

(Following is a summary of an article published in a special report *Navigating Licensing Opportunities in China and India*, published by *The Licensing Letter*.)

Trademark Portfolio Management in China and India – Some Considerations to Bear in Mind When Embarking on a Trademark Filing Program

by Darren B. Cohen, Esq. and Steven M. Getzoff

Both China and India have reputations as being soft on intellectual property enforcement. However, that climate is changing, as pressure from both other trading partner nations and Chinese and Indian nationals desirous of getting similar protections in other countries are moving these countries to ensure reciprocal protections for foreign intellectual property owners claiming rights in their countries. The accession of India and China to certain global intellectual property treaties (Madrid Protocol, Paris and Berne Conventions and the Patent Co-Operation Treaty) has also pushed these countries toward harmonization. However, the playing field is not yet level, and there are special considerations that need to be understood about creating and maintaining intellectual property rights, particularly trademarks, and augmenting their equities in China and India.

The first step for the U.S. trademark owner seeking to enter these countries is to assess one's own U.S. portfolio to determine what properties can be extended to China and India via the various global treaties. Depending on one's business model, new filings in those countries as well should be strongly considered for those properties of core value to the business.

Of course, engagement of local counsel specialized in intellectual property matters and the intricacies of the domestic IP offices and courts is of utmost importance, and experienced U.S. counsel should have a network of such resources.

Special considerations in China include the fact that, unlike the U.S. and India, China does not recognize common law and, absent a showing of fame, trademark rights will be solely derived from registration.

In addition, unlike the U.S. or India, China does not accept multi-class trademark applications, requiring a separate application for each class of goods or services.

India allows for an authorized user in that country (distributor, licensee, etc.) to co-register a mark with the rights holder, which can be useful in aiding the authorized user in enforcement actions on the rights holder's behalf.

India has a special provision allowing for registration of a "series" of marks; that is, one registration can cover multiple similar marks for related goods, which can be very useful in enforcement purposes and save costs as well.

Proof of use of a trademark is not required in either China or India to obtain a registration or to renew (10 year term in both countries).

Finally, special care must be placed on notice markings. In China, trademark notice is mandatory, and all marks used in commerce must be accompanied by registration notice (REGISTERED TRADEMARK in Chinese or ®). Notice in India, like the U.S., is optional, though unlike the U.S., carries potentially severe penalties for false notice designations. Local counsel should review labels, packaging, promotional materials and the like for compliance in both countries.

Obtaining trademark protection in China and India should be at the forefront of any business endeavor poised for those countries, and proper clearance and counsel prior to entry into those markets should be at the core of any commercial strategy. Bearing in mind these issues and maintaining active communication with experienced and specialized local IP counsel will both save resources and maximize trademark value.

For more information on specific issues related to trademark management in India and China, or to read the article published in *Navigating Licensing Opportunities in China and India*, please contact Darren Cohen at 212-549-0346 or dcohen@redsmith.com and Steven Getzoff at 212-549-0353 or sgetzoff@redsmith.com.