



IP CASE EXPRESS



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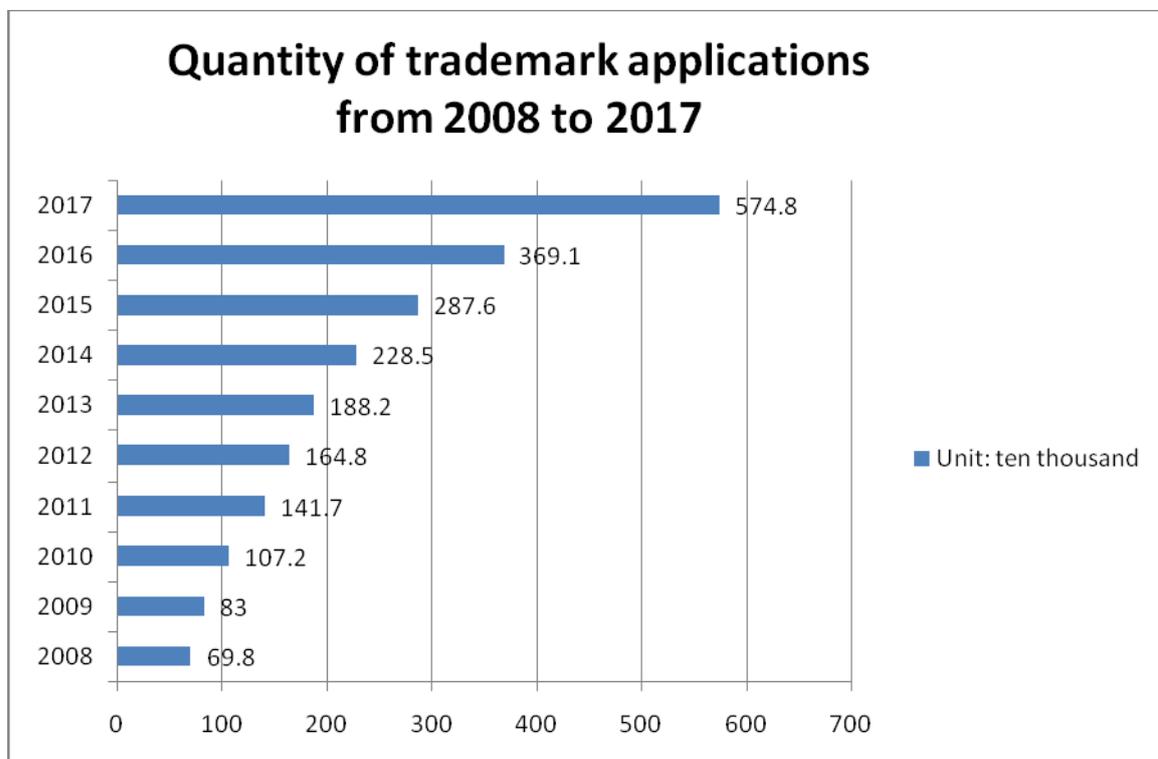
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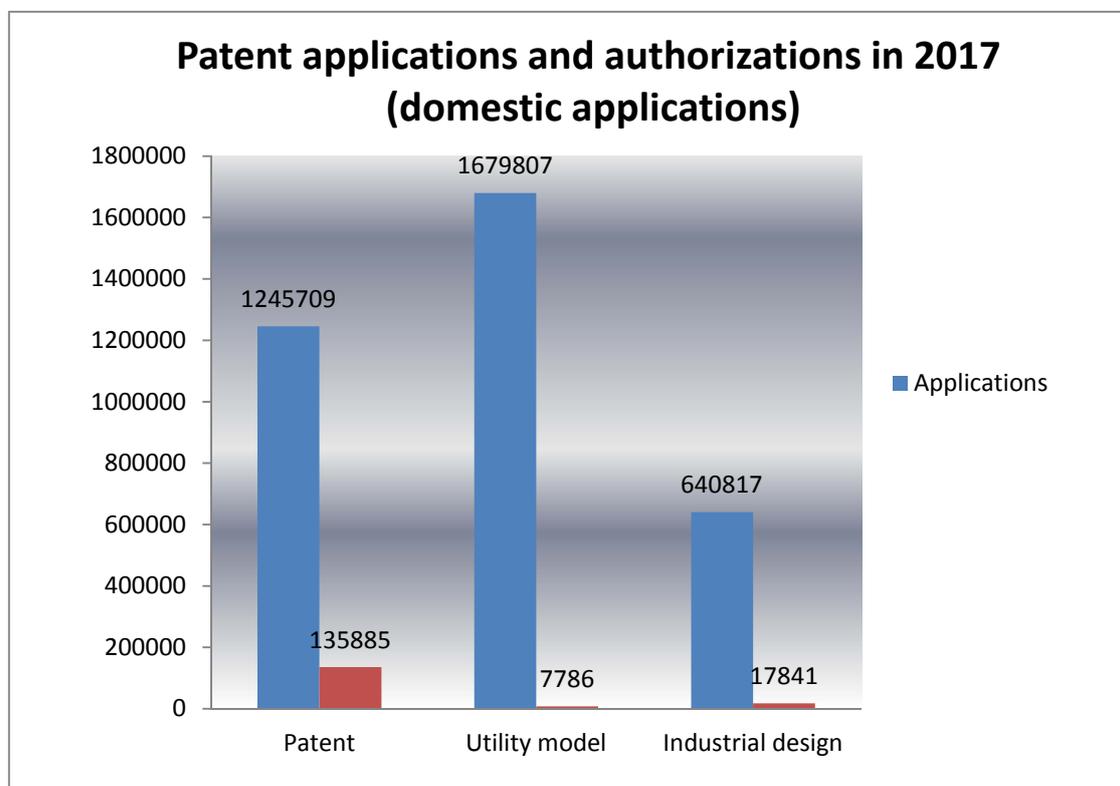
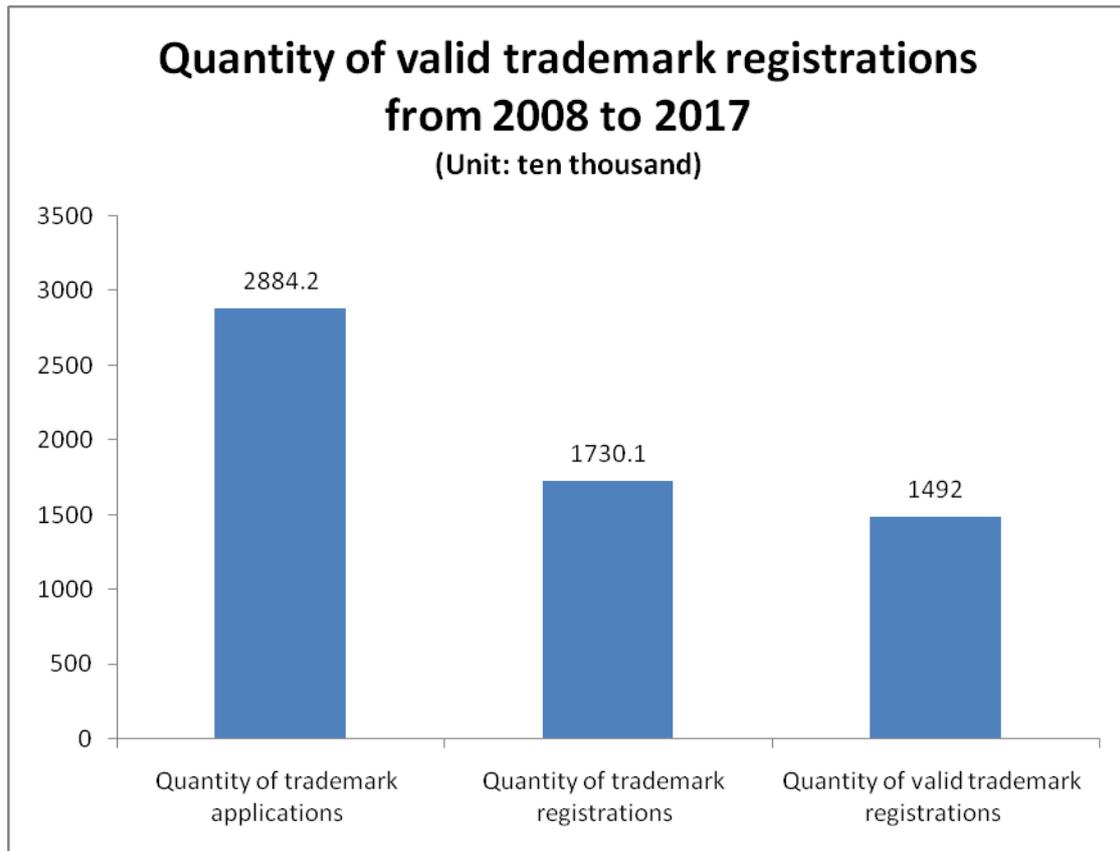
