



CCPIT PATENT & TRADEMARK
LAW OFFICE

65 Apr. 2025

Newsletter

I N T E L L E C T U A L P R O P E R T Y



CCPIT PATENT & TRADEMARK
LAW OFFICE

RECEPTION INVITATION

INTA 2025, San Diego



May 19 Monday
6:00 pm – 10:00 pm



Sapphire Ballroom ABEF, Level 4,
Hilton San Diego Bayfront,
1 Park Blvd, San Diego, CA 92101



We cordially invite you to join us for a cocktail
reception featuring live Chinese folk music.

JOIN THE PARTY NOW!



CCPIT PATENT & TRADEMARK
LAW OFFICE

MEETING INVITATION

INTA 2025, San Diego

Please be kindly advised that the following eighteen attorneys from our firm will be attending the INTA Annual Conference in San Diego from May 17 to 21, 2025.



Mr. Chuanhong Long



Mr. Jianzhong Kang



Mr. Bo Li



Ms. Ling Zhao



Mr. Aiguo Liu



Ms. Hui Gao



Ms. Hongxia Wu



Ms. Yanyan Zhao



Ms. Fuping Wang



Ms. Xiaoping Wei



Ms. Shufang Zhang



Ms. Chuan Wang



Ms. Jing Qiu



Ms. Lei Fu



Ms. Hong Qu



Ms. Bimei Zhang



Ms. Qingyun Ruan



Mr. Pu Feng

We would like to invite you and your colleagues for a meeting during the event to discuss our collaboration and exchange insights on the latest developments in intellectual property law and practice.

If it is convenient for you, we would like to have a meeting in our hospitality suite.

Room Cobalt 500, Level 5
Hilton San Diego Bayfront
1 Park Blvd, San Diego, CA 92101

18th

MAY

from 8:00am
to 6:00pm

19th

MAY

from 8:00am
to 6:00pm

20th

MAY

from 8:00am
to 6:00pm

21th

MAY

from 8:00am
to 1:00pm

Please let us know your availability for a meeting. If you have a more convenient venue and time other than the above, please do not hesitate to let us know.

Please kindly send an email to inta2025@ccpit-patent.com.cn to set up a meeting.



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Our firm has been ranked Band 1 in nonlitigation of intellectual property in Chambers Greater China Region Legal Guide 2025

Recently, Chambers and Partners, a globally renowned legal rating agency, officially released the “Chambers Greater China Region Legal Guide 2025”. CCPIT Patent and Trademark Law Office was ranked as a Band 1 firm in non-litigation of intellectual property in the Greater China region. Relying on highly professional services, our firm has been honored as a Band 1 firm in the non-litigation field of intellectual property in China for many consecutive years, which fully demonstrates the excellent professional level of the firm.



According to Chambers, “CCPIT Patent and Trademark Law Office houses a team with a strong track record in handling patent and trade mark registration and protection matters. The team is especially noted for its strength in prosecution work. It also offers expertise in relation to IP disputes and is especially active in patent and trade mark infringement

cases.” During the research, many clients spoke highly of the professional services of the firm: “I consider CCPIT to be one of the strongest law firms around and a household name in trade mark prosecution.” “CCPIT has outstanding expertise in PRC IP law, an excellent track record in trade mark cases, stellar legal professionals, strong service and seamless communication.” Chuanhong Long, President of the firm, who is a long-standing patent attorney and lawyer with more than 25 years of rich experience in the patent field, is recognized as Eminent Practitioners by Chambers.

Our firm has again been recognized by WTR 1000 as “Gold Band” for trademark prosecution and strategy in China



China and SARs: China: Domestic

World Trademark Review (WTR) released this year's WTR 1000: the World's Leading Trademark Professionals, which identifies the top trademark professionals in key jurisdictions around the globe. CCPIT Patent and Trademark Law Office is recommended and ranked in the “Gold Band” for trademark prosecution and strategy in China. The firm also takes the

rank of the “Bronze Band” for trademark enforcement and litigation in China. According to WTR, “CCPIT stands as China's premier trademark law firm, distinguished by its extensive history in trademark representation and a roster of seasoned professionals – a reputation that has earned the trust of countless clients.” “Renowned for its highly qualified team and exceptional service, CCPIT is a trusted

partner for a full spectrum of trademark services, including application, oppositions, cancellations, and strategic planning.” One of the clients affirms, “CCPIT has the most experienced professional in the field – that's precisely why we selected them.” Ling Zhao, Bo Li, Aimin Huo and Yuncheng Li are ranked as recommended individuals.

Legal 500 Asia Pacific 2024: CCPIT ranked in Tier 1 again



On November 20th, Legal 500 released its annual survey results of Legal 500 Asia Pacific Great China 2025 ranking. CCPIT Patent and Trademark Law Office has been ranked in Tier 1 again in China in the intellectual property area, both in contentious and non-contentious. According to Legal 500, CCPIT Patent and Trademark Law Office is renowned for its strong expertise across both contentious and non-contentious IP issues. The firm boasts one of the largest IP specialist teams in China, with over 300 patent and trademark attorneys, offering capabilities encompassing prosecution, mediation, administrative enforcement

and litigation. Headquartered in Beijing, the firm has bases all over China and internationally. Mr. Chuanhong Long, President of the firm, is inducted into the Hall of Fame. Mr. Bo Li, Director of the Domestic Trademark Department, is named as one of the leading associates. Legal 500 also highly recommended other members of the firm, “Shuhui Huang is sought after for patent matters from patent prosecution to invalidation, infringement and re-examination. Fan Li focuses on advising chemical companies on patent prosecution, while Ji Liu specialises in patent litigation and invalidation. For trademark prosecution, validity and infringement litigation, Ling Zhao is the go-to.”

Honored as the outstanding IP law firm 2024 by Asialaw Profiles



According to the Guide to the Asia-Pacific's Leading Regional and Domestic Law Firms revealed by Asialaw Profiles, our firm is recognized as the Outstanding IP law firm 2024 in China in the area of intellectual property. Asialaw Profiles provides law firm recommendations and editorial analysis of key practice areas and industry sectors across 20 jurisdictions. The

rankings are based on three key criteria, namely, work evidence, client feedback and peer feedback and are divided into 4 categories: Outstanding, Highly recommended, Recommended and Notable. Being ranked as the Outstanding IP Law Firm reveals our firm's competence and professionalism in the area of intellectual property.

How to judge trademark infringement related to OEM

By Ling Zhao

In a recent decision rendered by the Shanghai Intellectual Property Court on a trademark infringement lawsuit (Fuzhou Yama Electromechanical Co., Ltd. v. Chongqing Shenchu Import and Export Trading Co., Ltd., 2023), the accused infringer, the OEM producer, is found not guilty of infringement of the Chinese trademark “PREDATOR”.

You might still recall the

HONDAKIT verdict made by the Supreme People’s Court of PRC (Honda Motor Co Ltd v. Chongqing Hengsheng Group Company & Hengsheng Xintai Trading Co Ltd, 2019), wherein trademark infringement is found, and the court decided that the use of the alleged trademark constitutes use in the sense of trademark law, and there is the likelihood of confusion.

The different outcomes result from different case facts and analysis

of the specific transaction forms in the two cases. The courts hold consistent opinions on the essential elements to judge infringement arising from this special trade mode, OEM, namely original equipment manufacture, including the issues of trademark use on OEM products, likelihood of confusion, possible damage to the Chinese trademark right holder, etc. The courts made different conclusions on said elements in the two cases as below:

	PREDATOR case	HONDAKIT case
Trademark use	Yes	Yes
Likelihood of confusion	No	Yes
Possible damage to the Chinese trademark right holder	No	Yes
Infringement	No	Yes

Trademark use in OEM

There have been constant debates on the issue if the use of a trademark on OEM products exclusively for export purpose counts for trademark use in the sense of trademark law. In defense of non-use cancellation, both the CNIPA and the Court would confirm that the use of trademark for OEM exclusively for export is sufficient to maintain the registration, provided with sufficient evidence to show that the goods are manufactured within the territory of China and exported to other countries. It is also confirmed true by the Supreme People’s Court in the

HONDAKIT verdict.

In the HONDAKIT case, the Supreme People’s Court holds that if a trademark is used in the production, manufacturing or processing of products through labeling or other means, which has fulfilled the function of identifying the source of the goods, such use could be acknowledged as trademark use in the sense of trademark law. It is noted that the relevant public can have access to the trademark in question, as said relevant public does not only include the end consumers, but also people involved in the production and/or the transportation of the goods. Thus,

the trademark labeled on the OEM products has fulfilled the function of identifying the source of the goods, and such use should be regarded as trademark use in the sense of trademark law.

