HOW TO PROTECT THE LOOK OF PRODUCTS IN CHINA
7.8+ Million (2019)
China is now the most litigious IP society in the world.
What brand is this?
• Source: Dior China Website
https://www.dior.com/zh_tw/%E9%A6%99%E6%B0%9B/%E5%A5%B3%E6%80%A7%E9%A6%99%E6%B0%9B/jadore
WHY and HOW?

- Why is it so difficult?
- What are the primary ways to protect product look?
  - Design patent?
  - 3D Trademark?
  - Copyright?
  - Unfair Competition Law?
3D Trademark

• GRANT: Article 8 of the China Trademark Law

• LIMITATION: Article 12 of the China Trademark Law
NOT allowed for 3D Trademark

- The design is functional
- The design is driven by technology needs
- The design lacks distinctiveness
- The design is compromised of the product’s own shape
<table>
<thead>
<tr>
<th><strong>Mark</strong></th>
<th></th>
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<tbody>
<tr>
<td><strong>Indication relating to the nature or kind of mark</strong></td>
<td>Three-dimensional mark</td>
</tr>
<tr>
<td><strong>International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(7)</strong></td>
<td>19 07 01, 23 01 02</td>
</tr>
<tr>
<td><strong>Description of the mark</strong></td>
<td>The mark is the form of the and long* &quot;D&quot; letters with small globe, the lower and oval shape of the circles. Long domed gold</td>
</tr>
</tbody>
</table>
| **International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(10-2014)** | 03 Perfumes, perfumes, eau de parfum, eau de toilette, eau de cologne, perfume extracts, scented body milks, scented oils and lotions for the body, shower perfumed lotions, perfumed
• Selected as one of the top 10 cases by China Supreme People’s Court in 2018

• Decision unfavorable to Dior in the 1st and 2nd court decisions.

• Televised review on 4/26/2018 (World’s IP Day) Justice Ms. Tao
Copyright

- Super-Trademark?
- Strength & Limitations
- Key benefits?
Example
Customs Recordal Based on Copyright
What if there’s no registered rights in China?
Key Provision (Article 6(2))

“A business operator shall not harm its competitors.... By using any of the following through unfair means.... Using a unique name, packaging or decoration of another’s famous products, or using a name, packaging, or decoration that is similar to that of another’s famous products”
Product Packaging
Product Design
(Grooved Design)
RIMOWA日默瓦的微博 - 微博
叫上小跋我们三人组队去某医院割包皮呢！结果小明，小跋还有你都
www.sina.com.cn - 微博

新低3180元【爸爸去哪儿厂家】Rimowa 日默瓦S
网易考拉最新降价商品：【爸爸去哪儿厂家】Rimowa 日默瓦SALSA A
箱。此前记录最低价3180元，最高4116元。现价3180元。本店商品支
www.taobao.com - 网店

德国品牌：“百捱”不扰的RIMOWA | 非常德国之五
Jan 30, 2016 - 为市场太小，反倒没有企业想到会和RIMOWA展开竞
www.sina.com.cn - 微博

从RIMOWA看奢侈品营销策略- 知乎
Oct 10, 2019 - 的确，有一个在LVMH当CEO的爸爸——伯纳德·阿尔诺有
www.zhihu.com - 网站
Four-Prong Test

• The characteristics at issue has gained a high level of fame in China
• The characteristics at issue is not a common design in the industry
• The characteristics at issue is not functional in nature
• The characteristics at issue, as employed by the junior product, is identical or similar to that of the famous product which has resulted in consumer confusion.
Question ONE
Protecting the looks of products in China

Infringers are getting smarter in China – they no longer copy trademarks directly but target a product’s look. So how can rights holders best protect unique packaging, creative shapes or innovative designs in the world’s biggest market?

Ten years ago, the hottest IP question in China was: “How do you protect a western brand?” Discussions relating to China’s sub-class system were an inevitable topic in almost every international trademark conference.

Five years ago, the rise of ecommerce platforms such as Taobao, Alibaba and JD helped to move the focus away from sub-classes and on to the subject of online counterfeiting.

While this is still a big issue – particularly where infringers either copy or invent similar marks clearly based on famous brands, (JUST DO IT versus JUST DID IT) – around three years ago the spotlight shifted again as infringers started to develop new marketing methods for fake goods. Rather than simply using a word mark or a logo as a source identifier, companies began to...

situations trademark registrations are permitted for traditional elements, such as word marks or logo design only. The law has not (yet) evolved to the point where a product’s unique characteristics can also be recognised and protected as marks. For example, China has not yet allowed the use red soles of Christian Louboutin-branded high heels to be registered as a trademark (the application was appealed at the time of writing). Under the new laws in China there is nothing to stop any shoe manufacturer from manufacturing, selling or distributing red soles with soles which are exactly the same shade of red, provided that they do not explicitly include the Christian Louboutin logo or brand.

When a product’s creative marketing features cannot...

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- Email: Amy@AdseroIP.com
- Our website: https://www.adseroip.com/
- China TM Blog: www.chinatizeit.com
Thank you.

鑫睿 ☀️ ADSERO IP