

Unofficial SIPS Translation**Beijing Higher People's Court Guidance on the
Hearing of Administrative Trademark Cases***January 2014*

I. Issues Regarding the Recognition and Protection of Well-Known Trademarks

1. In disputes involving the opposition or cancellation of a mark under Art. 13(2) or 13(3) of the Trademark Law entering into effect on May 1, 2014 (the "Trademark Law"), the key criterion should be whether the cited mark achieved well-known trademark status prior to the application date of the disputed mark. Evidence submitted by the relevant party showing that the cited trademark was recognized as a well-known trademark after the application date of the disputed mark may be capable of proving that the cited mark had achieved well-known trademark status prior to the application date of the disputed mark, and such evidence should be admissible.
2. In determining whether a disputed mark shall be prohibited from registration and use in accordance with Arts. 13(2) or 13(3) of the Trademark Law, in principle it should first be determined whether the cited mark has attained well-known trademark status. In cases where a mark is determined to be well-known, it should then be determined whether the disputed mark is a copy, imitation or translation of the cited mark, which is likely to confuse or mislead the public, and which may harm the interests of the owner of the well-known mark.
3. Where, in accordance with the provisions of Art. 13(3) of the Trademark Law, a party has applied to oppose or cancel a disputed mark that is designated for use on identical or similar goods, if the administrative decision is based on Articles 30 or 31 of the Trademark Law and satisfied the following conditions, in principle such decision should not be determined as having a mistake in the application of the law:
 - (a) The party did not explicitly assert that the disputed mark violates Arts. 30 or 31 of the Trademark Law;
 - (b) The party's substantial grounds for opposing or cancelling the disputed mark are that the relevant public is likely to confuse the disputed mark and the mark for which protection is sought.

- (c) An application to cancel the disputed mark does not exceed the five year time limit provided in Art. 45(1) of the Trademark Law.

II. Issues Regarding the Recognition and Protection of Geographical Indications

- 4. Where a party has applied to oppose or cancel a disputed mark in accordance with the provisions of Art. 16(1) of the Trademark Law, the party should prove that the application to register the disputed mark would likely cause relevant consumers to mistakenly believe that the goods on which the dispute mark is used originate from the region indicated by the geographical indication.
- 5. Where, on the basis of its prior registered common trademark, a party applies to oppose or cancel another party's application to register a geographical indication certification trademark or collective trademark on the grounds that the disputed mark violates Art. 13(3) or Art. 30 of the Trademark Law, such arguments should not be supported. Where, on the basis of its prior registered geographical indication certification trademark or collective trademark, a party applies to oppose or cancel another party's application to register a common trademark on the grounds that the disputed mark violates Art. 13(3) or Art. 30 of the Trademark Law, such arguments should not be supported.
- 6. Where a party has applied to oppose or cancel a geographical indication certification trademark or collective trademark on the basis of the provisions of Art. 16(2), the phrase "does not conform to the relevant provisions of this Law" in clause of Art. 30 of the Trademark law shall be applied in hearing the case.

III. Issues Regarding the Determination of Confusion and Mistakes

- 7. A trademark registrant shall enjoy independent trademark rights in respect of each of its different registered trademarks. There is not necessarily a continuous relationship between a registrant's earlier and later registered marks.
- 8. Where a trademark registrant's underlying trademark has obtained a certain degree of reputation through use, thereby causing relevant consumers to associate a later application to register an identical or similar mark designated for use on identical or similar goods together with that underlying trademark, and to believe that the goods on which the two marks are used all come from the registrant or a party with a special connection to the registrant, then the commercial reputation of the underlying trademark can flow through to the later mark.
- 9. Following the registration of an underlying mark, and prior to an application to register a later mark, if another party registers a mark that is identical or similar to the later mark in respect of identical or similar goods and the other party's mark obtains a certain degree of reputation through continuous use, in circumstances where the underlying mark has not been used or has been used but has not obtained a reputation, and the relevant public would easily confuse the later mark and the other party's prior registered mark, then the applicant of the later marks assertion that the reputation of the underlying mark flows through to the later mark should not be supported.

10. Where a party asserts that its not yet registered disputed mark has already achieved a stable market order through use and can be distinguished from the cited mark, but the party cannot prove that the disputed mark was in continuous use prior to the application date of the cited mark, then such arguments should not be supported.
11. Where a party asserts that its unregistered disputed mark has already achieved a stable market order through use and can be distinguished from the cited mark, it shall provide evidence to prove its use of the mark, the degree of fame of the mark, and that the relevant public will not confuse the disputed mark and the cited mark. The right holder of the cited mark may also submit evidence proving that the relevant public is likely to confuse the disputed mark and the cited mark.
12. With respect to assertions made by the owner of a disputed mark that the disputed mark has already achieved a stable market order through use and can be distinguished from the cited mark, a determination should be made on the basis of a comprehensive consideration of the evidence submitted by the owner of the disputed mark, the evidence submitted by the right holder of the cited mark, the subjective state of the owner of the disputed mark, and other factors.
13. Regarding the question of whether the relevant public can distinguish the disputed mark and the cited mark, the parties may submit market research conclusions as evidence. Market research should as far as possible simulate the actual specific circumstances in place when the relevant public purchases goods, and should describe in detail the scope, number and method of determining the relevant public, the degree of attention of the relevant public when purchasing goods, and the methods of comparison, including overall comparison, comparison in isolation, and comparison of main parts. Market research conclusions will not be admissible if they lack the aforementioned key elements, if they contain methodological errors, or if the research cannot be verified as authentic.

