

# GET UPDATED ON INTELLECTUAL PROPERTY RIGHTS IN CHINA

NEWSLETTER | June 2024

品源知识产权 | BEYOND ATTORNEYS AT LAW



## Statistics Published by CNIPA

(January to May 2024)

CNIPA released further data shown in the table. Comparing with the same period in 2023 the total number of granted invention patents increased by 36.1%, while utility models and designs decreased.

Granted/Registered	January-May 2023	January-May 2024	Rate of Change
Invention patent	339048	461563	36.1%
Utility model patent	924275	784483	-15.1%
Design patent	296013	262676	-11.3%
Trade mark	1679048	2127802	26.7%
Number of PCTs Filed	27688	26922	-2.8%

■ The number of granted invention patents represented by BEYOND Attorneys At Law reached 11,507 in 2023, ranked No. 2 among all patent agencies in Beijing.

排名	专利代理机构	发明专利（授权）代理量（件）
1	[Redacted]	16,787
2	北京品源专利代理有限公司	11,507
3	[Redacted]	9,172
4	[Redacted]	7,934
5	[Redacted]	7,156
6	[Redacted]	6,739

resource: <https://www.ip-pilot.com/en/top-firms-for-pct-patent-applications-2023/>

■ BEYOND Attorneys At Law ranked 4<sup>th</sup> globally and 2<sup>nd</sup> in China according to IP Pilot's 2023 Global PCT Application Agency Rankings.

Rank: The Top 50 Firms for PCT Patent Applications

Rank 2023	Firm Name	Country	Number of PCT Filings 2023	Change since 2019
1	SHIGA INTERNATIONAL PATENT OFFICE	Japan	2141	10%
2	SCIHEAD IP GROUP	China	2140	9%
3	SAKAI INTERNATIONAL PATENT OFFICE	Japan	1999	21%
4	BEYOND ATTORNEYS AT LAW	China	1776	33%
5	PURPLEVINE INTELLECTUAL PROPERTY	China	1694	169300%
6	TDIP & PARTNERS	China	1644	79%
7	UNITALEN ATTORNEYS AT LAW	China	1514	99%
8	CHINA PAT INTELLECTUAL PROPERTY OFFICE	China	1431	57%
9	ADVANCE CHINA IP	China	1290	-19%
10	DRAGON INTELLECTUAL PROPERTY LAW FIRM	China	1270	23%

## Trademark Section

# Proposals on How to Overcome the Refusal concerning Retail and Wholesale Services

Updated: June 15, 2024

Under current trademark practice, the registrability of retail or wholesale services in respect of medicines and medical supplies has been ascertained in the Chinese Guidebook for Classification of Goods/Services. But the retail and wholesale services on other specific goods are still not acceptable in China for the purpose of trademark registration. It is very common that foreign applicants receive such kind of refusal notifications against the international registrations with extension protection designating China.

In the similar cases in 2016, we have ever suggested deleting the descriptions "retail and wholesale" from the list but unchanging the other goods so as to overcome the refusal. For instance, in the review of refusal case regarding IR No. 1186829 trademark "KILSGAARD", the applicant filed a limitation request before WIPO by deleting the description "retail sale and wholesale of" from the original list. The descriptions after limitation will be: "The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, namely ~~retail sale and wholesale of spectacle frames, spectacles [optics], spectacle lenses, optical correcting lenses, anti-glare glasses, goggles for sports, eyeglass cases.~~" Unfortunately the applicant then received "A DECLARATION THAT A LIMITATION HAS NO EFFECT" issued by the Trademark Office, which indicated that "The above mentioned goods and / or services are actually the enlargement of the original list of goods and / or services. Where a registered trademark needs to be used in respect of other goods of the same class, a new application for registration shall be filed." Obviously, the Trademark Office took a very stricter attitude towards the limitation request about "the retail and wholesale as well as related services" at that time.

We haven't recommended filing a limitation or amendment request about "the retail and wholesale as well as related services" since then due to the failure in the above-mentioned case. As long as the refusal ground is relevant to "retail and wholesale services", we usually suggest abandoning the application on these services or re-filing a fresh national application by using other similar descriptions acceptable under Chinese practice.

