



天達共和律師事務所
East & Concord Partners



Progress and Unsolved Challenges

主要进展和遗留问题

Brief Analysis on 2019 Revision of Trademark law of PRC

- 2019年中国《商标法》修订的简要分析

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Progress and Unsolved Challenges

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Analysis on Impact of Revision of Trademark law of PRC

中国《商标法》修订影响之分析

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Major Changes in 2019 revision 2019年修订的主要变化

1. Major changes on provisions regarding **bad faith pre-emptive applications**

1. 恶意抢注条款的主要变化

2. Major changes on **punishment** against bad faith applicants and their agents

2. 恶意抢注人及其代理人法律责任方面的变化

Provision for rejecting bad faith application and registration without intent-to-use 禁止无实际使用意图的恶意申请和注册方面的规定

Provision for rejecting bad faith application and registration without intent-to-use (NITU)

禁止无实际使用意图的恶意申请和注册的规定（NITU）

New Articles of TML

《商标法》的新规定

Provision for rejecting bad faith application and registration without intent-to-use (NITU)

禁止无实际使用意图的恶意申请和注册的规定（NITU）

- **Article 4** *Natural persons, legal persons or any other organizations that need to obtain exclusive rights to use trademark for their commodities or services in the course of their manufacturing and business activities shall apply to a trademark bureau for trademark registration. Any application for trademark registration that is malicious and is not filed for the purpose of use shall be rejected.*
- 第四条 自然人、法人或者其他组织在生产经营活动中，对其商品或者服务需要取得商标专用权的，应当向商标局申请商标注册。不以使用为目的的恶意商标注册申请，应当予以驳回。

Provision for rejecting bad faith application and registration without intent-to-use 驳回无实际使用意图的恶意申请和注册的规定

Bad faith application without intent to use shall be regarded as **legal ground for opposition and invalidation**

无实际使用意图的恶意申请可以作为商标异议和无效的理由

New Articles of TML

《商标法》新规定

- **Article 33** *A prior right holder or a stakeholder who holds that a preliminarily validated and gazetted trademark violates the provisions of the second and third paragraphs of Article 13, Article 15, the first paragraph of Article 16, Article 30, 31 or Article 32 of this Law, or any person who held that a preliminarily validated and gazetted trademark violates the provisions of **Article 4, 10, 11, 12 or 19.4** of this Law may raise an objection to the trademark bureau within three months from the date of gazette. Where no objection is raised during the gazette period, the trademark shall be registered, a trademark registration certificate shall be issued and the registered trademark shall be gazetted.*
- 第33条对初步审定公告的商标，自公告之日起三个月内，在先权利人、利害关系人认为违反本法第十三条第二款和第三款、第十五条、第十六条第一款、第三十条、第三十一条、第三十二条规定的，或者任何人认为违反本法**第四条**、第十条、第十一条、第十二条、**第十九条第四款**规定的，可以向商标局提出异议。公告期满无异议的，予以核准注册，发给商标注册证，并予公告。

Provision for rejecting bad faith application and registration without intent-to-use 驳回无实际使用意图的恶意申请和注册的规定

Bad faith application without intent to use shall be regarded as **legal ground for opposition and invalidation**

无实际使用意图的恶意申请可以作为商标异议和无效的理由

New Articles of TML

《商标法》新规定

- *Article 44.1* Where a registered trademark violates the provisions of **Article 4, 10, 11 or 12 of this Law, or the fourth paragraph of Article 19.4 of this Law, or the registration is obtained by fraudulent means or other improper means, the registered trademark shall be invalidated by the trademark bureau; any other organization or individual may request that the trademark review and adjudication board declares the said registered trademark invalid.**
- **第44条1款** 已经注册的商标，违反本法**第四条、第十条、第十一条、第十二条、第十九条第四款**规定的，或者是以欺骗手段或者其他不正当手段取得注册的，由商标局宣告该注册商标无效；其他单位或者个人可以请求商标评审委员会宣告该注册商标无效。

Provision for rejecting bad faith application and registration without intent-to-use

驳回无实际使用意图的恶意申请和注册的规定

What has been changed ?

