

Provisions on the Determination and Protection of Well-known Marks

(Issued by the State Administration for Industry and Commerce On April 17, 2003)

Article 1 These provisions are formulated in accordance with the Trademark Law of the People's Republic of China (hereinafter referred to as the Trademark Law) and the Implementing Regulations for the Trademark Law of the People's Republic of China (hereinafter referred to as the Implementing Regulations).

Article 2 For the purpose of these Provisions, a well-known mark refers to a mark that is widely known to the relevant sectors of the public and enjoys a relatively high reputation in China.

Relevant sectors of the public shall include consumers of the type of goods and /or services to which the mark applies, operators who manufacture the said goods or provide the said services, and sellers and other persons involved in the channels of distribution of the type of goods and/or services to which the mark applies.

Article 3 The following may serve as evidences to prove that a mark is well-known:

- (1) documents concerning the degree of knowledge or recognition of the mark in the relevant sector of the public;
- (2) documents concerning the duration of the use of the mark, including those related to the history and scope of the use and the registration of the mark;
- (3) documents concerning the duration, extent and geographical area of any promotion of the mark, including the approach to, geographic area of, the type of media for and the amount of advertisements for the promotion of the mark;
- (4) documents concerning the record of successful enforcement of rights in the mark, including the relevant documents certifying the mark in question was once protected as a well-known mark in China or any other country/region;
- (5) other evidences certifying that the mark is well-known, including, in the past 3 years, the outputs, sales volumes, sales incomes, profits and taxes and sales regions etc. of the principal goods to which the mark applies.

Article 4 Where any interested party believes that another party's preliminarily examined and published mark violates the provision of Article 13 of the Trademark Law, he or it may, according to the provisions of the Trademark Law and the Implementing Regulations, file an opposition with the Trademark Office and submit relevant documents

certifying that his or its mark is well known.

Where any interested party believes that another party's registered mark violates the provision of Article 13 of the Trademark Law, he or it may, according to the provisions of the Trademark Law and the Implementing regulations, request the Trademark Review and Adjudication Board to cancel the registered mark in question and submit relevant documents certifying that his or its mark is well known.

Article 5 In the process of trademark administration, where any interested party believes that another party's use of a mark falls within the circumstances provided for in Article 13 of the Trademark Law and requests for the protection of his or its well-known mark, he or it may file a request in writing for the prohibition of the alleged use with the administrative authorities for industry and commerce at or above the city (prefecture or autonomous prefecture) level of the place where the case arises, and submit relevant documents. Meanwhile, the interested party shall send a copy to the administrative authority for industry and commerce of the province where he or it has domicile.

Article 6 In the process of trademark administration, the administrative authority for industry and commerce shall, on receiving an application for the protection of a well-known mark, examine the case as to whether it falls within the following circumstances under Article 13 of the Trademark Law:

- (1) where another person's unauthorized use of a mark that is identical with or similar to an interested party's well-known mark not registered in China on identical or similar goods is liable to create confusion;
- (2) where another person's unauthorized use of a mark that is identical with or similar to an interested party's well-known mark registered in China on non-identical or dissimilar goods is liable to mislead the public, and the interests of the registrant of the well-known mark are likely to be damaged by such use;

In respect of cases held to have fallen within the above-mentioned circumstances, the city (autonomous prefecture or autonomous prefecture) administrative authority for industry and commerce shall, within 15 workdays from the date of acceptance of the request of the interested party, report and send all the documents of the case to the administrative authority for industry and commerce of the province (autonomous region or municipality directly under the Central Government) where it is located, and issue a notification of acceptance of the case to the interested party. The provincial (autonomous region or municipality directly under the Central Government) administrative authority for industry and commerce shall, within 15 workdays from the date of acceptance of the request of the interested party, report and send all the documents of the case to the Trademark Office. If the administrative authority for industry and commerce of the province where the interested party has his or its domicile holds that the case falls within the above-mentioned circumstances, it may also report in writing the case to the Trademark Office.

Cases held not to fall within the said circumstances shall be dealt with timely according

to the relevant provisions of the Trademark Law and its Implementing Regulations.

Article 7 The administrative authority for industry and commerce of the province (autonomous region or municipality directly under the Central Government) shall examine the documents of cases concerning the protection of well-known marks reported and sent by city (prefecture or autonomous prefecture) administrative authorities for industry and commerce within its administrative region.

