

## IP UPDATE



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## Our Winning Story: Obtaining Trademark Registration for a Composite Mark with Indistinctive Word Element

As consumers tend to remember word marks that are suggestive or descriptive, many businesses adopt such marks for their goods and services. Quite often, the business would add distinctive stylization or logos to enhance the distinctiveness of the mark. However, registering such marks are difficult in China, whether on a prima facie basis or through use. This article discusses registrability of such marks on a prima facie basis.

The guidelines on examination of marks lacking distinctive elements are clearly stated the Trademark Examination Guidelines - if a mark is made up of non-distinctive elements and other elements, and the general public cannot identify the provider of the relevant goods or services, the applied-for mark should not be registered. However, the applied-for mark is registrable if other elements or the mark as a whole is distinctive. In practice, the examination standard of such marks is still subjective and unpredictable.

Recently, we have successfully obtained trademark registration for  on "Education services, namely, providing non-downloadable webinars in the field of alternative investment analysis". The application was initially refused under Article 11(2) of the Trademark Law by both the Chinese Trademark Office (CTMO) and the Chinese Trademark Review and Adjudication Board (TRAB) for the reason that the word part "Fundamentals of Alternative Investments" (the "English Element") is descriptive of the content of the designated services in class 41. However, this was later overturned at the Beijing Intellectual Property Court, which is further affirmed by the Beijing High Court.

The High Court clarifies that Article 11(2) forbids the situation where the mark as a whole would easily represent and refer to

the quality, ingredients and functions of the designated goods and services, without the need for consumers to interpret, infer or associate. The Examiners should avoid separating the mark into different parts.

Although the High Court too found that the English Element of the mark is descriptive of the services applied-for, it made the final decision that the device of the mark is highly stylized and gives the subject mark the required distinctiveness as a whole for registration.

### Take away

Businesses would remain hopeful to register their marks with indistinctive words in China. Businesses may add a logo to enhance the overall distinctiveness of the mark.