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**Marvel fails to cancel X-MEN mark for Class 3 goods
Vietnam - IPMAX Law Firm**

**Cancellation
National procedures**

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The Hanoi City People's Court has upheld a decision of the [National Office of Intellectual Property of Vietnam](#) rejecting [Marvel Characters Inc's](#) petition for the cancellation of the trademark X-MEN, registered by International Consumer Goods Production Limited Company (ICP) (Case 08/2010/TLST-HC).

US company Marvel is the owner of a national trademark registration for the word mark X-MEN (Registration No 11455) for goods in Classes 9, 16, 25 and 28 of the [Nice Classification](#). The registration was granted on April 4 1994.

On June 27 2003 ICP filed an application for the mark X-MEN and device (Application No 4-2003-05427), pictured below, for cosmetic products in Class 3. The registration was granted on June 8 2005 (Registration No 63481).



On August 8 2006 Marvel filed a petition for the cancellation of ICP's trademark, claiming that:

- the mark was identical to its well-known trademark;
- the mark was identical to the name of characters that Marvel used in its well-known comic books and cinematographic works; and
- therefore, registration and use of the mark X-MEN by ICP took unfair advantage of the reputation of Marvel's trademark and copyrighted works in Vietnam.

Having considered the cancellation petition and the evidence submitted by the parties, on January 22 2008 the National Office of Intellectual Property rejected Marvel's petition for cancellation on the following grounds:

- According to the Vietnamese Civil Code 1995 and the regulations on copyright and related rights (applicable when the contested mark was registered), the names of characters are not protected by copyright; therefore, Marvel did not own exclusive rights over the names of the characters used in its comic books and cinematographic works. Moreover, 'X-Men' was not the name of a particular character, as it referred to a group of mutants who possess X-genes with superhuman powers. In fact, each character in the X-Men group has a different name (eg, Storm, Iceman, Angel and Beast).
- The contested mark consisted of the word 'X-Men' in capital letters, with a stylised letter 'X' in a circle. Therefore, it was not identical or similar to characters and images in Marvel's works. In addition, the goods covered by the contested mark fell within Class 3, while Marvel's mark covered goods in Classes 9, 16, 25, and 28. As a result, there was no likelihood of confusion among consumers.
- Although Marvel had provided proof of extensive use of the X-MEN mark in different countries, it was not sufficient to prove the well-known status of the mark in Vietnam. As Marvel had failed to prove that its mark and products were widely known among Vietnamese consumers, it could not be concluded that ICP had committed an act of unfair competition against Marvel in this country.

Marvel appealed to the Inspectorate of the [Ministry of Science and Technology Vietnam](#) (MOST). The MOST Inspectorate was of the same opinion as the National Office of Intellectual Property, concluding that there was no reasonable ground for the cancellation of ICP's trademark. On July 11 2008 the MOST Inspectorate rejected Marvel's petition for cancellation of ICP's trademark.

On August 10 2010 Marvel filed a complaint with the Hanoi People's Court. On March 29 2013 the court

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upheld the decision of the National Office of Intellectual Property.

First, the court agreed with the office that the evidence provided by Marvel was insufficient to prove that its mark had become well known among Vietnamese consumers. In addition, ICP's mark was used in Vietnam for cosmetic products (eg, shampoo and shower gel for men), while Marvel's mark was used for dissimilar goods (ie, comic books, cinematographic works and games). For that reason, the products bearing the two marks were totally different and could not lead to confusion among consumers.

Moreover, Marvel's X-Men were known as a group of mutants with superhuman powers, while ICP's products had become known under the slogan "The real man", which did not contain any reference to the X-Men mutants. Consequently, there was no reasonable ground for concluding that ICP had committed an act of unfair competition against Marvel.

Based on the above reasons, the court confirmed that there was no sufficient ground to cancel ICP's trademark. Accordingly, the court dismissed Marvel's appeal. The decision was final, as Marvel did not appeal, and thus put an end to the six-year dispute.

This case shows that character names, by themselves, are not afforded copyright protection, particularly against the registration of identical names as trademarks, where there is no actual reference to the copyrighted character. While the claim for unfair competition was rejected in this case, similar claims may still be accepted in other cases if the evidence shows that the name at issue was well known to the extent that consumers would associate it with the copyrighted character and mistakenly believe that the products sold under that name come from, or are authorised by, the owner of the characters.

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