

Application for Trademark Registration

A trademark is a sign that identifies and distinguishes the source of the goods or services of one party from those of others. In market economy, trademarks play a significant role in guiding market business, boosting national economy and protecting consumers' rights and interests.

Trademark Registration System

China implements the system of trademark registration. As provided in Article 3 of the Trademark Law, registered trademarks refer to trademarks that have been approved and registered by the Trademark Office, and the trademark registrants shall enjoy the exclusive right to use the trademarks, and be protected by law. The owner of a trademark shall apply to the Trademark Office for registration if he wants the trademark used in business to be fully protected by law.

Exclusive Right to Use a Registered trademark

Once a trademark is approved and registered, the trademark registrant is entitled to the exclusive rights to use the trademark, which includes:

1. Right to use the trademark: the trademark registrant is entitled to use the trademark in respect of the goods and service approved and use it in relevant business.
2. Exclusive right: the trademark registrant enjoys the exclusive right to use the registered trademark, no one else shall use identical or similar trademarks in respect of identical or similar goods and services.
3. Right to license; the trademark registrant is entitled to authorize other to use the registered trademark by signing a license contract in accordance with the law.
4. Restraining Power: the trademark registrant is entitled to prohibit any one from using identical or similar trademarks in respect of identical or similar goods and services without permission.
5. Right of mortgage: the trademark registrant is entitled to set a mortgage with the registered trademark in business.
6. Right to invest: The trademark registrant has the right to regard its registered trademark as the intangible assets and make the investment according to the due course of law according to the legal provisions
7. Right of assignment: the trademark registrant is entitled to assign the registered trademark to any one else in accordance with law, either paid or unpaid.
8. Heirdom: The registered trademark can be inherited by its rightful heir according to the order of inheritance as the incorporeal property.

Means of Trademark Application

Any Chinese natural person or legal entity intending to acquire the Exclusive Right to Use a Registered trademark can either come to the Trademark Office to apply for the

registration or appoint any of such organizations as designated by the State to act as his or its agent for the registration. Any foreign person or foreign enterprise intending to apply for the registration of a trademark or for any other matters concerning trademarks in China shall appoint any of such organizations as designated by the State to act as his or its agent.

Which Signs can be Registered as Trademarks?

As provided in Article 8 of the Trademark Law, in respect of any visual sign capable of distinguishing the goods or service of one natural person, legal entity or any other organization from that of others, including any word, design, letters of an alphabet, numerals, three-dimensional symbols, combinations of colors, and their combination, an application may be filed for registration. Meanwhile, it is also provided in Article 9 that Any trademark in respect of which an application for registration is filed shall be so distinctive as to be distinguishable, and shall not conflict with any prior right acquired by another person.

Who can Apply for Trademark Registration?

As provided in Article 4 of the Trademark Law, any natural person, legal entity or other organization intending to acquire the Exclusive Right to Use a Registered trademark for the goods produced, manufactured, processed, selected or marketed by him or it, or for the service provided by him or it, shall file an application for the registration of the trademark with the Trademark Office.

Which Signs shall not be Used as Trademarks?

As provided in Article 10 of the Trademark Law, the following signs shall not be used as trademarks:

1. Those identical with or similar to the State name, national flag, national emblem, military flag, or decorations, of the People's Republic of China, with names of the places where the Central and State organs are located, or with the names and designs of landmark buildings;
2. Those identical with or similar to the State names, national flags, national emblems or military flags of foreign countries, except that the foreign state government agrees otherwise on the use;
3. Those identical with or similar to the names, flags or emblems or names, of international intergovernmental organizations, except that the organizations agree otherwise on the use or that it is not easy for the use to mislead the public;
4. Those identical with or similar to official signs and hallmarks, showing official control or warranty by them, except that the use thereof is otherwise authorized;
5. Those identical with or similar to the symbols, or names, of the Red Cross or the Red Crescent;
6. Those having the nature of discrimination against any nationality;

7. Those having the nature of exaggeration and fraud in advertising goods; and
8. Those detrimental to socialist morals or customs, or having other unhealthy influences.

The geographical names as the administrative divisions at or above the county level and the foreign geographical names well known to the public shall not be used as trademarks, but such geographical terms as have otherwise meanings or are a part of collective marks/or a certification marks shall be exclusive. Where a trademark using any of the above-mentioned geographical names has been approved and registered, it shall continue to be valid.

