

你所需了解的商标抢注

What you need to know about trademark squatting

新《商标法》中最重要的一处修订是明确将“诚实信用”规定为在中国申请注册和使用商标的基本原则之一。将于2014年5月1日起实施的新《商标法》有望减轻打击商标抢注者的负担。西方公司在与商标抢注者打交道时最好留意以下新《商标法》中的重要内容。

商标抢注者是否为商标代理机构? 截止2013年6月, 中国有超过一万七千家法律实体有资格作为商标代理机构向中国商标局提出商标注册申请。现实中, 不乏许多商标代理机构以自己的名义注册很多的商标并胁迫商标真正所有人购回这些商标。

熟悉法律知识

商标代理机构熟悉法律知识, 因此相较于个人抢注者而言, 打击这些商标代理机构会更加困难。

修订后的《商标法》明确禁止商标代理机构以自己的名义申请注册任何商标。

如果在中国抢注你商标的是一家商标代理机构, 那么你根据新《商标法》对抢注者的商标注册申请提出的异议将很有可能成功。

商标抢注者是否与你有关、业务往来关系或者其他关系? 现行商标法律制度禁止商标代理人、代表人或者销售代理商、经销商(共同称为“代理人”)未经授权, 以自己的名义将被代理人或者被代表人的商标进行注册。

最高人民法院在法发〔2010〕12号司法解释中进一步明确, 对于商标抢注者与代理人串通合谋抢注的商标也不应当准予注册。不过在现实中, 供应商或其他商业伙伴是否也受到这些禁止性规定的约束仍然具有不确定性。

不确定性获澄清

新《商标法》对这些不确定性进行了澄清, 明确规定只要你有证据证明与你具有合同、业务往来关系或者其他关系的商标抢注者明知你商标的存在, 你就可以对商标抢注者的申请注册提出异议。

商标抢注行为是否侵犯了著作权、外观设计专利、商号、肖像权等在先权利? 现行商标法律制度禁止申请商标注册损害他人的在先权利。修订后的《商标法》保留了这项规则。现实中, 如果商标注册申请侵犯了你的在先权利, 包括但不限于著作权、外观设计专利、商号权以及肖像权, 你可以对商标抢注者的注册申请提出异议。

One of the most important changes in the revised Trademark Law is to explicitly set forth “good faith” as one of the fundamental principles for registration and use of a trademark in China. Fighting against trademark squatters is expected to be less burdensome under the revised Trademark Law, which comes into force on 1 May 2014. It would be advisable to consider the following key points when a Western company deals with trademark squatters under the revised Trademark Law.

Is the trademark squatter a trademark agent? As of June 2013, more than 17,000 firms in China are qualified to act as a local agent to file trademark applications with China's Trademark Office (TMO). In practice, it is not uncommon that trademark agency firms register a large number of trademarks in their own names and blackmail the actual owners to purchase them back.

Firms with good knowledge

The trademark agency firms have good knowledge on the law, and thus it is more difficult to tackle them than individual squatters. The revised Trademark Law explicitly prohibits the trademark agency firms from registering any trademark in their own names. If the squatter who applied for registration of your trademark in China is a trademark agency firm, you would have good chances of success in opposing the trademark registration of the squatter under the revised Trademark Law.

Does the trademark squatter have any contractual, commercial or other relation with you? The current trademark regime prohibits your trademark agent/representative or your sales agent/distributor (jointly, agents) from registering your trademark without authorisation.

The Supreme People's Court (SPC) further confirmed its judicial interpretation [2010] No. 12 that a trademark application through the collusion between a trademark squatter and the agents should also be rejected. However, in practice, there are still uncertainties about whether suppliers or other types of business partners would also be caught.

Uncertainties clarified

These uncertainties have been clarified under the revised Trademark Law, which explicitly provides that you would be allowed to oppose the registration of the trademark squatter as long as you have evidence proving that the trademark squatter obviously knows your trademark through its contractual, commercial or other relation with you.

