

# A Comprehensive Analysis of Adjudication of Trademark Administrative Cases

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Ever after the amendment made to the Trademark Law in 2001, the courts began to hear administrative cases involving trademarks. Through the judicial practice in recent years, a consensus on most issues has been reached between the courts and the Trademark Review and Adjudication Board (TRAB). However, the diversity of the cases of dispute and complexity in law application thereto have rendered their views divided on some issues involved in the cases. In the following sections, the writer will be presenting an overview and analysis of all the trademark administrative cases which the Beijing No. 1 Intermediate People's Court has heard in the recent two years.

## I. Application of the provision of Article 10, paragraph one (8), of the Trademark Law regarding unhealthy influences

### (1) Construction of unhealthy influence

It is provided in Article 10, paragraph one (8), of the Trademark Law that words or devices shall not be used as marks that are detrimental to socialist morals or customs or having other unhealthy influences.

Given that the provision on unhealthy influences is put in Article 10, paragraph one (8), of the Trademark Law, but the

Table of trademark administrative cases heard by Beijing No.1 Intermediate People's Court between 2007 and first half of 2009

Year	Cases accepted	Cases closed	Cases withdrawn	Articles of the Trademark Law applied to withdrawal of cases							
				Art.11	Art.13	Art.28	Art.31	Art.41	Art.44	Undue procedure	Undue application of law
2007	154	138	19	1		9	3	5			1
2008	164	142	22		2	10	3	5		2	
1st half of 2009	252	159	26			20			1	5	

various circumstances under Article 10 concern the public order and healthy customs or public interests, and the words or devices under the provision should not be registered, nor used as marks, it is generally held that application of the provision on unhealthy influences must be on the premise that use of the mark has caused prejudice to the public interest; as for the prejudice caused to the rights and interests of a particular civil subject, it falls within the scope of regulation by the relevant grounds under the Trademark Law.

For example, in the case involving the “Hua’anfo HAFO and device” mark<sup>1</sup>, both the TRAB and the court held that the mark in suit made it likely for the relevant sector of the public to associate the mark with the Buddhism, and its use in respect of goods of alcohol would be readily detrimental to the believers’ religious sentiment, and therefore, has unhealthy influence.

#### **(2) Relationship between unhealthy influence provision and the relative ground provisions of the Trademark Law**

Regarding a mark contrary to the relative ground provision, while it would have unhealthy influence on particular subjects, but this unhealthy influence is different, so only the specific relative ground provision should apply here.

As in the case involving the “GAOBANG” mark<sup>2</sup>, the plaintiff, Zhejiang Gaobang Corporation, claimed that the third party Guilin Emulsion Plant’s use of its “GAOBANG” mark in the products of condom had bad influence in the society. The TRAB and the court did not believe that said use had prejudice to the public interests, and did not support the claim.

#### **(3) Relationship between unhealthy influence provision and other provisions of Article 10, paragraph one, of the Trademark Law**

The other provisions of Article 10, paragraph one, of the Trademark Law are specific provisions while the unhealthy

influence provision is an embracing one. The rule underlying the specific application is that the latter applies only if the specific ones cannot.

## **II. Application of the distinctive character provision of Article 11 of the Trademark Law**

Article 11, paragraph one, of the Trademark Law provides: “The following signs shall not be registered as trademarks: (1) those which consist exclusively of generic names, designs or models of the goods in respects of which the trademark is used; (2) those which consist exclusively of signs or indications that have direct reference to the quality, main raw material, function, intended purpose, weight, quantity or other characteristics of goods or services; (3) those which are devoid of any distinctive character. Where trademarks under the preceding paragraphs have acquired distinctiveness through use and become easily distinguishable, they may be registered as trademarks.”

#### **(1) Application of items (1) and (2) of Article 11, paragraph one, of the Trademark Law**

1. Applicable to words and/or devices directly descriptive of the characteristics of goods or services in respect of which they are used, and implicative words and/or devices should not be held devoid of distinctive character.

Generally speaking, an implicative word or device takes a consumer’s imagination to understand its meaning. Therefore, a word or device of the nature is not closely related to the characteristics of goods or services, and is intrinsically distinctive, though its distinctive character is not very strong. Besides, implicative words or devices offer a relatively wide possibility of choice and their registration as marks would

have no improper impact on businesses in the same industry in their description of characteristics of their goods or services. Of course, it is difficult to draw a line of demarcation between directly descriptive and implicative words, and it is reasonable to understand, in many cases, these marks as directly descriptive or implicative.

As was in the case involving the “ADVANCED MEDICAL OPTICS” mark registered by the AMO Inc.<sup>3</sup> and the “BIAN”<sup>4</sup> mark registered by the Kaifeng Bian Embroidery Plant in the goods of embroidery in class 40 (the Bian embroidery is one of the major embroideries in China), which, all directly descriptive of the characteristics of the goods, do not have distinctive character.

But the mark “JOHNSON'S BABYFACE” applied for registration by Johnson & Johnson in the goods of cosmetics in class 3 implies that use of the goods will make skin baby-soft. It is implicatively descriptive.

2. Applicable to words or devices merely showing the relevant characteristics of the goods or services

If a mark applied for registration does not contain any other elements, except a word or device having direct reference to goods or services, then items (1) and (2) are applicable. But it must be noted that in the presence of the expression of “other characteristics” in item (2), application of the items is not limited to the various circumstances as specifically listed here. So long as a mark applied for registration consists exclusively of the relevant characters of the designated goods or services, item (2) may apply.

For examples, to the generic names of “Yun Jin”<sup>5</sup> (meaning a brand of “brocade” in Chinese) “Song Jin”<sup>6</sup> (meaning another brand of “brocade” in Chinese) having reference to textiles item (1) should apply. The TRAB applied item (3) in the case, and the court rectified the wrong application.

The word “Sanxingdui”<sup>7</sup> (the name of a place rich in cultural relics in China) was registered as a mark in goods of metal badges, bronze ware, ordinary metal figurines in class 6, referring to the sources of the goods, and item (2) also applies.

**(2) Application of Article 11, paragraph one (3), of the Trademark Law**

1. It applies to the word or device of a mark the use of which in any goods or services would make it difficult for the relevant sector of the public to identify.

The TRAB also applied the doctrine in the following cases it dealt with.

Take for example, the mark “LOGO!”<sup>8</sup>, it *per se* also meant “sign or indication”, and use of it in any goods or services would make it difficult to distinguish the sources of goods or services.

