



IP NEWS

2020 NO.66

www.jiaquanip.com

 嘉权专利商标事务所
Jiaquan IP Law

IP NEWS

THE THEME

Jiaquan is taking action while COVID-19 spreads all over the world

Can city names be included in trademark applications in China?

Jiaquan is taking action while COVID-19 spreads all over the world

Jiaquan understands that COVID-19 has become a pandemic and our oversea friends are now in the middle of the storm. Our managing partner Mr. Xinxue YU prepared 11,270 masks for our foreign friends and clients. These masks were sent out abroad with our sincere thoughts to support people in need. Hopefully our oversea friends will receive the parcels soon.

When there is nothing but only darkness ahead, let's just become the light. Even though it is a very slight one that cannot brighten the whole road, it can encourage others to go forward.

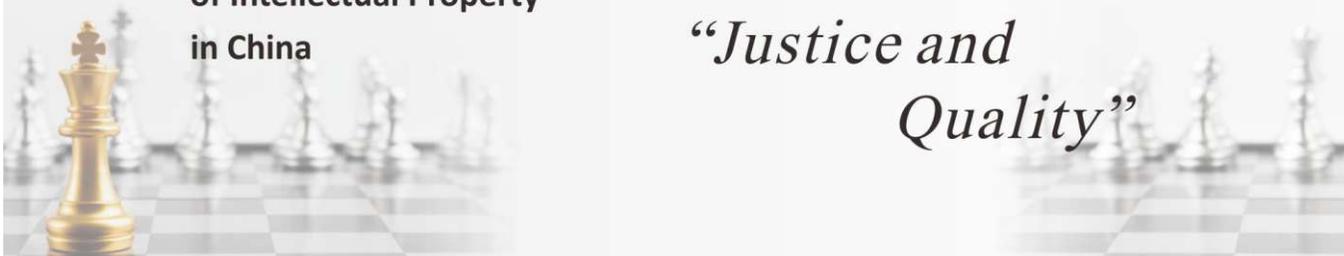
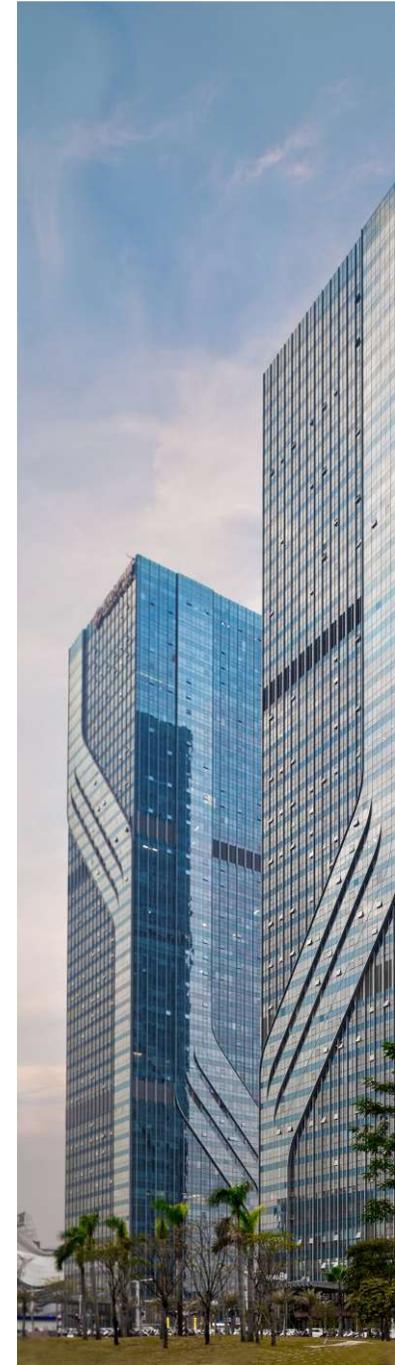
We hope you and all of your families stay well. We all hope that life will come back to normal soon. Fingers crossed!



**Efficient and Effective
Acquisition and Enforcement
of Intellectual Property
in China**

 嘉权专利商标事务所
Jiaquan IP Law

*“Justice and
Quality”*

A chessboard with a golden king piece in the foreground and other pieces in the background.

Can city names be included in trademark applications in China?

