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n° 57 WHD Case: TM | Heidelberg Materials AG successfully obtains registration of HEIDELBERG MATERIALS

Yang Mingming, 9 September 2024, first published by WTR

The case

Established in 1873, Heidelberg Materials AG, which is headquartered in Heidelberg, Germany, is one of the world's most renowned and influential building materials manufacturers. As an industry leader, the company provides essential building materials, such as cement, aggregates, ready-mixed concrete and asphalt, operating in over 50 countries worldwide.

On 30 March 2023 Heidelberg Materials AG filed for an international registration for its house mark, depicted below, in Classes 39 and 40, with territorial extension to China:

Heidelberg Materials

On 4 August 2023 the China National Intellectual Property Administration (CNIPA) rejected the application for all designated services based on the findings that:

1. 'Heidelberg', as a foreign geographical name well known to the public, shall not be used as a trademark; and
2. the mark is devoid of distinctiveness when used for the designated services.

Heidelberg Materials AG filed for review of the refusal, arguing, among other things, that:

- consent had been obtained from the Municipality of Heidelberg for the registration and use of the applied-for trademark; and
- the mark, as a whole, could be distinguished from the geographical name Heidelberg and function as a source identifier of services.

On 29 May 2024 the CNIPA approved the territorial extension application.

The difficulty of registering geographical names in China

Registering a trademark with a geographical name component may be quite challenging in China. In principle, geographical names are deemed to be inherently non-distinctive. Examiners often cite Article 10(2) of the Trademark Law to reject applications containing names of administrative divisions at or above county level or well-known foreign geographical names. If such marks are filed by applicants from locations other than those geographical names indicated in the trademark, they could be found misleading to the public, thus violating Article 10(1)(7) of the Trademark Law.

The prevalence of translation software and AI tools has also popularised foreign geographical names among the Chinese public, and the increasing awareness of such names is leading to more foreign geographical names being deemed well known in China.

The Supreme People's Court introduced, in its 2020 judicial interpretation, an exception that allows the registration of a trademark consisting of the geographical name of an administrative division at or above the county level or a well-known foreign geographical name and other elements, provided that the overall sign has a meaning distinct from the geographical name. The CNIPA further clarified in its 2021 Trademark Examination and Review Guidelines that "geographical names with other meanings" refer to those with a certain signification that outweighs the meaning as a geographical name and will not mislead the public.

However, in practice, the examination of marks with a geographical name component and other elements tends to be rigorous. Applicants seeking to register such marks will need to prove that their marks fall into any of the following scenarios:

1. the addition of other elements makes the overall mark distinctive;
2. the mark has formed a meaning stronger than that of the geographical name; or
3. the mark has no meaning and is not likely to be recognised as a geographical name.

In the present case, Heidelberg is a well-known city name in Germany, with its own entries in Chinese search engines and dictionaries. A search of the CNIPA database revealed that the CNIPA rejected the application for a trademark combining 'Heidelberg' with other words and a device filed by another applicant located in Heidelberg. The CNIPA reasoned that 'Heidelberg', as the distinctive part of the applied-for mark, referred to a well-known German city and thus constituted a well-known foreign geographical name that could not be used as a trademark. Given that the applied-for trademark constituted a mark prohibited from being used as a trademark, the applicant's use evidence could not serve as a basis for registration. Trademark rights are territorial, and the extraterritorial registrations for the applicant's mark could not establish its registrability in China.

Comment

Here, Heidelberg Materials AG was not only from Heidelberg, but had also obtained consent from the Municipality of Heidelberg for the registration and use of the applied-for trademark. A letter of consent from a city government, though not a mandatory document, may serve as an official endorsement that such a trademark, even in its place of origin, can perform its source-identifying function beyond the mere nomenclature of the geographical name. The success in the refusal review will help Heidelberg Materials AG deploy its house mark portfolio in China.

It is worth noting, however, that a letter of consent from a municipal government may not be a panacea for overcoming an *ex officio* refusal related to geographical names. The market fame of Heidelberg Materials in China and worldwide also played

a significant role in the successful registration of the trademark. Applicants are therefore advised to tailor their filing strategy on a case-by-case basis.

