

## 8.1 Application for Trademark Registration in China

Applications for trademark registration are handled in accordance with China's *Trademark Law* and the *Implementing Regulations of the Trademark Law*.

The Trademark Office under the State Administration for Industry and Commerce (SAIC) is the government authority for the registration of trademarks in China. The Trademark Management Office under SAIC is the administrative arm responsible for managing all trademark-related matters, while Trademark Affairs Offices set up in various major cities are trademark agents designated by the state and under the supervision of SAIC. The Trademark Review and Adjudication Board, also under SAIC, is responsible for handling disputes related to trademarks. Provincial-level administration offices for industry and commerce handle matters concerning trademarks under their jurisdiction, such as protecting the exclusive right to use registered trademarks and investigating acts of trademark infringement.

Any foreigner or foreign enterprise intending to apply for trademark registration in China should file an application in accordance with relevant agreements concluded between the country to which the applicant belongs and China, or according to relevant international treaties to which both countries are parties, or on the basis of the principle of reciprocity.

Foreign-invested enterprises (FIEs) may apply for trademark registration in China either directly or through trademark agents. Foreign enterprises wishing to do the same should appoint agents designated by the state to handle trademark registration for foreign parties.

### 8.1.1 Points to Note in Application for Trademark Registration

In applying for trademark registration, the class and description of the goods should be put in the application form according to the prescribed classification system. Currently, China adopts the International Classification System, which classifies goods and services into 34 categories and 8 categories respectively.

Where an applicant intends to register the same trademark for goods in different classes, a separate application for registration

should be filed in respect of each class of the prescribed classification of goods.

Where a registered trademark is to be used in respect of other goods of the same class, a new application for registration should be filed.

Where any design of a registered trademark is to be altered, a new registration should be applied for.

Where, after the registration of a trademark, the name, address or other matters concerning the registrant change, an application regarding the change should be filed.

A geographical indication may be the subject of an application for registration as a certification mark and a collective mark.

#### 8.1.2 Procedures for Trademark Registration and Documents Required

In applying for trademark registration, the following documents should be submitted to the relevant authorities: Application for Trademark Registration, power of attorney, five copies of the reproductions of the trademark (if colour is claimed, five copies of the colour reproductions of the trademark), and one copy of the black and white design thereof. The reproductions of the trademark must be clear and easy to be pasted up and should be printed on smooth and clear durable paper or substituted by photographs, the length and width of which should be less than 10 cm but more than 5 cm each.

When a foreigner or foreign enterprise applies for trademark registration, the Chinese language should be used (any document in a foreign language should be accompanied by a Chinese translation).

Where trademark registration is applied for a three-dimensional mark, the applicant should state the same in the application and submit reproductions enabling determination of the three-dimensional shape.

Where trademark registration is applied for a colour combination, the applicant should state the same in the application and submit a text description.

When applying for registration of a collective mark or certification mark, the applicant should state the same in the application and submit a certificate of qualification as subject and the rules for administration of the use of the mark.

Applications for trademark registration will undergo examination as to form and examination as to substance by the Trademark Office in accordance with the *Trademark Law*. Where an application has passed the examination both in form and in substance, preliminary approval will be granted and the trademark will be published.

Any person may, within three months from the date of publication of the trademark, file an opposition against the trademark that has been granted preliminary approval. The Trademark Office will send the Application for Trademark Opposition to the opposed party for a response to be made within 30 days as from the receipt of notification. The Trademark Office will then make an adjudication based on the facts and grounds presented by both parties.

Where no opposition has been filed against a trademark or the opposition is not justified, approval will be granted for the trademark to be registered. A certificate of registration will be issued and the trademark will be published. Where the opposition is justified, registration will be refused.

If the registration of an opposed trademark has been published before the ruling on the opposition becomes effective, the original publication will be revoked and the trademark whose registration is approved in the adjudication on the opposition will be published anew.

### 8.1.3 Right of Priority in Trademark Registration Application

Where an applicant, within six months from the date of his first-time application for registration of a trademark in a foreign country, applies for registration of the same trademark for goods in the same class in China, he may enjoy the right of priority in accordance with any relevant agreement entered into between that country and China or any relevant international treaties to which both countries are parties, or on the basis of the principle of reciprocity.