包含哪些变化？

1. Requirement of the intent to use of the mark as a principle

1. 要求具有实际使用商标的意图成为一项原则

2. Bad faith application without intent to use is regarded as an absolute grounds in opposition examination

2. 无实际使用意图的恶意申请被视为一项异议审查的绝对理由

Opposition (Art 33)

异议（33条）

- Article 4 which requires **intent to use** (“ITU”)
- 第4条要求具有**使用意图**（“ITU”）
- Article 19 which prohibits the application by a **trademark agent out of scope of its service**, as absolute grounds for rejection decision in opposition procedure.
- 第19条禁止商标代理机构超出其服务范围申请商标，成为异议程序中驳回商标申请的绝对理由
 - As a result, any person, without restriction to the relevant parties, are authorized to file the opposition accordingly.
 - 因此，任何人，不受利害关系人的限制，均有权据此提出异议。

Invalidation(Art 44)

无效（44条）

- Article 4 which requires **intent to use** (“ITU”)
- 第4条要求具有**使用意图**（“ITU”）
- Article 19 which prohibits the application of mark by a trademark agent out of scope of its service, as absolute grounds for such invalidation. As a result, any person, without restriction to the relevant parties, are authorized to file invalidation accordingly.
- 第19条禁止商标代理机构超出其服务范围申请商标，成为无效宣告申请的绝对理由。因此，任何人，不受利害关系人的限制，均有权据此提出无效申请。

TMO/TRAB Trademark Examination Guidelines

商标局/商评委商标审查及审理标准

《商标法》第四十四条第一款已经注册的商标，是以欺骗手段或者其他不正当手段取得注册的，由商标局宣告该注册商标无效；其他单位或者个人可以请求商标评审委员会宣告该注册商标无效

Article 44.1 of Trademark Law: where a registered trademark,is obtained by fraudulent means or other improper means, the registered trademark shall be invalidated by the trademark bureau; any other organization or individual may request that the trademark review and adjudication board declares the said registered trademark invalid.

2.2 以其他不正当手段取得商标注册的行为。此种情形是指确有充分证据证明系争商标注册人采用欺骗手段以外的扰乱商标注册秩序、损害公共利益、不正当占用公共资源或者以其他方式谋取不正当利益等其他不正当手段取得注册，其行为违反了诚实信用原则，损害了公共利益。对于只是损害特定民事权益的情形，则应适用商标法第四十五条及商标法的其他相应规定进行审查判断。

2.2 Trademark registration obtained by other improper refers to such cases that there are sufficient evidence materials proving that the applicant of the trademark has conducted other improper means other than fraudulent means that may disturb the administration of trademark registration, bring harm to the public interest, waist the public resources improperly or obtained illegal interests by other improper means and therefore violates the principle of honesty and bring harm to public interest. As to the cases that may bring harm to specific civil interest, it should be subjected to the Article 45 and other corresponding Articles of Trademark Law.

TMO/TRAB Trademark Examination Guidelines

商标局/商评委商标审查及审理标准

2.2.1 下列情形属于本条所指的“以其他不正当手段取得注册”：

- (1) 系争商标申请人申请注册多件商标，且与他人具有较强显著性的商标构成相同或者近似的；
- (2) 系争商标申请人申请注册多件商标，且与他人字号、企业名称、社会组织及其他机构名称、知名商品的特有名称、包装、装潢等构成相同或者近似的；
- (3) 系争商标申请人申请注册大量商标，且明显缺乏真实使用意图的；**
- (4) 其他可以认定为以不正当手段取得注册的情形。

2.2.1 It should be regarded as “registrations obtained by other improper means” under the following circumstances:

- (1) The applicant of the disputed mark has filed multiple applications/registrations that may constitute same or similar marks to the trademarks of others with high distinctiveness.
- (2) The applicant of the disputed mark has filed multiple applications/registrations that may be same or similar to the trade name, name of company or organization, unique name, package or decoration of well-known commodity of others;
- (3) The applicant of the disputed mark has filed applications/registrations in large scale without the intention to use;
- (4) Other circumstances that may constitute “registrations obtained by other improper means” .

2.2.2 系争商标获准注册后，系争商标申请人既无实际使用行为，也无准备使用行为，仅具有出于牟取不正当利益的目的，积极向他人兜售商标、胁迫他人与其进行贸易合作、或者向他人索要高额转让费、许可使用费、侵权赔偿金等行为的，可以判定其明显缺乏真实使用意图。

2.2.2 It shall be regarded as without the intention to use, in the case that the applicant of the disputed mark, after registration of the disputed mark, does not use or prepare to use the disputed mark and only tries to sell the disputed mark to others, or forces others to enter into cooperation, or demands high price, royalty or damages of the disputed mark in order to obtain illegal interests.

