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Overcoming citations: LOC or NUC?

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In June 2022, the Beijing High People's Court finally upheld the China National IP Administration's (CNIPA) initial rejection and the Beijing IP Court's first-instance judgement that the cited mark NUTREX, #832232, has posed obstruction to Nestle's mark NUTREN, #37003069, in class 5. The Court ruled that the applied-for mark is very similar to the cited mark NUTREX, #832232 and that the marks, if simultaneously used on the same or similar goods, might confuse or mislead the relevant public, in spite of the second cited mark holder's consent, though the consent from the holder of first cited mark NUTREND, Int'l #911718 had been accepted by the CNIPA in the initial review procedure in May 2020.

The CNIPA is growingly strict with letter of consent to overcome citation, but the subsequent courts are somewhat liberal. However, in the pharmaceutical area, both the CNIPA and the courts are very careful to accept such consent, because they are concerned that medicines are more directly related to human health and life. Of course, I personally think that the three marks are very similar in the eyes of Chinese consumers who are illiterate of Latin. This reflects the Chinese authorities' lower tolerance of co-existing similar marks in classes 5, 10 and 44 than in other classes.

The CNIPA's and court's attitude was also reflected in another case relating to pharmaceutical goods, where the Beijing IP Court upheld the CNIPA's citation. As we can see, the applied-for mark consisting of a two-fish device and the word "U.G.A." was obstructed by a "U**GA" mark and a two-fish device mark. It seems that the combination fails to lower the similarity. However, the rejection was then overruled by the Beijing High People's Court, also in June 2022, due to the non-use cancellation of the two cited marks.

Unlike the above-mentioned case, the applicant of this case overcame the citations through non-use cancellations which succeeded until the second-instance of administrative lawsuit. Since the CNIPA's review procedure is taking around eight months now, applicants need to be prepared to "fight" till the lawsuit procedure to get the result of non-use cancellations. As such, it is

advisable for pharmaceutical companies to do their homework early and take proper actions to overcome prior marks in China.

Applied-for Mark	Cited Mark 1	Cited Mark 2
		