

## Article

# Protection of Religious Signs under Trademark Law: A Perspective of China's Practice

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**Abstract:** This article looks at how religious signs are increasingly used in trade and how misappropriation can be harmful to the identity and preservation of religious cultures. Research has shown that trademark rules can be used to help prevent such issues occurring in trade. Some religious entities have also taken trademark strategies to safeguard their religious signs. Considering that religious signs are generally regarded as common patrimony, a balanced system is more beneficial to both the public and trademark proprietors. This research delves into the theory that the trademark system should ensure that the non-commercial use of religious signs used for historical, cultural and social purposes, remains in the public domain. By analyzing China's practice of protecting religious signs, this article finds that despite the success of certain religious entities in safeguarding religious trademarks, their approach is not necessarily feasible for wide application. The article suggests that the government should do more to protect religious signs by using trademark rules under which any signs detrimental to religious identity, value or culture should be refused for registration and prohibited from use. Also, in certain cases, social organizations and individuals should be entitled and encouraged to participate in the protection of religious signs.

**Keywords:** religious signs; religious beliefs; trademark protection; misappropriation; distinctiveness; the public order and morality

## 1. Introduction

Religious signs, an important part of religious culture, are increasingly used in trade. Because not all of the commercial activities are conducted by corresponding religious entities, misappropriation of religious signs has raised considerable concerns over the religious identity and the preservation of religious culture. For example, Buddhism is a strong religion in China, and Shaolin Temple is China's best-known Buddhist monastery and the birthplace of Kung Fu; however, the religious signs "Shaolin" (少林) and "Shaolin Temple" (少林寺) have been used as trademarks by a wide variety of enterprises, covering industries of automobile, furniture, hardware, food, pharmaceuticals, and so on (Wang 2002). Moreover, the religious signs had been registered as trademarks in foreign countries (Anonymous 2004). People who cared about Shaolin culture argued that misappropriation of religious signs would cause misunderstanding about religious beliefs and be harmful to the preservation of religious knowledge (Anonymous 2007).

In order to respond to the challenges, some religious entities took a series of measures. For example, Songshan Shaolin Temple (Shaolin Temple) launched a website that became a platform for developing Buddhism, Shaolin Kung Fu and Shaolin culture. The temple also invested in commercial entities, such as Shaolin Intangible Assets Management Co. Ltd., to manage and protect their intangible assets (Anonymous 2007). Abbot Shi Yongxin said that Shaolin Temple registered trademarks with the primary aim of preventing misappropriation of religious signs rather than utilizing trademarks in business (Li 2015). Currently, the business of Shaolin Temple has covered the field of film production, medical care, food, mobile technology, and so on (Ching 2014).

Similar cases occurred with other religious signs as well. A Buddhist temple called “海会寺” was registered as a trademark in the goods of fermented bean curd (Chen 2016). The gods in Daoist concepts, “城隍” and “泰山大帝” were misused as trademarks in the goods of jewelry and building materials respectively (Chen 2016), which did serious harm to the religious beliefs.

Misappropriation of religious signs is partly caused by the insufficient knowledge and respect for the religious culture. China is a multi-confessional country where the major religions practiced include Daoism, Buddhism, Islam and Christianity. According to the official statistics, China only has about 100 million religious believers, which accounts for less than 10% of the total Chinese population (State Council Information Office 2014). Places of worship and the number of religious facilities vary widely among different religions. For example, China has more than 33,000 Buddhist monasteries and about 200,000 Buddhist monks and nuns. It also has about 25,000 Christian churches and 37,000 clergy, while it only has about 9000 Daoist temples and 50,000 Daoist priest and nuns (Administration of Religious Affairs 2013). In addition, China has a lot of minority religions, which only have a few believers (Administration of Religious Affairs 2013). This indicates that the capability of various religions to disseminate their own religious knowledge and culture is significantly different. Furthermore, the distribution of religious believers varies extremely in different regions. In an empirical study, it was found that Buddhist believers account for more than 40% of the local population in Fujian Province, while they make up less than 3% of the local population in Zichuan Province, Guizhou Province and Hubei Province (Guai and Gao 2016). Similarly, there are many more Christian believers in Zhejiang Province than in Yunnan Province and Jiangxi Province (Guai and Gao 2016). This implies that religious culture exerts different influence on the population of different regions. More importantly, because religious education is not included in the national education curriculum (State Council Information Office 2014), it is unsurprising that many people do not have general knowledge of or respect for religious culture.

