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J.D. NEWS

J.D. Sellier at INTA 2016

Ariane Ramnath, Partner in our Intellectual Property department attended the 138th Annual Meeting of the International Trademark Association (INTA) in Orlando, Florida from May 21st - 25th 2016. This year the Association recorded its largest attendance which topped 10,115 bringing together brand management, trademark and other IP professionals from across the globe. The Annual Meeting affords the opportunity to personally meet our clients and stay abreast of international and current trends and developments in Intellectual Property Law.

BEHIND THE GREAT FIREWALL: FACEBOOK IN CHINA

Hoping to quench your thirst with a refreshing 'face book' beverage? Although once a possibility for residents of China, this is no longer the case.

Weeks after a Beijing court ruled that Chinese manufacturer Xintong Tiandi Technology Co. could continue using the mark "IPHONE" on accessories such as wallets, handbags and smartphone cases, the Beijing Higher People's Court on April 25th 2016 released a judgment against Zhujiang Beverage Factory prohibiting the company's use of its 'face book' trademark on beverage products.

According to reports, the Zhongshan based company registered its 'face book' or (lian shu) trademark in 2011, but subsequently faced objections by the U.S. social networking giant Facebook. Although objected to by Facebook, China's trademark authority the Trademark Review and Adjudication Board approved the company's continued use of the mark. The matter was eventually brought before the Beijing Higher People's Court which handed down its ruling in favour of Facebook.

Reporting on the court's decision, the Wall Street Journal highlighted the comments of Liu Hongqun, marketing manager of Zhujiang Beverage:

"Lian shu is something very Chinese... [w]e have lian shu in traditional operas," referring to the intricate masks called 'face books' in China - that are used to indicate a historical character in traditional Chinese opera. Mr. Lui argued that even though Facebook is a known brand around the world, it's blocked here in China - and has been since 2009.

"How many Chinese customers get access to or sign up for Facebook in mainland China?" Mr. Lui said. "Where can we get access to this product in mainland China?"



But does the mere fact of Facebook being blocked by what is colloquially referred to as the Great Firewall of the Chinese Government, somehow translate into the global brand being any less well-known in China in the trademark sense of the term? The vast number of tech-savvy China based Facebook users could suggest otherwise. Employing the use of circumvention tools such as proxy servers and virtual private networks that are freely available online, China based users could access Facebook and other blocked social networking sites from behind the Great Firewall, thus advancing the argument that the mark is accessible and as result has a reputation in that jurisdiction. Knowledge/reputation however, is not the sole matter to be considered by Chinese trademark authorities when determining whether a mark is well-known in China. Further matters for consideration are best summarised by the International Trade Mark Association (INTA) in its INTA Bulletin 'CHINA: SAIC Clarifies Requirements for Recognition of Well-Known Marks':

The following materials will be taken into consideration in assessing the recognition of a well-known mark:

- 1. Materials proving the extent to which the relevant sector of the public is aware of the trademark.*
- 2. Materials proving the period for which the trademark has been used, including materials proving its use, history and scope of registration. If the mark is unregistered, materials showing use for not less than five consecutive years should be provided; if it is a registered trademark, materials showing registration for not less than three years or materials showing use for not less than five consecutive years should be provided.*
- 3. Materials proving the period, extent and geographical scope of the promotional activities carried out for the trademark in question within three years, including materials showing the means for and geographical scope of the advertising, publicity and promotional activities carried out, along with the types of media and advertisement expenditure, etc.*
- 4. Materials proving that the mark has been protected as a well-known trademark, including materials proving that it has been protected as a well-known trademark in China or in other countries or regions.*
- 5. Other evidentiary materials proving that the mark is a well-known trademark, including materials on the sales revenue, market share, net profit, taxes, sales regions, etc., of the major products on which the trademark has been used in the past three years.*

According to reports, insufficient evidence was put forward to support the argument that 'Facebook' was well-known in China at the time Zhujiang Beverage applied to register its 'face book' trade mark. However, in recognising the prominence of the brand, the Court determined that Zhujiang Beverage employed deceptive or improper means to secure its

INTELLECTUAL PROPERTY

The firm's Intellectual Property practice is ranked Tier 1 for the Caribbean Region by Managing Intellectual Property Magazine. It advises clients on all aspects of non-contentious intellectual property law including copyright protection; entertainment law; franchising; intellectual property licensing; trademark, patent, industrial design and domain name applications and additionally advises on contentious matters including copyright, trademark and patent infringement and prosecuting cases of infringement arising out of the seizure of counterfeit goods by Customs authorities. The attorneys in this practice group also represent clients in trademark opposition and cancellation proceedings before the Intellectual Property Office.

Having developed an efficient network of intellectual property agents throughout the Caribbean and Latin America, the firm's Intellectual Property practice is well-positioned to meet clients' needs in managing their intellectual property portfolios on a local and regional basis.

This practice group is headed by [Brien de Gannes](#), an attorney-at-law with more than 40 years experience in intellectual property. He is Chairman of the Committee appointed by the Attorney General to review the country's Intellectual Property Laws and has worked together with WIPO and the relevant Government departments to draft and implement legislation consistent with the TRIPS Agreement. Brien was also a member of a Cabinet-appointed committee which formulated the national Intellectual Property Policy for Trinidad and Tobago.

registration, ruling that the company's behaviour was an 'obvious' and 'deliberate' copying of a "high-profile trademark".

The protection of well-known trademarks is not a new concept and can be found in the legal framework of many jurisdictions internationally, including that of Trinidad and Tobago under the *Trade Marks Act*, Chap. 82:81 (as amended).

Notwithstanding China's legislative update on the protection of well-known trademarks, western companies still struggle to have their trademarks upheld in China, Apple Inc.'s recent loss being one such example. One does wonder however, whether this recent Facebook ruling signals a change in China's attitude towards such companies, or whether it could be attributable to what some sources refer to as Facebook co-founder Mark Zuckerberg's charm offensive on China, for example his dedication to learning Mandarin.

Change in outlook or charm offensive aside, one key lesson to be learnt here is to never underestimate the importance of not only protecting, but also building your brand. What are you doing to build and protect yours?

N.B. This is not intended to be legal advice.



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ABOUT THE AUTHOR

A'isha Waldron, Attorney-at-Law, is an associate in J.D. Sellier's intellectual property department.

She advises clients on a range of contentious and non-contentious intellectual property matters including copyright protection, Customs border measures and trademark and copyright infringement and enforcement.

A'isha holds an LL.M. in Law & Corporate Governance achieved with merit, is a U.K. qualified Corporate Secretary and an Associate of the Institute of Chartered Secretaries and Administrators.

ABOUT J.D. SELLIER + CO.

J.D. Sellier + Co. was founded by Jean-Baptiste Denis Sellier who was admitted to practice as a Solicitor and Conveyancer in Trinidad and Tobago in 1882. He practiced on his own until 1916 when he invited his colleague and friend George Cecil Pantin to join him in a partnership.

Today, J.D. Sellier + Co. has expanded to approximately 25 attorneys-at-law and 77 employees and offers its clients quality legal services. Our clients include industrial, commercial and financial enterprises, domestic and foreign, public and private, ranging in size and complexity from small single location business enterprises to large diverse, multinational corporations.

Our firm is a general practice law firm specializing in four areas of civil practice, namely: Corporate + Commercial (including banking + finance; energy + regulated industries; probate; estate planning + administration; mergers + acquisitions; tax), Real Estate, Intellectual Property, and Litigation + Dispute Resolution (including admiralty + shipping).