

Reflexion on certain provisions for regulating
applications for trademark registration
关于规范商标申请注册行为的特定规定之反思

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BAD FAITH has different meanings

恶意有不同的含义

I. Proliferation of trademarks 商标扩散

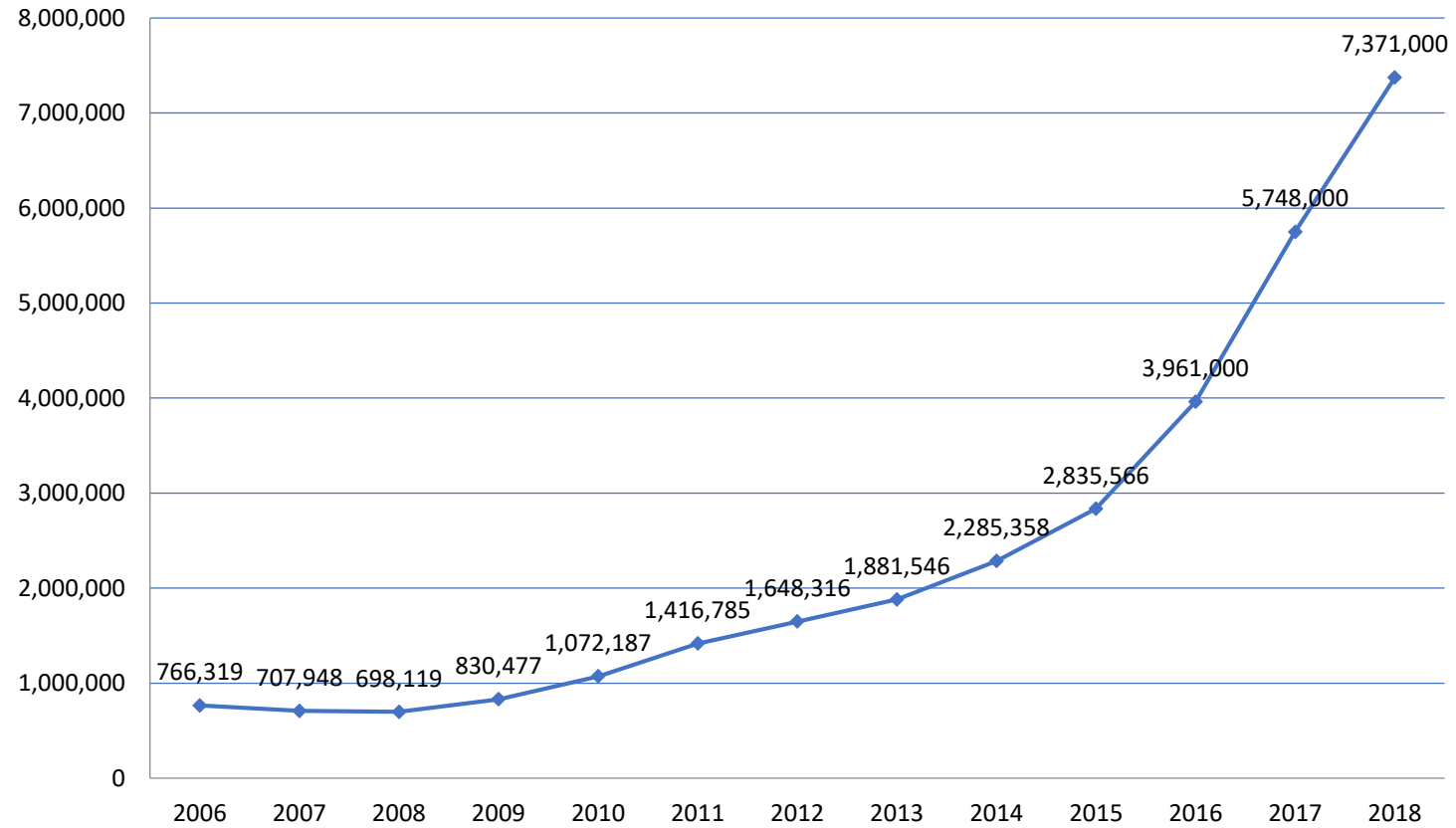
- Filing trademarks for reasons other than using them 非出于使用目的而注册商标
 - Make money (receive subsidies – resell the trademarks) 获利 (骗取补贴—转售商标)
 - “public order” involved 涉及“公共指令”

