

Protection of Well-Known Trademark in China

By Hongxia Wu, CCPIT Patent and Trademark Law Office, China

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It is often stated that in China a well-known trademark enjoys the broadest protection in a trademark legal system. This article will help you clearly understand how broad the protection scope of well-known trademark is in different circumstances and the related strategies.

Protection Scope of Well-known Trademark

There is no sole well-known trademark protection law in China. We must explore the actual protection scope from different Chinese laws and judicial interpretations, which may mainly include the following:

- 1) Chinese Trademark Law
- 2) Interpretation of the Supreme People's Court on Application of Laws in the Trial of Civil Disputes Over Domain Names of Computer Network (Judicial Interpretation [2001]24)
- 3) Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks (Judicial Interpretation [2002]32)
- 4) Provisions of the Supreme People's Court on Issues Concerned in the Trial of Cases of Civil Disputes over the Conflict between Registered Trademark or Enterprise Name with Prior Right (Judicial Interpretation [2008]3)
- 5) Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Well-known Trademarks (Judicial Interpretation [2009]3)
- 6) Provisions of the Supreme People's Court on Several Issues concerning the Trial of Administrative Cases involving Trademark Authorization and Confirmation (Judicial Interpretation [2017]2)

This article will base on above laws and judicial interpretations and provide a creative analysis of the respective protection scope of different types of trademarks (from normal trademark to well-known trademark) while combating others' rights or acts.

1. Well-Known Trademark vs. Late Trademark Application/Registration

Under Chinese trademark practice, the issue of a well-known trademark arises mostly in the situation where someone applies for a trademark which constitutes a copy, imitation or translation of a well-known trademark, namely in the proceedings of trademark opposition, invalidation and concerned lawsuit.

		Prior Mark App. or Reg.	Prior Used Mark of Certain Reputation	Prior Non-Registered Well-known Mark	Prior Registered Well-known mark
Late mark application or registration	Same or similar goods/services	✓ 【Articles 30 and 31 of Chinese Trademark Law】	✓ 【Article 32 of Chinese Trademark Law】	✓ 【Article 13 of Chinese Trademark Law】	✓ 【Article 13 of Chinese Trademark Law】
	Not dissimilar goods/services	X	X	X	✓ 【Article 13 of Chinese Trademark Law】
Invalidation time limit		Five-year time limit 【Article 45 of Chinese Trademark Law】	Five-year time limit 【Article 45 of Chinese Trademark Law】	Five-year time limit 【Article 45 of Chinese Trademark Law】	Not subject to the five-year time limit, if the disputed reg. is acquired in bad faith 【Article 45 of Chinese Trademark Law】

As can be seen from the above list, among the above four earlier trademark rights, only the registered well-known trademark can obtain a full protection, which applies to not only same or similar goods/services but also non-dissimilar goods/services.

The above list can also clearly indicate that the importance of registration in trademark right protection in China. Different from the registered well-known trademark which has the protection against non-dissimilar goods/services, the protection of unregistered well-known trademark is limited to same or similar goods/services only. Besides, an unregistered but prior used trademark can have the same level of protection as a trademark registration, only if the former has obtained a certain reputation through use.

It appears from the list that the prior used trademark of certain reputation and non-registered well-known trademark enjoy the same level of protection. However, in practice they are not same in similarity determination of goods and marks because the protection scope changes naturally along with the degree of reputation.

“Five-year time limit” means that a prior rights holder or an interested party may apply for declaration of invalidation of the registered trademark within five years from the date of trademark registration. This is a result after balancing the interests between the prior rights holder and the trademark registrant. However, a well-known trademark holder is not subject to the “five-year time limit” when the

disputed registration is acquired in bad faith. The different rules as to the invalidation time limit can strongly support the broad protection of a well-known trademark in China.

2. Well-Known Trademark vs. Late Trademark Use

The following list will reflect that if someone use a sign as a trademark in commerce and the said use is conflicting with the earlier trademark rights, how the reputation of a well-known trademark will affect the protection scope.

