

How to Acquire Trademark Protection in China through International Registration under Madrid System

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China is a member state of the Madrid Agreement concerning the International Registration of Marks (the Madrid Agreement) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Madrid Protocol). Marks registered under the Madrid Agreement, Madrid Protocol and the Common Regulations and Measures thereof are marks of international registration. Over the last decade, the number of applications for territorial extension, to China, of registration of trademarks under the Madrid System has almost doubled¹. Since international registered marks are not directly accorded protection in China, the Chinese Trademark Office has adopted a corre-

sponding implementing measures for acceptance and examination of applications for territorial extension of registration of marks to China (including applications designating China in the later stage) to meet its obligation as a contracting party. In terms of procedure, the marks of international registration designating China are quite different from marks in respect of which applications are directly filed for registration with the Chinese Trademark Office. Following are the matters that require attention when applications are filed for territorial extension, to China, of registration of marks under the Madrid System.

1. Background information



The Madrid Agreement and Madrid Protocol formally went into effect in China respectively on 4 October 1989 and 1 December 1995. On 24 May 1996, the State Administration for Industry and Commerce (SAIC) issued the Measures for the Implementation of the International Registration of Marks under the Madrid System, accepting applications for international registration filed with China as a country of origin, applications for territorial extension to China, and other relevant applications. Since the Trademark Law was amended in 2001 and the corresponding Regulations for Implementation thereof promulgated in 2002, the SAIC issued, on 7 April 2003, the new Implementing Measures in relation to Madrid International Registration of Marks (the Implementing Measures), and the Implementing Measures as of 1996 were abrogated on the same day. To date, all the trademarks in respect of which applications are filed for territorial extension to China are handled under the Madrid Agreement, Madrid Protocol, Common Regulations and Measures, and Implementing Measures.

The International Registration Division under the Chinese Trademark Office specially handles matters relating to applications for international trademark registration filed by domestic corporate and natural persons, and examines applications for territorial extension to China filed by nationals from other contracting parties and other applications. In respect of applications for international registration designating China, the Trademark Office does not directly contact registrants, and all documents are communicated thereto through the International Bureau. International trademark registrants who need to go to the Chinese trademark administrative authorities and relevant courts to handle matters relating to international registration of trademark should appoint a qualified trademark agency recognised by the State in relation to the relevant matters.

2. Opposition procedure

In respect of trademarks of international registration designating China (including those designating China in later stage), any one may file opposition, with the Trademark Office, to applications for territorial extension to China published in the WIPO International Trademark Gazette within three months from the first day of the month following the publication of the Gazette. Comparatively, the procedure for opposition to domestic trademarks is different from the procedure for opposition to marks of international registration in three aspects. First, opposition to international registration is filed before the substantive examination of trademarks be-

cause when the International Trademark Gazette in which the mark of international registration designating China is published comes out, the International Bureau is yet to inform the Chinese Trademark Office, so it is impossible for the latter to substantively examine the marks. For this reason, trademark proprietors should keep an eye on the International Trademark Gazette, find, in time, the international applications which might conflict with their own rights, and file their opposition with the Trademark Office, so as not to miss the opposition period. Second, the period for raising opposition to international registration starts from the first day of the month following the publication of the International Trademark Gazette, not from the date of publication, so the time for opposition to international registration is longer. Third, application is not limited to a class of goods or services, and it is possible to related to one or more classes of goods or services.

3. Examination and provisional refusal procedure

The time for a contracting party to the Madrid Agreement to exercise its right of refusal is 12 months, or possibly 18 months. Upon receipt of a notification from the International Bureau, the Chinese Trademark Office is required to finalise the examination (including the formality and substantive examinations) within the said prescribed time limit. At the expiry of the time limit, an international registration is automatically protected in China whether the examination thereof is finalised or not. Under the Madrid Protocol, when the original office of an international application or international registration has acceded to both the Madrid Protocol and Madrid Agreement, the provisions of the Madrid Protocol are not binding within the territory of another country that is also party to the Madrid Protocol and Madrid Agreement; hence, with regard to a country that is party to the Madrid Protocol and Madrid Agreement, the Chinese Trademark Office has to complete its examination within 12 months, and is allowed to complete, within 18 months, its examination of applications from the countries, such as the United States, the United Kingdom, and Japan, which have acceded only to the Madrid Protocol.

The Chinese Trademark Office may make its provisional refusal at the request for opposition filed by an opponent or on any grounds (including the absolute and relative grounds) provided for in the Trademark Law. Since the international registration application opposition procedure is a pre-posed procedure, the Trademark Office may issue a provisional refusal notification at the request of an opponent and accord-

ing to the substantive examination. For an application for territorial extension to China, the Trademark Office may issue, *ex officio*, a provisional refusal notification, notifying the International Bureau for it to notify the registrant, and the Trademark Office will no longer confirm the refusal to the International Bureau.

Directed to any provisional refusal based on opposition, if it is necessary to make a response on the opposition, the defence should be filed with the International Registration Division of the Trademark Office; directed to the Trademark Office's provisional refusals based on the absolute and relative grounds, an application for reexamination of the refusal should be filed with the Trademark Review and Adjudication Board (TRAB). Where a mark under opposition is refused in the phase of substantive examination before the Trademark Office, if the international registrant of the refused mark does not request reexamination, the Trademark Office will terminate the opposition procedure. The Trademark Office and TRAB may make its decision or adjudication at the expiry of the prescribed 12 or 18 months.

