

Research On the Protection of Trademark Rights in Intangible Cultural Heritage Names

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Abstract: As an important part of human culture, intangible cultural heritage plays an important role in maintaining and developing cultural diversity. China, as one of the four ancient civilizations, is faced with protection problems while possessing numerous intangible cultural heritages. Under the existing trademark right protection system, there are disputes over the subject of trademark registration between multiple practitioners of the same industry in the same region, and the registration of trademarks of non-heritage names. Therefore, in this case, regulating unfair competition through the prior application exclusion mechanism has become one of the solutions.

Keywords: Intangible Cultural Heritage; Trademark Exclusivity; Trademark Registration; Prior Exclusion Mechanism

1. Case Brief

1.1 Background of the Case

Xinjiang was known as Jiangzhou in ancient times, and as the only pottery inkstone among the four famous inkstones in ancient China, the history of its production can be traced back to the Western Han Dynasty, and flourished in the Tang and Song dynasties. Due to historical reasons, the production technology of Chengni ink stone was basically lost at the end of Ming Dynasty and the beginning of Qing Dynasty, and the father and son of Lin Yongmao and Lin Tao of Xinjiang County finally restored the production technology of Chengni inkstone after several years of dedicated research and repeated experiments. In 1997, the Xinjiang County Jiangzhou Clay Inkstone Research Institute of Shanxi Province applied to the Trademark Office of the State Administration for Industry and Commerce for the approval of the registration of the trademark "Jiangzhou",

with the approved use of commodities in the 16th category. Jiangyiyuan Inkstone Company and its legal representative Wang Xueren applied to the Trademark Office of the State Administration for Industry and Commerce for the approval of the registration of the trademark of "Jiangyiyuan" in 2003, with the approved use of the goods in the 16th class. In addition, before the registration of the trademark "Jiangyiyuan", the inkstone and ink slab products produced by Jiangyiyuan Inkstone Society did not use any other trademarks that had been approved for registration.

1.2. Case Analysis

In (2006) Jinmin Final No. 00196, the court ruled that: Jiangyiyuan Inkstone Company used "Jiangzhou Chengyi Inkstone" a lot for publicity, which objectively caused the ordinary consumers who received the information to think that the Chengni Inkstone products of Jiangyiyuan Inkstone Company produced in Xin Jiang County were Chengni Inkstones, weakening the specificity of the use of "Jiangzhou" as a registered trademark, especially a well-known trademark. "Jiangzhou" has weakened the specificity of the use of "Jiangzhou" as a registered trademark, especially a well-known trademark. Although Jiangzhou is an ancient place name, after the Jiangzhou Clay Inkstone Research Institute was approved to obtain the exclusive right to use the trademark "Jiangzhou" according to the law, other people will be subject to certain limitations when using the title of Jiangzhou. The well-knownness of the trademark "Jiangzhou" determines that the restriction should be more strict. Although Jiangyiyuan Inkstone Company has registered the trademark of "Jiangyiyuan", it uses a lot of "Jiangzhou four treasures", "China Jiangzhou" and "Shanxi Jiangzhou" in the package of its inkstone products, advertisement and