Which Signs shall not be Registered as Trademarks?

As provided in Article 11, the following signs shall not be registered as trademarks:

1. Those only comprising generic names, designs or models of the goods in respect of which the trademarks are used;
2. Those having direct reference to the quality, main raw materials, function, use, weight, quantity or other features of the goods in respect of which the trademarks are used; and
3. Those lacking distinctive features.

The signs under the preceding paragraphs may be registered as trademarks where they have acquired the distinctive features through use and become readily identifiable.

As also provided in Article 28 of the Trademark Law, where a trademark the registration of which has been applied for is identical with or similar to the trademark of another person that has, in respect of the same or similar goods, been registered or, after examination, preliminarily approved, the Trademark Office shall refuse the application.

Trademarks and Service Marks

Trademarks are the trademarks used in respect of goods, while service marks are those used in respect of service. China began the acceptance of applications for service marks registration from June 1st , 1993.

Collective Marks and Certification Marks

Collective marks mean signs which are registered in the name of bodies, associations or other organizations used by the members thereof in their commercial activities to indicate their membership of the organizations. Certification marks mean signs which are controlled by organizations capable of supervising some goods or services and used by entities or individual persons outside the organization for their goods or services to certify the origin, material, mode of manufacture, quality or other characteristics of the goods or services.

Geographical Indications

Geographical indications refer to the indications that identify a particular good as originating in a region, where a given quality, reputation or other characteristic of the goods is essentially attributable to its natural or human factors. Geographical indications are protected through trademark laws in China, since they can be registered as certification marks and collective marks. Up to now, there have been over 100 certification marks with geographical indications therein registered in China, including American “Florida” oranges, Chinese “Kuerle Pear” (Xinjiang Autonomous Region), “Hami Melon”, “Jingdezhen china” (Jiangxi province) and so on.

Three-dimensional Marks and Color Trademarks

Three-dimensional marks refer to the three-dimensional symbols used in respect of goods and service, and color trademarks are combinations of colors or any combination of the colors, words, devices and other elements. As provided in Article 12 of the Trademark Law, Where an application is filed for registration of a three-dimensional sign as a trademark, any shape derived from the goods itself, required for obtaining the technical effect, or giving the goods substantive value, shall not be registered. China began the acceptance of applications for three-dimensional and color trademarks registration from December 1st , 2001.

Protection of Well-known Trademarks

China has been fulfilling her promise to the world to protect the legitimate rights and interests of both Chinese and foreign trademark owners since China became party to a member of Paris Convention for the Protection of Industrial Property. As provided in Article 25 of Regulations for the Implementation of Trademark Law revised in 1993, to violate the principles of honesty and credit and plagiarize, counterfeit or translate any well-known trademark of another party in the registration shall be deemed as acts committed in the acquisition of a trademark registration by fraud or any other unfair means. As provided in Article 13 of the Trademark Law revised in 2001, where a trademark in respect of which the application for registration is filed for use for identical or similar goods is a reproduction, imitation or translation of another person's trademark not registered in China and likely to cause confusion, it shall be rejected for registration and prohibited from use. Where a trademark in respect of which the application for registration is filed for use for non-identical or dissimilar goods is a reproduction, imitation or translation of the well-known mark of another person that has been registered in China, misleads the public and is likely to create prejudice to the interests of the well-known mark registrant, it shall be rejected for registration and prohibited from use. As provided in Regulations for the Implementation of Trademark Law revised in 2002, a trademark owner who believes that the registration of its well-known trademark as an enterprise name by another person is likely to deceive or mislead the public may apply to the competent registration authorities of enterprise names for the cancellation of the registration of

the enterprise name.

Procedures for Trademark Registration

After the acceptance of the application for trademark registration, the procedures for trademark registration includes the following periods: formality check, substantive examination, being preliminarily approved and published, opposition and being approved for registration. The opposition period includes three months from the date of the publication, any person may, within this period, file an opposition against the trademark that has, after examination, been preliminarily approved. Where any party concerned is dissatisfied with the Trademark Office's decision of refusal of the registration application, decision of opposition and decision of cancellation, he or it may apply for a review to the Trademark Review and Adjudication Board. Where any party concerned considers a registered trademark to be improperly registered, he or it may apply for cancellation of the trademark to the Trademark Review and Adjudication Board. Where any party concerned is dissatisfied with the decision of the Trademark Review and Adjudication Board, he or it may institute legal administrative proceedings with Beijing No. 1 Intermediate People's Court.

