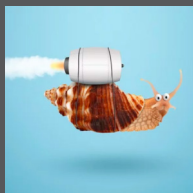




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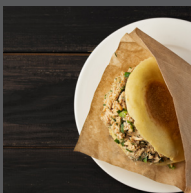
P2 CHINA IP

Fire up the engines: the successful case of MOTOVARIO



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Chinese Hey Tea wins against Singaporean copycat

Dear readers,

We start with a contribution regarding a case of trademark enforcement: recently won by HFG, the "Motovario-Case" is one of our best examples of how an efficient and consistent anticounterfeiting campaign can be successful.

The second article explains how "OMO 奥妙", a Unilever brand, widely known to the public in relation to laundry detergents, has been recognized as well-known and able to invalidate a copycat trademark.

Do you know what's Roujiamo? It's one of the most famous street foods in China, considered the Chinese hamburger, with a long tradition all over the country despite the origin in Shaanxi province.

What happens if a new association registers a collective trademark and asks all the shops to stop using that name or pay royalties? Read the article to discover it!

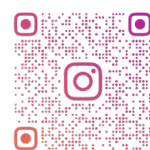
After all these issues about trademarks, we have a contribution that tries to give an answer to the request, typically Chinese, to have a trademark certificate for every product: how to explain the double soul of trademark certificates, being the most unvalued thing by foreign companies and the most valued thing from Chi-nese companies?

HEYTEA is a beverage brand that is taking the world by storm. Proudly made in China, HEYTEA is already part of China's pop culture. The product? Bubble tea with cheese topping. Can you believe that the brand got copied in Singapore?

The last article underlines the necessity to stay positive, or better: to think positive and stay actually negative! And in the overview of some ironic art production, it gives some suggestion on how to protect art under the copyright law in China.

Keep smiling, think positive, stay negative and read GossIP!

HFG Law&Intellectual Property



Trademark Enforcement/CHINA

Fire up the engines: the successful case of MOTOVARIO



The “*Motovario-Case*” is one of our best examples of how an efficient and consistent anticounterfeiting campaign can be successful.

Motovario is a company involved in the production of sales of worm gear reducers, NMRV and MOTOVARIO trademarks. Their products, already synonymous with quality and reliability since its foundation in 1965, are quite popular in Asia and in China especially.

As we all know, since imitation is the sincerest form of flattery, with the increase of such success, the number of counterfeited products increased accordingly.

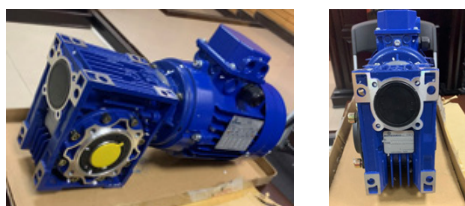
Being always caring about the quality, Motovario is also sensitive when it comes to counterfeits, aiming to keep “clean” the name and the story of their products and to not allow the consumers to be misled about the source of their worm gear reducers.

Over the years, Motovario has successfully carried out take down campaigns on the web and exhibition fairs against the counterfeiters.

But let’s go to straight to the main success.

In 2020, after discovering a company manufacturing and selling of counterfeited products bearing the MOTOVARIO trademark, Motovario International Trading (Shanghai) Co., Ltd. [摩铎利国际贸易 (上海) 有限公司] sued that company and its sole shareholder in front of the Dongguan City Second Intermediary People’s Court.

The company was the registrant of the infringing domain names and websites www.motovario-gear.com, www.motovario-china.diytrade.com selling products infringing Motovario’s trademark and making acts of unfair competition.



Counterfeit Motovario Motor-Gearbox

Motovario appointed HFG to initiate a civil litigation for trademark infringement and unfair competition. Motovario requested to the Court:

1. An order that the defendant shall cease trademark infringement against MOTOVARIO trademarks.
2. An order that the defendant shall assume damage for trademark infringement for RMB 500,000.
3. An order that the defendant shall make an apology statement on national newspapers.

Simultaneously, Motovario filed property preservation with the court, to freeze the defendant’s bank account, and to make the enforcement procedure quicker in case of success. Additionally, Motovario also filed notarized evidence of the infringing conducted in their detriment.

In order to increase the chances of having recognized a high amount of damage compensation, during the litigation Motovario point out the popularity of MOTOVARIO’s brand in continental China through the submission of several evidence.