For the “AJ” mark<sup>9</sup>, it is too simple to be distinctive.

Or the mark of the Chinese words meaning “we have grown up with one mind and one heart for the past thirty years”<sup>10</sup> would be deemed to be an advertisement by the relevant sector of the public, and difficult to be identified as a mark.

Or the mark consisting of a “device of a common medal”<sup>11</sup> would be deemed to be an indication of quality, not a mark by the relevant sector of the public.

But in some other cases, the courts and the TRAB took divided views.

As was in the case involving the mark “Fu (meaning ‘good luck’ and happiness) and the device”. For the TRAB, since it meant “good luck” and “good health”, it had no distinctive character if registered in all classes of goods or services. But the court, taking a different criterion to assess the distinctive character, held that a word, though a currently used word, had no impact on the relevant sector of the public in their identifying it as a mark, so it might still be held to have its distinctive character.



2. Item (3) should apply to marks consisting of a word or device having reference to the character of the goods or services and any other word or device if they have no distinctive character.

As is the case with the “guarana and device” mark<sup>12</sup>. The TRAB applied item (3) since it consisted of the generic name “guarana” and the device.

Also in the case involving the “WASHINGTON and apple device” mark in which the Trademark Office applied item (1) and refused to register it as a mark on the ground that the apple device was the generic device of the designated goods without considering the other parts of said mark. The TRAB duly applied item (3).

3. Item (3) is an embracing provision, applicable only where the preceding two items are not.

As in the cases involving the Chinese word marks of “Bian”, “Yun Jin” and “Song Jin”, in which item (3) was not applicable, but item (1) was.

### III. Determination of similarity of marks

The matters of similarity of marks are mentioned in all relative ground provisions in the Trademark Law. Therefore, to the criteria for assessing similarity of marks mentioned here and in the following sections not only Article 28 is applicable.

#### (1) Law basis and assessment criteria

Express provisions regarding the matter of specific assessment of similarity of marks are not set forth in the Trademark Law and the Regulations for the Implementation of the Trademark Law, but relative express provisions can be found in Article 9 of the Interpretation by the Supreme People's Court of Several Issues Relating to Application of Law to Trial of Cases of Civil Disputes over Trademarks, namely, the similarity of trademarks means that the allegedly infringing trademark, by comparison, is similar to the plaintiff's registered trademark in shape, pronunciation, meaning of words or the composition and colour of the device, or in global composition upon the combination of the various elements, or in the three-dimensional shape or the combination of colours, and is likely to cause the relevant sector of the public to confuse the source of goods or think the source of goods is related, in a particular way, to the plaintiff's registered trademark.

It is made known from the preceding provisions that account should be taken of two factors to assess similarity of marks: similarity of the word or device of a mark; and likelihood of confusion. The presence of the two is required, and the latter is more important. We can work out a formulism of the preceding provisions, namely similarity of the word or device of a mark plus likelihood of confusion is equal to similarity of the mark. Where determination is made on whether two marks are similar or not before court, account should be taken of the factors, such as the extent of similarity of the two marks *per se* and the distinctive character and repute of the prior mark and the extent of association of the goods or services in respect of which the marks are used. With comprehensive account taken, the likelihood of confusion on the part of the relevant sector of the public serves as the substantial criterion for the assessment.

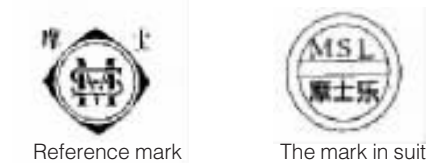
(2) Assessment of similarity of words or devices of marks (comparison of a mark as a whole with account taken of distinctive character)

1. For a mark of combination, considering the important role of the word part to refer to the mark in distribution of

goods, the word part may generally be taken as the distinctive part. In assessment of similarity, comparison is made of the marks as a whole with focus on the distinctive character.

Views of the TRAB and the courts are not divided on the assessment criteria in practice.

In the case involving "MSL" mark, it could be determined that the distinctive parts of the two marks were their respective word part. Given that the distinctive part "MSL" of the mark in suit differed from that of "MS" in the reference mark in one letter or character, the two marks were not very much different in reference. So, while the two marks differed as a whole to a certain extent, both the TRAB and the court held that they constituted similar marks<sup>13</sup>.



2. The word part does not naturally constitute the distinctive part. If the word part is not distinctive in a mark as a whole, or said word part *per se* does not have distinctive character, then, it is not a distinctive part. Comparison is made for similarity with account taken of the other parts.

But the TRAB and the court have split view to an extent in applying the criteria.

In the case involving the mark "HOUSHI 1818", both the reference mark and the mark applied for registration contained "1818", but considering that the part is too small a portion in the reference mark for it to arouse a consumer's attention, it was not determined as the distinctive part of the reference mark. Accordingly, while the mark in suit also contained the "1818" part, where the two marks were very much different as a whole, the court did not hold them similar<sup>14</sup>. In the case, however, the TRAB made a different decision, holding that the reference mark consisted of English letters "BYB" in a graphical form and the numerals "1818" and the English letters "BYB" were not easy for consumers to read; hence "1818" was the main part for consumers to refer to the reference mark. Accordingly, the TRAB held the two marks similar<sup>15</sup>.



In another case involving the Chinese characters pronounced "hui zhuang", the court held that the Chinese char-

acter “hui” in the reference mark and the mark in suit was another name for “Anhui province”, a geographic name in Chinese. Its use in a mark would also cause the relevant sector of the public to believe that it was used to show the place where the goods were made or the services provided. For that reason, it was not the distinctive part. Accordingly, the distinctive part of the reference mark was the device part thereof. By contrast, the distinctive part of the mark in suit was the Chinese character “莊” (pronounced “zhuang”); hence the two marks were not similar<sup>16</sup>. The distinctive part as determined by the TRAB was not the same as that by the court. For the TRAB, the character “zhuang” usually meant “village”, “a large shopping mall” or “a whole-sale centre”. It was not distinctively distinguishing when used as a mark in respect of alcoholic goods. The character “hui” used in the mark in suit was identical with the main reference part of the reference mark in pronunciation, form and meaning. When both used in the market, they were likely to create confusion on the part of the relevant sector of the public<sup>17</sup>.



Reference mark



Mark applied for registration

For the court, while in respect of alcoholic products, the Chinese character “zhuang” was a lexical item of less distinctivity, compared with the geographic name “hui”, and under the circumstance where the character “zhuang” used here was not a standard one in current Chinese in mainland China, this character was evidently more distinctive. Since the case involved the ground mentioned in Article 28, not Article 11 concerning distinctive character, comparison had to be made between the character “zhuang” and the device of the reference mark.