In the PREDATOR case, the local courts of both instances hold the same opinion, finding that OEM production exclusively for export should be considered as trademark use in the sense of trademark law.

Infringement

In the PREDATOR case, the Court noted that the disputed product is a sample product sent to a laboratory in the United States, not intended for the Chinese market. Considering the nature of the product, the Court believe that there is the minimal likelihood of the OEM goods re-entering the Chinese market. The plaintiff’s registered trademark’s recognition and differentiation



function in the domestic market would not likely be affected. It is further commented in the verdict that even though the alleged infringing trademark is the same as the mark claimed for protection, and the goods are also identical, we would still need to take the special circumstances into consideration, and judge about the likelihood of confusion. It is concluded that the OEM production in this case cause no consumer confusion, and hence it does not constitute trademark infringement.

However, in the HONDAKIT case, the Court noted that the OEM

goods may return to the Chinese market, and more and more Chinese people are traveling abroad, who may have access to the OEM goods, and hence there is likelihood of confusion and there is possible damage to the legal right and interests of the trademark owner. Therefore, trademark infringement is found in this case.

The Supreme People's Court comment in the HONDAKIT verdict that OEM is an important trade mode. People's understanding and dispute resolution of trademark infringement issues arising from OEM are constantly changing and evolving. There is no exemption

of infringement for trademark use in OEM. In each case, the judgement of infringement should be based upon analysis of the specific period, specific market, and specific transaction form. It is also noted that for trademarks that have not been registered in China, even if registered abroad, they do not enjoy the exclusive right in China. Correspondingly, the so-called "trademark use authorization" of a foreign trademark right is not protected by the trademark law and cannot be used as a defense against infringement claim.

How to effectively combat malicious trademark applications in China

By Hongxia Wu

Malicious applications to register trademarks have long been a significant issue for trademark rights holders in China. Unlike in some countries where trademark

rights are based on use, in China, these rights are primarily derived from registration. This makes the problem of malicious applications for trademark registration more challenging. This article explores three strategies to address

malicious trademark applications in China, covering conventional practice, less commonly used approaches and emerging judicial methods that have proven effective for right holders.

I. Opposition and Invalidation

To combat trademark squatting, the conventional practice is for the prior right holder to initiate opposition or invalidation proceedings to prevent the squatted trademark from being registered or to declare the registration invalid. Given that China's trademark rights are primarily acquired through registration, the prior right holder has to bear a heavier burden of proof in the trademark opposition or invalidation proceedings, which incurs significant time and financial costs. Moreover, the infringer can repeatedly apply for the same or similar trademark as the right holder's trademark with minimal economic investment, necessitating the prior right holder to initiate new trademark opposition or invalidation proceedings to combat this behavior. This trademark squatting trend has caused heavier burdens to the prior right holder and has



led to a substantial depletion of trademark examination and judicial resources.

II. Administrative Penalties

According to Chinese laws and regulations, in the event of a malicious trademark registration application, the Market Supervision Administration at or above the county level where the applicant is located or where the offense occurs may impose

administrative penalties, such as a warning and a fine of up to RMB 30,000 yuan, depending on the circumstances. In practice, the imposition of administrative penalties on malicious trademark applications is relatively rare, typically targeting cases where such registrations significantly harm the public interest, such as appropriating the names of Olympic athletes.

III. Civil Litigation

Our firm has achieved a success in a civil litigation case against malicious trademark applications before the Tianjin High Court by utilizing anti-unfair competition laws. This case was recognized by the Supreme Court in China on April 22, 2024 as one of China's 50 typical IP cases in 2023.

In this case, the plaintiff and its affiliates had applied for the registration of 32 trademarks identical or similar to the plaintiff's trademark, which enjoys a high reputation and strong distinctiveness, in multiple classes since 2018. This excessive registration exceeded normal production and business needs. Apart from appropriating the trademarks, the defendant also imitated the plaintiff's business name and domain name, engaged in misleading advertising, and extensively imitated the plaintiff's operations. The Court of Second Instance changed the judgment of the first instance to hold that the defendant's malicious

trademark applications, as part of a comprehensive infringement, violated the principles of honesty and credit, disrupted normal trademark registration processes, disturbed fair market competition, and harmed the lawful rights and interests of the plaintiff, constituting unfair competition act as per Article 2 of the Anti-Unfair Competition Law in China. Considering relevant factors including the plaintiff's costs of defending its rights over the years to stop the defendant's malicious trademark applications, the Court decided to award the plaintiff a full compensation of RMB 500,000 yuan for the economic damages and reasonable expense.

On a related note, another case selected as one of China's top 10 IP cases in 2023 by the Supreme Court in China on April 22, 2024 also pertains to regulating the malicious trademark applications through anti-unfair competition law. This case was adjudicated

by the Wenzhou Intermediate Court in Zhejiang province. In this case, the evidence demonstrated that 'Little Love Classmate', after widespread publicity and usage, had gained significant influence as a name of wake-up words, a name of an AI voice interaction engine, and a product name for a smart speaker equipped with the AI voice interaction engine. The defendant applied for the registration of 66 trademarks across 21 classes that were identical or similar to the plaintiff's reputed wake-up words 'Little Love Classmate' and even sent a cease-and-desist letter to the plaintiff's affiliated company, which violated the principle of honesty and good faith, disturbed the order of fair competition in the market, and harmed the legitimate rights and interests of the right holder, and constituted an act of unfair competition regulated under Article 2 of the Anti-Unfair Competition Law in China.

The Supreme People's Court in

China has recognized cases of regulating malicious trademark applications through the anti-unfair competition law as both one of China's 50 typical IP cases and one of China's top 10 IP cases for 2024 Intellectual Property Awareness Week. This acknowledgment not only validates the lower courts'

approach to addressing malicious trademark applications through anti-unfair competition law but also underscores Chinese courts' dedication to enhancing intellectual property protection and fostering a conducive business environment.

In conclusion, when confronted

with instances of bulk or continuous malicious trademark applications, right holders may opt to pursue civil litigation under anti-unfair competition law to secure an injunction from Chinese courts against such malicious trademark applications in China.



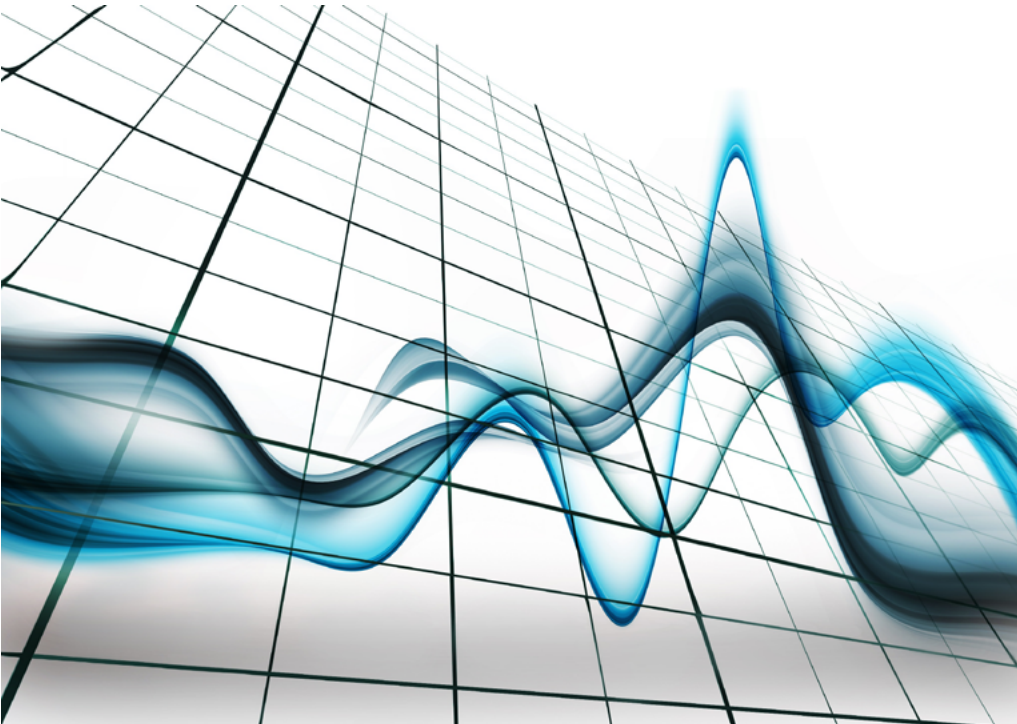
What should we know about the names of drugs?

