



(enter keywords / 输入关键词) [Advanced Search](#)

[Subscriber Info](#) [Renew](#)

Welcome, JOHN LIEBESKIND

[Renew](#) [e-Alert](#) [About Us](#) [Events](#) [Useful Links](#) [RSS Feeds](#) [Contact Us](#)

Change font size:

Latest issue: July/August 2010



[Subscribe](#) | [Free Trial](#)
[Free e-alert](#)
[Full Contents](#)
[Back Issues](#)

Sectors

- [Banking & Finance](#)
- [Capital Markets](#)
- [Company Structures & Regulations](#)
- [Competition Law](#)
- [Contract Law](#)
- [Dispute Resolution](#)
- [Employment](#)
- [Energy, Natural Resources & Environment](#)
- [Government](#)
- [Infrastructure & Construction](#)
- [Insurance](#)
- [Intellectual Property](#)
- [IT/Media/Telecoms](#)
- [M&A](#)
- [Manufacturing](#)
- [Property](#)
- [Retail & Distribution](#)
- [Tax](#)
- [Trade](#)
- [Transportation](#)
- [Others](#)
- [CLP Magazine](#)
- [Features & Analyses](#)
- [Full Text Translations](#)
- [Awards & Rankings](#)
- [Legislation Digest](#)
- [Latest News](#)
- [Deals & Dealmakers](#)
- [People & Places](#)
- [Business Law Bulletins](#)
- [My Account](#)
- [Personal Details](#)
- [Email Newsletters](#)
- [Change Password](#)
- [Information](#)
- [About Us](#)
- [Advertising](#)
- [Reprint](#)
- [Contact us](#)
- [Help](#)
- [Resources](#)
- [Asialaw.com](#)
- [Industry Links](#)
- [AsialawProfiles.com](#)

China Law & Practice is published by [Asia Law & Practice](#)



[China Law & Practice](#) / Authorities adopt cautious approach to trademark infringement

Authorities adopt cautious approach to trademark infringement

Issue: May 2010

Keywords (click to search): [\[Rouse\]](#) [\[trademark\]](#) [\[infringement\]](#)

Rouse

Cindy Lee
clee@pights.com

It is easy to find many examples of trade mark infringement in China where infringers are looking to free ride on the backs of famous international trademarks. What may look like an obvious infringement to a rights owner may, however, be approached much more cautiously by the administrative authorities. This is particularly so where the infringer has a pending application for the look-alike mark or where the infringement is not completely straightforward. The authorities' increasing caution means that rights holders must be prepared before filing administrative complaints. To maximise their chances of success, rights owners must therefore establish the status of the look-alike marks being used and be ready to take a more creative approach to arguing infringement.

Let us assume that the mark was the word 'Kangaroo'. You can see how creative the infringers are when you come across strange but similar marks such as 'Kengaroo', 'Kanyaroo', 'Konyanoo', 'Kanyaraa', and 'Konjaroo'. All these look-alike marks copy the main elements of the famous trade mark, namely, the same, somewhat unusual first letter and the double vowel at the end.

During the course of filing trade mark infringement complaints - against products bearing look-alike marks - with the administrative authorities (the Administration of Industry and Commerce, or AIC), we, as an IP agent, have had difficulty persuading AIC officers to rule that look-alike marks are infringements of the plaintiff's registered trade mark. While the basic law is clear, its application by the AICs is not so simple because of the attention they pay to the status of a look-alike mark and because of their general caution.

The basic principle can be found in Article 9 of the *Several Questions on the Application of Law in Trial of Trademark Civil Dispute Cases Interpretation* (关于审理商标民事纠纷案件适用法律若干问题的解释).

In addition to the legal grounds, AIC officers will consider whether the look-alike mark: (1) is registered, (2) has passed the preliminary examination (during the period of publication), (3) is being opposed (during the period of opposition), (4) is being applied for but is on the waiting list, (5) is unregistered or, (6) has been held to be invalid.