This article examines the justification for registering or refusing to register religious signs as trademarks and studies the challenges with respect to trademark protection of religious signs, asking whether China’s practice of protecting religious signs has achieved the anticipated objectives. This context will be viewed in three parts. Section 2 examines the scope of trademark protection under international treaties and national laws, and further articulates whether religious signs are eligible for trademark protection and the rationales behind these rules. Section 3 outlines disputes arising from the use of religious signs as trademarks and how religious entities take trademark strategies to protect their religious signs in China. It also explains China’s trademark laws concerning these issues. It further seeks to analyze the challenges in using trademark strategies and whether they are feasible for protecting religious signs. Section 4 proposes suggestions to deal with the challenges before concluding the article.

## 2. The Eligibility of Religious Signs for Trademark Protection

### 2.1. Considerations of Offering Trademark Protection for Religious Signs

#### 2.1.1. Requirements of Distinctiveness

In general, signs used or intended to be used in trade, and capable of distinguishing goods or services, may be eligible for trademark protection. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) provides that “[a]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark”<sup>1</sup>. This provision indicates that signs eligible for trademark protection must satisfy the requirement of distinctiveness. A similar provision is also reflected in

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<sup>1</sup> TRIPS Agreement, article 15(1).

the Paris Convention for the Protection of Industrial Property (Paris Convention). Article 6 of the Paris Convention denies trademark registration in cases where signs have no distinctive character<sup>2</sup>. Therefore, neither non-distinctive nor generic signs can be accepted for trademark protection under the international treaties, except for signs that have acquired distinctiveness as a result of use in trade.

The distinctiveness requirement is based on the theory of trademark. The theory of trademark implies that trademarks to be given legal protection must serve several functions, including identifying one seller's goods, signifying a particular commercial origin, guaranteeing quality, and advertising the goods (Merges et al. 2007). In modern practice, these functions have coalesced because trademarks are viewed as an instrument of reducing transaction and information search costs (Merges et al. 2007). Moreover, trademarks can be perceived as a device of protecting consumers against confusion about the source of goods offered in the marketplace. These rationales illustrate why trademark regulations can prevent non-distinctive marks from registration and protection.

### 2.1.2. Requirement of "Morality" or "Public Order"

Apart from the basic requirement of having a distinctive character, signs capable of trademark protection should not be contrary to morality or public order, and this is recognized by international trademark rules. The Paris Convention provides that member states may refuse or invalidate the registration of signs "when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public"<sup>3</sup>. An analogous provision is contained in the TRIPS Agreement that member states shall not be prevented "from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention"<sup>4</sup>. Therefore, the registration application for the sign can be rejected if it is perceived as being morally unacceptable, regardless of having a distinctive character.

Although the concepts of "morality" and "public order" have quite broad meanings, they refer to the requirements that should be followed by a country or society for living together in a civilized manner. Generally, "morality" or "public order" is related to the matters of national spirit, basic national policy, decency, sex, religious beliefs, traditional culture and lifestyle (Kitchin et al. 2005). In order to ensure that people live and work harmoniously with others of diverse cultures and customs, the government has responsibility to protect all of its citizens equally by safeguarding morality and public order in their state. This explains why the government should not support the use of signs in trade that offend against common values in civilized society.

### 2.1.3. Other Considerations

In order to strike a fair balance between the interests of trademark proprietors and the public, trademark law provides specific exceptions to trademark rights. On the one hand, some uses of trademarked signs, particularly for non-commercial purposes, remain in the public domain because of their significance in serving social, cultural, and educational needs. In other words, the use in certain forms is exempt from infringement. On the other hand, the exceptions should be extremely limited in particular cases to ensure the rights of trademark proprietors.

Despite the exceptions to trademark rights, cultural values and beliefs of religious signs may still be in danger of being gradually eroded. Theoretically, trademark laws only provide protection for signs used in the course of trade; as a result, the use of signs for non-commercial purposes does not fall within the scope of exclusive trademark rights. However, because commercial information conveyed by the trademarks would be widely disseminated by the promotion of goods or services, such information may supersede the original cultural values or religious beliefs of religious signs.

<sup>2</sup> Paris Convention, article 6quinquies(B)(2).

<sup>3</sup> Paris Convention, article 6quinquies(B)(3).

<sup>4</sup> TRIPS Agreement, article 15(2).

A scholar expressed his concern that “[e]ven though use of the sign for private, educational and cultural purposes does not necessarily fall within the scope of exclusive trademark rights, these forms of use outside the context of trade may still be influenced by the meanings and connotations attached to the sign by the trademark owner in the course of trade” (Senftleben 2012). In this regard, even though the trademark law protects signs of cultural significance in the public domain, the public interests may not be fully ensured.

In addition, the increasing expansion of trademark rights results in legal uncertainty in this context. In some countries, the trademark law is used to fight against dilution and unfair free-riding; therefore, the exceptions and limitations of trademark rights become less reliable for exempting certain non-commercial uses from infringement (Senftleben 2012).