II. Bad faith applications 恶意应用

- Filing trademarks to preempt others and/or take advantage of their reputation 抢注商标和/或攫取他人的声誉
 - Private interest involved 涉及私人利益

Trademark domestic and foreign applications in China (2006-2018)

中国的境内和境外商标申请数据 (2006-2018)



I. Proliferation of trademarks 商标扩散

- CNIPA draft provisions : 国家知识产权局的草案规定:
"Provisions for Regulating Applications for Trademark registration"
(February 2019)
《关于规范商标申请注册行为的若干规定》 (2019年2月)
- 4th Revision of the Trademark Law (April 23, 2019 – Effective November 1st, 2019)
《商标法》的第4次修改 (2019年4月23日修改, 2019年11月1日生效)

- CNIPA draft provisions 国家知识产权局的草案规定：
 - Some measures are very welcome 有些措施非常受欢迎
 - Reimbursement of subsidies
 - 归还补贴
 - Some are already provided in the law 有些措施在法律中已经有规定
- Some are problematic: 有些措施存在问题：
 - Art 7.2 : any person can report to CNIPA for invalidation...
 - 第7.2条：任何人都可以向国家知识产权局举报...

- **4th revision of the TML 《商标法》第4次修改**
 - **Article 4 第4条**
 - First draft did not mention bad faith
 - 第一稿未提到恶意行为
 - Problem of coherence with article 49 (revocation for non-use)
 - 第49条存在一致性问题（撤销不使用的商标）
 - **Introduction of bad faith solved the problem** (no intention to use + bad faith)
 - 引入“恶意”定义解决这个问题（无使用意图+恶意）
 - Examiner : difficult to assess bad faith
 - 审查员：难以界定“恶意”
 - Opposition and invalidation
 - 异议与宣告无效
 - **Quid retroactivity of the law ? 法律具有追溯性?**
 - Possibility to invalidate trademarks filed before November 2019 ?
 - 有可能使得2019年11月1日之前申请的商标宣告无效?

- "Defensive" trademarks
- “防御性” 商标
 - No bad faith
 - 无恶意
 - Why are they needed ? Because too difficult to use article 13
 - 为什么需要？ 因为很难利用第13条规定维权
 - The defensive trademark exposed to revocation (3 years non-use)
 - 防御性商标面临被撤销的可能（3年不使用）

Other suggested measures 其他建议措施

- **Revocation for non-use: 撤销不使用的商标**
 - Too difficult, too long 太难于实施, 时间跨度太长
 - Suggested : 建议:
 - **Introduce contradiction** at the 1st instance level
 - 在一审级别引入反驳机制
 - Impose **strict application of time limit** for producing evidence of use
 - 对商标使用举证施加严格的时间限制
 - If no evidence within the prescribed time, revocation must be FINAL
 - 如果规定时间内未提供证据, 则商标撤销决定是最终性的
 - Impose **financial consequences**
 - 施加财务影响
 - Must pay for the cost of procedure
 - 必须承担相关程序成本

II. Bad faith : more and more sophisticated

II. 恶意：越来越高级

- Trademark filed 所申请的商标
 - Remotely similar 低近似度
 - Not opposed, or opposition failed 无异议或异议无效
 - **Registered** 已注册
- **Transformed** in actual use 在实际使用中已变换形式

dunhill



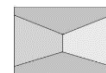
danhuoli



danhuoli



TOMMY  HILFIGER



Tommycrown



TOMMY CROWN

• Tommy Hilfiger v. Tommy Crown



TOMMY HILFIGER

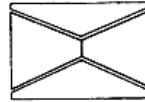
TOMMY  HILFIGER

1988.10.30

1988.10.30

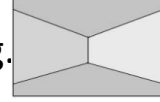
2006.8.18

(Reg.