If the first three cases, the officers are inclined not to make a ruling for the following reasons:

- If the mark is a 'registered look-alike trade mark', officers will consider that the dispute should be resolved through the courts, or that the plaintiff should first file an application to cancel the mark with the China Trade Mark Office;
- If there is an application to register a look-alike mark that has 'passed the preliminary examination (during the period of publication)' or is 'being opposed (during the period of opposition)', officers will prefer to wait for the final results from the China Trade Mark Office or Trade Mark Review and Adjudication Board before they make a ruling. They are concerned that if these look-alike marks are registered after they have ruled them to be an infringement, 'infringers' might be entitled to file an administrative litigation with the court or seek administrative reconsideration from the upper-level of the AIC.

If the second three cases, officers are more confident to make a ruling provided it is clear to them that the look-alike marks pass the legal test, i.e. are similar to the registered trademarks of the plaintiff after comparing the shape, phonetics and meaning of the words, or the shape of any graphics and colour.

For example, consider the case of 'Kengaroo' (used on the same goods). We will assume that the producer has applied to register the mark and been refused. In this case, we would expect the AIC officers to rule 'Kengaroo' to be an infringement of 'Kangaroo' having considered the following factors. Firstly, 'Kengaroo' having been held to be an invalid trademark. Secondly, 'Kengaroo' is very similar to 'Kangaroo' and the difference between 'Kengaroo' and 'Kangaroo' is only one English letter. And thirdly, the other English letters of 'K', and 'oo' in 'Kengaroo' are the unusual capital, and a double vowel, which makes the overall mark so similar to 'Kangaroo' that it could cause confusion among relevant consumers.

Another similar case would be 'Konjaroo', assuming it had also been held to be an invalid trademark and uses the first capital and double vowel. The invalidity of the mark should pose no problems, but the infringement itself might not be so straightforward and the attitude of the authorities can differ in different cities.

Tianjin City AIC might well have ruled that 'Konjaroo' was not an infringement of 'Kangaroo', finding that the mark was not similar enough to cause confusion with relevant consumers, as it did in the case of the famous mark we have referred to. But faced with creative arguments including an additional claim of unfair competition, Zhengzhou City AIC ruled in favour of the rights owner.

As can be seen from these examples, when dealing with the AICs, brand owners need to be aware of the status of the look-alike mark in the trademark application process and need to consider alternative creative arguments to put them in the best position to protect their brands.

Latest News

- 2010.07.20 [Know your bank-trust products before investment](#)
- 2010.07.20 [Full text translation - July 20 2010](#)
- 2010.07.20 [New China legislation this week - July 20 2010](#)
- 2010.07.20 [Mega-IPO for last of the state-owned banks](#)
- 2010.07.20 [Sino-Ocean in US\\$900 million convertible securities issue](#)

[More...](#)

Related Articles

[Generic words may be the subject matter of trademarks](#)
14 Jul 2010

[Seeking better protection through litigation](#)
14 Jul 2010

[Investors encouraged to seek indigenous product qualification](#)
14 Jul 2010

[State Administration for Industry and Commerce, Tentative Measures ...](#)
13 Jul 2010

[Full text translation - June 24 2010](#)
24 Jun 2010

China Law & Practice Events



[The 7th Annual Asia-Pacific IP Forum](#)

01 & 02 September 2010
Location: Hong Kong

[IFLR Asia Private Equity Forum](#)

10 September 2010
Location: Hong Kong

[China Law & Practice Awards 2010](#)

16 September 2010
Location: Beijing

[China Outbound Investment Summit 2010](#)

16 September 2010
Location: Beijing

Most read

- [China's Post-WTO Reforms in Financial Services: Achievements and Challenges](#)
- [Tentative Measures for the Administration of Overseas Investment of Insurance Capital](#)
- [Know your bank-trust products before investment](#)
- [China Law & Practice Awards 2008 - The Finalists](#)
- [Invitation and Submission of Bids for Construction Work for Construction Projects Measures](#)



**Asia Law
& Practice**

[Home](#) | [Sitemap](#) | [Archive](#) | [Advertising](#) | [Reprint](#) | [Contact Us](#) | [FAQ](#) | [Asia Law & Practice](#) | [Terms and Conditions](#) | [Privacy Policy](#) |

© Euromoney Institutional Investor (Jersey) Ltd 2010. All material subject to strictly enforced copyright laws.