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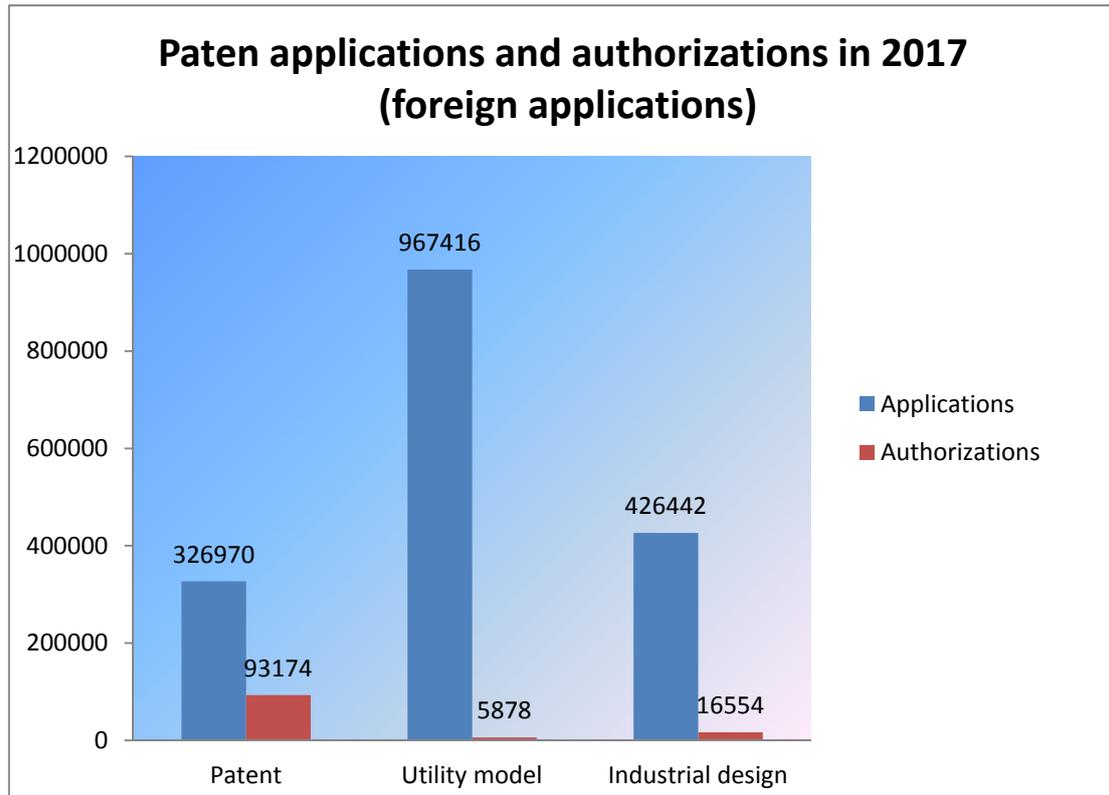
In this edition, we browsed and analyzed IP-related court judgments and adjudications together with the key statistics recently, and we would like to share with you noteworthy statistics and our comments on some significant cases.

