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Use of 'V-KOOL' as mark, domain name and company name held to constitute infringement

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On January 3 2014 the Intellectual Property Court rendered a decision in favour of plaintiff Solutia Singapore Pte Ltd in a trademark infringement case involving the use of 'V-KOOL' as a trademark, domain name and company name.

The plaintiff sued the defendants - Leader Window Film Co Ltd, V-KOOL International Co Ltd and four individuals - jointly for infringement of the following trademarks:

- V-COOL (and design), registered in 1999 for "window film used for automobiles" and "window film" in Class 17 of the Nice Classification:



- V-COOL, registered in 2010 for "semi-processed plastic substances" in Class 17 and "insulating glass" in Class 19:

V-KOOL

- I'M V-KOOL, registered in 2012 for "window film" in Class 17:

I'M V-KOOL

The plaintiff had obtained the above marks from V-KOOL International Pte Ltd, which had launched the wellknown V-KOOL mark for "thermal insulation film" in 1993 and had imported the products into Taiwan since 1996.

The defendants manufactured and sold thermal insulation film products using the term 'V-KOOL', with the words 'Leader Products' below in small size lettering. V-KOOL is the English company name of V-KOOL International Co Ltd. Both Leader Window Film Co Ltd and V-KOOL International Co Ltd used the term 'usVKOOL' as their domain name.

The plaintiff alleged that the defendants intended to take undue advantage of the fame of its V-KOOL trademark and to cause confusion among general consumers regarding the quality and origin of the products, which amounted to trademark infringement and unfair trading.

The Intellectual Property Court ruled in favour of the plaintiff based on the following findings:

1. The plaintiff's trademark V-KOOL has been recognised as famous by the Intellectual Property Office in several decisions. The continuing sales and promotion of products bearing the V-KOOL mark attested to the fame of the mark to date.

2. The use of the words 'Leader Products' in small size lettering beneath the V-KOOL mark did not affect the similarity and likelihood of confusion between the parties' trademarks.
3. The defendants were not good-faith prior users of the mark. There was a lack of evidence proving sales of the trademarked products by the defendants prior to May 20 1996, the filing date of the plaintiff's trademark.
4. V-KOOL International Co Ltd's use of the term 'V-KOOL' as its English company name to represent itself as a business entity when doing business and corresponding with banks constituted trademark infringement of the famous V-KOOL mark.
5. As the term 'us' refers to 'United States', the term 'usV-KOOL' in the defendants' domain name could be interpreted as meaning "V-KOOL products from the United States", which could mislead the relevant consumers about the origin of the products sold by the defendants. Thus, the defendants' use of the term 'usV-KOOL' as a domain name constituted trademark infringement of the famous VKOOL mark.

The defendants were considered to have infringed the mark intentionally. Accordingly, the court ruled that the defendants were jointly liable for damages, the amount of which was set at 1,200 times the selling price of the defendants' products.

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