commodity decoration. "" Shanxi Jiangzhou" and other words of Jiangzhou, which is sufficient to cause the relevant public to misidentify its similar products with those of the Jiangzhou Chengni ink stone development institute. Subsequently, the Supreme People's Court further held in its Judgment No. 6 (2014) that, taking into account the market share of the goods using the trademark "Jiangzhou", the sales area, the profits and taxes, the duration of the continuous use of the trademark, the manner, duration and extent of the publicity or promotional activities of the trademark, the capital investment and the geographic scope, and the fact that the trademark was protected as a well-known trademark, it is sufficient to cause the relevant public to misidentify the products as similar to those of Jiangzhou Clay Inkstones Development Institute. The Research and Development Institute of Clay Inkstones started to use the logo of "Lin's Jiangzhou Clay Inkstones" on inkstone products in 1994 at the latest, as it has a record of being protected as a well-known trademark. The Jiangyiyuan Inkstone Company constitutes an infringement of the registered trademark of the Jiangzhou Clay Inkstone Research Institute. Meanwhile, the Supreme People's Court held that to determine whether the opposed trademark constitutes a situation of non-registration as stipulated in Article 13(2) of the Trademark Law, the date of filing of the opposed trademark application should be taken as the point of time. To determine whether the cited trademark has been well-known before the filing date of the opposed trademark, evidence proving the cited trademark's popularity after the filing date of the opposed trademark can be used as reference. Although the filing date of the opposed trademark was April 9, 2002, the cited trademark was recognized as famous trademark and well-known trademark in Shanxi Province from 2003 to 2006 successively. Although the cited trademark was later than the registration date of the opposed trademark, the cited trademark was recognized as a famous trademark in Shanxi Province in the year following the application date of the opposed trademark, which further proves that the cited trademark had gained high reputation before the application date of the opposed trademark. At the same time, taking into account the fact

that the goods using the cited trademark have been praised by all walks of life, have a high reputation in the market, and have been infringed many times, it can be considered that the cited trademark has already reached the popularity that a well-known trademark should have. Therefore, the opposed trademark constitutes the unregistrable situation stipulated in Article 13(2) of the Trademark Law.

On the question of whether the opposed trademark constitutes a situation of non-registration as stipulated in Article 31 of the Trademark Law, the Supreme People's Court held that: according to the available evidence, the Research Institute of Chengni inkstone had started to use the cited trademark on the products of Chengni inkstone at least three years prior to the date of the application of the opposed trademark. Chengni ink stone is the only ceramic ink stone among the four famous ink stones, which is made of Chengni as raw material and fired by a special furnace. In terms of material properties, should be considered as Chengni inkstone belongs to pottery. Therefore, the actual use of the cited trademark inkstone and the opposed trademark designated goods are the same or similar goods. For the category of pottery, the cited trademark used by the research institute of ink stone is actually an unregistered trademark. However, the trademark has been awarded as famous trademark and recommended product in Yuncheng area, which was already highly recognized at that time. At the same time, combined with the relevant evidence shows that Jiangyiyuan Inkstone Company and its investor WangXueRen had been infringed upon the cited trademark and received administrative punishment, and issued an apology letter for this. Thus, it is known that Jiangyiyuan Inkstone Company applied for registration of the opposed trademark in the 21st class of "tile, pottery, imitation pottery" and other commodities, with obvious malicious intent. Although the above dispute between the two ended with the rejection of the registration application of Jiangyiyuan Inkstone Company, since 2020, Jiangyiyuan Inkstone Company has applied for registration of the trademark of "Jiangzhou Jiangyiyuan" in Classes 16, 20 and 35, and applied for registration of the trademark of "Jiangzhou Jiangyiyuan" in Class 20 for the goods of

antique furniture, worktops, etc. The trademark of "Jiangzhou Jiangyiyuan" was registered in Class 21 for the goods of "tiles, pottery and imitation pottery". The trademark of "Jiangzhou Jiangyiyuan" has been approved for registration. The scope of the trademark "Jiangzhou Jiangyiyuan" applied for by Jiangyiyuan Inkstone Company in Class 16 mainly includes paper, printed matter, drawings, calligraphy and painting engraved and printed works, brush holders, blocks of ink, ink slabs, seals (seals), seal boxes, brushes, and the scope of the trademark applied for registration in Class 35 service trademarks mainly includes providing buyers and sellers of goods and services with online marketplace, advertising, advertising agency, online advertising on computer networks, display of goods on communication media for retail purposes, outdoor advertising, organizing commercial or advertising exhibitions and fairs, selling for others, purchasing for others (purchasing goods or services for other businesses), marketing, etc. In this application, although JiangYiYuan Inkstone Society did not apply for registration with "JiangZhou" alone, it combined JiangZhou with its own enterprise name and actually used other people's registered trademarks prominently, and at the same time, it was difficult not to find that there was no suspicion of infringement with the JiangZhou Clarified Clay Inkstone Research and Development Institute selling the same kind of products. According to the second paragraph of Article 23 of the Judgment Standards for Trademark Infringement: "The prominent use of the name of an enterprise in the same or similar goods or services, which is similar to another person's registered trademark and is likely to lead to confusion, belongs to the trademark infringement as stipulated in the second paragraph of Article 57 of the Trademark Law".

