

How Int'l Filing Strategy Led To Ivanka Trump's Coffin TMs

By **Jane Shay Wald** (May 4, 2020)

The Twittersphere has again ignited with news of Ivanka Trump's Chinese trademark registrations. Last time it was voting machines. This time, tweeting fingers point to Chinese registrations for Ivanka Trump coffins and what that could mean during the global pandemic.

Yes, Ivanka Trump Marks LLC owns the mark "Ivanka Trump" in China, Reg. No. 23308695, for coffins. The cradle-to-grave registration also includes bumper guards for cribs and baby pillows. The application was filed March 28, 2017, and registration issued May 7, 2018. It's a family affair; Donald Trump, individually, has Chinese registrations for coffins — and identity bracelets for hospitals.



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Is there a benign trademark practice here that would bore a conspiracy theorist? Actually, there is. While we don't know what motivated the Trumps or any specific entity to identify any particular goods or services in their foreign trademark applications, we can examine the legal considerations that underlie such filings generally and draw some conclusions. In other words, we can make an informed guess.

In a **previous article**, I explained why Ivanka Trump and many famous designers had trademark registrations in China for voting machines. As detailed there, Chanel SA even has a Chinese registration for an atomic ray instrument and a control system for nuclear atom power station in addition to the more mundane voting machines and sunglasses.

So why do Ivanka's company, and Trump individually, have such ominous goods claimed in their Chinese registrations? And why might less controversial entities — Walmart Apollo LLC, Amazon Technologies Inc., even Tiffany & Co. — also hold registrations for coffins in China? Along the same lines, what do the Discovery Channel and Michael Kors (Switzerland) International GmbH have in common? They each have a Chinese registration for body bags. Body bags for enclosing cadavers. The underlying theory is the same as for the coffins. And the voting machines.

Let's review why an American entity may have trademark registrations in China or other countries for goods that have nothing to do with any commercial activities ongoing or intended. Goods they would not be entitled to cover in a U.S. trademark registration.

China, like most other countries, doesn't require any use to obtain a trademark registration. Nor does it require an intent to use the mark for any goods or services claimed in an application. In contrast, an American company cannot obtain a U.S. trademark registration unless it already owns a trademark. The U.S. trademark registration is evidence of that preexisting trademark and gives the owner important advantages.

But the U.S. registration does not create the trademark. Although the U.S. Patent and Trademark Office issues patents and trademark registrations, the two intellectual properties — patents and trademarks — are very different. Without an issued patent, an invention is not protected by patent. Without an issued trademark registration, a mark exists and can be protected under common law in the federal or state courts with essentially the same remedies as marks that are federally registered.

We hear people say "that's trademarked," to refer to a mark in the U.S. What they probably mean is "that trademark that already exists by its use in commerce is federally registered." In China, the concept of trademark rights arising from use does not exist. Chinese trademark rights come only from registration. In foreign countries, the registration does confer the trademark (or service mark); trademark and trademark registration are conceptually the same elsewhere.

The U.S. is the outlier in requiring use prior to registration. While Americans can apply to register with the USPTO based on a bona fide intent to use the mark in commerce with the identified goods, the USPTO will not register that mark unless and until the applicant submits evidence and a declaration proving use within the time allowed.

Why would anyone spend money to obtain a trademark (registration) covering commercially irrelevant goods or services? A quick dive into the international classification system helps answer that question.

Most countries, the U.S. included, require an applicant to identify the international classification associated with each of the goods and services claimed in the application. These categories were established by the Nice Agreement of 1957 and are updated every five years to scoop in new products and services that have become commonplace.

There are 34 classes of goods and 11 classes of services. Goods within some of the classes bear an intuitive relationship to each other. Class 25, for example, includes all items of clothing, as well as shoes and hats.

As discussed in my previous article, Class 9 is less intuitive. It includes popularly licensed consumer goods such as sunglasses and cell phone cases and videogames — as well as voting machines. The concept of Class 9 is scientific and technical goods, but optical goods were placed in International Class 9 as well.

Class 20, which protects furniture and cushions, pet enclosures and certain household accessories has scooped in hospital ID bracelets and coffins.

International Class 22 covers fishing nets, camouflage covers, tarpaulins, tents and packing string, among other goods. Body bags are among these.