2019 Beijing High Court Trademark Cases Guidelines 2019北京高院商标授权确权行政案件审理指南

7.1 【商标法第四条的适用】

商标申请人明显缺乏真实使用意图，且具有下列情形之一的，可以认定违反商标法第四条的规定：

- (1) 申请注册与不同主体具有一定知名度或者较强显著特征的商标相同或者近似的商标，且情节严重的；**
- (2) 申请注册与同一主体具有一定知名度或者较强显著特征的商标相同或者近似的商标，且情节严重的；**
- (3) 申请注册与他人除商标外的其他商业标识相同或者近似的商标，且情节严重的；**
- (4) 申请注册与具有一定知名度的地名、景点名称、建筑物名称等相同或者近似的商标，且情节严重的；**
- (5) 大量申请注册商标，且缺乏正当理由的。**

前述商标申请人主张具有真实使用意图，但未提交证据证明的，不予支持。

7.1 Application of Article 4 of the Trademark Law

If any trademark applicant obviously lacks the true intention of use and is under any of the following circumstances, this applicant may be determined to violate the provisions of Article 4 of the Trademark Law:

- (1) applying for registration of the trademark identical with or similar to that of various subject with certain popularity or higher distinctiveness, which is regarded as a serious circumstance;
- (2) applying for registration of the trademark identical with or similar to that of the same subject with certain popularity or higher distinctiveness, which is regarded as a serious circumstance;
- (3) applying for registration of the trademark identical with or similar to any other commercial signs other than trademarks of others, which is regarded as a serious circumstance;
- (4) applying for registration of the trademark identical with or similar to any name of place, scenic spot, building and others with certain popularity, which is regarded as a serious circumstance;
- (5) applying for registration of a large number of trademarks without good reasons.

If the trademark applicant above claims that he has the true intention of use, but fails to present the relevant evidence, this claim shall not be supported.

Look back : 2017 Judicial Interpretation

回顾：2017年司法解释

最高人民法院关于审理商标授权确权行政案件若干问题的规定（征求意见稿）

Provisions of the Supreme People's Court on Several Questions Concerning the Trial of Administrative Cases Concerning Trademark Granting and Verification (Draft for Opinion)

- **第三条**[大规模抢注行为]
- **Article 3** (Large-scale rush registration)

商标注册人明显缺乏真实使用意图，大量申请注册与他人有一定知名度的商标、有一定知名度的地名相同或者近似的商标，或者缺乏正当理由申请大量商标，商标评审委员会适用[商标法第四条](#)、[第四十四条](#)规定不予注册或者宣告无效的，人民法院予以支持。

If trademark applicants apparently lack real intention to use the trademarks, but apply on a large scale to register others' trademarks that have certain fame, or trademarks identical or similar to well-known names of place, or apply without justification to register a large number of trademarks, and the Trademark Review and Adjudication Board decides not to register the trademarks or announces the invalidity of the trademarks according to Article 4 and/or Article 44 of the Trademark Law, the People's Court shall uphold such decision.

最高人民法院关于审理商标授权确权行政案件若干问题的规定（最终）

Provisions of the Supreme People's Court on Several Questions Concerning the Trial of Administrative Cases Concerning Trade mark Granting and Verification (Final version)

法释〔2017〕2号

Fa Shi [2017] No.2

- **第二十四条**
- **Article 24**

以欺骗手段以外的其他方式扰乱商标注册秩序、损害公共利益、不正当占用公共资源或者谋取不正当利益的，人民法院可以认定其属于商标法[第四十四条第一款](#)规定的“其他不正当手段”。

The People's Court may determine disturbing trademark registration order, harming public interests, improperly occupying public resources or seek undue benefits in ways other than deception means as "other improper means" provided for in **Paragraph 1, Article 44** of the Trademark Law.

Looking back

关于规范商标注册行为的若干规定（征求意见稿）(2019.2)

第三条 本规定所称非正常申请商标注册的行为是指：

- （一）摹仿为相关公众所熟知的商标申请商标注册，攀附他人商誉；
- （二）抢先申请注册他人已经使用并有一定影响的商标，不当攫取他人商誉；
- （三）明知或应知存在其他在先权利，但仍抢先申请注册与其相同、相近似的商标；
- （四）重复申请商标注册，明显具有不正当目的；
- （五）短时间内大量申请商标注册，明显超过合理限度；
- （六）申请商标注册缺乏真实使用意图，没有对商品或者服务取得商标专用权的实际需要；
- （七）其他违反诚实信用原则，侵害他人合法权益或者扰乱市场秩序的商标申请注册行为；
- （八）帮助他人或者商标代理机构代理进行本条第（一）项至第（七）项所述类型的商标申请注册行为。

Several Provisions to Regulate the Applications for Trademark Registration (2019.2)

Art 3 Abnormal application

- (1) Imitate the famous trademark that is familiar to relevant public and free ride reputation of others
- (2) Pre-emptively apply for registration of the marks of others that have been used and acquired certain influence, in order to misappropriate the good will of others.
- (3) Knowingly apply for the mark that is identical to or similar with the prior right of others
- (4) Repeat the application of others with obvious inappropriate objectives.
- (5) Apply for marks in large number within short period
- (6) Apply for marks without true intent to use and real needs to acquire exclusive rights of trademarks with respect to goods or services
- (7) Other applications in violation of good faith principal which aims to infringe on the legitimate rights of others or disrupt market order.
- (8) Assist or represent others to apply for marks as provided in above provisions as trademark agents.

