

International Trademark Opposition in China

By Ms. Wenpei He, Chofn IP

A trademark application can be filed in China directly, namely national filing, or via the Madrid system, namely international filing with China designated. Other parties may file opposition to both national and international filings. Most professionals and interested parties are familiar with national trademark opposition, but not very familiar with international trademark opposition.

Having worked on some international trademark oppositions, I hope to introduce the procedures and share my experience with you through this article.

● Procedures in sequence:

- 1) An international trademark registration designating China, after passing WIPO's formality examination, will be published in the *International Trademark Gazette* (<https://www3.wipo.int/madrid/monitor/en/#gazette>);
- 2) An opposition may be filed with the China National Intellectual Property Administration (the CNIPA) within three months, counting from the first day of the following month after the publication. The opposition should be filed in Chinese, together with a Chinese translation of the relevant pages of *International Trademark Gazette*. After filing the opposition, the opponent (i.e., the opposing party) may make supplementation in the following three months;
- 3) The CNIPA will translate the main points of the opposition argument and the basic information of the opponent's cited mark(s), if any, from Chinese to English, French or Spanish, based on the filing language of the international trademark registration, and then, send a "Notification of Provisional Refusal based on an Opposition" to WIPO;

- 4) WIPO will send the notification to the owner or the recorded agent of the international registration. In practice, the notification is deemed to be successfully delivered 15 days after the “Date of notification from WIPO to the holder” indicated on the notification;
- 5) If the trademark owner wishes to review the full opposition documents and evidence, it should contact the CNIPA through a local agent, and then, is entitled to file response within 30 days counting from the receipt date of the notification, though absent response does not necessarily result in failure. Supplementation is available in the following three months;
- 6) The CNIPA will not begin to examine the opposition case immediately. Instead, it will suspend the opposition, conduct substantial examination (i.e., *ex officio* examination) of the trademark and take steps as follows:
 - a) If the trademark passes the substantial examination, the CNIPA will resume the examination of the opposition;
 - b) If the trademark is rejected in the substantial examination and no appeal is duly filed, the trademark will become invalid and there will be no need to examine the opposition. Therefore, the CNIPA will conclude the opposition by issuing an Opposition Closure Notification for International Trademark;
 - c) If the trademark is rejected in the substantial examination and appeal is duly filed, the opposition case will be suspended until the appeal case is concluded. If the appeal is not successful, the trademark will still become invalid and there will be no need to examine the opposition. If the appeal is successful, the examination of the opposition will begin.

● **Comparison of national with international oppositions**

From the procedures introduced above, we can note the differences between national and international oppositions as follows:

1. **Different Trademark Gazettes:** International trademark registration is published by the WIPO in the weekly *International Trademark Gazette* only, not to be published or re-published in the Chinese *Trademark Gazette*. In

contrast, a national trademark application will be published by the CNIPA in the Chinese *Trademark Gazette*, four issues a month. Therefore, it is advisable to monitor both Gazettes.

2. **Different order for substantial examination:** An international trademark registration designating China is published for opposition before the substantial examination. A national trademark will not be published for opposition until it provisionally passes the substantial examination.
3. **Different deadlines:** The period for an international opposition is three months, counting from the first day of the following month after the publication, which means the opponent usually has longer than three months to make a decision on opposition. The period for a national opposition is exactly three months, counting from the next day of the publication.
4. **Languages and services:** The CNIPA needs to provide the basic translation of an international opposition, and serve a notification to the WIPO who will then relay a copy to the trademark owner or agent, which is more time and resource-consuming and riskier in many ways. For a national opposition, the notification shall be directly served to the trademark owner or agent, together with the opposition documents.
5. **E-filing** is available for a national opposition, but not for an international opposition.
6. **Different duration of examination:** According to the Chinese Trademark Law, examination for an opposition should be completed within 12 months which can be extended to 18 months under special circumstances. In practices, the duration applies only to a national opposition, but not binding on an international opposition, which gives rise to some uncertainty.

In conclusion, international trademark opposition is far more complicated and should be processed and followed up more carefully than a national opposition.