

ANJIE

安杰律师事务所

恶意注册民事侵权和商标确权行政诉讼程序之

民行合一的初步探讨

Preliminary Thoughts on Merging Civil Suit against Bad Faith Trademark Applicants and Trademark Invalidation Action

何菁

He Jing

● 民行程序合一探讨的必要性

Necessity of the coordination between infringement civil case and invalidation administrative litigation

- 《商标法》关于恶意注册商标的规制;
- 目前商标确权行政程序和恶意注册民事责任程序衔接存在的问题;

● 比较法视角 Comparative Research on This Issue

- 美国 (United States)
- 欧盟 (EU)
- 英国 (UK)

● 对中国民行合一制度改革的初步思路

Preliminary Thoughts on the Coordination between Civil and Administrative Lawsuits



中国《商标法》关于“恶意注册”的最新修改

Recent Amendments on

Regulating “Bad Faith Trademarks” in *the Trademark Law of the PRC*

Amendments in the Trademark Law on “Bad Faith Trademarks”

➤ Article 4

“...Any application for bad faith trademark registration **that is not filed for the purpose of use** shall be rejected....”

“...不以使用为目的的恶意商标注册申请，应当予以驳回。”

➤ Article 32

Trademark registration applications shall not harm existing prior rights of others, **use of improper means to forestall registration of a trademark which is in use and has certain impact** shall not be allowed.

申请商标注册不得损害他人现有的在先权利，也不得以不正当手段抢先注册他人已经使用并有一定影响的商标。

➤ Article 45

“... If the registration is **acquired in bad faith**, a well-known trademark holder shall not be subject to the five-year time limit.”
自商标注册之日起五年内，在先权利人或者利害关系人可以请求商标评审委员会宣告该注册商标无效。对恶意注册的，驰名商标所有人不受五年的时间限制。

➤ Article 63

“... If the infringement is **committed in bad faith with serious circumstances**, the amount of damages shall be the amount, but not more than five times the amount, determined in the aforesaid method. The amount of damages shall include reasonable expenses of the right holder for stopping the infringement.”

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。



目前商标确权行政程序和恶意注册民事责任程序衔接存在的问题

**Problems in the Coordination between “Bad Faith Trademark” Civil Actions
and Administrative Litigations on Invalidation**

Coordination Issues between trademark civil and administrative procedures

在商标确权的行政诉讼程序中，原争议的双方当事人变成了原告和第三人，而商标局由争议裁判者变成被告。
In trademark administrative litigations, the adversary parties are the Trademark Office and the applicant/registrant, but not the parties directly related to the disputed mark.



问题：在恶意注册的案件中，当事人如果需要就恶意注册请求民事赔偿的话，需要另行向恶意注册人提起民事诉讼。在此程序模式下，当事人无法在行政程序中提供新的证据，而民事程序又受制于行政程序的结果影响。

Issue: In the case of trademark squatting, the party shall file an additional civil action for remedies. Under that circumstance, the party cannot submit new evidence in the administrative litigation while the outcome of the civil lawsuit is in restraint of the administrative litigation.



建议：是否可以考虑将商标确权行政诉讼和恶意注册的民事诉讼合并审理？

Advice: Is it possible to have the judicial review of administrative litigation and civil action together?

- US rules on the civil liability of trademark squatting
- 美国法关于恶意抢注商标的民事责任条款

§ 1120. Civil liability for **false or fraudulent registration** (15 U.S.C.A. § 1120)

Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, **shall be liable in a civil action by any person injured thereby for any damages sustained in consequence** thereof.

