Trademark Prosecution and Opposition in China

Recent Developments and Challenges

2017.11.

NTD Intellectual Property Attorneys

A Great Wall of ... Trademarks



A Great Wall of Trademarks

3 parts of the Wall –

- 1. Very different trademark system
- 2. Huge amount of filings and registrations
- 3. Serious bad faith filings

A Very Different Trademark System

- First to file system, filing is easy and cheap
- Use evidence or intention to use not required at and after filing
- Non-use cancellation available only after 3 years of registration
- Complicated subclass system based on Nice classification
- Registration is the King and basically no common law right

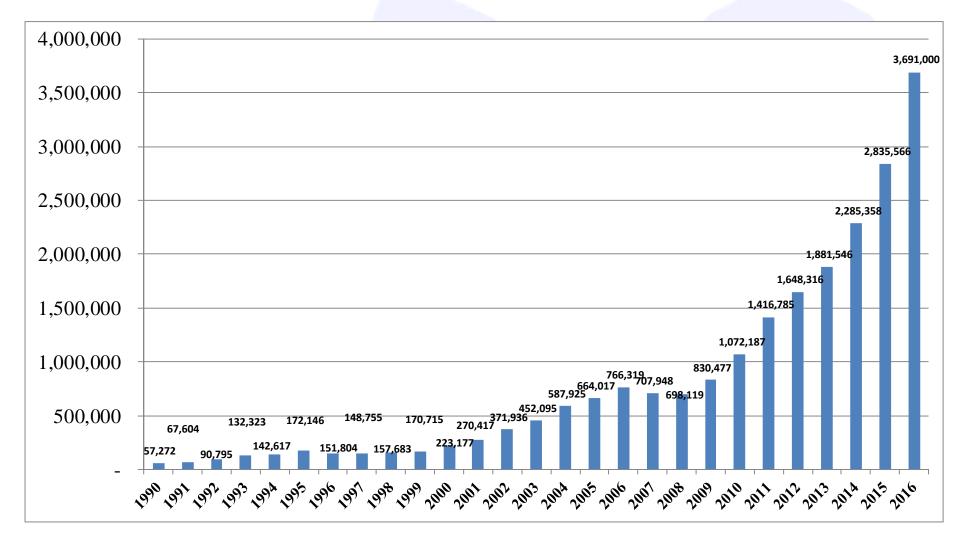
- Find US lawyers who has experiences

- Find reliable Chinese trademark firms

Go to China Trademark Association website to find their member firms (25K v. 500) www.cta.org.cn