## 2.2. The Eligibility of Religious Signs for Trademark Protection: Diversified Approaches

Previous research has pointed out that trademark rules can be used to prevent misappropriation of religious signs in trade (Olsen 2013; Simon 2009; McKenna 2006). Under the international legal framework, countries adopt different approaches to determine the eligibility of religious signs for trademark protection. When religious signs are contrary to morality or public order, they are excluded by some countries from trademark protection. Some countries limit the application of this doctrine to the particular circumstance where trademark registration is sought with an intention of offending the religion concerned (Senftleben 2012). In other countries where trademark signs are generally regarded as not being inherently distinctive, the distinctiveness requirement is used to safeguard against trademark registration, and protection, of religious signs. However, this also means that if a religious sign can serve to indicate the origin of the goods, it may be eligible for trademark registration and protection.

In the United States, the Lanham Act allows religious signs to be protected as trademark. On the basis of this provision, the U.S. courts have recognized that religious organizations are entitled to the same trademark rights as other commercial entities<sup>5</sup>. The underlying rationale is that even though a religious organization does not make profits or sell goods, it still needs to protect its reputation and good will. Just like an eleemosynary organization, although it has no goods to sell, its distinct identity is of the same significance as that of normal commercial entities, because its general reputation and financial credit are highly relevant to the distinct identity (McKenna 2006). On the other hand, the Lanham Act denies the registration of any mark that “[c]onsists of or comprises immoral, receptive, or scandalous matter”<sup>6</sup>. Therefore, religious signs used in an immoral manner cannot be accepted by the trademark system.

In the European Union (EU), an absolute ground is established to refuse trademark registration concerning state emblems, official hallmarks, and emblems of intergovernmental organizations, which is consistent with Article 6ter of the Paris Convention<sup>7</sup>. However, religious signs are not covered by Article 6ter. The EU legal system leaves its member states free to adopt an absolute ground for excluding the signs of public interests, although they would not be covered by Article 6ter from trademark registration. Even though the member states do not adopt such an absolute standard, they also can rely on provisions that prohibit trademarks from being deceptive or contrary to morality or public order<sup>8</sup>. In some EU countries, some signs of high symbolic values, such as religious signs and historical personages, are likely to be denied for trademark registration.

In Asian countries, signs of religious significance are not absolutely denied for trademark registration. For example, neither the trademark law of Japan or Korea explicitly recognizes that

<sup>5</sup> Purcell v. Summers, 145 F. 2d 979, 985 (4th Cir. 1944); Oklahoma Dist. Council of the Assemblies of God of the State of Okla., Inc. v. New Hope Assembly of God of Norman, Okla., Inc., 597 P. 2d 1211, 1215 (Okla. 1979).

<sup>6</sup> 15. 15 U.S.C. §1052 (a).

<sup>7</sup> EU Trademark Directive, article 3(1)(h).

<sup>8</sup> EU Trademark Directive, article 3(1)(g) and article 3(1)(f).

the religious sign itself constitutes grounds for refusal<sup>9</sup>. Moreover, the distinctiveness of religious signs is not generally denied, either. Nevertheless, if a religious sign is regarded as being immoral or disrespectful to a particular group, its eligibility for trademark registration may be denied<sup>10</sup>. Also, if a religious sign to be sought for registration is likely to cause confusion, it would lose the basis of registration due to the misleading or deceptive nature<sup>11</sup>.

### 3. China's Practice for Protecting Religious Signs under the Trademark Law

#### 3.1. Possibility of Safeguarding Religious Signs under China's Trademark Law

##### 3.1.1. Trademark Rules Concerning Religious Signs Protection

Under China's Trademark Law, any visible sign that can serve to distinguish the goods of a natural person, legal person, or other organization from those of another, including any word, letters, numerals, figurative elements, three-dimensional symbols, colors, sound or any combination of the above, may be applied for trademark registration<sup>12</sup>. The signs eligible for trademark registration should have a distinctive character, and not cause conflict with others' prior legitimate interests<sup>13</sup>. In addition, the scope of trademark protection is further limited by several instruments. First, all the signs capable of trademark protection must be used in trade, and the use must be public, genuine, commercial and legal. Thus, neither the use falling outside the registered class nor non-commercial use can constitute a trademark use. Second, Article 10 of China's Trademark Law absolutely prohibits some signs from being used and registered as trademarks, including the signs delivering deceptive information or being detrimental to socialist ethics or having other unwholesome influences<sup>14</sup>. Since the concept of "unwholesome influences" is not further defined in this Article, the scope of this ground for refusal seems very broad. It theoretically offers a flexible way to safeguard the public interests, but leads to legal uncertainty. Therefore, the Supreme People's Court has interpreted that a sign possibly being harmful to religious feelings or beliefs should be categorized as an instance of having other unwholesome influences<sup>15</sup>. Therefore, a mark consisting of the words "Buddha", "Convent", "Temple" or another religious term is unlikely to be granted trademark registration, because of being in violation of Article 10 of China's Trademark Law. However, the law permits religious entities or commercial entities under their directorship to use the mark of the unique place of worship as the symbol of the registered trademarks<sup>16</sup>.