Despite the efforts of the defendant to prove they get the reducer machine legally, on December 2021, the Judge issued the decision, confirming that the defendants had sold fake MOTOVARIO products through the two fake MOTOVARIO website, which constituted trademark infringement, and the Court supported most of our claims.

According to the Court’s word, both companies had to immediately stop selling counterfeit products, shut down their website and pay compensation to Motovario for the economic loss.

This decision represents a success in terms of recognition of the infringement of the defendants in detriment of Motovario and shows how the Courts are becoming more and more sensitive to the intellectual property rights in China.

“*We have achieved an excellent and fair result*” says Motovario General Manager in China , Mr. Rosario Pizzimenti.

Silvia Capraro
HFG Law&Intellectual Property

Trademark invalidation/CHINA

"OMO 奥妙" cleans up its reputation and gets well-known



With a recent decision, the Beijing Higher People's Court recognized that "OMO 奥妙" brand is widely known to the public in relation to laundry detergents and thus it can be protected as well-known trademark under Article 13.3 of the Trademark Law.

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Article 13 of the Trademark Law aims to provide well-known trademark owners with strengthened protection. Generally, normal trademark owners are being protected for similar or identical trademark over similar goods/services, while well-known trademarks can be protected over dissimilar goods/services (the so-called cross-class protection).

Whether cross-class protection can be granted depends mainly on the degree of well-knownness of the claimed well-known trademark, the likelihood of consumer confusion and other circumstances that may infringe the interests of the registered owner of the well-known trademark.

The "OMO 奥妙" case is a typical example showing the requirements of reaching a well-known status of a registered trademark. "OMO 奥妙" is a brand of fabric detergent owned by Unilever (the plaintiff), which entered the Chinese market in the early 1990s and has been known to Chinese consumers for nearly three decades.

	Disputed Trademark	Cited Trademark
Goods	Electric heating installations; heating elements; heating plates; solid, liquid, gaseous fuel heaters; burners; germicidal burners; water heaters; evaporators; heating units	Laundry detergents, laundry (detergent) agents and materials

In 2018, Unilever has filed an invalidation application against the copycat trademark "奥妙" registered in Class 3. After examination, the CNIPA held that the goods such as "electric heating device" approved for use by the trademark in dispute were different from "laundry detergents, laundry agent and materials", and thus should not cause confusion among relevant consumers.

The CNIPA rejected the request of invalidation and confirmed that the registration of the disputed trademark should not constitute the situation referred to in Article 13.3 of the Trademark Law.

Unilever was dissatisfied with the decision and appealed the case to the Beijing IP Court. The Beijing IP court reversed the CNIPA's decision and confirmed that the cited trademark has reached the level of well-known.

	Disputed Trademark	Cited Trademark
Trademark		
Trademark Number	No. 12156179	No. 1317644; 1508212 etc.
Applicant	Wuxi Lianhua Daily Use Technology Co., Ltd.	UNILEVER IP HOLDINGS B.V.
Class	11	3

The disputed trademark has copied the cited trademark and although the designated goods of disputed trademark and cited trademark are not similar according to the classification, but these goods are relevant because they are all daily supplies.

Thus, the use of the disputed trademark is likely to make the relevant public to link the disputed trademark with the plaintiff's cited trademark. Therefore, the registration of the disputed trademark violated Article 13.3 of the Trademark Law.

Continue reading

However, the case was not closed. The CNIPA, dissatisfied with Beijing IP Court's decision, appealed to Beijing Higher People's Court, and the Beijing Higher People's Court has upheld the first instance's decision, finding that the evidence submitted by Unilever proved that the registration of the disputed trademark violates Article 13.3 of the trademark law.

Below is a list of evidence that has been filed to the CNIPA and courts.

CNIPA

- ▶ Introduction of the brand
- ▶ Related statements and trademark information
- ▶ Relevant reports and website
- ▶ Search reports from the National Library
- ▶ Industry standards for related products
- ▶ Relevant sales invoices
- ▶ Other relevant evidence

Beijing IP Court

- ▶ An invalidation decision proving that the CNIPA has recognized the Cited Trademark (No. 1317644) as a well-known trademark on Laundry detergent
- ▶ Advertisements of “OMO 奥妙” products
- ▶ Trademark information of the trademark registrant
- ▶ Photos of the products
- ▶ Relevant audit reports
- ▶ Other relevant evidence

Beijing Higher People's Court

- ▶ A “Protection List” published by the Trademark Office in June 2000 showing that the trademark “奥妙 OMO” was given priority protection on detergents
- ▶ A Search Report issued by the Science and Technology Research Centre of the National Library on 23 May 2018
- ▶ Copies of sales invoices of Unilever
- ▶ MSA decisions
- ▶ Other relevant evidence

The Beijing Higher People's Court has found that prior to the filing date of the disputed trademark, Unilever had conducted a long-term and continuous promotion and sales of laundry detergents with its “OMO 奥妙” brand. Thus, the cited trademark has become widely known to the public and should be recognized as a well-known trademark.



