

Taking Advantage of the Reputation of the Legitimate Trademark Owner: How to Prove?

Proving that a third party has exploited the reputation of a trademark owner is never simple. It demands a comprehensive approach to gather and utilize evidence in disputes over trademark rights, particularly in instances where trademarks are registered with malicious intent (*bad faith*). KENFOX IP & Law Office offers the following step-by-step guidance to assist legitimate trademark owners in demonstrating that their trademark's reputation has been exploited.

Step 1: Establish the reputation and recognition of the trademark

- *Documentation of trademark use:* The legitimate trademark owner needs to provide documents showing the use of his trademark in commerce, including marketing materials, sales data and advertising expenditures over time.
- *Market surveys:* Conduct or obtain existing consumer surveys that demonstrate the level of recognition and positive association consumers have with the trademark.
- *Media coverage and publicity:* Compile articles, news reports, and other media content that highlight the presence and recognition of the trademark in the relevant market.
- *Awards and recognitions:* Include any awards or recognitions that the trademark has received which contribute to its reputation.

Step 2: Establish the similarity between the marks

- *Visual comparison:* Provide side-by-side comparisons between trademarks to highlight similarities in their structure, pronunciation, meaning, and presentation.
- *Expert opinion:* Request an assessment (expert opinion) at [Vietnam Intellectual Property Research Institute](#) on the similarity between the marks and the possibility of causing confusion for consumers.

Step 3: Establish third-party recognition of the mark

- *Same industry:* Evidence that both the applicant and the trademark owner actually operate in the same industry and participate in trade shows, conferences or markets to argue that a third party may have knowledge of the trademark of genuine owner's trademark.
- *Previous Interactions:* If any previous interactions (communications, business transactions, disputes) exist between the applicant and the genuine owner's trademark, then these documents can establish that the applicant knew of the pre-existence of the mark.

Step 4: Establish the intention to deceive or take advantage of a reputable brand

- *Direct intent:* Any direct communication from the applicant that indicates an intention to take advantage of the mark's established market presence.
- *Economic interest:* Provides analysis to clarify how the applicant's actions may have been motivated by a desire to benefit from the established reputation of the mark.
- *Market entry strategy:* Documentation or analysis showing that the applicant's market strategy is designed to mimic the success of the trademark owner's trademark.

Step 5: Evidence of actual consumer confusion

- *Consumer complaints:* Collect confirmations or complaints from consumers who are confused or misled by similarities between trademarks.
- *Cases of confusion:* Where a consumer or supplier confuses the applicant's products/services with those of the legitimate trademark owner.

Step 6: Analyze the impact on the genuine trademark owner

- *Sales impact analysis*: Provides data on any loss of sales, market share or business opportunities due to the applicant's use of a similar mark.
- *The possibility of trademark dilution*: Evidence that the value or perception of the true trademark owner's trademark has been diluted by the applicant's actions.

Final thought

The above six-step guide provides a comprehensive approach for legitimate trademark owners in proving that a third party has taken advantage of the reputation and goodwill of the mark. To succeed in trademark disputes related to “bad faith”, the legitimate trademark owner needs to provide documents proving the reputation and public recognition of the mark, proving similarity between the marks, the awareness of the applicant, the applicant's intention to deceive or exploit economically, and evidence of actual consumer confusion.

Please contact KENFOX IP & Law Office for in-depth advice and support in resolving complex issues related to intellectual property, especially cases of malicious trademark registration in Vietnam. With extensive practical experience and success in resolving many trademark disputes, both administrative and court proceedings, KENFOX is ready to accompany you to protect your rights in the most effective way.

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