According to these regulations, religious signs are not generally excluded from trademark use or registration. In reviewing the eligibility of religious signs for registration, the distinctive character will be carefully considered. Due to the common patrimony nature, religious signs are generally regarded as being absent of a distinctive character. However, if a sign does not mislead the public over the association between the sign concerned and a common patrimony sign, the sign concerned is likely to be distinctive. Moreover, a sign also may obtain secondary meaning by the use in trade. As a result, its original religious meaning may no longer definitely convey an impression that it was supposed to represent. For example, the term "Taiji" (太极) is well-known as a Daoist symbol.

<sup>9</sup> Japanese Trademark Act, section 4(1)(vii) and Korean Trademark Act article 7 (1) (ii).

<sup>10</sup> Japanese Trademark Act, Section 4(1)(vii) and Korean Trademark Act article 7 (1) (iv).

<sup>11</sup> Korean Trademark Act, article 7 (1) (x).

<sup>12</sup> China's Trademark Law, article 8.

<sup>13</sup> China's Trademark Law, article 9.

<sup>14</sup> Article 10 (8) of China's Trademark Law provides that "[t]hose detrimental to socialist ethics or customs, or having other unwholesome influences" may not be used as trademarks.

<sup>15</sup> The Notice of the Supreme People's Court on Issuing the Opinions on Several Issues Concerning the Trial of Administrative Cases Involving the Authorization and Determination of Trademark Rights, article 3. It provides that "In judging whether a mark has any other adverse effect, a people's court shall consider whether the mark or any of its elements is possible to cause any negative effect on political, economic, cultural, religious, ethnic and other public interests or the public order".

<sup>16</sup> No. 145 Decree of the State Council, 1994.

It means “supreme ultimate” and represents the fundamental Daoist view of the structure of reality (Little et al. 2000). However, with wide use of the “Taiji” term and symbol in commercial activities, people do not think it necessarily associates with Daoism. In contrast, the distinctiveness of the marks, using “Taiji” as the whole or a part of a trademark, has been created by plenty of commercial entities in trade. The term “Taiji Kongfu” (太极功夫) has been registered by Henan Weikang Industrial Co., Ltd. as a trademark in the goods category of beverages. Similarly, the term “Taiji Tiger” (太极虎) has been successfully registered by Beijing Green Leaf Century Chemical Products Co., Ltd. as a trademark in the goods category of air fresheners and disinfectant. Regrettably, the Daoist culture and value contained in the term and symbol “Taiji” have been diluted. Another typical instance is the Buddhist term “NIRVANA”, which means the final state of complete knowledge and understanding. Currently, the public do not regard the term “NIRVANA” as a specialized term for Buddhism but a general term widely used in a variety of fields. Therefore, China’s Trademark Office allows the registration of using the term “NIRVANA” as trademarks if they have obtained secondary meaning in the course of trade. Similarly, the Buddhist term “般若” referring to the highest wisdom, has been successfully registered as a trademark because its original religious meaning is not necessarily conveyed in the contemporary circumstance.

### 3.1.2. Legal Personality

As previously stated, a religious entity is entitled to have ownership of trademarks presenting the mark of its worship place. Moreover, under the General Rules of the Civil Law of China, which entered into effect on 1 November 2017, a place of religious worship that is legally established is entitled to apply for the registration of a legal person<sup>17</sup>. It confirms the entitlement to ownership of a trademark of the religious entity concerned. Thus, just like other commercial entities, religious entities holding trademarks may protect religious signs by preventing undesirable uses of the signs by third parties, and may use the trademark rules to promote their names or to collect royalties for goods or services in trade.

### 3.2. China’s Practices of Protecting Religious Signs under Trademark Law

In order to improve the preservation of religious culture, the signs of religious significance should be protected. In China, the following approaches have been adopted.

First, some religious entities have registered the marks of their unique worship places as trademarks. Under China’s trademark laws, such trademark registration is allowed, as long as it does not conflict with others’ legitimate interests. Once religious entities or associations acquire trademark rights, they may explore both positive and defensive options to protect their religious signs. Positive protection refers to the active assertion of rights, which is helpful for the trademark holder to actually exploit its own intangible assets through commercialization and licensing, with the purpose of raising funds or other charitable purposes. Defensive protection aims to prevent misappropriation of religious signs and illegal acquisition of trademark rights by third parties.

