International Trademark Association
Representing Trademark Owners Since 1878

Alan C. Drewsen
Executive Director

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Mr. Xiangjun Kong, Deputy Chief Judge
Intellectual Property Tribunal
The Supreme People's Court of China
27 Dong-jiao-min-xiang, Dongcheng District
Beijing 100745
People's Republic of China

Dear Sir:

As a global organization, the International Trademark Association (INTA) is grateful for the opportunity to put forward its comments with respect to the issues raised in the draft entitled *Interpretations of the Supreme People's Court of Several Issues Concerning the Application of the Law for the Recognition and Protection of the Well-known Trademark in the Trail of Civil Cases of Trademark Infringement*, circulated by the Supreme People's Court.

INTA is a not-for-profit membership association of more than 5,800 corporations, law firms and other trademark-related businesses from more than 190 countries throughout the world. INTA is headquartered in New York with offices in Shanghai and Brussels. Its membership crosses all industry lines, including manufacturers and retailers, and is united in the goal of supporting the essential role trademarks play in promoting effective national and international commerce, protecting the interest of consumers, and encouraging free and fair competition.

Enclosed are brief comments on several of the Articles in the draft paper. For your convenience, we have reproduced the relevant articles and followed them with brief questions and comments.

We again thank the Supreme People's Court for the opportunity to submit our comments and would be pleased to discuss or provide further information as needed. Please contact our INTA China Representative Ms. Chen Min by email at mchen@inta.org or by telephone at 021-6122-1156 if you have any questions.

Sincerely,

Alan C. Drewsen

Enclosures: Comments from INTA

INTA Comments on the draft entitled "Interpretations of the Supreme People's Court of Several Issues Concerning the Application of the Law for the Recognition and Protection of the Well-known Trademark in the Trail of Civil Cases of Trademark Infringement."

Article 2: Where the party concerned uses the recognition of well-known trademark as factual ground for trademark infringement and unfair competition in the following civil cases, the People's Court may recognize whether the said mark constitutes well-known trademark, in accordance with the detailed circumstance of the case:

(1) The plaintiff brings a lawsuit of trademark infringement against the defendant for violating Article 13 of the Trademark Law;

(2) The plaintiff brings a lawsuit of trademark infringement or unfair competition against the defendant's registration and/or use of the domain name that is identical or similar to the plaintiff's well-known trademark;

(3) The plaintiff brings a lawsuit of trademark infringement or unfair competition against the defendant's registration and/or use of trade name that is identical or similar to the plaintiff's well-known trademark;

(4) The plaintiff bring an action claiming the defendant's use of trademark infringes its exclusive trademark right, while a counterclaim is made by the defendant or a non-infringement declaration is requested by claiming that the disputed mark is the defendant's prior unregistered well-known trademark;

(5) Other civil cases where the recognition of well-known trademarks is needed pursuant to provisions of laws, regulations and special circumstance of different cases.

Comment: INTA believes that these enumerated scenarios do not cover a lawsuit for unfair competition based on a defendant's trademark. Article 2(2) and (3) cover infringement/unfair competition when a plaintiff sues over a defendant's domain name or enterprise name, respectively. Article 2(1) addresses infringement by a defendant's trademark, and Article 2(4) addresses infringement by a defendant's mark when a plaintiff has a registration. As a result, INTA respectfully suggests that consideration be given to a more explicit scenario to address unfair competition based on a defendant's use of a trademark.

Additionally, it is unclear whether any of these scenarios covers a trademark opposition or cancellation that goes to the Courts, i.e. upon appeal, although we assume that Article 2(5), a 'catch-all' to cover any scenario not addressed by Article 2(1)-(4), is intended to include oppositions and cancellations. However, given the importance of such proceedings in the protection of trademark rights, INTA also suggests that consideration be given to specifically mentioning oppositions and cancellations either within Article 2(5) or in a separate scenario.

Article 7: In respect of the trademark that is widely known to common public, the People's Court shall duly lessen the burden of proof borne by the plaintiff. If the plaintiff provides preliminary evidence to support that it is well known, or the defendant has no opposition against the same, the People's Court shall recognize the well-known status of the trademark in question.

Comment: INTA believes that this article could allow a party to receive well-known mark recognition without proving that its mark is actually well-known. The Article does not set forth the circumstances under which the burden of proof for the plaintiff is reduced, nor does it set forth what constitutes prima facie evidence. INTA respectfully recommends that a Court look at the evidence required to establish a mark as being well-known, and not make a ruling that would grant such recognition to the mark simply because the defendant in a particular dispute has not objected.

Article 9: The People's Court shall take into consideration of the distinctiveness of the well-known mark, the well-known status of the sued infringing products among relevant public and the relevancy of goods in dispute and etc when prohibiting the defendant from using the mark that is similar or identical to the plaintiff's mark on dissimilar goods.

Comment: INTA believes that a comparison of goods/services should not be relevant when a plaintiff has a well-known mark.