



# Beijing East IP

A Newsletter  
Beyond News

# Newsletter

## Big Event

Footprint 2014 of Beijing EAST IP

## Patent

Key Points of the Recent Amendment to Legal Interpretations  
Related to Trial of Patent Infringement

## Trademark

Comment and Analysis on Well-known Trademarks in the  
Internet Industry



## **Footprint 2014 of Beijing EAST IP**

### **January**

#### **The Annual Gathering**

All colleagues of Beijing EAST IP gathered in a Hot Spring Resort to celebrate the New Year of 2014.



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### **February**

#### **Creation of the Gao Lulin Foundation**



Beijing EAST IP funded 2 million yuan to create the Gao Lulin Foundation in name of our Chairman, Dr. Lulin GAO. The Gao Lulin Foundation will support research activities and award outstanding talents in the field of intellectual property, to help development of intellectual property community of China.

### **March**

#### **International Seminar in Japan**

On March 12, 2014, the Institute of Intellectual Property (IIP) and Beijing EAST IP co-hosted an international seminar in Tokyo, Japan. Our Chairman Dr. Lulin GAO and Vice General Manager Mr. Dragon WANG gave presentations to more than 120 professionals from different fields of Intellectual Property.



### **April**

#### **Seminar on Unfair Competition on the Internet**

On April 15, 2014, the 2nd Seminar on Regulations on Unfair Competition on the Internet was jointly held by the Copyright Union of Internet Society of China, Beijing EAST IP Ltd. and K& L Gates LLP. Over 30 attorneys from renowned domestic internet companies attended this informative and successful seminar.

April

### AUTM Asia 2014 in Taipei

On April 20, 2014, our Senior Partner Dr. Bo-In LIN attended the Annual Meeting of the Association of University Technology Managers (AUTM Asia 2014) in Taipei.



May

### INTA Annual Meeting 2014

From May 10 – 14, 2014, our Partner Mr. Jason WANG of the Trademark Department led a team to attend the 136th INTA in Hong Kong.

### Internet and E-Commerce IP Forum

On May 28 – 29, 2014, Beijing EAST IP attended the Internet and E-Commerce IP Forum hosted by the Supreme People's Court and the Beijing High Court. Our Chairman Dr. Lulin GAO presented a topic on software and business patent protection on the Internet.

### IPBC Global 2014 in Amsterdam

On June 22-24, 2014, our Chairman Dr. Lulin GAO led a team to attend IPBC Global 2014 in Amsterdam, and built up connections with delegates from leading international corporations, as well as senior members of the IP commercialisation and monetisation communities.

June

### Summer Outing at Nandaihe

On June 7-8, 2014, all colleagues from Beijing EAST IP had a summer outing at the Nandaihe Gold Coast.



July

### Training Course to Haidian District Government Officials

As invited by the Intellectual Property Office of Haidian District, chairman Dr. GAO of Beijing EAST IP represented a training course about protection of intellectual property to government officials in the Haidian District. The Haidian District is known for the Zhongguancun's Haidian Science Park, which covers more than 12,000 high-tech companies and universities.



August

### Presentation at JETRO 's Beijing Representative Office

On August 15, 2014, Manager of the Electric Department patent attorney Qiang LIN was invited to the Japan External Trade Organization (JETRO)'s Beijing representative office to give a presentation on "The Best Practice of Software Patent in China."

### Dr. Gao was Granted Honorary Doctoral Degree by JMLS

Our Chairman Dr. GAO gave a course about IP in China at the John Marshall Law School, and was granted an Honorary Doctoral Degree by JMLS.

Dr. GAO has been an adjunct professor of JMLS for years, and he has been giving a two-week-course lecture every September.



### IP Scholarship Founded at the John Marshall Law School

Beijing EAST IP founded an IP scholarship at the John Marshall Law School in Chicago, USA.

### Presentation at China Electronics Standardization Institute

On September 18, 2014, our General Manager Dr. Xiaodong LI was invited to give a presentation at China Electronics Standardization Institute (CESI). The presentation was based on the association between standardization and patent.

September

### Annual IP Review Books Published

The books *China Patent Case Review 2014* and *China Trademark Review 2014* were produced by patent attorneys and attorneys-at-law in Beijing EAST IP. These two books are written in English to facilitate foreign readers.



