



## Trademark Invalidation Administrative Dispute Between B & W

**GROUP LTD, China National IP Administration and Yiwu Pinshang Auto Products Co., Ltd. (2022) 京 73 行初 No. 11026**

### [Brief]

B & W GROUP LTD ( “B & W” ) filed an invalidation request against the trademark No. 32974277 in Class 12. The China National IP Administration ( “CNIPA” ) issued a decision on invalidation request, finding that the disputed trademark and the cited trademarks do not constitute similar trademarks used on similar goods, and thus maintaining the registration of the disputed trademark. B & W was dissatisfied and filed a lawsuit. The Beijing Intellectual Property Court made a judgment, holding that the disputed trademark “Bovvers & Wlikins” used on goods “upholstery for vehicles and etc.” in class 12 constituted a similar trademark used on similar goods to the cited trademarks “BOWERS & WILKINS” and “宝华韦健” (BOWERS & WILKINS in Chinese Characters) in respect of goods “loudspeakers and etc.” in class 9, and violated Article 30 of the Trademark Law and should be declared invalid in accordance with the law. The decision of the CNIPA was subsequently revoked.

### [Reasoning of the court]

When determining whether coexistence of two marks would cause confusion among the public, the degree of similarity between the two marks and the degree of similarity between the goods shall be

considered. In this case, “vv” in the disputed trademark “Bovvers & Wlikins” are visually similar to the letter “W” in the same position in the cited marks 3 and 4 i.e. “BOWERS & WILKINS”, and “li” in the disputed trademark are in the same position as the “IL” in the citations. The disputed trademark shall be considered confusingly similar to the cited trademarks 3 and 4 in terms of letter compositions, pronunciations and overall visual effects. Meanwhile, the disputed trademark should be considered similar to the cited trademarks 1 and 2 i.e. “宝华韦健” (BOWERS & WILKINS in Chinese Characters) in terms of similar pronunciations. In accordance with local Nice Classification, the goods under the disputed mark and those under the cited marks are not considered as similar to each other. However, the Nice Classification should not be taken as the sole criteria but only a reference in determining similarity of the goods. The Plaintiff is a manufacturer of audios including the main products car audios which are overlapped with or closely related to decorations in vehicles and other automotive assembly parts under the disputed mark in terms of functions, usages, sales channels and target consumers. Further, according to the Notary Certificate submitted by the Plaintiff in the litigation stage, the Third Party used the identical words as the cited trademarks 1 and 2 “宝华韦健” (BOWERS & WILKINS in Chinese Characters) in promoting the products and the publicity pages in the shops also demonstrate the bad faith of the Third Party in taking free ride of the reputation of the Plaintiff. In light of the similarity of the marks at issue and the close relationship between the designated goods thereof, there is likelihood of confusion arising from co-existence of the subject trademark registration and the cited marks. Therefore, the registration of the disputed trademark shall violate Article 30 of the Trademark Law and the CNIPA decision should be canceled.

#### **[Our contribution]**

Mr. Hong ZHENG and Ms. Liling YUAN, attorneys of Tee & Howe, represented B & W and won this case. The difficulties of this case are that the goods under the trademarks at issue are not deemed as similar according to Nice Classifications while the evidences from the Plaintiff are not sufficient enough to have its cited marks as well-known marks, the disputed trademark was subsequently transferred to the Third Party while the number of the trademarks applied by the original registrant is low to reveal its bad faith. Facing these challenges, our attorneys focus on the

close relation of the goods, the obvious bad faith of the Third Party and the actual confusion already incurred by the Third Party's actual business operation. The attorneys also arranged on-site investigations and found that the Third Party and the original registrant used the disputed trademark together with the Plaintiff's cited marks “宝华韦健” to mislead the consumers. The third Party runs several shops of modifying car audios and describes the “car audios” just as “decorations in vehicles”, which reinforces and confirms the close relation between the Plaintiff's goods “loudspeakers” and those of the disputed marks. These materials become the most striking evidence in this case to overturn the CNIPA's decision and exceptionally render a cross-class protection for a non-well-known trademark but with certain fame.



**Hong ZHENG**  
**Partner; Attorney-at-Law**

Mr. ZHENG is a PRC Attorney-at-Law specialized in the field of IPRs prosecutions and enforcement. His areas of practice cover counseling on trademark, domain name, copyright, unfair competition law and patent infringement, including advising on securing and defending IP rights, taking legal actions against bad faith applications, counterfeits and infringing acts, negotiating for acquisition of trademarks, licensing and handling UDRP actions.

Mr. ZHENG has acted for many multinationals in managing and protecting trademark portfolios in China and handled hundreds of trademark prosecution cases. He has also represented many leading companies in over 200 both civil and administrative litigations in China, some of which were widely recognized as landmark cases in the IP field.



**Liling YUAN**  
**Trademark Attorney; Attorney-at-Law**

Ms. YUAN obtained her Master of Law degree from Renmin University of China. She joined Tee & Howe in 2015 as a trademark attorney and is currently acting as an Attorney-at-Law as well.

Ms. YUAN has almost 13 years' practicing experience in trademark field and specializes in the prosecution, enforcement, licensing, acquisition, anti-counterfeiting, infringement, dispute resolution and other IP-related matters. She has served numerous well-known domestic and international companies on trademark affairs. She could always combine her in-depth perspective with feasible strategy and provide practical recommendations for the clients.

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