Past success under Art 44 依据44条的成功案例

Amcham v. TRAB (2016) Jingxingzhong2802
中国美国商会诉国家商标评审委员会京行终2802号

美国俱乐部在明知中国美国商会在先使用“AmCham”这一标志的前提下，仍然在多个类别商品或者服务上，大量申请注册“AmCham”商标，其行为难谓正当，有违商标法诚实信用的基本原则，扰乱了正常的商标注册管理秩序，有损于公平竞争的市场秩序。

It could hardly be reasonable and legitimate for American Club to apply/register multiple “AmCham” marks in multiple Classes in consideration that they have known that the American Chamber China have used the mark “AmCham” previously and the registration of the disputed mark goes against the principle of honesty of the Trademark Law, disturbs the administration of the trademark registration and brings harm to fair competition of the market.

依据2014年商标法第四十四条第一款关于禁止以欺骗手段或者其他不正当手段取得商标注册的规定，美国俱乐部申请注册诉争商标的行为应当予以禁止，诉争商标的申请注册不应予以核准。

According to the provisions prohibiting the registrations obtained by fraudulent means or other improper means provided by Article 44.1 of Trademark Law (2014), the action of American Club to apply/register the disputed mark shall be prohibited and the application of the disputed mark shall therefore be rejected.

Past success under Art 44 依据44条的成功案例

- Face book v. TRAB (2016)Jingxingzhong475
- Facebook诉国家商标评审委员会(2016)京行终475号

刘红群在多个商品类别上申请注册了"facebook"商标，还在第29类商品上注册过"黑人"、"壹加壹"等商标。刘红群的前述系列商标注册行为具有明显的复制、抄袭他人高知名度商标的故意，扰乱了正常的商标注册管理秩序，有损于公平竞争的市场秩序，违反了公序良俗原则。

Liu Hongqun has applied/registered multiple "facebook" marks in multiple Classes as well as "黑人" mark and "壹加壹" mark in Class 29. It is obvious that such action of Liu was conducted with the intention to replicate or imitate the trademarks of others with high famousness and thus disturbs the administration of the trademark registration, brings harm to the fair competition of the market and goes against the principle of Public Order and Good Custom.



What has been changed and what has not?

哪些发生了变化，哪些没有？

辛克营运有限公司 v. TRAB (2018)京行终3912号 2018.09.10

Think Operation Co., Ltd. V. TRAB (2018)Jing xing zhong3912 2018.09.10

蓉氏公司曾申请注册商标的列表及相应的商标档案，其中，显示申请人为蓉氏公司的商标共计206件，包括第3类、第5类、第8类、第9类、第10类、第11类、第12类、第14类、第18类、第20类、第21类、第24类、第25类、第26类、第28类、第42类、第44类等多个类别；

According to the database of Trademark Office of China, the applicant of the disputed mark Rongshi Company has filed totally 206 pieces of trademark applications/registrations in multiple Classes including Class 3, Class 5, Class 8, Class 9, Class 10, Class 11, Class 12, Class 14, Class 18, Class 20, Class 21, Class 24, Class 25, Class 26, Class 28, Class 42, and Class 44.

一审：蓉氏公司所实施的包括争议商标在内的系列商标注册行为，不具备注册商标应有的正当性，亦不正当地占用了公共资源，扰乱了正常的商标注册管理秩序，有损于公平竞争的市场秩序，有悖于商标法**第四十四条第一款**关于禁止以欺骗或者其他不正当手段取得商标注册的立法精神，其行为应当予以禁止。

First-instance: The multiple trademark registrations, including the disputed mark, filed by Rongshi Company have no reasonable and legitimate legal basis as well as waist public resources improperly and therefore disturb the administration of trademark registration, bring harm to the fair competition of the market and violate the principle to prohibit the registrations obtained by fraudulent means or other improper means provided by **Article 44.1 of Trademark Law** and such action shall therefore be prohibited.

