
CHOFNTM

Chinese IP Services

Chofn Intellectual Property

B316 Guangyi Plaza,
5 Guangyi Str., Xicheng,
Beijing 100053, P.R. China

Tel: +86-10-6213 9699

Fax: +86-10-6213 1230; +86-10-6213 1630

Email: patent@chofn.cn; trademark@chofn.cn

Web: www.chofn.com

Translated by Ms. Haoyu Feng and Mr. Tingxi Huo of Chofn IP

CNIPA Notification of Publishing the Criteria to Determine Trademark Infringement

CNIPA Notice Protection #2020-23

To the Attention of IP Offices (IP Administrations) of all Provinces, Autonomous Regions, Municipalities and the Xinjiang Production and Construction Corps:

In order to carry out the Party's and the State Council's decision to strengthen IP protection, enhance the guidance of the trademark enforcement, standardize enforcement criteria, raise the level of enforcement, strengthen the protection of trademark exclusive rights, this Administration makes and hereby publishes the Criteria in accordance with the relevant provisions of the Trademark Law and the Implementing Regulations for your compliance and implementation. If new scenarios or problems occur during the course of implementation, please report in a timely manner.

The China National IP Administration (CNIPA)

June 15, 2020

The Criteria to Determine Trademark Infringement

Rule 1. These criteria are made in accordance with the Trademark Law, the Implementing Regulations, and relevant law and ministerial regulations in order to enhance the guidance of the trademark enforcement, standardize enforcement criteria, raise the level of enforcement, and strengthen the protection of trademark exclusive rights.

Rule 2. The trademark enforcing organs shall comply with the Criteria to handle, investigate and punish trademark infringement.

Rule 3. Before trademark infringement is determined, it shall be generally determined whether a suspected infringing conduct constitutes the use of trademark in the sense of the Trademark Law.

The use of trademark shall refer to the use of trademark on goods, the packaging or containers of goods, venues of services, and the transaction documents, or the use of trademark for advertising, exhibition and other commercial activities for the purpose of identifying the source of goods or services.

Rule 4. The use of trademark on goods, the packaging or containers of goods, venues of services, and the transaction documents of goods can be specifically represented in the forms including but not limited to:

- 1) Directly attaching, printing or engraving, branding or knitting trademarks onto goods, the packaging or containers of goods, and tags, or using trademarks on the additional labels, product specification, explanatory manuals, or pricelists; or
- 2) Using trademark in transaction documents relating to the sale of goods, including sale agreements, invoices, bills, receipts, import and export inspection and quarantine certificates, and customs declarations etc.

Rule 5. The use of trademark in venues of services and the transaction documents of services can be specifically represented in the forms including but not limited to:

- 1) Using trademarks directly in the venues of services, including using in introductory manuals, staff clothing, signboards, menus, pricelists, name cards, coupons,

stationery, writing papers as well as other relevant materials used for providing services; or

- 2) Using trademarks in service-related documents such as invoices, bills, receipts, remittance bills, service agreements, maintenance certificates etc.

Rule 6. The use of trademarks for advertising, exhibition and other commercial activities can be specifically represented in the forms including but not limited to:

- 1) Using trademarks in such media as broadcasting, television, movies, and internet, or in public publications, or billboards, mail advertisements or other advertisement carriers;
- 2) Using trademarks in exhibitions and shows, including printed matters, booth photos, participation certificates and other materials with trademarks used at the exhibitions and shows;
- 3) Using trademarks in such carriers as websites, instant messenger, social networking platforms, and applications;
- 4) Using trademarks in such information carriers as QR codes; or
- 5) Using trademarks in shop signboards and decorations.

Rule 7. For the purpose of determining whether it is the use of trademarks, comprehensive consideration shall be given to such elements as the user's subjective intent, way of using, way of publicizing, industrial common practices, and consumers' knowledge.

Rule 8. The scenarios without the trademark registrants' license include the absence of license or exceeding the licensed classes of goods or services, period, or quantity.

Rule 9. The same goods mean that the goods actually produced and sold by a suspected infringer share the same goods name with the goods granted for others' registered trademarks, or that the goods are different in name but identical or basically identical in terms of function, use, main raw materials, producers, consumers, sales channels and the relevant public generally consider the goods identical.

The same services mean that the services actually provided by a suspected infringer share the same service name with the services granted for others' registered trademarks, or that the services are different in name but identical or basically identical in terms of service purposes, contents, methods, suppliers, consumers, and venues and the relevant public generally consider the services identical.

The goods or services granted refer to the goods and services accepted by the China National Intellectual Property Administration during the course of trademark registration, including the goods or services listed under the Classification of Similar Goods and Services (hereinafter referred to as "Classification") as well as the goods or services not listed in the Classification but accepted for registration.

Rule 10. Similar goods refer to the goods with some common features in terms of functions, use, main raw materials, producers, consumers, sale channels etc. Similar services refer to the services with some common features in terms of purposes, contents, methods, suppliers, consumers, venues etc.

Rule 11. For the purpose of determining whether the goods or services are similar or the same, comparison shall be made between the goods or services granted for a right holder's registered trademark and the goods or services of the suspected infringers.

