Newsletter

Beijing RisingMark

Professional Intellectual
Property Manager

Add: Room 432, Zhongbei Investment building, Fangzhuang, Fengtai District Beijing, China; 100078;
Tel: 010-87642418

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➢ The Eighth Secretary Meeting of China, U.S., Europe, Japan and Korea Held in Suzhou, with Cooperation Agreement Signed

On May 22, the eighth secretary meeting of China, U.S., Europe, Japan and Korea Intellectual Property Office was held in Suzhou, Jiangsu province. Secretaries from the five offices signed the Cooperation agreement at the meeting.

Secretary of China's State Intellectual Property Office Shen Changyu presided the meeting. EPO President Benoit Battistelli, JPO technical supervisor Kihara, the Korean Patent Office Director Cui Donggui, deputy director of the US Patent and Trademark Office Russell Shriff attended the meeting. WIPO Deputy Director General John Sandage also attended the meeting as an observer.

The Cooperation agreement includes four parts: common ideology, services provided, current focus of work and cooperation activities by the five offices in future.

Review:

To solve the common serious problems of patent application surge and backlog of pending files, in 2007 IP institutions of the European Patent Office (EPO), the US Patent and Trademark Office (USPTO), the Japan Patent Office (JPO), the Korean Patent Office (KIPO) and China State Intellectual Property Office (SIPO) established a cooperation mechanism in these five countries / regions.

In the second meeting in October 2008 in Jeju Island of South Korea, the five offices defined the cooperation vision: "to eliminate unnecessary duplication of effort between the offices and improve efficiency and quality of patent examination, to ensure stability of patent ". The five offices considered "work-sharing" as important ideas and the main way for cooperation, with the "quality of timeliness" as a precondition for work-sharing.

Since 2007, a total of seven meetings have been held between Secretaries and thirteen meetings between Deputy Secretaries. Business cooperation has been expanded from ten basic projects at the beginning to dozens of projects under several working groups, many of which have significant international impact.

➢ SAIC: Well-known Trademark Recognition Adjusted from Non-administrative Approval Item to Administrative Adjudication Item

Notice on Adjustments to Relevant Approval Items

In accordance with the non-administrative approval items cleanup advice examined and adopted at the 91st State Council executive meeting, and the requirements by *Notice on timely adjustment & announcement of approval items by Approval Reform Office of the State Council* (S.G.B.H [2015] No.32), the administrative approval items to be adjusted by the SAIC are announced as follows:

1. The trademark registration is adjusted from non-administrative licensing approval item to administrative confirmation item;

2. The recognition of well-known trademarks is adjusted from non-administrative licensing approval item to the administrative adjudication item;

3. Special sign registration is adjusted from non-administrative licensing approval item to administrative confirmation item;

4. Special sign licensing contract record is adjusted from non-administrative licensing approval item to administrative confirmation item.

The above items are no longer among administrative approval items after adjustment, which are immediately removed from our approval directory. The above items will be further studied, checked up and standardized, combined with the list of department power by the State Council while promoting decentralization and administration by law.

Notice is hereby given.

General Office of the State Administration for Industry and Commerce

Issued on May 25, 2015

Reading by Li Chunya, lawyer from Unitalen:

Chinese Well-known Trademarks have developed from the overwhelming advertising honors to the specific provision that "well-known trademark shall not be used in advertising" by the new 2014 Trademark Law, from periodical approval and announcement of well-known trademarks before 2013 to today's administrative decisions, and from alienation of honor by the government to the substance of legal relief, which shows the well-known trademark recognition has returned to the nature of the law itself. The well-known trademarks recognized by administrative decisions are quasi-judicial, with legal consequence of administrative enforcement in the relevant administrative confirmation and authorization

cases in future, which is even directly applicable when it meets the standards of similar cases. Of course, changing the nature of administrative adjudication will reflect the principle of “passive protection of individual case recognition” of well-known trademarks, that is, the administration cannot take the initiative to recognize well-known trademarks, and the opposite party cannot make application by "only requiring well-known trademark recognition". Only when the interest of well-known trademarks is damaged or in dispute can a well-known trademark be claimed for recognition in specific cases, with the purpose of protecting well-known trademark rights, rather than the recognition itself. Of course, for administrative adjudication, except for those where administrtative decisions are final according to the statutes, the party may apply for administrative review or bring an administrative lawsuit.

➢ SIPO: Cloud Patent Examination System (CPES) Formally Launched

In order to facilitate the sharing of examination capacity among patent examination authorities and improve quality and efficiency of patent examination, the State Intellectual Property Office built and launched a cloud patent examination system (hereinafter referred to as "CPES"),which was formally launched on May 22, 2015. The system made functional improvement and upgrading based on cloud patent examination test system launched in June 2013 (hereinafter referred to as "test system"), bringing together the examination files, bibliographic information and publication text information from multiple examination authorities in the world, also providing system users with topic discussion, real-time communication and other forms of community communication functions.

