The International Trademark Association (INTA) would like to thank the Chinese National Intellectual Property Administration (CNIPA) for the opportunity to provide comments on its Guide on Determining Generic Names in the Protection of Geographical Indications (the “Guide”).

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. INTA’s members are more than 7200 organizations from 187 countries, including 246 in the People’s Republic of China. INTA members collectively contribute almost US$12 trillion / ¥73 trillion to global GDP annually. The Association’s member organizations represent some 31,000 trademark professionals and include brand owners from major corporations as well as small- and medium-size enterprises, law firms and non-profits, government agencies, academics and students.

INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. Headquartered in New York City, INTA also has offices in Shanghai, Singapore, Brussels, Santiago de Chile and Washington D.C. and a representative in New Delhi. Further information about our Association can be found at www.inta.org.

INTA recognizes that intellectual property law in China has greatly improved over the last decade thanks to the actions of the Chinese government (‘the Government’). In this regard, INTA is encouraged by the proposals in the Guide which seek a balanced protection of geographical indications (‘GIs’) in light of prior rights, including trademarks. To assist the Government in such efforts, INTA respectfully submits the following general comments (Section I) then followed specific comments (Section II) on the Guide.

I. General Comments

INTA’s position with regard to the protection of GIs is grounded on the principle of “first in time, first in right,” which in turn is based on the well-established principles of territoriality, exclusivity, priority, and good faith when resolving conflicts between geographical indications and trademarks, including collective and certification marks, as enshrined in INTA’s 2019 Board Resolution on ‘Protection of Geographical Indications’.
INTA recommends any regulation of geographical indications to have effective and transparent mechanisms for addressing: (i) the applications for geographical indications, applications for amendments, and applications for cancellation; and (ii) effective opposition, cancellation, and notification procedures that recognize pre-existing trademark rights with which geographical indications might conflict or cause confusion.

II. Specific Comments

a) Article 4 – Principle

As to Article 4, INTA commends the Government for prohibiting in the Guide the protection in China of a GI that corresponds to a generic term. However, it should also be stressed that INTA has always supported the protection of GIs as an intellectual property right as it does for trademarks, designs and other related intellectual property rights (“IPRs”), based on the well-established principles of territoriality, exclusivity, priority and good faith. INTA recognizes that in some jurisdictions, geographical names are, in fact, protected and registered as collective trademarks or certification trademarks. INTA recommends that a GI should not impair the free use of a generic term, and recommend that the genericness of the transcription, transliteration or translation of GI terms shall be evaluated on territorial basis, taking into account the perception of Chinese consumers.

b) Article 5 - The Generic Name in Combined Name shall not be protected

As to Article 5 as read in conjunction with Article 8, INTA commends the Government for recognizing in the Guide that portions of compound GIs may not be protected as a GI because it corresponds with a generic term. This ensures the GI cannot be used to impair the use by third parties of a generic term contained in the protected GI.

c) Article 7 - Factors for the Determination

As to Article 7, with regard to the factors for the determination whether a GI becomes a generic name, INTA supports the position that the identified criteria shall be more specific. In particular, criteria n° 3 "How the products referred by the name are produced, distributed and circulated in Chinese market"- should be specified more clearly.

Criteria n° 4 "Whether the products referred by the name are produced outside the place of origin in a way that does not mislead the public on the original of the products, and the trade situation of such products in China"- could have an adverse effect on well-know GIs whose name could be exploited for products originating from another area. The public policy considerations of accurate source identification and consumer protection, which form the basis of trademark law, are applicable to GIs. Over the last 20 years GIs laws and regulations have developed with clear rules, online accessible lists of protected names and clearly identifiable right holders. INTA has noted that the number of protected GIs continues to rise. Not considering the relevance of existing GIs would be incongruent with the express recognition of private legal ownership rights in GIs by sovereign states also recognized by international treaties.

Criteria n° 5 “Other factors that may cause the name to become a generic name”, it appears vague and shall be detailed.
d) Article 9 – Follow-up Procedure

As to Article 9, INTA comments that it is not clear what avenues are available to object to an adverse decision. INTA recommends that any such decision be appealable in a court of law and that the process be transparent and able to be pursued not only by foreign governments but also third-party individuals and corporations, provided they have legitimate standing to do so.

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INTA would like to thank, once again, CNIPA for the opportunity to provide these comments and remains at your full disposal for any question you may have on the above comments or any other point. Should you wish to further discuss any of the points we have raised or additional issues, please contact Seth Hays, Chief Representative Officer- Asia-Pacific and China at shays@inta.org and Monica Su, China Representative Officer at msu@inta.org.