### Strategic Tri-party Cooperation Agreement Signed

On September 29, 2014, a Strategic Tri-party Cooperation Agreement was signed among Beijing EAST IP Ltd., Tongji Law School/Intellectual Property Institute and W&H Law Firm. Afterwards, a seminar about Anti-monopoly in the Automobile Industry was held at the Tongji Law School in Shanghai.





**September**

### Patent Information Annual Conference of China 2014

Beijing EAST IP held a booth in the Patent Information Annual Conference of China 2014 (PIAC2014) in Beijing.

### Gao Lulin IP Scholarship Founded at Tsinghua University

The Gao Lulin Foundation donated a “Gao Lulin Intellectual Property Scholarship” in the Tsinghua University School of Law, to encourage study of Intellectual Property Laws among lawschool students.

### US and China IP Dialogue in Silicon Valley, California

On October 2, the Gao lulin Foundation and the SVIPLA co-hosted, and the Beijing EAST IP and the Tsinghua University School of Law co-sponsored the 2014 US and China IP Dialogue in Silicon Valley, California.



**October**

### Intellectual Property and Capital Market Forum in Yantai

On October 17, the 2014 Intellectual Property and Capital Market Forum in Yantai City was co-hosted by the Intellectual Property Office of Yantai and the Lawyer's Association of Yantai, and sponsored by Beijing EAST IP and W&H Law Firm.





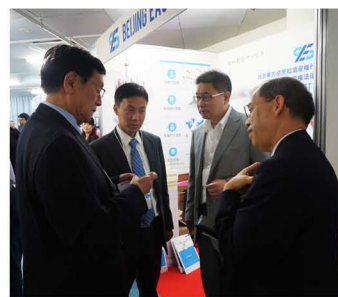
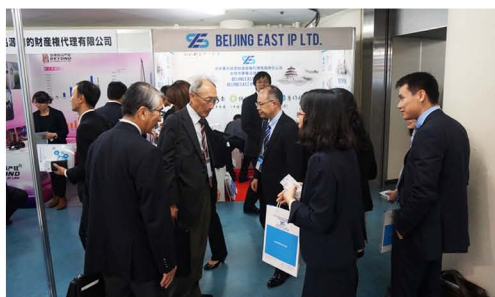
**November**



## Exhibition at PIFIC 2014 in Japan

From November 5 – 7, 2014, the annual Patent Information Fair & Conference (PIFIC) was held in Tokyo, Japan. Beijing EAST IP organized a team to attend this Conference for the second consecutive year.

During this Conference, Beijing EAST IP attracted numerous attendees who have or will have intellectual property services to exchange their view. Our professionals introduced Beijing EAST IP's 1-Stop services concept and advantage, and provided precise demonstrations and suggestions to the attendees at our boot. We have established connection with more than 300 companies and corporations, and reached an excellent business communication and



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## World Internet Conference • Wuzhen Summit

As invited by the State Internet Information Office of China, Chairman Dr. Gao of Beijing EAST IP attended the World Internet Conference • Wuzhen Summit as the Vice Chairman of Internet Society of China.

## IPBC Asia 2014 in Shanghai

Beijing EAST IP attended IPBC Asia 2014 in Shanghai as a host-sponsor. Chairman Dr. Lulin Gao was interviewed by the IAM Magazine.

**December**





# Key Points of the Recent Amendment to Legal Interpretation related to Trial of Patent Infringement --Rule 5

On July 31st, 2014, the Supreme People's Court (SPC) of China published a draft of the Interpretations of the SPC on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement II (最高人民法院于审理侵犯专利权纠纷案件应用法律若干问题的解释(二)) for public opinions, which will undoubtedly have fundamental influence to enforcement of patents in China.

This draft contains 37 rules in total, part of which are based on Decisions of the SPC on typical cases. For a better understanding of such rules, we will present in this special column the amended rules, our comments, and brief of interpretation to underlying typical cases for some rules.