Although the goods approved by the disputed trademark, such as “electric heating devices and heating plates”, and the designated goods of cited trademark “laundry detergents” are not similar goods, their sales channels and consumer groups are overlapped.

Thus, the coexistence of these trademarks will easily lead confusion among relevant consumers. The registration and use of the disputed trademark weaken the distinctiveness of Unilever's well-known trademark.

Consequently, the submitted evidence proves that the cited trademark was widely known to the public before the filing date of the disputed trademark, and should be recognized as a well-known trademark over goods of “laundry detergent” under Article 13.3 of the Trademark Law.

HFG Comments

Chinese Trademark Law does not define precisely “well-known trademark”, but only implies that a well-known trademark should be extensively used and advertised, and should enjoy a high reputation over designated goods in continental China.

An unregistered well-known trademark in China can be protected under Article 13.2 for the goods that are identical or similar to the goods for which the well-known trademark is famous for. For a well-known trademark that is already registered (Article 13.3), the special range of protection can be granted over different classes, which is also called cross-class protection.

How wide the cross-class can be reached usually depends on the reputation of the trademark; the higher the reputation, the greater the scope of protection. The above second instance decision also highlighted that “the protection of a well-known trademark should take into account its own popularity and distinctiveness, and that for well-known trademarks with high popularity and distinctiveness, a wider protection should be granted”.

In sum, Article 13.3 of the Trademark Law for cross-class protection is interpreted in the context of each individual case, and the scope of cross-class protection is dynamic and is determined in the context of the evidence in a particular case.

Summer Xia
HFG Law&Intellectual Property

Collective Trademark/
FOOD/ China

Roujiamo: trademark protection or fraudulent scheme?



Recently a dispute over collective trademarks has aroused heated debate across the Country. Roujiamo, also known as the Chinese hamburger, is one of the most famous street foods in China.

With multiple legends and a long history, Tongguan Roujiamo has become a symbol of the most authentic taste of the beloved snack, born in a small town in Shaanxi Province, East China.

A few months ago, many stores using the name of Tongguan Roujiamo were sued by the Laotongguan Snack Association (hereinafter referred to as the “Association”) because of trademark infringement.

The Association was born in 2016 and it is actually registered in the city of Tongguan. The Association has filed and registered the trademark “潼关肉夹馍” (No. 14369120) and based on such trademark raised hundreds of litigations with the aim of collecting damage compensation.

What’s more, if the sued stores still want to use a name containing Tongguan Roujiamo, according to the claims of the Association, they shall pay royalty for trademark license and subscribe to join the Association.



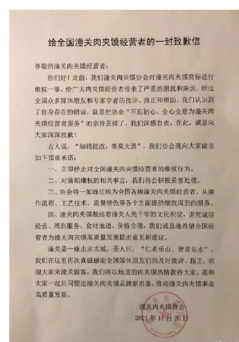
Many might have noticed that there are countless stores using Tongguan Roujiamo name/trademark all over the country. Virtually, these stores have become an invisible gold mine for the trademark owner, which can enable them to claim compensation through multiple litigations. If they succeed in most of the cases, it will be a lot of wealth.

According to the Trademark Law, a collective trademark mark is a mark registered in the name of a group, association, or any other organization and used in business activities by its members to indicate their membership. Unlike normal trademarks, geographical names can be contained in the collective trademarks.

For a normal trademark, it is a legal pattern to charge and authorize others to use the trademark. However, things are different in this case. Geographical indications shall indicate the place of origin of the goods, which shall not be simply authorized to be used by operators without the certain geographical region.

With more and more disputes aroused on the Internet, one of the judges of the Supreme People’s Court indicated that the geographical trademark can be used legally within the scope indicated by geographical indications. In contrast, those who do not meet the conditions for the use of geographical trademark or exceed the geographical scope cannot obtain the qualification to use the geographical trademark by means of trademark license, or membership of the association.

