



TRADEMARKS IN CHINA : A FEW BASIC FACTS BEFORE DIVING IN

BOB H. SOTIRIADIS & MANON MOREAU^{*}
ROBIC, LLP
LAWYERS, PATENT AND TRADE-MARKS AGENTS

We know that China is an economy that is increasingly important in the world, that its gross domestic product is growing like no other and that it is one of the most important markets for Canadian exports. We also know to what extent it has become famous for counterfeiting. The importance of securing your trademark has therefore become essential nowadays.

In China, unless a trademark is well-known, the first person to file an application for a registration acquires rights in a trademark. It may therefore be advisable to look into the issue of trademarks before developing your market in China. This way, you may be able to avoid spending unnecessarily for exporting your products and reduce the risk of conflicts with the owner of an earlier-filed trademark.

Chinese Versions of the Trademark

Under normal practice, local customers and local businesses might adopt their own Chinese version of your brand. This can have a long-term negative effect on the value of your trademark. It is therefore recommended that, from the outset, you adopt and register yourself a Chinese version of your trademark. In an ideal world, it would be advisable to consider the registration of two Chinese versions of your trademarks, that is a) a translation of the trademark if it has a certain meaning and b) a translated version of the pronunciation of the trademark.

Undertaking a Prior Search

It takes an average of two and a half years between the filing of an application for registration and the issuance of a certificate of registration in China and it is not possible to expedite the registration process. A prior search is recommended. Bear in mind that a similar trademark that is filed before yours in the same class will preclude the registration of your trademark, even if the products or services within the same class are different. For example, class 25 includes clothing. If you wish to register your trademark for bridal gowns and a third party has filed an application to register a

© CIPS, 2011.

^{*} With ROBIC, LLP a multidisciplinary firm of Lawyers, and Patent and Trade-mark Agents. Published in the Winter 2011 Newsletter of the firm (Vol. 14, No. 4). Publication 068.130E.

ROBIC, LLP
1001 Square-Victoria - Bloc E - 8th floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: 514 987-6242 Fax: 514 845-7874
www.robic.ca info@robic.com

similar trademark for sports clothing before you, it is highly likely that you will not obtain your registration and this would be a major obstacle to the development of your business!

Hong Kong, Macao and Taiwan

The territories of Hong Kong, Macao and Taiwan are distinct in terms of registration. Provisions should therefore be made for the registration of your trademarks on each of these territories because they are not encompassed by the steps taken for China.

Six Month Priority

It is always useful to recall the existence of the Paris Convention, an international agreement that allows the owner of a national trademark to file abroad (in a member state of the Convention, such as China) within six months of the national filing by benefiting from the priority date of this national depository.

Use of the Trademark after Registration

It is also important to ensure that the registered trademark is being used in China because it could be struck off the register if it has not been used for three years.

Conclusion

As in many cases, prevention is the better and cheaper option. The lawyers and trademark agents at ROBIC can advise you accordingly so that you can avoid obstacles related to your trademarks abroad, and specifically in China.