During the domestic application examination procedure, the Trademark Office first makes the formality examination. Where the application is procedurally ready on basic terms or the application basically satisfies the requirement, but it is necessary to make amendment thereto, the Trademark Office will issue an amendment notification, inviting the applicant to make amendment within the time limit. Only the domestic applications that have passed the formality examination are allowed to enter the substantive examination procedure. However, in the procedure for examination of applications for territorial extension to China, the International Registration Division of the Trademark Office makes the formality examination and substantive examination at the same time. If the description of the goods or services is found contrary to the standard or some goods or services are not acceptable (e.g. gambling service provision) in China, for provisional refusal on these formality matters, the registrant can not address the matter by requesting reexamination before the TRAB. These formality flaws can be rectified through the International Bureau. Designation is made again to China after the rectification is made, but the former date of designation is not reserved.

4. Grant of protection and enforcement

Before 1 January 2011, an application for international registration designating China was deemed to be granted protection if no notification of refusal of the mark is received.

Since 1 January 2011, if no grounds for refusal are found upon examination, the Trademark Office will issue a statement of grant of protection to the International Bureau in relation to the application. If the Trademark Office issues a provisional refusal notification based on the opposition or the substantive examination findings, the Trademark Office would issue no statement of grant of protection even if the grounds for opposition are untenable or the grounds for refusal in the substantive examination are positively addressed.

The registrant of an international registration granted protection in China is obliged to use the registered mark in an active and constant manner. If the mark is not used for three consecutive years, any person may request the Trademark Office to cancel it. For a mark of international registration that is provisionally refused, the three years start from the expiry of the time for refusal; for a mark of international registration in respect of which the grounds for opposition are untenable or the grounds for refusal in the substantive examination are positively addressed, the three years start from the date on which the relevant adjudication takes effect.

The statement of grant of protection issued by the Trademark Office is not a document to prove the validity of the trademark right. A registrant of international registration may appoint a local trademark agency to file an application with the Trademark Office for issuance of a certificate confirming the registration after the date of expiry of the time for refusal of the trademark or after the Trademark Office's provisional refusal is overcome.

5. International registration changing into domestic application due to central attack

An international registration and basic registration are mutually independent at the expiry of the five years starting from the date of the international registration. Before the five years expires, if the basic application or any application resulting from it is withdrawn, overdue, abandoned, finally refused, cancelled or invalidated, in respect of all the goods or services or some goods or services listed in the international registration, request should not be filed for grant of protection of it. However, when an international registration is cancelled in respect all or part of the goods or services is withdrawn due to said central attack, the registrant may change the international registration into a domestic one within the prescribed three months, and the relevant date of international registration or any date later specified or fixed will be the date of filing. If the international registration has a priority

date, the priority date is also preserved.

6. Assignment/combination/change of registrant's name or address

A trademark of domestic registration must be assigned in its entirety, and the Trademark Office disallows registration in respect of some goods. International registration designating China may be partially assigned so long as the goods or services in respect of which the international registration is assigned are not similar to the remaining goods or services with the international registration. Meanwhile, in the presence of domestic trademark application, where a trademark of the domestic application is similar to a trademark of international registration in terms of goods or services, the former should be assigned together. If an assignor does not apply for assignment of a trademark granted protection in China in respect of all the similar goods or services, the Trademark Office notifies the international registrant to make rectification within 30 days from the date of receipt of the notification; if no rectification is made at the expiry of the time limit, the Trademark Office makes a decision that said assignment is not valid in China, and make a statement to this effect to the International Bureau.

Where any addition or reduction of items of goods or services does not meet the requirement in relation to the classification of goods or services in China, the Trademark Office makes a decision that the addition or reduction is not effective, and make a statement to this effect to the International Bureau.

If a trademark register's name or address is changed, all names and addresses in connection with the trademarks that are protected in China under the registrant's name, including those of all the marks of domestic and international registration should also be changed. Failure to do so is deemed to be a waiver of application for making the change. An application for change of a trademark of domestic registration is filed with the Trademark Office, and that of the international registration with the International Bureau.

7. Substitution of international registration for domestic registration

Where the applicant for territorial extension of an international registration designating China substitutes the international registration of its trademark for a mark of registration secured in China, said international registration does not affect the right in the trademark registered in China. The Trademark Office makes stringent examination of an application for substitution of an international registration for a do-

mestic application, requiring that the sample photographs of the international registration be exactly identical with that of the domestic trademark, the goods or services designated by the international registration fully cover all the goods or services of the domestic registration. Any small variation in the form or words or inconsistency in the goods or services designated is likely to result in the refusal of the application.

8. Provisions pertaining to collective marks and certification marks

The applicant for territory extension of an international registration designating China should submit, under the relevant provisions, proof of qualification for use of such a mark and the regulations for managing the use of said mark to the Trademark Office through a trademark agency within 3 months from the date of registration of the mark in the International Register of the International Bureau of WIPO if the mark of international registration is a collective or certification mark. If the proof and regulations or any other certifying documents are not submitted within the specified 3 months, the Trademark Office will refuse the application filed for territory extension of said collective or certification mark. ■

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¹ According to the WIPO statistics, there were 6,901 trademarks of international registration designating China (including those designating China at later dates), and 18,724 such trademarks in 2011.