The most typical example is Shaolin Temple. Since Shaolin Temple found the wide misappropriation of the mark “Shaolin Temple” (少林寺) and similar marks in trade, it has recognized the urgency of protecting its religious identity and preserving religious values. Subsequently, Shaolin Temple used trademark strategies to protect religious signs. To date, Shaolin Temple has successfully registered the sign “Shaolin Temple” (少林寺) as trademarks in all the forty-five categories of the prescribed classifications of goods and services. Shaolin Temple also invested in establishing Shaolin Intangible Assets Management Co. Ltd. and other enterprises, to manage their intangible assets. Through defensive uses of trademark registration, it may fight against trademark infringement and unfair competition, and thereby prevent the misappropriation of the religious signs. Furthermore, Shaolin

<sup>17</sup> General Rules of the Civil Law of China, article 92.



Temple may take positive strategies to strengthen its religious identity and disseminate its religious culture by using registered marks in trade. In this regard, the trademark regulations are powerful for protecting religious signs.

Second, the examiners of China's trademark office adopt a cautious attitude towards trademark applications for signs consisting of religious elements. Because religious signs generally fall under the category of common patrimony, the marks similar to them or containing their elements are incapable of trademark registration in most circumstances. One of the underlying rationales is that these signs may cause the public confusion over the origin of the goods or service. Once the signs lacking distinctiveness are permitted to be used and registered, the public would possibly associate the goods or service with the religion concerned. Another rationale is that the law should not encourage free-riding behaviors. If a commercial entity only has an intention of grabbing cultural heritage, rather than establishing a distinctive character of a mark, no justification can be found to approve its trademark application. Just because of this, the overwhelming majority of trademark applications for the signs containing the term "Shaolin" are rejected by the Trademark Office. It merits noting that few of these signs have successfully passed through registration. For example, Henan TV Station of China has obtained the registration of the term "Shaolin Heroes" (少林英雄) in the goods category of computers, downloadable image files and cartoons. "Shaolin Heroes" is the title of a children's outdoor reality show; that was jointly produced by Henan TV Station of China and Shaolin Temple. This TV program presented Shaolin Kongfu and cultures, which were studied by children in Shaolin Temple. This program has been broadcast across China and it has received very high audience ratings since its launch. Although Shaolin Temple is viewed by martial arts lovers as the "Mecca" for Kongfu, people know little about its history over 1500 years and the culture behind it. Therefore, in view of the substantial contribution this reality show plays in delivering Shaolin cultures and the distinctiveness of the term, the Trademark Office granted the trademark. Likewise, Shanghai Jinri Animated Film and Television Ltd. has registered the trademark "Shaolin Kids" (少林小子). The trademark holder has produced well-known animated cartoons; that depict Shaolin Kongfu and the growth of three Shaolin children. It can be observed that successful registration is mainly attributed to the distinctiveness of the sign concerned. In other words, a sign consisting of religious terms but lacking of a distinctive character is ineligible for trademark registration.

Third, religious signs may also be protected by invalidating the trademark if it is contrary to the principles of public order and morality. On this basis, a term or symbol that has unwholesome influences on religious feelings or values cannot be registered as the whole or a part of a trademark. Even when registered, it can be invalidated if deemed contrary to public order and morality. Under Article 44 of China's Trademark Law, a registered trademark shall be declared invalid by the Trademark Office if it is in violation of this principle; or any other entities or individuals may request the Trademark Review and Adjudication Board to declare such registered trademark invalid<sup>18</sup>. A typical instance is the case of Shanghai Cheng Huang Jewelry Co., Ltd. v. Trademark Review and Adjudication Board of the State Administration for Industry & Commerce of China<sup>19</sup>. In this case, a trademark "城隍" registered in the goods of precious stones, diamonds, pearls, jade, and other jewelry was canceled, because the use of such a trademark did serious harm to Daoist concepts in which the term "城隍" referred to gods in charge of fighting evil and bringing peace.

### 3.3. Challenges of Protecting Religious Signs in China's Practice

Despite great efforts, China is still facing some challenges regarding protection of religious signs. Above all, registration of goods and services in multiple classes would be open to revocation after

<sup>18</sup> China's Trademark Law, article 44. It states that "[a] registered trademark shall be declared invalid by the trademark office if it is in violation of Article 10 . . . . Other entities or individuals may request the trademark review and adjudication board to declare the aforesaid registered trademark invalid."