	Prior Mark Registration	Prior Unregistered Well-Known Mark	Prior Registered Well-Known Mark
Use Registered Mark as It Is Registered	X 【 Article 1 of Judicial Interpretation [2008]3 】	✓ 【 Article 11 of Judicial Interpretation [2009]3 】	✓ 【 Article 11 of Judicial Interpretation [2009]3 】
Use Registered Mark Not as It Is Registered	✓ 【 Article 1 of Judicial Interpretation [2008]3 】	✓ 【 Article 11 of Judicial Interpretation [2009]3 】	✓ 【 Article 11 of Judicial Interpretation [2009]3 】
Use an Unregistered Mark on Same or Similar Goods	✓ 【 Article 57 of Chinese Mark Law 】	✓ 【 Article 2 of Judicial Interpretation [2002]32 】	✓ 【 Article 1 of Judicial Interpretation [2002]32 】
Use an Unregistered Mark on Non-Similar Goods	X	X	✓ 【 Article 1 of Judicial Interpretation [2002]32 】

As seen from the above list, when conflicting with a trademark use in commerce, the prior well-known trademark rights have a broader protection in following circumstances:

Circumstance No. 1: In case that someone uses the trademark in commerce in the same way as it is registered but a prior trademark right holder finds that the use is conflicting with his earlier rights, there will be two different handling ways. If the earlier right holder has a normal trademark registration rights, he must first apply for declaration of invalidation against the trademark registration upon which the trademark use is based with China National Intellectual Property Administration (CNIPA). Before the invalidation is decided, Chinese Courts will not accept the lawsuit based on trademark infringement or anti-unfair competition. Currently, it takes around 1 to 1.5 years for an invalidation to be decided by the CNIPA. After that, both parties can appeal the invalidation decisions of the CNIPA to Beijing IP Court and further to Beijing Higher People's Court. Therefore, it might be considered as time consuming to the earlier right holder. However, if the earlier right holder's trademark is well-known even it is not registered in China, he has the right to directly file a lawsuit against the trademark use with Chinese courts and request the courts to prohibit the defendant from using the trademark.

Circumstance No. 2: A prior registered well-known trademark owner is entitled to have a protection in respect of non-similar goods/services, where it is sufficient to make the relevant general public believe that there is a certain connection between the trademark against which the lawsuit is lodged and the well-known trademark and as a result the distinctiveness of the well-known trademark is diluted and the market reputation of the well-known trademark is degraded or the market reputation of the well-known trademark is improperly utilized. However, a normal trademark registration and a prior un-registered well-known trademark are protected only against other's trademark use in respect of same or similar goods.

3. Well-Known Trademark vs. Late Enterprise Name

	Prior Mark Registration	Prior Unregistered Well-Known Mark	Prior Registered Well-Known Mark
Use Enterprise Name on Same or Similar Goods	✓ 【Article 1 of Judicial Interpretation [2002]32】	✓ 【Article 6 of Anti-Unfair Competition】	✓ 【Article 1 of Judicial Interpretation [2002]32】
Use Enterprise Name on Non-dissimilar Similar Goods	X	X	✓ 【Article 2 of Judicial Interpretation [2009]3】

An enterprise name should be used in accordance with laws and not in a way to liable to mislead relative public as to the other's earlier trademark rights. The earlier trademark holder has the right to request Chinese Court to demand the enterprise name be used legally and be stopped for use. The broad protection of well-known trademark lies on situation that even the enterprise name is used on the dissimilar goods/services, the prior well-known trademark registrant can still fight against it, where the enterprise name use will damage their interests upon the well-known trademark.

4. Well-Known Trademark vs. Late Domain Name

	Normal Mark Registration	Well-Known Mark
Register or Use Domain Name for Commercial Purpose	✓ (plus bad faith and misrecognition requirement) 【Articles 4 and 5 of Judicial Interpretation [2001]24】	✓ 【Articles 4 and 5 of Judicial Interpretation [2001]24】

The above list shows that while combating the domain name right, the prior trademark holder does not need to establish the reputation of the prior trademark. However, if the holder's trademark is well-known, he has no need to prove that the disputed use or registration of the domain name is sufficient

to cause misrecognition as to the relative public and the said use or registration of the counter party is in bad faith, as a normal trademark registration holder should do. In other words, comparatively, the holder of well-known trademark has less burden of proof while taking actions against domain name registration or use.

