

Protection of Famous Names Under Trademark Law: Lessons from the Usain Bolt Case and Vietnamese Practice



The successful opposition by Usain Saint Leo Bolt ("**Usain Bolt**") against the trademark application " in China stands as a prime example of how the China National Intellectual Property Administration ("**CNIPA**") recognizes and protects the rights attached to a famous personal name, even where no trademark registration exists in China. The CNIPA's decision has set a noteworthy precedent for legitimate foreign brand owners: even without formal trademark registration, individuals with a high level of fame and a strong association between their name and identity may still be afforded legal protection. Significantly, the CNIPA did not limit its assessment to the textual element "BOLT," but also took into account the graphic portion of the disputed mark, which bore a strong resemblance to Usain Bolt's iconic silhouette. This reflects the CNIPA's perceptiveness in identifying acts of unfair "free-riding" on personal image and reputation.

However, this raises a critical question: Had this case occurred in Vietnam, where current trademark examination practice remains heavily tilted in favor of the "first-to-file" principle, could an unregistered foreign rights holder have achieved a similar outcome? Or would they have become entangled in a prolonged, multi-tiered legal battle with an unpredictable result?

KENFOX IP & Law Office offers an in-depth analysis of the Usain Bolt case, alongside a comparison with Vietnam's current trademark examination practice. This aims to help legitimate brand owners shape effective trademark protection strategies and mitigate avoidable risks when navigating one of the fastest-growing and most dynamic markets in the region.

The Usain Saint Leo Bolt Trademark Opposition Case: A Progressive Decision by the China National Intellectual Property Administration (CNIPA)

Usain Saint Leo Bolt (the "**Opponent**") filed [an opposition against Trademark Application](#) No. 43691032 ("



") in Class 12 (the "**Opposed Mark**"), submitted by Fujian Victoria Machinery Co., Ltd. (the "**Applicant**"), on the grounds of his name rights. Upon review, the China National Intellectual Property Administration ("CNIPA") issued a decision rejecting the registration of the Opposed Mark.

The CNIPA's decision stated: *"The evidence submitted by the Opponent demonstrates that the Opponent is a well-known Jamaican athlete who holds multiple world records in men's sprint events. As an Olympic champion, "Bolt" had become widely recognized well before the filing date of the Opposed Mark. Given that Chinese audiences commonly refer to foreigners by their surnames, it can be concluded that within the perception of the relevant Chinese public, the name "Bolt" has established a unique and specific association with the Opponent. The Applicant should have been aware of this. The letters comprising the Opposed Mark are identical to the English portion of the Opponent's name, "Bolt". The Applicant, without the Opponent's authorization, applied to register this word as a trademark with the intent of seeking improper benefits. This could easily mislead the relevant public into believing that the mark has a particular connection with the Opponent, thereby infringing upon the Opponent's name rights"*.


This decision by the CNIPA reflects a progressive and balanced approach to protecting the rights associated with famous personal names. Despite the fact that Usain Saint Leo Bolt had no prior trademark registration in China, the CNIPA accepted the opposition based on his international reputation and the strong public association between the name "Bolt" and the Opponent.

Key factors considered by the CNIPA included:

- **Degree of Fame and Public Association:** The name "Bolt" had established a strong, unique, and widespread association with Usain Saint Leo Bolt within the perception of the Chinese public.
- **Potential Damage:** Registration of the Opposed Mark could mislead consumers into believing that there was a connection between the mark and Usain Saint Leo Bolt, thereby causing harm to his legitimate rights.
- **Bad Faith Intent:** The Applicant acted with the apparent intention of unfairly capitalizing on the fame and reputation of Usain Saint Leo Bolt for commercial gain.

