

What about China?

China is a huge, exciting and expanding market. Despite what is said of it as ‘the wild east’, it is rapidly catching up on intellectual properties, because, like Japan, Hong Kong, Taiwan and South Korea before them, it is now their IP that is under threat.

Registration of a trade mark in China is relatively straight forward and inexpensive. We work with associates in China and Hong Kong who advise us of the detail and issues as they come up. It is a learning process, which we share with our clients.

Things to bear in mind

There are three trade mark jurisdictions within the People’s Republic of China – China, Hong Kong and Macao. This does not include Taiwan, which is an independent country; there is also Singapore, which is a predominantly Chinese country.

Subject to certain regulations, there is no problem in registering an English language trade mark in China.

If you register an English language trade mark in China it is advisable to also register the Chinese language equivalent – certainly in Mandarin – both the Chinese characters that make up that trade mark, and also the Chinese characters that make up the sound of the words in that trade mark. In short, a translation and a transliteration. You may also consider the trade mark in Yue Chinese (Cantonese) on the same basis, especially if you are trading in the Hong Kong or Guangdong areas. At this point obtaining rule protection can become expensive.

China does not operate a multi-class application system, so if your goods or services are in several classes, these will each be subject to a separate application (which again, can become expensive). Hong Kong however does have a multi-class application system.

There are two routes to registration in China, national registrations and the Madrid Protocol, which is a filing convention. A Madrid Protocol application would be based on a home registration – typically a UK or EU trade mark from the UK. This may be the least expensive method, especially if several classes are involved. China typically accepts Madrid Protocol applications (unless there is an objection) within two to three months, however, if you are going to use the trade mark in litigation etc. then an enforcement certificate is necessary, which is a matter of time and money. If you use Madrid, you should get your enforcement certificate as soon as possible after registration. Neither Hong Kong, Macao nor Taiwan are parties to the Madrid Protocol see separate applications would be necessary there. In Singapore a Madrid application usually takes around two years to register. The Madrid Protocol becomes more cost effective when using it in several countries.

As we say above, we are learning about China day by day. For this reason, we frequently advise national registrations in China. Apart from the enforcement certificate issue, we are not sure how strong a Madrid Protocol registration (which is a Chinese national registration via the Protocol) is going to be when you have to use it to defend your rights. If your trade mark is a relatively simple matter – in one class for example, then a national registration may be cheaper and have greater certainty of its effectiveness before Chinese courts.

We have been filing and defending trade marks in China through our associates for many years, and it has been an increasing area of our work. If China is of interest to you we are happy to share our experience with you and hope the above gives you an introduction at least. Please contact us if have a specific enquiry.

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July 2017