5. Well-known Trademark Related Criminal Liability

Under Article 123 of Chinese Criminal Law, the use of mark same to other's prior registered trademark in respect of same goods is given a criminal punishment, if the circumstances are serious. Despite that the provision itself does not make a difference between a normal trademark registration and a well-known trademark, the protection of well-known trademark right by invoking this provision is explicitly mentioned in the official letter of CNIPA dated July 12, 2019. It is reasonably expected that the well-known trademark rights will be better protected in terms of criminal punishment in China.

After the above analysis, now it is clear why the well-known trademark is deemed as having broadest protection in China. What's more, trademark holders or trademark practitioners may check the above lists to know the respective protection scope of trademarks when encountering different conflicts.

Well-Known Trademark Recognition

After understanding the protection scope of a well-known trademark in China, we would be very curious about how to recognize a well-known trademark in China.

In China, CNIPA and Chinese Courts designated by China Supreme People's Court are the only competent authorities in well-known trademark recognition.

They may determine whether the trademark is well-known trademark, upon the request of a party and when necessary for case examination or handling, in the following types of cases:

Case types of CNIPA:

- trademark registration examination on the ground of violation of Article 13 of the Trademark Law;
- trademark violation case investigation on the ground of violation of Article 13 of the Trademark Law; or
- trademark dispute resolution cases on the ground of violation of Article 13 of the Trademark Law.

Case types of Chinese Courts:

- a trademark right infringement lawsuit initiated on the ground of violation of Article 13 of the Trademark Law;
- a trademark right infringement or unfair competition lawsuit initiated by a party on the ground that an enterprise's name is identical with or similar to its well-known trademark; or
- a counterargument or counterclaim of the defendant on the ground that the plaintiff's registered trademark is a copy, imitation or translation of its earlier un-registered well-known trademark.

As noticed from the above, domain name related disputed cases are not competent for recognizing well-known trademarks in China.

Well-Known Trademark Strategy

1. A trademark will be granted broadest protection scope in China, if it is recognized as a well-known. Furthermore, the record of well-known trademark recognition will play a substantial impact for future cases based on the same mark. Therefore, it is recommended to applying for recognition when encountering a proper case.
2. The most difficult part for an applicant in well-known trademark recognition is to submit enough evidence proving that his trademark has become well-known. The evidence should prove the reputation of the applicant's mark before the date of filing of the disputed mark or before the date of the alleged use. The evidence is better formed in mainland of China (excluding Hong Kong and Macao), because the reputation in other jurisdiction is deemed as a reference. Well-known trademark recognition is a very challenging protect. It is advised that the applicant put great efforts to fully demonstrate that it is a leading brand in the relative field in China.
3. The first to file principle is mainly followed in trademark examination and protection in China. As above analyzed, a registered well-known trademark and an unregistered well-known trademark is quite different in protection scope in China. It is advised to take actions to ensure the well-known trademark be registered in China, except that the said mark is not inherently registrable.
4. In China, the well-known trademark owner should be cautious that they cannot use the words "well-known trademark" on their goods and the packages or containers of their goods or for advertisements, exhibitions, and other commercial activities. However, the owner can advertise well-known trademark recognition as an event in their company websites, WeChat accounts, and etc.
5. A Chinese trademark registration is vulnerable to a non-use cancellation after it is registered for three years. A trademark registration which used to be recognized a well-known trademark cannot be an exception. Therefore, it is necessary to save the concerned use evidence from time to time and monitor any use deadline even for a well-known trademark registration.

For more information, please contact:



Hongxia Wu
Trademark Attorney, Group Leader
CCPIT Patent and Trademark Law Office
wuhx@ccpit-patent.com.cn
www.ccpit-patent.com.cn

Ms. Wu's practices focus primarily on trademark prosecution, administrative protection of trademark validity litigation. She obtained a Juris Mater from Peking University in China in 2006 and attended a 4.5 months intellectual property certificate program in Cardozo Law School in U.S. in 2017. She moderated Table Topic TSU09 (Best Practices for Coping with Trademark Squatting in China for Foreign Companies) in 2019 INTA annual meeting.