



**Recent cases of bad-faith
trademark in the experience
of an EU Member State**
近期恶意商标案例汇总
一个欧盟成员国的经历

Federico Roberto Antonelli

Legal Counsellor - Embassy of Italy

Federico Roberto Antonelli

意大利大使馆法律参赞

Three main groups of cases:

案例的三种主要类型：

01

DUPLICATION OF ENTIRE IMAGE OF THE COMPANY/BRAND 复制公司/品牌的整套形象

02

REGISTRATION IN BAD FAITH 恶意注册

03

BAD FAITH REGISTRATION OF GEOGRAPHICAL INDICATION 恶意注册地理标志

The company was founded in Italy in 1910. Today it is one of the most important **Italian fashion** brands in the world.

该公司于1910年在意大利成立。今天，它是全球最重要的**意大利时尚**品牌之一。

Ermenegildo Zegna

2013

A Chinese company (*Fuyin*) copied the **entire set of image** of the Italian brand, selling products labelled with trademarks which were phonetically similar and easy to confuse with Zegna's ones.

一家中国公司（富银）复制了该意大利品牌的**全套形象**，出售的产品所附商标与Zegna商标读音近似，易于混淆。

2014

Zegna asked for the **invalidation** of the trademark of the counterpart.

Zegna要求**无效**富银的商标。

2016

The court of Guangzhou delivered a **judgement in favor** of Ermenegildo Zegna, acknowledging the **bad faith** used by the Chinese registrant.

广州法院作出**有利于**Ermenegildo Zegna的**判决**，确认中国注册人做出了恶意注册行为。



Zegna → Zsnoi
 ZZegna → ZZsnoi
 ZegnaSport → ZsnoiSport
 Z → ZN



TRADEMARK 商标

Ermenegildo Zegna

SHOPS 店面

WEBSITE & HISTORY 网站与历史

PRODUCTS & SHOPPERS 产品与顾客

Zegna 杰尼亚

“Ermenegildo Zegna founded his “Lanificio Zegna” in 1910 in the Alpine foothills of Trivero (Biella). Today, Zegna fabrics are still one of Italy’s most acclaimed exports.”

“Ermenegildo Zegna于1910年在阿尔卑斯山下的特里韦罗（毕耶拉）建立了自己的“Lanificio Zegna”品牌。今天，Zegna面料依然是意大利最受赞誉的出口产品之一。”

Zsnoi 杰锐

“In 1910 the Italian fashion brand ZSNOI was established having its wool spinning mill at Biella, the world-famous Italian textile center.”

“意大利时尚品牌ZSNOI于1910年成立，其毛纺厂设在世界知名的意大利纺织品中心毕耶拉。”





CANALI is a fashion brand founded in Italy in 1934. Canali has been fighting for years against the **fraudulent registration** of a trademark (CARLI) which is very similar to its one, both by a figurative and a nominative point of view. Also, the use of a **misleading advertising** campaign has caused customers to believe the brand is “Made in Italy”. **CANALI**是1934年在意大利建立的时尚品牌。Canali数年来一直与**欺诈性注册**的商标（CARLI）做斗争。不论是从图形还是指示角度，该商标都与CANALI极为相似。同时，**误导性广告活动**已经使得消费者相信CARLI品牌是“意大利制造”。

The Chinese counterparty registered marks are:
中国对手方注册的商标是：

- «**CARLI**» (pronunciation very similar to the one of the italian brand) (发音与该意大利品牌极为相似)
- «**卡拉利**» (pinyin: *ka la li*).

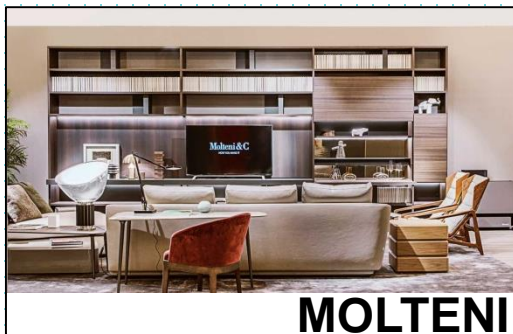
CANALI
1934

Molteni & C

Molteni Group is one of the leading companies worldwide in the **high-level furniture market**. Molteni集团是全球**高端家具市场**的领先公司之一。

In 2018, Molteni discovered that a company named Hothing Casa had **copied their entire set of image and products**, accessories, and even the layout of their shops. The Chinese brand sells more than 40 models that are very similar or identical to the ones created by Molteni's designers. Molteni contested the **clonation of its products** and sued the counterpart for **unfair competition**.