Where a trademark is used for the first time in respect of a commodity displayed in an international exhibition organised or recognised by China, the applicant of the trademark is entitled to the right of priority for a period of six months from the date of the display of the commodity.

### 8.1.4 Application for Change of Details of Registered Trademark

To change the name, address or other registered particulars of a trademark registrant, an application for change should be filed with the Trademark Office. Upon granting approval, the Trademark Office will issue a certificate to the registrant and announce the change; for rejected cases, the Trademark Office will notify the applicant in writing, stating the grounds for rejection.

To change the name of a trademark registrant, a document in support of the change issued by the registration organisation should be submitted. Where the name or address of a trademark registrant is to be changed, the trademark registrant should make the same modification in respect of all his registered trademarks.

### 8.1.5 Application for Assignment of Registered Trademark and Transfer of Exclusive Right to Use a Trademark

Where a registered trademark is to be assigned, both the assignor and assignee should submit an Application for Assignment of Registered Trademark to the Trademark Office,

while the application procedures are to be completed by the assignee. Upon approval granted by the Trademark Office, a certificate to that effect will be issued to the assignee and the assignment will be announced.

When assigning a registered trademark, the trademark registrant should assign simultaneously the same or similar trademarks registered by him for the same or similar goods.

If the exclusive right to use a registered trademark is to be transferred for reasons other than assignment, the transferee should complete the procedures for the transfer of such right with the Trademark Office by presenting the relevant supporting documents or legal documentation. When transferring the exclusive right to use a registered trademark, the transferor should transfer simultaneously the same or similar trademarks registered by him for the same or similar goods.

#### 8.1.6 Validity Period and Renewal of Registered Trademark

The period of validity of a registered trademark is 10 years, counted from the date of approval of the registration. For renewal, the period of validity of each renewal is 10 years, counted from the day immediately following the expiration of the preceding validity period.

Where the registrant intends to continue to use the registered trademark beyond the expiration of the validity period, an application for renewal should be made within six months before the said expiration. If no application is filed within this period, a grace period of six months may be granted. If no application is filed at the expiration of the grace period, the registered trademark will be cancelled.

To apply for renewal of a trademark registration, an application for renewal of trademark registration should be filed with the Trademark Office. Upon approval granted by the Trademark Office, a certificate to that effect will be issued to the registrant and the renewal will be announced.

#### 8.1.7 Authorised Use of Registered Trademark

A trademark registrant may, by signing a trademark licensing contract, authorise other persons to use his registered trademark. The licensor should file a copy of the trademark licensing contract with the Trademark Office for the record within three months from the signing of the contract. Parties authorised to use the registered trademark of others must display the name of the licensee and the place of production of the goods on the goods using the licensed trademark.

#### 8.1.8 Re-issuance of Certificate of Trademark Registration

Where a Certificate of Trademark Registration is lost or damaged, it is necessary to apply for re-issuance of the certificate and the registrant should submit an Application for Re-issuance of Certificate of Trademark Registration and five copies of the reproductions of the registered trademark to the Trademark Office. Where the Certificate of Trademark Registration is lost, a declaration should be published in the Trademark Gazette. Where the certificate is damaged, it should be returned to the Trademark Office.

#### 8.1.9 Protection of Well-known Trademark

The Trademark Office under SAIC is responsible for endorsing and managing well-known trademarks.

A trademark registrant seeking protection for his well-known trademark should file an application with the Trademark Office. Upon endorsement, the Trademark Office will notify the applicant and publish the relevant information. For trademarks endorsed by the Trademark Office as well-known, no application for renewal of endorsement is necessary within three years after endorsement.

If any person uses a trademark that is identical with or similar to the well-known trademark of another person on goods of a different class, insinuating that the goods are in some way associated with the registrant of the well-known trademark

thereby causing possible damage to the registrant, the registrant of the well-known trademark may make a request, within two years from the date on which he obtains or should have obtained knowledge of such acts, to SAIC to stop such acts.

Once a well-known trademark has been endorsed, SAIC will not approve the use of any word or device that is identical with or similar to the said well-known trademark by any person as part of the name of an enterprise which may mislead the public. For well-known trademarks that have been registered, the registrant may, within two years from the date on which he obtains or should have obtained knowledge of such acts, request SAIC to cancel it.