## Amended Rule 5

*When the literal meaning of a claim is clear but is in fundamental conflict with corresponding part in the description, which does not belong to the circumstances as prescribed by Rule 4, the people's court shall determine the patent protection scope based on the literal meaning of the claim.*

*If the meaning of a claim is unclear and the patent protection scope claimed by such a claim cannot be determined by any statutory manner of interpretation, which does not belong to the circumstances as prescribed by Rule 4, the people's court may dismiss the lawsuit.*

*If the parties prove that a petitioner have requested the Patent Reexamination Board to invalidate the patent based on the above-mentioned grounds before the judgment of the patent infringement litigation is made, the people's court may suspend the lawsuit.*

## Our Comments

According to Rule 5.1, as long as the literal meaning of a claim is clear, the people's court can determine the protection scope of the claim based on its literal meaning, and make a comparison with the accused infringing technical solution, even if such a claim has defect that may result in invalidation. For example, inconsistency of claims with the description may cause such claims not to be supported by the description and thus the claims do not conform to Article 26.4 of the *Chinese Patent Law*.

The obvious errors in Rule 4 usually make the technical solution of a claim unreasonable or unenforceable. However, under the circumstances of Rule 5.1 wherein a claim is inconsistent with the description, the claim *per se* does not have a defect making the technical solution unreasonable or unenforceable.

**The Civil Decision (2012) Min Ti Zi No.3 by the Supreme People's Court may be referred to a better understanding of Rule 5.1.**

According to Rule 5.2, if a claim lacking clarity causes the protection scope thereof cannot be determined, the people's court can dismiss the lawsuit without waiting for the invalidation of such a claim. This rule confers the people's court power to determine validness of claims. However, this determination is available to obvious substantive errors such as clarity issues, and excludes defects of novelty/inventiveness in the invalidation proceeding.

**The Civil Ruling (2012) Min Shen Zi No.1544 by the Supreme People's Court may be referred to a better understanding of Rule 5.2.**



According to Rule 5.3, under the circumstance wherein the accused infringer has requested for invalidation based on the defect of lacking clarity of Rule 5.2, the people's court may dismiss the lawsuit. This reflects the discreet attitude held by the people's court in hearing defects related to validity of claims, e.g. clarity issue of claims.

## Typical Cases

### The Civil Decision (2012) Min Ti Zi No.3 - Method for Manufacturing Smooth Metal-shield Composite Belt

*Xi'an Qinqiang Telecommunication Material Co.,Ltd. v. Wuxi Longsheng Cable Material Factory et.al.* – How to Interpret Inconsistent Claims with Detail Specifications (Civil Judgment (2012) Min Ti Zi No.3 by the Supreme People's Court on August 24, 2012)

Obvious drafting mistakes in the claims of a granted patent do not inevitably render the patent invalid. If those skilled in the art upon reading the claims, can immediately realize that there is an obvious mistake in a particular claim and can determine its exclusive and correct meaning in light of the patent specification, the scope of the claim shall be determined based on the corrected understanding. However, if the language of the claim is clear, even if inconsistent with the specification, the claim shall be construed as it would be understood by those skilled in the art, rather than based on the specification.

Xi'an Qinqiang Telecommunication Material Co.,Ltd. (hereinafter referred to as "Qinqiang") is the patentee of Chinese Invention Patent No. ZL01106788.8 titled "Method for Manufacturing Smooth Metal-shield Composite Belt." Qinqiang brought a patent infringement lawsuit to the Xi'an Intermediate People's Court against three defendants including Wuxi Longsheng Cable Material Factory (hereinafter referred to as "Longsheng Factory") and other two entities, claiming monetary damages and injunctions.

Claim 1 of the patent involved is reproduced in part as follows:

*"1. A method for manufacturing smooth metal-shield composite belt, comprising adhering a plastic thin film to a metal foil surface in an uneven and non-planar manner to form point contacts between the composite belt and a longitudinal wrapped or sizing mold of an optical cable or electric cable, such that friction force can be reduced, and bumps, air-leakage, mold release and belt breakage of the cable can be prevented, the process and conditions of the method are as follow: ..., (2) transferring a plastic melt or plastic film through a fine meshed steel roller and a squeeze roller rotating with respect to each other, such that there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film, which is thermally extruded on one side of a substrate facing the metal foil, wherein the steel roller is at a temperature of 35°C-80°C, has a diameter of 240mm-600mm and a mesh number of 40-85, and wherein the squeeze roller has a diameter of 160mm-480mm; ...."*