III. Issues Regarding the Protection of Prior Rights

Name Rights

14. If an application to register as a trademark the name of a political, religious, historical or other public figure would have negative effects on China's political, economic, cultural, religious, ethnic, or other public interests and public order, this can be deemed to be an "other harmful effect" as set out in Art. 10(1)(8) of the Trademark Law.
15. If an application to register as a trademark the name of a living natural person harms that person's name rights, it is inappropriate to deem this to be an "other harmful effect" as set out in Art. 10(1)(8) of the Trademark Law.
16. In relation to name rights, the term "name" shall mean the name as recorded in census records / household registry records, and shall also include aliases, pen names, stage names, nick names and other forms of appellation.
17. An identifying sign that is capable of being used in a corresponding relationship with a specific natural person may be considered as that person's name.

18. Where an applicant is aware of the name of a natural person and uses illegitimate or fraudulent means to apply to register that natural person's name as a trademark, such behavior shall be deemed as harming that natural person's name rights in violation of Art. 32 of the Trademark Law.
19. Fame is not a prerequisite for protection of the name rights of a natural person, but fame may be a factor to be considered when determining whether the relevant public regards a certain name as having a corresponding relationship with a specific natural person.
20. In normal circumstances, natural persons should assert their name rights themselves. Under special circumstances, such as where documents are submitted that clearly authorize a manager of models, actors or other name right holders to assert name rights on their behalf, a duly authorized manager may assert name rights on his/her client's behalf.

Copyright

21. The question of whether a trademark representation constitutes a copyright work shall be determined in accordance with the provisions of the Copyright Law.
22. Documents related to the design of a trademark representation, copyright registration certificates, contracts commissioning the design of the trademark representation, copyright assignment agreements, and other materials can be taken as prima facie evidence of copyright in the trademark representation.
23. A copyright registration certificate that is obtained after a trademark is opposed or a cancellation is filed is not sufficient to prove ownership of copyright in the trademark representation.

V. Issues Regarding Relevant Procedures

24. Provided that the following conditions are met, if an opposed trademark is owned by an enterprise that has had its business license suspended, but that has not carried out cancellation procedures, the opposed mark can be refused registration in accordance with Art. 4 of the Trademark Law:
 - (a) At the time the administrative decision is issued, the business license of the enterprise that owns the opposed mark has been suspended for more than three years;
 - (b) There is no evidence indicating that the opposed mark has been assigned or licensed to another party;
 - (c) The enterprise that applied for the opposed mark has not participated in administrative review or subsequent judicial appeal proceedings, and has not provided an explanation or made any assertions related to its enterprise status or the status of the opposed trademark;
 - (d) The opposed mark is a copy or imitation of the cited mark, and there is a certain degree of association between the goods on which the two marks are designated for use.
25. Where a disputed trademark is assigned while still under review, and the defendant has not informed the assignee to request that the assignee give explicit notice as to whether it will participate in the review procedures and directly deliver unfavorable administrative rulings, if the assignee is able to prove in a court appeal that the grounds and conclusion of the administrative ruling are contrary to the law, the administrative ruling should be revoked. If

the defendant has not informed the assignee to request that the assignee give explicit notice as to whether it will participate in the review procedures, but the assignee is not able to prove in a court appeal that the grounds and conclusion of the administrative ruling are contrary to the law, the court should confirm that the review and adjudication procedures were improper, but reject the assignee's assertion that the adjudication procedures are contrary to the law.

26. Where a disputed trademark is assigned while still under review, and the assignee takes part in subsequent review procedures, the assignor shall no longer be deemed an interested party to the review procedures, and the assignor shall not have the right to file a court appeal in respect of the relevant review decision.
27. With respect to the mail delivery of case acceptance notices, evidence notices, notices of response, evidence exchange notices and evidence, and other relevant case materials delivered during the course of trademark review and adjudication procedures, the standard of proof of delivery shall be receipt by the relevant party.
28. Where the complainant asserts that it has not received relevant case materials, and that the notice procedures are therefore contrary to the law, the defendant should furnish evidence proving that the relevant case materials have been signed for, or provide other evidence showing that the materials have been received or that constitute evidence of delivery. Evidence submitted by the defendant, such as outgoing mail lists and other internal materials, or evidence that the relevant case materials were handed over to the post office and not returned, are not sufficient to prove prior delivery.
29. If the defendant is unable to provide evidence that the complainant has received the relevant case materials, but the grounds and conclusions of the ruling are not improper, and the complainant has not made any substantial arguments other than the assertion that the delivery procedures are contrary to the law, or if it is obvious that the complainant's arguments or evidence are not tenable or are outside of the scope of review of the case, the court should acknowledge that the delivery procedures were improper, but its judgment should dismiss the complainant's claims.
30. If the complainant asserts that the TRAB decision should be overturned due to procedural errors that resulted in the complainant being unable to exercise its right to apply for recusal of a member of the collegial panel, but during the court appeal the complainant does not put forward any substantive reason for the recusal of a member of the collegial panel, the court should point out that the procedures relating to notification of recusal were improper, but should dismiss the complainant's corresponding claim.