I. **Statistics**

China's Patent & Trademark-related Statistics







Source: State Intellectual Property Office

II. Comments on Typical Cases

Patent

Chen Huaqing v. Patent Reexamination Board

- *Second instance: Beijing High Court civil judgment (2017) Jing Xing Zhong No. 1082*
- *First instance : Beijing Intellectual Property Court civil judgment (2016) Jing 73 Xing Chu No. 126*



Rules:

The patent invalidation proceedings are quasi-judicial proceedings initiated upon request of the invalidation petitioner. As invalidation proceedings involve both parties, the Patent Reexamination Board (“PRB”) shall act as an impartial judge,

so as not to diminish the value of such proceedings.

The ex-officio examination of PRB shall be subject to strict restrictions. Rule 72.2 of the Rules for the Implementation of the Patent Law only grants PRB the power of making ex-officio decisions on behaviors of the invalidation petitioner before oral hearings. In this case, the disputed behavior happened after oral hearing, so the invalidation decision made by PRB in accordance with Rule 72.2 of the Rules for the Implementation of the Patent Law obviously exceeds the scope of ex-officio examination and does not comply with the law.

Facts:

In this case, the invalidation petitioner made an invalidation request on April 2, 2015 before PRB. PRB issued a notification of oral hearing to both parties on April 13, 2015, appointing May 5, 2015 as the date of oral hearing. The invalidation petitioner submitted an

observation and supplementary evidence on April 30, 2015. The oral hearing was held as scheduled and both parties were present. During the oral hearing, PRB transferred the supplementary evidence and the observation submitted by the invalidation petitioner to the patentee, and notified the patentee that he may submit written opinions within a specified time limit.