Where a case is held to fall within the circumstance of paragraph 1 of Article 6 under these provisions, the provincial (autonomous region or municipality directly under the Central Government) administrative authority for industry and commerce shall report and send it to the Trademark Office within 15 workdays from the date of its receipt of the case documents from the city (prefecture or autonomous prefecture) administrative authority for industry and commerce within its administrative region.

Where a case is held not to fall within the circumstance of paragraph 1 of Article 6 under these provisions, the provincial (autonomous region or municipality directly under the Central Government) administrative authority for industry and commerce shall return the case to the authority that initially accepts it and the latter shall deal with the case timely according to the relevant provisions of the Trademark Law and its Implementing Regulations.

Article 8 The Trademark Office shall make determination within 6 months from the date of the receipt of the relevant documents of a case, notify the result of the determination to the provincial (autonomous region or municipality directly under the Central Government) administrative authority for industry and commerce of the place where the case arises and send duplication thereof to the provincial (autonomous region or municipality directly under the Central Government) administrative authority for industry and commerce of the place where the interested party has his or its domicile.

The Trademark Office shall return the documents of the case, except those certifying the mark is well-known, to the administrative authority for industry and commerce of the province (autonomous region or municipality directly under the Central Government) where the case arises.

Article 9 Where a mark is not determined as well-known, the interested party shall not file a new application for the determination of the same mark on the basis of the same facts and grounds within one year from the date on which the determination is made.

Article 10 When determining a well-known mark, the Trademark Office or the Trademark Adjudication Board shall comprehensively consider each and every factor under Article 14 of the Trademark Law, but it shall not be the prerequisite that the mark shall satisfy all the factors prescribed therein.

Article 11 In the protection of well-known marks, the Trademark Office, the Trademark Review and Adjudication Board and the local administrative authorities for industry and

commerce shall take into account of the mark's distinctiveness and the extent of its being well-known.

Article 12 When requesting for the protection of his or its mark according to Article 13 under the Trademark Law, an interested party may furnish the record of the mark once being protected as a well-known one by the relevant competent authority in China.

Where the scope of protection of an accepted case is substantially the same as that of a mark being protected as a well-known mark and where the opposite party raises no opposition to the said mark's being well-known, and where, although he raises the opposition thereto, the opposite party cannot furnish any document certifying that the said mark is not well-known, the administrative authority for industry and commerce accepting the case may adjudicate or deal with the case in the light of the conclusion of the protection record.

Where the scope of protection of an accepted case is different from that of a mark being protected, or where the opposite party raises opposition to the said mark's being well-known, and he furnishes documents certifying that the said mark is not well-known, the Trademark Office or the Trademark Review and Adjudication Board shall re-examine the documents of the well-known mark in question and make a determination.

Article 13 Where an interested party believes that another party has registered his or its well-known mark as an enterprise name, which is likely to deceive or mislead the public, he or it may apply to the competent authority for the registration of enterprise names for the cancellation of the registration of the enterprise name in question. The competent authority for the registration of enterprise names shall deal with the case in accordance with the Provisions for the Administration of the Registration of Enterprise Names.

Article 14 The administrative authority for industry and commerce at various levels shall enhance the protection of well-known marks, and timely transfer cases of suspected crime of counterfeiting trademarks to the competent authority concerned.

Article 15 The administrative authority for industry and commerce of the province (autonomous region or municipality directly under the Central Government) of the place where the authority handling the case is located shall send the Trademark Office a copy of the decision on the protection of a well-known mark.

Article 16 The administrative authority for industry and commerce at various levels shall establish corresponding supervisory mechanisms and formulate corresponding supervisory control measures to enhance the supervision and inspection of the whole process for the determination of well-known marks.

Where any member of staff who is involved in the determination of well-known marks abuses his power, practices fraud for his personal gains, seeks illicit interests or handles, in violation of law, matters concerning the determination of well-known marks, he or she shall be subject to administrative disciplinary measures according to law. Where the case

is so serious as to constitute a crime, the person involved shall be prosecuted, according to law, for his or her criminal liabilities.

Article 17 These provisions shall enter into force on June 1, 2003. The Provisional Regulations Concerning the Determination and Administration of well-known Marks issued by the State Administration for Industry and Commerce on August 14, 1996, shall be abrogated on the same date.

(Source: State Administration for Industry and Commerce of the P.R.C.)