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## NEWSLETTER

issue 05 . 2019

### IP UPDATE



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## Protecting Your App Names in China

With the number of mobile apps on the rise, designing a unique and striking app name and icon is crucial for app developers to set their innovations apart from others in the marketplace. A strong app name can give the app a competitive edge amongst constantly emerging apps providing similar services, and registering the app name as a trademark becomes central to the app's continued success as it gains influence.

### I. REGISTERING YOUR APP NAMES AS TRADEMARKS

Proactively registering your app name as trademark in the relevant countries is crucial in keeping other traders from free-riding on the success of your app. While app platforms generally do not conduct name conflict checks before approving an app to list on their platforms, having a trademark registration is a powerful tool in proving your prior rights if others copy your name.

### II. WHAT TO REGISTER FOR?

An app usually has more than one indicator of origin. The app name is often relatively descriptive, so that the app would be searchable when users look for apps with certain specific function. Accordingly, many apps have (1) relatively short and descriptive name; (2) a full name; (3) logo displayed on the phone.

App developers are encouraged to register all different forms of their trademarks for full protection, in case free riders merely copy one form of the trademarks, such as the logo but not the name. While many full names of apps contain a slogan, slogans remain difficult to be accepted for registration in China.

### III. WHICH GOODS/ SERVICES TO REGISTER FOR?

The goods and services associated with mobile apps may fall into multiple classes. In general, trademarks which are used in relation to application software or downloadable software should be registered in Class 9. It is also common to apply for registration under Class 42 which covers "development of computer software" as a service. More and more cases suggest that the app developers need to register on the exact nature and function of the services which the app provides, as apps are increasingly seen as a way to provide services of different nature, instead of a type of service of its own. For instance, instant messaging apps are protected under Class 38 which covers "electronic exchange of voice, data, audio, video, text and graphics accessible via computer and telecommunications networks", while apps facilitating ride sharing are protected under Class 39, apps on financial information are protected under Class 36, and reading apps such as Kindle are covered by "publication of electronic books, newspapers, magazines, journals and blogs" under Class 41. Only with the correct coverage would the court protect your app name from infringement.

#### IV. WHEN TO REGISTER?

As many of the app names are relatively simple and descriptive, if one app developer selected and used the name, other app owners may be left with very few choices. Also, there is a risk of having a name becoming generic through use.

By filing a trademark application as early as possible in your development process, and enforcing against copycats, you are protecting your hard work and potential revenue.

#### V. ENFORCING YOUR TRADEMARK RIGHTS

One way to protect your app name from infringement is to collaborate with app distribution platforms. Platforms such as Google Play, Xiaomi App Store and Baidu operate an online complaint mechanism which allows app developers to report and take down infringing activities. While the procedures for each app platform differs, having a trademark registration in the jurisdiction is a pre-requisite.

It is also paramount to obtain notarized evidence of the alleged infringement. Such evidence includes notarized screenshots of the infringing apps' pages and proof of ownership. Since the Chinese administrative authorities and IP courts usually only accept notarized and translated (if the evidence is in foreign language) evidence, you should make sure that such documents are in place if you wish to take the matter further to the court and to seek compensation.

Potential app developers should be mindful of protecting their innovation when entering the Chinese market. Registering your app name as trademark is a good way in extending the reach of your brand and preventing copycats from piggybacking on the success of your app.