Wanhuida IP represented Heidelberg Materials AG in this case.

n° 65 WHD Insights: PT | What applicants need to know about partial design examination in China

Li Han, 25 July 2024, first published by WTR

The fourth amendment of China's Patent Law, which entered into force on 1 June 2021, introduced the concept of 'partial design'. Article 2.4 of the Patent Law defines 'design' as "a new design of the shape, pattern, or a combination thereof, as well as a combination of the color, shape and pattern, of the entirety or a portion of a product, which creates an aesthetic feeling and is fit for industrial application" (emphasis added). The revision, which makes a partial design patentable matter in China, is conducive to encouraging innovation in product details and helps China to align with international practice.

Although design patent applications are not subject to substantive examination in China, partial design applicants could still meet objections in the following aspects.

Eligible subject matter

In accordance with the Patent Law and the Patent Examination Guidelines, the claimed part in a partial design must be a new design that forms a relatively independent area within the overall product, thus constituting a relatively complete design unit. Moreover, a patentable partial design cannot be merely a pattern, nor a combination of pattern and colour on the product surface.

As shown in Figure 1, a design application seeking to protect the circular knob of a blender is clearly not a new design and will be rejected.

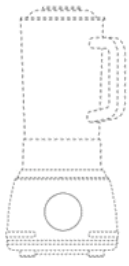


Figure 1

Figure 2 depicts a design application seeking to protect a randomly selected part of a bottle. The part, which does not form a relatively complete design unit within the overall product, will be rejected.

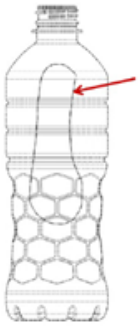


Figure 2

Figure 3 is a design application seeking to protect part of a pot lid. As the claimed part is purely a pattern design and lacks 3D effect, the application will be rejected.

Figure 3

Unity

Article 31.2 of the Patent Law provides:

A design patent application shall be limited to one design. Two or more similar designs for the same product, or two or more designs for products belonging to the same category and sold or used in sets, can be filed as one application. (Emphasis added)

In the context of partial designs, we merely discuss the first two underlined scenarios.

In general, 'one design' refers to a single part of the product. However, there is an exception where two or more unconnected parts on the same product can only be considered one design, provided that they have functional or design associations and form specific visual effects. Examples include the design of two eyeglass temples or two handlebars of a bicycle.

In principle, whether two or more partial designs are similar and can be filed as one design application hinges on whether:

- the overall product carrier is the same product;
- the claimed part is the same part; and
- the claimed parts are similar, with their proportion and position in the overall product being similar as well.

Figure 4 is a design application seeking to protect the handle of the blender jar and the base knob. These two parts are not physically connected and are unrelated in design and function; therefore, they will not be deemed as one design and cannot be filed as one design.

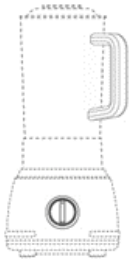


Figure 4

Figure 5 depicts three partial designs pertaining to the same product: a blender. All the claimed parts are the base, and the base designs are similar. The proportion and position of these bases in the overall product are also similar. Therefore, these three designs may be deemed as similar designs and filed as one application.

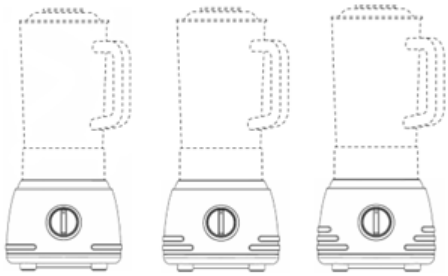


Figure 5

In Figure 6, the two partial designs pertain to the same product: a blender. However, the claimed parts are different; Design 1 is the base, while Design 2 is the blender jar. Therefore, these two designs are not similar designs and cannot be filed as one application.

