

# Rethinking the Fei-Cheng-Wu-Rao case

Simon Tsi, Nancy Qu and Andrew Wang of Chang Tsi & Partners take us through this high-profile case



The famous Fei-Cheng-Wu-Rao Case was concluded in the Guangdong High Court in December 2016. The appeal judgment dismissed Jin A'huan's claims and supported Jiangsu Broadcasting and TV Station's continued use of Fei-Cheng-Wu-Rao logo (figure 1) as the programme name.



Figure 1: the Fei-Cheng-Wu-Rao logo



Figure 2: the authorised trade mark

This case attracted broad attention for two main reasons. First, Fei-Cheng-Wu-Rao has been one of the most famous dating shows in China since 2010. Second, this case involved several important trade mark issues, such as whether TV programme names constitute trade mark use, and whether specific services in class 41 and class 45 are similar.

We review the two most controversial key issues in this case and provide general recommendations on litigation strategy for cases of this type. The information about the case is summarised in the box.

## 2) Whether Jiangsu TV used the Jin's logo as a trade mark

The plaintiff Jin A'huan (Jin) proved Jiangsu TV used the logo as a trade mark based on the following:

- i) Jiangsu TV used the logo together with other trade marks, including the Jiangsu TV logo and the Tuniu logo.
- ii) Jiangsu TV had been authorised by Huayi Brothers to use the trade mark (figure 2) on the entertainment TV programme.

The appellate court found that Jiangsu TV used the logo as a trade mark to identify the source of services.

## Non-standard use of the trade mark

Jiangsu TV was authorised to use the trade mark (figure 2) but it actually used the logo in its TV programme (figure 1).

As is clear, Jiangsu TV changed the font, colour and structure of the trade mark and added the silhouette of a lady. On the one hand, this made the trade mark more beautiful and easier to recognise. On the other hand, such non-standard use of a registered trade mark brought legal risks.

It was Jiangsu TV's non-standard use of the registered trade mark that gave the plaintiff a chance to sue it. If Jiangsu TV had used the authorised trade mark as it was, either the plaintiff's lawsuit would have been dismissed, or his claims overruled in the first instance.

Jiangsu TV should have registered the modified logo as a trade mark to reduce legal risks.

## Similarity of services

Whether "Entertainment TV programme" in class 41 and "Dating service; matchmaking agency" in class 45 are similar was the most controversial question of the case.

**Case information**

(i) Plaintiff: Jin A'huan (Jin)

Registration number	Logo	Application date	Registration date	Designated service	Nice Classification
7199523		February 2009	September 2010	Dating Service; Matchmaking Agency, etc	45

(i) Defendant 1: Jiangsu Broadcasting TV Station (Jiangsu TV)  
 Defendant 2: Shenzhen Zhen'ai Information and Technology (Zhen'ai)

Registration number	Logo	Application date	Registration date	Designated service	Nice Classification
7068059		November 2008	October 2010	Entertainment TV Programme, etc	41

The logo (figure 1) had been used by Jiangsu TV since the first episode of the programme in January 2010.

According to relevant laws, “similar services” are those that are identical in respect of the purpose, content, manner or object of services, or that the relevant general public usually believes are connected so that confusion may result.

The appellate court held that the relevant public could differentiate between entertainment TV programmes and matchmaking services and wouldn't believe that the two were connected. Thus, the two were neither identical nor similar. Though the logo was similar to the trade mark owned by the plaintiff, it was used for a different purpose and so wouldn't cause public confusion.

We don't agree with the appellate court, for two main reasons.

**Different services may overlap**

When the theme of a TV programme is dating or

*“The overlap between different services is becoming larger and larger, and the likelihood of confusion will be higher.”*

matchmaking, and this programme in fact provides dating or matchmaking services for the show guests and viewers, we deem them to overlap with “Dating and matchmaking services” in class 45 (see figure 3).

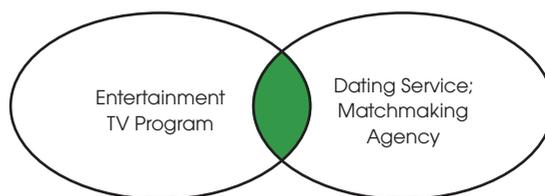


Figure 3

**When the logos are very similar, the requirement of similarity between services should be reduced**

This point of view is supported by several precedents. In both the *Gay Devil* case and the *Elite* case, “Entertainment” in class 41 and “Dating service” in class 45 were considered similar services and the contested trade marks were rejected by the OHIM (now EUIPO) Opposition Division.

In the *Gay Devil* case, the Opposition Division deemed that providing a dating service is helping a person to know another and develop a relationship. It could include online introduction services. Online entertainment services include online forums, chat

rooms and online games. Online entertainment was similar and complementary to dating services, and they could be provided by the same company.

In the *Elite* case, the Opposition Division concluded that the contested services in class 45 have a low degree of similarity with the earlier right's services in class 41. Yet, the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa.

We believe that, as the online economy develops, the territorial scope of services is extending and new types of services are emerging. Thus, the overlap between different services is becoming larger and larger, and the likelihood of confusion will be higher. Therefore, we strongly urge trade mark owners to pay more attention to protecting their service marks beyond the designated classes.

### Litigation strategy recommendations

In the Fei-Cheng-Wu-Rao case, the legal strategy pursued by Jiangsu TV had the consequence of making the defendant quite passive in the appeal.

We recommend that a defendant in an important IP infringement case always engage an experienced legal adviser to conduct a comprehensive analysis. As far as Fei-Cheng-Wu-Rao case is concerned, the following points should be considered:

- i) Conducting an analysis of the plaintiff's legal basis. If there are defects in the plaintiff's legal position, we recommend immediately initiating an invalidation or cancellation procedure. In the Fei-Cheng-Wu-Rao

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case, the plaintiff's trade mark was suspected to infringe Huayi Brother's copyright over the logo (figure 2). Thus, undermining his position should have been a priority at the first instance.

- ii) Conducting an analysis of the defendant's infringement. In the Fei-Cheng-Wu-Rao case, it was a risky strategy to argue that entertainment TV programmes are not similar to a dating and matchmaking service. Therefore, unless the plaintiff's position had no defects or the case had already entered into the appeal procedure, it's not recommended to argue on those lines.
- iii) Take seriously the long-term IP protection strategy. From the perspective of trade mark law, the main cause of the Fei-Cheng-Wu-Rao case is that Jiangsu TV didn't conduct defensive registration and didn't use the standard authorised trade mark. Thus, for TV programmes, in addition to the core service in class 41, it's recommended to conduct defensive trade mark or copyright registrations in other relevant services or goods in different classes. The good news is that the official trade mark registration fee has just been significantly reduced according to the recent policy of CTMO, which saves a lot of costs for TV stations and TV producers in establishment of their trade mark portfolio.



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