Laura Wen-yu Young, a law professor at Soochow University and managing partner of Wang and Wang LLP, agrees that there is no contemporary commercial reason for body bags to be grouped in the Nice international classification system with e.g., fishing nets, but this mashup goes back to original principles under which these classifications derived.

Sometimes goods were classified by materials, sometimes by function, and other times we can but point anecdotally to abstract concepts. For example, Young says Class 22 "basically covers containers made of soft materials, which is why ropes, tarps, tents ... and body bags end up together, gruesome as that is."

Because of our use principles, an American applicant in the USPTO cannot claim any goods or services in a given class unless there is to be actual trademark use of that mark for each and every product and service identified. Use that must be proven before the application will mature into a registration. In many foreign countries it is not unusual to claim far more goods in a class than are of commercial interest to the registrant. The idea is to protect the mark by bracketing one's goods with other goods in the class to exclude subsequent registration to applicants for the same or a similar mark for any goods and services in that

class.

In China in particular, which adheres not only to the Nice international classification system but has detailed subclasses within it, it is customary to claim very broadly. The basic filing fee allows a designation of up to ten goods descriptions, so the best use of the filing fee is often to cover 10 subclasses. It is no longer possible to occupy an entire class in China, but it is often possible to occupy a subclass.

U.S. companies and outside counsel work with foreign trademark practitioners the world over to search, file and protect our American clients' foreign trademarks. Chinese counsel sometimes advise applying to register more of what is in a category or at least within a Chinese subclass, to put a fence around what might be the product of actual or potential commercial interest. But it's not always the Chinese counsel's advice that results in such strange pairings.

Young, who has represented a great number of U.S. companies and law firms in obtaining and protecting Chinese trademarks over the course of her practice, finds it unlikely that the individual applicants themselves have approved of a specific list of goods or services, including coffins, hospital ID bracelets, body bags or funeral services. In her experience, the applicant may not even know what other goods or services they have claimed in addition to their core business products.

Besides the bracketing concept, there is another likely reason, opines Young. In this setting, the client is advised — often by the U.S. counsel — that its core goods fit into a classification and, in China, a subclassification, which contains a considerable number of other goods. The U.S. attorney may ask the client whether it wishes to broaden the application to the maximum scope within the basic filing fee. If so, the additional goods are then added to the application. Young points out that some subclasses even have sub-subclasses, which could initiate a desire for even broader filing, "and it's going to get worse in the future."

These coffin and hospital ID wrist band registrations are in International Class 20, a class that also includes a wide array of innocuous home goods in addition to coffins. Class 20 includes bedding, pillows, furniture, mirrors, bassinets, toyboxes, pet beds and habitats, storage bin organizers and identification plates. In a country where it is considered important to claim many goods in an international class to bracket the goods of interest, we see others doing the same.

The Class 20 goods that are likely of core interest are probably not the more intriguing ones in the registration. In this case, the "Ivanka Trump" registration also covers more quotidian goods, including pet kennels, artworks, picture frames, furniture, curtain rods and towel stands.

Similarly Trump, personally, has registrations in China for not only coffins but identity bracelets for hospitals. Chinese Reg. No. 10489493 covers "Trump" and design for these goods. His Reg. No. 10489494 (covering the "Trump Home" mark and a design mark) similarly protects coffins, identity bracelets for hospitals and, more innocuously, mirrors, artwork, bed accessories and mattresses

Let's take a look at what others are registering in China along the same lines. When we speak of Costco Wholesale Corp. and Walmart as big box stores, we may not have been thinking so literally. But they indeed have Chinese trademark registrations for coffins, as do many others.

Underscoring that what is registered may not be headed to the marketplace, we see Walmart Apollo LLC has its "Play Day" and design registered, Reg. No. 15403257 for identification bracelets for hospitals and coffins. Not the most commercially appealing brand for these goods, although its "Play Day" mark extends to pet habitats, which makes more sense.

Walmart also has its "Daily Chef" mark registered Reg. No. 11693741, for caskets and identification bracelets for hospitals, very odd choices indeed for this trademark, but the registration also includes photo frames and storage accessories, among others. Its "Simply Right" mark is registered, Reg. No. 11693748, for a variety of home goods, including photo-frames and ladders, but also identification bracelets for hospitals, pillows and caskets. Its "Walmart" mark is registered, Reg. No. 38232716, for an array of Class 22 goods, including body bags, and has a pending additional application claiming a design, App. No. 39621505 for the same goods, including body bags.