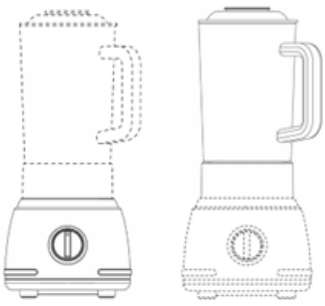


Figure 6

Drawings or photographs

In practice, the submitted drawings or photographs for partial designs should clearly and accurately indicate the claimed part and its position and proportion in relation

to the overall product. Ideally, six-sided orthographic projection views and one perspective view that can clearly show the claimed part should be included. If necessary, enlarged or cross-sectional views can also be submitted.
Although only protecting a certain part of the product, partial design applicants need to submit views of the overall product to indicate the position and proportion of the claimed part in relation to the overall product. Applicants are allowed to submit line drawings using a combination of solid and dashed lines, or photos or renderings using color coatings to differentiate the protected part from the rest.

It should be noted that when submitting line drawings, applicants must ensure that the claimed area is enclosed by solid lines. If the claimed area does not have a clear boundary with other areas, dash-dot lines can be used to separate them.

The practice aims to ensure the clarity and certainty of the patent rights, as only the part enclosed by solid lines (and dash-dot lines, if necessary) falls unambiguously within the scope of patent protection. On top of that, this practice also prevents applicants from including unrelated design elements in the design application, which could markedly undermine the enforceability of patent rights.

In Figure 7, the claimed part is the fork's prongs, rather than the handle. The protected area is not enclosed by solid lines; dash-dot lines should be added vertically (as indicated by the red circle) to separate the prongs and the handle.

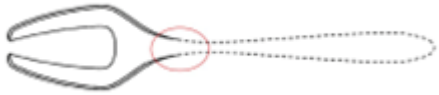


Figure 7

Comment

The examination practice for partial design applications in China differs significantly from that in other jurisdictions. Applicants seeking to protect partial design applications in China while claiming foreign priority are advised to study the discrepancies in examination practice to better navigate the terrain.

As Article 33 of the Chinese Patent Law mandates that post-filing modifications made to a design application must not extend beyond the scope represented by the original drawings or photographs, foreign applicants are strongly recommended to formulate their filing strategies in advance and retain the services of competent local patent counsel to avoid possible pitfalls.

n° 66 WHD Insights: PT | How to patent targeted therapy pharmaceuticals in China

Miranda Xie, 7 August 2024, first published by IAM

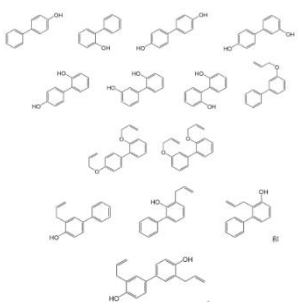
Targeted cancer therapies involve agents that directly or indirectly attack a specific genetic biomarker found in a given cancer. Examples of targeted drugs include small molecules, antibodies, polypeptides, antibody-drug conjugates and nucleic acids, among others.

For newly discovered biomarkers associated with a certain cancer, it is typical to file for a patent application over targeted therapy drugs, apart from when it comes to diagnostic use. In China, claims of such pharmaceutical use are drafted as Swiss-type claims, which often read: "agents that [inhibit a target] in the preparation of a medicament for the treatment of [a certain disease]."

Over the years, the China National Intellectual Property Administration (CNIPA)'s examination practice on this issue has shifted. In most cases, the CNIPA used to allow the pharmaceutical use of biomarker-derived agents, which were drafted to cover a broad scope of protection, as long as the pharmaceutical effect of the target is new. This led to the smooth granting of patents in the last 10 years with biomarker-related features, broadly defined as 'inhibitor', 'antagonist' or 'agonist'. Although some were further defined with functional features, most had a reasonably satisfactory protection scope. See below for some examples.

