

Highlights of June



Firm of the Year by Managing IP

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Nancy Qu Awarded "2021 Power List: Top 15 Litigators" by LEGALBAND

We are pleased to announce that Nancy Qu, Partner of Chang Tsi & Partners, was awarded "2021 Power List: Top 15 Litigators" by LEGALBAND with her abundant professional experience and high reputation among clients.

[Representative Case]

Protection of 3M's Trademark

This is an invalidation case, in which the China National Intellectual Property Administration (CNIPA) made a breakthrough in determining whether the goods are similar between Class 22 and 23. While determining the degree of similarity, the CNIPA comprehensively considered many factors, including the awareness of the applicant's prior trademarks and the relevance of the products.

Patent Team of Chang Tsi & Partners Invited to LINK ELITES IP Conference

On 28-29 May 2021, LINK ELITES Intellectual Property Conference of Information Technology

Industry was successfully held. Chang Tsi & Partners as co-sponsor participated in the organization of the conference and held the "IP Global Vision" seminar.

A Brief Guide of Trademark Registration in Macau

Besides Hong Kong, the famous policy "One country, two systems" has been adopting in the Macao Special Administrative Region of China. A registration in Chinese Mainland will not grant you any protection in Macau. As Macau is an important role in Greater China, this article will guide you to have a knowledge of trademark registration in Macau.

Holiday Notice

Please note that 1 July 2021 has been declared as Public Holiday by Hong Kong Government. Therefore, Intellectual Property Department of Hong Kong, as well as our Hong Kong office will be closed during this period. All deadlines for trademark, patent, and other legal matters that would occur during this period will be automatically extended to 2 July 2021 (Friday). Should you have any urgent cases, please let us have your instructions ahead of the holiday.

Chang Tsi & Partners Named Firm of the Year for Trademark Prosecution by Managing IP

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The Managing IP Awards programme is the most comprehensive and widely respected IP awards event in the world. Now in its 16th year, the programme covers a wide range of IP practice areas and more than 30 jurisdictions. Each year MIP's research analysts obtain information from thousands of firms, IP practitioners and their clients through interviews, email and online surveys.

The Editorial Team highlights the notable accomplishments of Chang Tsi & Partners in the past year, e.g. representing Dairy Queen in opposition proceedings and securing a favourable outcome to safeguard the company's business interests, and representing Guinness World Records Consulting in opposition proceedings to consolidate its trademark rights and market share.

Nancy Qu Awarded "2021 Power List: Top 15 Litigators" by LEGALBAND

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As a well-known legal rating agency under Accurate Media Group, LEGALBAND

provides in-depth knowledge related to Asian legal market through publishing articles, reports and guidebooks on a regular basis. The research team of LEGALBAND is well known for its thorough understanding on legal service market for its extensive knowledge and experience in professional fields. The major roles that LEGALBAND play are evaluating law firms and lawyers via carefully designed rating systems together with research programs, and recommending legal elites in legal fields for both internal corporate legal advisers and individuals. LEGALBAND, therefore, has been a trusted legal guide for clients who need excellent law firms and lawyers.

Nancy Qu specializes in the prosecution and enforcement of multiple intellectual property rights, including trademarks, patents, copyrights, trade secrets and domain names. Ms. Qu has over 10 years of experience as a litigation lawyer and patent attorney. She is experienced in the development of strategy in patent and trademark lawsuits, enforcement of effective judgments, as well as in negotiation strategy. She is specifically skilled at handling complicated and difficult IP infringement cases. Ms. Qu has successfully helped to protect the IP rights of many Fortune 500 companies. Nancy Qu is fluent in English and Chinese.



[Representative Case]

Protection of 3M's Trademark

This is an invalidation case, in which the China National Intellectual Property Administration (CNIPA) made a breakthrough in determining whether the goods are similar between Class 22 and 23. It determined the similarity exists between the designated good in Class 23 of the Disputed Mark and the designated good "textile fiber raw materials, etc." in Class 22 of the Cited Mark. While determining the degree of similarity, the CNIPA comprehensively considered many factors, including the awareness of the applicant's prior trademarks and the relevance of the products.

Given the fact that the applicant, in this case, does not have the prior trademark rights in Class 23, we carefully analysed the case after receiving the instructions to file the invalidation. Then, we strategically emphasized that the high relevance of the designated goods of the two parties' trademarks and the reputation of the applicant's "THINSULATE" brand in the grounds of invalidation. Eventually, we succeeded in persuading the CNIPA to make a favourable invalidation decision.

