



中华人民共和国国家工商行政管理总局商标局

Trademark Office of The Administration for Industry & Commerce of P.R.C



Chinese Legal System of Coping with Bad-faith Filing of Trademark

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People's Republic of China



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- What kind of trademark application might be termed as “bad-faith filing”?
- Common types of bad-faith filing and the related provisions in the *Trademark Law*
- New amendments in the *Trademark Law* against bad-faith filing



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What kind of trademark application might be termed as “bad-faith filing”?

Act of application for trademark registration that is against the principle of good faith, for the purpose of grabbing or unfairly exploiting the goodwill of another party's trademark(s), infringing another party's prior rights, or encroaching public resources.



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Common types of bad-faith filing and the related provisions in the *Trademark Law*

- Reproducing, imitating, or translating another party's well-known trademark
- Applying in unfair means for the registration of a trademark that is already in use by another party and has certain influence
- Applying for the registration of a trademark that infringes another party's prior rights
- The agent or representative of a person who is the owner of a trademark applying in bad faith for the registration of the mark in his own name



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Reproducing, imitating, or translating another party's well-known trademark

Article 13 of the *Trademark Law*

Paragraph 2: A trademark that is applied for registration in identical or similar goods shall not be registered and its use shall be prohibited, if it is a reproduction, an imitation or a translation, of another party's well-known mark that is not registered in China and it is liable to create confusion.

Paragraph 3: A trademark that is applied for registration in non-identical or dissimilar goods shall not be registered and its use shall be prohibited, if it is a reproduction, an imitation or a translation, of a well-known mark which is registered in China, misleads the public, and the interests of the registrant of the well-known mark are likely to be damaged by such use.



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No.4481864 “金灶” trademark opposition case

- The opposed trademark:
No.4481864 “金灶” trademark on
“meat, preserved” in Cl.29
- Grounds of opposition: the opponent requests for recognizing its prior registered “金灶” trademark in Class 11 as well-known trademark.
- The opponent’s trademark:

金灶

KAMJOVE 金灶

Evidence provided by the opponent may prove that its trademark has become well-known among the relevant public in China.

The opposed “金灶” trademark designates goods in Class 29 such as “meat, preserved”, and that the mark is similar to the opponent’s trademark. Thus it constitutes the imitation of a well-known trademark. If the opposed trademark were granted protection and used on its designated goods, it is likely to mislead the public, causing damages to the interests of the registrant of the well-known mark.



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Applying in unfair means for the registration of a trademark that is already in use by another party and has certain influence

Article 32 of the *Trademark Law*:

No trademark application shall infringe upon another party's existing prior rights. Nor shall an applicant register in an unfair means a mark that is already in use by another party and has certain influence.



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No. 4809737 “ERE” trademark dispute case

Requisite conditions for a prior used unregistered trademark to prevent posterior trademark registration include:

- 1. the other party’s trademark is already in use and has acquired certain influence before the application of the disputed trademark;
 - 2. the disputed trademark is identical with or similar to the other party’s trademark;
 - 3. the designated goods/services of the disputed trademark are identical with or similar to the related goods/services of other party’s trademark in principle;
 - 4. the applicant of the disputed trademark bears bad faith.
- The applicant of the dispute case has provided sufficient evidence to prove that it had been using the “ERE” trademark on the aluminum ingots it produced and had acquired certain influence before the application date of the disputed trademark.
 - Both trademarks were using on goods such as “aluminum ingots”.
 - The applicant of the disputed trademark obviously applied for the registration of the trademark in bad faith, for the purpose of making unfair profits.

ERE



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Applying for the registration of a trademark that infringes another party's prior rights

Article 32 of the *Trademark Law*:

No trademark application shall infringe upon another party's
existing prior rights.



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No. 7968391 “季世家1915 and device” trademark opposition case

- The opposed trademark:
- The opponent (Ji Keliang):



The human head portrait device in the opposed trademark bears the same major characters with the portrait of the opponent. It has constituted the infringement of portraiture right that the opposed applied for trademark registration of the portrait in his own name without consent of the opponent.



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The agent or representative of a person who is the owner of a trademark applying in bad faith for the registration of the mark in his own name

Article 15 of the *Trademark Law*:

Where the agent or representative of a person who is the owner of a mark applies, without such owner's authorization, for the registration of the mark in his own name, if the owner opposes the registration applied for, the application shall be refused and the use of the mark shall be prohibited.



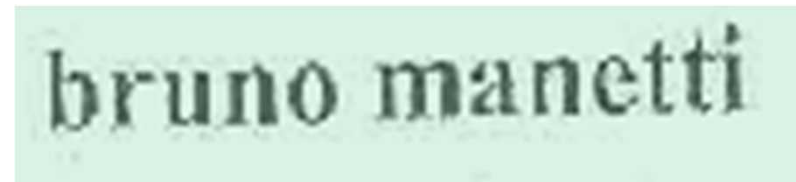
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No. 3083605 “BRUNO MANETTI” trademark opposition case

- The opposed trademark:
No.3083605 “BRUNO MANETTI”
trademark
- The opponent has provided
notarial agreements of “BRUNO
MANETTI” trademark license and
assignment, which proved that as
the agent of the opponent, the
opposed clearly knew that the
“BRUNO MANETTI” trademark was
owned by the opponent, and that
the opposed was not authorized to
register the “BRUNO MANETTI”
trademark in China.
- Ruling of the opposition:
The opponent’s grounds of opposition
is justified, and the registration of
No.3083605 “BRUNO MANETTI”
trademark is not granted.



bruno manetti



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New amendments in the *Trademark Law* against bad-faith filing

- In the General Provisions (Paragraph 1 of Article 7), add the provision of “The application for registration and the use of trademarks shall follow the principle of good faith.”
- Add Paragraph 2 in Article 15: “A trademark that is applied for registration in identical or similar goods with another party’s prior used identical or similar trademark shall not be registered, if the applicant is in a contractual or business relationship or other kind of relationship other than provided in the preceding paragraph with the party, thus clearly knows about the party’s trademark and that the party opposes the registration applied for.”



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The screenshot shows the official website of the Trademark Office of the Administration for Industry & Commerce of the People's Republic of China. The header features the logo and the name in Chinese (中國商標網) and English. A navigation bar includes links to Home, News, Trademark Strategy, Trademark application, Trademark Enforcement, Organization, Important Announcements, International Cooperation, Laws&Regulations, Statistics, Well-known Trademarks, Trademark Agency, and Geographical Indications. The main content area is divided into several sections: News (with a list of recent updates and dates), Search (with a search bar and button), Organization (with links to About us, Internal divisions, and Organization chart), and Important Announcements (with a link to Annual Development Report). There are also buttons for Online application, Trademark search, Trademark gazette, Trademark Application Guide, Trademark Registration Flow Chart, Application Guide for Madrid, and Trademark Application Forms. The bottom section includes Laws&Regulations and Trademark Strategy, each with a list of relevant documents.

<http://sbj.saic.gov.cn/>



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Thank You!