

The Anatomy of Trademark Use vs. Descriptive Fair Use

An Educational Breakdown of the 'BEETHOVEN' Trademark Infringement Ruling

Case Citation: Intellectual Property and Commercial Court, Criminal Judgment 111 Xing-Zhi-Shang-Yi-Zi No. 40 (2023).



BRAND MODEL

POINT OF LEGAL FRICTION
& CONSUMER CONFUSION

The Crux of the Dispute

When a competitor uses your registered trademark on their website, is it an illegal infringement, or just a legal descriptive term for their specific product model?

Governed by Applicable Law:

- Trademark Act Article 5
- Trademark Act Article 36(1)(1)
- Trademark Act Article 95(3)



The Protected Asset

Mark: BEETHOVEN

Registration No.: 01295290

Class 020 Goods:

- Tables, chairs, sofas, bookcases, wardrobes, beds, bed frames, headboards, and crucially—SPRING MATTRESSES



Context Section:

The Plaintiff holds exclusive rights to use this mark as a source identifier for bedding products in the regional market.

The Act of Infringement

Beginning October 1, 2019, the Defendant (a director at Panbor Furniture) listed a product online labeled exactly with the protected mark.



The Plaintiff discovered this unauthorized commercial use and initiated legal action, ultimately leading to a criminal indictment.

The Courtroom Clash



Defendant: Descriptive Fair Use

- Claims "Beethoven" is merely a model name.
- Argues their "Century Movement" series names mattresses after composers (Mozart, Chopin, etc.) to describe the product line theme, not to indicate the brand.



Plaintiff: Trademark Infringement

- Argues the usage goes completely beyond description.
- Acts as a primary brand identifier, causing a clear Likelihood of Confusion among average consumers regarding the origin of the goods.

Court Analysis I: Decoding Visual Prominence



1. English only, easily skipped by local consumers.
2. Dark, large, bold font. Deliberately engineered as the primary visual anchor.
3. Faded, significantly smaller font, minimizing visual impact.

Conclusion: The specific layout is deliberately engineered to leave a lasting visual impression of the protected mark, constituting undeniable Trademark Use rather than a simple descriptive label.

Court Analysis II: Inherent Distinctiveness



Descriptive



Highly Distinctive

Silk Latex Hard
Pocket Spring

*Directly describes
material and
physical quality.*

Beethoven

*A classical composer's name has absolutely
zero direct connection to the function,
quality, or characteristics of a mattress.*

Verdict on Distinctiveness: Because it lacks descriptive utility for mattresses, it possesses high distinctiveness as a source identifier. The 'Series Theme' defense is invalid.

Court Analysis III: Capturing Search Intent



Insight

By placing the protected mark at the very front of the product title, the Defendant foresaw digital consumer behavior.

Impact

They deliberately capitalized on the Plaintiff's established brand awareness to hijack search engine traffic, cementing the reality of market confusion.

Court Analysis IV: Establishing Criminal Intent (Mens Rea)

1

OEM Manufacturer: Defendant previously manufactured goods for the Plaintiff for 5-6 years, establishing pre-existing knowledge of the mark.

2

Cease & Desist: Plaintiff formally warns Defendant with direct legal notice.

3

Civil Loss: Defendant loses a separate Civil Lawsuit on August 18, 2022 (111 Min-Shang-Shang-Yi-Zi No. 2).

4

Delayed Takedown: Only after losing the civil trial were the infringing webpages finally removed.

Key Takeaway: The delayed takedown and prior commercial relationship prove direct criminal intent to infringe, elevating this action beyond a simple descriptive mistake.

The Final Judgment



The Verdict: The original lower court judgment is entirely revoked.

The Ruling: The Defendant is found guilty of Criminal Trademark Infringement under Article 95(3) of the Trademark Act.

The Sentence: 50 days of criminal detention (commutable to a fine).

Executive Summary & Strategic Takeaways



Placement Dictates Purpose: Enlarged, bolded text placed prominently will be interpreted by courts as "Trademark Use," overriding any claims of descriptive naming.



Distinctiveness Overrides Theme: Naming a product series after a broad theme (like 'Composers') grants absolutely no legal immunity if the specific name is a registered mark.



Digital Footprints Count: Utilizing a competitor's trademark as a leading keyword to capture search traffic is strong evidence of deliberately inducing consumer confusion.



Act on Notice: Ignoring Cease & Desist letters and forcing a civil judgment before removing content solidifies *Mens Rea* for subsequent criminal prosecution.