By Ling Zhao

Drugs are a special category of commodities that concern public life, health and safety. The registration of drug trademarks is an important means for drug enterprises to protect the intellectual property rights of drugs and plays an important role in ensuring the

safety of clinical drug use and safeguarding the legitimate rights and interests of the public. The commercial identification of a drug mainly includes three types: the generic name of the drug, the trade name of the drug and the trademark, which are different and interrelated.

I. The generic name of the drug shall be used in accordance with the provisions of the Drug Administration Law and the Regulations on the Administration of Drug Instructions and Labels and shall not be registered as a trademark.



With regard to generic drug names, Article 29 of the Drug Administration Law of the People's Republic of China, which took effect on December 2019, stipulates that "a drug name included in the national drug standards shall be a generic drug name. Where it has been used as the generic name of a drug, the name may not be used as a trademark of the drug". Article 8 of the General Provisions of the Principles for Naming of Generic

Names of Drugs in China stipulates that "neither the generic name of a drug (including INN) nor the English or Chinese translation of its special stem shall be used as a trade name or be used to form a trade name for the purpose of trademark registration".

The generic name of a drug reflects the difference between different drugs, is stipulated by the specialized agency for drug administration, is mandatory

and binding, and belongs to the public domain. On the other hand, a drug trademark is used to distinguish between different drug manufacturers and has the attribute of private rights. The law prohibits the registration of generic names of drugs as trademarks in order to avoid the monopoly of public interests and protect the public interests of the society. Considering that the generic name of a drug refers to a drug or a drug ingredient for the treatment of a specific disease, its registration and use as a trademark will mislead the relevant public, thus confusing the pharmacological effects of the product and affecting drug safety. The registration of trademarks containing the INN stem will also limit the creation of new INNs, which will not be conducive to the acquisition of new generic names for new drugs, and will be unfair to the new drug research and development enterprises.

How to determine generic names and especially generic names of drugs? The generic name of drugs in China refers to a legal name for drugs formulated by the Pharmacopoeia Commission of the People's Republic of China in accordance with the Principles of Naming Generic Drug Names of the People's Republic of China and recorded with the Ministry of Health of the People's Republic of China. It is a generic name for certain kinds of drugs with the same composition or formula.

In the administrative litigation of trademark review of refusal against the mark "OGIVRI" No. 33152593, the Court finds that the English combination "OGIVRI" is not an inherent vocabulary and has no specific meaning. It is only a trade name of the drug "trastuzumab" created by the trademark applicant. Multiple pharmaceutical companies are producing and selling anti-cancer targeted drugs with "trastuzumab"

as the main active ingredient, and the applicant only produces one of them. Therefore, "trastuzumab" ("trastuzumab") should be the generic name of this type of drug, while "OGIVRI" is only the trade name of the drug produced by the trademark applicant, i.e. the plaintiff in this case.

II. When applying for marketing approval of the new drugs, the drug manufacturers may formulate drug trade names according to their needs. The trade name of a drug must comply with the naming principles of the trade name of a drug published by the State Drug Administration.

On March 15, 2006, the former State Food and Drug Administration issued the "Notice on Further Regulating the Administration of Drug Names" and the annex "Principles for the Naming of Drug Trade Names". According to the notice, drug

trade names should not have exaggerated publicity or imply therapeutic effects. They should comply with the Principles of Drug Trade names and be approved by the State Food and Drug Administration before they can be used. The Principles of Drug Trade Naming include not using the words that are not allowed to be used in trademarks. In addition, according to the notice, except





for new chemical structures, new active ingredients, and required products holding compound patents, other varieties are not allowed to use trade names.

From the above administrative orders and regulations, it can be seen that a drug trade name is a name given by a drug manufacturer for a new drug, which shall not be the same as

the generic name of the drug and its constituent elements. From the point of view of its function, it has a certain role in indicating the source of the drug. From the point of view of its naming rules, it shall comply with the provisions of the Trademark Law and shall not contain words that exaggerate the publicity or describe the characteristics of the product. Nor shall it be the same or similar with

the drug trade name of others, which is quite common with the composition of the trademark. In practice, drug manufacturers often register their approved drug trade name as a trademark to obtain protection under the Trademark Law. In view of the shared common nature of drug trade names and trademarks, some scholars have also proposed that the “two into one”, so as to better regulate the use and protection of drug trade names.

However, the drug trade name is still a drug name by nature, and the drug trade name that has not obtained the trademark registration shall not be used as an unregistered trademark on drugs. As the Supreme People’s Court held in the administrative judgment in Southwest Pharmaceutical Co., Ltd. v. Trademark Review and Adjudication Board of the State Administration for Industry and Commerce and Bayer



Consumer Care Co. on the retrial of No. 631613 “San Lie Tong” trademark dispute, “China’s Drug Administration Law prohibits the use of unregistered trademarks in drugs. When Southwest Pharmaceutical Company applied for the registration of ‘San Lie Tong’ trademark and the trademark was approved for registration, ‘San Lie Tong’ could not legally be an unregistered trademark of ‘Sanlietong tablets’.”

III.The conflicts between drug trade names and trademarks

shall be resolved in accordance with the relevant provisions of the Trademark Law.

Although drug trade names play a similar function of distinguishing market entities as other industrial and commercial signs in the market due to their own characteristics such as recognizability, the biggest difference between drug trade names and trademarks lies in that although drug companies obtain the right to use after registering the drug name with the drug

regulatory department, the right to use is not a specific civil right created by law. The exclusive right to use a registered trademark is a civil right protected by law, including exclusive use right and prohibition right, which has the right attribute once registered.

Considering that the drug trade name has the characteristics of identifying different drugs and is similar to other industrial and commercial marks, its value comes from its distinguishing function and the commercial reputation of the industrial and commercial subjects it marks. The protection of industrial and commercial marks must be premised on the fact that they have a certain degree of popularity. The Supreme People’s Court in Shanxi Kangbao Biological Products Co., Ltd. v. Beijing Jiulong Pharmaceutical Co., Ltd. and the Trademark Review and Adjudication Board on the administrative dispute of No. 1592518 “KE LI TING”

trademark held that according to the relevant administrative rules and administrative normative documents, the State implements the corresponding administrative management system for the use of drug trade names, but in addition to obtaining civil rights in accordance with other laws, whether the drug trade names approved by the drug administration department produce civil rights and interests depends on its actual use; the drug trade names that are actually used and have a certain influence may be protected by law as civil rights and interests.

The Beijing High People's Court also reiterated the above view in the administrative judgment on the trademark dispute for No. 5430775 "PHUDICIN" trademark, that is, after the registration of the trade name of the approved drug, the applicant of the name does not necessarily enjoy the corresponding civil rights and

interests. It is only after the applicant has accumulated a certain degree of goodwill and gained a certain degree of popularity in the market through its use of the drug trade name that the applicant can enjoy the corresponding civil rights and interests.

Thus, the registration of a drug trade name does not directly generate the prior right to exclude others from using the same or similar trademark on the same kind of goods. In the event of a conflict between the prior drug name and the trademark, whether protection can be requested in accordance with the provisions of Article 32 of the Trademark Law, the premise is that the drug name is used earlier and has gained a certain popularity.

IV. Drug trade names should be registered as trademarks for protection, and drug enterprises should strategically

register their trademarks, and conduct defensive registrations as appropriate.

Since the registration of drug trade names does not directly produce the prior right to exclude others from using the same or similar trademarks on similar goods, civil rights and interests need to be generated on the premise of the drug trade names being used and gaining certain popularity first, for drug enterprises, the registration of drug trade names as trademarks is a necessary move to avoid squatting and obtain adequate protection.

