

No. 2024-10

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n° 59 WHD Case: TM | DEL MONTE FOODS successfully blocks the registration of a seemingly dissimilar copycat mark

YANG Mingming & LI Chen, 6 November 2024, first published by [Lexology](#)

Del Monte Foods is a leading American food production and distribution company based in California. It is known for its popular brands like Del Monte, S&W, and Contadina. The company was founded in 1886, and the Del Monte brand was officially introduced in 1892. In 1916, the predecessor company, California Packing Corporation, also known as Calpak, which was formed through a merger of four large California canning companies, rebranded itself as Del Monte Corporation. The company began marketing its products under the Del Monte brand and expanded its operations to include canneries in various states and overseas.

On July 4, 2022, the opposed mark “” was filed by an obstinate trademark squatter called Quanzhou Qiandu Ecological Foods Ltd. (hereinafter referred to as Qiandu) in class 29, designating goods “canned fruit, canned fish, marinated olives, peanut butter, Auriculariales”, among others. Qiandu had repeatedly filed copycat trademarks mimicking the prior registered trademarks of Del Monte Foods and has been on the latter’s radar for years.

Qiandu used to register in class 30 (designating honey, soy sauce, ketchup and condiment) a combination mark “” (Qiandu CALPAK 1916 & device), which

specifically incorporates the distinguishing device from the house mark  of Del Monte Foods and the explicit reference to the latter’s predecessor company Calpak and the year of its rebranding. After the aforesaid trademark was invalidated, Qiandu changed its tactics and shifted away from filing strikingly similar copycat marks. By tweaking the shape of the device of the earlier copycat mark, adding some decorative elements and placing it against a green background, Qiandu

created the opposed trademark , a seemingly dissimilar mark.

In the opposition proceeding, apart from identifying the similarities the opposed trademark share with the cited mark, Del Monte Foods also underscored the bad faith of the opposed party in imitating many other famous food brands like “四季宝” (Chinese equivalent of Skippy).

On September 15, 2023, the CNIPA upheld the opposition and disapproved the registration of the opposed mark. The CNIPA affirmed that:

1. The opposed mark is similar to the cited mark in terms of visual effect and design,

and they constitute similar marks on designated goods that are partially similar to those of the cited mark, which is likely to cause confusion and misidentification among the consumers.

2. The opposed party has exhibited blatant bad faith in copying others' marks that have been used in prior and acquired certain reputation. In applying for the opposed mark, the opposed party intentionally duplicates, copies and imitates other's prior mark, which breaches the good faith principle, creates confusion over source of goods, prejudices fair competition in the market and contravenes the legislative spirit of the Trademark Law (banning the acquisition of trademark registration by fraudulent or other unfair means).

The outcome is quite inspiring.

Article 30 of the Trademark Law aims to prevent trademark confusion by banning the registration of a trademark that is identical with or similar to other's prior mark filed on or registered on identical or similar goods. The examiners adopted a holistic approach in ascertaining the likelihood of confusion (LOC). Other than the degree of similarity between marks, the examiners also weighed up the similarity of goods, the distinctiveness and reputation of the cited marks, and in particular whether the trademark applicant acted in bad faith in the LOC assessment.

As the CNIPA is taking a hardline and ratcheting up efforts against bad faith trademark filings and registrations, trademark squatters are adapting their tricks to game the system. They are employing all sorts of means to conceal and even whitewash their bad faith. Therefore, evidence collection pertaining to the filing record, trademark use status and other factors that may help establish bad faith on the adverse party should be high on the radar of brand owners. **W**



n° 69 WHD Insights: GIs | The Protection of Geographical Indications in China

Bai Gang & Paul Ranjard, Nov 27, 2024, first published by [Legal500](#)

1. Introduction

The TRIPS Agreement

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 15 April 1994 defines Geographical Indications as “... *indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin*”.

The Agreement leaves to the Members the choice between protecting GIs under the trademark system (the United States choice) or as a “*sui generis*” concept (the European choice).

The dual choice of China

China embraced both regimes and started, first, with the collective or certification trademark system and adopted, later and concurrently with the *sui generis* system, an *ad hoc* regulation in which GIs are defined as “GI Products”.

Trademark regime

In establishing its GI trademark regime, China cited and combined two different sources: (1) the definition of the TRIPS Agreement (above) and (2) the definition provided by the *Lisbon Agreement for the Protection of Appellations of Origin and their International Registration* (October 31, 1958), for the “Appellations of Origin”: “... *the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors*”.

