



The Trademark Prosecution Review

2025

**Best practices for protecting
trademarks containing geographical
names in China**

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The second edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

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Best practices for protecting trademarks containing geographical names in China

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IN SUMMARY

The topic of whether trademarks containing geographical names can be registered, and the scope of protection after registration has always been a hotly debated issue. For businesses, incorporating geographical names (especially foreign ones) into their trademarks can signify quality, culture or location, boosting market appeal and consumer interest. However, authorities must balance rights protection with market fairness and prevent consumer confusion. In January 2023, the China National Intellectual Property Administration of China (CNIPA) issued Guidance on the Registration and Use of Trademarks Containing Geographical Names, which clarifies prohibitions, risks and rights limits for such trademarks, emphasising honesty and preventing rights abuse. This article, based on those guidelines and examination practices, analyses the registrability of trademarks containing foreign geographical names, tips to increase the chances of registration and post-registration protection scope to aid businesses in China's trademark strategies.

DISCUSSION POINTS

- Current examination practices for trademarks containing foreign geographical names
 - Strategies for obtaining registration of trademarks containing foreign geographical names
 - Rights boundaries of trademarks containing foreign geographical names after registration
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REFERENCED IN THIS ARTICLE

- Guidance on the Registration and Use of Trademarks Containing Geographical Names
 - Trademark Examination and Adjudication Guidance (2021)
 - Trademark Law
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INTRODUCTION

Geographical names are labels for specific places, used to indicate location or direction. They are public resources, owned collectively by a region's members, and are essential for identifying and distinguishing locations such as Beijing, Paris and New York. Registered trademarks are those officially approved by trademark authorities under applicable laws. Registration grants the owner exclusive use of the trademark and the right to stop others from using identical/similar marks for identical/similar goods or services. Clearly, trademarks containing geographical names involve a delicate balance between public resources and private rights. Determining whether a trademark containing a geographical name can be registered requires authorities to consider the balance between public and private interests.

CURRENT EXAMINATION PRACTICES FOR TRADEMARKS CONTAINING FOREIGN GEOGRAPHICAL NAMES

According to article 10(2) of the Trademark Law:

Names of administrative divisions at or above the county level or well-known foreign geographical names shall not be used as trademarks. However, this shall not apply if the geographical name has other meanings or is part of a collective trademark or certification trademark. Registered trademarks containing geographical names shall remain valid.

The Trademark Examination and Adjudication Guidance (2021) defines 'well-known foreign geographical names' as those known to the Chinese public, including the full names, abbreviations, foreign names and commonly used Chinese translations of geographical names from other countries and regions.

The concept of 'well known' is dynamic and evolving. Factors considered include: (1) dictionary definitions; (2) whether the foreign geographical name has been widely disseminated through mass media such as publishing, the internet, broadcasting, and film and television within a certain period, making it easily recognisable by the Chinese public; and (3) the actual usage of the foreign geographical name by trademark applicants.

In January 2023, the CNIPA issued the Guidance on Registration and Use of Trademarks Containing Geographical Names (the 2023 Guidance). This Guidance further clarifies the prohibitions, stability risks and rights boundaries of trademarks containing geographical names, guiding trademark applicants and users to adhere to principles of honesty and good faith, and preventing the abuse of rights when applying for and using trademarks. The 2023 Guidance identifies three scenarios involving foreign geographical names:

- Well-known foreign geographical names: examples include Havana (capital city of Cuba), Massachusetts (the state of Massachusetts in the United States), Florence (a famous tourist destination in Italy), etc.
- Foreign geographical names known for producing specific goods or services: this refers to foreign geographical names not known to the general Chinese public but whose corresponding regions are famous for producing certain goods or providing specific services. An example is 伊豆 (Izu) (Imabari, a city in Japan), which is used in trademarks for textile towels and blankets. Imabari has the highest towel production in Japan, enjoying a certain degree of popularity among relevant consumers.
- Names of religious activity locations or venues: an example is Mecca (the holy city of Mecca in Islam).

