



The Trademark Prosecution Review

2024

**Specialist Chapter: Common Mistakes
to Avoid When Filing Trademark
Applications in China**

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The first edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

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Specialist Chapter: Common Mistakes to Avoid When Filing Trademark Applications in China

Shanshan Du

China Patent Agent (HK) Ltd

Summary

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IN SUMMARY

Chinese trademark law and practice have characteristics distinct from their counterparts in other countries and areas. Many foreign applicants failed to obtain trademark registration in China because of their inadequate or improper understanding of the Chinese Trademark Law, the Implementing Regulations of the Trademark Law, and specific requirements of the China National Intellectual Property Administration (CNIPA). In China, once an application is filed, no amendment to the trademark specimen is allowed, nor can the designated goods or services be voluntarily amended either, unless the CNIPA so requires. This article provides some guidance on the common mistakes to avoid at the outset in filing a trademark application in China.

DISCUSSION POINTS

- What should be known when choosing a trademark?
 - How to choose goods and services
 - The importance of formality issues
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REFERENCED IN THIS ARTICLE

- Provisions of the Supreme People's Court on Several Issues Concerning the Trial of Administrative Cases of Trademark Authorisation and Confirmation
 - Chinese Trademark Law
 - Guidelines for Trademark Examination and Trial 2021
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WHAT SHOULD BE KNOWN WHEN CHOOSING A TRADEMARK?

Suggestive Marks Face High Rejection Risk And Provide Limited Protection

It is advisable to choose a mark with strong distinctiveness, such as a fanciful or an arbitrary one, which will offer a strong level of protection against infringement. While suggestive marks may save time and cost in marketing and advertising to gain customer recognition, they leave their owners vulnerable to infringement, which could eventually cost even more. In Chinese examination practice, the boundary between a suggestive mark and a descriptive mark is considered vague. In other words, a suggestive mark is likely to be rejected on the grounds of lack of distinctive characteristics, and hence, it is difficult for these to be approved for registration.

- Case 1: the application for trademark 'Chlorophyll TEA LEAF in logo' on the goods "shampoo; anti-wrinkle cream; acne cream; hair generating oil; cosmetics", etc, in Class 3 was finally determined as lacking distinctive characteristics by the Supreme People's Court of China, even though the applicant argued that the trademark is a suggestive mark and not a descriptive mark.^[1] The Court held that when paying average attention, the relevant public would regard the trademark as a direct description of the characteristics of the raw materials, ingredients and other aspects of the above-mentioned goods,^[2] and in addition, the descriptive part of the trademark

is not expressed in a unique way, which does not give the trademark a significant feature as a whole and, therefore, cannot serve to identify the source of the goods.^[3]

- Case 2: Meishi Daren Company, the trademark owner of '85 °C' series trademark, claimed that Bright Dairy Company used a label '85 °C' identical to its registered trademark for similar goods, specifically, in a prominent position on the packaging of Bright Dairy's 'Yubei' series of fresh milk products, and Bright Dairy also highlighted the label '85 °C' in advertising. The first instance judgment held that Bright Dairy's use of '85 °C' constitutes infringement. Bright Dairy was dissatisfied with the decision and filed an appeal. The court of second instance deemed that Bright Dairy's use of '85 °C' on the accused infringing products is only for the purpose of explaining to the relevant public the process characteristics of its pasteurisation technology, which still falls within the scope of reasonable description of the characteristics of its products and does not constitute use of Meishi Daren's registered trademark; rather, it is a legitimate use of expressing temperature and, therefore, does not constitute trademark infringement.^[4]

From Case 1, we can see that a suggestive mark carries with it a high risk of being rejected, and it is quite hard to be granted the exclusive rights to the mark. On the one hand, this kind of trademark may lack distinctive characteristics or potentially mislead the relevant public regarding the goods; however, if the trademark is granted exclusive rights, it will pose a potential threat to the third parties' use of the composing words even in a descriptive manner, as it will render the third parties hesitant about whether to use the words included in the registered mark, regardless of whether they are descriptive or not.

In Case 2, the likelihood of confusion among the relevant public is the key factor in determining whether trademark infringement is established. If a trademark is not of strong distinctiveness in distinguishing the relevant goods or is even not used thereon, its protection scope will be limited.

It Is Not Advisable To Include A Generic Term In A Trademark

A generic term is likely to cause rejection due to it misleading the relevant public about the quality or other characteristics of the goods, and the chance of overruling the decision is very slim.

