

CNIPA Interprets Suspension of Certain Trademark Review Cases

By Ms. Haiyu Li, Lawyer and Partner of Chofn IP

On June 13, the China National IP Administration (CNIPA) officially interpreted *the Regulation of Suspension Circumstances in Review Cases* (the Regulation), providing seven specific circumstances where examination shall be compulsorily suspended and three circumstances where examination may be discreetly suspended.

This is a great piece of news for legitimate trademark holders as the Regulation might substantially save their resources and efforts in maintaining an effective application to wait for the result of other pending cases. The Regulation will be helpful to reduce the number of repeated applications and prevent the exhaustion of legal proceedings, and eventually optimize the allocation of administrative and judicial resources.

The approval of suspension shall be based on the **principle of necessity**, and only when such circumstances as the determination of prior rights have a substantial impact on the outcome of the review, the case shall be suspended. Where the other review grounds or stable prior rights are sufficient to determine the conclusion of the case, suspension shall not be granted.

To be specific, review cases under the following five circumstances **shall be compulsorily** suspended:

Circumstances	Applicable cases
1. Name change or assignment is going on and the conflict of rights might be avoided;	
2. The cited mark has expired and stays in the renewal procedure or in grace period;	
3. The cited mark is under proceedings of removal or withdrawal;	a) Appeal against rejection;
4. The cited mark is still within the one-year prohibition period after cancellation, invalidation, or absent renewal. Note: ● If the rejection ground is irrelevant to the prohibition period, there is no need to suspend. ● For the non-use mark, the prohibition period ends on the publication date of the cancellation.	b) Appeal against registration disapproval; and c) Invalidation.
5. The case affecting the effectiveness of the cited mark has been concluded and is waiting for the decision to take effect.	

6. The prior rights concerned shall be decided by the result of another pending proceeding with the court or administrative organ.	a) Appeal against registration disapproval; and b) Invalidation.
7. The status of the cited mark concerned shall be decided by the result of another pending proceeding with the court or administrative organs, and the applicant explicitly made a request for suspension.	Appeal against rejection.

Under the following three circumstances, the CNIPA may use its discretion to suspend the cases:

Circumstances	Applicable cases
8. In case of appeal against rejection, if the cited mark is pending invalidation, and the registrant of the cited mark was once identified as a bad-faith filer according to Articles 4, 19.4 and 44.1 of the Chinese Trademark Law, the examiner may discreetly suspend the case according to the specific scenarios. The appellant's request is not a necessary condition.	Appeal against rejection.
9. The examiner may suspend the examination, on a case-by-case basis, if the review case needs to wait for the prior decision or ruling of a similar or relevant case. The appellant's request is not a necessary condition.	a) Appeal against rejection; b) Appeal against registration disapproval; and
10. For circumstances not specified in this Interpretation, the examiners may use their discretion to decide suspension base on the principle of necessity and protection of the legitimate right holders, with full consideration of the specific scenarios.	c) Invalidation.

The necessary condition for the suspension of an appeal against rejection is the appellant's explicit request, except for the active suspension for the cited mark holder's possible bad faith as identified in above Circumstance 8. The appellant shall file a written request no later than the three-month supplementing period. When the circumstances of suspension have terminated, the appellant **shall** file a separate request for resuming the examination.

Our Chofn attorneys would provide the following tips for your easy reference:

1. Under the circumstances where cases shall be compulsorily suspended, the legitimate right holders can consider only relying on the review procedure to solve the dispute and refrain from repeated applications.
2. Under the circumstances where the examiners may be discreetly suspended, it remains advisable to file at least one repeating back-up application to be on the safer side.
3. Although under some circumstances, explicit request for suspension is not a necessary condition for suspending the review cases, if the right holders believe having the cases suspended is more beneficial, we suggest always explicitly requesting suspension to draw the examiner's attention and increase the possibility of suspension approval.