In 2001, China’s legislator introduced Article 16.2 in the then Trademark Law, which reads as follows: “... *a sign which identifies a good originating from a certain region, where a given quality, reputation or other characteristic of the good is essentially attributable to the natural or human factors of the region.*” In 2002, the Implementing Regulation of the Trademark Law specified that “*GIs may be registered as collective or certification trademarks*”.

In 2003, China promulgated the “Regulations for the Registration and Administration of Collective Marks and Certification Marks”, which heralded the registration of a geographical indication as a collective mark or a certification mark.

“*sui generis* GI Products” regime

In 2005, China decided to protect GIs with a “*sui generis*” registration and protection system that runs parallel to the trademark system already in place. The “*sui generis*” regime is similar to what was in force in Europe. The *Provisions for the Protection of GI Products* published by the then quality watchdog Administration of Quality Supervision Inspection and Quarantine (AQSIQ)¹, define the GI Product using similar terms as the Trademark Law: “*The term ‘geographical indication product’ refers to products whose quality, reputation, or other essential characteristics are primarily determined by the natural and human factors of a specific region*”.

Both regulations were revised and respectively replaced by a new Regulation on Collective and Certification Trademarks and a new Measures on the Protection of GI products (both dated 29 December 2023), which entered into force on 1st February 2024.

2. Differences between the two regimes: enforcement

China’s institutional reform in 2018, which led to the dissolution of the AQSIQ and the integration of its remit over GI products under the roof of China National Intellectual Property Administration (CNIPA) has long triggered the speculation over the integration of the two regimes. The simultaneous promulgation of the two aforesaid regulations may have given, at the time, the impression that the creation of a unique regime of protection for all GIs could be well under way. Indeed, the concept of a “unified GI law” is a topic of heated discussion in the Chinese academia.

Six years on, a unified law is not yet on the horizon. The concomitance of the two regimes merits a thorough analysis of their differences, which mainly concerns the enforcement of the GI right.

Protection against conflicting trademarks

In fact, the term “enforcement” corresponds to two different situations which need to be distinguished: (1) protection against the registration of conflicting trademarks incorporating the GI, and designating identical, similar or even different products, and (2) protection against the use of the GI by third parties on identical, similar or even different products.

The Trademark Law offers unique legal basis and affords GI right owners protection against conflicting trademarks in three articles:

Article 10.1.7: “*The following signs shall not be used as trademarks:... (7) those deceptive, which are likely to mislead the public to misidentify the quality or other characteristics or place of origin of the goods;*”

Article 10.2: “*The geographical names (in China) ...and the foreign geographical names well-known to the public shall not be used as trademarks, [except if they have*

¹ China even created a third system under the Ministry of Agriculture, which was abandoned in March 2022, according to a reply of the Ministry of Agriculture and Rural Affairs (the successor of the Ministry of Agriculture) to an online inquiry regarding the accreditation policy of agricultural product geographical indications.

other meanings or are part of a collective mark or certification mark.]”

Article 16.1: *“A trademark that consists of or contains a geographical indication in respect of goods that are not originating from the indicated region to such an extent as to mislead the public, ...shall not be registered and shall not be used.”*

Based on Article 16, foreign GIs like the famous Margaux and Romanée Conti wines obtained the refusal or invalidation of trademarks using their name, even without trademark registrations in China. The CNIPA also sided with owners of registered collective trademarks of Napa Valley, Bordeaux, and Saint Emilion, in refusal or invalidation proceeding, citing Article 16 or Article 10.2.

And even when different products are concerned, Article 10.2 was wielded by the Comité Interprofessionnel du Vin de Champagne (CIVC) to prevent Victoria Secret from filing the name VICTORIA'S SECRET CHAMPAGNE GLOW, designating "cosmetic preparations for skin care; bath preparations, not for medical purposes; perfumes" in Class 3.

Protection against infringement

Concerning the protection against acts of infringement, the two systems - trademarks and GI Products - provide different solutions. Right owners may resort to the two systems even if their GI has not yet been registered, either as a collective/certification trademark or as a GI Product, as illustrated by some of our practice below.