In summary, in the same or similar goods or publicity and promotion, the other's registered trademark is prominently used, whether it belongs to the trademark infringement under Article 57 of the Trademark Law. At the same time, in the registered trademark name belongs to the background of ancient geographical names, the same area peer operators of the use of intangible cultural heritage name of the boundary standards is also worth discussing a problem.

2. The Realistic Dilemma of Trademark Rights Protection of Intangible Cultural Heritage Names

Summarizing the above cases, the main problems in the trademark protection of intangible cultural heritage names are as follows.

2.1 Conflict between the Non-uniqueness of the Subject of Non-genetic Inheritance and the Exclusive Right of Trademarks

Intangible cultural heritage is created by specific groups in long-term production practice, passed from generation to generation, the product of common wisdom, so the identification of the subject of the rights is the premise of the protection of intangible cultural heritage through the relevant system [1]. China has adopted a tacit attitude towards the registration of trademarks for the names of intangible cultural heritage, but the intangible cultural heritage itself represents a kind of public interest, and the registration and authorization of trademarks implies the privatization of the rights, which is incompatible with the status quo of the existence of intangible cultural heritage [2]. Its public interest is reflected in the intangible cultural heritage of the nation, region, country embodied in the cultural diversity and biodiversity of the significance and value of the habits, customs, concepts, etc., and its trademark registration is more to play a role in the identification of the source of the goods as well as the economic value. The intangible cultural heritage program itself has the uncertainty of the subject, but not everyone can register, because the main body of the intangible cultural heritage transmission and development is the community, group or individual who owns the intangible cultural heritage. If the intangible cultural heritage is only a single single or a single family inheritance, it may not exist trademark registration disputes this problem, but in the same area there are a number of practitioners of the same profession, the inheritor or the origin of the controversy or in a heritage subject will be the development of the intangible cultural heritage under the premise of the development and growth of the subject, the other relevant subjects follow the development of the grabbing commercial interests, what can be applied for registration

of trademarks as a qualified subject Trademark registration has become a new problem. Taking the above-mentioned Chengni inkstone as an example, the Jiangzhou Clay Inkstone Research Institute restored the Chengni inkstone production technology after years of efforts and vigorously promoted it to become a well-known trademark with certain popularity. Although Jiangzhou is an ancient place name, it meets the conditions for trademark registration and can be registered as a trademark. On the premise that Jiangzhou Chengni inkstone research institute has registered the trademark of "Jiangzhou", other subjects should also be avoided when using it, but Jiangyiyuan Inkstone Company follows suit, although it doesn't use the generic name of "Chengni inkstone", it prominently uses the trademark of "Jiangzhou" through its packaging, publicity and promotion methods. Although it does not use the generic name, it is easy to mislead consumers through the prominent use of symbols such as "Jiangzhou" in packaging and publicity and promotion.

2.2 Conflict of Boundaries between the Protection of Prior Rights in Non-Heritage Trademarks and the Protection of Similar Goods

Prior rights refer to the rights that have been legally acquired or legally enjoyed and legally protected by others before the applicant for a registered trademark files an application for a registered trademark. Although trademarks do not protect the production techniques and methods of intangible cultural heritage, trademarks can protect the legitimate rights and interests of the right holders. In the case of multiple practitioners in the same area, there are difficulties in protecting the prior rights of trademarks for the names of intangible cultural heritage. In the case of inkstones, for example, "inkstone" is the name of the practical function, while "inkstone" is the name of the material used for making the inkstone. The fact that "Jiangzhou" is an ancient place name does not affect the application for trademark registration. There are as many as 190 registered trademarks with "Jiangzhou" as a constituent element of the trademark, but after the "Jiangzhou" Chengni inkstone of the Chengni inkstone research institute has become a well-known trademark in the same kind of goods, the rest of the operators in the