- Case 1: the application for trademark 'FINESSEREFLEX' for "surgical instruments and instruments for ophthalmology" was finally determined as lacking distinctive characteristics by the High People's Court of Beijing Municipality, even though the same trademark had been approved for registration in many other countries.-^[5] The Court held that when used for "surgical instruments and instruments for ophthalmology", the trademark would be regarded as the combination of the word 'FINESSE', meaning "refinement or delicacy of workmanship, structure, or texture", and the word 'REFLEX', meaning of "mirror lens". Therefore, it was deemed that the trademark is descriptive and can hardly identify the source of the goods.
- Case 2: the application for trademark 'Coldmelt' on all the designated goods including "unprocessed plastics; metal foam; machines and apparatus for the treatment of materials; semi-processed plastics; concrete; plastic-based liquefiable dowels; glass fibers", etc, in Classes 1, 6, 7, 17, 19, 20 and 21 was finally determined as lacking distinctive characteristics and rejected by the High People's Court of Beijing Municipality.^[6] The fact that the same trademark was approved for registration in

other countries did not contribute to the legal basis for approval in China. The Court opined that the trademark is the combination of the words 'Cold' and 'melt', which constitute a description of the characteristics or contents of the designated goods.^[7] Although the combination is a coined term, it would be easily perceived by the related public as two descriptive words, and hence each part of which will be taken into consideration by the Court.

In light of the above two cases, if a trademark includes a generic term or a combination of generic terms, and where the meaning of any such term has some connection with the characteristics of the designated goods, the trademark as a whole will probably be rejected.

There Is Not Only One Chinese Counterpart To A Trademark In Latin Alphabet

Chinese counterparts, based on transliteration of a Latin mark, could be numerous. They are generally regarded as dissimilar to each other, and thus there is no such thing as a universally recognised counterpart to prevent others from using different versions based on similar pronunciation. The registration of a trademark in letters does not protect the trademark against use or registration of a trademark in Chinese characters with the same or similar pronunciation, and vice versa. It is highly advisable to file an application for the registration of a Chinese version of a Latin mark. If there is not a ready Chinese name for a foreign brand, it is very likely that Chinese consumers will create one by way of translation or transliteration in actual use and the Chinese name is at risk of being squatted.

For example, the letters in trademark 'CATENI' have three syllables, which correspond to three Chinese characters. However, for each syllable, there are several different Chinese characters with the same pronunciation; that is, there is more than one Chinese counterpart for each syllable. The relevant Chinese public tend to write 'CATENI' in Chinese characters more often than in the Latin alphabet for the sake of language habits. In view of this, it is advisable to register a Chinese name for 'CATENI' and use that name for publicity purposes. Otherwise, the relevant public may use a Chinese name of their own choice, thus running the risk of any arbitrary version being pre-emptively registered by some unauthorised parties.

When A Trademark Comes From The Name Of An Enterprise

If a trademark contains the name of an enterprise, in its full form or an abbreviation, and the name is substantially different from the name of the trademark applicant, it will not be approved for registration.^[8] In addition, if a trademark only contains the applicant's full company name, or the distinctive part of which is just the applicant's full company name, it will be rejected due to lack of distinctive characteristics.^[9]

In one case, the application for trademark 'STRAIGHT2BANK' for the goods "computer; computer software", etc, in Class 9 was finally determined by the Beijing Intellectual Property Court as violating Article 10.1(7) of the Trademark Law, because the applicant's company name, STANDARD CHARTERED PLC, is inconsistent with the trademark, which includes the term 'BANK', and the trademark would mislead the relevant public that the goods come from banks or have special association with banks. Although evidential materials were filed by the applicant showing the use of the trademark, they were not adopted by the Court.^[10]

Based on our experience, for the approval of an application for a trademark that includes the term 'BANK', it is required that the trademark applicant be a real bank and the term 'BANK' be included in the company name.

An Application For A Trademark Containing A Slogan Will Probably Be Rejected

A slogan is deemed as lacking distinctive characteristics under Article 11.1(3) of the Trademark Law. For example, the applications for 'WHEN TOMORROW FALLS',^[11] 'EXPANDING HUMAN POSSIBILITY',^[12] and 'LIFE WELL LIVED'^[13] were all rejected by the Chinese courts on the grounds of lacking distinctive characteristics, even though they had been approved for registration in many other countries and areas.

We recommend that when applying for a trademark in China, the mark should be identical to the version in actual use, including the capitalisation of the letters, especially when the designated goods are medical devices in Class 10, as the Chinese supervisory agency is quite strict about this class of goods.

HOW TO CHOOSE GOODS AND SERVICES

A common mistake of many trademark applicants is that they think an application in the name of a class heading can give them full protection for goods and services in that class. Actually, claiming the class heading does not mean full class protection in China. Adopting the local sub-class system for the goods and services is advisable. Take "clothing" in subclass 2501, designating "clothing" as the goods in a Chinese trademark application will not automatically encompass "shoes; hats; hosiery; gloves; scarves; waistbands".

It is advisable to designate the goods in both specific and broad categories to allow more smooth and flexible use of the trademark.