Protection of unregistered GIs

In 2011, the CIVC had not yet secured the registration of *Champagne* as a collective trademark (the registration of foreign GI Product was only possible in 2016) and found out that a Chinese company was selling sparkling water called Seven Star Champagne. The CIVC initiated a civil action before the Beijing No.1 Intermediate Court in 2012, citing articles 10.1.7, 10.2 and 16 of the Trademark Law, as well as Article 13 (unregistered well-known trademark). The court took three years to decide and finally, after careful analysis of all the legal means cited by the CIVC, ruled in favor of the CIVC on the basis of Article 16, finding: Champagne is a geographical indication and the sparkling water of Seven Star does not originate from such place. The court added that the geographical indication should be protected regardless of whether, or not, it is registered as a collective mark or certification mark in China.

Protection of GIs registered as trademark

Once a GI is registered as a collective or certification trademark, the enforcement of the right is governed by the relevant articles of the law, with no difference from other ordinary trademarks. The GI trademark can also be recognized as a well-known trademark and enforced against the use on different goods.

In 2020, the CIVC launched a civil action before the Beijing IP Court against two Chinese companies manufacturing and selling perfumes under the name *Champagne Life*. In February 2022, the court decided in favor of the CIVC, establishing, first, that the collective trademark Champagne is well-known, as provided by Article 13 of the

Trademark law. The court elaborated on the issue, explaining that the reputation achieved by Champagne resulted from its long duration of use as a GI before it was registered. The court also specified that the reputation acquired by the main producers of Champagne benefited the CIVC, owner of the GI. Finally, the court added a comment on the necessity for the CIVC to protect the GI against a claim that the name Champagne could be considered as a generic term. The defendants were ordered to pay damages and costs totaling RMB220,000. In November 2023, the Beijing High Court confirmed the first instance judgment.

More recently, in May 2023, the CIVC brought an action against a company selling non-alcoholic beverage under the name “Little Champagne”. The Beijing IP Court, in its judgment of 29 September 2024, found that sparkling wine and non-alcoholic beverage are dissimilar goods and that, due to the reputation of Champagne, the use of such name on non-alcoholic beverage creates a risk of association in the minds of the consumers which is detrimental to the interests of the CIVC. The court added a similar comment as regards the risk of genericity which justifies the need to protect the GI Champagne. The defendant was ordered to pay CIVC damages for RMB400,000 plus cost RMB80,000. The case is currently under appeal.

Finally, another recent case illustrates the willingness of Chinese courts to protect well-known GIs registered as collective trademarks. In 2023, the CIVB (Conseil Interprofessionnel du Vin de Bordeaux) filed a civil action before the Shenzhen Intermediate Court against a company operating a club where consumers can play games while enjoying a foot massage. The club called itself Xixiang Bordeaux Leisure Club. On 30 September 2024, the court decided in favor of the CIVB, stating that the collective trademark Bordeaux is well-known in China and that the use of this name, even in the absence of confusion, weakens the association between the GI and the famous wines produced in the region. Furthermore, the use of Bordeaux in the tradename of the defendant was considered as an act of unfair competition. The defendant was ordered to pay RMB50,000 as damages and costs.

Protection of GI Products

Cases of enforcement against acts of infringement involving a GI product are rare, due to the absence of a special law regulating such infringement actions.

The Measures of 29 December 2023 provide (article 30) that violations are “...*subject to relevant laws and regulations...*”

As a matter of fact, the Civil Code of China, promulgated on 28 May 2020 provides in Article 123 that “*Civil subjects enjoy intellectual property rights according to law. Intellectual property rights are [...] (4) Geographical Indications...*.” However, whereas the enforcement of works of art, inventions, trademarks and trade secrets is explicitly provided by copyright, patent, trademark, and anti-unfair competition laws, there is no “GI Law” supporting the enforcement of GIs.

In practice, the only law that can be used is the Anti-Unfair Competition Law. Article 2 establishes the principle of fairness and good faith in business activities and Article 6 addresses situations where a business operator misleads consumers into believing that its own goods are the goods of another entity.

Article 2 of this law was cited once, successfully, in a case between the Bureau National Interprofessionnel du Cognac (BNIC) and the car manufacturer Ford.

In 2018, Ford China launched a series of vehicles under the name "COGNAC Special Edition" including models like the "EcoSport COGNAC Special Edition" and "Mondeo EcoBoost 180 COGNAC Special Edition".

These vehicles were promoted on Ford China's official website and on other media. The marketing campaign went as far as using the tagline of "Not all brandies are Cognac, not all Fords are Cognac", which inappropriately leveraged Cognac's prominent position in brandy to endorse the premium quality of Ford's Cognac series vehicles. Ford also used "COGNAC Brown" to refer to the color of the interior decoration of these vehicles.