Application number	Granted claim 1	Grant date
201810265974.0	Use of VCP inhibitor in the preparation of an anti-tumor synergist or a drug-resistant reversal agent for oncolytic virus, wherein the oncolytic virus is the M1 virus.	2 October 2018
201710478154.5	Use of an miR-3648 expression inhibitor in the preparation of medicaments for the inhibition of bladder cancer metastasis.	27 March 2020
201710854229.5	Use of an agent inhibiting the Myosin1b protein expression in the preparation of medicaments for the treatment of cervical cancer.	2 February 2021
CN201680050962.5	Use of the Allergin-1 antagonist in the preparation of medicaments for enhancing immunity and suppression of progress or recurrence of cancer, wherein the Allergin-1 antagonist suppresses immunosuppressive intracellular signalling of Allergin-1.	12 November 2021

In the last two years, the examination criteria concerning targeted therapy drugs has been gradually tightened. In general, examiners are increasingly inclined to reject the claim on the ground that target-related features are devoid of support from the specification. See below for some recent examples of applications, which have been amended to overcome rejection.

Application number	Granted claim 1	Original claim 1	Grant date
CN201880070859.6	Use of an antibody that is capable of binding and inhibiting the ATPase activity combined with a platinum agent in the preparation of medicaments for treating cancer, wherein the antibody is made up of: • an HCDR1 comprising amino-acid sequence DYNMH (SEQ ID NO: 5); • an HCDR2 comprising amino-acid sequence YIVPLNGGSTFNQKFKG (SEQ ID NO: 6); • an HCDR3 comprising amino-acid sequence GGTRFAY (SEQ ID NO: 7); • an LCDR1 comprising amino-acid sequence RASESVDNFGVSFMY (SEQ ID NO: 8); • an LCDR2 region comprising amino-acid sequence GASNQGS (SEQ ID NO: 9); and • an LCDR3 region comprising amino-acid sequence QQTKEVPYT (SEQ ID NO: 10). This could be used to treat ovarian cancer, stomach or esophageal cancer, lung cancer, colon cancer, head and neck cancer and platinum-resistant cancer.	An antibody that is capable of binding and inhibiting the ATPase activity of the human CD39 (NTPDasel) protein for use in treating a tumor. The treatment comprises administering an effective amount of an antibody that is capable of binding and inhibiting the ATPase activity of CD39 in the presence of ATP, and an agent or treatment that induces the extracellular release of ATP from tumor cells.	20 Feb 2024
201810865178.0	Pharmaceutical composition for use in the prevention or treatment of pancreatic ductal intraepithelial neoplasia, wherein the composition is capable of reducing or inhibiting: • the biological activity of BCAT2; or • the expression of a gene encoding BCAT2. The pharmaceutical composition comprises an shRNA targeting the BCAT2 gene, wherein the sequence of said shRNA is as shown in SEQ ID NO:1-6, and the composition further comprises a pharmaceutical excipient.	Pharmaceutical composition for the prevention or treatment of pancreatic cancer, wherein the composition is capable of reducing or inhibiting: • the biological activity of BCAT2; or the expression of a gene encoding BCAT2.	16 April 2024
201980091497.3	Use of an NFkB inhibitor and adjuvant in the preparation of vaccines, and the NFkB inhibitor is selected from: 	A method for vaccinating a subject, which comprises administering an NFkB inhibitor and an adjuvant to the subject.	9 July 2024

On top of formal office actions, examiners are increasingly resorting to phone calls with patent attorneys to propose amendments that often further limit the claims.

In order to secure a satisfactory scope of protection, applicants seeking to patent drugs for biomarker-targeted therapy should submit diverse examples (eg, nucleic acid molecules, antibodies and small molecular) to build a solid case.

Further, if an applicant fails to secure a satisfactory scope of protection during the substantive examination process, it would be worth trying the reexamination procedure to reverse the initial decision, or to at least regain some lost ground. For example, in decision 1F422128, which was issued on 22 April 2023, the CNIPA's reexamination board allowed for a more reasonable scope than the examiner in the substantive examination. Of course, applicants must take into account the breadth of the specification in assessing the viability of reexamination. For example, specifications with mere experimental data of small-molecular examples would be highly insufficient to support a reasonable scope.

Finally, if the pharmaceutical use of a targeted drug cannot be granted with satisfactory scope, another option is to claim for a drug screening method.