It is also clarified that the geographical trademarks are public resource. The registrant shall be a local non-profit group, association or other organization, which shall be legal and self-disciplined, and shall exercise litigation rights reasonably.



We take this chance to recall that, in June 2021, was published the “Official Reply of the Supreme People’s Court on Issues concerning the Claim of the Defendant for Compensation for Reasonable Expenses on the Ground that the Plaintiff Abuses Rights in the Action of Infringement on Intellectual Property Rights”.

Continue reading

It is stipulated that in the intellectual property infringement lawsuit, if the plaintiff's lawsuit constitutes an abuse of rights and damages its legitimate rights and interests as stipulated by law, and requests the plaintiff to compensate for the reasonable expense such as lawyer's fees, transportation expenses, board and lodging expenses paid by the defendant due to the lawsuit, the people's court shall support it according to law.

China National Intellectual Property Administration has already requested the related departments to investigate the progress of this incident, strengthen the administrative instruction of trademark protection and use. It is necessary to protect the intellectual property and prevent the abuse of the rights.

At present, the Roujiamo Association has stopped this series of action and apologized for the argument. A joint investigation team composed of the Bureau of Commerce, the Bureau of market supervision and administration, the Bureau of industry and information technology and other departments conducted an investigation.

Pepper and chili soup Industry Development Center of Xihua County also issued an announcement to order the association to stop the litigation.

**Peggy Tong
HFG Law&Intellectual Property**



IP CHINA

The hysteria of trademark certificates



As a lawyer, as a jurist I perfectly know that evidence is the key to victory in a tribunal, that the form is as important as the substance. However, I still don't catch the reason of the hysteria behind trademark certificates in China.

There is not one day passing without receiving a request about trademark certificates. Every single day. Trademark certificates have a double soul, being the most unvalued thing by foreign companies and the most valued thing from Chinese companies.

The demand for trademark certificates is so strong that you can find vendors specialized in selling (fake) trademark certificates on Taobao. CNIPA's and attorneys' fees are high and so Taobao "see and provides" a different cheaper solution. Certificates themselves have value, regardless of the relative substantial right.

However, the question remains still here: why the trademark certificates are so important?

Any person can make a search with the public database of the CNIPA or some paid database and verify who is the owner of a certain trademark. Of course, it might need a certain set of skills and some basic knowledge, but I would say that the information is available online and any IP attorney could be able to provide such service (at a very reasonable price).

Even if what above is true, in China it is very common that your business counterpart will usually require that you provide trademark certificates in relation to the product that you are going to sell. It is pure dogma. You want to sell a bike? You need to show the trademark certificate. You want to sell a cake? Trademark certificate first. A dress? Trademark certificate or nothing!

However, this routine, this habit is still underestimated by foreign companies. Whenever a Chinese counterpart asks for trademark certificates, the foreign company turns the face in a different direction, they ignore the request probably counting that will soon be forgotten. Or they probably think, why don't they check on the database instead of bothering me!?!

Also, often the managers of foreign companies become suspicious about such a request. If the trademark details are so easy to retrieve online why asking for the certificates? There must be a reason, maybe it is a kind of scam. Trademark squatting? Counterfeits?

We – as IP lawyers, as trademark attorneys – have this cultural challenge. We are in the friction point of these tectonic plaques, trying to explain to foreign companies making business in China that trademark certificates are very important here. And to Chinese companies we explain that foreign companies do not care at all at these plasticized yellow papers. Forget about it!

Yes, anyone can find online the details of the 30 million trademarks registered in China, but yet -anyhow- your client will demand that you provide the trademark certificates. Why? Not clear why, maybe because trademark certificates are one of the Alibaba's Group commandments.

And this is not all, in cauda venenum, there are differences in the trademark certificates. National trademarks have certain type of certificates, international trademarks have different ones. And be aware T-Mall does not like international trademarks (they might accept if you insist, but firstly they ask the national trademark certificates). Changes to trademark details also come with different certificates (license, transfer, company name, address, etc.).

DISCLAIMER: Clearly, this is not legal consulting but is part of the bible of making business in China.