In practice, when drug companies apply for the approval of new drugs, they often first apply for the registration of several drug trademarks that may be used, and select the appropriate trademark from the registered trademarks to submit the drug trade name registration, which, on the one hand, eliminates the need to make

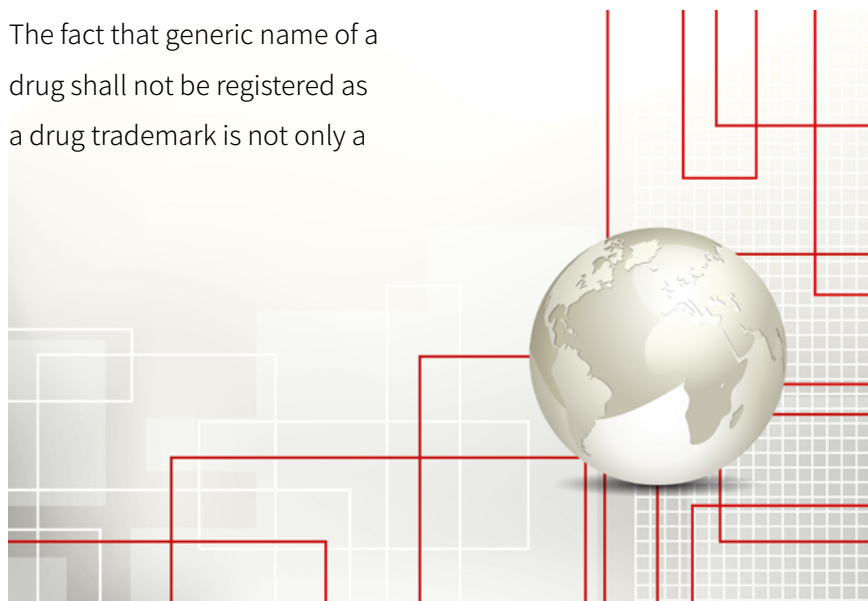
corrections due to non-compliance with the trade name of the new drug that may lead to delayed approval, and on the other and avoids the conflicts of rights with others' trademarks.

In addition, drug companies facing infringement of their trademark rights are limited in the amount of advertising evidence due to the restrictions imposed by laws and regulations on pharmaceutical advertising. At the same time, due to the specific consumer groups of drugs, functional uses, sales channels and production departments of drugs are also relatively special, to prove that there is a correlation between such goods and other goods or services, and then prove that the registration and use of the trademark in dispute is easy to mislead the public and damage the legitimate interests of the trademark right holder is relatively difficult. There is a certain difficulty in drug trademark

rights protection. Therefore, it is suggested that drug enterprises, when applying for trademark registration, can appropriately expand the scope of goods and services, and carry out defensive registration in the related goods and services category, such as "dietary nutritional supplements", "medical apparatus and instruments", "retail and wholesale of pharmaceutical, veterinary and sanitary preparations and medical products", "medical care", "rehabilitation centers" and "guidance on diet nutrition".

The fact that generic name of a drug shall not be registered as a drug trademark is not only a

consideration from the perspective of consumers' drug safety, but also a way to ensure that the name of a drug in the public domain shall not become anyone's private right. Drug trade names are important identifiers for consumers to distinguish between different drugs and registering them as trademarks not only protects the legitimate rights and interests of pharmaceutical companies, but also avoids market confusion and maintains a fair market competition order.



Strategies to overcome rejections when marks in foreign language considered as both “deceptive” and “lack of distinctiveness”

By Shufang Zhang & Ling Zhao

In recent years, there's an increasing number of trademark applications encounter rejections due to being considered as “deceptive”. According to Article 10.1.7 of the China Trademark Law, a sign which is deceptive and is liable to mislead the relevant public regarding the quality, origin of

goods or other characteristics of the goods shall not be used as trademarks. “Deceptive” referred to in this clause occurs when descriptive elements such as the type, composition, or ingredients of the goods contained in a trademark are inconsistent with its designated goods, potentially leading to public deception. On

the other hand, whenever a mark contains descriptive elements relating to the ingredients or characteristics of the goods, the trademark may also be considered as lacking in distinctiveness. Therefore, it happens a lot that one mark applied for is considered both as “deceptive” and “lack in distinctiveness”.

In the “Guidelines for Prohibiting the Use of Signs as Trademarks”¹ issued by the National Intellectual Property Administration (the CNIPA) in January 2023, it is emphasized that if a sign has multiple meanings or can be used in different ways, as long as one of its meanings or ways of use is likely to make the public believe that it falls under the circumstances specified in Article 10.1 of the China Trademark Law, or if a specific group of public has reasonable grounds to believe that the use of the sign as a trademark violates the provisions of this Article, then the sign falls under the aforementioned circumstances of violation.

With examination standards becoming stricter, the number of trademark applications encountering rejections due to being considered as “deceptive” has been increasing. Theoretically, the criteria to determine the registrability of

marks composed of Chinese characters or foreign languages, in terms of deceptiveness and distinctiveness, should be the same, only that meanings of the marks in foreign languages might not be properly understood or commonly known by the relevant public, i.e. in most time the Chinese public. For Chinese public, whether the elements in one mark composed of Chinese characters are deceptive is kind of self-explanatory, but for marks composed of foreign language, the situation is bit trickier. To better understand situations when marks composed of foreign languages being deemed as both “deceptive” and “lack in distinctiveness”, we have made studies on cases, and tried to explore strategies for overcoming rejections by citing both “deceptiveness” and “distinctiveness” clauses for marks composed of foreign languages.

i. Is the element of relevant public relevant and the role it

plays?

To begin with, determining whether a trademark is “deceptive” or “distinctive” requires a thorough examination of whether the descriptive elements in this mark are aligning with the function, ingredients or other characteristics of the designated goods of the mark. This understanding is particularly crucial when dealing with foreign trademarks.



Article 8 of the “Provisions of the Supreme People’s Court on Several Issues Concerning the Trial of Administrative Cases Involving Trademark Authorization and Confirmation”² stipulates: “When the trademark concerned is composed of a foreign language, the people’s court shall examine and determine whether the trademark in foreign language has distinctive features based on the usual understanding of the relevant public in China. This rule also applies to the examination

of Article 10.1.7, emphasizing the importance of considering the “usual understanding of the relevant public in China” and the “cognitive degree” of the relevant public for the “inherent meaning” of the marks in foreign language. The trademark “Axhidrox” used on the goods like “toiletry preparations, deodorant, antiperspirant” was rejected by the CNIPA by considering this mark as being liable to mislead the relevant public on the characteristics of its designated goods. The case was brought to Beijing IP Court, which considers that even though according to the recognition habit of the public, the mark “Axhidrox” is likely recognized as combination of “Ax” and “hidrox”, while “Ax” is usually understood as “reduction” and “hidrox” refers to an extract of olive fruit pulp with antioxidant effects, “hidrox” is not a common English word, and with the general understanding of English language among the Chinese public, they usually

would not comprehend its specific meaning. Consequently, the trademark “Axhidrox”, designated for use on “personal deodorants” and other goods, would not be perceived as inconsistent with the characteristics, functions, or other features of the designated goods. Based on the above, the Beijing IP Court ruled that the mark is not liable to mislead the relevant public on the characteristics or function of the reviewed goods and is not “deceptive”³. The CNIPA appealed to Beijing High People’s Court, who sustained the judgment of the first instance and further stressed that when judging whether a mark is “deceptive”, the usual understanding of the relevant public and the designated goods or services of the mark shall all be taken into consideration.

It can be seen that the court, in its examination, fully considered the possibility of deception starting from the “usual understanding of the relevant public in China”. And



hence the “usual understanding” or “general cognition” of the relevant public is one of the key aspects of analysis.

In the retrial of review of refusal of the trademark BIODERMA, used on the goods “pharmaceutical preparations for skin care; pharmaceutical preparations; pharmaceutical preparations for skin disease” in Class 3, the Supreme People’s Court rules that to determine whether an English trademark is distinctive, the standard should be based on the usual understanding of the relevant Chinese public for the goods or services designated by the mark. The assessment should be made based on the overall composition and meaning of the mark, considering the degree of association between the mark itself and the designated goods or services, as well as its ability to distinguish the origin of the goods or services in actual use. The mark BIODERMA was refused

by the CNIPA, whose decision was sustained by courts of two instances, based upon the grounds that the mark was understood as composing two parts, i.e. BIO and DERMA, wherein “BIO” was understood as biology and “DERMA” was a commonly used root word in English and was translated as “dermis layer of the skin”. The SPC reversed the decisions of CNIPA and the lower courts, deciding that the mark BIODERMA is a coined word and is not likely be understood as abovementioned by the relevant public in China.⁴

Aside from the “usual understanding of the relevant public”, determining the possibility of deceptive or distinctiveness also requires judgment based on the common sense of the relevant public. The “Guidelines for the Trial of Administrative Cases Involving Trademark Authorization and Confirmation by the Beijing Higher People’s Court”⁵ issued in 2019

stated that “if the public, based on daily life experience, would not misperceive the quality or origin of the goods or services covered by the concerned trademark, it does not fall under the circumstances specified in Article 10.1.7 of the China Trademark Law.”