The court of first instance appointed an appraisal organization to conduct a technical appraisal, in order to determine whether the manufacturing method of aluminum-plastic composite belt of Longsheng Factory and the technical features of the above patented method are identical or equivalent to each other. Regarding the technical feature *"there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film,"* the appraisal report asserted this technical feature means the thickness of the plastic thin film is from 0.04 to 0.09 mm, while the product manufacturing method of Longsheng Factory produces a plastic film having a surface roughness of Ra 2.47 μm to 3.53 μm and a thickness of 0.055-0.070mm. Accordingly, the appraisal opinion asserted these two features are equivalent to each other. The court of first instance decided Longsheng Factory constituted an infringement, and shall compensate Qinqiang for RMB



3,000,000 (around USD 500,000).

Longsheng Factory and the other defendant unsatisfied with the judgment rendered by the court of first instance, and filed an appeal with the Shanxi High People's Court ("the court of second instance"). The court of second instance affirmed the original judgment upon trial. Longsheng Factory was still not satisfied with the judgment of the court of second instance, and filed to the Supreme People's Court for a retrial. The Supreme People's Court directed the court of second instance to conduct the retrial. The court of second instance upheld the original judgment upon retrial.

Longsheng Factory and the other appellant filed to the Supreme People's Court for retrial again, and submitted that the feature "*there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film*" recited in claim 1 refers to the thickness of the uneven and rough layer on the plastic film surface, instead of the overall thickness of the plastic film, i.e. there is formed a concave-convex surface structure of 0.04-0.09mm (40μm-90μm) on the surface of the plastic film. Regarding the feature "*there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film*", the Supreme People's Court found that a person of ordinary skill in the art would construe it's meaning as the thickness of the uneven and rough surface on the plastic film surface



Photoed by Ms. Yaohong ZHANG, patent attorney in the Patent Information Consulting Division

being 0.04-0.09mm. The meaning of this feature is clear and definite. If the feature "there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film" is interpreted as the thickness of the plastic film being 0.04-0.09mm, the modifiers of "surface," "rough surface," and so on in this feature will actually become redundant. Moreover, since the specification of the present patent describes the technical solution in a very simple way, those skilled in the art after reading the claims and the specification, would not come to the conclusion that this feature should be understood as the thickness of the plastic film being 0.04-0.09mm. The surface structure (with a roughness of Ra 1.8μm—5μm) of the plastic film used by Longsheng Factory is very different from the concave-convex surface structure of 0.04-0.09mm (40μm-90μm) formed on the surface of the plastic film in claim 1. These two features are neither identical nor equivalent to each other.

## Remarks

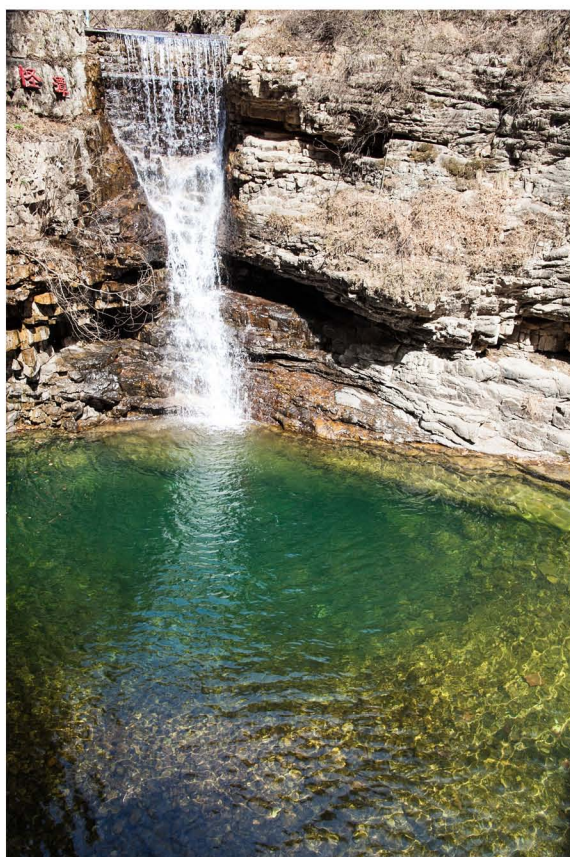
As a guiding principle, Article 56 of the Chinese Patent Law (2001) provides that the extent of protection of the patent right for invention or utility model shall be determined by the terms of the claims. Accordingly, the meaning of the claim language shall be ascertained in view of the application's specification from the perspective of those skilled in the relevant art. Particularly, to ascertain the meaning of a term in the claims, a variety of sources may be adopted, among which the words of the claims themselves can be highly instructive, and the specification in most cases is the best source for discerning the proper context of claim terms.