3. If a mark under reexamination is identical with or similar to a reference mark in the distinctive part, or the former contains a word or device identical with or similar to the latter, and said word or device is also the distinctive part in the former, then the two may be held similar.

The TRAB has followed the above criteria in most cases it has handled.

In the case involving the mark of the Chinese characters pronounced “Lulubao”, the reference mark substantially contained the mark applied for registration, and this part was also the distinctive part of the reference mark. In the case,

both the TRAB and the court held that the two were similar marks.<sup>18</sup>



Reference mark

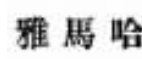


Mark applied for registration

In the case involving the mark “YAMANHA”, “YAMANHA” was the distinctive part of the mark under opposition. Where said distinctive part was similar to the reference marks, it could be said the mark under opposition contained the reference marks, then they were similar; hence the TRAB and the court did not allow the mark under opposition to be registered as a mark.<sup>19</sup>



Reference mark 1



Reference mark 2



Mark under opposition

But in some other cases, the TRAB followed different criteria in making its determination.

As was in the case involving the “SHYEN and device” mark, it could be held that the mark under opposition substantially contained the reference mark, and said part was, in addition, the distinctive part in the mark under opposition; hence the court held the two marks similar<sup>20</sup>. But the TRAB took a different view, believing that the two marks were obviously different in composition, appearance, meaning and reference, and determined them as dissimilar<sup>21</sup>.



Reference mark



Mark under opposition

**(3) Factors to be considered in determining likelihood of confusion**

1. Characteristics of goods or services in respect of which a mark is designated or approved to be used

Likelihood of confusion is determined from the perspective of the relevant sector of the public. Given that the different characteristics of different goods or services draw different attention from the relevant sector of the public to the word and/or device of a mark, determination made on the similarity of the identical word or device of two marks used in different goods or services is also different.

For example, as regards two goods or services of great difference in price, the relevant sector of the public naturally pay different attention to the word and/or device used in

them. Auto consumers usually pay more attention to the word and/or device of a mark used in automobiles than to those in goods for daily use. The same word and/or device of a mark used in daily necessities is likely to create confusion among consumers, but it is unlikely to when used in automobiles.

For example, the “H”-shape marks for Honda and Hyundai, relatively similar though, is unlikely to create confusion.

Besides, depending on the different proportion taken by a word or device *per se* in the goods, the relevant sector of the public will identify the similarity of the word or device used in goods or services differently.

The TRAB and the courts take somewhat different views on the matter.

In the Longines case, the word and device of the two marks involved in the case were indeed different, and they could be held dissimilar when used in respect of some ordinary goods. But when the marks were designated to be used in goods of clocks and watches, especially in the goods of watches, the word and device took a rather small portion of such goods, so the difference between the two marks in suit would not have distinctive visual impact on consumers. The court held the marks similar when used in respect of goods of clocks and watches in class 14<sup>22</sup>, and thus did not uphold the TRAB’s adjudicative decision.



Reference mark



Mark under opposition

## 2. Repute of reference marks

Repute is one of the factors having impact on mark similarity assessment. Consumers identify, to a different extent, marks of varied repute. Compared with a mark devoid of repute, a somewhat reputable mark makes a relatively deep impression on consumers, and is more likely to cause confusion.

In many cases, the TRAB and the courts would take account of the repute of marks in determination of similarity of marks.

As in the case involving the “亚斯嘉鳄 (pronounced “ya si jia e” in Chinese) YASIJIAE” mark, the reference mark was the relatively reputable “鳄鱼” (Chinese translation of the “LACOSTE”) mark owned by the French Lacoste Shirt Inc.. As was shown in the comparison between the two marks

without considering the repute of the reference mark, they were considerably different. But the TRAB and the court both took account of the factor of repute of the reference mark when making the comparison for similarity, and decided that the distinctive part of the mark applied for registration was the Chinese word for crocodile, and thus held the two marks likely to create confusion and similar when used simultaneously. The mark applied for registration was refused<sup>23</sup>.

But in some cases, the TRAB and the court took different views.

As was in the case involving the “梦特仙女” (pronounced “meng te xian nu” in Chinese) mark. The TRAB made comparison for similarity with respect to the word and device of the mark, and held that the mark under opposition was not similar to the “梦特娇” (Chinese translation of the “MONTAGUT”) mark. While the court did not establish the reference mark as a well-known mark, the court took consideration of the repute of the mark to a certain extent, and decided, on the basis of this, the use of the mark under opposition was likely to create confusion on the part of the relevant sector of the public about the source of the goods, and the two marks constituted similar marks in respect of identical goods<sup>24</sup>. Therefore, the court did not uphold the TRAB’s adjudication.

In the case involving the mark “XK-III”, the TRAB also believed that the mark under opposition was not similar to the reference mark “SK-II”. But the court held that the “SK-II” mark was somewhat reputable and likely to create confusion, and decided that the two marks were similar<sup>25</sup>.

## 3. Geographic factor

In determining likelihood of confusion, consideration should also be taken of whether the proprietor of the prior reference mark and one of a mark under reexamination are domiciled in the same region under some circumstances. The reason for considering the geographic factor is that while the exclusive right to use a registered mark is a national right, not subject to specific geographic limitations, in the real business activities, the range of only few marks cover the whole country, and most marks are used within the regions where the mark registrants are domiciled or in their proximity; hence the courts take the view that if the proprietor of a mark in suit and one of the prior mark are domiciled in the same region, then the relatively relaxed criteria should be followed in judging similarity.

In some cases, the TRAB considered the geographic factor.

As was in the case involving the “Luo Binwang” (written as “骆宾王” in Chinese) mark and the reference mark “Binwang” (written as “宾王” in Chinese). Given the fact that “Luo Binwang” was the name of a famous poet in ancient China, the two marks, though identical in two Chinese characters, were generally taken as different by relevant sector of the public, and it is very possible for the two marks to be determined as dissimilar. Specifically in respect of this case, however, the TRAB, considering the matter in connection with the geographic factor, took the view that both proprietors of the two marks were domiciled in Yiwu, Jiangsu Province, China, Luo Binwang was a native there, and several places and institutions there were named after “Binwang” in the region, so the TRAB believed that the two marks were likely to cause confusion, and held them similar. The court upheld the TRAB’s decision<sup>26</sup>.