For example, some e-commerce platforms request that the name of the products to be sold should align with the goods recorded in the registration certificate or should at least be covered by the recorded goods in broad description. If the products differ from the goods in the recorded descriptions, the products will not be allowed to be sold on their e-commerce platforms.

For recordation of a trademark licence, if the goods have been designated as belonging to a very broad category only, such as "electronic machines", no specific goods such as "printers" can then be recorded as the licensed goods, because in licensing only the designated goods will be accepted.

It will be better if the applicant, when sending the instruction for a trademark application, also provides a brief introduction or a link to the goods, which can avoid mistranslation in the application as a result of language or cultural difference.

Most, if not all, of the goods and services in Nice Classification are acceptable in China, including "cryptocurrency"-related goods and services, "slot machines [gaming machines]" and 'online retail services for downloadable digital music'. A comprehensive version of China's subclass system can be found at the [WIPO website](#).^[14]

FORMALITY ISSUES ARE ALSO IMPORTANT

All the components included in a trademark specimen to be filed should be clear; otherwise, a clearer version must be submitted. If the re-filed version is still unclear, the application will be rejected and the filing date will lapse. In light of this, if the trademark to be filed includes complicated components, the applicant should pay more attention to the image clarity of the trademark specimen to be filed.

For instance, a company filed an application for its package on which there are many components, among which the net weight part is too small to be recognised. The examiners required the applicant to file a clear specimen, but the re-filed image was still vague. Under this circumstance, the applicant has no further chance of filing a clearer version, nor will this unclear part be allowed to be removed from the filed application. The applicant, if they intend to remove the net weight part, must file a new application.

File With The Valid Business Registration Certificate

In some countries, the validity period of business registration is recorded in the business registration certificate. If the certificate expires when an application for trademark registration is filed, the application will be rejected. But if no validity period is indicated in the certificate, there will be no such kind of problem.

If a trademark contains Chinese characters or Japanese characters, but the writing is not identical to the Chinese standard characters, with some parts added or removed, it is likely that the registration of the trademark will be deemed as bringing negative influence, and the application will accordingly be rejected.

In one case, a company applied for the registration of trademark “”, in which a vertical stroke and a horizontal stroke are missing from the standard character “囧”. It was deemed that this could easily lead the public to believe that it is a modified Chinese character, which belongs to the non-standard use of Chinese characters and is misleading to the public, especially minors, and in this sense may have a negative influence on the culture, education and other social interests of the country.^[15]

Filing applications for the same trademark in a large number of broad classes within a short period of time can expose the applications to the risk of being rejected. The CNIPA may suspect that the applicant has no intention of truly using the trademarks on so many goods and services in different industries, and that the applications are maliciously filed to occupy trademark resources. As such, the CNIPA may require the applicant to submit proof of use or intent-to-use for the trademark.^[16]

Endnotes

- 1 The Supreme People’s Court Judgment No. 12497/2019. ^ [Back to section](#)
- 2 Provisions of the Supreme People’s Court on Several Issues Concerning the Trial of Administrative Cases of Trademark Authorisation and Confirmation. ^ [Back to section](#)
- 3 Article 11.1(2) of the Chinese Trademark Law. ^ [Back to section](#)
- 4 Shanghai Intellectual Property Court Judgment No. H73MZ289/2018. ^ [Back to section](#)
- 5 The High People’s Court of Beijing Municipality judgment (2020)JXZ7137. ^ [Back to section](#)
- 6 The High People’s Court of Beijing Municipality judgment (2019)JXZ9122. ^ [Back to section](#)

- 7 Article 11.1(3) of the Chinese Trademark Law. [^ Back to section](#)
- 8 Article 3.7.2.5 of the Guidelines for Trademark Examination and Trial 2021. [^ Back to section](#)
- 9 Article 3.3.10 of the Guidelines for Trademark Examination and Trial 2021. [^ Back to section](#)
- 10 Beijing Intellectual Property Court Judgment No. J73XC3998/2016. [^ Back to section](#)
- 11 The High People's Court of Beijing Municipality Judgment No. JXZ1306/2023. [^ Back to section](#)
- 12 The High People's Court of Beijing Municipality Judgment No. JXZ7251/2021. [^ Back to section](#)
- 13 The High People's Court of Beijing Municipality Judgment No. JXZ2214/2022. [^ Back to section](#)
- 14 <https://www.wipo.int/madrid/memberprofiles/result?countries=9135&datafields=10076>. [^ Back to section](#)
- 15 The High People's Court of Beijing Municipality Judgment No. JXZ10006/2021. [^ Back to section](#)
- 16 Article 4 of the Chinese Trademark Law. [^ Back to section](#)



Shanshan Du

dshanshan@cpahktd.com

Beijing office CPA Tower, 46 Huayanbeili , Chaoyang District , Beijing 100029, China

Tel: +86 10 8220 2288

<http://www.cpahktd.com/en/default.aspx>

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