

Trademark Review and Adjudication Board
under the State Administration of Industry and Commerce

Adjudication for Dispute over Trademark “UGG” under No.880518

No. 30872 of Shang Ping Zi [2011]

Applicant of the Dispute: Yi Di Leather Technology (Shanghai) Co., Ltd.
Agent: Shanghai Shubin Intellectual Property Agent Ltd.

Respondent: Deckers Outdoor Corporation
Agent: An, Tian, Zhang & Partners

The applicant filed a dispute application on May 24, 2010 over the trademark under No. 880518 for “UGG” (hereinafter referred to as “the disputed mark”) registered by the respondent. We, the Trademark Review and Adjudication Board (TRAB) accepted the dispute. According to Article 24 of *Trademark Review and Adjudication Rules*, we formed a collegial panel to adjudicate the dispute and the adjudication is now finished.

The basis for the dispute is that, “UGG” is a generic name in the industry of sheepskin snow boots and thus shall not be registered as a trademark; the registration of the disputed mark violates Article 11.1.1 of the *Trademark Law of the People’s Republic of China* (“China Trademark Law”) and Article 4 of the *General Principles of the Civil Law*. The applicant pleaded for cancellation of the disputed mark in accordance with Article 41.1 of China Trademark Law.

The applicant submitted the following evidence to support its above arguments (all of them are copies):

1. The Baidupedia and Wikipedia search results of “UGG”;
2. The Decision of a Delegate of the Registrar on the cancellation of “UGH-BOOTS” from the website of Australian Intellectual Property Bureau and its Chinese summary translation, search results from Australian Trade Mark On-line Search System and the press release of the article “Decision on UGG Trade Mark Non-use Action” issued by the Secretary of Australian Parliament and Minister of Industry, Travel and Resources.

The main counter-arguments provided by the respondent are: no law or state and industrial standard defines “UGG” as a commonly used industrial name in China; “UGG” is not a generic name of goods that is formed by historical traditions, local conditions and customs, geological environments, etc.; For Chinese consumers, “UGG” does not stand for any category of goods, but a mark of a series of products

made by the respondent, and it is unique and distinctive, and has obtained high reputation through use; That “UGG” has been approved for registration in many countries, like the U.S.A., the U.K. and the Netherlands, etc. clearly show that it is not a generic name of goods but a mark with distinctiveness. In view of the above, the respondent asked that the registration of the disputed mark should be maintained.

The respondent submitted the following evidence (all of them are copies):

1. China national standard Shoes Terminology published in 2008 and put into force in 2009 by General Administration of Quality Supervision, Inspection and Quarantine and Standardization Administration of China;
2. The entry for “UGG” in Baidupedia, the entry for “UGG” in Wikipedia, the entry for UGG in the English-Chinese Chinese-English Dictionary on Shoes, excerpts of some professional English-Chinese and Chinese-English dictionaries edited in China since 1991 and search reports on “UGG” from the China National Library;
3. Notarized and legalized copy of the list of registration certificates for “UGG” in the world, registration certificates of trademark “UGG” in some countries and regions, the certificate of registration for UGG in Australia and the adjudication made by the IP authorities of Australia on the non-use action of the said mark;
4. The verdicts given by the United States District Court of California and the Netherlands District Court on the cases concerning cancellations against “UGG” as a generic name;
5. Materials on UGG-related business and promotion activities in China, extracts from the websites reporting the counterfeiting “UGG” products in China and the raids thereof by local AICs and Administrative Punishment Decisions issued by the PRC administrative enforcement authorities of at various levels on fake and forged commodities using the brand “UGG”;
6. Printouts from the China Trademark Office (“the CTO”) on-line database of the two applications for registration of “UGG” and “Super UGG” filed by the applicant of this dispute;
7. China Customs published by the General Administration of China Customs, Decisions made by the courts in mainland China and in Taiwan district concerning the sales and production of fake and forged commodities using the brand “UGG”, two reports excerpted from the website of Australian IP authorities concerning the brand “UGG”;
8. Printouts of the website of INTA and the documents about the assignment of the disputed mark.

Through adjudication, we find that, the disputed mark was registered by UGG Holdings, Inc. on October 14, 1996, designating on shoes, clothing, visors, etc. in Class 25, and then was assigned to the respondent by the approval of the CTO.

We hold that, “UGG” is a meaningless combination of letters, and no evidence shows that the industries of shoes, clothing, visors, jackets, T-shirts, etc. on which the disputed mark designates have used that combination as a product name or a model.

In this case, the expression of the disputed mark could function as a source-identifier of goods, and possesses the inherent distinctiveness as a trademark. And the registration of the disputed mark does not violate Article 11.1.1. With respect to the evidence submitted by the applicant, Evidence 1 is webpage material, which belongs to electronic evidence. In light of the mutability of electronic evidence, Evidence 1 shall not be taken into consideration without other supportive evidence. Evidence 2 is the registration and use of “UGG” trademark or trademarks that contain “UGG” in the country of Australia. As the protection of trademark right is territorial, such evidence shall not be taken to decide whether the disputed mark is distinctive or not in China. In view of the above, the use and registration of the disputed mark do not violate Article 11.1.1 and thus it shall be maintained. Besides, the registration of the disputed mark does not go against Article 41.1.

In accordance with Article 43, this Board hereby rules that:
The disputed mark shall be maintained.

Either party, in case of being unsatisfied with this decision, may bring a lawsuit to the Beijing First Intermediate Court (the Court) within 30 days upon receipt of the decision, and shall, at the same time of submitting the complaint to the Court or within 15 days after the submission, send a duplicate of the complaint to the TRAB or inform this Board separately in written form.

Member of the Collegial Panel: WU Dong
TANG Youlong
ZHANG Yongchao

Copy to: China Trademark Office under the State Administration of Industry and Commerce

Seal of Trademark Review and Adjudication Board
November 29, 2011