The CNIPA released the “Standard for Judging General Trademark Violations” (the Standard) on December 13, 2021⁶. Article 8 of



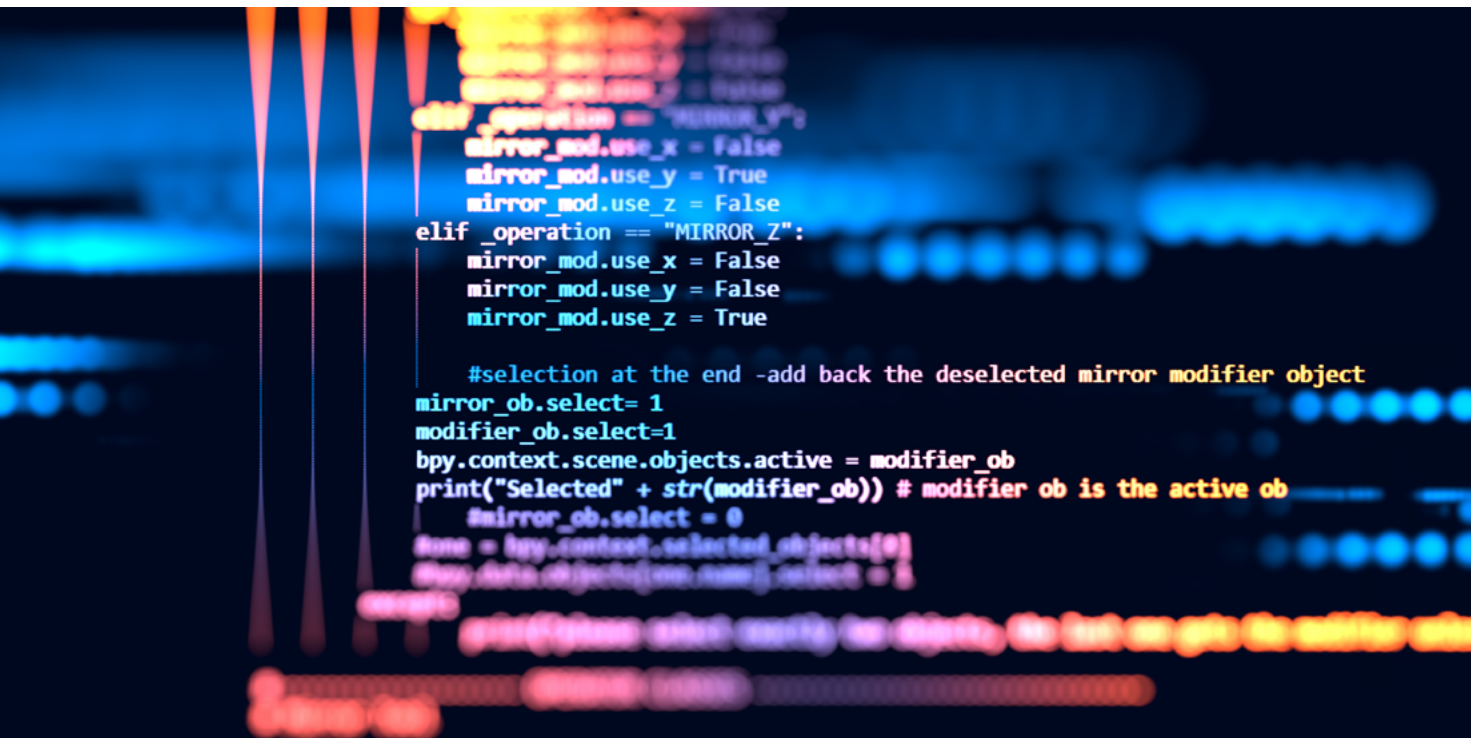
the Standard stipulates that the representation of a trademark about the quality and other characteristics or the origin of a product or service used exceeds its inherent degree or is inconsistent with the facts, which easily misleads the public about the quality and other characteristics or the origin of the product or service. However, exceptions are made for situations where the public, based on everyday experiences,

would not mistake the quality or origin of the goods or services. The regulations here stressed the “daily life experience” shall be considered when considering whether a mark is “deceptive”.

For example, even though “Blackberry” is name of a fruit, when it is used on electronic products, the relevant public can readily judge based on common sense that “Blackberry” is not

related to electronic products. Therefore, the mark “Blackberry” is not liable to mislead the relevant public or associate this word with any feature of the goods “electronic products”, avoiding the possibility of being deemed as “deceptive” or “lack of distinctiveness”.

In sum, when determining whether there is a possibility of deceptiveness or lack of



distinctiveness in a trademark, the considerations and judgments shall be based on the common experience or usual understanding of the relevant public, focusing on the correlation between the meanings/connotations of the trademark and the designated goods/services, and then further analyzing the possibility of misleading or possible associations between mark and characteristics of goods.

ii. Association with the designated goods and services

Furthermore, determining the possibility of deceptiveness or distinctiveness requires consideration of specific goods and services covered by the mark and the relevant public of such goods and services.

The trademark “HyCOsyn” used on the services like “processing of carbon dioxide; purification of carbon dioxide and etc.” in class

40 was rejected by the Trademark Office for being considered as devoid of distinctive character and liable to mislead the public as to the contents of the services other than those relating to “HYCO”. In review procedure, the grounds were built based on the following aspects: the trademark “HyCOsyn” as a whole is a coined word with no dictionary meaning and cannot refer to any characteristics of its designated services; even if the mark is considered as combination of “HYCO” and “syn”, in the gas industry, “HYCO” is mainly used to refer to “hydrogen and/or carbon monoxide”, while the main content of the designated services refer to “processing of carbon dioxide; purification of carbon dioxide and etc.”, which has no connection with “hydrogen and/or carbon monoxide”; in view of the above, “HYCO” does not describe any characteristics of the services and could not mislead the relevant public on characteristics of the services. The Trademark

Review and Adjudication Division of the CNIOA acknowledges the arguments. It rules that the trademark “HyCOsyn”, which has specific meaning in its entirety and is generally not liable to mislead the relevant public on the contents of the services or is lack of distinctiveness.⁷

In the defense of this case, elements like “usual understanding of the relevant public”, “relevance between the specific services” and the meanings of the mark, the scope of the relevant public of the services are all emphasized in the arguments, which finally persuaded the examiners to consider the term “HyCOsyn” is neither misleading nor lack of distinctiveness when used on its designated services.

iii. Tips for trademark applicants

In practice, there are some tips

to apply when a trademark in foreign language is found to be both “deceptive” and “lack of distinctiveness”:

- it is advised to analyze meanings of connotations of the mark starting from the perspective of “usual understanding of the relevant public”;
- elements like “common sense”, “general cognitive level”, “habits of cognition” of the relevant public shall all be taken into consideration;
- the characteristics of the designated goods/services of the mark, the features and scope of the relevant public shall always be considered in combination with the elements listed above.

It is understandable that brand owners usually prefer to adopt descriptive or suggestive elements in their composition of trademarks, as to establish associations between the trademark and the designated goods/services.

However, to increase the chance of success in trademark registration, it is necessary to strike a balance between obtaining rapid consumer recognition and smooth trademark registration and subsequent trademark rights protection.

And as using trademarks being deemed as deceptive constitutes

general trademark violations, brand owners should be cautious when applying for trademarks with descriptive or even suggestive elements. It is advised to seek advice from local counsels in China to assess if their marks would be deemed deceptive, or lack of distinctiveness in China.

¹ “Guidelines for Prohibiting the Use of Signs as Trademarks”: https://www.cnipa.gov.cn/art/2023/1/19/art_66_181565.html

² “Provisions of the Supreme People’s Court on Several Issues Concerning the Trial of Administrative Cases Involving Trademark Authorization and Confirmation”: https://sbj.cnipa.gov.cn/sbj/zcwj/201806/t20180612_6485.html

³ Beijing High Court [2024] No. 61

⁴ (2022) Supreme Court Retrial No. 4

⁵ “Guidelines for the Trial of Administrative Cases Involving Trademark Authorization and Confirmation by the Beijing Higher People's Court”: https://www.beijing.gov.cn/zhengce/fygfxwj/202308/t20230817_3224611.html

⁶ “Standard for Judging General Trademark Violations”: https://www.cnipa.gov.cn/art/2021/12/16/art_75_172237.html

⁷ Trademark Review [2023] No. 295822

Fighting trademark squatting to the end

In 2024, our firm has achieved another total success in fighting trademark squatting against one of our clients on all fronts of the legal battle in trademark opposition, invalidation, and civil litigation.

