



# The Tale of Two Sofas

A Visual Deconstruction of Trademark Infringement & Fair Use

*Source: Intellectual Property and Commercial Court, 2022 Criminal IP Appeal Case No. 14 (Date: 2023)*

## The Plaintiff (Appellant)

ISOFA



Class 10  
(Massage Equipment)



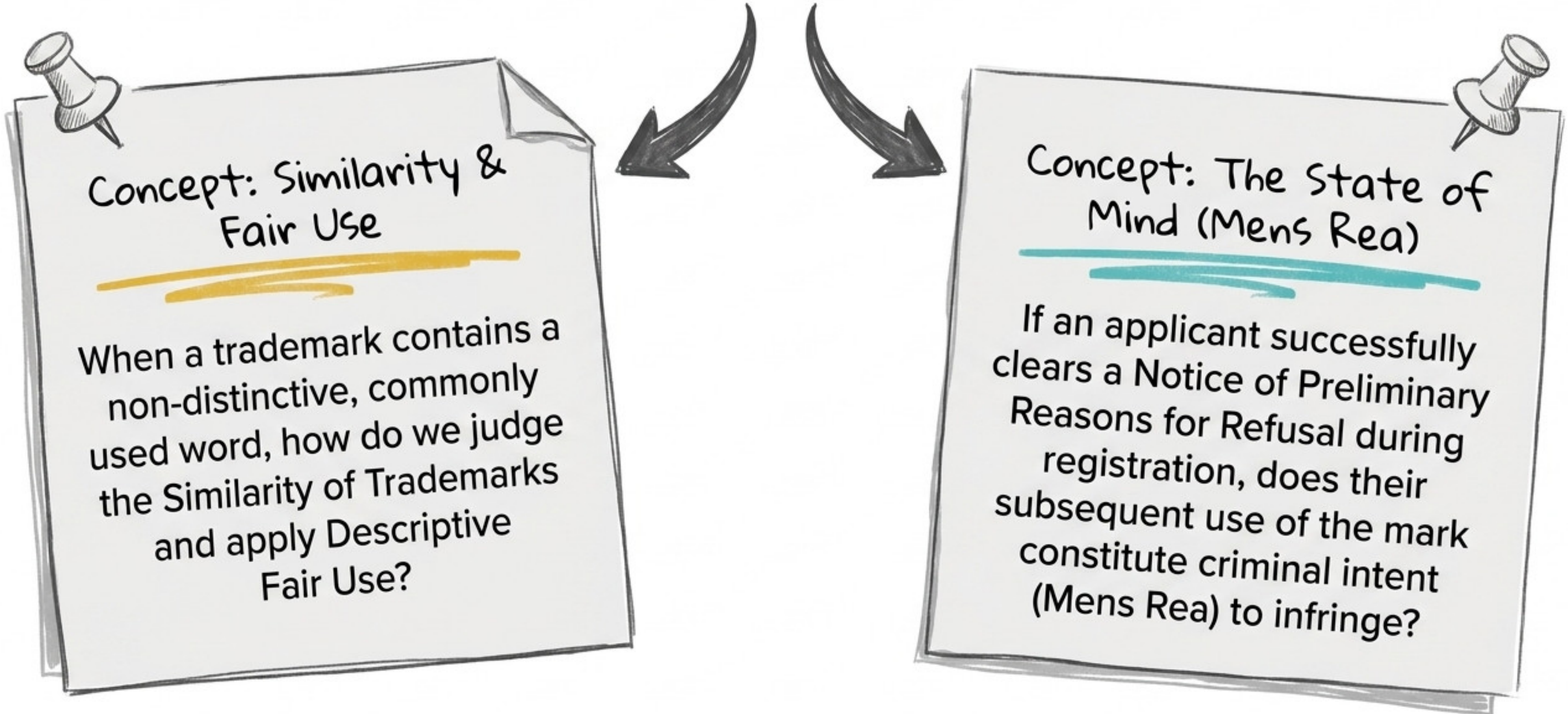
## The Defendant

HUEI YEH  
V sofa

**V**  
**SOFA**

Class 10  
(Massage Equipment)

# The Two Core Legal Disputes



## Concept: Similarity & Fair Use

When a trademark contains a non-distinctive, commonly used word, how do we judge the Similarity of Trademarks and apply Descriptive Fair Use?

## Concept: The State of Mind (Mens Rea)

If an applicant successfully clears a Notice of Preliminary Reasons for Refusal during registration, does their subsequent use of the mark constitute criminal intent (Mens Rea) to infringe?

