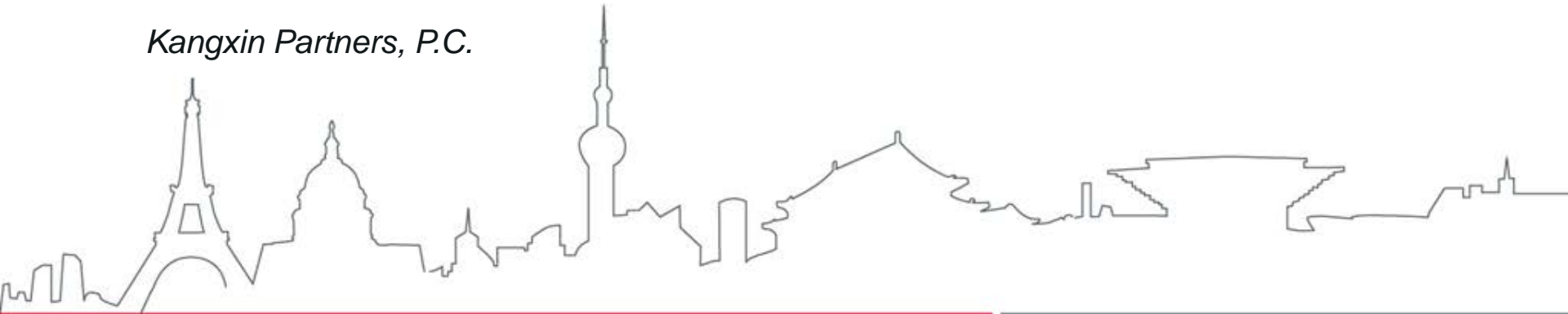


TRADEMARKS & FASHION - China

Gloria Q. Wu

Kangxin Partners, P.C.



In the old days...



Nowadays...