But in some other cases, the TRAB and the court held different views.

As was in the case involving the “Yiya Qiulin” (written as “伊雅秋林” in Chinese) mark. While the registrant of the mark under opposition and the one of the “Qiulin” and device mark were domiciled in the same region, the TRAB considered more of the difference in the words of marks involved, holding the two marks considerably different in words and unlikely to cause confusion; the two were not similar<sup>27</sup>. The court considered the geographic factor in its judgment of similarity, and also considered that the registrant of the mark under opposition and proprietor of the reference mark belonged to the same corporate group, and the reference mark was relatively reputable in the region, so it held them similar despite their difference to a certain extent<sup>28</sup>.

## IV. Determination of similarity of goods

### (1) Law basis

Article 11 of the Interpretation by the Supreme People’s Court of Several Issues Relating to Application of Law to Trial of Cases of Civil Disputes over Trademarks: The similar goods shall refer to goods that are identical in function, use, manufacturer, channel of commerce and target consumers or goods that the relevant sector of the public generally think are related in a particular way or are likely to cause confusion. The similar services shall refer to services that are identical in purpose, content, mode or object or services that are identical in objective, content, mode and target consumers, or service that is likely to cause confusion. The similarity of

goods and services means that the goods or services are related to each other in a particular manner, which is likely to cause confusion on the part of the relevant sector of the public, as is the case with goods of cosmetics, beauty saloon services, goods of jewelries and fabrication of jewelries.

Article 12: The people’s court shall establish whether or not a goods or service is similar in the light of the comprehensive assessment based on the average perception of the relevant sector of the public of the goods or service. The International Classification of Goods and Services for the Purpose of Registration of Marks and the Classification for the Purpose of Distinguishing Similar Goods and Services may serve as the frame of reference for establishing similar goods or services.

### (2) Judgment criteria

As the preceding provisions show, the core issue in determining similarity of goods or services is the likelihood of confusion of the relevant goods or services on the part of the relevant sector of the public. But given that goods of different classes *per se* are unlikely to cause confusion, what would be confused are possibly the providers of the goods or services. For this reason, the criteria should be understood as follows:

Whether use of an identical mark in respect of goods or services of different class is likely to create confusion among the relevant sector of the public about the sources of goods or services (they would wrongly believe that the goods or services come from the same market player or associated market player). If it is, the marks should then be determined as similar, or they are not.

As a supplementary means for assessing the similarity of goods or services, the Classification of Similar Goods or Services has been worked out with considerable consideration taken of the objective attributes of goods or services in classification of similar goods or services, but it is impossible for it to present an absolutely accurate classification of the goods or services of all classes now available. For this reason, while the goods or services in one class in the Classification can be determined as similar goods or services, comparison of goods or services put in one class may show, in practice, that they are not by comparing all of them, or vice versa. That is, it is also possible for goods or services not put in the same class to be similar. The Classification has its kernel role in the phase of preliminary examination of marks. The preliminary examination proceedings are mainly for screening marks applied for registration. Marks that have passed

the preliminary examination and comply with the Trademark Law are preliminarily published. Given the main function of the preliminary examination proceedings and considering the huge number of marks to be preliminarily examined, only by examining them according to the Classification is it possible for the examiners to finalise the preliminary examination of all of them within the shortest possible time.

In the reexamination and judicial procedures, however, with specific marks in suit, the issue to be addressed is a specific one of dispute, not fast examination and grant of registration. For that reason, the court believes that in the two procedures, while consideration should be given to the Classification and, as well, to the determination of the similarity of goods or services from the perspective of objective attributes of goods or services as much as possible, in order to make a due assessment of similar goods or services, without being limited to the provisions of the Classification. Meanwhile, on the level of specific prosecution, the practice is objectively workable.

To sum up, the court takes the view that the Classification of Similar Goods or Services should be used as a reference only in the trademark reexamination and judicial procedures.

#### **(4) Factor likely to be considered**

1. Relationship between relevant goods or services and corresponding relevant sector of the public

The premise to determine similar goods or services is that the goods or services are provided in substantially identical scope of the corresponding relevant sector of the public, or the relevant sector of the public of the goods or services in respect of which a later mark is used substantially falls within the scope of the relevant sector of the public of the goods or services in respect of which a prior mark is used.

The similarity of goods is determined from the perspective of the relevant sector of the public and on the basis of the core criteria of likelihood of confusion. As regards different goods or services, only when the scope of relevant sector of the public of goods or services bearing a later mark is, in principle, smaller than that of the relevant sector of the public of the goods or services bearing a prior mark is it possible for the relevant sector of the public of the later goods or services to be cognitively capable of identifying the goods or services bearing the prior mark, otherwise it would cause some of the relevant sector of the public of the later goods or services to identify the goods or services bearing the prior

mark. In case like this, even if the same mark is used for the two goods or services, in respect of the later goods or services, the confusion among the relevant sector of the public as a whole is unlikely.

Take “automobiles” and “auto parts” for example, the relevant sector of the public of the former are ordinary consumers while those of latter auto repair and maintenance businesses. Since such businesses are also consumers of the goods of automobiles and only a small part of the auto consumers are auto repair and maintenance businesses, the latter as a whole are included in the former. Then, if a reference mark is used in respect of goods of automobiles, it is possible to be a barrier to a later used mark applied for registration in auto parts. Conversely, however, if a reference mark is used in respect of auto parts, it, in principle, is unlikely to block the registration of a later mark in respect of automobiles.

As was in the case involving “Touran”<sup>29</sup>, the TRAB decided that the mark applied for registration and the reference mark were similar in the designated goods. However, the court held that, comparing the goods of machine-driven land, air, water and rail crafts, trucks, cars, and jeeps the mark applied for registration was designated to be used with the goods of “auto parts” the reference mark was designated to be used, and given that the consumers of the latter were mainly the end users of automobiles while the former were mainly manufacturers and repair and maintenance businesses of automobiles, the scope of the former was larger than that of the latter. Besides, most of the former were unable to identify the goods of auto parts and the manufacturers and businesses thereof. Hence, even if the mark applied for registration was identical with the reference mark, most consumers of the designated goods bearing the later mark applied for registration would not normally think the two marks belonged to the same market player. Based on this assumption, the court held the goods dissimilar<sup>30</sup>.

2. Relevant sector of the public's identification of the relevant goods or services

This means whether the relevant sector of the public, with their cognitive capability, would believe that two classes of goods or services are likely to be made available by the same provider. The judgment is made on the basis of identification of the special characteristics, function, and channel of commerce of the goods or services.