2018年，Molteni发现一家名为Hothing Casa的公司**复制了他们的整套形象和产品**、配件、甚至店面的布局。该中国品牌出售40多种与Molteni设计师创作的产品极为相似或相同的产品。Molteni抗议对**其产品的克隆**，以不公平竞争为理由起诉该公司。



PREMIATA is one of the most famous Italian **footwear manufacturer**, widely known for the excellence of their “Made in Italy”. It entered the Chinese market in 2010.
PREMIATA是最著名的意大利**鞋业制造商**之一，以其“意大利制造”的卓越性而闻名全球。该制造商于2010年进入中国市场。

The company is fighting against several cases of unfair trademark registration: it has taken several legal actions against a Chinese entrepreneur who registered a lot of trademarks similar to the ones of famous Italian brands. They also filed for actions of **opposition to the registration**, actions of **cancellation for lack of use**, and actions of **invalidation**. Unfortunately they all led to unfavorable decisions so far.

公司正在对抗多个不公平商标注册的行为：有中国商家注册了大量与该知名意大利品牌的商标相似的商标；为此，PREMIATA已经采取多次法律行动。PREMIATA还针对**商标注册提出异议**，以**缺乏使用为由要求撤销这些商标**，并要求**宣告这些商标无效**。可惜，截至目前，所有判决都不利于他们。

PREMIATA is also fighting a legal battle against a Chinese company that has been selling **counterfeited imitations** of the Italian company's products.
PREMIATA还正在与另一家一直在出售PREMIATA**仿冒品**的中国公司开展法律诉讼。

PREMIATA → PREMIATA PREMIATA PREMIATA



→ 木 木 /木\ PREMIATA PREMIATA木




PREMIATA



Alfa Romeo is an Italian brand known all around the world for sports and race cars, part of FCA Group. In China, the trademarks ALFAROMEO, 阿尔法罗密欧, 阿尔发罗密欧 and the ALFAROMEO logo have been filed for in 1994 and officially registered in 1996.

Alfa Romeo是享誉全球的意大利跑车品牌，隶属FCA集团。在中国，Alfa Romeo于1994年申请将ALFAROME、“阿尔法罗密欧”、“阿尔发罗密欧”和ALFAROMEO logo注册为商标，于1996年获得授权。

Recently, a Chinese company filed for 13 **actions of cancellation on grounds of lack of use** for some of the FCA group trademarks, including ALFAROMEO, 阿乐法罗密欧, the ALFAROMEO logo, GIULIA, GIULIETTA. The applications were **all rejected** by the CTMO.

最近，一家中国公司以**缺乏使用为理由**针对几个FCA集团商标提起13次**撤销申请**，这些商标包括ALFAROMEO、“阿乐法罗密欧”、ALFAROMEO logo、GIULIA和 GIULIETTA。这些申请都被中国国家知识产权局商标局驳回。

The same company decided to **lodge an appeal** at TRAB against the decision of CTMO, but even in this case the Court pronounced **in favor of FCA group**.

针对商标局的决定，这家公司决定向商标评审委员会**提起申诉**。但是即使在这种情况下，法院也判**FCA集团胜诉**。

The Chinese company decided then to **request for a further review** of the TRAB's decision before the Beijing Intellectual Property Court.

这家中国公司又请求北京知识产权法庭**再次复审**商标评审委员会的决定。

GIULIA *Giulietta* STELVIO

In the meantime, the same company has **applied for the registration** of a number of trademarks, among which 阿乐法罗密欧, ALFA ROMEO GIULIA, GIULIETTA and STELVIO, all **under class 12** (automotive). The CTMO **rejected the application**, but the company **lodged an appeal** before the TRAB.

同时, 这家公司也提交了大量**商标申请**, 其中的“阿乐法罗密欧”, ALFA ROMEO GIULIA, GIULIETTA 和 STELVIO都属于**第12类**商标(汽车)。商标局**驳回其申请**, 但是这家公司向商标评审委员会**提起申诉**。

The Chinese company has also applied for the registration of a number of other foreign brands.

这家中国公司还申请了大量其他国外商标。

Finally, another Chinese company from the same city has applied in the same days for the registration of the trademark Stelvio **under class 12**. This time **the application was preliminarily accepted** by the Chinese Trademarks Office. FCA Group immediately opposed the decision.

