known trademark.³³ Rather, it recognizes three kinds of conflicting trademark.³⁴ The first type is a trademark which causes the association between it and the goods and/or services provided by the owner of an infringed well-known trademark so that such owner’s interests are likely damaged.³⁵ The second type is a trademark which causes the impairment or dilution of the distinctive character of a well-known trademark.³⁶ Whether the impairment or dilution is done by an unfair manner is a matter of degree.³⁷ Last, the third type is a trademark which takes advantage of the distinctive character of a well-known trademark. Again, whether the advantage taken is unfair is a matter of degree.³⁸

The Recommendation provides three measures for the owner of a well-known trademark to knock out a conflicting mark. Article 4(2) provides to well-known trademark owners the right to oppose a conflicting trademark in an opposition procedure if the opposition procedure is available in such a country.³⁹ The opposition procedure is a forum for the public to oppose the registration of a trademark application before such registration if such registration will cause the harm of the opposer’s interests.⁴⁰ If the opposer succeeds, then the trademark agency will withdraw or cancel the registration of the conflicting mark. The second measure is vested in Article 4(3) which

³² *Id.*

³³ *See id.*

³⁴ *See id.*

³⁵ *See id.*

³⁶ *See id.*

³⁷ *See id.*

³⁸ *See id.*

³⁹ *See id.*

⁴⁰ See Ethan G. Zlotchew, “Scandalous” or “Disparaging”? It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act’s Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics, 22 COLUM.-VLA J.L. & ARTS 217, 222-23 (1998).



provides the right to invalidate a conflicting trademark.⁴¹ An invalidation decision may be made by a competent authority, either a court or a trademark agency.⁴² Last, the third measure is the right to prohibit the use of a conflicting trademark and is vested in Article 4(4).⁴³

The two cases analyzed in this paper are related to the second measure. In each case, the well-known trademark owner initiated an invalidation request in the TIPO. The conflicting trademark uses all or part of the features of the well-known trademark. In the next two sections, two cases will be analyzed in terms of why the TIPC did or did not invalidate the disputed trademark.

B. Amanresorts International Pte Ltd.

In the Amanresorts case, the opposed trademark was “aman” (Fig. 3). The Amanresorts challenged the disputed trademark because it caused likelihood of confusion with Amanresorts’ well-known trademarks.



Figure 3: The disputed trademark.

The TIPC agreed with Amanresorts. First, Amanresorts’ well-known trademarks were quite distinctive, while the disputed trademark was less distinctive. Second, Amanresorts’ trademarks were more well-known than the disputed trademark because Amanresorts had used its trademarks for a very long time. Third, while the disputed trademark was designated to “rental and sale of various kinds of building, real estate transactions, lease brokers, real estate management services” and Amanresorts’ trademarks were designated to hotel services and hostel services, the use of Amanresorts’ trademarks was not limited to hotel services and hostel services because Amanresorts had begun its real estate business with its trademarks. So, the TIPC concluded, “Objectively, relevant consumers are likely to misunderstand that the services offered under the disputed trademark and [Amanresorts’ trademarks] are from the same source or that the user of the disputed trademarks is an affiliation [of Amanresorts], or has a licensing relationship, franchise relationship, or any other similar relationship with [Amanresorts].” The similarity between the disputed

⁴¹ See WIPO, *Publication 833: Part II*, *supra* note 30.

⁴² See *id.*

⁴³ See *id.*



trademark and Amanresorts' trademarks would result in the likelihood of confusion.

C. Four Seasons Hotels (Barbados) Ltd.

In the Four Seasons case, Four Seasons challenged the disputed trademark (Fig. 4), the combination of Mandarin characters (“四季山莊”) and English characters (“Four Seasons Villa&Resort”), because the disputed trademark had caused likelihood of confusion with Four Seasons' well-known trademarks and likelihood of dilution of the distinctiveness or reputation of Four Seasons' trademarks.



Figure 4: The disputed trademark.

Although recognizing the high similarity between Four Seasons' trademarks and the disputed trademark, the TIPC held no likelihood of confusion or dilution.

Regarding the issue of likelihood of confusion, the TIPC considered four factors: (1) “the degree of relevancy between the services as designated by both trademarks,” (2) “the situation of the diversity of the plaintiff's businesses,” (3) “circumstances of actual confusion,” and (4) “the degree of how relevant consumers get familiar with the later registered trademark.”