For example, the relevant sector of the public of the goods of “beer” and “alcoholic drinks (except beer)”<sup>31</sup> is



substantially the same. It is quite possible for the relevant sector of the public to believe that a beer manufacturer or brewer also makes other alcoholic drinks. Therefore, use of the same mark in respect of these two goods would be likely to create confusion among the relevant sector of the public. Therefore, said two kinds of goods, though in dissimilar classes, also constitute similar goods.

But a diametrically different conclusion would be drawn with regard to “cigarettes” and “beer”<sup>32</sup>. While the relevant sector of the public of the two classes of goods are roughly the same, as far as the relevant sector of the public know it, a cigarettes manufacturer generally does not make beer; hence they are dissimilar goods.

As for the above discussed “automobiles” and “auto parts”, the reason for believing that if the goods bearing a prior registered mark were automobiles, it would block the registration of the later mark in respect of auto parts. Besides considering of the scope of the relevant sector of the public, consideration is also taken of the fact that the relevant sector of the public were likely to believe that it was possible for an auto maker to make auto parts, but it is less possible the other way round.

## V. Understanding of “by fraud or any other unfair means” mentioned in Article 41, paragraph one of the Trademark Law

“By fraud or any other unfair means” has long been understood in different ways in practice. For one view, it is only an absolute ground relevant to trademark registration; for some other view, it is not only an absolute ground, but also an encompassing clause of provision with respect to relative grounds. But, the Supreme People’s Court now takes the view that, in its practice, it is only an absolute ground.

As in the Notification on Refusing “Chenglian” (written as “诚联” in Chinese) mark<sup>33</sup>, the Supreme People’s Court expressly pointed out that “the circumstance of securing registration by fraud or any other unfair means involved the absolute ground for cancellation of trademark registration”. Acts of the nature are detrimental to the public order or interests, or disruptive to the order of registration and administration of marks.

In the retrial judgment in the case involving the “Sanlietong” (written as “散列通” in Chinese) mark<sup>34</sup>, the Supreme

People’s Court expressly pointed out that “the circumstance of securing registration ‘by fraud or any other unfair means’ involved the absolute ground for cancellation of trademark registration”.

In case like this, we are going to, in the judicial practice in the future, follow this principle in our application of the provision. That is, the provision is applicable to the examination under Articles 10–12 of the Trademark Law. Since said provision is no longer an encompassing relative ground provision, correspondingly, the application of other relative ground provisions will be extended to an extent.

## VI. Determination of “shall not infringe another party’s existing prior rights” under Article 31 of the Trademark Law

Controversy has long been going on over the scope of the “prior rights”. But as the practical cases show, the prior rights now mainly involve the statutory rights (the copyright and design patent right), rights and interests (in well-known trade name, and trade dress of well-known goods or services). There is no disagreement in the administrative and judicial procedures as to the fact that these rights and interests constitute the prior rights under Article 31 of the Trademark Law.

### 1. The special law provisions as the criteria for making determination

Application of the provisions involves mainly two issues: how to determine a party’s prior right and how to determine constitution of injury or damage.

Regarding the determination of a prior right and constitution of damage, the court takes the view that they should both be based on the specific provisions of the special laws. For example, whether the rights and interests of a prior trade name are constituted and whether the registration of a mark under reexamination constitutes an infringement of them should be determined or judged under the relevant provisions of the Unfair Competition Law. Whether infringement of the rights and interests of a prior patent right is constituted should be determined under the specific provisions of the Patent Law. The same is true for other prior rights.

The elements required for establishing infringement should also apply to the determination of injury or damage. While pure registration of a mark usually does not constitute an infringement of another party’s prior right, given that

trademark registration is generally for the purpose of using the mark, the objective of the provision is to prevent conflict of the relevant rights from arising. To this end, in determining damage, whether an act of using said mark constitutes an infringement of the prior rights should be decided on the supposition that the mark has been put to actual use.

### 2. Business indication right

In practice, the court is usually not different from the TRAB in its determination of the business indication right and confirmation of the damage standards.

As is in the case involving the “Xiyue” (written as “喜悦” and meaning “happy” in Chinese) mark.<sup>35</sup> The TRAB expressly pointed out that a prior trade name is protected under the provision that “no trademark application shall infringe another party’s existing prior rights” as set forth in Article 31 of the Trademark Law provided that said trade name has been registered earlier, has its own reputation, and another party’s registration of said trade name is likely to confuse the relevant sector of the public and causes prejudice to the interests of the prior trade name proprietor.

### 3. Patent right for design

Problem stands out in practice in determining infringement of a prior patent right for design for the reason that the criteria for determining infringement of the patent right for a design is different from those for determining trademark infringement, and the TRAB’s work does not involve patent right infringement. That is why differences arise in making the determination of the kind.

As was in the case involving the mark of “Wanhuatong” (written as “万花筒” and meaning “Kaleidoscope” in Chinese)<sup>36</sup>. The plaintiff had the prior patent right in the design of the poker package and the third party registered the mark of “Wanhuatong” in suit in the goods of poker. In the case, the TRAB took the view that “since the characters of the mark in suit obviously differed from those of the design patent in font, the mark in suit did not infringe the patent right for the design”. It was thus shown that what were compared in the determination were the word of the design and the word of the mark in suit, an approach usually used to establish trademark infringement, not that of a design patent, in which the specific products were compared, not merely a particular design of the product. In the present case, the comparison should be made between the poker bearing the mark and the whole poker incorporating said design element to see whether their difference would have noticeable visual effect on consumers, but not between the corresponding parts of

the mark and the design. Nonetheless, while the criterion by which the TRAB makes its determination would yet to be improved, its conclusion was by no means undue.

Besides, given that establishment of infringement of the patent right for a design is based on a product, if the goods in respect of which a mark is used are not identical with or similar to the patented product incorporating a design, it is difficult for a registered mark to constitute an infringement of the patent right even if the registered mark is exactly identical with the design of the prior design patent.

### 4. Copyright

#### (1) Criteria for making determination

Problem also stands out in practice in determining infringement of a copyright. In principle, the criteria for determining infringement of the copyright should certainly apply to the determination of infringement of a prior copyright. That is, it should first be determined whether the subject matter an applicant claims constitutes a work and whether it enjoys the copyright therein, and then determine whether it constitutes a copyright infringement by applying the criteria for determining the access to, and substantial identity with, the copyrighted work.