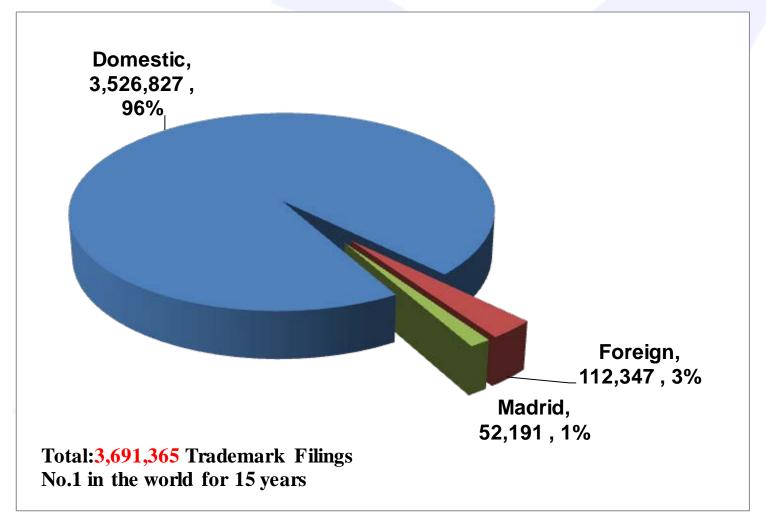


Trademark Filings 1990 - 2016





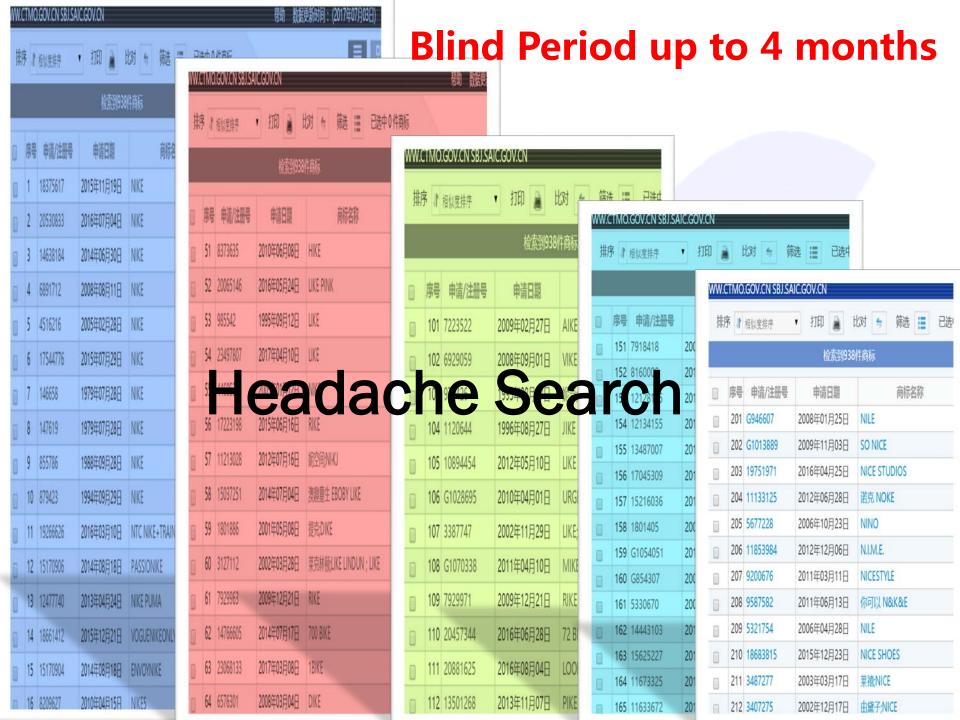
Trademark Filings in 2016



13.2 millions Existing Registrations

http://sbj.saic.gov.cn/sbcx/





High Rate of Rejection

2016

- Total filings: 3.691 M
- Filings examined: 3 M
- Rejected and partially rejected: 1.2 M