Notably, the CNIPA also took the graphic element of the Opposed Mark into consideration. Although the figurative component of the Opposed Mark was only vaguely or superficially similar to Usain Bolt's iconic



silhouette “”, and despite the fact that the Opposed Mark was filed for goods in Class 12, namely, “carriages” (vehicles), a field clearly unrelated to the sports industry where Usain Bolt has achieved fame, the CNIPA nonetheless rendered a bold and decisive ruling that the mark constituted an act of imitation and unfair exploitation of Bolt's personal image. This demonstrates the CNIPA's nuanced and assertive approach in safeguarding intellectual property rights, even in cases where the contested elements are not entirely identical.

Comparison with Vietnamese Trademark Examination Practice: Time for Vietnam to Re-evaluate its Approach to Protecting Genuine Trademark Owners' Rights

While the decision issued by the CNIPA in the Usain Saint Leo Bolt case has been widely recognized by the international intellectual property community as a progressive step forward in protecting personal name and image rights, Vietnam's current trademark [examination](#) practice, particularly in cases where the mark or name in question has not yet been registered, presents a markedly different picture. This reality poses significant challenges for genuine trademark owners, especially foreign companies.

Although Vietnam's Intellectual Property Law, under Articles 74.2(g) and 74.2(i), has established a legal framework aimed at balancing two fundamental principles, “**first-to-file**” and “**first-to-use**”, in practice, the mechanism for protecting prior use rights is almost entirely rendered ineffective. The vast majority of opposition cases based on prior use or international reputation are routinely rejected with familiar reasoning: “**Insufficient evidence to prove that the trademark has been widely used or has established reputation in Vietnam**”, or “**Trademark rights are territorial in nature,**” or “**Foreign decisions are for reference only and are not binding**”.

This rigid, overly formalistic, and evidence-heavy approach has unintentionally placed genuine trademark owners, particularly foreign enterprises, at a serious disadvantage, even though they are the very parties the law intends to protect. Examiners, though empowered to weigh and balance competing legal principles, often opt for the “safer” route: strictly adhering to the first-to-file principle and summarily dismissing any arguments based on prior use rights unless the evidence submitted is overwhelmingly strong and nearly flawless, an often unattainable standard for foreign marks not yet actively marketed or promoted in Vietnam.

More alarmingly, this very loophole has inadvertently **fueled the growing and increasingly sophisticated problem of trademark squatting in Vietnam**. Opportunistic entities and individuals with bad-faith intent are exploiting weaknesses in the examination system to fast-track ownership of internationally [renowned trademarks](#), despite having no genuine business activities whatsoever.

In the Usain Bolt case, the CNIPA did not confine its assessment to the textual element “BOLT” but adopted a comprehensive and holistic approach, taking into account the graphic elements, the applicant's bad faith, and Bolt's global fame, despite his lack of trademark registration in China. This is a progressive and substantive approach, grounded in protecting legitimate rights and preventing trademark registrations motivated by unfair commercial gain.

It is time for Vietnam to change. Without timely adjustments in legal interpretation and application, not only will foreign enterprises continue to face an uphill battle in protecting their legitimate rights, but the overall investment and business environment in Vietnam also risks being undermined by a surge in protracted, costly, and potentially unjust trademark disputes.

Final thoughts

The Usain Saint Leo Bolt case serves as a clear demonstration that intellectual property authorities can and should apply legal provisions flexibly to protect the legitimate rights of individuals and businesses, going beyond the rigid confines of the first-to-file principle where there is sufficient evidence of reputation and bad faith intent. The Vietnam Intellectual Property Office (IPVN) can draw valuable lessons from the CNIPA's approach in this case improve the quality of trademark examination in Vietnam. The IPVN should adopt a more flexible approach, comprehensively assessing factors like international reputation, intentional infringement, and the risk of confusion, rather than solely focusing on the quantity and quality of evidence of use within Vietnam.

Protecting the reputation and trademark rights of genuine brand owners is not just a legal responsibility; it's also a measure of the transparency and credibility of a nation's intellectual property system.

By QUAN, Nguyen Vu | Partner, IP Attorney

PHAN, Do Thi | Special Counsel

HONG, Hoang Thi Tuyet | Senior Trademark Attorney

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com