

# Why a Chinese Company Must File a United States Trademark with the United States Patent and Trademark Office

## Protecting Chinese Brands in the United States

Every Chinese business knows that the biggest names in China are protected through the Chinese trademark system. These companies go to great lengths to maintain that protection. What many Chinese companies are learning – often the hard way – is that the smartest Chinese brands also file for trademark protection in the United States. Brands like Tencent<sup>1</sup> and Baidu<sup>2</sup>, along with other major Chinese brands, maintain strong US market protection by filing trademarks through the United States Patent & Trademark Office (USPTO).

Despite trade tariffs, an increasing number of Chinese companies are exporting their brands to the United States, making it more important than ever to own the brand. More than a manufacturing center, China is a vibrant and thriving export economy. Dunlap Bennett & Ludwig, the #1 firm in the United States for trademark registrations in 2018,<sup>3</sup> has an office in Beijing and a team of both US and Chinese attorneys ready to assist with all United States trademark filings for Chinese companies.

## What is the difference between the United States Trademark System and the Chinese Trademark System?

China's trademark law states that whoever has filed the first trademark application (according to the stipulations under the People's Republic of China applicable trademark laws) will be granted the trademark rights. In the United States, however, it is different. Under United States trademark law, trademark rights are based on business practices and use of the trademark in commerce; instead of the first filer having all the

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<sup>1</sup> US Registration Numbers 5558151, 5500137, 5456071

<sup>2</sup> US Registration Numbers 5831432, 5617568, 5617567

<sup>3</sup> Dunlap Bennett & Ludwig has had more than 1,400 *successful* US trademark registrations in 2018 alone!

rights, the first user normally has the rights. This is subject, however, to several complicating factors. The attorneys at Dunlap Bennett & Ludwig can help Chinese companies navigate these complications and obtain the trademark rights they need.

United States trademark law provides for additional rights that can benefit Chinese companies and brand owners. For example, a company can register a trademark *before* it begins using the mark by making a special reservation under the “intent to use” system; this can be done as early as three years before the owner begins using the mark. The “intent to use” provision makes it extremely important for a Chinese company to file early in the planning stages. Additionally, under the United States trademark system, a registered trademark becomes legally incontestable after it has been officially registered for a 5-year period; at that point, the trademark is immune from challenges from any third party.

## New Rule Prohibiting Chinese Companies from Filing Their Own Trademarks

A new USPTO rule announced July 2, 2019, requires that *all* foreign-domiciled trademark applicants/registrants be represented by a licensed US attorney for any Trademark Trial and Appeal Board proceedings. Located in Washington DC, just a few miles from the USPTO, Dunlap Bennett & Ludwig’s US trademark team works closely with their Beijing partner lawyers to ensure smooth communication with their Chinese clients and to make the process of managing and filing trademarks in the United States easy for Chinese companies.

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*Call today to let Dunlap Bennett & Ludwig help defend your trademark, respond to a trademark lawsuit in the United States, or file your United States trademark. Local language, global lawyers.*

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