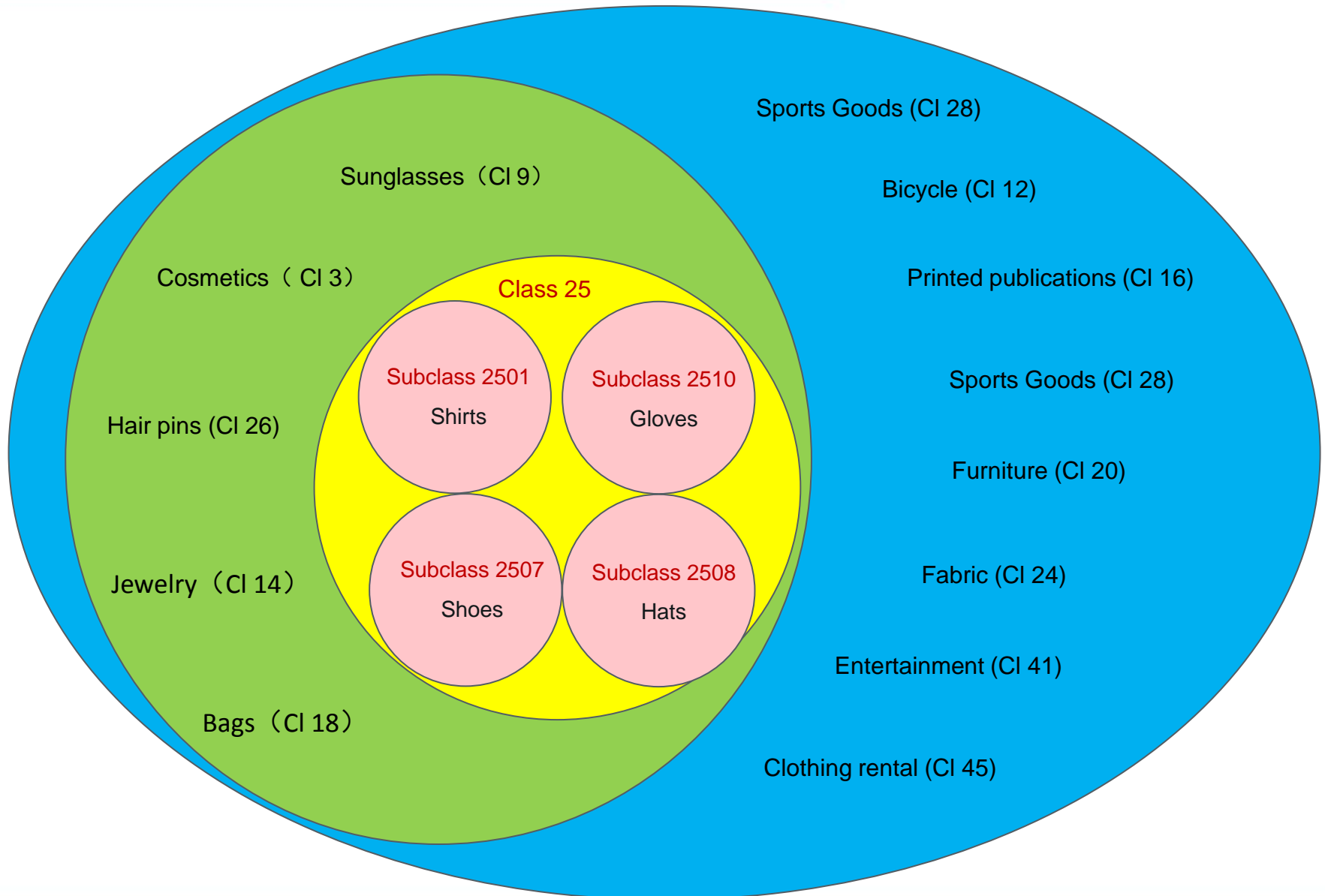


Classification?

Similar or Not?

Likelihood of
Confusion?





Protection Scope

Ordinary Mark

- Same or Similar Mark
- Same or Similar Goods/Services



Well-known Mark (registered)

- Same or Similar Mark
- Likelihood of Misleading



Mark with Prior Use and Reputation in Fashion Industry

- Same or Similar Mark
- Same or Similar or **Closely Related** Goods/Services



Name right (Designer) VS Trademark



Legal Ground

- Article 32 The trademark application shall neither infringe upon another party's **prior existing rights**, nor be an improper means to register a trademark that is already in use by another party and enjoys substantial influence.

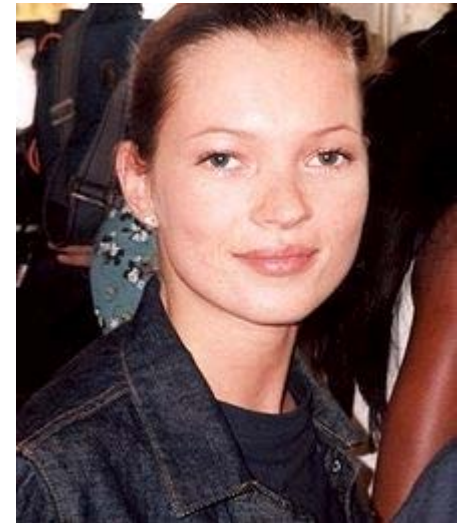
Examination Guideline

- The disputed mark is same as the third party's name;
- The disputed mark has caused or may cause damage to the name right of the third party;
- “Name” means original name, pen name, stage name, nickname, etc.;
- “Third party” means living natural person;
- “Same” means having identical words /characters, or being the translation of the name, which is known by the general public as referring to the third party;
- The public awareness of the third party shall be taken into consideration.

Kate Moss Trademark Invalidation (administrative litigation)

Beijing Higher Court held:

- **Procedural issue:** Storm Model Management as authorized by Kate Moss has the right as “interested party” to file the trademark invalidation based on the name right of Kate Moss;
- **Substantive issue:** though the evidence submitted was not sufficient to prove the high reputation of the name Kate Moss in China, considering that 1) “Kate Moss” is not an existing fixed term, the registrant did not provide reasonable explanation of using this term as trademark; 2) the registrant being an operator in clothing industry should have better knowledge about this industry than general public; 3) Kate Moss appeared as a model for the Spring/Summer Collection for Ports in 2002, the disputed mark unfairly uses the name of Kate Moss for commercial purpose, and thus infringes the name right of Kate Moss.