Period of Validity of a Registered Trademark

The period of validity of a registered trademark shall be ten years, counted from the date of approval of the registration. Where the trademark registrant intends to continue to use the registered trademark beyond the expiration of the period of validity, an application for renewal of the registration shall be made within six months before the said expiration. Where no application therefore has been filed within the said period, a grace period of six months may be allowed, yet extra fees shall be charged for the delay of renewal. If no application has been filed at the expiration the grace period, the registered trademark shall be cancelled. The period of validity of each renewal of registration shall be ten years.

Assignment and Licensing of Registered Trademarks

The right holder of a trademark has the right to deal with his/her intangible property in accordance with legal procedures. Trademark holders can dispose trademark right either by assignment or by licensing. Trademark assignment is the transfer of trademark ownership to another party voluntarily by the right holder, either paid or unpaid. And a trademark transfer caused by merger, annex or judgment by a court can also be viewed as trademark assignment. In that case, the assignee should handle assignment with the Trademark Office. After approval, an assigned trademark can be publicized on the Trademark Gazette. The assignee enjoys the exclusive right to use the trademark since the date of publication. The trademark licensing of registered trademarks is to allow others to use the trademarks without assigning the ownership. To license a registered trademark, the licensor shall sign a trademark license contract

with the licensee. And the licensor shall report the contract to the Trademark Office to make a record of the contract within 3 months counting from the date on which the contract was signed.

Acts Deemed as an Infringement of the Exclusive Right to Use a Registered Trademark

As provided in Article 52 of the Trademark Law and Article 52 of Regulations for the Implementation of Trademark Law, Any of the following acts shall be an infringement of the exclusive right to use a registered trademark:

1. To use a trademark that is identical with or similar to a registered trademark in respect of the identical or similar goods without authorization from the trademark registrant;
2. To sell goods knowingly which contain a counterfeit trademark;
3. To counterfeit, or to make, without authorization, representations of a registered trademark of another person, or to sell such representations of a registered trademark as were counterfeited, or made without authorization;
4. To replace, without the consent of the trademark registrant, its or his registered trademark and market again the goods bearing the replaced trademark;
5. To use any signs which are identical or similar to another person's registered trademark as the name of the goods or decoration of the goods on the same or similar goods, thus misleading the public;
6. To intentionally provide facilities such as storage, transport, mailing, concealing, etc. for the purpose of infringing another person's exclusive right to use a registered trademark.

Protection of the Exclusive Right to Use a Registered trademark

Protection of the exclusive right to use a registered trademark can be achieved through both administrative means and judicial means. Where any party has committed any of such acts to infringe the exclusive right to use a registered trademark, the interested party can complain to local Administrations for Industry and Commerce at or above county level, requiring the administrations to investigate and handle the cases. The administrative authority for industry and commerce has the power to make an administrative decision to the cases which are not serious enough to constitute a crime, where the case is so serious as to constitute a crime, it shall be transferred to the judicial authority for handling. Where any interested party is dissatisfied with decision on handling the matter, it or he may, within fifteen days from the date of receipt of the notice, institute legal proceedings in the People's Court according to the Administrative Procedure Law of the People's Republic of China. If there have been instituted no legal proceedings or made on performance of the decision at the expiration of the said period, the administrative authority for industry and commerce shall request the People's Court for compulsory execution thereof. The interested party may also institute legal proceedings in the People's Court directly, and

the court will protect the legitimate rights and interests of the right owner according to the Civil Procedure Law of the People's Republic of China.

Administrative Proceedings against Trademark Infringements

According to the relevant provisions of the Trademark Law, any one can complain to the local administrations at or above the county level where the infringer resides or the infringement took place. The complaints shall be put in the written form usually, noting relevant information and evidence, such as the name, address of the infringer, the place where the infringement took place or was found, and relevant marks which are suspected to have infringed registered trademarks or stuff like photos and so on. Meanwhile, the interested party can also make a complaint on the phone. Where the trademark registrant complains to the administrative authority for industry and commerce, requesting for protection of the exclusive right to use a registered trademark, the written form shall be handed in with effective certification. Once the administrative authority decides to deal with the case, it shall notify the complainant of the result.