To determine whether a disputed term in the claims is an apparent mistake, this judgment of the Supreme People's Court provided a two-step test. First, if those skilled in the art can definitely determine the meaning of the disputed term in the claims, the claims shall be



construed as they would be understood by those skilled in the art, and the specification shall not be used to contradict the meaning of the term in the claims, even if such meaning is inconsistent with the specification. Second, in contrast, if those skilled in the art upon reading the description and the drawings, can immediately realize that the disputed term is an apparent mistake and can directly, unambiguously, and exclusively ascertain the correct meaning of the term according to the description and the drawings, the particular claims in which the disputed term appears shall be construed so as to be consistent with the description and drawings.

In this case, it is very important to determine whether there is an apparent mistake in the feature “there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film” of claim 1, i.e., whether the “thickness of 0.04-0.09 mm”



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in the claims refers to the overall thickness of the plastic film or the thickness of the uneven and rough layer on the plastic film surface. The patentee asserted that this feature should be understood as defining the thickness of the plastic film itself, since each of the numerical values “0.04mm,” “0.09mm,” and “0.07mm” appeared in the embodiments in the patent description represents a respective thickness of the plastic film. Upon reading the written description, there may be a doubt as to whether the term “a thickness of 0.04-0.09 mm” in claim 1 corresponds to the thickness values of the plastic film (0.04mm, 0.09mm, and 0.07mm) provided in the description such that the above feature should be regarded as having an apparent mistake. An apparent mistake in a claim means that a term in the discussed claim can be directly determined to be erroneous and then unambiguously corrected by a person of ordinary skill in the art in the context of the original description and claims, and thus cannot be interpreted in any other plausible way. However, from the specification disclosure, it cannot be unambiguously determined that the above feature means “the thickness of the plastic film is 0.04-0.09mm.” In contrast, according to the claim language, it is clear that the “thickness of 0.04-0.09 mm” should be interpreted as the thickness of the uneven and rough layer on the plastic film surface. Therefore, the feature “there is formed an uneven and rough surface with a thickness of 0.04-0.09 mm on the surface of the plastic film” of claim 1 cannot be regarded as an apparent drafting mistake in the claims and then be corrected based on the description, but shall be construed according to the words of the claims themselves.

From the teaching of this decision, several measures may be taken during drafting and examination of a patent application to reduce the ambiguities in subsequent litigation of the issued patent. In order to obtain a broad and reasonable patent right, the applicant should clarify the scope and meaning of the



claims at the application stage as clear as possible, rather than attempting to resolve the ambiguity in litigation later. Generally, the usage of a term in one claim can often illuminate the meaning of the same term in other claims, and each term in the claims has its respective meaning and cannot be regarded as redundant. Therefore, the applicant should carefully adopt terms and features used in the claims when drafting the application document, such that identical terms are used for the same meaning and different terms are used for different meanings, thereby avoiding claim indefiniteness issue resulted from literal conflict or inconsistency between the claims and the description.

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## Typical Cases

Civil Ruling (2012) Min Shen Zi No. 1544 - Clothing for Electromagnetic Pollution Protection

*Wanqing BAI v. Shanghai Tianxiang Industrial Co., Ltd. et.al.* - The Influence of Ambiguity in Claim on Patent Infringement (Civil Ruling (2012) Min Shen Zi No. 1544 by the Supreme People's Court on December 28, 2012)

Regarding problems raised under the condition that distinct defects existed in a claim make the protection scope of the claim unclear. For example, how to define the protection scope of the claim and how to enforce the patent right. This case gives the explicit attitude of the court. The Supreme People's Court explicitly states that: accurately defining the protection scope of a patent right is a precondition for judging whether the accused technical solution constitute an infringement; if the protection scope of a patent right cannot be clearly defined, it should not confirm the infringement act of the accused technical solution.