Overall Rejection Rate: 40% +

2017 filing expectation: 4-5M

- File immediately, as soon as possible

- Chinese version is extremely important

- File more times for really important marks

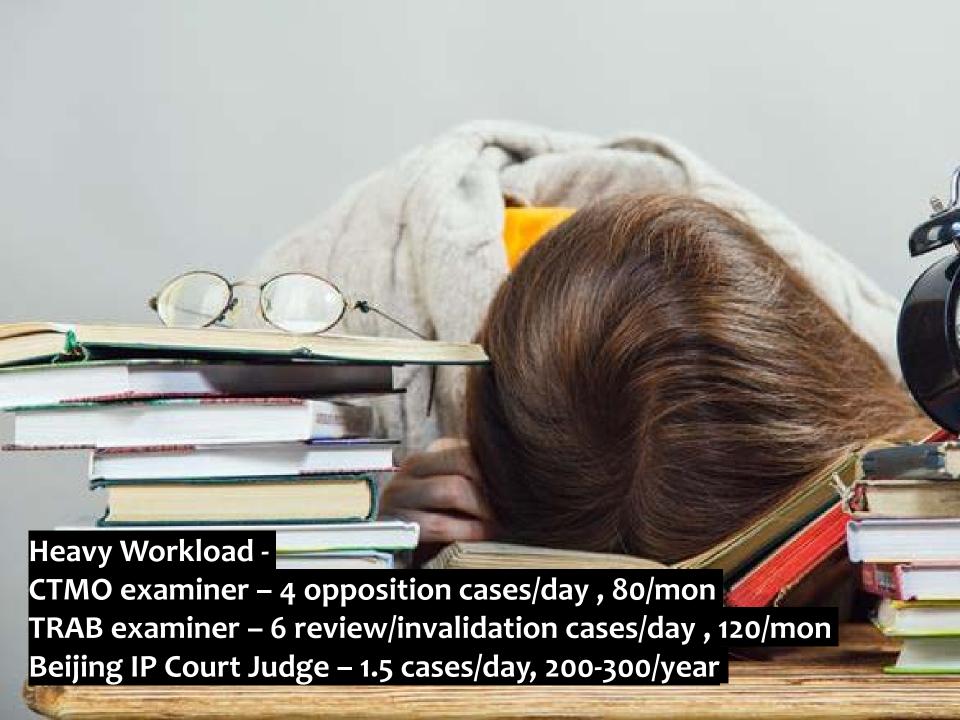
A jungle with bad faith filings





Numbers from Beijing IP Court (from 2014.11-2017.3)

- 13558 trademark administrative litigations, 58% of all IP cases
- Cases (review on opposition and invalidation) involving bad faith filing 30%



Watch and Opposition Important

Total oppositions received in 2016 -

57274

Success rate: about 30% (18000)

Total review on opposition received in 2016 -

1280

 Copyright registration for device mark and stylized mark - a super trademark

- Collect evidence of bad faith and bring that to Court (22% chance to beat TRAB in Court)

Take Away Tips

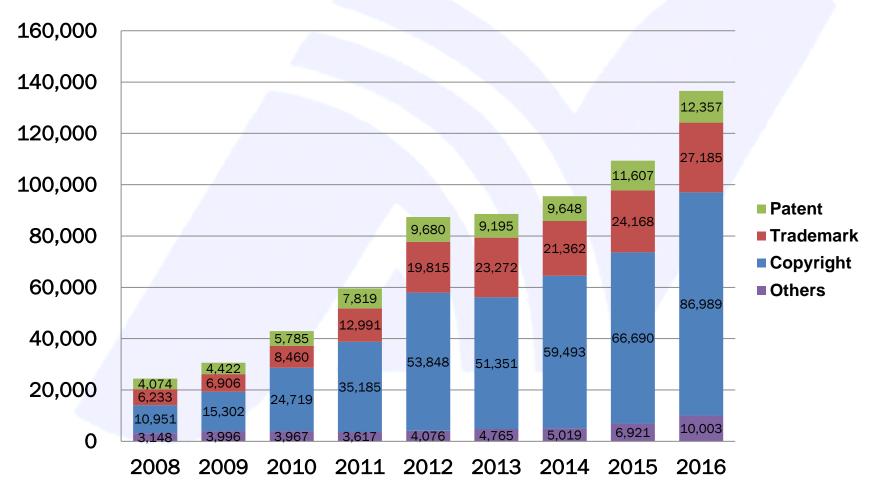
When facing bad faith filings

Situation	Suggestion
Within 3 months of publication	File opposition at CTMO
Already registered	File invalidation at TRAB and/or try anonymous purchase
Registered over 3 years	File cancellation at CTMO for non-use
Large scale trademark squatting	Government dialogue channel
Need to enter the market immediately	Change your mark

Be Careful - Don't Underestimate the Risk

China is strengthening the protection on IP, punishment can be severe

IP civil actions filed to Chinese courts (first instance)



Recent Cases Awarded with High Damages <u>Trademark Infringement</u>

Qiang Gu Case (Beijing IP Court)

First Instance: 10 Million RMB (USD \$1.5 Million)
The highest damages awarded by Beijing IP Court in TM infringement case so far.

John Deere Case (Beijing IP Court)

First Instance: 5 Million RMB (USD \$0.75 Million)
Fully support the plaintiff's claims for damages

• New Balance Case (Guangdong High Court)

First Instance: 98 Million (USD \$14.5 Million)
Second Instance: 5 Million (USD \$0.75 Million)

New Balance Case (Suzhou intermediate Court)
 First Instance: 10 Million RMB (USD \$1.5 Million)



Thank You!

Any Questions?

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