<sup>19</sup> Gao Xin Zhong Zi No. 539 (2014) ((2014) 高行终字第539号).

three years for lack of genuine use. The trademark law primarily aims to prevent unfair competition by protecting the use of a distinctive sign in trade. Therefore, the trademark law offers protection for genuine uses of the sign in trade, instead of mere registration without uses. In China, a registered trademark is vulnerable to revocation if it has not been used for a consecutive period of three years. As previously stated, Shaolin Temple has obtained trademark registration in all the categories of the classifications of goods and services. However, Shaolin Temple's original purpose is to prevent misappropriation of its religious signs rather than utilize trademarks in trade (Li 2015). This raises doubts about whether Shaolin Temple has the intention and/or the capability to make genuine use of the registered sign in all the prescribed classifications of goods and service. Even though a religious entity registers its own signs, it still has to satisfy the requirement of the genuine use in trade to defend itself against a challenge posed by a third party before the trademark office. It should be noted that the rules with respect to the genuine use in trade are applied strictly. It has been recognized that several circumstances cannot be categorized into the use in trade. For example, the commercial use of a sign falling outside of the registered class is not an eligible use in trade. Furthermore, a mere media report about a trademark would not constitute the use in trade, because the commercial purpose can be hardly found in that case<sup>20</sup>. In sum, in adopting the strategy of abundant trademark registration to protect religious signs, the registered trademark is vulnerable to invalidity due to the lack of genuine use or good faith.

Next, registration of goods and services in multiple classes can not necessarily achieve the anticipated purposes of preventing misappropriation. It is often supposed that trademark registration will reduce users of the sign, which is likely to reduce the possibility of consumers' confusion. Even though some religious entities have registered trademarks in all the categories of goods and services, the registration has not covered each small item of goods and service prescribed in the classifications. On the one hand, both the TRIPS Agreement and China's Trademark Law establish the exclusive right for the owner of a trademark to prevent the use of an identical or similar sign on identical or similar goods<sup>21</sup>, so that trademark registration gives protection broader than the exact terms of the registration. On the other hand, it should be noted that the similarity is construed quite narrowly in judicial practice. Subject to the judicial interpretation released by the People's Supreme Court, the similarity only establishes if the use of the concerned mark causes the likelihood of confusion<sup>22</sup>. Thus, the religious entity cannot necessarily prevent others from registering similar signs in different items of goods or services. The failure or success of the subsequent registration heavily depends on the distinctiveness of the sign concerned and the consistency of the principle of morality. Moreover, Shaolin Temple, the proprietor of the trademarks, rarely fights against misappropriation of its religious signs by bringing trademark infringement lawsuits. The maintenance of marks with an overly broad coverage is so costly that Shaolin Temple's approach is not suitable for all religious entities.

### 3.4. A New Consideration of Well-Known Trademark Strategies

Some scholars proposed that certain religious entities may adopt the well-known trademark strategy (Wang 2002; Bo 2005). Once a trademark is recognized as well-known, it may receive greater protection. Under China's Trademark Law, a sign that replicates, imitates or translates others'

<sup>20</sup> Pfizer Inc. v. Welman Ltd., Gao Min Zhong Zi No. 1685 (2007) ((2007) 高民终字第1685号).

<sup>21</sup> TRIPS Agreement, article 16(1), China's Trademark Law, article 57.

<sup>22</sup> Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks, article 9(2) provides that "the term 'similar trademarks' refers to that the trademark charged of infringement and the registered trademark are similar in the font style, pronunciation, meaning of the words, or in the composition and color of the pictures, or in the overall structure of all the elements combined, or in the cubic form or combination of colors so that the relevant public may be confused about the origin of the commodity or believe that there exist certain connections between the origin and the commodity which is represented by the registered trademark of the plaintiff".



unregistered well-known trademarks and is likely to cause confusion, is incapable of registration<sup>23</sup>. Not only that, the Trademark Law offers protection of registered well-known trademarks beyond the principle of specialty<sup>24</sup>. The proprietor of the well-known trademark is entitled to prohibit its use, as well as its main part in relation to goods or services that are not identical or similar under the circumstance where the use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark<sup>25</sup>. Nevertheless, this approach is not always feasible for religious trademarks. It should be noted that the religious sign carries significant cultural meaning, which belongs to a common patrimony. Once a religious sign is recognized as a well-known trademark, few other commercial participants can use the sign without authorization. It seems to prevent potential misappropriation of the religious sign; but it is only the one side of a coin. In view of the private character of the trademark, information resources belonging to a common patrimony should not be absolutely occupied by an individual entity (Liu 2008). More importantly, the repute of the well-known trademark is a dynamic fact. In China, the identification of the well-known trademark is on a case-by-case basis. It means that the examination on whether a mark shall be considered well-known is conducted based on the evidence provided by the trademark proprietor in each case. In the intensive market competition, it is difficult to ensure that the repute of a trademark is maintained. On the case-by-case basis, the recognition of the well-known trademark only has legal effects in the particular case. The previous record of being recognized as a well-known trademark may be used as a reference but has only limited impact on subsequent cases. The law provides that a mark shall be determined as a well-known trademark in the ordinary judicial or administrative procedures. In both of the procedures, the proprietor of the trademark has a heavy duty to prove the reputation of the mark, because plenty of factors would be taken into account when determining such cases. If a religious entity uses well-known trademark strategies to safeguard its religious sign, it has to concentrate considerable efforts to deal with the complex procedure of examination. Considering that religious entities are not ordinary commercial entities, well-known trademark strategies would be burdensome.

