

## **Risk of using “on behalf of” or “dba” in applicant's name for Chinese trademark application**

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In many countries, it is not uncommon to use the pattern of names like “doing business as (dba, d/b/a.)”, “trading as (t/a)”, “on behalf of”, “as trustee for” in an applicant’s name when filing trademark applications. The applicant’s name will be officially recorded as “A doing business as B” or “A on behalf of B”.

However, such use might cause trouble or risk in China or might put the applicant into a very unfavorable position in the trademark registration procedure, especially if the case proceeds to litigation. The risk can be seen from the following case.

### **1. Problem at the Court caused by the pattern “A on behalf of B”**

A trademark was applied for in its original country Australia by an applicant named in the pattern “Company A on behalf of Company B” (hereinafter referred to as “A on behalf of B”). An application for international registration in WIPO was filed, with China as one of the designated countries. Unfortunately, the international trademark registration was rejected by the China National Intellectual Property Administration (CNIPA) due to citation. The applicant appealed to the CNIPA, but failed. Then the applicant wanted to file a lawsuit with the Beijing IP Court against CNIPA’s appeal decision, but no document could meet the Court’s formality requirements.

The qualified documents should be the ID card or passport if the applicant is a natural person, or the “certificate of incorporation” if the applicant is a legal entity. What is more, the applicant’s name should be identical with that indicated in the documents certifying its identity.

Only in very rare cases can the problem be solved. For example, if the applicant is a natural person, and there is a middle name in his or her ID card, but the lawsuit is filed with only the first name and last name, the Court might then be convinced that the missing middle name is not a substantial formality

problem.

In this case, the trademark applicant is “A on behalf of B”, but there is no “certificate of incorporation” or any other documents which indicate the full name “A on behalf of B”, though both the “certificate of incorporations” for party A and party B are available. In other words, “A on behalf of B” is not an official name registered in any official documents. Despite the facts that 1) the trademark has been registered in its original country and accepted in WIPO under the name “A on behalf of B”, 2) party A and party B have very close relationship, 3) party B can execute an Authorization Letter to show that B authorized A to file the application and handle the relevant lawsuits, etc., the Court noted that there was no qualified document to prove so. Therefore, the formality requirements could not be met.

It seems possible to solve this problem by 1) changing the name “A on behalf of B” to A or B or assigning the trademark to A or B in China, and then 2) filing the lawsuit in A or B’s name with the Court. However, name change applications might involve all the trademarks in the name of the applicant in all countries, and assignment applications might involve other identical or similar marks on identical or similar goods or services. In addition, as it will also take substantial time (at least several months) to record the name change or assignment, the applicant can hardly meet the deadline of supplementation.

In one word, the initial problematic pattern might make it difficult to pursue the trademark registration in China later on.

## **2. Why “A on behalf of B” is not a problem in other countries or in WIPO**

In many countries, it is not required for the applicant to file identity document when filing a trademark application. Accordingly, the applicant can use a name different from that indicated in its identity documents.

Similarly, when the application is filed with WIPO based on its original application, WIPO is more liberal. We conducted a search in WIPO database and noted that around 30 applicants use the pattern “A on behalf of B”, around 300 applicants use the pattern “A dba B” and around 300 applicants use the pattern “A as trustee for B”.

## **3. “A on behalf of B” is normally a problem for a Chinese application**

If a national Chinese application is filed with CNIPA by an applicant in the name “A on behalf of B”, without identity document which can indicate this full name, then the application will not be accepted.

“A on behalf of B” was not a problem before 2014 as CNIPA at that time did not require the applicant to submit identity document if the applicant is a foreign legal entity, although it required such document for Chinese applicants and for natural person.

We noted in CNIPA's database that a few trademarks successfully registered under the pattern “A on behalf of B” or similar patterns. Some of them were filed before 2014 whereas a few were filed after 2014 when identity documentation was needed for foreign legal entity. We cannot see the documents filed. From this fact, however, it seems it is still possible to convince CNIPA to accept the application in the name “A on behalf of B”.

#### **4. “A on behalf of B” is not a problem for international application designating China if no rejection arises in China**

The applicant's name “A on behalf of B” is not a problem in the registration procedure for an international application designating China, if no rejection arises in China, as CNIPA does not require the applicant to file its identity documents at this stage if it is registered smoothly.

#### **5. “A on behalf of B” might be a problem for international application designating China if rejection arises in China**

However, if rejection or office action arises for the international application designating China in the name “A on behalf of B” and the applicant needs to appeal against the rejection, the pattern “A on behalf of B” might be a problem as CNIPA needs identity documents in the appeal procedure. If no qualified identity document is submitted, the appeal might be refused.

According to the current practices, in the appeal procedure for the international application designating China, CNIPA was not very strict with the identity documents. Therefore, it remains possible to convince CNIPA to accept the appeal even if no identity document indicates the name “A on behalf of B”. To our knowledge, in some cases, the separate identity documents for A and for B can convince CNIPA.

#### **6. “A on behalf of B” is a problem for post-grant procedures**

The pattern “A on behalf of B” can also be a big problem if the owner needs to assign or license its trademarks in China in the future, as CNIPA still requires qualified identity document in the procedures.

Similarly, the enforcement authorities in China, including but not limited to the Courts, the Customs and the Administration of Market Regulations (AMR), also

require qualified identity document.

## **7. Lessons and suggestions**

To sum up, if a trademark application is filed by an applicant in the aforesaid name pattern, it will encounter formality problem often difficult or even impossible to solve in China.

As such, if possible, it is advisable to file trademark applications, national or international, in the name A or B, but avoid using “A on behalf of B” as the applicant’s name.

If an international application designating China has already been filed in the name “A on behalf of B” and there is no identity document indicating this name, it is advisable to change its name or assign the trademark to A or B as soon as possible, just in case the trademark application is rejected in China and the qualified identity document is needed in a relatively short period by CNIPA or by the Court.