2007.10.8

(Reg.



2014.3.24

Tommycrown

2014.4.28

2018.7.16

TOMMY CROWN





Lacoste v. EXING

- TM filed in 1992, registered in 1993
- 商标申请于1992年，注册于1993年
- The history of the transformed use
- 商标变换使用的历史



Administrative solution 行政解决方案

• Article 49 TML 《商标法》第49条

- *Where the trademark registrant who uses his registered trademark has committed any of the following, the local administrative department for industry and commerce shall order him to rectify the situation within a specified period; where the situation is not rectified at the expiration of the said specified period, the Trademark Office may revoke the registered trademark:*
- 商标注册人在使用注册商标的过程中，发生如下任何事项之一的，由地方工商行政管理部门责令限期改正；期满不改正的，由商标局撤销其注册商标。
- **(1) where a registered trademark is altered unilaterally;**
- **(1) 自行改变注册商标的**
- In practice : does not work
- 实践中：无用

Civil litigation 民事诉讼

- SPC interpretations : OBSTACLE
 - 最高人民法院解释：阻碍
 - Infringement action against a registered trademark is **only** possible if
 - **只有**满足如下条件才有可能针对一个注册商标发起侵权诉讼：
 - (1) the mark has been significantly **transformed**
 - (1)该商标发生显著**转化**;
- OR
- 或者**
- (2) the plaintiff's trademark was **well-known** when the target mark was filed.
 - (2) 在申请目标商标时，原告的商标已经**广为知晓**。

Solution : article 7 解决方案：第7条

“Trademarks should be filed and used in good faith”

“申请和注册商标应遵循诚实信用原则”

- **However...article 7 is only a general principle, and cannot be cited independantly**
- **但是，第7条仅是一项通用原则，无法独立引用。**

Suggested explanation 建议的解释

- **Article 33 第33条**
 - a prior owner may raise an opposition ..., if the trademark “violates the provisions of clauses 2 and 3 of article 13, article 15, article 16.1, **article 30**, article 31 and article 32 of this law”.
 - 如果商标“违反本法第13条第2款和第3款、第15条、第16条第1款、**第30条**、第31条和第32条规定的”，**先在所有人可以提出异议。**
- **No mention of article 7 未提及第7条**

- **Article 30 第30条**

- a trademark that is
 - (a) **not in conformity with the law**, or
 - (b) *is identical or similar to a prior registered or approved trademark of another person*
- **may not be registered.**
- 满足如下两项条件之一的商标**不得注册**:
 - (a) **不符合本法的规定**, 或者
 - (b) 与在同一种商品或者类似商品上已经有的商标相同或者近似

Article 7 is included in article **将第7条纳入如下两条**

A trademark that is filed or used in bad faith ***is not in conformity with the law***
恶意申请或使用的商标不符合法律规定

- Therefore, there is no reason to prevent the plaintiff from citing Article 7
- 因此，就没有理由阻止原告引用第7条规定
- If bad faith is proven, there should be no obstacle to the action
- 如果证明存在恶意，则提起侵权诉讼**应该不存在阻碍。**
- **A trademark filed or used in bad faith should be invalidated**
- **恶意申请或使用的商标应该被宣告无效。**

Recent cases of SPC 最高人民法院的最近案例

- Wang Suiyong v. **Ellassay** 王碎永诉歌力思
 - Retrial 2014 – Guiding case in 2017
 - 2014年二审——2017年指导案例
- Compass Exhibition Service Company v. **UNIQLO** 指南针展会服务公司诉优衣库
 - Retrial 2018
 - 2018年二审
- In both cases : 在这两个案例中:
 - A trademark acquired in **bad faith** 都有一个**恶意**获取的商标
 - **Cannot be protected** : claims dismissed 无法受到保护: 主张被驳回
 - Trademark eventually invalidated 商标最终被宣告无效
- Bad faith plaintiff to pay the cost 恶意的原告都支付诉讼成本

THANK YOU !

谢谢!