Rule 12. The current Classification shall be the reference to determine whether the suspected infringing goods or services are the same as or similar to the goods or services granted for others' registered trademarks.

Where the goods are not covered by the Classification, the relevant public's common sense shall be the basis for the comprehensive consideration of such elements as the functions, use, main raw materials, producing departments, consumers, and sales channels to determine whether the goods are identical or similar.

Where the services are not covered by the Classification, the relevant public common sense shall be the basis for the comprehensive consideration of such elements as the purposes, contents, methods, suppliers, consumers, and venues to determine whether the services are identical or similar.

Rule 13. A trademark identical with a registered trademark means that a suspected infringing trademark is totally identical with others' registered trademark or that the trademarks, though not identical, are basically not different visually or phonetically and

the relevant public can hardly distinguish the trademarks.

Rule 14. The scenarios where a suspected infringing trademark can be determined identical with others' registered trademark include:

- 1) Word trademarks carrying any of the following scenarios:
 1. Identical in terms of both the word composition and spelling;
 2. Basically not different from the registered trademark in spite of the changed fonts, cases, and/or transition between horizontal and vertical order;
 3. Basically not different from the registered trademark in spite of the changed space between the words, characters, and numerals
 4. With changed colors from the registered trademark but with the distinctive features uninfluenced; or
 5. Uninfluenced distinctive features of the registered trademark in spite of such additional indistinctive features as generic names, devices, or models.
- 2) Device trademarks basically not visually different in terms of structural elements and forms of representation;
- 3) Word-device-combination trademarks basically not different in overall look in terms of word composition, device appearance or the way of combination;
- 4) Three-dimensional trademarks identical or basically not different in terms of distinctive three-dimensional signs and distinctive surface elements;
- 5) Color-combination trademarks identical or basically not different in terms of the combined colors and way of arrangement;
- 6) Sound trademarks identical or basically not different in terms of auditory perception or overall musical image; or
- 7) Other scenarios where the suspected trademarks are basically not different from the registered trademarks in terms of visual effects and auditory perception.

Rule 15. Trademarks similar to registered trademarks means that the suspected infringing trademarks are similar to others' registered trademarks in terms of word shape, pronunciation and meaning in the case of word trademarks, in terms of structure, colors,

and appearance in the case of device trademarks, in terms of overall combination and appearance in the case of word-device-combination trademarks, in terms of shape and appearance in the case of three-dimensional trademarks, in terms of color or combination in the case of color-combination trademarks, or in terms of auditory perception and overall musical image in the case of sound trademarks.

Rule 16. The provisions concerning similarity of trademarks under the Trademark Examination Criteria shall be followed to determine whether a suspected infringing trademark is similar to others' registered trademarks.

Rule 17. The suspected infringing trademarks shall be compared with the right holders' registered trademarks to determine whether trademarks are identical or similar.

Rule 18. The relevant public's general attention and consciousness shall be taken as the criteria to determine whether trademarks are identical with or similar to registered trademarks, through isolated observation, overall comparison, and comparison of the main parts.

Rule 19. During the course of determining trademark infringement in the scenarios where similar trademarks are used on the same goods or services or where identical or similar trademarks are used on similar goods or services, determination shall also be made about the likelihood of confusion.

Rule 20. The likely confusion prescribed by the Trademark Law includes the scenarios below:

- 1) Sufficient to convince the relevant public that the goods or services concerned are produced or provided by the right holders of the registered trademarks; or
- 2) Sufficient to convince the relevant public that the goods or services suppliers and the right holders of the registered trademarks are related in terms of investment, license, franchise or cooperation.

Rule 21. The trademark enforcing organs shall comprehensively consider the following elements and the mutual influence thereof to determine the likelihood of confusion:

- 1) The similarity of the trademarks;
- 2) The similarity of the goods or services;

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- 3) The distinctiveness and notoriety of the registered trademarks;
 - 4) The features of the goods or services and the way of using the trademarks;
 - 5) The relevant public's attention and consciousness; and
 - 6) Other relevant elements.

Rule 22. Unilateral change of the registered trademarks or combination of many registered trademarks to pose trademarks identical with others' registered trademarks on the same goods or services constitutes trademark infringement under Article 57.1 of the Trademark Law.

Unilateral change of the registered trademarks or combination of many registered trademarks to pose trademarks similar to others' registered trademarks on the same or similar goods or services and likely to cause confusion constitutes trademark infringement under Article 57.2 of the Trademark Law.

Rule 23. Outstanding use of the company's trade name which is identical with others' registered trademarks on the same goods or services constitutes trademark infringement under Article 57.1 of the Trademark Law.

Outstanding use of the company's trade name which is similar to others' registered trademarks on the same goods or services and likely to cause confusion constitutes trademark infringement under Article 57.2 of the Trademark Law.

Rule 24. Registered trademarks without designated colors may be painted in color freely. However, where the color is painted for the purpose of imitation, and the painted trademark is similar to others' registered trademarks on the same or similar goods or services and likely to cause confusion, such conduct constitutes trademark infringement under Article 57.2 of the Trademark Law.

