

## **CPA Successful in Recent Trademark Administrative Suit**

On October 22, 2007, Beijing No.1 Intermediate People's Court ruled with regard to Hong Kong Nan Sing Machinery Limited (briefed as Nan Sing Ltd.) v. Trademark Review and Adjudication Board (briefed as TRAB), reversing TRAB's Decision on Review against Refusal of Trademark Registration. CPA, as the law firm representing Nan Sing Ltd., is very delighted with this success, and would be most pleased to share our experience and inspirations in dealing with this suit.

As early as in 1995, Nan Sing Ltd. obtained the registration of the trademark “野马 Wild Horse and Device” on goods in Class seven including flat knitting machines. In 2002, however, when Nan Sing Ltd. applied for registration of the same trademark on other similar goods within Class seven according to its commercial needs, its application was refused by reason that this trademark constitutes similarity with the cited trademark “野马 and DEVICE” which was registered by another company on goods in Class seven including loom bobbin. Our firm represented Nan Sing Ltd. and filed a request for review with TRAB, indicating that: since Nan Sing Ltd. has obtained registration of the same trademark on similar goods, and its application date is earlier than that of the cited trademark, it is assumed that the Trademark Office did not consider there is similarity between the cited trademark and the priorly registered trademark of Nan Sing Ltd. at the time it approved the cited trademark. Otherwise, the cited mark cannot be registered. The Trademark Office, however, now considers the trademark that is completely the same as the previously registered trademark constitutes similarity with the cited trademark and refuses the registration of this trademark, the Trademark Office is obviously contradictory in its standard for determining similarity between these two trademarks. TRAB held in the Decision on Review against Refusal of Trademark in 2007 that the trademark applied by Nan Sing Ltd. is a similar trademark on similar goods with the cited trademark, and that whether the previously registered trademark of Nan Sing Ltd. is similar to the cited trademark does not fall within the examining scope of the present case.

Nan Sing Ltd. was not satisfied with TRAB's decision, and entrusted our firm to file a lawsuit before Beijing No.1 Intermediate People's Court. In our complaint, we indicated that it is implied in Article 28 of the Trademark Law that the approved registration trademarks on the same or similar goods shall not constitute the same or similar trademarks. The fact that the cited trademark was registered demonstrates that the Trademark Office does not consider that the cited trademark and the previously registered trademark of Nan Sing Ltd. are similar. The conclusion made in the Decision on Review against Refusal of Trademark, i.e., the completely the same trademark applied by Nan Sing Ltd. constitutes similarity with the cited trademark, betrays the legal principles on which Article 28 of the Trademark Law is based. Besides, the previously registered trademark of Nan Sing Ltd. is not irrelevant with the present case, as the existence of the previously registered trademark reveals the examination standard for similarity between the same trademark and the cited

trademark as adopted by the Trademark Office. TRAB did not take the previously registered trademark of Nan Sing Ltd. into consideration, and therefore was erroneous in ascertaining the facts.

Upon hearing, Beijing No. 1 Intermediate People's Court upheld Nan Sing Ltd.'s claims, ruling that TRAB's Decision on Review against Refusal of Trademark shall be reversed.

Based on this ruling, we summarize the following two points:

1. The examination results of other applications or review cases by the Trademark Office and the Trademark Review and Adjudication Board are not irrelevant to the cases at dispute. The decisions by the Trademark Office and the Trademark Review and Adjudication Board shall not have obvious conflict with previous examination or review results.
2. Basic legal principles that are not explicitly stated in the terms of the law can be applied. Decisions by the Trademark Office and the Trademark Review and Adjudication Board shall not betray such rules.