Determination of whether a subject matter constitutes a work is a complex matter. But, in principle, a work should have certain originality. As long as it is independently created, a work is susceptible to the protection under the Copyright Law. There is, however, a precondition for the protection, that is, there exists no prior work identical with or similar to it, or it is coincident, that there exists a work identical with or similar to it, otherwise, the work is precluded from the protection under the Copyright Law.

As for the principle of being accessible and substantially identical in establishing infringement, the requirement of “access” is deemed to be met by the potential, not practical access. Generally, so long as another party’s work has been published earlier, it is then presumed that it is possible for the author of a later work to have access thereto. Where it is determined that it is possible for the author of a later work to have the access under the above principle, a reexamined mark’s being highly identical with a prior work, without the possibility to rule out the coincidence, may also prove, from another perspective, the accessibility. Determination of substantial identity means the examination of whether the original part of a prior work has been used in a mark under re-examination. If yes, the mark is held substantially identical. Protection of the copyright is closely related to the degree of

originality. The more original, the more enhanced protection, the easier to determine the substantial identity, and vice versa. Only if a mark is substantially identical or very similar is it possible to hold it substantially similar.

As was in the case involving the “small-bird device” mark of Auchan Group. The disagreement between the TRAB and the court lay in whether it might be determined that the third party the Jinjiang Aidu Corporation was possible to have access to the work before it applied for the registration of the mark under opposition. For the TRAB, in the case no evidence showed that the third party ran into or had access to the copyrighted work of the “small-bird device” of the Auchan Group.<sup>37</sup> But the court held that since Auchan secured international registration of the mark “Auchan, A and the small bird device” in 1988, it was possible for the third party to know about it through the public channel. With the fact that the device part of the mark under opposition was identical with the plaintiff’s copyrighted work of “A and the small bird device”, it could be determined that Jinjiang Aidu had access to the plaintiff’s work of “A and the small bird device” before applying for the registration of the mark under opposition<sup>38</sup>.



Reference mark



Mark under opposition

(2) For the same two marks, different conclusions are likely by applying the criteria for establishment of copyright infringement or the criteria for assessment of trademark similarity.

The two marks below are similar. But if they are determined by applying the criteria for establishment of copyright infringement, suppose the reference mark constitutes a work, it is possible for the mark under reexamination not to constitute an infringement of the copyright because the reference mark is a real depiction of the basic shape of kangaroo with a low level of originality under less protection. Therefore, only when the mark in suit is very much similar to the reference mark is it possible to hold it infringing the copyrighted work. As the comparison between the two showed, they were similar in the basic shape of kangaroo, which falls outside the scope of copyright protection, and the original part of the mark under reexamination did not appear

in the reference mark. Accordingly, judged by applying the criteria for establishment of copyright infringement, the mark under reexamination did not infringe the copyright in the reference mark.



Reference mark



Mark under reexamination

For the same reason, the two marks involved in the case involving the word marks in Chinese for “crocodile” are similar. But it is impossible for a claim against infringement of a prior copyright to be tenable.



Reference mark



Mark under reexamination

## VII. Determination of “registering by an unfair means a mark that is already in use by another party and has certain influence” under Article 31 of the Trademark Law.

The provision is meant to prohibit any act of registration of a mark in bad faith. For it to be applicable, three conditions should be met, namely “prior use”, “having certain influence” and “by unfair means”. The three conditions are interrelated, and each should not apply in isolation. To be specific, “certain influence” is secured only through “use”. Only if a registrant knows or has the reason to know that a prior used mark has “certain influence” and registers it is it possible to determine constitution of “by unfair means” “Having certain influence” should be determined with account taken of whether the registrant of a later mark knows about the “influence”. High standard should not be set in this regard in an absolute way or in isolation. The court takes the view that, generally speaking, if the region of the repute of a prior mark covers the region where the later mark registrant is domiciled, it is possible to infer that the later mark registrant knows about the repute of the prior mark. Under this circum-

stance, it is possible to be determined that the act of registration of the later mark registrant is one “by unfair means, and the registration is one secured in bad faith.

In practice, the TRAB has dealt with most cases by this standard, with all the above factors considered.

As was in the case involving the mark of “Yawang” (written as “鸭王” and meaning “duck king” in Chinese). The TRAB was not different from the court in following the standard for the application of the provision. Their difference lay in the determination of the fact of whether the Shanghai Quanjude Corporation knew about the repute of the “Yawang” mark. For the TRAB, the available evidence was not sufficient to prove that the Shanghai Quanjude Corporation knew about the prior “Yawang” mark of the Beijing Yawang Corporation when it was applying for the registration of the mark under opposition and filed its application by unfair means<sup>39</sup>. The court held that exchange between Beijing and Shanghai was so frequent that it was impossible for any reports in the press and commercials in Beijing to have influence only in Beijing”. “Both the Shanghai Quanjude Corporation and the Beijing Yawang Corporation were businesses in the same business of roasted duck restaurant, and the former had reason to know about the use and repute of the “Yawang” mark of the latter”. In this case, the court decided that the Shanghai Quanjude Corporation’s registration was contrary to the provision concerning prohibition of registration in bad faith of Article 31 of the Trademark Law.<sup>40</sup>

But, there are also some cases where the TRAB separately determined “having certain influence” and “by unfair means”.

As was in the case involving the mark of “Sony-Ericsson”. The TRAB, after holding that said mark was not one that was already in use and had certain influence, went on to decide whether the unfair means existed<sup>41</sup>.

The court, by contrast, made its decision with the two elements combined, holding:

“Liu Jianjia filed an application for registration of the mark in suit in respect of the goods, such as telephone sets, when he knew about the “Sony-Ericsson” mark the Sony-Ericsson and Sony-Ericsson (China) Corporation owned and the influence it had; it had performed its act obviously by unfair means.”<sup>42</sup>

While in the second-instance trial, the Beijing Higher People’s Court upheld the registration of the reexamined mark, the Court made another decision not on the ground that it disagreed to the above adjudicative principle. Rather,

it held that the Sony-Ericsson was unable to prove its prior use of the “Sony-Ericsson” mark<sup>43</sup>.

## VIII. Understanding and application of “use of a registered mark has ceased for three consecutive years” of Article 44 (4) of the Trademark Law.