What has been changed and what has not? 哪些发生了变化，哪些没有？

辛克营运有限公司 v. TRAB (2018)京行终3912号 2018.09.10

Think Operation Co., Ltd. V. TRAB (2018)Jing xingzhong3912 2018.09.10

二审：根据商标法**第四条**的规定，自然人、法人或者其他组织在生产经营活动中，对其商品或者服务需要取得商标专用权的，应当向商标局申请商标注册。商标的基本功能在于区分商品或者服务的来源，民事主体申请商标注册应以满足自身的商标使用需求为目的，并具有真实的使用意图，即其申请注册商标的行为应具有正当性。

Second-instance: According to the **Article 4 of Trademark Law**, natural persons, legal persons or any other organizations that need to obtain exclusive rights to use trademark for their commodities or services in the course of their manufacturing and business activities shall apply to a trademark bureau for trademark registration. The basic function of trademark is to identify the origin of goods or services, therefore, the application of a trademark shall be based on the demand of business and the intention to use, i.e., the application of trademark shall have its legitimate legal basis.

商标是附着于其指定使用的商品或者服务上的，本案中，蓉氏公司并未提交争议商标在核定的第5类哺乳用垫等商品上的使用证据，同时蓉氏公司申请注册的**206件商标**，不仅涵盖的商品类别极为广泛，并且**其中诸多商标与他人具有一定显著性的商标较为相近**，在蓉氏公司并未充分说明其注册相关商标具有合理事由的情况下，蓉氏公司申请注册商标的行为，**明显并非基于正常的商业使用目的**。蓉氏公司**不能证明其具有真实的使用意图**，其申请注册包括诉争商标在内的系列商标的行为，不具备注册商标应有的正当性，亦不正当地占用了公共资源，扰乱了正常的商标注册管理秩序，有损于公平竞争的市场秩序，有悖于商标法第四十四条第一款关于禁止以欺骗或者其他不正当手段取得商标注册的立法精神，其行为应当予以禁止。

A trademark shall be used in relation with the designated goods or services, however, in this case, Rongshi Company have not provided any evidence materials proving that the disputed mark had been used with regard to the designated goods in Class 5. In the meantime, Rongshi Company has applied/registered totally 206 trademarks in numerous Classes and some of which are similar with the trademarks of others with certain distinctiveness. In consideration that Rongshi Company have not provided legitimate legal basis for such applications/registrations, we would like to believe that these applications/registrations have not been based on purpose of reasonable commercial use. Rongshi Company failed to prove that they have the intention to use these trademarks, the multiple trademark registrations, including the disputed mark, filed by Rongshi Company have no reasonable and legitimate legal basis as well as waist public resources improperly and therefore disturb the administration of trademark registration, bring harm to the fair competition of the market and violate the principle to **prohibit the registrations obtained by fraudulent means or other improper means provided by Article 44.1 of Trademark Law and such action shall therefore be prohibited.**

What has been changed and what has not?

哪些发生了变化，哪些没有？

商评委诉霍尼韦尔 (2018)京行终5649号 2018.12.17

TRAB v. Honeywell (2018) Jingxingzhong5649 2018.12.17

25、陈朝霞商标注册信息列表、关于凡客诚品、圣大保罗、保罗骑士百度查询情况等资料。

25. The list of trademark applications/registrations by Chen Chaoxia, Baidu search results of Vancl, SANTA POLO and Palm Polo

陈朝霞在申请注册诉争商标时提交的“代县霍尼薇尔皮具销售部”个体工商户营业执照与工商登记档案记载项目相符，故陈朝霞的注册行为未构成商标法第四十四条第一款关于“以其他不正当手段取得注册的”的情形。

The Business Registration Certificate of “Dai Conunty Huo Ni Wei Er Leather Store” filed by Chen Chaoxia during the application of the disputed mark was in accordance with the AIC registration information, therefore, the application of the disputed mark by Chen should not be regarded as “registration obtained by other improper means” provided by the Article 44.1 of Trademark Law.

霍尼韦尔公司关于诉争商标违反商标法第四条、第十条第一款第七项、第十条第一款第八项所规定之情形的主张，缺乏事实依据，不予支持。商标评审委员会依照商标法第四十四条第三款、第四十五条第二款和第四十六条的规定，裁定：诉争商标予以维持。

The arguments of Honeywell that the registration of the disputed mark violated the Article 4, the Article 10.1.7, the Article 10.1.8 lack of factual basis and shall therefore be rejected. It is hereby decided by TRAB according to the Article 44.3, Article 45.2 and Article 46 that the validity of the disputed mark shall be maintained.

What has been changed and what has not?