The prohibition of the use of the aforementioned foreign geographical names is due to the following considerations:

- Geographical names directly indicate the origin of goods or services, making it difficult for them to function as identifiers of the source of products or services.
- Geographical names that do not match the actual origin of goods or services can mislead and deceive consumers.
- To prevent the monopoly of public resources by private rights, the scope of trademark rights cannot extend to public domains such as well-known geographical names.

Based on current examination practices, the CNIPA adopts a strict standard for examining absolute grounds for rejection. Generally, if examiners determine that a trademark contains any of the aforementioned foreign geographical names, the trademark is likely to be rejected during the initial examination stage. Moreover, due to the prohibitive nature of article 10 of the Trademark Law, the trademark cannot be used in the market. This represents a very strict regulatory measure.

Trademarks such as Prada Milano, Trinny London, Royal Delft 1653 and 24h Le Mans have been rejected in the initial examination stage due to the inclusion of foreign geographical names.

HOW TO INCREASE THE CHANCES OF REGISTERING TRADEMARKS CONTAINING FOREIGN GEOGRAPHICAL NAMES

Are all trademarks containing foreign geographical names that are rejected necessarily unregistrable? No.

If a trademark application is rejected in China, the applicant can request a review and challenge the refusal decision within a specified time frame. Following review, they can take the matter to court to dispute the decision, seeking a judicial review of the trademark's registrability.

So, what types of trademarks containing foreign geographical names may have a chance of being registered through the review or litigation process?

As per article 10(2) of the Trademark Law: 'However, this shall not apply if the geographical name has other meanings or is part of a collective trademark or certification trademark.'

Article 6 of the Supreme People's Court's Interpretation on Several Issues Concerning the Trial of Administrative Cases Involving the Authorisation and Confirmation of Trademarks (Fashi (2017) No. 2) states:

If a trademark consists of the name of an administrative division at or above the county level, a well-known foreign geographical name, and other elements, and has a meaning distinct from the geographical name as a whole, the people's court shall determine that it does not fall under the circumstances specified in Article 10(2) of the Trademark Law.

According to the Trademark Examination and Adjudication Guidance, a geographical name with alternative meanings is one that carries a clear and more significant meaning as a word than as a geographical identifier, without causing confusion.

The 2023 Guidance also mentions that the prohibitions on registering trademarks containing geographical names include the following exceptions: the geographical name contained in the trademark is independent of other elements with distinctive features, and the geographical name only serves to indicate the applicant's location.

In practice, the applicant may consider the following aspects.

How Well Known The Foreign Geographical Name Is

If the foreign geographical name is not widely known among the Chinese public or is not famous for producing certain goods or providing specific services, the trademark remains registrable.

For Case No. (2011) GaoXingZhongZi 384, regarding the refusal to review Mark No. 5356237 'SHIMIZU and device', the Beijing High People's Court ruled that the trademark contained 'SHIMIZU'. The Trademark Review and Adjudication Board (TRAB) cited the English–Chinese Dictionary to prove that 'SHIMIZU' refers to the city name in Japan. However, due to language differences, the Chinese public generally does not recognise 'SHIMIZU' as a geographical name in Japan, and existing evidence is insufficient to prove that SHIMIZU as a Japanese geographical name is widely known among the Chinese public.

Trademark No. 69159007 'LANCASTER GOLDEN LIFT' (containing the geographical name Lancaster) was also registered after argument based on similar reason.

Therefore, for trademarks rejected for containing geographical names, the starting point may be the relatively low degree of awareness of the geographical name.

Whether The Chinese Public Knows The Foreign Geographical Name In Its Foreign Language Or Chinese Translation

For foreign geographical names, the applicant may consider whether the Chinese public is familiar with the English or Chinese expressions of the geographical name. Some foreign geographical names may be known to the Chinese public in their Chinese translations but not in their English expressions. This does not preclude the English expression from being registered as a trademark, or vice versa.

For Case No. (2012) GaoXingZhongZi No.1001, regarding the refusal review of Trademark No. G980884 'ZURICH HELPPPOINT', the Beijing High People's Court ruled that, if the Chinese public knows the Chinese translation of the foreign geographical name but not the English expression, the English expression is not prohibited from use or registration as a trademark. Regarding the disputed mark, although the name 'ZURICH' corresponds to the Chinese translation '瑞 士 瑞 旗' which is known to the Chinese public, the English name per se is not widely recognised by the Chinese public. Therefore, the first instance court correctly determined that the trademark application did not violate the provisions of article 10(2) of the Trademark Law and had registrability.