# Dissecting the Shared Element

*Descriptive Fair Use (Article 36, Paragraph 1, Subparagraph 1 of the Trademark Act)*

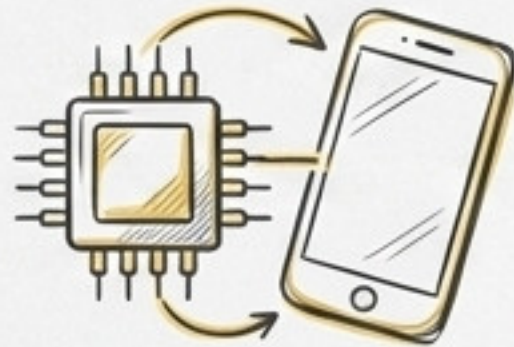


**Third parties can use the term to describe their goods without infringing on trademark rights.**

# Similarity of Trademarks: Holistic Observation

ISOFA  
iSofa

Visual Focus: Strong emphasis on the “I” or “i” and the side-profile massage chair logo.



Conceptual Impression: Evokes “Technology” and “Smart Sofa” imagery.

VSOFA  
HUEI YEH Vsofa

Visual Focus: Strong emphasis on the enlarged “V” and the master-brand characters.

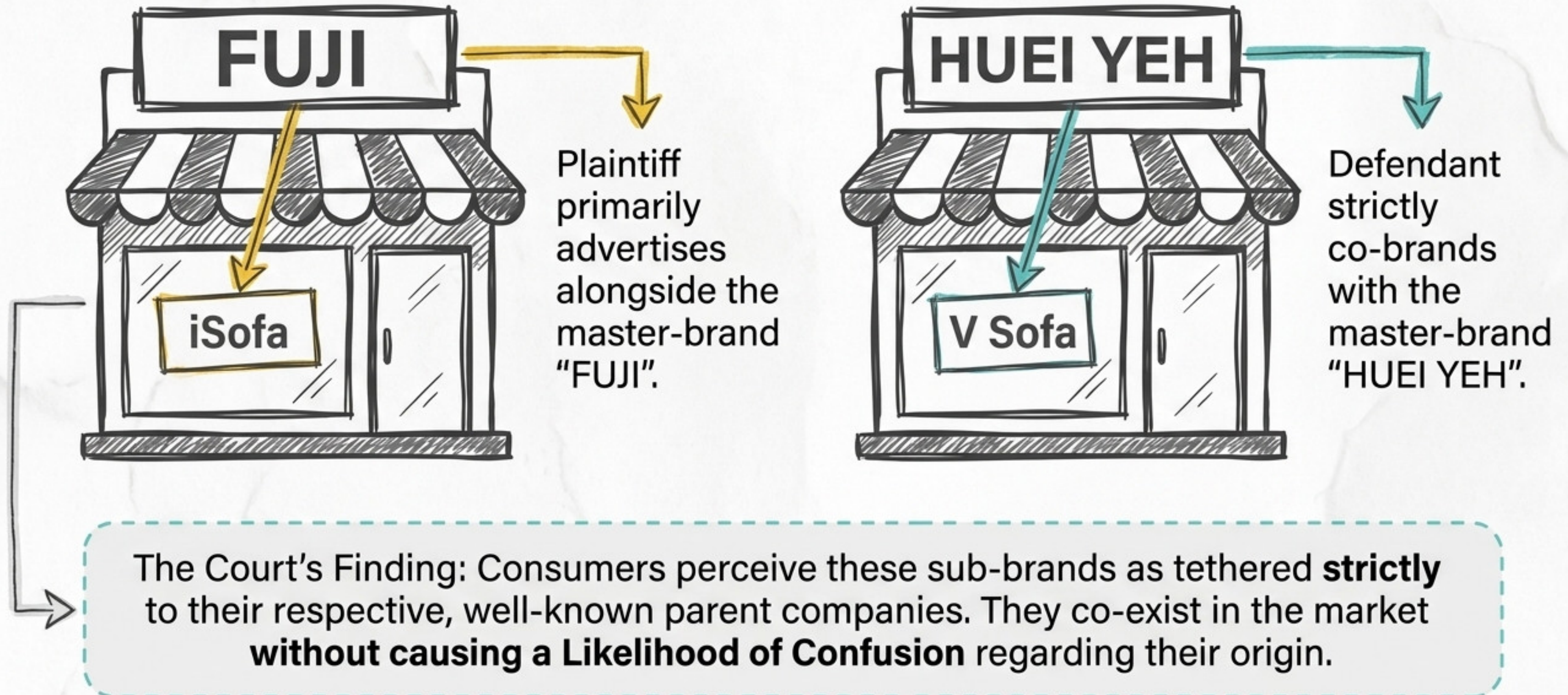


Conceptual Impression: Evokes “Victory” and “Vitality”.