Because of two main reasons, the TIPC concluded no confusion between the uses of the disputed trademark and Four Seasons' trademarks. First, the service as designated by the disputed trademark is dissimilar from the Four Seasons' service. The service of the disputed trademark covers “gardening and landscaping, turf care, weed removal, garden design, landscape design, and garden landscaping,” while Four Seasons' service covers “hotels, hostels, real estate, and rental services of various kinds of building.” The TIPC held that those two services are less commercially relevant because “the nature of each service is different, the needs or purposes of the customers in those services are different, the markets of those services are obviously separate and non-competing.”

Second, the TIPC held that “the protective scope depends on the degree of the well-knownness of the well-known trademark and degree of the diversity of the owner’s businesses.” The protection for Four Seasons cannot extend to the gardening service because the well-knownness of Four Seasons’ trademarks is “limited to hotels, hotel service industry, tourism, and relevant consumers, but not to the general public.” The use of Four Seasons’ trademarks is in the area of “hotels, hostels, residential apartments, and hotel houses.” The intent to diversify the owner’s businesses is not shown. Therefore, it cannot be concluded that the protective scope can be extended to the field that is less relevant to the hotel industry.

Regarding the dilution issue, the TIPC held that the applicable standard is to consider (1) “the degree of inherent distinctiveness and well-knownness of the well-known trademark,” (2) “the degree of similarity between the trademarks [of both parties],” and (3) “the uses of the [well-known] trademark by third parties to associate with different goods or services.” Because the distinctiveness of Four Seasons’ well-known trademarks was weak, the TIPC held no dilution. The main reason for such holding was that “FOUR SEASONS” or “四季” is suggestive and indicates the service provided by hotel in all four seasons. Additionally, there had existed prior uses of “FOUR SEASONS” or “四季” as trademarks by others, either foreign or domestic trademark owners in other products or services. Thus, the TIPC held there was no dilution of the distinctiveness or reputation of Four Seasons’ trademarks.

D. Implications

Drawing from those two decisions, some implications can be concluded. First, international trademark filing, publications about the hotel, advertisements in magazines or journals, worldwide establishments of hotel business, and business records are those factors which help define the well-knownness of a trademark or mark in the hotel industry.

Second, the similarity factor is not an ultimate factor for a well-known trademark owner to invalidate a conflicting trademark under Article 4(1)(b) of the Recommendation.

Third, the protective scope of a well-known mark with respect to conflicting trademarks depends on the degree of the well-knownness of a well-known trademark in the fields other than what such well-known trademark is designated to.

Finally, the degree of diversity of the businesses of a well-known trademark holder helps enlarge the protective scope of such well-known trademark.



V. Conclusion

While the trademarks of both Amanresorts and Four Seasons are considered as well-known in the hotel industry by the TIPC, Amanresorts acquires more extensive protection than Four Seasons. The key issue is whether the owner of a well-known trademark intends to enter the business sectors other than what the well-known trademark is designated to. In the Amanresorts case, Amanresorts successfully requested the TIPO to revoke one registered trademark which uses “aman.” The revoked trademark was designated to architectural design services. The TIPC affirmed the TIPO’s ruling because Amanresorts has used “AMAN“ for its real estate business. Whereas, in the Four Seasons case, the TIPC affirmed the TIPO’s denial of the revocation of a trademark requested by Four Seasons because the challenged trademark was designated to gardening services. Four Seasons argued that it did provide gardening services because its hotels were famous of its garden decors, but the TIPC disagreed by stating that the garden decors were only part of the hotel services and that it did not show that Four Seasons intends to enter into the gardening business. Comparing both cases, the key implication could be that a hotel has to extend to other business sectors so as to acquire a well-protected well-known trademark.

Cited as:

Bluebook Style: Ping-Hsun Chen & Ting-Wei Huang, *Judicial Standard for the Well-Knownness of Trademarks in the Hotel Industry under the Case Law of the Taiwan Intellectual Property Court*, 3 NTUT J. OF INTELL. PROP. L. & MGMT. 164 (2014).

APA Style: Chen, P.-H. & T.-W. Huang. (2014). Judicial standard for the well-knownness of trademarks in the hotel industry under the case law of the Taiwan Intellectual Property Court. *NTUT Journal of Intellectual Property Law & Management*, 3(2), 164-177.

OSCOLA Style: PH Chen & TW Huang, ‘Judicial Standard for the Well-Knownness of Trademarks in the Hotel Industry under the Case Law of the Taiwan Intellectual Property Court’ (2014) 3 NTUT Journal of Intellectual Property Law & Management 164.