The case relates to an infringement dispute between Patentee, Wanqing BAI, and Chengdu Nanxun Marketing Service Center (hereinafter referred to as "Nanxun Center"), Shanghai Tianxiang Industry Co.,Ltd. (hereinafter referred to as "Tianxiang Industry").

The patentee is the assignee of a utility model patent No.ZL200420091540.7 titled "Clothing for Electromagnetic Pollution Protection." This utility model patent has only one claim, which recites:

*"A clothing for electromagnetic pollution protection, comprising a top and a bottom, characterized in that, the clothing provides metal mesh or film for shielding in its fabrics, wherein the metal mesh or film is constituted of metal filaments or powders with high magnetic permeability and no remanence."*

The Patentee brought a lawsuit against the Tianxiang Industry and the Nanxun Center to the Chengdu Intermediate People's Court (hereinafter referred to as "the court of first instance") on July 19, 2010 for the reason that a top clothing for electromagnetic pollution protection which is produced by Tianxiang Industry and sold by Nanxun Center has infringed the utility model patent right owned by the patentee.

The court of first instance held that, Wanqing BAI failed to specify in the claim the standard for the technical feature "high magnetic permeability," and cannot prove that the magnetic permeability of stainless steel wire utilized by the accused product has achieved the "high magnetic permeability" recited in the claim either; the proposition of the patentee that the feature in the accused product "stainless steel wire" was the same as the feature "the metal mesh or film for shielding, wherein the metal mesh or film is constituted of metal filaments or powders with high magnetic permeability and no remanence" in the claim was untenable; thus the court of first instance rejected the petition of Wanqing BAI. Wanqing BAI was not

satisfied with this judgment, and appealed to the Sichuan High People's Court (hereinafter referred to as "the court of second instance"). The court of second instance supported the opinions of the first instance and rejected the appeal and affirmed the original judgment.

Again, Wanqing BAI was not satisfied with the judgment of second instance and appealed to the Supreme People's Court for retrial. Along with this appeal, Wanqing BAI submitted new evidences such as textbooks, reference books, science literatures, etc., trying to prove that the scope of the technical feature "high magnetic permeability" is clearly defined.

After the retrial procedure, the Supreme People's Court determined that the dispute of this case focused on the definition of the protection scope of the feature "high magnetic permeability" in the claim. The opinions of the Supreme People's Court are as below:

First, the specification of the utility model failed to clearly indicate whether the magnetic permeability in the technical solution of the utility model was a relative magnetic permeability, an absolute magnetic permeability or other meanings, failed to recite the detailed scope covered by the high magnetic permeability, and failed to describe objective conditions (such as the intensity of magnetic field

etc.) used for calculating the magnetic permeability. Based on said specification, those skilled in the art will have difficulty to determine the specific meaning of the feature "high magnetic permeability" in the related utility model.

Second, though the expression of "high magnetic permeability" has been used in some prior arts as proved by the submitted evidences, the meaning of the high magnetic permeability varies a lot, depending on the differences of the magnetic field intensity and the technical field. The difference between values of the magnetic permeability in some literatures is as large as four orders of magnitude. Therefore, the evidences submitted by the patentee cannot prove that person skilled in the technical field to which the utility model belongs have a relatively consistent knowledge of the meaning or scope of the high magnetic permeability.

Last, the patentee contends that those skilled in the art may determine the desired magnetic permeability according to the specific lower limit of magnetic permeability for safety depending on the specific using environment. However, this argument actually covers all the situations that achieve the purpose of electromagnetic radiation protection into the protection scope of this claim, which is to seek a much broader protection scope and lacks supports of facts and laws. In conclude, as the meaning of the technical feature "high magnetic permeability" in the claim 1 cannot be determined definitely, neither can the protection scope of this claim be determined definitely.