After the oral hearing, the patentee submitted his observation in response to the petitioner's observation and supplementary evidence, and amended his claims. Then, PRB transferred the patentee's observation and its appendixes to the invalidation petitioner, and requiring the latter to state opinions within a specified time limit. The invalidation petitioner did not state any opinion within the specified time limit. Later, the patentee submitted another observation and amended his claims again. PRB directly made a decision of invalidation in part without transferring the patentee's observation and amended claims to the invalidation petitioner or notifying the invalidation petitioner to state opinions within a specified time limit.

The patentee was dissatisfied with PRB's decision and filed a lawsuit with Beijing

Intellectual Property Court, requesting for revocation of the invalidation decision.

Beijing Intellectual Property Court rejected the patentee's request and upheld the decision of PRB.

The patentee was dissatisfied with the first-instance judgment made by Beijing Intellectual Property Court and appealed this judgment to Beijing High Court.

Beijing High Court held that PRB violated the principle of examination upon request and principle of hearing, revoked the judgment of the first instance and the sued decision, and ordered PRB to make a decision anew.

Remarks:

A key issue in this case is whether PRB violated the principle of examination upon request and principle of hearing, which is directly related to the scope of PRB's ex-officio examination.

For a long time, there have been different views on the nature of invalidation proceeding. Some think that the invalidation proceeding is a quasi-judicial proceeding, and PRB shall act as an impartial judicator. Some think that in an invalidation proceeding, PRB is not just a judicator but also plays the role of correcting improper patent granting.

In judicial practice, courts at various levels have always advocated that the scope of

PRB's ex-officio examination shall be subject to strict restrictions.

In the case of Supreme People's Court (2013) Zhi Xing Zi No. 92, the Supreme People's Court held that the principle of requesting is a basic principle in the invalidation proceeding, requiring that the examination shall not only be initiated by the petitioner but also be restricted to the scope and reasons of the invalidation request as well as the evidence submitted, and exempting PRB's obligation to make an all-round examination on patent validity. The principle of requesting also means that the petitioner has the liberty to dispose its own request and may give up all or part of its invalidation grounds and evidence for invalidation, while PRB generally should not examine the invalidation grounds and evidence that have been given up if there is no legal basis. The Guidelines for Examination ("Guidelines") stipulates the principle of ex-officio examination, and listed circumstances for PRB's ex-officio examination. As exceptions to the principle of requesting, these circumstances of ex-officio examination empower PRB to carry out ex-officio examination and provide the public with corresponding anticipations on the one hand, and restrict the scope of PRB's ex-officio examination on the other hand.

It is clear that the Supreme People's Court think that the scope of PRB's ex-officio examination must have explicit legal basis, and PRB shall not extend its power without authorization.

In this case, Beijing High Court reaffirmed that patent invalidation proceeding is a quasi-judicial proceeding initiated upon request of the invalidation petitioner. As invalidation proceedings involve both parties, PRB shall act as an impartial adjudicator so as not to diminish the value of this proceeding. In this case, the invalidation petitioner did not challenge the inventiveness of amended claim 2. But PRB made a decision prejudicial to the patentee based on its own understanding that the amendment to claim 2 is a simple superposition of technical features. This decision of PRB went against not only the principle of requesting but also the principle of hearing.

It is worth noting in this case that Beijing High Court also made interpretations to the ex-officio examination stipulated in Rule 72.2 of the Rules for the Implementation of the Patent Law. Rule 72.2 of the Rules for the Implementation of the Patent Law stipulates that "Where the person requesting invalidation withdraws his request or the request is deemed to have been withdrawn before the Patent

Reexamination Board makes a decision on it, the examination of the request for invalidation is terminated. Where, based on the examination work it has done, the Patent Reexamination Board finds that it is able to make a decision of invalidation or invalidation in part of the patent right, the examination procedure shall not be terminated”.

Beijing High Court held that Rule 72.2 of the Rules for the Implementation of the Patent Law only grants PRB the power of making ex-officio decisions on behaviors of the invalidation

petitioner before oral hearings. In this case, the disputed behavior happened after the oral hearing, so the invalidation decision of PRB in accordance with Rule 72.2 obviously exceeds the scope of ex-officio examination and is therefore not supported by the law.

To sum up, the current judicial practice in China requires PRB to carry out ex-officio examination in strict accordance with the Rules for the Implementation of the Patent Law and the Guidelines, and should not expand the scope of ex-officio examination without authorization.