CPES now covers patent examination information of 16 agencies from Chinese State Intellectual Property Office, the European Patent Office, the Japan Patent Office, the Korean Patent Office, the US Patent and Trademark Office, the United Kingdom, Australia and Germany. The system uses a new interface design and timeline display, with the establishment of various forms of channels to collect feedback information, to provide users with nine languages like Chinese, English, Spanish, Portuguese and Arabic, and the multilingual translation tool within the system enables translation between twelve languages like Chinese, English, Korean and Japanese.

Cases in Spotlight

➢ “Weixin.com” domain name ownership dispute and WeChat

January 29, 2015, Asian Domain Name Dispute Resolution Centre (ADNDRC) issued their arbitration decision (HK-1500816) on the complaint filed by Tencent Holdings Limited against “weixin.com” (the disputed domain) owned by Li Ming. The decision demands Li Ming transfer the disputed domain to the complainer, Tencent Holdings Limited.

“weixin.com” was registered in 2000 by Hai Shen Yang. After many transfers, the disputed domain name was owned by Li Ming. Although the initial intention of registering the disputed domain name is uncertain, from the related internet materials and arbitration decision, it’s known that the website associated with the disputed domain name still showed their Chinese name as “威信” (a different word also pronounced as “weixin” in pinyin) in 2011, while a screen snapshot taken in April 11, 2014 showed the name was changed to “微信” (WeChat name in Chinese). So it’s at least confirmed that the disputed domain had not and could not have established necessary and exclusive association with “微信” (WeChat) before 2011.

Tencent’s WeChat App came out in January 21, 2011, as a free real time communication service app provided to smart phone devices. Due to its user friendly design, it gained popularity swiftly and became one of the most important communication tools and a lifestyle among Chinese users. As of reported in the 3rd quarter of 2015, active accounts have hit over 650 million. The word “微信” enjoys sharp increase of prestige and value, which also attracts a lot of trademark and domain name squatters’ attention.

The disputed domain, as sharing the same pinyin spelling (“weixin”) as WeChat, gained much increased value along with WeChat’s popularity. From April to July, 2015, this domain was transferred many times. It’s said one of the former owners asked Tencent for 10 million yuan to transfer the disputed domain; while Tencent had not made a decision yet, the domain was sold to a third party for 30 million yuan in April 2015. However, all the value gain came from WeChat instead of weixin.com itself.

According to the related news and arbitration decision, the existing owner, who’s paid a huge amount of money for the disputed domain, conducts business closely related to Tencent WeChat. The website associated with this domain name is called “WeChat Developer Platform”, which facilitates WeChat development forums, FAQs regarding WeChat development and WeChat public accounts development, as well as provides industry news. Under the bottom of the website home page, there is a disclaimer saying “this website has no association with Tencent WeChat in any way. We are not an official Tencent Website” and the wording of “weixin.com is a professional third party WeChat developer platform”.

However, the claims of non-official, not a Tencent WeChat official website were only added after ADNDRC received Tencent company's complaint. Before that, the website had used Tencent company's "penguin graphic" trademark, "QQ" and "WeChat" trademarks.

ADNDRC therefore decided to have weixin.com transferred to Tencent according to "Uniform Domain Name Dispute Resolution Policy".

The disputed domain name owner has filed a lawsuit against this decision and Haidian People's Court in Beijing accepted the case. Shall the result of this litigation case comply with the arbitration decision? Whether this arbitration decision can gain juridical approval? Let's rub our eyes and wait.

Observation:

In the current trademark administrative and juridical practices, judgement of trademark registration and use with ill intention is still rigidly based on the initial application date of the dispute mark. We have come across similar infringement cases, in which infringers searched and dig out old marks that haven't been used for many years and are similar to the existing famous brands. After reassignment, the infringers use such marks to produce identical or similar products to gain improper interest. A more experienced infringer would file further applications for the old mark in more classes or for a new trademark which is more similar to the current famous brand. Many famous brands owners suffer the confusion and misleading information caused by the old marks' owners as they can't prove there had been ill intention at the time of the trademark application. How will the juridical system consider "third party transfer seen as new registration" as in the domain name dispute might provide us with meaningful guidance and inspiration with regards to trademark registration and use.

RSMK news

- **Patent lecture of Shandong Longda company**

In September 17, 2012, Li Ji, an intellectual property consultant of the company, went to the Shandong long Da company for patent talks. The lecture is centered around biological patent application and writing. It also discussed the issue of patent writing and the staff of enterprises.