The Judge of the Supreme People's Court held that, accurately defining the protection scope of the patent right is a precondition for judging whether the accused technical solution contributes an infringement; if the drafting of the claims has distinct defects, and the meaning of the technical terminology in the claims cannot be determined or the protection scope of the patent right cannot be determined definitely even by



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### 3. Items of goods and services under trademarks in the Internet industry are comprehensive

All of the items recognized as well-known for the above trademarks are services, but it does not mean that trademarks in the Internet industry are limited to services. Actually, some trademarks in the Internet industry cover both goods and services. For example, instant messaging business covers not only the services of “Message sending; Communications via computer terminals” and other services in Class 38, but also goods of “Computer software (recorded); Computer programs [downloadable software]” and other goods in Class 9. Network dictionary business covers “Computer software services” in Class 42, as well as goods of “Electronic dictionary” in Class 9. Electronic publication business covers services of “Providing online electronic publications (not downloadable); Publication of electronic books and journals online” in Class 41, as well as goods of “Electronic publications (downloadable)” in Class 9. Online game business covers services of “Providing online game via the computer network” in Class 41, as well as goods of “Computer game programs” in Class 9.

In addition, some well-known trademarks in the Internet industry also cover multiple services in different Classes simultaneously. For example, social networking (Social Network Service, SNS) business is online social networking services, which integrate various functions like dating (“Dating services” in Class 45), chatting (“Message sending” in Class 38), information sharing (“Providing online electronic publications via the computer network” in Class 41), game (“Providing online games via the computer network” in Class 41). Another example, sites like Sina, Sohu, Yahoo!, also provide services like portal sites, e-mail, instant messaging, in addition to providing Internet search engine services in Class 42. It is not actually difficult for the portal site services to find the appropriate descriptions in the CTMO Classification. The fact is, portal services do not

correspond to merely a single Class, but rather multiple Classes comprehensively. These services may include items in different Classes like “Providing entertainment information via the Internet” in Class 41, “Providing business information via the Internet” in Class 35, “Providing financial information via the Internet” in Class 36, and “Providing beauty information and/or dining information via the computer information network” in Class 42. It is the exact reason that goods and services designated under the trademarks in the Internet industry are comprehensive. Therefore, the trademark applications in the Internet industry should cover multiple key Classes of goods and services. The nature of the trademark in the Internet industry also determines that recognition of the well-known trademark in the Internet industry may probably involve more than one Class of goods and services.

### III. Evidence Proving for the Fame of Trademarks in the Internet Industry

After obtaining a trademark registration in the Internet industry, which defines the boundary of trademark rights, the issues followed will include the enforcement of the trademark rights, request for well-known trademark recognition and evidence proving the fame of trademarks. The characteristic that the Internet industry differs from the traditional industry leads to the fact that evidence proving for fame of trademarks in the Internet Industry is different from that in the traditional industry.

First, there is an issue regarding emerging and rapid development in the Internet industry vs. long-term accumulation for fame of trademarks. In the traditional industry, fame of trademarks are usually formed and accumulated for a long period of time of several years or even generations. However, the Internet industry is emerging industry with short history, while the development is rapid. In the Internet industry, the situation is usually like this: Shortly after one Internet

company has created a miracle and record, another Internet company will break the old record and create the new miracle. The issue is whether a trademark in the Internet industry as emerging industry may achieve the well-known status within a short period of time. On the early Internet stage particularly, investment for advertisement for the trademarks in the Internet industry was rare, and mostly relied on word of mouth. This is especially obvious during the well-known trademark recognition for trademarks of Yahoo! Inc. and Google Inc. at the early stage. According to the Trademark Examination Standard, one element required for applying Article 13 of the Chinese Trademark Law is that the cited trademark has achieved well-known status before the application date of the disputed trademark. It took five years for the trademarks “YAHOO! in Chinese” and “YAHOO!” to achieve the well-known status in September 2000, the application date of the opposed mark “YAHOO! in Chinese and YAHOO” (Application No. 1649903), since the foundation of Yahoo! Inc. in March 1995. It took three years for the trademark “GOOGLE” to achieve the well-known status in January 2002, the application date of the opposed mark “GOOGLE and Bao Hu in Chinese” (Application No. 3077519), since the foundation of Google Inc. in September 1998. These trademarks were used and promoted in a short time, and it may probably be difficult for the Internet companies to provide as sufficient and complete evidence of fame as trademarks in the traditional industry. However, there is no doubt that, the above trademarks are truly well-known trademarks widely known among the general public, and have achieved the well-known status. By contrast to the traditional industry, the Internet industry develops faster and changes quicker, and trademark in the Internet industry is more vulnerable to be infringed, which provides more urgent necessity for the protection of the well-known trademark. Under these circumstances, Chinese authorities lowered the burden of proof for the trademark owners regarding the well-known trademark

recognition, and recognized the above trademarks as well-known, and thus effectively and efficiently protected the well-known trademarks in the Internet industry.