Does the trademark squatting infringe any of your prior rights such as copyright, registered design, trade name and right in portrait, etc.? Trademark registrations that prejudice prior



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范围宽泛

在先权利的范围十分广泛。例如，最高人民法院在2010年的一起案件中认定经实际使用并具有一定影响的药品商品名称可以作为在先权利受到保护，不受商标抢注者侵犯。

你是否受到商标抢注者的敲诈？ 如果商标抢注者敲诈你购回

自己的商标，或者强迫你与他进行业务交易，或者如果商标抢注者“搭便车”利用你持有的商标所现有的声誉来误导消费者，那么这些都可以成为证明商标抢注者具有恶意的有力证据。

对恶意提出控告

如果你已经在中国使用了未注册的商标并取得了良好的声誉，你不妨针对抢注者的恶意提出控告，并援引新《商标法》第32条（即现行《商标法》第31条）的规定请求宣告抢注者的注册商标无效。

新《商标法》第44条（即现行《商标法》第41条）规定了一项兜底性条款，禁止在中国以不正当手段取得商标注册。即使你的商标尚未在中国范围内广泛使用，不过你可以援引该兜底条款对抢注者的恶意提出异议，并控告其商标注册是通过不正当手段取得的。

商标抢注者是否实际使用商标？ 如果注册商标在中国连续三年不使用的，那么该注册商标可以被申请撤销。绝大部分商标抢注者并不会实际使用他们注册的商标。现实中，如果商标抢注者注册了大量的商标，这可能意味着他并不会实际使用这些商标。你不妨以商标未使用为由向商标局申请撤销其注册商标。

实际效果有待证实

尽管修订后的《商标法》有望能够遏制中国商标抢注者的蓬勃发展，但它的实际效果还有待2014年5月1日修订案正式实施后才可以得以证实。

以上介绍的重点问题无意穷尽新《商标法》中针对恶意商标抢注行为规定的所有救济措施。无论如何，预防胜于治疗。计划在中国开展业务的西方公司最好尽早进行商标注册申请。

rights are prohibited under the current trademark regime. This rule remains unchanged under the revised Trademark Law. In practice, you are allowed to oppose the registration of the trademark squatter, if such registration infringes your prior rights, including but not limited to copyright, registered design, trade name and right in portrait.

Scope is broad

The scope of the prior rights is broad. For example, the SPC ruled in 2010 that the name of a medicine that has been actually used and has a significant influence can be protected as a prior right against trademark squatters.

Are you being blackmailed by the trademark squatter? If you are blackmailed to purchase back your trademark, or the trademark squatter forces you to conduct business with him, or if the trademark squatter “free rides” the pre-existing reputation of your trademark to mislead consumers, these would be useful evidence proving the bad faith of the trademark squatter.

You may wish to challenge

In the case that you have used your unregistered trademark in China and gained a good reputation, you may wish to challenge the bad faith of the trademark squatter and invoke article 32 of the revised Trademark Law (i.e. article 31 of the current Trademark Law) to invalidate the registration of the trademark squatter. Article 44 of the revised Trademark Law (i.e. article 41 of the current Trademark Law) contains a “catch-all” provision prohibiting improper trademark registration in China. Even if your trademark has not yet been broadly used in China, you may nevertheless invoke the “catch-all” provision to challenge the bad faith of the trademark squatter and complain that its trademark registration was acquired by improper means.

Does trademark squatter actually use the trademark? A trademark would be vulnerable for revocation if it has not been used in China for a consecutive period of three years after it has been granted registration. Most of the trademark squatters do not actually use the trademarks that they have registered. In practice, if a trademark squatter has registered a large number of trademarks, this would be an indication that those trademarks are not actually used by the trademark squatter. You may wish to request that the TMO revoke the trademark registration on the ground of non-use.

Effect needs to be tested

Although it is expected that the revised Trademark Law should hold back the booming growth of trademark squatters in China, the actual effect needs to be tested after the amendments have been implemented on 1 May 2014.

The key points mentioned above are not intended to be exhaustive of all possible remedies against the trademark squatters under the revised Trademark Law. In any case, preservation is better than cure. Early registration would be always recommendable for Western companies intending to do business in China.