same kind of business have the right to use the symbol "Jiangzhou", and the right to use the symbol "Jiangzhou" is also a right to use the symbol "Jiangzhou". The right of the remaining operators of the same kind to use the symbol "Jiangzhou" should also be subject to certain restrictions. Jiangyiyuan Inkstone Company applied for the trademark of "Jiangzhou Jiangyiyuan" on September 22, 2020 in the 16th class of goods and the 35th class of service marks respectively. Although Jiangyiyuan Inkstone Company has not applied for a single trademark on inkstone goods, the scope of its trademark application covers almost all stationery goods, and although it has changed the constituent elements of the registered trademark and the types of goods and added its enterprise name in the trademark name, the essence is still closely related to the use of inkstone goods. At the same time, in combination with its application for registration of Class 35 service mark promotion and publicity, is bound to cause confusion among the relevant public to a large extent.

Although Jiangyiyuan Inkstone Company added the enterprise name of "Jiangyiyuan" after the original registered trademark and wanted to publicize and promote the trademark through advertisement and other services, combining with its past behaviors and the comparison of the business types between the two inkstone producers, it is suspected that it has malicious competition and exploits the goodwill of others. Cross-category protection of well-known trademark refers to the trademark protection that when the trademark reaches well-known status, it can break through the class of goods or services in which the trademark was originally registered or used and prohibit others from using or registering the same or similar symbols as the well-known trademark in other goods or services that are not the same or similar [3]. The boundary of the scope of cross-category protection for well-known trademarks also has some issues to consider. Its scope should not be unlimitedly expanded nor limited to too small a scope. The definition of the class of registered trademark for the cross-class protection of well-known trademark should be defined in the scope that has certain close connection with the well-known trademark and is easy to cause the public to misunderstand. For example, the

Court of Justice of the European Union (CJEU) also pays attention to whether there is a competitive or complementary relationship between goods or services in the practice of judging "similar goods (services)" [4]. Competitive relationship means that goods are substitutable for each other, and complementarity means that one kind of goods is essential for the use of another kind of goods or services, and it is easy for consumers to misunderstand the origin of the two kinds of goods. In the seemingly different but the actual use of complementary goods on the registration of the use of the trademark has been disputed with the cited trademark, whether it also constitutes infringement? As mentioned above, Jiangyiyuan Inkstone Company applied for trademark registration in Class 16 and Class 35 goods and services by means of one mark for multiple classes, and at the same time, it also applied for registration of the trademark in Class 20 antique furniture, worktables, picture frames and other articles, and the application has been approved. Its application for registration of the trademark in the 20th class of goods did not cause others to oppose, to a large extent, also because the 20th class of goods and inkstone goods and inkstone-related goods do not have a close relationship between the source of the goods will not cause others to misidentify the source of the goods.

Intangible cultural heritage should not be used as a tool for profit-making, nor should it be victimized by malicious competition. The years-long dispute between the Jiangyiyuan Inkstone Society and the Jiangzhou Clay Inkstone Research Institute is not only detrimental to the development of commercialization of intangible cultural heritage, but also to the inheritance of intangible cultural heritage. Therefore, when registering a trademark, such problems can be circumvented by modifying the existing application process and rules.

2.3 Conflicts between the Judgment of Distinctiveness of Non-Religious Trademarks and the Demarcation of Generic Names

Generally speaking, distinctiveness refers to the "uniqueness" of a trademark [5], which includes not only the difference between the trademark and the descriptive and generic