Author: Jonathan Miao

Trademark

Accor SA v. Trademark Review and Adjudication Board

- *Beijing High Court administrative judgment (2017) Jing Xing Zhong No. 860*
- *Beijing Intellectual Property Court administrative judgment (2016) Jing Xing Chu No. 3168*



Rules:

When judging whether the trademark at issue is similar to the cited trademark under the Trademark Law, the Letter of Consent on Trademark Co-existence may act as the preliminary evidence for exclusion of confusion.

As the trademark applicant's application for restricting services is in conformity with the Trademark Co-existence Agreement, the Trademark Review and Adjudication

Board ("TRAB") may approve the application in its reexamination decision.

Facts:

The applied trademark in this case is "F1 Hotel", the applicant is Accor SA ("Accor"), and the trademark is designated on the services in Class 43 including "hotel, motel and temporary accommodation". By citing the No. 4123023 "F1" trademark registered by FORMULA ONE LICENSING B.V. on services including "restaurant, restaurant menu, restaurant reservation, food & drink supply, catering, mobile food & drink supply", the Trademark Office rejected the applied trademark in accordance with Article 30 and Article 34 of the Trademark Law.

Accor applied to the TRAB for reexamination, and submitted exhibits including the notarized Letter of Consent on Trademark Co-existence ("Letter of Consent") produced by FORMULA ONE LICENSING B.V. and its translation. The Board thought the two trademark

applicants of the Letter of Consent failed to put forward an appropriate solution to avoid confusing or misleading the consumers, and the use of two trademarks on the same or similar service is easy to confuse or mislead the consumers on the source of service, therefore TRAB did not accept the Letter of Consent.

Accor was dissatisfied with the TRAB's decision, filed a lawsuit with Beijing Intellectual Property Court, and submitted exhibits including the notarized original and translation of the Trademark Co-existence Agreement ("Agreement"). In said agreement, Accor states that the trademark "F1 Hotel" will only be used in the names of Accor's hotels, motels and temporary accommodations as well as the services including dining halls, cookshops, cafeterias, teahouses, cafes, food & beverages, bars and barrooms therein (except for nightclubs and discotheques), making clear market segmentation for the trademark's use. The court held the Letter of Consent and the Agreement reflects the disposal of his trademark right by the owner of the cited trademark and shall be respected if there is no evidence to prove that they might harm the interests of consumers. Therefore, it is confirmed in the court's judgment that the applied trademark is not similar to the cited

trademark when used on the same or similar services.

The Board was dissatisfied with the judgment and appealed to Beijing High Court. During the second instance, Accor submitted an application for designated use of the applied trademark on restricted services including "food & drink supply, cafeterias and teahouses in hotels and other accommodation facilities". The court held that Accor had agreed with the owner of the cited trademark on clear market segmentation for the applied trademark and the reference trademark, the coexistence of the applied trademark and the cited trademark is in conformity with the trademark right owner's autonomy of will and will not harm the public interests by causing confusion. Additionally, Accor's application for restricting services is in conformity with the Agreement, the Board may approve the application in its reexamination decision.

Remarks:

In recent years, courts have adopted a rather lenient attitude towards coexistence agreements by respecting them, if they are not against laws or administrative regulations, and there is no evidence to show a possibility of harming the public interests.

Among all cases of 2016 where TRAB decisions were overturned, more than 80 cases (with a little increase over 2015) involve approval of registrations of later trademarks by the courts of the first and second instances, after making a decision on non-similarity based on trademark coexistence agreements. However, the TRAB insists that such agreements shall not exclude the examination on possibility of confusion, and the trial of such cases shall also involve the judgment on whether the public are prone to be confused or misled when considering factors such as similarity of trademarks, relevance of commodities, distinctiveness, popularity and conditions of use. A trademark that is the same or obviously similar to and is used on the same or obviously similar commodities as another trademark, shall

not be allowed to register merely because of a trademark coexistence agreement.

As to the application for restricting services, a trademark applicant is generally allowed to abandon but not allowed to change the designated goods or services in the trademark registration and review period. There is no precedence that the court approves the change of goods or services in following administrative proceedings. In this case, the court mainly took into consideration of the fact that the application for restricting services is in conformity with the coexistence agreement and further exclude the possibility of confusing consumers by making clear market segmentation for the trademark's use.

