

CNIPA Releases 10 Typical Trademark Cases

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On 26 April 2021, the 21st World Intellectual Property Day, the China National Intellectual Property Administration (CNIPA) released 10 typical trademark cases in 2020, including five oppositions and five review cases.

We summarize the cases and the relevant principles to help understand the CNIPA's latest practices in the application of the revised Chinese Trademark Law.

Case 1: Opposition to mark “中智行”, No. 33953937, to crack down on malicious applications for large number of marks without intention to use

The opponent Allride.AI opposed the trademark of Xu Haojie, an individual applicant who has filed more than 170 trademarks in more than 20 classes, some of which are identical or highly similar to others' prior distinctive trademarks and trade names. The big number has obviously exceeded his normal needs and the filing evidently aims at unjustifiable interests. The individual failed to prove that the marks were his own creation or to submit evidence of use.

Case 2: Opposition to mark “草薙家族草薙京冒菜”, No. 31919844, to crack down on maliciously squatting others' character names and protect the prior right holder's creative work

SNK, a Japanese company, opposed Li Xingjun's trademark, which corresponds to the name of an important character in the opponent's online games containing property value and economic interests originated from the opponent's intelligent creation and investment. The mark might lead to the misbelief that the services come from or are associated with the character name right holder. The filing is unfavorable for fair market order or innovation.

Case 3: Opposition to mark “亮神”, No. 24438839, to crack down on associated companies squatting online shop names

The opponent Yongkang Dude Industry & Trade Co, Ltd opposed the mark owned by Wuhu Wushaoshe Trading Co, Ltd. To avoid legal risk, the legal representative of the opposed party registered several companies to file more than 2,000 trademarks, mostly squatting the names of Tmall online flagship shops. The associated companies' tricky filing constituted fraudulent and unjustified registration.

Case 4: Opposition to marks “好待百”, No. 33838169, and “梦多加喱”, number 33827187, to crack down on maliciously splitting foreign famous marks for filing to protect prior trademark rights

The marks of the applicant Nanjing Yaosheng Trading Co, Ltd are separately distinguishable from the opponent's famous marks, but when combined, are very similar to the prior famous marks of the opponent House Foods Group Inc. The tricky squatting can hardly be found out in the normal examination. The CNIPA combined the relevant oppositions in a more comprehensive way to stop the hidden squatting.

Case 5: Opposition to mark “橙米 CNMI”, No. 33255177, to curb infringement of copyright and protect the famous company's goodwill

The opponent Xiaomi owns prior copyright to the stylized MI, whereas the last two Latin characters of the opposed mark are identical with the original copyright which has become famous after the opponent's long extensive use. The opposed party is taking advantage of the opponent's goodwill and might cause confusion in the market.

Case 6: Invalidation against mark “云铜”, No. 36699370, to crack down on malicious filing and unjustifiable registration

The claimant Yunnan Copper has been long using its abbreviation YUNTONG in Chinese characters. The respondent Yunduanzhixiang and its associated companies jointly hoarded many YUNTONG marks and the claimant's logo in 45 classes to make false advertisement, sue the claimant, and request CNY8 billion to the claimant's affiliated companies. The CNIPA decided that the respondent maliciously registered the marks without intention to use and unjustifiably occupied public resources.

Case 7: Appeal against rejection of 3D mark, No. 32315366, to guide examination of 3D marks in terms of distinctiveness and functionality

FERRERO's egg-shaped 3D mark in red, blue, and white plus the term KINDER was rejected due to indistinctiveness. In the appeal, the CNIPA was partially convinced and decided the mark had acquired distinctiveness on chocolate and corresponded solely to the applicant, but upheld the rejection regarding confectionery.

Case 8: Invalidation of color combination mark, No. 18338886, to guide examination of color combination marks

Three claimants requested the invalidation of ZoomLion's color combination mark because of formality defects, generic color in the mechanical industry, and inability to distinguish the source of the goods through the owner's extensive use. Zoomlion filed a response with evidence and convinced the CNIPA to maintain the validity.

Case 9: Invalidation against mark “上海故事 Story Of Shanghai & Device”, No. 12676248, to illustrate the principle for coexistence of earlier used mark with later registered mark

Hangzhou Lingjueding Garments Co, Ltd, the respondent and owner of the mark, failed to prove that its mark was originally created or used earlier than the claimant's cited mark. The CNIPA accordingly invalidated the mark and refused the coexistence of the marks. This is the CNIPA's first case of circuit hearing to examine a complicated case.

Case 10: Invalidation against mark “佳丽芙 Jialifu (stylized)”, No. 17393381, to regulate trademark representation and eliminate malicious filing and hoarding

The claimant S C Johnson & Son, Inc proved that Ma Jihui, an individual, registered the mark through Guangzhou Yangzhi Ad Design Co, Ltd, an agent recorded at the CNIPA and solely owned by Ma himself, who filed more than 2,000 marks, many of which are identical with or similar to others' name brands. The CNIPA deemed Ma to be the agent, who should be restricted to filing marks for only relevant services. The mark was invalidated, though it was assigned to another party.