第1120条 任何在申请商标中存在错误或欺诈声明/表示的，不论口头还是书面或通过其它方式的，应当对受害人因错误/欺诈注册造成的损失承担民事责任。

- US rules on civil remedies in the appeal to TTAB decisions
- 美国法关于对TTAB商标确权行政决定上诉的规定

For the **decisions made by TTAB**, the applicant : (§ 21, 15 U.S.C. § 1071)

- (1) can appeal to **the United States Court of Appeals for the Federal Circuit**, OR
 - only under de novo review based on the facts provided by TTAB;
- (2) may **have remedy by a civil action** no less than sixty days after a TTAB decision;
 - supplementary factual evidence is admissible;
 - mostly in **the United States District Court for the Eastern District of Virginia**

对于TTAB做出的商标确权决定，申请人可以：

- (1) 上诉至联邦上诉法院，联邦上诉法院仅对法律问题进行审核；或
- (2) 在收到决定后，可在弗吉尼亚东区地区法院发起民事诉讼请求赔偿；

➤ US rules on civil remedies in the appeal to TTAB decisions

The applicant may **have remedy by a civil action** after the decision made by TTAB: § 21, 15 U.S.C. § 1071(b)

- The definition of an “**adverse party**”
 - Parties in interest as shown by the records of USPTO at the time of the decision being contested
 - To be a party in interest, a party “**must only demonstrate a direct and personal stake in the outcome.**” *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498 (2014)
- In the case where **there is no adverse party** (Applicant v. Director of TTAB)
 - All the expanses, including attorney’s fees, are paid **by the applicant, unless it is unreasonable**, regardless of success.
- In the case where **there is an adverse party** (Applicant v. Adverse Party)
 - The court decides the remedies **according to case circumstances**, for amount above the actual damages, but not exceeding three times such amount.
 - **Attorney fees** to the prevailing party can be awarded if (15 USC § 1117):
 - (1) counterfeit goods were sold in a case that is exceptional (malicious, fraudulent, deliberate, or willful infringement).
 - (2) the violation consists of intentionally and knowingly using a counterfeit designation or mark.

➤ 美国法关于对TTAB商标确权行政决定上诉的规定

当事人就TTAB做出的确权决定发起民事诉讼请求赔偿的：§ 21, 15 U.S.C. § 1071(b)

- 不存在其他相关利益方的情形下（申请人诉TTAB负责人）

不论申请人最后获胜与否，都应当承担TTAB为应诉产生的所有必要支出，包括律师费

- 存在其他相关利益方的情形下（申请人诉相关利益方）
 - “相关利益方” 的定义
 - USPTO做决定时的记录中可以表明有相关利益的当事方
 - *Pro-Football, Inc. v. Blackhorse*, 62 F.Supp.3d 498 (2014)
“相关利益方只需要展示其对决定的结果有直接的个人利益关系 ”
 - 法院会根据案件具体情况决定赔偿数额，但不得超过实际损失的三倍。
 - 例外情况下，法院可以决定应当赔偿胜诉方合理的律师费，例如恶意使用虚假标识等，

➤ **美国法关于行政确权诉讼和恶意注册民事诉讼的安排：**

- 当事人各自承担TTAB确权行政程序中产生的费用。
- 但是，申请人在收到行政确权决定后，可以向利益相关人或TTAB负责人提起民事诉讼请求补偿损失。
- 如果是对TTAB负责人提起民事诉讼的话，申请人应当承担TTAB的所有必要支出。
- 如果是对利益相关人就损失提起民事诉讼的话，法院会根据具体案情决定赔偿数额，例外时胜诉方可获赔律师费。

➤ **Summary**

- Each party **in the administrative procedure bears its own costs** for the proceeding because the Board does not have the resources to decide who is required to pay costs and attorneys' fee.
- Applicants in the administrative process can request a new trial in U.S. District Court against the adverse party in interest for remedy in a **civil action**.
 - Non-adverse: If the applicant file litigation **against the Director of TTAB**, all expenses of TTAB shall be taken by the plaintiff.
 - Adverse: If the applicant files **a civil action against the adverse party** for remedy, the court may decide damages according to the circumstances of the case, and in exceptional cases may award reasonable attorney fees.

- **Bad faith as a factor when deciding the invalidation**
- **恶意注册属于商标无效的绝对情形**

Article 59 Absolute grounds for invalidity

An EU trademark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

.....(b) where the **applicant was acting in bad faith when he filed** the application for the trademark.