Trademarks ASIA

Chinese Hey Tea wins against Singaporean copycat



HEYTEA is a beverage brand that is taking the world by storm. Proudly made in China, HEYTEA is already part of China's pop culture. HEYTEA, also known as 喜茶XiCha "happytea", is a trademark owned Shenzhen Meixixi Catering Management Co., Ltd. (hereinafter as Meixixi) and was founded by Neo Nie Yunchen in 2012. The product? Bubble tea with cheese and fruit topping.

Started off as a small tea store called "royal tea" (皇茶) in Jiangmen city, Guangdong Province, the brand quickly expanded into other cities in Guangdong and China. Due to a trademark issue, the original name "Royal Tea" was dropped and "HEYTEA" (喜茶) was adopted. By the end of March 2020, HEYTEA operated 450 stores in 37 Chinese cities and 4 stores in Singapore.

Popular for its cheese topped tea and fruit tea, the brand gained such a powerful popularity through Chinese social media to the point to create business collaboration such as Adidas and Fenty Beauty.



HeyTea for Adidas



Hey Tea for Fenty Beauty

After the first dispute for the original name (Royal Tea), in 2019, Meixixi had to face a new challenge in Singapore. A company called Heetea Pte Ltd. - in 2017 - had filed and registered the trademark HEYTEA in class 30 (tea product), while Meixixi had only secured the registration for HEYTEA in class 43 (tea stores).

In 2019 Meixixi filed an invalidation action against the Singapore-based Heetea Pte Ltd. (hereinafter as Heetea) against the trademark application HEYTEA in class 43 in front of Singapore Trademark Office. Four main grounds can be identified during the invalidation procedure.

Firstly, Meixixi argued that the trademark HEYTEA in class 43 is identical or similar to their earlier mark registered on January 23rd 2017 for similar services (tea store), resulting in a likelihood of confusion.

	Shenzhen Meixixi Catering Management Co., Ltd	Heetea Pte Ltd.
Specimen	HEYTEA	HEYTEA
Class	43 (tea shops etc.)	30 (tea beverages)

The hearing officer of the Intellectual Property Office of Singapore held that the marks were identical or at the very least highly similar, and that the goods and services, i.e. tea shops and tea drinks, were similar despite being in different classes. Consumers would be highly misleading in purchasing those drinks.

Therefore, the likelihood of confusion was successfully established.

Secondly, Meixixi claimed that their mark is well known in Singapore and that use of the counterpart trademark in relation to the claimed goods would indicate a connection and be likely to damage their business and asked the examiner to consider their trademarks as wellknown in Singapore.

However, the examiner held that evidence post-dating the registration date could not be taken into consideration. Based on the evidence lodged, the Hearing Officer held that the Applicant's claim was "simply a bare assertion which is not substantiated".



Thirdly, Meixixi argued that the counterpart trademark had been applied for in bad faith. The Hearing Officer held that the chronology of events, including HEYTEA setting up a new business entity called HEYTEA Pte Ltd., suggested that the counterpart had registered their mark in bad faith, simply to hold the Applicant ransom or to disrupt their business.

Continue reading

S/N	Date	Events
1	23 January 2017	Applicant applied to register the Applicant's Earlier Mark in Class 43 HEYTEA
2	3 May 2017	Heetea Pte. Ltd was incorporated
3	12 May 2017	Registered Proprietor applied to register [the Registered Mark] in Class 30 HEETEA
4	29 May 2017	Heytea Pte. Ltd was incorporated
5	5 October 2017	Registered Proprietor posted on Facebook a picture of its shopfront already fitted with "HEETEA" decorations and branding

The Hearing Officer also noted how the HEETEA had requested that the hearing proceed without their attendance or filing written submissions or bundle of authorities, for which the officer considered difficult to understand given the serious allegation of bad faith.

Finally, the Applicant argued that the opposed trademark would be in conflict with the laws of passing off and copyright. However, there may have been some lack of clarity in the submissions and evidence. The Hearing Officer simply said that the issues were not fully dealt with, and the Applicant was not successful on Ground 4.

Applicant's Copyright Work	Proprietor's Get Up
	



The Singaporean Trademark Office decided to invalidate the trademark HEYTEA in class 30 owned by Heetea Pte Lt. This subject decision provides a useful reminder that enforcement can be taken based on both registered and unregistered rights.

In this case, Shenzhen Meixixi had registered its mark three months before HEETEA, guaranteeing itself to rely on earlier registration rights.

Eventually, a company as well as an individual can protect their marks based on unregistered rights, claim bad faith, passing off, or breach of copyright. However, such actions will depend largely on the facts and evidence in each case.