#### 4. Suggestions for Protecting Religious Signs

Undoubtedly, China's practice of protecting religious signs has made considerable progress. This accomplishment is attributed to religious entities, Chinese government, and the public. In spite of this kind of progress, it remains important to consider which approach to the matter of protection is most suitable for wide application.

##### 4.1. Defensive Options through Trademark Registration with Overly Broad Coverage

The religious entity is entitled to use the name of the unique worship place as the symbol of the registered trademark. As for other forms of religious signs, such as religious symbols and terms, religious entities are not granted priority over other commercial entities. In principle, any commercial entity may file applications of trademark registration for signs identical or similar to religious signs. From this perspective, trademark registration of the name of the worship place is insufficient to prevent misappropriation of other religious signs.

To some extent, Shaolin Temple's defensive registration is effective in reducing market participants and thereby strengthening the identity of its religious symbols. Shaolin Temple has a history over 1500 years and its commercial subsidiaries run business successfully. In comparison with other religious entities, Shaolin Temple has the capability to use defensive strategies, which need considerable financial

<sup>23</sup> China's Trademark Law, article 13.

<sup>24</sup> The principle of specialty means that the scope of trademark protection will be limited to the same or similar goods or services covered by their registration.

<sup>25</sup> Article 58 of China's Trademark Law provides that "[w]hoever uses a registered trademark or an unregistered well-known trademark of another party as the trade name in its enterprise name and mislead the public, which constitutes unfair competition, shall be dealt with in accordance with the Anti-Unfair Competition Law of the People's Republic of China".

resources to maintain the validity of the trademarks. However, not all religious entities have such capability. In addition, it should be highlighted that the trademark registration beyond the genuine use may be challenged for ineligible use. Therefore, preventing the misuse of religious signs would not be done by a defensive registration.

#### *4.2. Defensive Options through Filtering out Objections*

It would be more practical to adopt defensive mechanisms through filtering out objections at the examination stage, providing opposition or invoking invalidation proceedings. China's Trademark office, being in charge of examining application of trademark registration, should conduct critical reviews of applications for signs identical or similar to religious signs. Any unfair or free-riding use of religious signs should be refused registration. Moreover, applications for signs lacking a distinctive character or being contrary to the public order or morality have to be rejected as well. In the case where a sign has been granted the trademark right but failed to satisfy the requirement of trademark registration, the Trademark Office shall invalidate it at issue. Should this occur, any social organization or individual may also request the Trademark Review and Adjudication Board to make a decision to invalidate such a registered trademark. If the social organization or individual is dissatisfied with the decision of the Trademark Review and Adjudication Board, it may bring a legal proceeding before the court.

It should also be noted that the Trademark Office has limited knowledge about religious culture, so it may not easily determine whether the sign is connected to significant religious culture and should be examined from a perspective of the preservation of religious identity and values. Therefore, both legal and practical aspects should be considered. The legal aspect concerns whether trademark registration establishes misappropriation of religious signs under the trademark law of the jurisdiction concerned. Legal questions may include, for example, recognition of religious signs, and determining their connotation and religious values. The practical aspect is to ensure information is actually available to trademark authorities. A feasible approach is that religious entities or religious associations may file a list of the religious signs worthy of being protected before the Trademark Office, which may be used as a reference point during the trademark examination. The holders of religious signs are also encouraged to disseminate knowledge to promote awareness of religious signs. Similar mechanisms for preventing acquisition of patents over traditional knowledge have been implemented at the international level<sup>26</sup>. Such mechanisms are intended to ensure relevant information is available to patent examiners, and thereby to help them find out whether traditional knowledge is relevant in the review of prior art in determining the novelty of a claimed invention<sup>27</sup>.

As for the use of unregistered trademarks, the trademark rules with respect to the refusal of trademark use are applicable as well. As previously stated, Article 10 of the Trademark Law provides the absolute grounds for refusal of use, which rules both registered and unregistered trademarks. All the trademarks used in the market must be regulated by the law and not be harmful to the public order or morality, whether registered or unregistered. If a trademark violates these provisions, it should be strictly prohibited. Therefore, if a trademark consisting of religious signs is detrimental to religious identity, religious beliefs or religious values, the relevant administrative departments of local governments shall forbid the illegal use of it. Likewise, any social organization or individual shall also be entitled and encouraged to request the local government to take measures to prevent such use.

