

CNIPA recognises distinctiveness of Tommy Hilfiger's 'TH' interlocking pattern (2023)

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Background

Tommy Hilfiger worked with celebrated British illustrator and graphic designer Fergus Purcell to introduce its brand-new monogram in 2022:



On 20 January 2022 Tommy Hilfiger filed applications for the registration of the above device mark in Classes 18 and 25. The CNIPA refused the applications, citing Articles 11.1.3 of China's Trademark Law (lack of distinctiveness).

Tommy Hilfiger filed an application for review, arguing as follows:

In the fashion industry, it is a common practice to use a monogram as a source identifier. Brands like Louis Vuitton, Gucci and Fendi all have their own monogram and have registered such patterns as device marks in China. The mark applied for is formed by interlocking the letter 'T' with the letter 'H', with the 'T' referring to 'Tommy' and the 'H' referring to 'Hilfiger'.

It is artistically designed and is inherently distinctive. In addition, Tommy Hilfiger has extensively used its new monogram on a series of products and in brand publicity, so that consumers will identify the mark as originating from Tommy Hilfiger.

The registration and use of the mark conformed with the practice of the fashion industry. The refusal of the registration would prejudice the interests of Tommy Hilfiger and those of the public.

CNIPA review decision

On 6 June 2023 the CNIPA approved the registration of the mark.

A pattern mark - a trademark consisting of a set of elements that are recurrent and repeated regularly - is registrable in certain jurisdictions. Since pattern marks are not expressly listed as registrable trademarks in China's Trademark Law, brand owners often apply to register their monogram patterns as device marks. However, the registrability of such device marks is often challenged by examiners on the ground that they are overly complicated or purely decorative, so that they are devoid of distinctive features and could not function as a source identifier.

To overcome such a refusal, brand owners may argue that:

the mark applied for is inherently distinctive due to its individual design and originality; and/or
the mark has acquired distinctiveness through extensive use.

However, in practice, it is an onerous task to prove acquired distinctiveness. The examiners tend to see the recurrent use of a monogram as purely decorative, and not as a trademark used to indicate the source of the goods. In addition, the evidence required to prove acquired distinctiveness is usually on par with that required to demonstrate well-known status.

In 2021 the Beijing High Court handed down a decision in the administrative litigation concerning the review of the refusal of Burberry's device mark:



The court concluded that the evidence was insufficient to prove the acquired distinctiveness of the mark, based on the finding that Burberry had mainly used the mark as the exterior design of products, which did not constitute trademark use.

In the subject case, given the relatively short-term use of the 'TH' interlocking pattern and the difficulty of proving acquired distinctiveness, Tommy Hilfiger mainly focused on the inherent distinctiveness of the mark; further, it cited precedents in which similar marks had been registered to build its case. The CNIPA's finding that the mark applied for had intrinsic distinctiveness and could act as a source identifier shows that it still leaves the door open for the registration of pattern marks in a roundabout way.

Comment

If a pattern mark is found to be devoid of inherent distinctiveness and has not yet acquired distinctiveness, a compromise for brand owners would be to add a word element to the monogram or to apply for a single unit of the pattern to lower the risk of the mark being refused *ex officio* by the CNIPA.