最后, 来自同一城市的另一家中国公司同期也申请了**第12类**项下的Stelvio商标。这次, 中国商标局**初步受理**了该申请。FCA集团立即提出异议。

Some other Chinese companies have also tried to register FCA Group trademarks **under different classes**. FCA Group lodged several objections based upon the fact that ALFA ROMEO is a well-known brand and should be protected under different classes.

另外有几家中国公司也试图在**不同类别**项下注册FCA集团商标。FCA集团基于ALFA ROMEO是一个知名品牌, 因此应该在不同类别项下受到保护的事实, 提起了数次异议。





Alce Nero is an Italian **organic food producer**, well known in China and Asia.
Alce Nero是一家在中国和亚洲都很有名的意大利**有机食品生产商**。

Recently, a Chinese company has registered the trademark Alce Nero under class 30. The **opposition** moved by Alce Nero, however, has been **rejected** for the following reasons:

最近，一家中国公司注册了一个第30类Alce Nero商标。但是，出于如下原因，Alce Nero提出的**异议被驳回**：

- The product of the Chinese company are different from the ones protected under Alce Nero's trademark registration
- 这家中国公司的产品与Alce Nero商标注册所保护的产品不同。
- There aren't specific evidences to prove that the registration and the eventual use of the trademark would result into **marketplace confusion**
- 没有明确的证据可证明该商标的注册和最终使用会导致**市场混淆**。
- The authenticity of evidences produced by Alce can't be verified because the documents presented **haven't been authenticated** by a notary
- 无法确认Alce证据的真实性，因为它们所提供的文件没有**经过公证**。

Counterpart logo 对手的logo



Alce ⁰²
Nero.
Una
parte
di te.

C'È UN PO' DI ALCE NERO IN OGNUNO DI NOI. NOI CHE RISPETTIAMO I RITMI DELLA NATURA, LE STORIE E LE MANI CHE LA LAVORANO. NOI CHE CREDIAMO NELLA TERRA E CHE PREFERIAMO PROTEGGERLA PER MANTENERLA FORTE E RICCA PER IL DOMANI. NOI CHE SCEGLIAMO DI MANGIARE SANO PERCHÉ VOLERCI BENE CI FA STARE BENE.

NOI SIAMO ALCE NERO,
IL BIOLOGICO DA OLTRE 30 ANNI.




alce nero
IL BUONO DEL BIOLOGICO
DAL 1978
www.alcenero.com



- **Reggio Children S.r.l.**, owned by the Municipality of Reggio Emilia in Italy, promotes and safeguards the pedagogical method “Reggio Emilia Approach”. In 1991 the American publication “Newsweek” identified the Reggio Children “Diana” Preschool as the most avant-garde school in the world for education in early childhood.

意大利Reggio Emilia市**Reggio Children S.r.l.**公司推广和主张一种名为“瑞吉欧”的教学方法。1991年，美国杂志《新闻周刊》将瑞吉欧儿童“戴安娜”幼儿园评为全球早教领域最先进的学校。

- During the years, several Chinese legal entities have tried to register some trademarks which were **similar**, if not **identical**, to the Reggio Children’s one, in order to take advantage of the popularity of the Italian pedagogical method and confusing the Chinese consumers.

近年来，有好几家中国法律实体试图注册与瑞吉欧儿童教育**相似**的商标，以期从该意大利教学方法的知名度中获利，并混淆中国消费者。





The Italian **fashion brand** is largely known worldwide; it's name and logo are also strictly linked with the figure of the "dachshund dog".

这一意大利**时尚品牌**可以说是享誉全球；其名称和logo都与“腊肠犬”图像结合在一起。

Recently, Harmont&Blaine has been **denied the registration** of their trademark "Harmont&Blaine and Device" in China because of a previous registration of a very similar Chinese trademark "**HARMOND&DOG**" (in pinyin 哈曼柏林).

最近, Harmont&Blaine尝试在中国注册 "Harmont&Blaine and Device" 商标, 却遭到**拒绝**; 因为之前与之非常相似的中国商标 "**HARMOND&DOG (哈曼柏林)**" 已经完成了注册。"

In 2019, the Beijing High Court finally **ruled in favor** of Harmont&Blaine.

2019年, 北京高院最终做出**有利于**Harmont&Blaine的判决。



Harmont & Blaine

MARINA MILITARE



In the case of the Italian Navy (State emblem), the Embassy supported the Italian Institution in the fight against the **fraudulent registration** of a very similar trademark (both by a nominative and figurative point of view).