I. BACKGROUND

The respondent, Suzhou Bo Nuan Yu Han Technology Co., Ltd., maliciously registered the "THINSULATION TECH" trademark, which is confusingly similar to 3M company's "THINSULATE" trademark. The respondent filed the Disputed Mark with the malicious intention of inducing consumers to purchase it by mistake.

On behalf of 3M Company, we filed an invalidation against the Disputed Mark in March 2020. The CNIPA issued an invalidation decision on January 19, 2021,

and invalidated the Disputed Mark in class 23. The client is satisfied with the result.

II. DIFFICULTIES

(i) The client does not have prior rights in Class 23, so how to demonstrate the similarity between the goods in Class 22 and 23 is the critical issue;

(ii) How to demonstrate that the Disputed Mark is similar to the Cited Marks is another key point.

III. STRATEGIES

Due to the disputes and the difficulties, in this case, we made the following strategies:

(i) In three aspects, namely the function and purpose of the products, the distribution channel and place of the products, and the relevant producers and the consumers of the products, we fully demonstrate the relevance and similarity of the goods in Classes 22 and 23. Also, we provide the introduction of the "THINSULATE" brand of the applicant's official website, and further support the arguments with the respondent's product introduction related to the Disputed Mark.

(ii) We collect evidence of the popularity of the "THINSULATE" brand and submit evidence such as "THINSULATE" product brochures, brand advertisements, winter clothing design guidance, brand promotional materials, media reports, product series introductions, etc. The evidence proves that the applicant's "THINSULATE" trademark, which is used on textiles commodities such as fiber raw materials and textile fibers, has already gained a certain reputation through use. Hence, we achieved cross-class protection in this case.

(iii) While comparing trademarks' similarity, we refer to the third part of the "Trademark Examination and Trial Standards" ,

"Examination of Identical and Similar Trademarks". In Article 4.1.10 of Examination of Identical and Similar Trademarks, it regulates that "Foreign language trademarks only differ in Singular and plural, gerund, abbreviation, articles, comparative or superlative, part of speech, etc., but the meaning stays the same and the relevant public is likely to be confused with the source of the goods or services. Then, the marks are judged to be similar trademarks". Meanwhile, we quoted the same part in Article 4.1.12 that stipulates "Trademarks only composed by others' prior trademarks and directly indicate the quality, main raw materials, functions, uses, weight, quantity, and other features of the goods with other text. If the above-mentioned composition of the text is likely to cause the relevant public confusion of the source of the goods or services, it shall be judged as a similar trademark."

IV. SIGNIFICANCE

In determining the issue of whether the goods in Class 22 and 23 constitute similar goods, the CNIPA comprehensively considered the relevance of the products and the reputation of the applicant's prior trademarks, then made a breakthrough in cross-class protection.

The CNIPA determines as below:

"The designated products of the Disputed Mark, namely artificial threads and yarns, and the designated products of the Cited Marks 1&2, namely textile fiber raw materials and textile fibers, are related to a certain extent in terms of consumers, distribution channels, functional purposes and so on. The evidence 2-5 submitted by the applicant include "THINSULATE" product brochures, brand advertisements, winter clothing design guidelines, brand promotional materials, media reports, product series introductions,

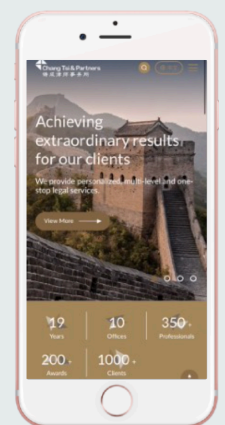
which can prove that the applicant's "THINSULATE" trademark is used and acquired a certain fame through using the Cited Marks 1&2 on textile fiber raw materials, textile fibers and other products. The situation that Disputed Mark and the Cited Mark 1&2 coexist on the above-mentioned similar goods, makes it easy for the relevant public to associate the Disputed Mark with Cited Mark 1&2, and to believe that the goods of the above-mentioned trademarks originate from the same business entity or the providers of the goods have a specific connection. Eventually, the relevant public will be confused and misunderstood the source of the goods, which means the Disputed Mark cannot realize the trademark function."