Whether The Trademark Contains Other Elements And Whether It Has A Different Meaning As A Whole

In practice, most trademarks rejected for containing geographical names consist of a geographical name and other elements. In such cases, if the trademark gains distinctiveness through the addition of other elements and no longer only has the meaning of a geographical name or primarily conveys a geographical name, it should not be deemed unregistrable solely due to the inclusion of a foreign geographical name.

According to the Trademark Examination and Adjudication Guidance, trademarks consisting of well-known foreign geographical names and other characters shall not be excluded from registration if they have a different meaning as a whole and their use on the designated goods or services will not lead to public confusion regarding the origin of the goods, for example 'London Fog' (Class 18: briefcases; umbrellas) (*London fog is a natural phenomenon).

For Case No. (2019) JingXingZhong No. 5319, regarding the refusal review of Mark No. 22790153 'VIRGINIABLU', the Beijing High Court held that the disputed trademark

'VIRGINIABLU' is a coined word with no fixed meaning. Although 'VIRGINIA' in the disputed trademark refers to the state of Virginia, the Chinese public does not easily recognise the individual spelling of Virginia in the disputed trademark. Therefore, the first instance court correctly determined that the disputed trademark did not constitute a violation of the provisions of article 10(2) of the Trademark Law.

On the other hand, if a trademark includes other elements but fails to form a meaning distinct from the geographical name as a whole, it remains unregistrable.

For Case No. (2019) JingXingZhong No. 8165, regarding the refusal review of Trademark No. 25834778 '碧山里昂' (Bishan Lison & Lyon' in Chinese), the courts ruled that, although the trademark includes several other elements and the characters 'Lyon' are located at the end, the trademark as a whole did not form a meaning distinct from the geographical name. Therefore, both the first instance and second instance courts held that the registration of the disputed trademark constituted the circumstances specified in article 10(2) of the Trademark Law, prohibiting its use as a trademark.

Whether The Trademark Has Been Used To Distinguish It From The Geographical Name

The essential purpose of a trademark is to distinguish the source of goods or services. If a trademark containing a geographical name has been used to develop a secondary meaning that enables the public to distinguish the source of the product, it can be registered. Therefore, whether a trademark containing a geographical name has developed a secondary meaning through use is also a key consideration.

For Case No. (2013) GaoXingZhongZi No. 884, regarding the refusal review of the Trademark IR No. 1024730 'Munich RE and device', the Beijing High Court ruled that the disputed trademark consists of 'Munich Re' and a device. Considering that the English name of the applicant is 'Munich Reinsurance Company' and its business is reinsurance for insurers, as well as the evidence in the case, the relevant public does not view the disputed trademark solely as a geographical name. Therefore, although the application trademark contains the characters of a geographical name, the addition of other elements has created a meaning distinct from the geographical name as a whole.

Upon research, many trademarks have been successfully registered by arguing on similar grounds, including:

- Trademark No. 22350425 'GARDNER DENVER PUREAIR' (including the geographical name DENVER); and
- Trademark No. 30287287 '巴黎' (the first two characters mean 'Paris').

Whether The Trademark Contains Other Elements And The Geographical Name Only Serves To Indicate The Applicant's Location

If the disputed trademark contains a geographical name that is independent of other marks with distinct characteristics and only serves to truthfully indicate the location of the applicant, it can also be argued for its registrability.

Examples in the Trademark Examination and Adjudication Guidance include:

- Raymond Weil Geneve (the registrant is located in Geneve, Switzerland); and
- Ambregris Paris (the registrant is located in Paris, France).

In the trademark case '24h Le Mans' represented by the author, the CNIPA determined that, despite 'Le Mans' being a well-known foreign geographical name, the mark could be registered because the applicant was from Le Mans, France. The geographical name served solely to indicate the applicant's location, not falling under the circumstances of article 10(2) of the Trademark Law. Consequently, the trademark was successfully registered and protected in China.