Our client owns a famous clothing brand and has trademark registrations of the same mark in Class 25 in China, and the mark has been recognized as having certain influence by the China National Intellectual Property Administration (“CNIPA”) and/or the Chinese courts. However, although the client also sells eyewear and other accessories under the same brand, the client could not obtain trademark registration for such goods due

to the infringer’s trademark squatting.

The earliest trademark squatting by the infringer dates back to 2009. Our initial efforts to block its registration through trademark opposition failed because the CNIPA considered our goods to be dissimilar to the infringer’s. None of the subsequent reviewal of opposition and the administrative litigations in two instances could reverse the results.

We did not give up. After gathering evidence showing the infringer had copied trademarks not only from our client but also from other renowned brands, we filed another round of trademark invalidations on the legal basis of fighting

bad faith trademark squatting. The trademark invalidation was eventually supported by the court in the administrative litigation.

Following up on this victory and using the evidence we had obtained from the infringer in the prior proceedings regarding its own promotion and sales of its fake glasses, and the evidence we preserved in communications with the infringer for a possible trademark assignment, which showed the infringer’s bad faith in demanding an extremely high amount of money for the assignment, we launched a civil action against the infringer for its illegal use and bad faith trademark squatting of our client’s trademark. At our request, an amount equal

to the damages we were seeking was frozen in the infringer's bank account from the outset of the lawsuit.

In light of the strong evidence and the persuasive precedent that we had carefully built up and researched, the court upheld

our claim that the infringer had infringed our client's trademark in class 25, on the basis that glasses and clothing are similar goods, and that the infringer's trademark squatting constituted an act of unfair competition. The court supported 80% of our claims for damages, more than enough to

cover our client's costs in all of the legal actions above.

Neither party appealed the court's decision, and the dispute was resolved in substance, achieving both legally and socially positive effects.



Utilizing an array of rights to combat trademark squatting

Our client was the victim of trademark squatting and large-scale counterfeiting by a group of inter-related companies in a different industry. Considering the difficulty and lengthy timeframe of invalidating all the trademark registrations held by the infringer, we adopted a strategy to combat the trademark squatting by utilizing all of the trademark adjacent rights – copyright, trade name, design, etc. And this strategy had already begun to bear fruit in 2024. Actions of trademark invalidation / opposition / cancellation, design patent invalidation, trademark / trade name infringement, and copyright infringement were filed in coordination. And the infringers' design patent has been invalidated; most of their trademark registrations have been invalidated / cancelled;

an amount of RMB 3.5 million, equivalent to all the damages we claimed in two civil actions, is now frozen at our request; and a favorable first-instance judgement has already been obtained supporting our claim that three companies and two individuals behind them jointly committed copyright infringement and that all five should be bear joint liable for RMB 1.15 million to compensate our client. All of our claims for damages were upheld in that judgment, and it is one of the copyright infringement disputes handled by our firm with a relatively high compensation amount.

Thorough investigation and careful coordination between the actions were crucial in achieving the preliminary victories. Evidence of connection between infringers fixed during the field

investigation contributed greatly to the successes. Figures and sales obtained from the infringers in trademark cancellation / opposition proceedings were promptly used in civil actions against them. And one infringer's ownership of a patent and his company's use of the same patent helped demonstrate the infringers had conspired and jointly committed the series of infringements together.

Final and complete success is still on the way, and we are confident that it will come.

Total victory in defense against mass trademark enforcement

Recently, our firm successfully assisted a well-known art supplies company in winning a series of trademark infringement disputes, achieving complete victory. All final judgments ruled that our client's distributors did not constitute trademark infringement.

In this series of cases, the plaintiff filed trademark infringement lawsuits against dozens of our client's distributors nationwide, intending to gain benefits through mass enforcement of rights. The large number of lawsuits and their wide geographical spread severely disrupted the normal business operations of our client and its distributors.

Our office quickly assembled a litigation team to represent the client's distributors in

a comprehensive defense, focusing on the core argument of non-confusion to contest the allegations of infringement, aiming for consistent rulings across various courts.

The litigation team collected a substantial amount of public perception evidence and conducted an in-depth analysis of the evidence submitted by the opposing party. On behalf of distributors, we successfully prompted the courts to recognize the plaintiff's trademark as having weak distinctiveness and low recognition, thereby limiting its scope and strength of protection. Additionally, the team submitted relevant evidence of our client's durable and extensive use of the mark, demonstrating the legitimacy and reasonableness of their usage, as well as the higher recognition and reputation of the

related brand in China.

Despite initial losses in some first-instance cases, we thoroughly analyzed and summarized the viewpoints of various courts and the overall progress of the cases, steadfastly executing the established litigation strategy. Ultimately, through the team's relentless efforts, all final judgments unanimously determined that our client's distributors did not intentionally seek to exploit the plaintiff's trademark recognition and goodwill, and that their actions will not confuse consumers regarding the source of the goods, thus ruling out trademark infringement.

The comprehensive victory in this series of cases fully upheld the legitimate rights and interests of our client and its dozens of distributors nationwide.

Beiersdorf AG vs. A Petrochemical company in Tianjin city

—50 Typical IP Cases in 2023 selected by Supreme People's Court

Our office has successfully represented Beiersdorf AG in a trademark infringement and unfair competition case against a petrochemical company in Tianjin City. This case is a typical case of regulating malicious trademark squatting through anti-unfair competition laws.

The plaintiff owns the registered trademarks “Beiersdorf” and “Beiersdorf in Chinese” in China, where “Beiersdorf” is also the plaintiff’s trade name and “Beiersdorf in Chinese” is its Chinese translation. The

defendant, a petrochemical company based in Tianjin City, used the plaintiff’s trademarks and trade names “Beiersdorf” and/or “Beiersdorf in Chinese” on its lubricant products, as its own trade name, and as the main part of its domain name without authorization, engaging in false advertising. Additionally, the defendant and its affiliated company applied for 32 trademarks that are identical or similar to the plaintiff’s trademarks.

In the first instance, the court did not recognize the malicious trademark squatting by infringers

as acts of unfair competition and only partially supporting the requested compensation. Consequently, the plaintiff filed an appeal. In the second instance, the court upheld the first-instance determination that the defendant’s imitation of the company name and domain name constituted unfair competition. It also recognized the defendant’s malicious trademark squatting as unfair competition and fully supported the plaintiff’s claims for economic losses and reasonable expenses. The defendant later filed a retrial application, but the Supreme People’s Court dismissed it on December 9, 2024, confirming

the second-instance judgment.

The second-instance court considers the following factors in deciding malicious trademark squatting:

The defendant and its affiliate company filed 32 trademark registration applications in

multiple classes of goods or services related to the plaintiff's trademarks since 2018, attempted to legitimize and rationalize the trademark applications filed in bad faith, but all the trademarks were invalidated or rejected; Besides trademark filings, the defendant conducted a comprehensive imitation of the

plaintiff by using the plaintiff's trademark and trade name as its trade name and domain name; The defendant shows bad faith in copying and imitating the plaintiff's trademarks as well as in taking the advantage of plaintiff's reputation.

When deciding the amount of compensation, the court takes into consideration that "the defendant's malicious trademark squatting behavior over the years has led to the plaintiff incurring unnecessary costs for long-term rights protection."

This case provides an effective judicial remedy against the malicious trademark squatting by infringers, which disrupts the normal order of trademark registration management.



Administrative raid action concerning the rental of vehicle infringing “Rolls-Royce” trademarks

——“Case of the Year 2024” in the China Trademark Association’s “Thirty Years, Thirty Classic Cases”

We represented our client in collaboration with the Shanghai Market Supervision Administration to conduct a series of raid actions targeting multiple wedding car rental companies. These operations resulted in the seizure of five illegally modified counterfeit “Rolls-Royce” vehicles and the imposition of administrative penalties on 15 infringers.

