Madrid System in Mainland China

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An overview of Madrid system in mainland China

Some practical issues you need to know

A milestone case by Supreme Court in 2018
Overview

- 1989: China became a member of Madrid Agreement
- 1995: China became a member of Madrid Protocol
Madrid Applications Entering China

<table>
<thead>
<tr>
<th>Year</th>
<th>Designating China</th>
<th>Approved by China</th>
</tr>
</thead>
<tbody>
<tr>
<td>2015</td>
<td>60,205</td>
<td>49,552</td>
</tr>
<tr>
<td>2016</td>
<td>52,191</td>
<td>38,416</td>
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<tr>
<td>2017</td>
<td>67,244</td>
<td>41,886</td>
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</tbody>
</table>
Madrid Applications from China

- 2015: 1,830
- 2016: 3,820
- 2017: 6,066
- 2018: 6,594
- 2019.1-6: 2,849
China is the most active filing country in recent years. In 2018, the total filings through Madrid by Chinese applicants is 6594, a 72.6% increase comparing with 2016, ranked the third in the world, after US and Germany.
Practical issues

Protected scope

Subclass system in deciding similarity among goods/services

No official action available for amending the goods/service names to fit the classification requirement of subclass system.

<table>
<thead>
<tr>
<th>CLARKE</th>
<th>power tools</th>
</tr>
</thead>
<tbody>
<tr>
<td>CLARKE</td>
<td>0742 metal cutting machines</td>
</tr>
<tr>
<td>Clarke</td>
<td>0743 handheld tools, other than hand operated</td>
</tr>
</tbody>
</table>
Practical issues
Practical issues

No automatically issued registration certificate

For IR marks which extended to China, the China Intellectual Property Office does not issue registration certificate directly.

Applicants need to submit applications for issuing the certification of registration.
Practical Issues

Non-use cancellation procedure

• Direct Notification (with no clear deadline information) from CNIPA to registrant or registrant’s agent recorded with WIPO

• No procedure available to record a local agency for a Madrid registration with CNIPA

• CNIPA will inform the local agent if any kind of application is filed with CNIPA for a Madrid registration through this local agent
Practical issues

Documents have to be submitted in appeal procedure

Applications for

Collective mark

Certification mark

Non-traditional mark
A Milestone Case By Supreme Court in 2018

The Supreme Court Made a Public Hearing on the World IP Day of Dior's Three-dimensional Trademark Retrial Case Represented by NTD and Overturned the TRAB’s Decision.
A Milestone Case By Supreme Court in 2018

Mark:  

Class: 3

Goods: Perfumery, perfumes, eau de parfum, eau de toilette, eau-de-cologne, perfume extracts, scented body milks, scented oils and lotions for the body, shower perfumed lotions, perfumed shower gels, bath lotions, scented gels for the bath, scented soaps, scented shampoos; make-up for the face, eyes and lips; nail and nail care products.

The nature of mark: Three-dimensional mark

Description of the mark: The mark is the form of fine and long "8", for top with small a globe; the lower end is oval shape; of the circles. Long ornent gold.
China Trademark Office ("CTMO") rejected the mark due to that the mark is not distinctive and the Trademark Review and Adjudication Board ("TRAB") maintained the decision of the CTMO.

The CTMO and TRAB incorrectly considered that the mark is a normal mark rather than a three-dimensional mark.

The courts of first and second instance did not issue decisions in the favor of Dior. Then, Dior filed retrial petition before the Supreme Court.
A Milestone Case By Supreme Court in 2018

The hearing mainly focused on two issues:

- whether the TRAB had procedural flaws in processing Dior’s international application; and

- whether the 3D trademark for J’adore bottle is distinctive and registrable.
After the court debate by both parties and an internal discussion by the collegial bench, the chief judge pronounced the judgment in court to: revoke the judgments made by the courts of the first and second instances, revoke the TRAB’s decision, and demand the TRAB to make a new decision on this case. The judgment is final.

The court hearing also invited the envoys of relevant countries, news reporters at home and abroad and the public. After the trial the Counselor of French Embassy expressed his congratulations to NTD attorneys.
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