Fiona R. PENG



Fiona R. PENG

Paralegal
International Department

Graduated from Wuyi University, Ms. PENG works as an IP paralegal joining Jiaquan IP Law in 2015, and she is experienced in handling trademark availability search, application, opposition, invalidation, cancellation and administrative litigation. At the same time, she has accumulated experience in handling copyright registration as well as IPR Customs Recordance. She is familiar with the Chinese IP laws and related regulations, which allows her to provide every client with the best suggestion.

When designing a trademark, many people may want to include the specific country name or city name as a major part of the trademark, so as to indicate clearly the origin of goods or services. It is very common and might not have problems when filing trademark registration applications in many foreign countries, as long as the applicants disclaim the protection of the country names/city names at the time of filing. However, it does not work for Chinese trademark applications. According to Article 10 of Trademark Law of the People's Republic of China, no geographical names of administrative divisions at or above the county level or foreign geographical names known to the public may be used as trademarks. Those identical with or similar to the state name, national flag, national emblem or military flag etc., of a foreign country, except with the consent of the government of that country, may not be used as trademarks. So, is it requisite to remove country names/city names when filing trademark applications in China? In fact, these applications could be approved if they meet the following requirements:

A. The country names/ city names included have other specific meanings and will not cause misidentification by the public.

Example 1:

Trademark:



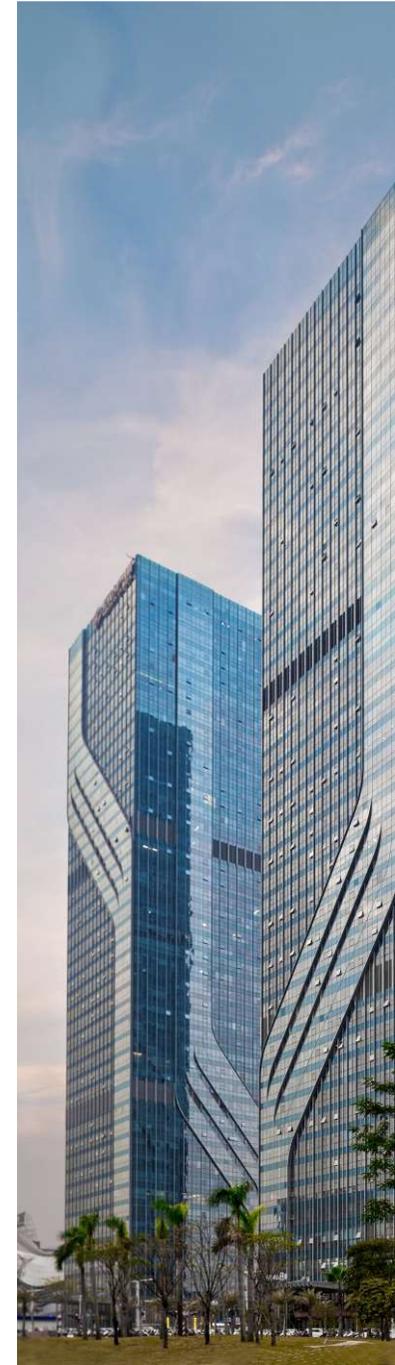
Registration No.: 1015988

Applicant: A Chinese natural person ¹

Analysis: Turkey could refer to an Asian country, but it is also known as a large bird grown for its meat on farms.

Example 2:

Trademark:



Registration No.: 32429248

Applicant: An American company

Analysis: Besides being a city name of the United Kingdom, Sheffield is commonly used as a foreign surname. In this application, Sheffield is used along with Dr., an appellation that refers to a person with a medical degree or the highest degree. The application was approved by CNIPA after arguing over the diversity of meanings of Sheffield.

Example 3:

Trademark: 米兰星光

Registration No.: 18194096

Applicant: A Chinese company

Analysis: (Milan or aglaia odorata in English) is a well-known city in Italy, but it is also an ancient Chinese city, a kind of plant or a football club. The application was approved by CNIPA after arguing over the diversity of meanings of

Conclusion: If an application containing a country name/ city name is rejected, we can try to argue the multiple meanings of the name beyond being a country /city in the refusal review.