This point provides a new way of thinking for the future preparation of conflict cases, that is, when goods and services do not constitute similar under a legally similar situation, it is essential to demonstrate both 1)the relevance and similarity of commodities from multiple angles in combination with the possibility of actual confusion and 2)the sufficient fame related evidence to achieve cross-class protection.

Chang Tsi & Partners is a leading full-service Chinese law firm with a strong reputation in intellectual property and litigation. Established in 2002, Chang Tsi & Partners always integrates legal solutions and peace of mind in China's competitive and turbulent market.

Visit our website for more information.

www.changtsi.com



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On 28-29 May 2021, LINK ELITES Intellectual Property Conference of Information Technology Industry was successfully held. Chang Tsi & Partners as co-sponsor participated in the organization of the conference and held the "IP Global Vision" seminar.

The conference was held by China Trademark Association and China Communication Industry Association in Beijing. Guests from Beijing Municipal High People's Court, Beijing Intellectual Property Court, China National Intellectual Property Administration, leading internet and communication companies, law firms and academic institutions.

Kim Lu, Partner of Chang Tsi & Partners, was invited to host the "IP Global Vision" seminar with special focus on SEP and international judicial jurisdiction. In addition, Michael Wu, Partner of Chang Tsi & Partner, was invited to share his sharp understanding on typical SEP cases as senior patent attorney.

The two-day conference is a great opportunity for all participants to discuss the hotspot issues related to AI, Big Data, privacy protection and IT patents, providing effective solutions to legal practice in different countries.



A Brief Guide of Trademark Registration in Macau

Besides Hong Kong, the famous policy "One country, two systems" has been adopting in the Macao Special Administrative Region of China. A registration in Chinese Mainland will not grant you any protection in Macau. As Macau is an important role in Greater China, this article will guide you to have a knowledge of trademark registration in Macau.

I. Sources of law

The principal source of law and regulation relating to trademarks in Macau is the Industrial Property Code, adopted by Decree-Law Number 97/99/M, effective from 13 December 1999. As a supplement, the following 3 Chief Executive's Notices also applies, where appropriate:

International Classification of Goods and Services for the Purpose of the Registration of Marks (Nice Classification) 9th Edition - Notice of Chief Executive No. 10/2009;

Approving the table of fees due for the acts provided for in the Industrial Property Code - Notice of Chief Executive No. 10/2009;

Regarding the models of certificates that prove Industrial Property rights and forms for applications for granting Industrial Property rights - Notice of Chief Executive No. 10/2009.

II. Competent Administration

Trademark registration in Macau is separate from mainland China. The Economic and Technological Development Bureau (DSED) is a public department of the Macao Special Administrative Region (MSAR) responsible for trademark examining and granting. The

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related website is:

https://www.dsedt.gov.mo/en_US/web/public/pg_home

At present, Macau is not the member of Madrid system. As such, if you want trademark protection in Macau, you will need to seek a local IP agent for assistance.

III. Filing procedure and documentation

The requirements and related documents for the filing of a trademark application in Macao are as follows:

- the applicant's full name, nationality, address or place of business;
- a representation of the mark;
- the list of goods and services;
- a certified copy of the home application, if a priority is claimed;
- and an original copy of power of attorney signed by the legal representative and notarised by a notary public.

Less than most countries in the world, the period of publication for opposition in Macau only takes 2 months. If no opposition or objection is raised against the trademark application, you may expect the registration certificate within 6 to 8 months after date of filing.

The duration of registration of a Macau trademark is seven years from the application date and is renewable for further seven-year periods. A renewal application shall be filed prior to six months before the mark expires.

IV. We in Macau

Chang Tsi & Partners has expanded business in Macau since 2010 and has been helping clients file trademark applications and maintain trademark registrations in Macau for more than a decade. Now we have a professional Macau team consists of more than 10 agents and 1 local liaison so we can handle trademark prosecution cases directly in Macau by ourselves. Chang Tsi & Partners is always ready to assist you on IP matter in Greater China.



Achieving Extraordinary Results for Our Clients

Since its establishment in 2002, Chang Tsi & Partners has been managing to become one of the leading law firms in China. The firm has been constantly referred as the "National Outstanding Law Firm", "The Best IP Law Firm in China", "China IP Law Firm", "Tier 1 IP Law Firm of the Year" by Ministry of Justice of China, international legal directories and various business magazines such as Chambers Asia Pacific, The Asia Pacific Legal 500, Asialaw Profiles.