signs of the goods on which the trademark is used, but also the difference with other trademarks for the same or similar goods. The distinctiveness of a trademark is divided into intrinsic distinctiveness and acquired distinctiveness, and acquired distinctiveness is mainly due to the use of the trademark, which makes the public give a second layer of meaning to a symbol in addition to the meaning of the symbol itself. The most important function of trademark distinctiveness is to tell people where the goods come from and what distinguishes them from goods of other similar producers. Generally speaking, the acquired distinctiveness is the real distinctiveness of the trademark. The reason why obtaining distinctiveness is the real distinctiveness of the goods is that it truly reflects or corresponds to the position of a trademark in the memory of consumers and the influence on consumer psychology. The biggest role of trademark distinctiveness is to tell people where the goods come from and what distinguishes them from goods of other similar producers. Trademark Examination and Trial Standards states that whether a trademark is distinctive or not should take into account the meaning, call and appearance of the sign itself, the goods designated for use, and the actual situation of the industry to which the goods designated for use belong. The goods designated for use of the trademark "Jiangzhou" of Jiangzhou Clay Inkstone Research Institute are inkstones, which has become a well-known trademark known to the relevant public after more than 20 years of publicity and promotion. As an operator of the same kind as Jiangzhou Clay Inkstone Research Institute, and against the background of several rejections of trademark registration, JiangYiYuan applied for the registration of commodity and service trademarks related to inkstone commodities with "Jiangzhou JiangYiYuan", which is inevitably suspected of malicious competition. At the same time, it is not possible to judge the geographical origin of the goods by the name of Jiangyiyuan alone, but the prominent use of the word "Jiangzhou" in packaging and publicity and promotion will largely lead to the misunderstanding of consumers about the origin of the products.

2.4 Conflict between the Distinctiveness of Intangible Cultural Heritage Trademarks and the Criteria for Defining Generic Names

China's existing trademark registration examination and approval procedures are mainly divided into four major steps: formal examination, substantive examination, preliminary examination and announcement of trademark opposition, and approval of registration. In the formal examination, formalities, forms and other external conditions are mainly examined, and specific information is not examined. In the substantive examination, the trademark will be examined whether it conforms to the substantive conditions stipulated in the Trademark Law. However, according to the Trademark Law, the Trademark Office shall complete the examination of the trademark registration application within nine months from the date of receipt of the application documents. The current Trademark Law stipulates that the opposition period for trademark registration in China shall be 3 months from the date of announcement of preliminary examination, and the Trademark Office shall hear the opposer and the opposing party state the facts and reasons, and after investigation and verification, make a decision on whether to grant the registration within 12 months from the date of expiration of the announcement, and if there is a need to extend the period under special circumstances, it can be extended by 6 months upon approval. If the opposer is not satisfied, he/she may apply to the Trademark Review and Adjudication Board for a review. If the opposer is not satisfied with the decision of the Trademark Review and Adjudication Board, he/she may file a lawsuit with the People's Court, which shall notify the opposer to participate as a third party.

In the existing trademark examination and opposition review, only the relevant personnel of the Trademark Office conduct the examination, although the front-loaded opposition process can make up for the shortcomings of the trademark examination to a certain extent and improve the quality of the approved registered trademarks. However, it is more from the perspective of trademark judgment, and there is a certain information gap between it and the cultural authorities for

the protection of intangible cultural heritage, and the excessively long trademark opposition cycle prolongs the time of trademark registration and is not conducive to the protection of trademark rights of the opposer and the development of intellectual property rights of intangible cultural heritage.

3. Countermeasures and Suggestions for the Protection of Trademark Rights of Intangible Cultural Heritage

Summarizing the above issues, its main problems can be attributed to two aspects: firstly, the need to clarify the subject of the right to register trademarks of intangible cultural heritage and to strengthen the administrative protection; and secondly, the need to improve the mechanism of the application procedure for the registration of trademarks of intangible cultural heritage.

3.1 Clarifying the Scope of Subjects of Rights and Administrative Protection Responsibilities for the Registration of Intangible Cultural Heritage Trademarks

Intangible cultural heritage should neither be completely privatized nor lose its essence in commercial competition. Article 7 of the Intangible Cultural Heritage Law stipulates that the competent cultural authorities are the administrative authorities for the protection of intangible cultural heritage. Although provinces and cities have formulated relevant protection regulations, most of the contents of these regulations only emphasize and restate the Intangible Cultural Heritage Law, and they do not have any specific and clear protection strategies for the protection of the existing intangible cultural heritage. Therefore, in the Trademark Law needs to increase the corresponding specific provisions to be clear. For the main body of the inheritance is clear, such as a single inheritance of intangible cultural heritage can be the main body of the inheritance directly apply for registration of trademarks, for the main body of the inheritance is not clear or there are disputes, you can apply for the registration of collective trademarks or certification trademarks.