Costco Wholesale Corp. holds a Chinese registration for the "Kirkland Signature" and design for coffins, as well as for furniture, statuettes, pet kennels and mirrors. Costco's registration 9775700 also claims coffins, identification bracelets for hospitals and pet beds, among other goods. Price Costco International Inc. holds a Chinese trademark registration 38643534 for "Costco" and design for pet beds, pillows, identification bracelets for hospitals and coffins.

Amazon owns Chinese Reg. No. 35012255 covering coffins, as well as household goods like workbenches, door fittings, furniture and cushions. Amazon's Reg. No. 35012253 claims ropes, packing materials, sails, vehicle covers, tarpaulins, tents, raw textiles — and body bags. Amazon's Chinese "Kindle" registration, Reg. No. 20321670, claims standing desks, library shelves and coffins.

Even the Discovery Channel has filed broadly to claim coffins. Its Chinese Reg. No. 12807553 claims photo frames, camping sleeping bags and coffins, among other goods.

Jaguar Land Rover Ltd. of the U.K. owns the Chinese registration 28376445 for its Evoque mark, covering nesting boxes for household pets, picture frames, "coffin fittings not of metal," and lacquer craftwork. Its Chinese Reg. No. 11545593 for F-Type claims the expected key rings, license plates for land motor vehicles, ornaments for land motor vehicles as well as identification bracelets for hospitals and coffins. The company's Chinese registration for "Jaguar" and design, Reg. No. 12159597, includes nonmetallic license plates, domestic pet litter, identification bracelets for hospitals and the ubiquitous coffins.

Levi Strauss & Co. owns a design mark Chinese registration, Reg. No. 31296009 for pet cushions, toyboxes, coat hooks, pillows and caskets.

Macy's West Stores Inc. owns a Chinese registration for "Macy's Backstage," Reg. No. 20854816, for a wide array of goods, including coffins, as does Tiffany & Co., whose Chinese registration, Reg. No. 14034735, protects the "Tiffany" mark for coffins.

Michael Kors has registered "Michael Kors," Reg. No. 27263044 for bags for washing hosiery, textile envelopes for packaging, camouflage coverings and body bags.

While the perceived need to claim broadly in China is apparent, we also see EU trademark registrations claiming broadly. The EU registration covers all the countries in the EU. No use is required to register, but as in most places, nonuse for five years provides others with a basis to move to expunge such registrations, and indeed one of the Trump companies'

marks was recently expunged in the EU in several classes for nonuse, including for hotel conference facilities. EU trademarks are relatively inexpensive and are not examined with respect to prior conflicting registrations, so many companies see an advantage to claiming very broadly under the EU system as well.

For example, Walmart Apollo LLC has its "Wal-Mart" mark registered as an EU trademark, Reg. No. 001997600, for flower-pot pedestals, foundations for beehives, furniture and funerary urns.

Walmart has also registered "Sam's Club" as an EU trademark for foundations for beehives and funerary urns. That registration, Reg. No. 006142715, extends into International Class 45, a category that includes legal services, and a broad array of personal and social services. It claims horoscope casting, dating services, marriage agencies, detective agencies, crematorium services and funerals. (Combined, those services form the plot of a great number of episodes of various television series.)

There is no way to tell from foreign trademark office databases whether a registered mark is actually in use. The USPTO in contrast, gives us a clue. The USPTO requires applicants to set forth, under oath, the dates of first use of their marks in each claimed International Class, and to provide specimens with declarations attesting to actual use in commerce. Between the fifth and sixth year after U.S. registration, and again at the 10-year point, the USPTO requires sworn evidence of use to avoid automatic cancellation of the registration.

Other countries do not have this requirement, as they do not require use at all. We are not aware of any use by the Trumps or the other registrants of branded sales of hospital identification bracelets or coffins in China or the EU. We do know that none of these entities with foreign trademark rights in hospital identification bracelets, coffins or funeral services has any U.S. application pending or registration issued for these goods or services, where the focus is on use.

It is probably reasonable to assume for the moment that these registrants are not using or licensing their registered trademark brands for the controversial goods called out on Twitter. Some registration literally protect marks for some very strange bedfellows — mattresses, pillows and coffins. Similarly, there is no commercial logic for automakers to protect their names for key rings and coffins. In such registrations the goal is typically to protect the core goods — the home goods or the automotive accessories. The coffin goes along for the ride.

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