

# 48

## Eastman Kodak Corporation v. Suzhou Keda Hydraulic Elevators Co., Ltd.

*Citation: The Jiangsu Province Suzhou City Intermediate People's Court's Civil Judgement*

*No. Suzhongminsanchuzi 0213/2005*

*Date of judgment: April 6, 2006*

### **Procedural history**

The Eastman Kodak Corporation (Kodak) sued, in the Jiangsu Province Suzhou City Intermediate People's Court, the Suzhou Keda Hydraulic Elevators Co., Ltd. (Keda) for infringement of its trademark right.

### **Issue**

Judicial establishment of a well-known mark

### **Facts**

Kodak was the proprietor of the Chinese trademark "KODAK" in classes 1 and 9 (mainly in chemical and optical products and services); the "KODAK" mark was registered in goods of class 1 in China in as early as 1982, and before the suit was instituted, the "KODAK" mark was not established as a well-known mark by the administration for industry and commerce in China. Kodak found that the "KODAK" representation was used on the elevators the Keda made and marketed, and used "KODAK" representation on its corporate publicity materials and obtained the registration of the related domain name. Although the products and services in respect of which Keda used the "KODAK" representation were different from those in which Kodak used its registered mark, Kodak held that "KODAK" mark had very high repute and good market goodwill in China and around the world, and should be eligible to be protected as a well-known mark in different classes of goods under the trademark law. To prove its assertion, Kodak furnished considerable

evidence, including proofs of the registration of the “KODAK” mark in China and in other countries, advertisement and promotion reports in the press, and the proprietor’s own profile.

Keda argued that the products Keda and Kodak dealt in were neither identical, nor similar in class. To determine Keda’s infringement, it was required that the “KODAK” mark be established as a well-known mark, eligible for protection in different classes of goods and services. Besides, even if “KODAK” mark could be established as such, Keda’s “KODAK” representation was the English version of its corporate Chinese trade name “科达” (pronouncing “ke da”), which was not used as a mark of the product, and did not infringe Kodak’s “KODAK” trademark.

### **Rule of law**

Article 14 of the Trademark Law *In determining whether a mark is well-known or not, the following factors shall be considered:*

- (1) the knowledge of the relevant sector of the public about the mark in suit;*
- (2) the duration of time when the mark has been in use;*
- (3) the duration of time, degree and geographical range of any publicity of the mark;*
- (4) any records of the mark being protected as a well-known mark;*
- (5) any other factors which make the mark well-known.*

### **Reasoning**

The considerable evidence from Kodak showed that the “KODAK” mark, its coined lexical trade representation, had been globally registered, and virtually a trade brand known to almost every household in and outside of China through constant advertisement, on a large scale, of the “KODAK” mark and for the high quality of the goods bearing said mark. Kodak’s registered “KODAK” mark was one of relatively high repute in the market and well known to the relative sector of the public, and should be established as a well-known mark and protected as such in the present case. Keda’s use of “KODAK” representation was obviously acts of imitating the mark in suit and taking advantage of the good repute and image of Kodak’s well-known “KODAK” mark to seek illicit benefits. These acts should be determined as infringement and prohibited under the law. Keda’s argument that its “KODAK” representation was the English version of its enterprise name was not compatible with the translation and pronunciation practice in China. Accordingly, its de

fense of fair use of the trademark was not acceptable.

***Holding***

The trademark that is of relatively high repute in the market and known to the relevant sector of the public should be established as a well-known mark, and be judicially accorded high-level, cross-class protection under the law.