#### *4.3. Positive Options through Commercial Use of Religious Signs*

Commercial use of religious signs in a proper manner can promote the name and value of the religious entity concerned. In the normal case where a religious entity registers its religious signs

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<sup>26</sup> The information is provided in the document WIPO/GRTKF/IC/6/8.

<sup>27</sup> The information is provided in the document WIPO/GRTKF/IC/5/6.

as trademarks, it may exploit its intangible assets through commercialization or use the intellectual property system to further its own end by permitting other commercial entities to use its trademarks and collect royalties. To some extent, valuable religious knowledge and culture would be promoted in proper commercial matters.

Another positive option is to approve third parties engaging in commercial activities that may promote values of religious signs, to use religious signs as trademarks. A typical example is a UK trademark, THE CATHOLIC PRINTING COMPANY (UK Registration 2373449). The mark's holders were a private company whose mission was printing books and magazines that had the religious values of the Roman Catholic Church, a world-wide communion. The company's use of the religious name was allowed because its commercial use promoted the name and values of the Roman Catholic Church whilst working within trademark rules. This example illustrates how a religious entity can promote its own values through commercial activities of approved third parties.

#### *4.4. Using Trademark Rules Regarding Collective and Certification Marks*

Generally, a religious sign regarded as common patrimony cannot be protected as a trademark because it is not a sign used in the course of trade to identity a specific origin of goods or services. This follows the general trademark rules of exceptions and limitations. However, it is possible to use the rules of collective and certification marks to prevent misuse of religious signs.

Under China's trademark law, the term "a collective trademark" refers to a trademark "registered in the name of a group, association, or any other organization for use in business by its members to indicate membership"; and, a certification mark is defined as "a mark owned by an organization that exercises supervision over a particular product or service and which is used to indicate that third-party goods or services meet certain standards pertaining to place of origin, raw materials, mode of manufacture, quality, or other characteristics"<sup>28</sup>. Rules of collective trademarks are reliable in cases where a religious sign should be owned by the religious group instead of any particular religious entity. In practice, some religious signs, such as "金菩提" and "禅茶堂", have been registered by the Buddhist Association of China. Moreover, because certification trademarks are not used by the holder but by owner-authorized users to affirm that the goods or services have met certain predetermined standards set and maintained by the holder, certification trademarks do not have the same strict requirements of distinctiveness as ordinary trademarks. Considering that the trademark holder of a collective or certification trademark has the duty to control the manner in which the mark is used by its authorized users or members, these two types of trademarks may be used to prevent misuse of religious signs.

#### *4.5. Seeking Protection through a Sui Generis Right*

It might make sense to establish a sui generis right to safeguard religious signs due to their standing as common patrimony. Religious signs carrying traditional knowledge or traditional cultural expression deserve protection, but conventional categories of intellectual property do not provide adequate protection for them. China is a member of the World Intellectual Property Organization (WIPO) Intergovernmental Committee; therefore, it could protect this type of indigenous patrimony by a sui generis right. Although this mechanism has not been well established, it may be an avenue for further practice.

## **5. Conclusions**

Since religious signs are common patrimony within the society and an important part of religious culture, it is necessary for the whole society to respect, preserve and protect them. Any misappropriation

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<sup>28</sup> China's Trademark Law, article 3.

of religious signs that is harmful to religious beliefs and values should be prohibited. In order to achieve these objectives, trademark strategies have been developed to safeguard religious signs.

Under the trademark law, not only can religious signs be registered as trademarks, but also religious entities may be entitled to the same trademark rights as common commercial entities. However, because of the common patrimony nature, the balance between the interests of the public and the trademark proprietor should be carefully struck. In addition to requiring the distinctiveness of the religious trademark, it should ensure that any non-commercial use serving historical, cultural and social purposes remains in the public domain.

In China, religious entities have made considerable efforts to safeguard the identity and value of religious signs. Among them, Shaolin Temple has successfully taken the trademark strategy to prevent misappropriation of its religious sign. The Daoist Association of China, participating in the proceeding as a third party to prevent the aforementioned misappropriation of the term “城隍”, also made a considerable contribution to safeguarding religious culture. In *Taishai Shigao Ltd. v. Shandong Wanjia Ltd.*, the Daoist Association provided the court with its view on the religious value of the Daoist term “泰山大帝”<sup>29</sup>. However, Shaolin Temple’s approach is infeasible for wide application. In contrast, the government has a responsibility to protect religious signs, including filtering out objections on morality and public order at the examination stage, or in opposition or invalidation proceedings. In certain cases, social organizations and individuals should be entitled to participate in the protection of religious signs.

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