Entrusted by our client, we

assisted the Shanghai Market Supervision Administration in investigating several parties suspected of illegally modifying counterfeit “Rolls-Royce” vintage cars for wedding rental services. Throughout this process, we actively collaborated with law enforcement to clarify rights, track leads, and confirm that the vehicles in question were, in fact, domestically produced “Jinma” cars. The trademarks on the front, body, and wheels had been replaced with our client’s trademarks. During the raid

actions, multiple contracts for the rental of “Rolls-Royce” vehicles as wedding cars, along with five vehicles suspected of being counterfeit, were seized. The law enforcement authority determined that, without the permission of the rights holder, the involved parties had used trademarks on the vehicles that were identical to the registered trademarks of the rights holder. This action violated Article 6.1 of the Anti-Unfair Competition Law of the PRC and Article 57.7 of the Trademark Law of the PRC. Consequently, based

on Article 18.1 of the Anti-Unfair Competition Law and Article 60.2 of the Trademark Law, the law enforcement authority imposed a total administrative penalty exceeding 710,000 yuan on the 15 parties involved.

This case is significant as it clarifies the definition on the act of renting goods that infringe upon the exclusive rights of registered trademarks. The law enforcement

authority concluded that the wedding car rental companies, being aware or should have been aware of the high reputation of the involved trademarks, failed to verify the authenticity of the rental wedding cars. Their negligence resulted in consumer confusion regarding the source of the vehicles and encroached upon the business opportunities of the trademark rights holder, thereby constituting trademark

infringement. The successful resolution of this case offers practical guidance for regulating trademark infringement within the rental process.

This case has been widely reported by multiple media and was selected as the Case for the year 2024 in the China Trademark Association's "Thirty Years, Thirty Classic Cases" in September 2024.



Retrial for invalidation against RICHARD MILLE in class 10

We represented renowned watch designer Richard Mille in appealing a CNIPA's invalidation decision maintaining the trademark "RICHARD MILLE" in Class 10, registered by Shanghai Xialang Art Design Co., Ltd. We argued the trademark infringed Mr. Richard Mille's name rights under Article 32 of the Trademark Law. The Beijing High People's Court ruled because

of the high reputation of Mr. Richard Mille as watch designer, the use of disputed mark RICHARD MILLE on "medical apparatus and instruments" in Class 10 could mislead the public into associating the goods with Mr. Richard Mille, violating his name rights. Beijing High People's Court overturned CNIPA's decision and the first-instance verdict. The Supreme Court refused retrial filed by the owner of the disputed mark,

confirming the second-instance verdict.

This case underscores the importance of protecting personal name rights in Trademark Law, especially for well-known individuals, to prevent public confusion and ensure fair competition.



Customs border protection cases represented by CCPIT selected as Typical IP Protection Cases by Chinese Customs

In 2023, our office represented clients in several notable seizure cases under the Customs Intellectual Property Protection framework, two of which were selected as Typical Cases of Intellectual Property Protection by Chinese Customs.

In September 2023, the Changzhou Customs employed big data analysis to evaluate the risk associated with a batch of bearings declared for export by a trading company in Ningbo. The analysis indicated a significant suspicion of infringement. Upon inspection, it was discovered that the suspected infringing products bore our client's registered trademark, despite being declared

as "no brand" in both Chinese and English. Our office assisted the rights holder in conducting an on-site appraisal, which confirmed that the products in question were indeed infringing goods. This case exemplifies the effective use of big data analysis by customs authorities to enhance the quality and efficacy of law enforcement.


In October 2023, during an inspection of a batch of export goods, Dayaowan Customs under Dalian Customs discovered 3,000 sets of bearings that were poorly packaged and roughly made, all bearing our client's registered trademark. We actively cooperated with the customs to contact the rights holder for

appraisal, and confirmed that the bearings in question were infringing goods. This case reflects how Chinese customs, through precise risk prevention and control measures, seizes infringing goods from various channels. Such actions promote the global competitiveness of high-quality Chinese manufactured products while maintaining a positive image for Chinese manufacturing. These cases highlight the importance of effective customs enforcement in protecting intellectual property rights. Our office is dedicated to assisting our clients in navigating the complexities of customs regulations and safeguarding their intellectual property rights.

Bad faith of assignor weighed in invalidation against assignee's refiled trademark: Case of “法格 FAGE”

FAGOR, S. COOP (“the applicant”) filed an invalidation against the disputed mark “法格FAGE” registered by a Chinese company (“the respondent”) in 2021, covering the goods in class 34. The applicant's cited marks include marks “法格” and “FAGOR ”, covering the goods in classes 7, 8, 9, 11, 20 and 21. The China National Intellectual Property Administration (CNIPA) made a decision to invalidate the disputed mark based on Article 44.1 of China Trademark Law.

In the invalidation proceedings, as representatives of the applicant, we emphasized that the disputed mark “法格FAGE” completely contains the cited mark “法格” which is also the trade name of

the applicant's Chinese subsidiary and is highly similar to the cited mark “FAGOR ” in pronunciation. In addition to the disputed mark in this case, the respondent owns another TM No. 24368984 “法格FAGE” in class 34, which is also a copy and imitation of the applicant's prior trademarks. This trademark has already been declared invalid due to the bad faith of its original registrant.

The CNIPA supported our claims and held that the disputed mark is highly similar to the applicant's marks and trade name, which is not a coincidence. After the respondent acquired the mark No. 24368984 “法格FAGE” transferred from the malicious original registrant, it re-applied for the registration of the disputed

mark with the same wording, which is obviously a deliberate imitation of the applicant's marks. The respondent's behavior disrupts the normal order of trademark registration management and harms the market order of fair competition.

The significance of this case lies in the fact that after a trademark is invalidated due to the original registrant's bad faith, the assignee's refiled for the same trademark will still be deemed as an act of obtaining registration by improper means.

Successful registration of trademark “FORVIA 佛瑞亚” by overcoming Article 10.18 of China Trademark Law

The China National Intellectual Property Administration (CNIPA) rejected the registration of the trademark No. 63405142 “FORVIA佛瑞亚” under Trademark Law Article 10(1)(8) (the subject trademark contains the word “佛”, which is easy to hurt the feelings of the religious people when used on the designated goods, and causes unhealthy influences) in the decision on review of refusal. The Beijing IP Court issued the verdict of first instance, ruling that though the subject trademark contains the character “佛”, as to the overall recognition of the subject trademark, it will not make the public to connect it with the Buddhism, and will not hurt the religious belief and religious



feelings of the related public. So the subject trademark does not violate Article 10.1.8 of China Trademark Law. The CIPNA filed the appeal of second instance before the Beijing High Court. The Beijing High Court issued a final verdict (2024) Jingxingzhong No. 3710, ruling that though the subject trademark contain the character “佛”, according the normal experiences of the public daily life, or the commons sense of the religious people, the use of the subject trademark on the

designated goods will not make the public to connect it with the Buddhism, and will not cause unhealthy and negative influences to the social public interests and public orders. So the subject trademark does not violate Article 10.1.8 of China Trademark Law.

This case makes clear that judging whether a mark would cause unhealthy influence shall rely on the normal experiences of the public daily life, or the commons sense of the religious people.



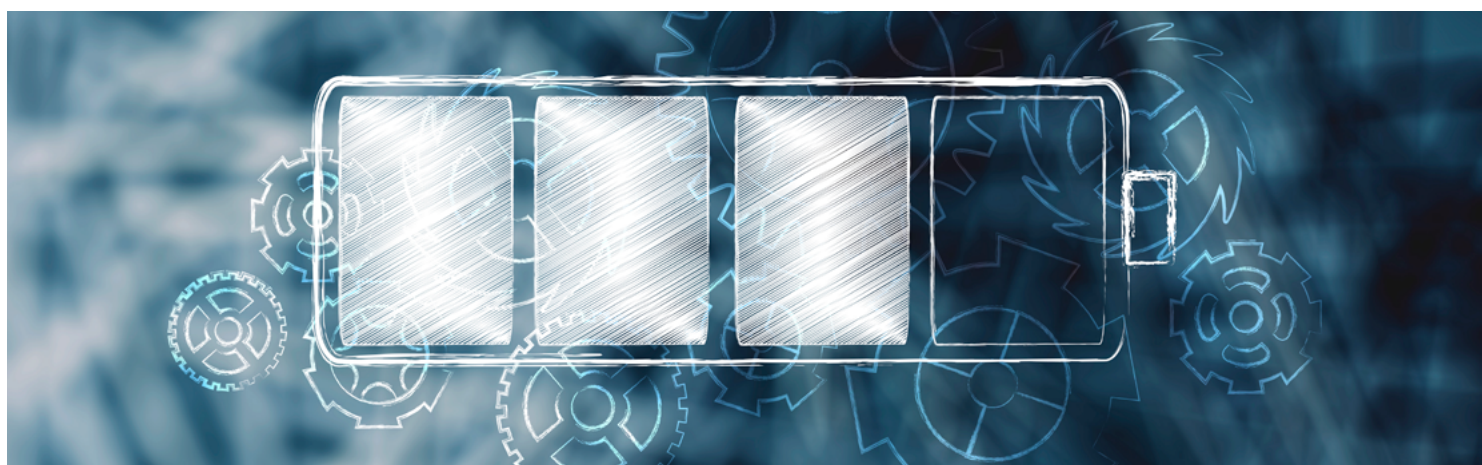
Series of oppositions to “ZE& Device” trademarks demonstrate CNIPA’s resolve against malicious filings