在意大利海军（国家徽标）的案件中，大使馆支持意大利机构针对他人**欺诈性注册**极为相似商标（从指示和图形角度来看都极为相似）的行为发起对抗。

The case was conducted and was solved on the basis of the **Paris Convention for the Protection of Industrial Property** and Chinese Trademark Law.

这个案件最终依据《**保护工业产权巴黎公约**》和《中国商标法》得到判决和解决。

The Embassy is currently following a similar case that involves the some trademarks linked to the Italian Air Force (Aeronautica Militare) 目前大使馆正在跟踪另一类似案件；该案涉及与意大利空军相关的商标。

LUXOTTICA-LENSCRAFTERS

End of 2015 → Luxottica contacts the Italian Embassy in China to receive assistance regarding the protection of its American trademark “LensCrafters” in its Chinese transliteration (亮视点). Indeed, a Chinese entrepreneur (Mr. Li) who had previously registered a similar trademark (百视点), had managed to have LensCrafters’ trademark **cancelled by final judgment**.

2015年底 → Luxottica联系意大利驻中国大使馆，要求大使馆协助保护其美国商标“LensCrafters”的中文音译“亮视点”。实际上，有一名中国企业家（李先生）之前已经注册过类似的商标“百视点”，并成功地使得法院的**最终判决撤销**了LensCrafters商标。

In March 2016 → the Supreme Court accepted the application for the review of the judgement and **annulled the judgement** adverse to Luxottica based on the fact that, although he **registered the trademark in good faith**, he eventually started to **operate in bad faith** when he tried to take advantage of the brand’s success.

2016年3月 → 最高院受理了重审判决的申请，**无效了**对Luxottica不利的判决；所依据的事实是：尽管李先生注册商标时是善意的，但当他试图利用意大利品牌的商业成功而谋利时，构成了**恶意行为**。

LUXOTTICA®



LC

LENSCRAFTERS®

MONTEPULCIANO

In 2016, the Chinese Authorities refused to add the **designation of origin** “Montepulciano d’Abruzzo” to the list of 100+100 European and Chinese geographical indications that will be protected through a **bilateral agreement** (still under discussion).

2016年，中国相关部门拒绝将“Montepulciano d’Abruzzo” **原产地名称**加入100+100欧中地理标志清单；该清单中的名称将通过一份（目前依然在磋商中的）**双边协议**得到保护。

The decision was due to the fact that, since 2013, a trademark denominated with the **Chinese transliteration** of “Abruzzo” had been registered and owned by a Chinese individual based in Hebei province.

中国做出这一决定的原因是：自2013年起，一名来自河北省的中国个人已经注册并拥有了“Abruzzo”的**中国音译**商标。

At the same time, in 2016 the Trademark Office decided to **reject the application** for the registration of a trademark **蒙蒂普尔查诺** because it was considered **too similar** to the Chinese transliteration of the European Geographic Indication “Montepulciano d’Abruzzo”.

与此同时，2016年，商标局决定驳回“蒙蒂普尔查诺”的商标注册申请，认定其与欧洲地理标识“Montepulciano d’Abruzzo”的中国音译**过于相似**。

“Abruzzo” vs. 啊布鲁佐



Prosecco DOC is one of the most well-known Italian wines.

Prosecco DOC是最负盛名的意大利葡萄酒品牌之一。

In September 2014 → the Consortium applied for the registration of the trademarks “**PROSECCO**” and “**普罗塞克**”. The trademark in Chinese characters was registered by the end of 2016, while the “**PROSECCO**” trademark was rejected by the TRAB, because another trademark with the same name had previously been registered by another Italian company, partner of the consortium;

2014年9月 → 联盟申请将“**PROSECCO**”和“**普罗塞克**”注册为商标。汉字商标在2016年底注册成功，而“**PROSECCO**”商标则被商标评审委员会驳回，原因是另一家意大利公司，同时是联盟的合作伙伴，之前已经注册过同样名称的商标。

Despite the fact that this company gave its consent to the registration of the trademark by the consortium, the application was **rejected**.

尽管这家公司同意联盟注册该商标，但是申请依然被**驳回**。

The consortium started an **appeal process** towards the decision of TRAB at the Beijing Intellectual Property Court, which admitted the request. Eventually, the TRAB appealed, in its turn, against the decision of the BIPC. The final decision by the High Court is pending.

针对商标评审委员会的驳回决定，联盟向北京知识产权法院提起**申诉**程序；法院认可该商标申请。最后，商标评审委员会不服北京知识产权法院的决定，再次提出上诉。目前正在等待高级法院的最终判决。