哪些发生了变化，哪些没有？

拉多芮国际股份有限公司Laduree（瑞士）v TRAB 2018.12.12

Laduree International Co., Ltd. v. TRAB 2018.12.12

争议商标：第18类“背包；钱包（钱夹）；手提包；制香肠用肠衣”

The disputed mark: “backpack, wallet, handbag, etc.” in Class 18

拉多芮公司质证意见：徽商公司在其他多个类别还申请注册了百余件与他人知名商标构成混淆性近似或完全相同的商标，可见其申请注册诉争商标的行为具有明显的一贯恶意。请求依据商标法**第四条**、**第十五条第二款**，对诉争商标的注册予以无效宣告。

Cross-examination opinion of Laduree: Huishang Company has also applied/registered more than a hundred marks that may be identical with or similar to the trademarks of others with certain famousness, which proves that Huishang Company has applied/registered the disputed mark with bad-faith and the disputed mark shall therefore be invalidated according to Article 4, Article 15.2 of Trademark Law.

二审：虽然诉争商标的原申请人申请注册了**106件**商标，不排除其具有商标囤积行为，但是本案诉争商标已经转让给奥商公司，且拉多芮公司未能证明徽商公司与奥商公司之间存在恶意串通的情形，在诉争商标不违反商标法其他规定的情况下，如果宣告诉争商标无效，对于合法受让诉争商标的奥商公司将产生不利影响。因此，在适用该项规定时，应当结合个案的情况进行判断，拉多芮公司关于其他无效案件中商标评审委员会认定徽商公司不正当行为不是本案诉争商标应被宣告无效的当然理由。

Second-instance: Although the pervious applicant(huishang) of the disputed mark has filed **106 pieces of applications/registrations and may possibly illegally storage marks**, however **given the disputed mark had already been assigned to Aoshang Co., Ltd and Laduree has not been able to prove that there could be malicious conspiracy between Huishang and Aoshang** and the registration of the disputed mark has not violated the other provisions of Trademark Law, **the invalidation of the disputed mark will bring harm to the legitimate right the bona fide assignee of the disputed mark**. Therefore, the application of the Article 44.1 shall be applied on case-by-case basis. In addition, **the unfair competition acts as found by TRAB in other cases should not constitute sufficient reason to invalidate the disputed mark in this case.**

What has been changed and what has not?

哪些发生了变化，哪些没有？

Mary Kay v. TRAB and Mei lin kai Co. Ltd (2018) Jingxingzhong1395

玫琳凯公司诉商标评审委员会、玫琳凯有限公司 (2018) 京行终1395号

玫琳凯公司在上诉状中指出玫琳凯有限公司还申请注册了第5062344号“玫琳凯”商标、第8937823号“玫琳凯”商标、第9032014号“依云”商标，但仅凭上述申请商标注册行为尚不足以体现诉争商标的申请注册系通过欺骗手段或者其他不正当手段，且玫琳凯公司在商标评审程序中并未具体主张诉争商标注册申请人抢注他人多个商标的事实，其并非被诉裁定的作出的依据。关于玫琳凯有限公司多次更名的情况与诉争商标是否通过欺骗手段或者其他不正当手段申请注册的认定无直接关联性。因此，商标评审委员会及一审法院认定诉争商标的申请注册未违反2001年商标法第四十一条第一款的规定并无不当。

Mary Kay Inc. argued in the Appeal that Meilinkai Company had also filed the applications/registrations of No. 5062344 “玫琳凯/Mary Kay”, No. 8937823 “玫琳凯/maryKay” mark and No. 9032014 “依云/Evian” mark, however, such evidence does not suffice to prove that the registration of the disputed mark was obtained by fraudulent means or other improper means only on the basis of these applications or registrations. In the meantime, Mary Kay Inc. had not mentioned this argument in the invalidation proceedings and the disputed decision was not issued on the basis of this argument either. The fact that Meilinkai Company had changed its name several times had no direct relationship with the determination of whether the registration of the disputed mark was obtained by fraudulent means or other improper means. In sum, it is appropriate for the TRAB and the court of the first instance to decide that the registration of the disputed mark had not violated the Article 41.1 of the Trademark Law (2001).

What can we expect from the New Art 4? 新第4条的展望

7.1 【商标法第四条的适用】

商标申请人明显缺乏真实使用意图，且具有下列情形之一的，可以认定违反商标法第四条的规定：

- (1) 申请注册与不同主体具有一定知名度或者较强显著特征的商标相同或者近似的商标，且情节严重的；
- (2) 申请注册与同一主体具有一定知名度或者较强显著特征的商标相同或者近似的商标，且情节严重的；
- (3) 申请注册与他人除商标外的其他商业标识相同或者近似的商标，且情节严重的；
- (4) 申请注册与具有一定知名度的地名、景点名称、建筑物名称等相同或者近似的商标，且情节严重的；
- (5) 大量申请注册商标，且缺乏正当理由的。