### 1. Relationship between the “use” in the Article and the “use” in Article 3 of the Regulations for the Implementation of the Trademark Law

Article 3 of the Regulations for the Implementation of the Trademark Law provides that the use of the trademark, as referred to in the Trademark Law and these Regulations, shall include the use in respect of goods, packages or containers of the goods or in trading documents, and the use of the trademark in advertising, exhibition or any other business activities.

In practice there is a view that the word “use” in this provision means the same as the word “use” in Article 44 of the Trademark Law. Regarding this, the court takes the view that while the word “use” is used in the two provisions, it does not mean the same in the two provisions. The “use” used in Article 3 of the Regulations for the Implementation of the Trademark Law is directed to acts of trademark infringement, that is, to the acts provided for in Article 52 of the Trademark Law. If an alleged infringer commits an act mentioned in Article 3, the act can be determined as an infringement of a trademark under Article 52 of the Trademark Law. But mere existence of said act is not naturally to be established as “use” as mentioned in Article 44 of the Trademark Law.

### 2. Understanding of the “use” in “use of a registered mark has ceased for three consecutive years”

(1) The act of use should be a true act of use in market distribution or circulation.

Since a mark functions to show the sources of goods or services, and this function is normally embodied in the distribution or circulation of goods or services, it is required that this act of use generally be use in the open business circulation, so that it is known to the relevant sector of the public. An act of use inside a business should not be determined as the use as such.

In practice, the TRAB determines “use”, in most cases, according to the preceding criteria.

As was in the case involving the mark of “莊吉 (translation of “GEORGE” and pronounced “zhuang ji” in Chinese), GEORGE and the device”, in which George presented the evidence showing the reexamined trademark made by another party under entrustment, photos of the clothing bearing said mark, certificate of loan hypothecation with the mark, and envelopes and employees’ badges bearing said mark. The TRAB did not think they could prove that said mark under reexamination had been already in use in the sense of the Trademark Law, so it cancelled the mark.<sup>44</sup> The court took the same view as the TRAB<sup>45</sup>.

In some other cases, however, the TRAB and the court often held different views.

As was in the case involving the mark of “KANG-WANG”. The evidence from the Yunnan Dianhong Corporation mainly included evidence 3: the pack of “KANGWANG” brand skin-care cream; evidence 5: contract for supplying said pack; evidence 6: proofs of associated material for making said cream; and evidence 17: package of “KANG-WANG” detergent. The case was rather similar to the George case in the absence of any evidence showing distribution of the goods in the market. But the TRAB was relatively lax in understanding the “use” in the case, deciding that from the above evidence it could be determined the existence of its intent to use, and actual use of, the mark under reexamination<sup>46</sup>. The court made a different decision. The court accepted evidence 17 as authentic, and believed, on the basis of this, that the other pieces of evidence could not prove that the goods bearing the mark in suit had been put on the market<sup>47</sup>.

The case also involved an issue of great contraversion, namely, whether the use mentioned in the provision is limited to the act of lawful use and whether the “lawful use” is limited to the “use” as mentioned in the Trademark Law.<sup>48</sup> In the first-instance judgment in the case, the court took the view that act of use had to be one of lawful use 48, but after the second-instance trial and retrial of the case, the Supreme People’s Court specified that the act of use mentioned in the provision of the Trademark Law should be lawful use, not merely use in compliance with the Trademark Law. In other words, even if the mark under reexamination is already in use in the market, if it is an unlawful act of use, then the “use” should not be held to be the “use” as provided for in Article 44.

(2) Use of mark must be standard use of a registered mark.

Article 22 provides that where the sign of a registered mark needs to be altered, a new registration should be applied for. Article 51 of the Trademark Law provides that the exclusive right to use a registered trademark is limited to the trademark that has been approved for registration and to the goods in respect of which the use of the trademark has been approved. Accordingly, use of a registered mark should be subject to the limitation on use of the sign applied for registration and in respect of the approved goods or services.

a. Use of sign of a mark does not change distinctive character

As far as the sign of a mark is concerned, change of the sign does not naturally result in invalidity or cancellation of the mark. The key lies in the change of the distinctive character of the mark. If a use does not change the main part and distinctive character of a mark, it may be determined as use of a registered mark.

b. Use in respect of class of approved goods or services.

A registrant’s use of its mark in respect of some of the approved goods may be an extended use of the mark in respect of the similar goods within the scope of the approved goods. But use of a mark under reexamination in respect of non-approved goods or services cannot be determined as use of said mark even if these goods or services are similar to the approved goods or services.

In practice, one view on the issue is that use of a mark in respect of goods similar to the approved goods may be determined as an act of use, regardless of whether the goods fall within the scope of the approved goods or not.

As was in the case involving the mark “GNC”, the mark proprietor argued that, while “honey” was not an approved goods, the goods and the approved goods “nutritious fish oil for non-medical use”, both in class 3005, were similar goods, and its use of the mark in respect of the goods of honey could be deemed to be use of the mark in respect of the approved goods “nutritious fish oil for non-medical use”; hence the registration of the mark should be kept valid. Both the TRAB and the first-instance court supported the argument.

But the second-instance court held that since the package and handbag bearing the sign of “GNC” were used in respect of honey products, such as “honey”, but not use of the mark in respect of the approved goods of “nutritious fish oil for non-medical use”; therefore, it was not the use in the sense of the Trademark Law, and the court did not support the argument.<sup>49</sup>

After that, the TRAB applied the above standard to most cases it dealt with.

As was in the case involving the mark of “博奥” (Chinese characters pronounced “bo ao”), BOAO and the device”. Use of the mark under reexamination in respect of the goods of “vibrating massager” was use as such. The TRAB held that given that “the mechanic device of sports for medical use” was substantially identical with the “vibrating massager” in function and use, use of the mark in respect of goods of vibrating massager could be deemed to be use of the mark in respect of the mechanic device of sports for medical use.<sup>50</sup>

(3) Issue of determination in cases where the involved use went before the amendment made to the Trademark Law and its Implementing Regulations

The Regulations for the Implementation of the Trademark Law now in force has provided for cancellation of partial registration of a mark used in respect of some of the approved goods, but the former Implementing Regulations of the Trademark Law did not. As a result, the Trademark Office deems a mark registrant's use of a mark under reexamination in respect of one approved goods to be the use of said mark in respect of other goods. In other words, the administrative authority would keep valid the registration of a mark used in respect of all the approved goods before 15 September 2002 where the mark was used just in respect of some of them.

Given this, the court held that, if an act of use in this period was involved, it should be dealt with according to the understanding of the law in force at the time since in doing

things this way, no harm will be done to the established reasonable trust interests of the mark registrant.

