

## THE WHY AND HOW OF IP- EPISODE 3

### CHINESE APPLICATIONS VERSUS INTERNATIONAL DESIGNATIONS FOR CHINA, THE PROS AND CONS: THE IMPORTANCE OF MAKING THE RIGHT DECISION

With economic globalization, more and more overseas companies are active in the Chinese market. While participating in market activities, having your brands protected in China is very important.

Since both France (and same applies to most EU countries such as Italy) and China are members of WIPO (World Intellectual Property Organization), if the applicants (individual, companies and organizations) in France hope to register a trademark in China, it is possible to file an International trademark application before WIPO and designate China. Alternatively, applicants can file the trademark application directly before the CNIPA (China National Intellectual Property Administration). Although both these routes can enable the applicants in France to register trademarks in China, there are differences between them and we have tried to summarize and highlight the main points to consider in the chart below.

|  | <b>International application designating<br/>China</b>  | <b>National application</b>   |
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| <b>Costs<br/>(Official fees)</b>                   | Basic fee: for one trademark application in no more than three classes, the basic application flat fee in CHF needs to be paid, and additional fees per country designated (which are different depending on the country), while extra fees are also required for colored marks and additional classes.   | Costs depends on the number of classes and on the number of items per class (extra fees are due for more than 10 goods or services)   |
| <b>Specification<br/>of goods and<br/>services</b> | The Nice classification is the one to consider  | Even if China joined the Nice classification local sub class systems apply and it is very important to designate proper sub classes to have a wider scope of protection and be able to protect the mark against infringing filings that are commonly filed in sub classes not covered by the international class headings   |
| <b>Procedure</b>                                   | <ol style="list-style-type: none"> <li>1) File national trademark application with the INPI (or local TMO) or a EUTM at the EUIPO. (If you have already have an application or a registration, no need to take this step)</li> <li>2) File International trademark application with WIPO based on the French or EU trademark application/registration and designate China.</li> <li>3) The WIPO conducts formal examination of the application and issues a registration certificate.</li> <li>4) The WIPO publishes the registration of</li> </ol> | <ol style="list-style-type: none"> <li>1) Entrust a qualified Chinese IP agency to file a national trademark application with the CNIPA</li> <li>2) The CNIPA conducts a formal examination and <b>substantive examination</b>*</li> <li>3) The CNIPA publishes the trademark application in the Chinese trademark Gazette, if no grounds of refusal were found.</li> <li>4) The CNIPA issues a registration certificate, if no grounds of refusal were found and no opposition was raised during the publication period</li> </ol> |

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|  | <p>the International trademark in the WIPO Gazette and informs the CNIPA of the designation.</p> <p>5) The CNIPA conducts substantive examination* and issues grant of protection, if no grounds of refusal were found and no opposition was raised during the publication period.</p>  |  |
|  | <p>* <b>Substantive examination:</b> the CNIPA checks whether the trademark itself can be registered as a trademark <b>and</b> whether there are any prior identical or similar trademarks filed or registered by third parties in respect of similar goods/services.</p>   |  |
| Required documents                               | <p>As required by the trademark office in your country (which mainly means, on a EU or FR basis, filling the appropriate WIPO/EU forms, including the references of the home application or registration with the same information as the home mark along with a some additional details depending on the country designated such as it possible meaning etc.)</p>                                      | <ol style="list-style-type: none"> <li>1) Applicant's name and address in both English and Chinese.</li> <li>2) A scanned copy of the applicant's Certificate of Incorporation (if a company)/ Passport (if a natural person)</li> <li>3) A copy of the signed Power of Attorney.</li> <li>4) Trademark Specimen (JPEG format)</li> <li>5) Classification(s) and designated goods or services</li> <li>6) Priority document (if claimed).</li> </ol>   |
| Time frame for CNIPA to complete the examination | 8-12 months (as from the registration date of the International trademark)  | 4-6 months (as from the filing date of the Chinese national trademark)   |
| Designated goods/services                        | <p>Less strict with the specifications of goods or services, but there is a risk that the goods or services might be translated into incorrect Chinese and then be classified into different subclasses which could affect future protection.</p>   | <p>Strict with the specifications of goods or services. Generally, it is required to designate <b>standard specifications</b> from the Nice Classifications or the list of acceptable goods/services published by the CNIPA. Otherwise, the office will request an amendment.</p>  |
|  | <p>For example, the following specification <i>Vitamins for animals; all of the above-mentioned products with the exception of the medical field; plastic materials for packaging (not included in other classes); crustaceans (not live), seafood (not live) and shellfish (not live)</i> has been accepted in an international designation but are not acceptable in a national application.</p>      |  |
| Opposition period                                | 3 months counting from the first day of the month following the publication date  | 3 months counting from the date of publication   |
| Certificate of registration                      | <p>Only a notification of grant of protection will be issued and no registration certificate will be issued by the CNIPA.</p> <p>It is possible to request a certified copy of the registration which has the same effect as the registration certificate. However, the certificate can only be requested 12 months after the date that the WIPO informs the CNIPA of the designation. Furthermore,</p> | <p>A registration certificate will be issued by the CNIPA and widely acceptable in commercial activities.</p> <p>China will no longer issue paper certificates but only electronic certificates from January 1, 2022. Visit our LinkedIn account for more details<br/> <a href="https://www.linkedin.com/feed/update/urn:li:activity:6853638932425527296/">https://www.linkedin.com/feed/update/urn:li:activity:6853638932425527296/</a> )</p> <p>Sample of the registration certificate in electronic form:</p> |