BOUNDARIES OF RIGHTS PROTECTION FOR TRADEMARKS CONTAINING FOREIGN GEOGRAPHICAL NAMES

After the registration of a trademark containing a geographical name, does this mean that everything is fine and the trademark holder has absolute exclusivity protection? No.

Upon registration, the trademark owner gains exclusive rights, allowing them to use, license, transfer and renew the mark for specific goods or services. They can also prevent unauthorised use of the same or similar marks on identical or related products.

However, the exclusivity of trademarks containing geographical names is subject to certain limitations due to their public nature. This restriction aims to balance interests, promote fair competition and maintain economic order.

According to article 59 of the Trademark Law, the registrant of a registered trademark has no right to prohibit others from using the trademark in a proper manner if it contains a geographical name.

The 2023 Guidance contains the following information.

- The trademark registrant should use the registered trademark in accordance with the approved trademark symbol and designated goods or services. The use should not alter, highlight, simplify, add to, deform or split the geographical name portion of the trademark without authorisation. If the use needs to extend beyond the designated scope of goods or services, or if there is a need to change the trademark symbol, a separate application should be submitted.
- The trademark registrant should exercise and maintain their rights in accordance with principles of honesty and good faith and the principle that rights should not be abused. The use of a relevant geographical name as a non-trademark meaning to indicate geographical origin should be considered a justified use, and the registrant has no right to prohibit it based on the similarity of the geographical name to the one in their registered trademark.
- Other market participants should respect the exclusive rights of registered trademarks and use the geographical name in a way that does not exceed the 'justified and reasonable' boundaries. When using the geographical name in a registered trademark, it should be limited to a non-trademark meaning to indicate geographical origin and should not ride on the reputation of others' trademarks, confuse the source of goods or services or use a non-geographical origin place name, to avoid misleading the public.
- Parties should avoid transferring a trademark containing a geographical name to an assignee who will actually use it in a way that could lead to confusion about the origin or source.

Therefore, in practice, if others use a geographical name to describe or introduce geographical location or environment, and not as a trademark to distinguish the source of products, even if the geographical name is included in the registrant's registered trademark, others are fully entitled to use the name in a reasonable manner.

For Case No. (2019) YueMinZhong No. 1597, Company A claimed trademark infringement by Company B, alleging unauthorised use of the Chinese translation of 'Fontainebleau' on hotel signage, brochures and other materials, on the basis of its earlier registered trademarks '凤丹凤 Bailu & device' and '凤丹凤 Bailu' (similar to Fengdan Bailu, which is the Chinese translation of Fontainebleau).

The second instance court held that 'Fengdan Bailu' is the Chinese translation of the famous French historical, cultural and tourist town Fontainebleau. They are well known in both France and China and have become public resources that cannot be monopolised by individuals. The main part of the alleged infringing mark, the French part, is identical to the famous French geographical name 'Fontainebleau', and the Chinese part is a complete translation of the French name. Other elements of the alleged infringing mark are not the same as nor similar to the registered trademarks. Therefore, Company A has no right to prohibit others from using the foreign geographical name Fontainebleau in Chinese in a proper manner, and Company B's use of the alleged infringing mark does not infringe on Company A's registered trademark rights.

However, the legitimate use of a geographical name contained in other parties' registered marks requires the public to recognise it as a location, not as another party's trademark. The use should be in good faith and within reasonable limits. If it is overused, the trademark owner is still entitled to take action to protect their rights.

For Case No. 2019 JinMinZhong No. 577, the court ruled that Shanxi Chaoniu Company's prominent use of 'Xiaolongkan' on various store elements constituted trademark use, as it served to identify the source of goods or services, despite the company's argument that 'Xiaolongkan' is a geographical name.

CONCLUSION

Every sword possesses two blades, and the registration of trademarks that incorporate foreign geographical names is also characterised by a balance of dual rights. For enterprises, the initial stage of applying for trademarks containing geographical names requires proactive preparation and strategic planning. Following successful registration, it is essential to engage in subsequent rights protection efforts to strike a balance between rights and responsibilities, to strategically plan ahead, and this approach holds significant practical value.



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