

**Can an applicant include the name of a city or administrative district in China as part of its trademark in China?  
Daimler Chrysler AG's application for "Beijing Benz"**

Where a trademark consists of "China" or the name of a province, municipality, district or city in China, the Chinese Trademark authorities' practice is to generally reject the application. This was followed in DaimlerChrysler AG ("Daimler")'s trademark registration of "Beijing Benz", and the case is now on appeal.

As reported in Legal Daily Newspaper this month, Daimler filed an application for the trademark Beijing Benz in 2004. Its application was rejected by the China Trademark Office ("CTMO") in 2007, and upon review by the Trademark Review and Adjudication Board. ("TRAB"), TRAB also turned it down. The bases of TRAB's decision included:

- (a) a foreign company should not have the name "Beijing" as part of its trademark, as it may cause confusion to the public as to the origin of the products, and
- (b) Beijing being the capital of the country and geographical name of an administrative district should not be used as part of the trademark.

Daimler has filed an appeal to the Beijing First Intermediate Court. ("Court"). If the appeal is pursued, its decision is much awaited to see if the Court accepts a mark comprising of a distinguished mark such as "Benz" coupled with the name of a major city and administrative district, Beijing in this case, will be accepted for registration.

**Similarity in Manner of Writing and Font Type have to be considered in devising your Chinese Trademark  
Instant Noodle battle between Baijia ("white home") and Baixiang ("white elephant")**

To minimize exposure to trademark disputes over Chinese trademarks, in addition meaning, sound and appearance, similarity in font type and manner of writing have to be the subject of search and care in the selection of the Chinese characters.

The Chinese characters Baijia (white home in Chinese) and Baixiang (white elephant in Chinese) are similar visually and phonetically. This led to the recent law suit between the two substantial domestic rice noodle makers, Baixiang Food Company ("Baixiang") and Baijia Food Company ("Baijia"), at the Henan province Supreme People's Court ("Court").

Baixiang started to produce and sell instant noodles under its upright (meaning characters written vertically) trademark in 2001 after it was granted registration of the mark. Baijia was established in 2001 and it sold its noodles under two different trademarks, one being represented horizontally and the other one in an upright manner. Baijia's horizontal mark was granted registration by the Chinese Trademark Office in 2001 but its upright trademark was not. Baixiang claimed that the use of upright trademark by Baijia confused the consumers in the market, as it was similar to Baixiang's mark and their respective noodle products shared almost the same sales channels and used the type of materials in production. The Court ruled in favour of Baixiang and Baijia was ordered to stop applying its Baijia mark in upright type on its instant rice noodle products..

### **Damages of RMB20 million made for Patent Infringement when sales were yet launched German manufacturer sues PRC Bus and Coach Group**

Neoplan succeeded in its patent infringement lawsuit against Zhongwei Bus & Coach Group ("Zhingwei") on the design of the body of Zhongwei's A9 bus series, and was awarded compensation of RMB 20 million yuan (US\$ 2.94 million). Zhongwei was also ordered to cease all manufacturing and sales activities of its A9 bus series.

Generally, prove of loss is difficult in infringement cases over patent rights, whether of invention, utility model or design. In this case, Neoplan still had yet started to launch its Starliner series in China at the time of the infringement. On the other hand, Zhongwei has been selling its A9 series overseas to countries in Southeast Asia and Eastern Europe for several years with a target is to increase its overseas sales to 60% of overall sales. Among others, the Beijing No. 1 Intermediate People's Court took into account such factors, and made an award of US\$20 million yuan as damages.

### **The IPR mediation desk has been established at trade fairs in Europe**

In implementation of its co-operation program with the European Union (EU-China IPR2 project) which commenced in 2007 with focus on intellectual property right protection in China, the Chinese government had set up the first IPR disputes settlement service desk, "China IPR desk" ("IPR desk") this month at CeBIT, the world's largest trade fair for digital IT and telecommunications solutions in Hannover Germany.

The IPR desk helps to resolve disputes between Chinese and European companies on IPR issues such as patent, trademark and industrial designs. It provides advice to exhibitors, and assist the parties in the negotiation and compromise on terms of licensing. It represents another major step of the Chinese government in strengthening the protection of intellectual property rights of foreigners against possible infringement by manufacturers in China and which exhibit their products at international trade fairs.

### **New requirements for trademark applications for newspaper, periodicals, magazine and journals under class 16**

The Chinese Trademark Office has introduced new requirements for trademark applicants that file applications for marks in respect of "Newspaper, periodicals, magazine and journals under class 16:

- i) If the marks applied for fall under the categories of newspaper and periodicals, or if the mark applied for is similar or identical to China's country name [?], then the applicant shall submit the publication license issued by the State Publications administration. The same requirement applies if the marks applied for fall under other provisions of Article 10 of the China Trade mark law.
- ii) The name on the publication license and must be the same as the applicant and the newspaper in respect of which the mark is applied for.
- iii) Applicants may submit the Publication license when filing the applications or responding to an office action.

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