On 23 November 2020, the Suzhou Intermediate Court decided that, by exploiting the reputation of the name Cognac, Ford had committed acts of unfair competition, violating Article 2 of the law. Ford appealed to the Jiangsu Provincial High Court who confirmed the first instance decision in 2023.

3. The need for a GI Products Law

The BNIC v. Ford case, high profile as it may be, is an exception and does not offset the weak enforcement of GI Products against acts of infringement.

This weakness is due to the absence of power of the administrative enforcement authority to take action when GI Products are infringed.


Such powers had been provided in a draft regulation issued in 2020, and again in 2023, by the CNIPA, which provided: *"In case of any of the following [infringing] acts, the authorities responsible for enforcement for geographical indications shall order the offender to forthwith stop the illegal act; where there is illegal turnover, the illegal turnover shall be confiscated; in serious cases, a fine of not more than five times the illegal turnover, capped at RMB100,000 may be imposed; where there is no illegal turnover or the illegal turnover is less than RMB50,000, a fine of not more than RMB50,000 may be imposed"*.

Unfortunately, the final text of the Measures promulgated at the end of 2023, did not keep this provision. The reason is apparently that, as indicated in the State Council Institutional Reform Plan dated 7 March 2023, the CNIPA, which used to be administered by the State Administration for Market Regulation (SAMR), was elevated to a higher administrative echelon and became an institution directly under the State Council. As a result, the CNIPA no longer has the enforcement authority over the IP rights. This responsibility belongs now to the SAMR.

Besides, the absence of a GI Law does not help either. Such a law could provide for the protection of the GI Products in the same manner as the Trademark Law addresses the issue of the protection of trademarks. Right holders of GI Products need a law that clearly defines the scope of protection of their rights and serves as a legal base for legal civil action, or criminal prosecution, as the case maybe.

The European model

In that regard, China could find inspiration in the latest European Regulation dated 18 October 2023, which provides that GIs shall be protected “*against any direct or indirect commercial use [...] where the use of the name exploits, weakens, dilutes, or is detrimental to the reputation of the protected geographical indication*” and “*against any misuse, imitation or evocation of the name protected as a geographical indication...*”.

The few cases mentioned above show that China is quite in line with the European view, even though it achieves an equivalent level of protection through different legal means (protection of well-known trademark or unfair competition). 

n° 70 WHD Insights: PT | CNIPA’s new tweak over inventiveness assessments of co-solvent compound crystals

Wu Xiaohui, October 15, 2024, first published by [MIP](#)

The invention patent for drug crystal forms has been a key cog in chemical products research and a critical building block in the patent portfolio of pharmaceutical corporations. Invalidation decision No. 580021 made by the CNIPA on June 21 2024 offers a glimpse into the agency’s shift of focus and its latest inventiveness assessment practice regarding co-solvent compound crystals, which merits analysis and dissection.

Case summary

AstraZeneca owns patent No. 200780024135.X (the Patent at Issue), which relates to the S-propylene glycol hydrate of Dapagliflozin, a prescription drug for type 2 diabetes. On August 9 2023, Nanjing Huaxun Intellectual Property Consulting Co., Ltd. (the Petitioner) initiated an invalidation action, mainly challenging the inventiveness of the Patent at Issue, among others. On June 21 2024, the CNIPA issued the aforesaid invalidation decision to maintain the validity of the patent.

Claim 1 of the Patent at Issue sought to protect the crystalline structure of the compound in formula Ia (i.e., S-propylene glycol hydrate of Dapagliflozin) and specified the powder X-ray diffraction pattern.

The Petitioner cited multiple pieces of evidence – including the Dapagliflozin L-phenylalanine complex disclosed in evidence 1 or 2 as the closest prior art, combined with evidence 4–8, 16–18, and common knowledge – to argue that claim 1 lacks inventiveness. Evidence 9-11 was adduced by the Petitioner for the purpose of proving common knowledge.

The panel started with identifying the difference between claim 1 and evidence 1,

finding that claim 1 seeks to protect the crystalline structure of formula Ia and specifies the powder X-ray diffraction pattern, while evidence 1 discloses the Dapagliflozin L-phenylalanine complex form. Based on the distinguishing features, the technical problem actually solved by claim 1, relative to evidence 1, is to provide the crystalline structure of Dapagliflozin shown in formula Ia. The key issue in this case could be boiled down to whether the evidence on record suffices to substantiate that for the Dapagliflozin L-phenylalanine complex, it is obvious to introduce S-propylene glycol and water to form a co-solvent compound.