Therefore, being the first to register a mark, is always the best solution. Not only in China, also in Singapore.

Laura Batzella
HFG Law&Intellectual Property

IP & Art

With a laugh
the lockdown will
pass: stay negative!



Shanghai is now facing its fourth week of strict lockdown: this can be defined an upsetting situation. People, often alone, are locked into apartments, often small. Or maybe even worse locked with the partner and the kids all day, all night. This can easily blow up your mind.

Someone shows anger by posting protests (and make Wechat surveillance team crazy to chase all the illegal content), other react differently.

We noticed that some people has a curious reaction to this difficult moment, instead of getting upset, they laugh and make others laugh.

Laughter, like exercise, increases adrenaline and oxygen flow, releases the endorphins of well-being and accelerates the heart rate. And just like a good workout, this “burst” of energy results in a feeling of relaxation and calm.

But it is more than just a feeling. In fact, studies show how humor can help us be more skilled in solving problems and making decisions. Scans of the cerebral cortex reveal that humor inspires creativity and helps the ability to think critically. “Humor is an essential element of healthy brain development, in both children and adults”, says Mary Kay Morrison, author of Using Humor to Maximize Living and founder of the Humor Academy at the Association for Applied Therapeutic Humor.

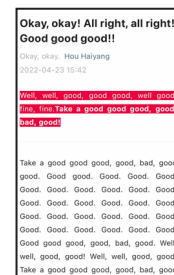
Furthermore, humor can represent the defense mechanism our bodies need to become more resilient in facing adversity. Being able to laugh during life's challenges - whether it's spilled milk or a pandemic lockdown - can, in fact, help us manage our emotional well-being. The ability to capture humor in an upsetting situation is an invaluable talent that can alleviate states of depression, loneliness and anger.

In this very moment we see a number of people that are able to do what Morrison suggests, meaning to capture the humorous side of these stressing circumstances. We already wrote about the phenomenon of meme [here](#). Today we want to explore another kind of artistic production.

It’s already quite well known the Malaysian POPaganda posters guy, Simon Fong, who reviewed the Mao-era propaganda posters in a humorous way, picturing typical moments of the Shanghai lockdown such as mass testing, shortage of food or lack of bare necessities.



Another piece that made me laugh is by Haiyang Hou, a Chinese artist who exhibited in Milan and published an article called Hao. The Wechat automatic translation, by the way, tries to give some kind of variety to the text, which I find hilarious:



But if I have to chose the best humorous graphic frames, I will go for sure with the “Stay negative” series.

The word is of course a joke between the “stay positive” frase that everyone is used to saying to cheer up, and the fact that during the pandemic is much better to stay, actually, negative (from CoVid).

Continue reading



This phrase “*Stay negative*” became a caption for a number of illustrations that captures special moments of Shanghai life that went viral with videos and photos on Chinese social media.

So you can find the “*white angel*” pointing a guy with a megaphone, the drone fishing, the expensive fruits, a revisited version of green code showing green fences instead, and many others, all depicted with an ironic voice.

The group behind this humorous production is called Ugly, and the purpose of the project is to raise money for charity for people in need because of the lockdown. According to the “*manifesto*”, in fact, *Stay negative* is “*an idea that has taken graphic form but that wants to do good, in practice*”.

And then arises the difficult question of whether or not to want the end of the lockdown... Because, according to what they told us, the project is limited to the lockdown period, and they will stop to produce the graphic pictures as soon as we’ll be released. Really?

Well, let’s forget about the fact that sooner or later we’ll be deprived of such hilarious graphic cartoons and have a look instead at the legal framework of this kind of creative production.

HFG’s partner Fabio Giacobello gives us the answer to the following question: What kind of legal / IP protection such kind of work enjoys?

The graphic works, such as those from the Ugly team or from other artists showed in this article, can enjoy protection under Chinese Law **since the moment of creation**.

Strictly speaking it is not needed to proceed with registration or recordation with any authority (like – on the contrary – shall be done for trademarks or patents).



What is very important is that author has **evidence** that he/she is the author and that creation happened at certain date. For this reason (a practical reason) we advise creators to proceed to voluntary recordation of the work of art with Copyright Bureau.

Such recordation ensures that in case needed, if someone abuse the copyright of the author, it is possible and simpler to prove paternity, date of creation and protect the copyright.

Silvia Marchi
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