前述商标申请人主张具有真实使用意图，但未提交证据证明的，不予支持。

7.1 Application of Article 4 of the Trademark Law If any trademark applicant obviously lacks the true intention of use and is under any of the following circumstances, this applicant may be determined to violate the provisions of Article 4 of the Trademark Law:

- (1) applying for registration of the **trademark identical with or similar to the marks, which are owned by different subjects, with certain popularity or higher distinctiveness, (and at?)which is regarded as a serious circumstance;**
- (2) applying for registration of the trademark identical with or similar to the marks, which are owned by **same subject**, with certain popularity or higher distinctiveness, (and at?)which is regarded as a serious circumstance;
- (3) applying for registration of the trademark identical with or similar to any other commercial signs other than trademarks of others, which is regarded as a serious circumstance;
- (4) applying for registration of the trademark identical with or similar to any name of place, scenic spot, building and others with certain popularity, which is regarded as a serious circumstance;
- (5) applying for registration of **a large number of trademarks without good reasons.**

If the trademark applicant above claims that he has the true intention of use, but fails to present the relevant evidence, this claim shall not be supported

What can we expect from the New Art 4 - Progress?

新第4条的展望—进步?

- Pre-emptive registration against multiple marks owned by multiple brand owners

- 对不同主体的多个商标进行抢注的行为

Seemingly Yes

看起来是

- Pre-emptive registration against multiple marks owned by one brand owner

- 对同一主体的多个商标进行抢注的行为

Seemingly Yes

看起来是

- Pre-emptive registration against one marks owned by one brand owner

- 对同一主体的同一个商标进行抢注的行为

Yes?

是?

- Pre-emptive registration against signs other than trademarks

- 对商标以外的其他标识的抢注行为

Yes ! Then relationship with Art 32? Famousness requirement ?

是! 与32条的关系? 知名度的要求?

- Large number of registrations without good reason

- 无正当理由大量申请注册

How many?

多少?

- And at serious circumstance

- 情节严重

Then how serious ? How to define seriousness?

多严重? 如何定义严重?

- *Which is regarded as a serious circumstance or And at serious circumstance?*

- 什么情形被视为严重的情节或者情节严重?

Unsolved issue on the New Art 4 / Formal

新第4条的遗留问题/形式

Relationship with other provisions and the applications

与其他条款的关系及其适用

Art 4 v. Art 44:

第4条 v. 第44条

- Difference b/t Art 4 and Art 44?
- 第4条和第44条的不同?
 - 44: requires large number of marks? (But See *Facebook case (3)* and *Amcham case* not that many)
 - 44: 要求大量商标? (但Facebook案(3)和AmCham案中也不是很多)
 - 44: not apply to one brand? (See *Amcham* just have one brand).
 - 44: 不适用于单一品牌? (AmCham案中是单一品牌)

Art 44 theoretically can solve all the issues, but not really in practice.

第44条理论上看起来可以解决一切问题，但实际上不是。

See *Mary Kay v. TRAB and Mei lin kai Co. Ltd*

请参考玫琳凯诉商评委和玫琳凯有限公司案

Joint or independent application with Art 4 ?

与第4条同时或者单独适用?

Intendent application – from legislation - yes (4+

单独适用-从立法角度-是 (4+

辛克营运有限公司 v. TRAB (2018)京行终3912号 (Yes)

Unsolved issue on the New Art 4 / Essential

新第4条的遗留问题/实质

What is the real problem??

真正的问题是什么??

How to recognize bad faith of applicant?

如何认定申请人的恶意?

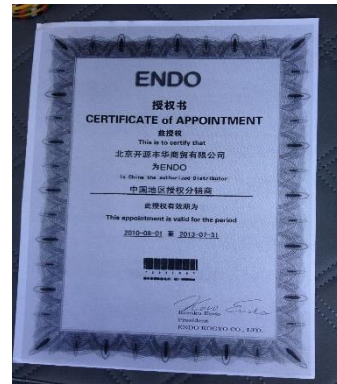
- Imitation of trade names : Mei lin kai Co. Ltd.
- 摹仿商号：玫琳凯有限公司

霍尼薇尔皮具销售部/Honewell Leather

- Imitation of designs:
- 摹仿产品设计:
- Fake authorization:
- 假冒授权书:
- Fake domain names
- 假冒域名
- Use of photo of the brand owner
- 使用品牌所有人的照片
- Piracy of articles/confusing

Advertisements

抄袭、剽窃文章/误导性宣传



Unsolved issue : Art 7 遗留问题：第7条

What is the REAL REAL problem ?

什么是最根本的问题？

- Whether first-to-file is an unshakable principle or it should be re-evaluated by bona fide principle
- 先申请原则是否不可撼动，还是应该根据诚实信用原则重新衡量？
- How to recognize and apply good faith/bona fide principle
- 如何认识和适用诚实信用原则

Art 7.1 Application for registration and use of trademarks shall comply with the principles of honesty and trustworthiness.