Authors: Nathan Yang
Nancy Xu

Copyright

Shanghai Microphone Culture Media Co., Ltd. v. Lao Jinghua

- *Shanghai Intellectual Property Court civil judgment (2016) Hu 73 Min Zhong No. 30*
- *Shanghai Pudong New Area People's Court civil judgment (2015) Pu Min San (Zhi) Chu Zi No. 949*



Rules:

Where the licensee of any written work reproduces, distributes or disseminates sound recordings of this written work to the public through information network, it shall obtain permission from and also pay remuneration to both the copyright owner and the performer. A platform which operates the online listening business shall carefully examine the scope of copyright licensing, and fulfill the obligation of reasonable care.

Facts:

Lao Jinghua is the copyrighter of a novel named *Family Line*, and Shanghai Microphone Culture Media Co., Ltd. ("Microphone") provides online listening of the audio book *Family Line* to the public through its "Qting fm" website. Lao Jinghua entered into a Publication Licensing Contract with Guowen Runhua Company, the third party in this case, on November 27, 2009, it is agreed in the contract that Guowen Runhua Company is the exclusive general agency for the publication and distribution of *Family Line* and owns the digital and audio-video copyright of said work, and the contract shall be valid until November 26, 2014. After a series of sublicensing, Microphone obtained the reproduction right and information network transmission right of the sound recordings of *Family Line* on December 15, 2014, and it still continued to use the involved audio book *Family Line* on April 17, 2015. Therefore, Lao Jinghua brought a lawsuit against Microphone, accusing the latter for infringing upon her information network transmission right of *Family Line*.

The court of the first instance held that the audio book *Family Line* is the sound recording of the involved written work *Family Line*. In accordance with the China Copyright Law, where Microphone uses said audio book, it shall not only obtain permission from the producer of sound recording, but also obtain permission from and pay remuneration to the copyright owner Lao Jinghua of the involved written work *Family Line*. The authorization period got by Guowen Runhua Company is from November 27, 2009 to November 26, 2014, and Microphone was still using the involved audio work on April 17, 2015, which was beyond the aforesaid period. Therefore, Microphone's behavior of disseminating the involved audio book without obtaining permission from the copyright owner infringed upon Lao Jinghua's information network transmission right.

The court of the second instance held that Microphone shall, when disseminating sound recordings to the public through information network as the licensee, obtain permission from and pay remuneration to the copyright owner. In this case, there is no evidence to prove that Microphone has obtained permission from and paid remuneration to the copyright owner Lao Jinghua. Therefore, Microphone infringes

upon Lao Jinghua's information network transmission right.

The court of the second instance also held that according to the Publication Licensing Contract, the third party Guowen Runhua Company has obtained the electronic copyright and audio-video copyright of the written work *Family Line* as well as the corresponding sublicensing right, and the involved audio book *Family Line* is the sound recording produced from said written work, the reproduction, distribution, lease of such sound recording or the dissemination of the sound recording to the public through information network shall not be subject to the term of five years agreed in the contract only if such sound recording is completed within the agreed term. That is because the written work and the sound recording are different works, and the producer of sound recording independently enjoys the rights of such sound recording which are protected by law. To sum up, the court of the second instance held that under circumstance of failing to find out the completion time of the audio book *Family Line*, the court of the first instance's conclusion on Microphone's infringement was due to exceeding the term of licensing shall be corrected because of the use of a wrong reason.

Remarks:

In recent years, “online listening” has become a fashion due to the enhanced functions of smartphones and the increased demands of users for experience. A lot of audio book Apps with “Ximalaya” and “Lizhi FM” as representatives have appeared in swarms, leading to serious infringement upon copyright.

In cases of this kind, the court shall first decide which type of work the audio book belongs to. In this case, the involved audio work is the sound recording of someone’s reading of the written works, so the court held the audio book is a sound recording. However, an operator of audio books may also provide its users with audio books by adopting the TTS technology (i.e. Text To Speech, a technology of automatically transforming text to speech), such audio books are essentially the reproduction of original works and do not belong to sound

recordings as the carrier of original works is transformed by simply adopting digitalization.

Besides, it is worth noting that when anyone uses the audio book recorded by another person with lawful licensing for online dissemination, he shall obtain permission from not only the producer of sound recording but also the copyright owner of written work, unless the latter has made explicit licensing on the right to disseminate such sound recording through information network. Therefore, a platform engages in the operation of audio books shall carefully examine the scope of copyright licensing of the relevant works, sufficiently perform the obligation of reasonable care, and ensure the cleanliness of the chain of rights.

Author: RichardHu,

Unfair Competition

AUX Group Co., Ltd. v. AUX Express Elevator (Suzhou) Co., Ltd.

