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PARIS - DAKAR invalidates copycat mark “MARKMA DAKARA/T”

Time: Nov 26 2024

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YANG Mingming & Nie Xiaoyan, 27 November 2024, first published by [Lexology](#)

The Dakar Rally, often referred to simply as “The Dakar,” stands as one of the most gruelling and legendary events in motorsport history. Held annually, the Dakar Rally is known for its extreme challenges and the rugged endurance required of both vehicles and competitors. The Dakar Rally was conceived by French motorcycle racer Thierry Sabine. The inaugural rally, known as the Paris-Dakar Rally, took place in 1978, starting in Paris, France, and ending in Dakar, Senegal.

On June 4, 2020, a Chinese company Guangzhou HAO ZAI LAI Tyre Co., Ltd. applied for the mark “

MarkMa DAKARA/T” in Class 12, designating “motorized vehicle for terrestrial, aerial, subaqueous or railway use, tyres for motorized vehicle”, among others.

PARIS - DAKAR filed for opposition against the said mark citing its prior registration  in the same class, only partially obstructed its registration. On January 21, 2022, the CNIPA decided to approve its registration on “aerial conveyors, tyre for delivery vehicle, auto tyre, repair outfits for inner tubes”, which the CNIPA deemed to be not conflicting with the opponent’s prior mark in class 12. The mark later proceeded to registration on the aforesaid goods, with the date of registration calculated retrospectively on February 7, 2021.

On November 4, 2022, PARIS - DAKAR filed an invalidation against the said mark, citing the client’s prior mark registered on class 41 designating services like “organiser of sports events”, among others.

On October 17, 2023, the invalidation request was upheld by the CNIPA for violating provisions of Articles 30 and 44 of the Trademark Law.

The CNIPA found that Articles 30 is applicable based on the below reasoning:

1. Evidence suffices to prove that the cited mark, which is highly original, had acquired certain reputation on “sporting events” prior to the application date of the disputed mark.
2. The disputed mark, which incorporates the main distinguishing word element “DAKAR” of the cited mark, is similar to the latter.
3. The designated goods (auto tyre) of the disputed mark in class 12 are closely associated with the services (sports and events) covered by the cited mark in class 41 in terms of service origin, usage scenario and target consumers.
4. As a player in auto tyre industry, the registrant of the disputed mark should have been aware of the cited mark, yet it registered the disputed mark and promoted tyre products for Dakar rally on various occasions, which attests its blatant bad faith.
5. The co-existence of the marks is likely to mislead the relevant public into believing that the goods and services originate from the same source or there is certain association between their sources, thus creating confusion and misidentification.

The CNIPA also affirmed that the registrant of the disputed mark copied and plagiarised the client’s famous marks, which breaches the good faith principle and disrupts the trademark registration, use and administration order, thus falls under the scenario of “acquiring trademark registration by other unfair means” as prescribed in Article 44.

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The CNIPA therefore ruled to invalidate the registration of the disputed mark on all the remaining goods.

This is great news for the client as the CNIPA, for the first time, affirmed that goods in class 12 are similar to the client's services in class 41. The holistic approach the CNIPA employed in finding trademark similarity in this case also aligns with the methodology elucidated by the Beijing High Court in the Guidelines for the Trial of Trademark Right Granting and Verification Cases.