第59条 商标无效的绝对情形

一 欧盟商标应当在商标局申请或侵权诉讼的反诉程序中被宣告无效：

(b) 如果申请人在申请商标时存在恶意注册行为的；

➤ **Civil liability of a trademark squatter**

SECTION 2 Costs Article 109 Costs (Regulation (EU) 2017/1001)

1. The **losing party** in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings **shall bear the fees paid by the other party**. Without prejudice to Article 146(7), the losing party shall also **bear all costs incurred by the other party that are essential to the proceedings**, including travel and subsistence and the remuneration of a representative within the meaning of Article 120(1)...

商标行政确权案件中的败诉方应当承担对方当事人因该程序所遭受的必要开支和成本，包括律师、顾问或代理人的报酬、差旅费和生活补贴。具体费用数额根据具体案情变更（如下）。该条有利于遏制恶意注册商标的行为。

“the Board shall fix the amount of costs to be paid by the opponent to the applicants at **EUR 550** for the representation costs with respect to the appeal proceedings. ..”(CFA Institute 560 v. Dietmar Ernst and Joachim Häcker/o DICF)

“These are fixed at **€ 2,500** (i.e. **€ 450** in respect of representation costs before the Cancellation Division, **€ 550** in respect of representation costs before the Board of Appeal, **€ 700** in respect of the cancellation fee and **€ 800** in respect of the appeal fee), (*Brutt Saver Germany GmbH and Industriestr v. Target Fixings Ltd Holpur House 5 Albert Road Crowthorne*)

➤ Trade Marks Act 1994 Section 68

(1) Provisions may be made by rules empowering the registrar, in any proceedings before him under this Act-

- (a) to award any party **such costs as he may consider reasonable**, and 在商标异议程序中，胜诉方可获得费用补偿。
- (b) to direct how and by what parties they are to be paid.

➤ Tribunal Practice Notice (TPN 2/2000) Costs In Proceedings Before The Comptroller

the Tribunal can award costs “**off the scale**” where there have been breaches of the rules, delaying tactics and other unreasonable behavior by a party. 如果当事人存在违规或者不合理性的话，当事人可以获得超范围的费用补偿。

- **Summary:** The successful opponent is entitled to a contribution towards its costs. The tribunal uses a scale of costs to determine the amount of costs, and can award “off the scale” costs to reflect the applicant’s unreasonable and bad faith conducts (including trademark squatting.)
- 英国商标法规定，在商标异议程序中，胜诉方即可获得费用补偿，甚至超范围补偿，无需再另外重新发起一个民事诉讼请求补偿。



对中国民行合一制度改革的初步思路

Preliminary Thoughts on the Coordination between Civil and Administrative Lawsuits

Preliminary Thoughts on the coordination of two types of litigations

- 可以基于《商标法》第七条关于**诚实信用原则**的规定，明确恶意注册人应当承担的民事赔偿责任
- To confirm the civil liability of a trademark squatter by citing the good faith principle under Article 7 of the Trademark Law
- 探索明确**恶意注册的构成要件**；比如，在先商业标识早于涉案商标申请日前存在并延续有效；涉案商标申请人明知或应知在先商业标识的存在；在先商业标识权利主体并无明显怠于行使“商标无效宣告”等行政程序救济的情形；涉案商标权利人并无实际使用的情形与意图
- To establish the constituent elements for identifying “trademark squatting,” for example, the prior mark shall exist prior to the application of the disputed mark and still be effective; the applicant of the disputed mark was already aware of the existence of the prior mark; the right holder of the prior mark did not intentionally delay the use of the right to file opposition/invalidation application; the owner of the disputed mark does not intend to conduct the actual use of the mark;
- 在恶意注册的案件中，**允许当事人在提起商标确权行政纠纷诉讼的同时，提起请求恶意注册人承担赔偿责任的民事诉讼。**
- Permit civil suits against a trademark squatter for remedies simultaneously when filing the trademark administrative litigation on the invalidation/opposition issues.
- 法院可将以上两程序**合并审理**，从而加快纠纷的实质解决，减少了等待行政诉讼案件解决的环节，一次性解决相关问题。
- The court may have a joint action by combining above two litigations, in order to accelerate the dispute resolution without the need to wait for the outcomes of administrative litigations and solving two issue at once.

THANKS