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Successful Opposition Based on Prior Famous TV Programme DOCTOR WHO

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Case brief:

“神秘博士 (the Chinese equivalent of DOCTOR WHO)” has been a long-running science fiction television programme of BBC. There are also some series movies released under the same title.

Sichuan Garage Electronic Commerce Co., Ltd., namely the Opposed Party, filed an identical trademark No. 31321875 in class 30, namely the Opposed Mark. BBC naturally decided to file an opposition thereto.

China National Intellectual Property Administration (CNIPA) made a decision in favor of BBC and held that:

- 1) The television programme had been published before the application date of the Opposed Mark and widely known to the relevant public;
- 2) The Opposed Mark is identical with the title of BBC’s famous television programme and the Opposed Party failed to give a reasonable explanation in this regard.
- 3) The Opposed Mark improperly took advantage of the good will to BBC’s famous television programme title, which might damage BBC’s prior rights and interests.

In compliance with Articles 32 and 35 of the Chinese Trademark Law, the CNIPA disapproved the registration of the Opposed Mark. The Opposed Party did not duly appeal and the decision has come into force.

Analysis:

In the opposition decision, the CNIPA recognized BBC’s prior right and interests to the title of the television programme. The CNIPA mentioned that

the "prior rights" stipulated in Article 32 of the Chinese Trademark Law include not only the prior legal rights which have been explicitly prescribed in the current laws, but also the legitimate rights and interests that should be protected according to the General Principles of Civil Law and other laws.

In this case, BBC has invested substantial resources in promoting and running the television programme and made it widely known to the Chinese consumers. The good will of the programme has been accumulated and can bring tremendous market advantage and trading opportunities. Because of the commercial value behind the programme title, there should be rights and interests, which deserve legal protection. Allowing a third party to register the same title as a trademark will harm BBC's legitimate right and interests, disturb the market order and damage fair competition.

Although the decision only mentioned "prior rights and interests to the famous television programme", not the terms "commercialization right" or "merchandising right", in practices, it can be interpreted as "commercialization right". The *Guidelines of Beijing High People's Court on Trial of Administrative Cases of Trademark Right Granting and Verification* has provided some specific scenarios to interpret "prior rights", which explicitly include "title of a work", "name of a character in works", etc.

In fact, there are already some cases where "commercialization right" has been recognized, such as the cases of *James Bond*, *Kung Fu Panda*, etc.

In one word, if your titles of a television programme, novel, movie and the character names in these works are popular among Chinese consumers and fans, the risk of trademark piracy can be higher. In such circumstances, it is advisable to lodge the trademark opposition or invalidation cases by claiming commercialization rights, though the terms "commercialization rights" might not be used in the official decisions.