Second, there is an issue regarding non-stability and easy modification of the Internet content vs. collection and preservation of electronic evidence proving the trademark use. Even if the current web pages of the Internet companies were preserved by the notary public, it can only prove the status of the web pages for the current moment when the notarization is conducted, and it is difficult to trace back to the history web pages before that. The Chinese Trademark Law, Judicial Interpretations of the Chinese Trademark Law, the Trademark Examination Standard, and other regulations mainly made references to goods and services in the traditional industry, and rarely involved the preservation and exhibition of electronic evidence, especially the evidence related to first use and specific period of trademark use on the Internet. It is really a technical and legal issue newly emerged regarding how to determine the use of trademarks on the Internet. In practice, it may be a feasible solution to retrieve historical web pages via neutral third-party websites like Internet Internet Archive ([www.archive.org](http://www.archive.org) or [www.waybackmachine.org](http://www.waybackmachine.org)) or tools with similar features to the function of “back in time.” In the three-year non-use cancellation case of “HUA JUN in Chinese and huajun,” the court held as follows: The web pages are persevered for Huajun web pages by searching on the famous archives website ([www.waybackmachine.org](http://www.waybackmachine.org)) and the notarization of the real time printing, and such site preserving the achieve is the famous non government organization. Thus, it will usually be deemed as high degree of credibility. Without the contrary evidence submitted by the other party, the web pages preserved in the form of electronic archive on that site may be deemed as true and correct. Based on that, the court adjudicated that the trademarks in the Internet industry have been used



in compliance with the law within the specified period of time, and shall not be deemed to be non-use in three consecutive years.[9] In *Yahoo! Inc. v. Shenzhen Yahoo! Messenger Technology Co., Ltd.* trademark infringement and unfair competition case, Yahoo! Inc. used the Internet Archive website with notarization as evidence as well. The court recognized the authenticity of the evidence and concluded that the evidence reflected the use of the relevant trademarks owned by Yahoo! Inc.[10] Therefore, in the process of proving the use and the fame for the trademark in the Internet industry, we may need to pay special attention to the characteristics of the Internet industry and provide the evidence innovatively.

In addition, there is the issue of the nature of cross-territory in the Internet industry vs. territory of fame for trademarks. The Internet has the nature and characteristics of cross-territory (including cross the boundary of nations), while the fame of trademarks has the nature of territory. Whether the nature of cross-territory may be recognized? How to prove the nature of cross-territory for the trademarks in the Internet industry? These issues involve not only legal issues but also technical and evidence issues. All of the similar questions need to be explored and developed through practice and theory in the future.

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[1] Shenzhen Luohu District Court Civil Judgment (2006) Shen Luo Fa Min Er Chu Zi No. 816. The trademarks “Penguin design” and “QQ design” were originally registered jointly by Shenzhen Tencent Computer System Co., Ltd. and Tencent Technology (Shenzhen), and the trademarks are held solely by the latter after the assignment in 2011

[2] List of well-known trademarks published by the CTMO on April 25, 2009

[3] List of well-known trademarks published by the CTMO on September 14, 2007

[4] List of well-known trademarks published by the CTMO on April 25, 2009. In March 2008, the trademark “GOOGLE” was transferred to Google Ireland Holdings

[5] List of well-known trademarks published by the CTMO on March 25, 2008

[6] List of well-known trademarks published by the CTMO on January 15, 2010

[7] List of well-known trademarks published by the CTMO on November 29, 2011

[8] List of well-known trademarks published by the TRAB on April 27, 2012

[9] Beijing First Intermediate Court Administrative Judgments (2010) No. 1597, 1598, 1599

[10] Shenzhen Intermediate Court Civil Judgment (2009) Shen Zhong Fa Min San Chu Zi No. 375

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