- *Second instance: Jiangsu High People's Court(2017) Su Min Zhong No. 207*
- *First instance: Nanjing intermediate people's court in Jiangsu Province (2014) Ning Zhi Min Chu Zi No. 240*



Rules:

1. The trademark at issue “奥克斯” is a well-known mark with huge commercial value, the use of this trademark by AUX Lift Company (Aux Lift, predecessor of AUX Express Elevator (Suzhou) Co., Ltd.) on products exceed the approved scope for such trademark is liable to mislead the public about the commercial relations between AUX Group Co., Ltd. (AUX Group, owner of the trademark “奥克斯”) and AUX Lift. If there is any quality problem in AUX Lift's services, the consumers will dispraise the trademark “奥克斯” and AUX Group will lose the corresponding market share; such trademark infringement

weakens the distinctiveness of the trademark “奥克斯” to a certain extent, and fulfills the conditions of applying cross-category protection for well-known trademark.

2. The courts of the first and second instances both cited Article 4 and Article 5 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Laws in the Trial of Civil Disputes over Domain Names of Computer Network, and decided that the appellant's domain name constitutes infringement based on the fact that the appellant's registration and use of a domain name similar to the trademark at issue for the commercial publicity of its enterprise and products is sufficient for confusing and misleading the public and violates Article 2 of the Law Against Unfair Competition, which also constitutes unfair competition even if the website with such domain name is not used for the e-commerce activities of the relevant products.

Facts:

AUX Group, the plaintiff of the first instance, has applied and registered a series of trademarks including “奥克斯” and “AUX” since 1995, which are designated to be used on goods including Class 7 “lifts (elevators)” and Class 11 “refrigerators, air conditioners, illuminating lights”. Aux Lift, the defendant of the first instance, was established in 2009 with its business scope covering the production of passenger lifts, goods lifts and escalators as well as the installation, transformation and maintenance of lifts. The defendant was found out to highlight “AUXEXPRESS” on the lifts produced and sold by it; began to use its official website (www.auxlift.com) in 2009; and used words like “Entering AUX” and “ABOUTAUX” in its website columns and for the introduction of itself (including its Shaanxi Branch and other subsidiaries) and its products.

Therefore, the plaintiff put forward the following claims: 1. The No. 800469 trademark “奥克斯” and the No. 800472 trademark “AUX” shall be confirmed as well-known trademarks; 2. The defendant shall immediately stop infringing upon the plaintiff’s exclusive right to use such trademarks and other unfair competition activities, and shall immediately destroying infringing products or removing such words as “奥克斯” on them; 3. The

defendant shall immediately stop using the enterprise name including the words of “Ao Ke Si”; 4. The defendant shall compensate the plaintiff’s economic loss of RMB 1,000,000 and reasonable expenses of RMB 100,000; 5. The defendant shall immediately stop using the domain name www.auxlift.com.

The defendant argued: 1. It has not used the plaintiff’s trademarks for the sale of lifts, so it did not constitute infringement upon and damage to the trademark at issues; the plaintiff’s trademarks are just common ones, and do not meet the conditions to be confirmed as well-known trademarks; 2. Its Chinese name has two more characters than “奥克斯”, there is obvious distinction and will not mislead the public; 3. The plaintiff’s claim for damages lacks factual basis.

In its judgment, Jiangsu Nanjing Intermediate People’s Court held:

1. The popularity and distinctiveness of the trademark at issue registered by plaintiff in prior have reached the level for well-known trademarks, the duplication and imitation of the plaintiff’s trademark by the defendant will mislead the public, and the plaintiff’s existing consumers will have a wrong understanding that there are specific relations between these two

trademarks; therefore, if there is any quality problem in the defendant's service, the consumers will dispraise the trademark "Ao Ke Si" and the plaintiff will lose the corresponding market share; such trademark infringement weakens the distinctiveness of the plaintiff's trademark to a certain extent, and the cross-class protection shall be given to the plaintiff's trademark in accordance with the law;

2. The defendant's use of words "奥克斯" in its enterprise name and the highlighting of words "奥克斯" in the lifts produced and sold by it constitute unfair competition against the plaintiff;

3. In accordance with Paragraph 3, Article 1 of the Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Laws in the Trial of Trademark-involved Civil Dispute Cases, the defendant only used the domain name for enterprise and product publicity and did not use the website for the e-commerce activities of the relevant products, so the defendant did not infringe upon the plaintiff's exclusive right to use the trademark at issue in this respect. However, in accordance with Article 4 and Article 5 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Laws in the Trial of Civil Disputes over Domain

Names of Computer Network, the use of a similar domain name, columns and column names constitutes unfair competition.