**Distinct differences exist in appearance, phonetics, and concept.**

Distinct differences exist in appearance, phonetics, and concept. The marks are Not Similar.

# Context Matters: Likelihood of Confusion



# The Burden of Proof: Well-Known Trademark

## The Claim:

Plaintiff submitted internal sales data and ad spend to prove "ISOFA" 'ISOFA' is a Well-Known Trademark.

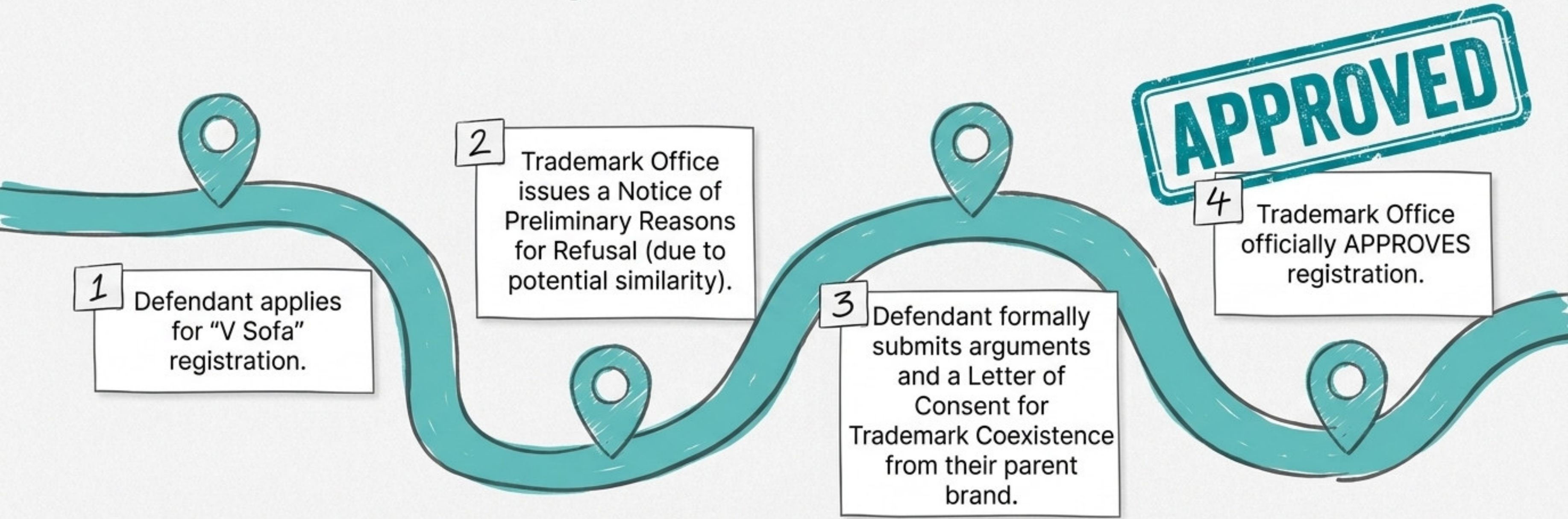


## The Reality Check

- Data Mismatch: The submitted data belonged to a completely different registered mark, not the marks in this specific dispute.
- Lack of Context: Internal sales figures do not prove actual market share or broad consumer recognition.

**Result: Insufficient evidence to establish the mark as a Well-Known Trademark.**

# Establishing Mens Rea (Criminal Intent)



The Court's Logic: Because the Defendant underwent a rigorous formal process and was granted legal registration, they subjectively believed their use was lawful. Therefore, there is an **absolute lack of** Mens Rea (Intent) to infringe. (Article 95, Paragraph 3 & Article 97 of the Trademark Act)

# THE FINAL VERDICT

**DECISION:  
APPEAL  
DISMISSED.**



**STATUS:  
NOT GUILTY OF  
TRADEMARK  
INFRINGEMENT**

- ✓ No similarity of trademarks
- ✓ No likelihood of confusion
- ✓ Proper execution of descriptive fair use
- ✓ Absolute lack of criminal intent

# Key Takeaways & Strategic Insights



**Descriptive terms are shields, not swords:** Common dictionary words (like 'SOFA') cannot easily be monopolized. Competitors can legally invoke Descriptive Fair Use.



**Holistic impression is king:** Trademarks are judged by their overall visual, phonetic, and conceptual impression. Sharing a single descriptive word does not equate to Similarity of Trademarks.



**Context prevents confusion:** Tying a sub-brand to a strong, distinct master-brand in actual market use drastically reduces the Likelihood of Confusion.



**The paper trail is a robust defense:** Surviving administrative pushback (like a Notice of Preliminary Reasons for Refusal) and gaining official approval completely negates the presence of criminal Mens Rea.