The panel then parsed through the evidence submitted by the Petitioner, concluding that:

- Evidence 1 discloses the Dapagliflozin L-phenylalanine complex. However, due to the different chemical structures and physicochemical properties of L-phenylalanine and propylene glycol, a person skilled in the art would be unable to envisage forming a solvent compound of Dapagliflozin with propylene glycol, based on this evidence.
- Although evidence 4 highlights the advantages of propylene glycol solvent compounds, the enumerated compounds differ significantly in terms of structure and properties from Dapagliflozin. On top of that, evidence 4, which makes no mention of S-propylene glycol solvent compounds, fails to provide sufficient technical guidance.
- Evidence 5–8 involves drugs that share no similarities in chemical structure and physicochemical properties with Dapagliflozin, thus offering no technical inspiration.
- Evidence 9–11 pertains to general research methods for polymorphs and does not involve specific applications of S-propylene glycol solvent compounds, thus providing no technical guidance.

As regards the inventiveness assessment, the panel delved into the potential industrial value generated by the Patent at Issue. The panel opined that the differential scanning calorimetry thermal analysis diagram in the description of the patent shows that the endothermic peak of the (S)-PG crystalline structure of formula Ia is at 71.43°C, while that of the (R)-PG crystalline structure of formula Ib is at 52.29°C.

These results indicate that the (R)-PG crystalline structure of formula Ib may melt at a temperature that is slightly above room temperature or during the drug formulation process, leading to uncontrollable drug formulation quality. This is a technical problem that needs to be addressed at the industrial application level. In contrast, the endothermic peak of the (S)-PG crystalline structure of formula Ia, as involved in claim 1, is markedly higher so as to solve the above technical problem and thus possesses industrial application value.

Therefore, even if a person skilled in the art uses propylene glycol to prepare a Dapagliflozin solvent compound, they would not conceive that S-propylene glycol, as opposed to R-propylene glycol, could solve the technical problems present in industrial applications.

Ultimately, the panel concluded that the technical evidence on record does not provide any technical guidance for the preparation of Dapagliflozin as an S-propylene glycol hydrate. The Petitioner’s argument that claim 1 lacks inventiveness, based on

evidence 1 disclosing the Dapagliflozin L-phenylalanine complex as the closest prior art, was untenable.

Comments on the CNIPA's inventiveness assessments of co-solvent compound crystals

This case is very intriguing, as it diverges from the CNIPA's past practice.

The CNIPA used to assess the inventiveness of drug crystal form inventions by taking into account:

- Whether there is technical teaching in the prior art; and
- Whether the patent at issue has achieved unexpected technical effects compared with the prior art.

Based on such methodology, the panel tends to believe that there is a research need and technical teaching for crystallisation and recrystallisation of known compounds in the prior art. As the crystal form of a compound and the compound per se, as well as a new crystal form and the known crystal forms thereof are deemed structurally similar, the presence of inventiveness would hinge on whether the claimed drug crystal form has unexpected technical effects. Solvates, as pseudo-polymorphs, are also subject to similar examination criteria.

It is therefore quite creative that the subject decision – based on the disclosed content of the evidence, especially the differences in structure and physicochemical properties between the compounds involved and the crystal form compound at issue – shifts its focus back to whether the prior art provided technical teaching for preparing Dapagliflozin as an S-propylene glycol hydrate, rather than whether the Patent at Issue achieved unexpected technical effects. Specifically, in assessing the common knowledge evidence, the decision found that it only involves general research methods for polymorphs but fails to include the specific application of S-propylene glycol solvates to drug compounds to improve certain properties.

The panel therefore concluded that a person skilled in the art could not obtain technical teaching from the cited common knowledge, and the prior art did not directly indicate a general motivation to form this crystal.

This decision provides an alternative examination route, which could be attributable to the structural differences between the Dapagliflozin S-propylene glycol solvate and its compound, as well as the industrial value generated therefrom. In a nutshell, the very core of an inventiveness assessment of crystal form patents lies in the presence of specific and clear technical teaching in the prior art, which is to be ascertained by factoring in the disclosures made by such prior art. 