there is risk this kind of document will not be accepted, when the owner enters certain E-platforms, such as Alibaba, Taobao, Tmall, etc.

Sample of the grant of protection:



DECLARATION D' OBTIEN DE LA PROTECTION

Notifiée au Bureau International de l' Organisation Mondiale de la Propriété Intellectuelle (OMPI) En vertu de la règle 18ter(1) du Règlement d' Exécution Commun

I. Administration qui prononce la déclaration : L'Administration Nationale de la Propriété Intellectuelle, RPC (CNIPA)

I.China Nanjie, Xichengqu, Beijing, 100055 People's Republic of China Tel: 8610-63219000 Fax: 8610-68050285

II. Date à laquelle la déclaration est prononcée: 2021/06/01

III. Notre numéro de référence :

IV. Numéro d' enregistrement international: [REDACTED]

V. Date de notification en Chine: 2021/02/18

VI. Enregistrement national de base No: [REDACTED] Dépôt national de base No: [REDACTED]

VII. Protection est accordée à la marque qui fait l' objet de l' enregistrement international pour tous les produits/services désignés.



Sample of the certified copy of the registration:



商标注册证明

兹证明, [REDACTED] 在第33类商品上使用的 "[REDACTED]" 商标, 已在我局注册。注册号为 [REDACTED], 有效期自2017年10月20日至2027年10月20日。



核定使用商品/服务 第33类: 酒精饮料(啤酒除外); 葡萄酒(截止)

特此证明。



**In our view one of the most important differences between the two channels is:- that the International application is subject to the status of the basic application for five years. That is to say, if the basic application or registration in your country is refused or cancelled within five years as from the registration date of the International trademark, the designations in China will be deemed invalid. However, the national application in China is totally independent. Even if you claimed priority, the status of the priority application will not affect the national application.**

- in case of infringement/ later third parties' bad faith filings, subject to having drafted a proper specification of goods and services, you will have wider protection through appropriate sub classes.
- of course, for marks in Chinese characters directly filing them in China through a national application would avoid the costs of a related national home mark where the Chinese characters are not so meaningful and become soon vulnerable due to non-use.

As compared above, a Chinese designation of an International trademark and a Chinese national application have their own advantages and disadvantages. We are here to advise you throughout your process and related strategy so you can make your decision and select a suitable filing route according to your conditions and requirements. If you hope to obtain registration in shorter time, it might be advisable to file a national application, while if you hope to designate goods and/or services that are non-standard or not included in the International Classification, or designate multiple countries, it might be then more recommended to file an International application.

***IPSIDE CHINA is part of the SANTARELLI GROUP. Our team is made of more than ten members. Existing since 2016, we are committed to assisting clients with Chinese trademark applications, oppositions, appeals, non-use cancellations, etc. Using English, French and Japanese as our working languages to communicate smoothly with clients all over the world is one of our strengths.***