

Protect Your Trade Mark In China

Application Procedures

- (a) Filing receipt (Online filing receipt in 1-2 working days and physical one is generally issued in about 2 months from the date of filing).
- (b) Formality examination (2-4 months).
- (c) Substantive examination (6-8 months).
- (d) Publication and opposition (3 months).
- (e) Registration and issuance of certificate of registration.

Filing Requirements:

- 1. Name and address of the applicant;
- 2. State or country of incorporation; copy of business registration if applicant is legal entity;
- 3. Proof of citizenship, namely, copy of passport if applicant is an individual;
- 4. Description of trademark;
- 5. Representation of trademark (a depiction of the mark an applicant seeks to register);
- 6. List of goods/services;
- 7. Power of attorney duly signed. No notarization or legalization is required
- 8. Certified copy priority document if priority is to be claimed.

Tips

1. Plan Early

China adopts the “**first to file**” principle for trade mark registrations.

Obtaining trade mark registrations in China early or identifying potentially conflicting registrations should be top on the list before one goes into the Chinese market.

2. Register in the Right Class

China adopts the Nice Classification. However, goods or services falling under different **sub-classes**

within the same class are not necessarily considered similar. One must carefully choose which sub-class(es) to register in order to obtain the desired protection.

3. Mind the Language

The Chinese name or transliteration of a foreign brand is vulnerable to third party registrations. If a brand does not have its own Chinese equivalent, the Chinese consumers or squatters will likely invent one.

Devising a Chinese equivalent which reflects the meaning and pronunciation of the original brand is an art, but this is something a foreign brand owner should give thoughts to at the outset of its brand strategy.

4. Know Your Opponent

If one needs to **purchase an earlier registration** from a local entity, make sure of proper due diligence. In China, one often finds companies with strikingly similar names. It is of utmost importance to ascertain the ownership, validity and status of a registration. Better still, one should conduct background and credit checks to get information about who you are up against. The strategy against an individual squatter could be very different from that against a genuine early user.

5. Caution on Extra Fees

There is no official fees for publication, certificate or after registration in China. Thus please do not trust any notice for these payments.

6. Keep an Eye

Spotting potentially conflicting or bad faith applications early (by **monitoring** the trade mark gazettes) and taking prompt action (e.g. opposition) is extremely important.

Under the Revised Trademark Law, now only prior rights' holders and relevant interested parties are allowed to file an opposition on the basis of **relative refusal grounds**. The Regulations specify that for the above, the opposing party shall submit evidence to the STO proving that it is a prior rights' holder or an interested party. This considerably limits the groups who can file oppositions before the STO in the future.

7. Become Well-known

Gaining the recognition of a well-known mark in China affords a much wider and stronger protection, even against dissimilar goods and services. It is probably easier said than done – the threshold is very high, but there were successful stories. One needs to produce really impressive evidence of use, promotion and/or sale in China – it is generally believed that this must last for at least 5 years and extend to no fewer than 10 provinces. Start keeping your awards, news reports, advertisements, etc. in order, and in their original forms.

8. Copyright the Brand

If your brand qualifies as a copyright work, this could provide an additional or alternative ground for protection. The Chinese trade mark law recognizes that earlier copyright provides a ground for revoking a registered trade mark. Ideally one should produce all the relevant drawings, sketches, assignments to prove copyright. Having a voluntary copyright registration in China or in other jurisdictions would also come in handy as evidence of ownership.

9. Know the Enforcement Channels

The multiple trade mark enforcement channels in China, including administrative raids, litigation, and customs seizure. A variety of remedies are available, e.g. confiscation, fine, damages, injunction. These remedies are generally not exclusive to each other. Further, China is a civil law system so case law is not binding as in a common law forum. Brand owners should be aware of all these enforcement channels, and potential weapons.

10. Multiple classes trademark application in China

For multiple classes application, we recommend not.

Firstly, when assigning a trademark, all classes of the application must be transferred together. At least it is the current situation. Now, division of trademark application happens only when an application is partially rejected, the applicant can choose to divide the application to allow approved parts to be published then registered being given a new trademark number, while the refused parts enter into time lasting review phase or simply being given up. However, trademark application division is not applicable to any other situation.

Secondly, multiple classes application does not help to save filing fees, official fees are still calculated by



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classes and no discount for additional classes.

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