第7条1款 申请注册和使用商标，应当遵循诚实信用原则。

What if : Art 7.1 be jointly applied with Art 33 and Art 44.1 to make Art 7 an real/applicable provision. (we have seen in past TMO Decisions Art 7 has been applied with Art 30 (*any applications does not comply with the law*) but rarely by TRAB or Courts)

如果：第7条1款和第33条和第44条1款同时使用，以使第7条成为一条真正可以适用的条款。（我们在商标局的异议裁定中发现了第7条和第30条“凡不符合本法有关规定”同时适用，但很少看到商评委和法院这样适用）

- What is the real intent of the application
- 商标申请的真实意图
- Apply and use to create/develop its own brand ?
- 申请并使用以创造/发展自己的品牌？
- Apply and register to make profits by transfer to other parties ?
- 申请并注册以向其他人转让获利？
- **Apply and register to free-ride the reputation of other brand owners ?**
- 申请并注册以攀附其他品牌所有人的商誉？

Unsolved issue : Art 7
遗留问题：第7条

欺诈毁灭一切
Fraus omnia corrumpit

Increased Punishment against infringer 加重侵权人法律责任

The increase in amount of damages on intentional trademark infringement 提高恶意商标侵权的赔偿数额

*Article 63 The amount of damages for infringement on the exclusive right to use a trademark shall be determined based on the actual loss suffered by the right holder as a result of the infringement; if it is difficult to determine the actual loss, the amount of damages may be determined according to the proceeds gained therefrom by the infringer, if it is difficult to determine both the loss of the right holder and the proceeds gained by the infringing party, the amount of damages may be reasonably determined by reference to the multiples of the trademark royalties. Where an infringer maliciously infringes upon another party's exclusive right to use a trademark, in the case of serious circumstances, **the amount of damages may be determined as not less than one time but not more than five times** the amount that is determined according to the aforesaid methods. The amount of damages shall cover the reasonable expenses paid by the right holder for stopping the infringing act.*

第63条 侵犯商标专用权的赔偿数额，按照权利人因被侵权所受到的实际损失确定；实际损失难以确定的，可以按照侵权人因侵权所获得的利益确定；权利人的损失或者侵权人获得的利益难以确定的，参照该商标许可使用费的倍数合理确定。对恶意侵犯商标专用权，情节严重的，可以在按照上述方法确定数额的一倍以上五倍以下确定赔偿数额。赔偿数额应当包括权利人为制止侵权行为所支付的合理开支。

*Where it is difficult to determine the actual loss suffered by the right holder as a result of the infringement, the proceeds gained by the infringer from the infringement or the royalties of the registered trademark concerned, the people's court shall render a judgment awarding damages in an amount not more than **RMB five million** based on the circumstances of the infringing acts.*

权利人因被侵权所受到的实际损失、侵权人因侵权所获得的利益、注册商标许可使用费难以确定的，由人民法院根据侵权行为的情节判决给予五百万元以下的赔偿。

Applaudable Progress
Punishment against trademark squatter and its agent
可喜的进步
商标抢注人及其代理人的法律责任

- Legal liability of trademark agency representing the bad faith application without intent to use.
- 代理无实际使用意图恶意抢注行为的代理机构的法律责任

Article 19.3.4 Where a trademark agency is or should be aware that the trademark to be registered by the entrusting party falls under the circumstances stipulated in Article 4, 15 or 32 of this Law, it shall not accept the entrustment.

第19条3款 商标代理机构知道或者应当知道委托人申请注册的商标属于本法第四条、第十五条和第三十二条规定情形的，不得接受其委托。

Legal liability of trademark agency : The violation of the provisions of Article 4 of this Law or the third and fourth paragraphs of Article 19 of this Law. As a result, the trademark agencies who handle the applications can be penalized with fines or warnings by enforcement agencies.

商标代理机构的法律责任：商标代理机构违反本法第四条、第十九条第三款和第四款规定的，由工商行政管理部门给予罚款或者警告处分。

- Legal liability of applicants/litigants of the bad faith application/litigation
- 恶意申请/诉讼的申请人/诉讼当事人的法律责任

Article 68.4, Whoever maliciously applies for trademark registration shall be subject to a warning, a fine or any other administrative punishments, as the case may be; and whoever maliciously lodges a trademark lawsuit shall be penalized by the People's Court according to law.

第68条4款 对恶意申请商标注册的，根据情节给予警告、罚款等行政处罚；对恶意提起商标诉讼的，由人民法院依法给予处罚。



Thank you

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