We represent the German auto parts company – ZF FRIEDRICHSHAFEN AG with the house brand as , lodged over 80 oppositions against the marks  in the name of Jinan Xinyatong Auto Parts Co., Ltd. in various Classes. Remarkably, all these oppositions achieved




favorable results, although the goods/services covered by most of the opposed marks are not related to auto parts. The CNIPA determines that the opposed party’s actions have the intention of copying and imitating, disrupting the trademark registration order. This violates the spirit of the Trademark Law against obtaining trademark registration

by deceptive or unfair means.

These outcomes highlight the CNIPA’s firm stand against malicious trademark registrations, safeguarding the legitimate rights of trademark owners, and maintaining a healthy and fair trademark registration environment.



Rolls-Royce's RR Logo secures well-known protection once again in "PRS & Device" trademark invalidation

C CPIT, representing Rolls-Royce Motor Cars Limited, successfully won an appeal case before Beijing IP Court regarding invalidation against trademark  on "cosmetics for animals" based on well-known claim of the cited marks  and  on automobiles, as according to Article 13(3) of the Chinese Trademark Law. In invalidation, the CNIPA did not support the well-known claim as it held the disputed mark and the cited marks have difference in terms of composing letters, pronunciation and overall appearance while the goods covered by them are in different industry sectors and thus

have weak connections. The Court overruled the CNIPA's decision and supported our claim by holding that the disputed mark constituted copy and imitation of the cited marks. Though "cosmetics for animals" are dissimilar to automobiles, in view of the well-known status of the cited marks, overlapped consumer targets and the subjective intention of the third party, there's reasonable grounds to conclude that the registration and use of the disputed mark is likely to mislead consumers that the disputed mark and the plaintiff have certain connection, so as to cause confusion or misleading as to the sources of goods, or damage the reputation of the cited marks, and then sever the

intrinsic connections between the well-known trademark and automobiles, diminish and distinctiveness or exploit the market reputation so as the cause possible damage to the plaintiff over the interests of the well-known trademark.

In applying Article 13(3) of the Chinese Trademark Law, in addition to the similarity of the marks and goods, the well-known status of the cited marks, overlapped consumer targets and the subjective intention of the third party shall be comprehensively taken into consideration.

“MOBIL” re-affirmed as well-known trademark in invalidation appeal against trademark “美弗威霸”

EXXON MOBIL CORPORATION filed invalidation against the mark “美弗威霸” (MEI FU WEI BA) registered in 2016 covering the goods in class 04. CCPIT represented EXXON MOBIL submitted evidence proving the high reputation of the cited marks and the bad faith of the disputed party. The CNIPA, based on the evidence filed and the arguments built on the evidence, confirmed the cited mark “美孚” (MOBIL in Chinese-MEI FU) as well-known to the relevant public in China on goods like lubricants in Class 4 and

granted well-known protection. It also affirmed the bad faith of the disputed party. The disputed party filed appeals with Beijing IP Court and then Beijing High Court. Both Courts acknowledges the cited mark “美孚” (MEI FU) is well-known and the disputed party filed the marks through “improper means” maintained the rulings of the CNIPA.

This case strengthens the protection of well - known trademarks. It helps to prevent malicious hoarding of trademarks and unfair competition in the

trademark field, maintaining the normal order of trademark registration.



“GRUNDFOS” secures well-known trademark protection once more in series of invalidation appeals against “GRANDFAR”

C CPIT representing GRUNDFOS HOLDING A/S successfully cracked down on the series of “GRANDFAR” marks registered by its long-time plagiarizer. The house marks “GRUNDFOS” and “格兰富” (GRUNDFOS in Chinese)

of the world’s leading pump manufacturer, Grundfos Holding A/S, have long been target of copycats. The disputed party filed series of “GRANDFAR” marks Classes 16, 40 and 42. As the goods of the disputed marks bear large differences from those of the cited marks, the invalidations against these marks failed before the CNIPA. During the lawsuit before the Beijing IP Court, we submitted further evidence proving the high reputation of the cited marks and the bad faith of the disputed party and presented strong arguments based on the evidence. The

Court determined that based on the evidence submitted by the plaintiffs, the cited marks “GRUNDFOS” and “格兰富” had reached the well-known level for pump and related products and granted well-known protection.

The well-known recognition for the mark “GRUNDFOS” and “格兰富” helps GRUNDFOS to better protect its house marks in China, increasing its chance of success in opposition/invalidation actions and helping GRUNDFOS to better enforce its rights against bad faith trademark filings.





Profile

320+

Patent Attorneys and Trademark Attorneys

100+

Professionals with Lawyer's Qualification

CCPIT PATENT AND TRADEMARK LAW OFFICE, with a history dating back to 1957, is the oldest full-service Chinese intellectual property law firm. We have 320 patent and trademark attorneys, more than 100 of whom have Chinese Lawyer's Qualification or passed bar examination of other jurisdictions. We provide one-stop professional services, including consultation, prosecution, mediation, administrative enforcement and litigation services, in relation to patents, trademarks, copyrights, domain names, trade secrets, unfair competition and other intellectual property-related matters. Headquartered in Beijing, we have branch offices in New York, Tokyo, HongKong, Shanghai, Shenzhen and Wuhan.

OUR MISSION is to render tailored services to clients with high quality, efficiency and reliability. We continuously devote more resources to improvement of reliability and flexibility of our portfolio management system and make every effort to increase the effectiveness of our quality control mechanism. Our attorneys work proactively in teams in response to our client's diverse needs, providing insightful advice and practical solutions.

OUR PROFESSIONALS attend internal academic and experience-sharing activities and various external trainings continuously to keep pace with the rapid development of laws and technologies. Our professionals are also active participants and frequent speakers in domestic and international intellectual property-related conferences and seminars. Our colleagues participate voluntarily in formulation and amendment of related laws and regulations, and intellectual property-related governmental policy making.

OUR CLIENTS represent every sector of industry and commerce, from start-up businesses to multinational giants such as Fortune 500 companies. Through decades of unrelenting efforts, we have successfully assisted our clients from home and abroad in acquiring millions of patent rights and trademark registrations across the globe and in enforcing patents, trademarks and other intellectual property rights in different jurisdictions. With rich legal experience and extensive technical expertise, we are in a position to satisfy our clients' demands in all aspects of intellectual property protection.

Recognitions

OUR SERVICE QUALITY is widely recognized and highly appreciated by our clients and international associates. In the past decades, we have been ranked highly by *Managing Intellectual Property (MIP)*, *Chambers and Partners*, *The Legal 500*, *Asia Legal Business (ALB)*, *Intellectual Asset Management (IAM)*, *World Trademark Review (WTR)*, *Asia IP*, *China Business Law Journal*, etc.

**Managing
Intellectual
Property**

**ASIAN LEGAL
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**The
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500**

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WTR
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AsiaIP
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**CHINA BUSINESS
LAW JOURNAL** 商法

"This firm has a very good reputation. It has a competent team, not just a single competent attorney. The practitioners are proactive." — MIP

"CCPIT is broadly acknowledged as a market leader with respect to the prosecution, opposition and enforcement of IP rights. CCPIT offers extensive geographical coverage and versatile industry expertise." — Chambers and Partners

"The firm has a sizeable intellectual property practice and offers clients a full-service approach. The firm advises clients on both contentious and non-contentious matters relating to trademarks, patents, domain names and more. The firm has a strong international presence with office locations spread across Asia, USA, and Europe." — The Legal 500

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