While, the author notices that, from the latest official decisions on review of refusal, the examination of the CNIPA seems to be more relaxed towards the limitation request of international registrations about "the retail and wholesale as well as related services" in Class 35. In the review of refusal case of IR No. 1665074 trademark "TABACALERA", the applicant filed a limitation request by only deleting the retail and wholesale as well as related services, i.e.: "Advertising services, promotion services ~~and retail and/or wholesale services for tobacco, smokers' articles and products related to tobacco; Collection, for the benefit of others, of tobacco, tobacco products, cigarettes, cigars, electronic cigarettes, liquids for electronic cigarettes, tobacco substitutes, matches, smokers' articles and various products related to tobacco, enabling consumers to conveniently compare and purchase those goods; The provision of commercial information via computer~~

~~databases, the Internet, telecommunications systems, online forums and social media sites related to tobacco, tobacco products, smokers' articles, liquor stores and retail points of sale of tobacco, smokers' articles, smokers' rights and smokers' areas; Providing consumers with advice and recommendations on products for commercial purposes concerning goods and services related to tobacco and tobacco, tobacco products, smokers' articles, liquor stores and retail points of sale of tobacco, smokers, smokers' rights and areas where you can smoke; Information and advisory services in relation to retailing and commercial retailing; Wholesale and retail ordering services in the field of tobacco.~~" Pursuant to the review decision issued on Feb. 26, 2024, the foregoing limitation request has been approved by the CNIPA, and therefore, the trademark application on the appealed services does not violate the regulation in Article 22 of China Trademark Law.

Similarly, in the review of refusal case of IR No. 1725565 trademark "HIGHLIFT BY OLVONDO", the applicant filed a limitation request by replacing "retail and/or wholesale services" with "sales promotion for others", i. e. "Retail and wholesale services (Sales promotion for others) in relation to machine tools, compressors, refrigerant compressors, heat exchangers (parts of machines), heat pumps, air cooling apparatus, refrigerating appliances and installations, ...", which, according to the review decision issued on Mar. 13, 2024, has been approved and is acceptable in China. Therefore, the trademark application on the appealed services does not violate the stipulation in Article 22 of China Trademark Law.

There is a view in the academic circles that, according to the interpretation of the text, "sales promotion for others" can fully cover the retail services of supermarkets and department stores. However, on December 7, 2022, the CNIPA issued the "Guidelines on the Application for Registration and Use of Class 35 Service Marks", which clarified that "sales promotion services for others" means providing specific advice, planning, consulting and other services to help others improve the sales or demand of their goods or services in the market. It does not include selling its own goods or services directly to consumers through retail or wholesale means, nor does it include selling other's goods or services to earn a price difference, that is, the mere sale of goods does not belong to the category of sales promotion for others.

Therefore, there is a certain difference in essence between "retail and wholesale services" and "sales promotion services for others". Nevertheless, as can be seen from the above latest cases, the CNIPA seems to be inclined to accept the direct deletion of "retail wholesale services" or amendment from "retail wholesale services" to "sales promotion for others", and does not think that the deletion or amendment will affect the original scope of the goods. Considering that the retail and wholesale services on other specific goods are still not acceptable in China for the purpose of trademark registration, the author believes that it is still a wise choice to overcome the refuse through the above restrictions. (By Shirley PENG)

## Dongguan ( 东莞 ) – Mega City in Guangdong Province

Dongguan city is located in south China, on the east bank of the Pearl River estuary, bordering Guangzhou City to the northwest, Shenzhen City to the south. It has a subtropical monsoon climate with long summers and abundant rainfall. According to the census in 2022 Dongguan City has a permanent population of 10.437 million.

The earliest traces of human habitation in this area date back to 5,000 years. In June 1839 the famous destruction of large quantities of opium at Humen took place, a town which belongs to Dongguan. This was considered the outset of the First Opium War (1840-1842). Between December 1840 and August 1841 several major battles were fought in Humen and Guangzhou.

With further development of China's economic reform and opening up, Dongguan City was upgraded to a prefecture-level city in January 1988, directly under the jurisdiction of

Guangdong Province. The city administration is known to be very proactive in attracting foreign investors, among which 45 Fortune 500 companies, more than 800 overseas listed companies settled down here. Dongguan has strong manufacturing capabilities and diversified industries. It is one of the largest producing hubs in the world with electronic products, telecommunication equipment, textiles and clothing, furniture, toys, papermaking, food & beverages and chemicals. Among Chinese cities Dongguan ranks No. 4 in exports, namely just behind Shenzhen, Shanghai and Suzhou.

With more than 9000 "national high-tech" enterprises in Dongguan City, there are several clusters of high-tech sectors. No wonder it ranks No. 2 in Guangdong Province in terms of the number of PCT filings in recent years. The city has 7 colleges and universities with more than 150 000 students and ca. 37 000 graduates each year.



**BEYOND**  
ATTORNEYS AT LAW

### BEYOND ATTORNEYS AT LAW in Key Figures

- Over 800 employees headed by a core team of 12 partners
- Headquarters in Beijing, China
- 16 branch offices in major Chinese cities
- 3 overseas representative offices in Munich, New York and Tokyo
- Ranked one of the top 10 Chinese IP law firms.

### Our Services