Where a registered trademark enjoys high notoriety and the suspected infringer, in an industry identical or largely associated with the right holder of the registered trademark, uses signs identical with or similar to the registered trademark without justified reasons, the suspected infringer shall be considered having the intent to imitate.

Rule 25. A contractor's use of goods that infringe the exclusive right to registered trademarks in a contract for labor and materials constitutes trademark infringement under Article 57.3 of the Trademark Law.

Rule 26. Dealers' offer of gifts that infringe the exclusive right to registered trademarks during the course of goods sale constitutes trademark infringement under Article 57.3 of the Trademark Law.

Rule 27. None of the following scenarios constitute sale of goods infringing the exclusive right to a registered trademark unaware of the infringing nature prescribed by Article 60.2 of the Trademark Law:

- 1) The supply channels do not fit the common practice of business and the price is obviously lower than the market price;
- 2) Submission of such accounting evidence as accounting books and sale log is refused, or the accounting evidence is fabricated;
- 3) After the infringement case is initiated, physical evidence is transferred or destroyed or false evidence or information is provided;
- 4) Similar violation of the law is committed again after punishment; or
- 5) Other scenarios where the party concerned may be considered aware or supposedly aware of infringement.

Rule 28. Under Article 60.2 of the Trademark Law, "providing information on the suppliers" means that the suspected infringer takes the initiative to provide such accurate information or clues as the suppliers' names, business venues, or contact information.

Where the suppliers cannot be found because of the false or unverifiable information provided by the suspected infringer, the situation cannot be regarded as "providing information on the suppliers".

Rule 29. Where the suspected infringer sells goods infringing the exclusive right to others' registered trademarks under Article 60.2 of the Trademark Law, it shall be ordered to stop selling the infringing goods and the suppliers shall be investigated and punished or the clues shall be handed over to the competent trademark enforcing organ for investigation and punishment.

Where the infringer re-sells the goods ordered to be stopped for sales, it shall be

investigated and punished in accordance with the law.

Rule 30. Where such operators as the market or exhibition organizers, counter leasers, or electronic business platforms, though they are aware of or should be aware, fail to perform their management duty to stop the trademark infringement conducted by the market dealers, exhibition participants, counter renters, operators in the electronic business platforms, or still fail to take necessary actions to stop the trademark infringement, though they are not aware but have been notified by the trademark enforcing organ or the trademark holders who hold the effective administrative or judicial documents, the failure to take actions constitutes trademark infringement under Article 57.7 of the Trademark Law.

Rule 31. Where the words identical with or similar to others' registered trademark are registered as domain names and where electronic business is done in relation with the relevant goods or services through the domain names, likely to cause the relevant public's confusion, it shall constitute the trademark infringement under Article 57.7 of the Trademark Law.

Rule 32. The legitimate prior rights shall be protected when trademark infringement is investigated and punished.

Where the exclusive right to others' registered trademark is contested with design or copyright and where the application date of the registered trademark precedes the application date of the design or the copyrighted work's date of completion supported by evidence, the trademark enforcing organ may investigate and punish the trademark infringement.

Rule 33. The "trademark of certain influence" prescribed under Article 59.3 of the Trademark Law refers to an unregistered trademark that had been used earlier in China and known to the relevant public in a certain area.

To determine a trademark of certain influence, comprehensive consideration shall be given to such elements of the trademark as the duration of use, sales volume, turnover, and publicity.

None of the users' following acts shall be considered continued use in the original scope:

- 1) Adding extra specific goods or services under the trademark;

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- 2) Altering the trademark in terms of device, words, color, structure, or way of writing, except the alteration aiming to distinguish itself from others' registered trademarks; or
 - 3) Other scenarios beyond the original scope of use.

Rule 34. Twice or more trademark infringement within five years under Article 60.2 of the Trademark Law means that the same party concerned infringes trademark again within five years beginning from the date when a trademark enforcing organ's administrative punishment or People's Court' ruling determining infringement of the exclusive right to others' registered trademark takes effect.

Rule 35. In the cases listed below pending before the China National Intellectual Property Administration or the People's Courts, suspension may be applicable under Article 62.3 of the Trademark Law.

- 1) A registered trademark is being invalidated;
- 2) A registered trademark is staying in the grace period of renewal; or
- 3) A registered trademark is involved in other disputes.

Rule 36. During the course of investigating and punishing trademark infringement, the trademark enforcing organ may require the right holder to submit written verifying opinions on whether of the goods involved are produced or licensed by the right holder. The right holder shall be legally liable for its verifying opinions.

The trademark enforcing organ shall examine the qualification of the verifier who submit the verifying opinions and the authenticity of the verifying opinions. Where the suspected infringers have no contrary evidence to overrule the verifying opinions, the trademark enforcing organ shall accept the identifying opinions as evidence.

Rule 37. The China National Intellectual Property Administration shall be entitled to interpret these Criteria.

Rule 38. These Criteria shall take effect as of the date of publication.

Note: This is not the CNIPA's official translation. If discrepancies arise, the official Chinese version prevails.