B. With the consent of the country's government.

According to the "Trademark Examination and Trial Standards", if a trademark containing a foreign country name/ city name has been registered in the corresponding

country, it is deemed that the foreign government agrees to allow the trademark registration. Therefore, we may overcome the refusal by submitting the trademark certificate of the foreign trademark in the review stage. To prove the authenticity of the trademark certificate and improve the success rate, it is suggested having the trademark certificate notarized and legalized before submitting it to CNIPA.

Example:

Trademark:



Registration No.: 26865005

Applicant: A New Zealand company

Analysis: The trademark contains the English words NEW ZEALAND, which only refers to a country of Oceania. After submitting the trademark certificate of the same mark registered in New Zealand, the Chinese application was approved.

C. If the country name/ city name contained in the trademark is independent of other distinctive parts, and it only serves to truly represent the country of the applicant or the characteristics of the designated goods or services with other narrative languages, the trademark is allowed for registration.

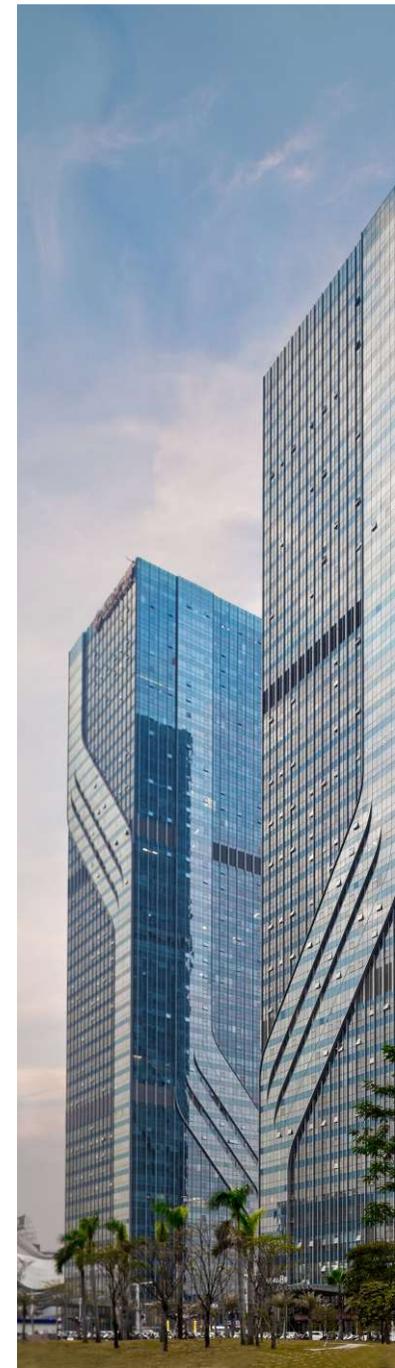
Example:

Trademark:



Registration No.: G838008

Applicant: An Italian company²



Analysis: ITALIANO means "Italian", but it is independent from MAESTRO, the distinctive part of the trademark. Also, the applicant is an Italian company, and it "ITALIANO" does represent the country where the applicant is located.

One important thing in this kind of trademark is that the included country name/ city name must be consistent with the applicant's nationality, i.e., the applicant must from that country/ city. Otherwise the trademark would be refused because of misleading.

To sum up, if you consider filing a trademark application in China which contains a country name or city name, please look at whether any of the requirements below is met.

1.If a Chinese trademark application that includes country name/ city name which has multiple meanings is refused, the applicant may try to argue the multiple meanings in the review;

2.If the country name/ city name in a Chinese trademark application only refers to the corresponding place, the

applicant should pay attention to the consistency of his/her/its nationality. It is recommended to obtain registration in his/her/its country before entering China;

3.If the applicant wants to apply for a trademark that includes the country name/ city name with a single meaning in China, he/she/it could try to make the font size of the country name/ city name smaller than the other parts to distinguish it from other distinctive parts. If the application is refused, the applicant can argue that the country name/ city name only represents his/her country or, together with other narrative languages to show the characteristics of specified goods or services.

References:

1. Part 1 (Article 3 (a) 2) of the Trademark Examination and Trial Standards, Trademark Office of National Intellectual Property Administration, PRC and Trademark Review and Adjudication Board, 2016, P20-21
2. Part 1 (Article 3 (a) 5) of the Trademark Examination and Trial Standards, Trademark Office of National Intellectual Property Administration, PRC and Trademark Review and Adjudication Board, 2016, P22