The matter was involved in the case involving the “博奥 BOAO and device” mark. The TRAB and the court had split views. In the case, the TRAB only kept valid the registration of the reexamined mark in respect of the goods in respect of which said mark was actually used and the similar goods. For the TRAB, while, in the past practice, the Trademark Office took the view that with evidence of use of a mark under reexamination in respect of some goods, said mark would be deemed to be in use in respect of all the other goods, but this practice did not comply with the aim of the legislation of the Trademark Law<sup>51</sup>. For the court, an administrative authority's enforcement is based on the standards that enable a mark registrant to pretty much predict the legal consequence, and has made it possible for a mark registrant to have a reasonable prediction and trust. Since the present case involved the judgment and handling of the issue of whether the mark under the reexamination was used between 22 July 1999 and 21 July 2002, it was addressed under the enforcement standards in force before the Regulations for the Implementation of the Trademark Law went into force, or the fairness doctrine would not be complied with. Under the circumstance, the court kept valid the registration of the mark under reexamination in respect of all the approved goods<sup>52</sup>. ■

The author: Judge of the IP Tribunal of the Beijing No.1 Intermediate People's Court

<sup>1</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1145/2006.

<sup>2</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1148/2005.

<sup>3</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 199/2006.

<sup>4</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 202/2007

<sup>5</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 234/2009.

<sup>6</sup> See the Beijing No.1 Intermediate People's

Court's Administrative Judgment No. Yizhongxingchuzi 235/2009.

<sup>7</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 438/2008.

<sup>8</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 349/2006.

<sup>9</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 607/2006.

<sup>10</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1751/2008.

<sup>11</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No.

Yizhongxingchuzi 533/2008.

<sup>12</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 436/2006.

<sup>13</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1446/2008

<sup>14</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1475/2008.

<sup>15</sup> See the TRAB's Decision (No. Shangpingzi 07845/2008) on Reexamination of Refusal of the “HOU SHI 1818” MARK (3496292).

<sup>16</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 183/2009.

<sup>17</sup> See the TRAB's Decision (No. Shangpingzi 16899/2008) on Reexamination of Refusal of the "Huizhuang" mark (4710203).

<sup>18</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1265/2008; the TRAB's Decision (No. Shangpingzi 3512/2008) on Reexamination of Refusal of the device mark (3955569).

<sup>19</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1095/2008; the TRAB's Decision (No. Shangpingzi 5666/2008) on Reexamination of Refusal of the "亚曼哈 YAMANHA and device" mark (1756371).

<sup>20</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1037/2008.

<sup>21</sup> See the TRAB's Decision (No. Shangpingzi 06544/2008) on Reexamination of Refusal of the "SHYEN and device" mark (3142559).

<sup>22</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 17/2008.

<sup>23</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 663/2008; the TRAB's Decision (No. Shangpingzi 1188/2008) on Reexamination of Refusal of the "亚斯嘉鳄 YSI-JAE" mark (3106931).

<sup>24</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 344/2008; the TRAB's Decision (No. Shangpingzi 1418/2007) on Reexamination of Refusal of the "梦特仙奴" mark (1271126).

<sup>25</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 600/2008; the TRAB's Decision (No. Shangpingzi 11244/2007) on Reexamination of Refusal of the "SK-III" mark (1317651).

<sup>26</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 378/2008.

<sup>27</sup> See the Beijing No.1 Intermediate People's

Court's Administrative Judgment No. Yizhongxingchuzi 681/2008.

<sup>28</sup> See the TRAB's Decision (No. Shangpingzi 4378/2008) on Reexamination of Refusal of the "伊雅秋林" mark (3612653).

<sup>29</sup> See the TRAB's Decision (No. Shangpingzi 13002/2008) on Reexamination of Refusal of the "途安 Touran" mark (4108302).

<sup>30</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 431/2009, judgment made in *Wolks wag v. TRAB*.

<sup>31</sup> See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 417/2007.

<sup>32</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 219/2003.

<sup>33</sup> See the Supreme People's Court's Rejection Notification No. Xingjianzi 118-1/2006.

<sup>34</sup> See the Supreme People's court's Retrial Judgment No. Xingtizi 1/2009.

<sup>35</sup> See the TRAB's Decision (No. Shangpingzi 00200/2008) on Reexamination of Refusal of the "喜悦" mark (1554296); the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 365/2008.

<sup>36</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 439/2006.

<sup>37</sup> See the TRAB's Decision (No. Shangpingzi 04708/2008) on Reexamination of Refusal of the device mark (1275939).

<sup>38</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1302/2008.

<sup>39</sup> See the TRAB's Decision (No. Shangpingzi 2831/2007) on Reexamination of Refusal of the "鸭王" mark (3083416).

<sup>40</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 966/2007.

<sup>41</sup> See the TRAB's Decision (No. Shangpingzi 11295/2008) on Reexamination of Refusal of the "索爱" mark (3492439).

<sup>42</sup> See the Beijing No.1 Intermediate People's

Court's Administrative Judgment No. Yizhongxingchuzi 196/2008.

<sup>43</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 717/2008.

<sup>44</sup> See the TRAB's Decision (No. Shangpingzi 5270/2008) on Reexamination of Refusal of the "莊吉 GEORGE and device" mark (879181).

<sup>45</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1034/2008.

<sup>46</sup> See the TRAB's Decision (No. Shangpingzi 2432/2008) on Reexamination of Refusal of the "康王" mark (738354).

<sup>47</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 1052/2006.

<sup>48</sup> The view had no actual impact on the TRAB's determination of whether it constituted the "use" mentioned the provision. It was stated in the judgment that "even if it is determined that the pack is real, it is unlawful use given the fact that the indication of the number of the certificate is contrary to the relevant law provisions, and the use is not protected under the Trademark Law; hence said use cannot prove the lawful use is not protected under the Trademark Law; hence said use cannot prove the lawful use of the mark under reexamination.

<sup>49</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 78/2006.

<sup>50</sup> See the TRAB's Decision (No. Shangpingzi 1679/2007) on Reexamination of Refusal of the "博奥 BOAO and device" mark (1294337).

<sup>51</sup> See the TRAB's Decision (No. Shangpingzi 1679/2007) on Reexamination of Refusal of the "博奥 BOAO and device" mark (1294337).

<sup>52</sup> See the Beijing No.1 Intermediate People's Court's Administrative Judgment No. Yizhongxingchuzi 891/2007.