

# 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. A power of attorney, executed by the applicant. No notarization or legalization is required
- 2. Full details of the applicant (i.e. name, address, nationality)
- 3. List of goods and/or services according to 10th Edition of Nice International classification of Goods & Services
- 4. A sample of the mark in JPG format
- 5. A copy of certificate of company incorporation if applicant is legal entity or copy of passport if individual

## Trade Mark Application Fees in China (in US\$)

		Official Fee	Professional Fee
First Class	-	100	300
Each Additional Class	-	100	250

## 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.