Copyright VS Trademark

Hypothetical Case Study

- European company ABC owns a mark  in Class 25
- ABC manufactures clothes in China and exports to Europe
- Chinese company XYZ files the same mark  in Class 18

Examination Guideline

- The mark constitutes works protectable as copyright;
- Ownership of the copyright;
- The copyright is earlier than the filing date of the disputed mark;
- The disputed mark is identical with or substantially similar to the copyright
- The copyright had been accessible before the filing date of the disputed mark

BABOLAT Trademark Opposition (administrative litigation)

- Beijing Higher Court held that the letter 'O' in the middle of the opponent's cited trademark is stylized, which divides the letters 'BAB' and 'LAT' into two symmetrical parts, which renders the mark as a whole with originality, and thus constitute the works under China Copyright Law.

BABOLAT
百 保 力 (opposed trademark)

BABOLAT (opponent's cited trademark & claimed prior copyright)

Evidence of Copyright

- Article 7 of Supreme Court Interpretation on Issues of Applicable Laws for Copyright Civil Dispute Cases: Documents concerning copyright, such as manuscript, original copy, legitimate publication, copyright recordation certificate, certification issued by certifying organization or contract of ownership, can serve as evidence of copyright.

How to Protect *Designer's Signature*

Name Right

- Is the Designer still alive?
- Same spelling?
- Reputation in China?

Copyright

- How fancy / creative?
- Same /substantially similar?
- When / where of earlier publication?

Tim Hortons Trademark Opposition (administrative litigation)

Beijing Higher Court held:

- **Name right claim:** the natural person Tim Horton is no longer alive, so has no civil right capability to execute his right and perform his duty, and thus cannot claim name right in this case;
- **Copyright claim:** the works should have originality, which means that it should express the author's own choice, selection and arrangement with the author's characteristic. What THE TDL GROUP CORP. claims for copyright protection is the handwriting form of 'Tim Hortons', which does not constitute works under China Copyright Law.

Tim Hortons (opposed trademark)

Tim Hortons (opponent's cited trademark & claimed prior copyright)

Localize Your Trademark in China

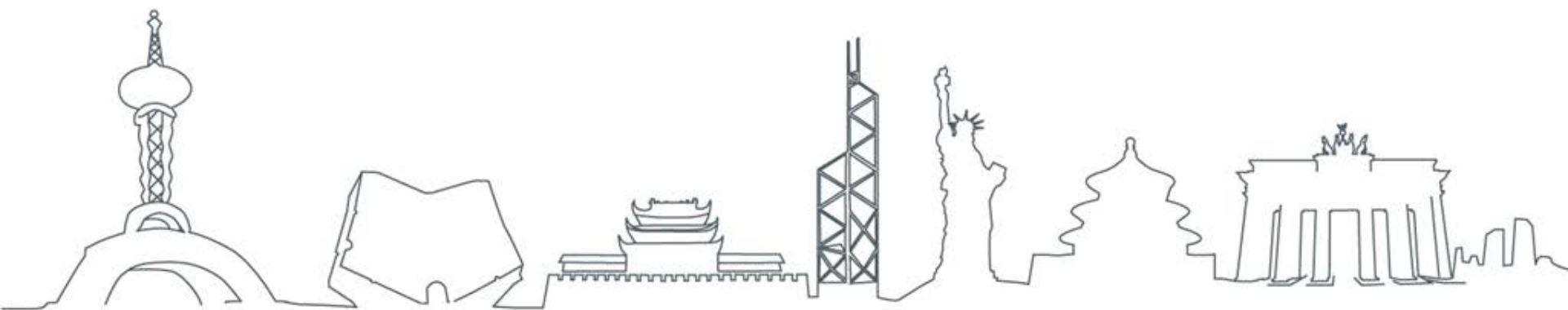
Latin Letters VS Chinese Characters



[biang]
a type of noodle

Thanks!





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