

The GDPR and WHOIS

Following the introduction of the General Data Protection Regulation (GDPR) on 25 May 2018, the Internet Corporation for Assigned Names and Numbers (ICANN), which is the organisation responsible for coordinating the maintenance and procedures of numerous internet databases relating to domain name registrations, has issued a “proposed interim model” regarding how personal information is to be stored and what data should be open and publicly available on WHOIS databases.

WHOIS data is incredibly useful for intellectual property holders and their professional representatives. This data is used in conducting trade mark enforcement investigations, for sending cease and desist letters, for communicating with the registrants, for preparing and prosecuting domain name disputes/complaints, and in general to protect the interests of intellectual property owners, of consumers as well as law enforcement authorities in order to try to keep the Internet safe from security breaches and other nefarious/criminal behaviour.

However, under the ICANN’s currently proposed model, public access to the WHOIS data will be severely restricted. If adopted, such a restriction is likely to impact the interests of the intellectual property owners, of consumers, as well as the safety of the Internet.

The GDPR and WHOIS (cont)

Several intellectual property associations are working together to advocate for:

1. The retention of the current WHOIS system, or at least;
2. The development of an accreditation program that is simple and accommodates the legitimate rights and interests of intellectual property owners and their representatives;
3. An interim system that will not restrict the functioning of the domain name dispute/complaint procedures.

Until ICANN's model is finalised and implemented, our recommendation, if important data is restricted/unavailable but is vital to progress with a domain name dispute or infringement matter, is to consider instructing commercial investigators or raising the issue directly with the domain name registrar.

We will continue to monitor for further developments. Please keep an eye out for our future reports on this matter.

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In this edition of Distinguishing Marks we are delighted to be publishing an article kindly written for us by our good friends Jimmy Huang and Tracy Liu of Zhong Lun Law Firm focusing on important considerations for the Chinese market.

Key tactics for protecting trademarks in China

According to the China Trademark and Brand Strategy and Development Annual Report 2017 (published May 2018) there were a total of 5,748,000 trademark applications filed in 2017, with a 55 per cent year-on-year growth. This means that it will be more and more difficult for enterprises to successfully obtain new trademark registrations in China, in view of the increasing number of prior marks as applied and registered.

Here are some useful tactics to take now to protect foreign brands in China.

1. Top priority in China: Filing applications as soon as possible

Even though there are an increasing number of trademark applications filed in China, we usually suggest filing new applications as a first step before entering into Chinese markets. Unlike other jurisdictions such as the US, China does not require actual use/intention to use as a compulsory condition when applying for the new trademarks. Moreover, filing new applications for registration as soon as possible is also beneficial to set a priority day against any subsequent identical/similar applications by third parties (especially against trademark hijackers). As a member of the Paris Convention, the six-month priority period applies in China, which is essential to protect the position of foreign companies.

Key tactics for protecting trademarks in China

2. Importance of Chinese character marks

Remembering the cases of NEW BALANCE, VIAGRA and CASTEL, except for the pre-emptive registration issue, such precedents enlightened us a lot on the importance of Chinese character marks in China. Since the Chinese version mark would be more convenient for the Chinese consumers to recognize, it would be easier and more effective to promote a foreign brand together with its corresponding Chinese name in the Chinese market. Normally, the Chinese version mark can be either a translation or phonetic version (namely transliteration) of its foreign brand. Even if the brand owner does not adopt an official Chinese version mark, if a brand becomes more popular in China, the public usually will create one which will also play the role of a trademark. As result, it is always advisable for foreign brand owners to create and register a Chinese version mark proactively, educate the market and preserve their rights.

Key tactics for protecting trademarks in China

3. A secret weapon of Copyright protection

As China uses the Nice classification system, it is subject to goods/services classification when securing trademark registration and clearing prior obstacles. Legitimate trademark owners may get bothered by the pre-emptive registrations, especially for those marks copied directly from the logo, but applied to goods/services that are far different from the goods of concern. For example, it would be very difficult to claim the prior right for a trademark registered and used on “whisky” in class 33, against a squatted trademark on “clothing” in class 25. However, thanks to those trademark squatters who copy logos directly, we can rely on a good weapon – copyright claim – to break through the boundary between goods/services that are not in conflict under the current practice in China. It is also said that copyright registrations are “Super Trademarks” that are even better than well-known trademarks against trademark squatters in China. To this end, evidence, as the key part, shall be sufficient at least in proving the original creation of the work and prior date of publication. In most cases, a copyright registration certificate in China will ease the process of evidence collection.

Many thanks to our guest authors:

Jimmy Huang and Tracy Liu



Renewing your trade mark registrations – the expert approach

Making sensible decisions about renewing your trade mark registrations in the context of how your business, your products and your markets may be changing and developing is essential to brand protection

Trade marks can often be renewed without thinking clearly about the potential future strategy of your business and how your trade mark protection may need to evolve. It is becoming common to outsource this specialist task to companies which have no knowledge of the business of the trade mark owner.

The Wildbore Team approach every renewal and review of trade marks with full regard to your business needs and how those may change. We have found that this approach is a more effective way of maintaining a trade mark portfolio.

At Wildbore & Gibbons LLP we have a specialist dedicated **Renewals Team** led by a professional manager - **Marie Bolam**.

Our dedicated renewals team will always be happy to advise you of the best way to protect your brands as your business develops.

For further information and a review of your trade marks please contact Marie.

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