In addition, in practice, very few government departments or collective organizations and other management types have raised objections to the aforementioned true one and manifested them in the corresponding legal

procedures, such as the opposition procedures at the stage of trademark registration or court proceedings [6]. Thus, it is also possible to consider the participation of cultural authorities in trademark examination or litigation activities involving intangible cultural heritage, for example, by giving them the corresponding authority to protect intangible cultural heritage through public interest litigation procedures.

3.2 Improving the Synergy of the Prior Examination Procedure for the Registration of Trademarks in Relation to Non-Legacy

Article 13 of the Intangible Cultural Heritage Law stipulates that the competent cultural authorities shall gain a comprehensive understanding of the intangible cultural heritage and establish an archive of the intangible cultural heritage and a relevant database. Therefore, it is possible to set up a database of trademark symbols of intangible cultural heritage, so that prior exclusion can be carried out when the relevant subject applies for trademark registration. For example, some scholars suggest that ICH can learn from the USPTO's NATI database system, and build a set of ICH symbols database, which can be used as the prohibited symbols database in the trademark examination [6]. This is because when the Trademark Office conducts substantive examination, it only examines the content of the rights related to intellectual property and does not examine the cultural background, and at the same time, the Trademark Office also lacks the information to determine whether a sign is an intangible cultural heritage symbol or whether it contains an intangible cultural heritage symbol, which results in the disorder of the utilization of trademarks for intangible cultural heritage symbols [6]. Therefore, on the premise of establishing a trademark symbol database of ICH names, relevant subjects can make prior inquiries and comparisons through the pre-examination system before trademark registration, and then proceed to the subsequent substantive examination. At the same time, we can consider utilizing the existing official website of intangible cultural heritage, regularly updating the progress of intangible cultural heritage protection, and combining with the existing query system of the Trademark Office website, adding the

category option of "intangible cultural heritage" on the query page for the public's query, so as to reduce the potential disputes.

In addition, it can increase the mechanism of prior commitment and increase the strength of punishment after the fact, at the same time, the prior commitment will be used as a reference factor for judging "bad faith". In the "Several Provisions on Regulating the Behavior of Trademark Application and Registration" being drafted, credit files, industry self-regulatory measures, and stop accepting trademark agency business in serious cases will be utilized to regulate the supervisory means. Therefore, we can also utilize the credit file for trademark registration, by setting up different standards and circumstances to put the relevant individual subjects and agencies involved in malicious registration into the relevant restriction list, and expand the scope of examination of their registration applications while strictly examining them.

3.3 Improving the Linkage of Ex Parte Procedures for the Examination of Intangible Cultural Heritage Trademark Registrations

When the relevant subject completes the pre-examination of the database and enters the substantive examination, the substantive examination organization may, through the establishment of a linkage working mechanism between the trademark examination function and the competent cultural authorities, have the trademark examination department forward the information on disputes to the local competent cultural authorities, which will issue opinions or provide relevant information while conducting the examination in respect of intellectual property rights. This not only helps to shorten the information gap between the trademark review department and the cultural authorities, but also helps to resolve potential trademark registration conflicts and disputes in the prior procedure.

4. Conclusion

The protection of intangible cultural heritage should follow the principle of "seeing people, seeing things, seeing life", and the protection from the perspective of trademark rights is also to promote the intangible cultural heritage to play its role of inheritance in the existing state. Therefore, by setting up a reasonable and

orderly trademark prior review mechanism and linkage review mechanism, it is not only conducive to avoiding potential disputes in advance, but also conducive to encouraging the main body of the inheritance to carry out re-creation in response to the changes and development of the times in the dynamic continuity, which is also conducive to the continuation and inheritance of the connotation of the intangible cultural heritage itself.

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