AUX Lift was dissatisfied with the judgment of the first instance and appealed to Jiangsu High Court.

On October 30, 2017, Jiangsu High Court made the final judgment: 1. The use of trademark "奥克斯" on its lifts has fulfilled the conditions of applying cross-category protection for well-known trademark; 2. The appellant's use of "奥克斯" in its enterprise name constitutes unfair competition; 3. The appellant's use of a domain name similar to the trademark at issue and basically the same columns in the website for commercial publicity of enterprise and products is sufficient for confusing and misleading the public and constitutes unfair competition against the appellee. To sum up, the appeal is rejected and the original judgment is maintained.

Remarks:

This case involves cross-category protection of enterprise name and well-known trademark. Though the defendant argued that lifts and air conditions are not similar commodities and have great differences in terms of sales channel and consumer group thus the consumers will not confuse them, the court

still held the brand “奥克斯” has a strong influence; lifts and air conditioners both target at common consumers and their consumer groups are rather connected; the defendant's use of “奥克斯” in enterprise name and the highlighting of such words on products is liable to mislead the public to have a wrong understanding of the specific relations between the defendant and the plaintiff, taking advantage of others' good reputation to improve its own fame, which is against the commercial ethics and constitutes unfair competition against the plaintiff.

Therefore, in order to obtain cross-category protection of a famous trademark, we need to establish a solid chain of evidence to prove the trademark

at issue is a famous trademark. Even though the two parties have different business scopes and their commodities are not similar ones, we can claim these two kinds of commodities both target at common consumers, their consumer groups are rather connected and the brand influence of the plaintiff's trademark covers all kinds of products, so as to convince the court that the other party's use of the mark as a trademark goes against the commercial ethics with the vicious intent of “seeking connection with a famous brand”, constituting unfair completion and infringement.

Authors: Lily Fu
Zhao Qianying

III. NTD Case Selection

The Supreme Court made the final decision that “顺峰康王” (Shun Feng Kang Wang) is similar to “康王” (Kang Wang)

- *The Supreme Court (2015) Zhi Xing Zi No.64*
- *Beijing Higher People's Court (2014) Gao Xing Zhi Zhong Zi No.3266*
- *Beijing First Intermediate People's Court (2014) Yi Zhong Zhi xing Chu Zi No. 1969*



Our client Dihon Pharmaceutical Group Co. Ltd's (hereinafter "Dihon's") mark “康王” (Kang Wang) has very high fame in China on the products including dermatological drug, compound ketoconazole lotion for scalp disorders

and others. Guangdong Hua Run Shun Feng Pharmaceutical Co. Ltd (hereinafter “Hua Run Shun Feng”) filed an application for the mark “顺峰康王” (Shun Feng Kang Wang, hereinafter “the opposed mark”) on March 21, 2007 in connection with the goods in class 5 “medicines for human purposes; injection; pharmaceutical preparation, etc.” Dihon filed an opposition based on its prior mark “康王” (Kang Wang, hereinafter “the cited mark”) in class 5. The cited mark was registered on August 28, 1997 and the designated good covers “traditional Chinese medicine; western medicine; preparation of traditional Chinese medicine; preparation of Western medicine”. Hua Run Shun Fen argued that the opposed mark was continuation of its prior registered mark “顺峰康王” (Shun Feng Kang Wang, hereinafter “the prior mark”) in class 5, which was registered on May 14, 1997 and was designated on the goods “compound ketoconazole cream”.

The Supreme Court held in the retrial proceeding that: although the prior mark was registered before the cited mark, designated goods of the former covers only 1 item “compound ketoconazole cream”. Evidence at the court was insufficient to prove that the use of opposed mark in connection with the designated goods. Under the circumstance that the cited mark has obtained relative high fame, relevant customers would be confused if the opposed mark is allowed to be registered.

The concept of “trademark continuation” is put forward by Beijing High Court in *Guidelines on Trial of Administrative Cases Concerning Decisions on*

Ownership of Trademark, which has strict precondition for application. In this case, the basic mark (i.e. the prior mark) and the latter applied-for-mark (i.e. the opposed mark) are designated on different goods, and they are two different marks with different scope of protection. Moreover, Dihon’s cited mark has obtained high fame prior to the filing of Hua Run Shun Feng’s latter applied-for-mark. Under such circumstance, Hua Run Shun Feng’s latter applied-for-mark should not be continuation of the its basic mark

Authors: Lily Fu

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If you are interested in gathering further details about the above cases, please do not hesitate to contact us.

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