

PROTECTING WELL-KNOWN MARKS AND REPUTED MARKS IN THE EUROPEAN UNION

欧盟对驰名商标和知名商标的保护

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WELL-KNOWN MARKS / REPUTED MARKS 驰名商标/知名商标

Different !! 不同! !

Well-known marks (Art. 6bis Paris Convention).

- registered or unregistered
- protected only against likelihood of confusion (**identical or similar** goods or services)

驰名商标 (《巴黎公约》第6bis条)

- 已注册或未注册商标
- 仅防止混淆可能性 (**相同或近似商品或服务**)

Reputed marks (Art. 8(5) EUTMR)

- only registered
- protected also against **non-similar** goods or services.

知名商标 (《欧盟商标条例》第8(5)条)

- 仅限已注册商标
- 还防止**非近似**商品或服务的侵权

WHAT IS A **WELL-KNOWN MARK** ACCORDING TO THE PARIS CONVENTION? 根据《巴黎公约》，何为**驰名商标**？

Article 6bis was introduced for the first time in the Paris Convention in **1925**;
第6bis条于**1925**年首次引入《巴黎公约》；

- to prevent the registration and use of a trade mark that constitutes a reproduction, an imitation or a translation
- of a mark **already well-known** in the country of such registration
- liable to create **confusion with the well-known mark**,
- even if the **well-known mark is not, or not yet, registered** in that country.
- 防止在一国注册和使用对在该国**已驰名**商标构成复制、模仿或翻译，易与**该驰名商标**导致**混淆**的商标，
- 即便**该驰名商标**未在该国注册。

WIPO Joint Recommendation concerning provisions on the **protection of well-known marks** 世界知识产权组织关于**驰名商标保护**规定的联合建议

- Degree of knowledge/recognition of the mark in the relevant sector of the public
- 该商标在相关公众中的了解或认知程度

Duration, extent and geographical area 持续时间、程度和地理范围

- of **use** of the mark 该商标的使用
- of any **promotion** of the mark – advertising, presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies 该商标的宣传，包括在交易会或展览会上对该商标的商品或服务所做的广告、宣传和展示
- of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or **recognition** of the mark 能反映该商标使用或被**认知**程度的任何注册或任何注册申请
- Record of **successful enforcement** and whether the mark is recognised as well-known by competent authorities 该商标**成功实施**商标权的记录，尤其是为主管机关认定**驰名**的程度
- **Value** associated with the mark 该商标的**相关价值**

https://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm

WHAT IS A WELL-KNOWN MARK IN THE EUROPEAN UNION?

在欧盟，什么是驰名商标？

Article 8(2)(c) EUTMR (earlier marks in opposition proceedings) 《欧盟商标条例》第8(2)(c)条（异议程序中的在先商标）

Trade marks which,

- on the **date of application** for registration of the EU trade mark, or where appropriate, of the **priority** claimed in respect of the application for registration of the EU trade mark,
- are **well-known in a Member State**, in the sense in which the words ‘**well-known**’ are used in **Article 6bis of the Paris Convention**.

满足下列条件的商标：

在欧盟商标注册**申请日**，或在适当情况下，在针对欧盟商标注册申请主张的**优先权日**，

在**成员国**已满足《**巴黎公约**》第**6bis**条所确定的“**驰名**”条件。

WHAT IS A **WELL-KNOWN MARK** IN THE EUROPEAN UNION? 在欧盟，什么是**驰名商标**？

Article 8(2)(c) EUTMR (earlier marks in opposition proceedings)
《欧盟商标条例》第8(2)(c)条（异议程序中的在先商标）

- *Only* protected against likelihood of **confusion**
- 仅防止**混淆**可能性
- with regard to **identical or similar goods or services**
- **针对相同或近似商品或服务**

FUNCTIONS OF A TRADE MARK 商标的功能

- Essential function: identify **commercial origin** – protection against likelihood of confusion (Article 8(1)(b) EUTMR)
基本功能：识别**商品来源**—防止**混淆可能性**（《欧盟商标条例》第8(1)(b)条）
- Other functions: guarantee the **quality** of the goods and services, **advertising** function, **investment** function, particular **image** (such as exclusivity, lifestyle), etc.
- 其他功能：保证商品和服务的**质量**、**广告功能**、**投资功能**、**特定形象**（例如**专有性**、**生活风格**）等
 - These functions are protected under **Article 8(5) EUTMR**, outside the protection offered by likelihood of confusion under Article 8(1)(b) EUTMR.
这些功能由**《欧盟商标条例》第8(5)条**保护，在第8(b)(b)条**混淆可能性**规定的保护范围之外。

Article 8(5) EUTMR. Protecting **REPUTED MARKS**. Requirements 《欧盟商标条例》第8(5)条。保护**知名商标**。要求：

1. Earlier, valid, **registered** trade mark 在先、有效、**已注册**的商标
2. Reputation 声誉 (知名度)
3. **Link** between the signs 标识之间的**关联**
4. Risk of injury 伤害风险
5. **Absence of due cause** **无正当理由**

EARLIER, VALID, REGISTERED TRADE MARK 在先、有效、已注册的商标

- only **registered** trade marks (and applications subject to their registration)
- 仅限**已注册**商标（及其注册申请）
- **non-registered well-known marks** (Article 6bis Paris Convention) are **not** protected under Art. 8(5) EUTMR: **not** protected in relation to dissimilar goods or services
- 《**欧盟商标条例**》第8(5)条**不**保护未注册的驰名商标（《**巴黎公约**》第6bis条）：**非**近似商品或服务相关侵权，**不予**保护



WHAT IS **REPUTATION** ? 什么是**声誉**?

- Quantitative requirement: degree of knowledge of the earlier mark among the relevant public, how large is the segment of the relevant public that knows the mark.
- 定量要求: 在先商标在相关公众中的知名度以及该相关公众范围
- Qualitative aspects: quality image, prestige, uniqueness, public appeal of the reputed mark...
- 定性方面: 品质形象、声望、独特性、知名商标的公众号召力.....
 - These may be significant later on, in order to prove that it has suffered **detriment** or that **unfair advantage** has been taken of it
 - 在用于证明在先商标遭到**损害**或者**不公平利用**方面可能具有重要性

WHAT TO PROVE ? 证明什么?

- a) **Nature of use:** as a trade mark, for the G&S for which it is registered
使用性质: 作为其注册所面向的商品和服务的商标
- b) **Time of use:** reputation must be acquired before the date of priority of the contested mark
使用时间: 必须在涉争商标优先权日之前已获得知名度
- c) **Place of use:** the earlier mark must be reputed in the territory where it is registered (i.e., earlier Italian mark: must be reputed in Italy. Earlier EUTM: reputed in the EU –or at least in a substantial part)
使用地点: 在先商标必须在其注册领土知名 (即, 在先意大利商标: 必须在意大利知名; 在先欧盟商标: 在欧盟知名, 或者至少在欧盟大部分区域知名)
- d) **Extent of use:** known to a **substantial part of the relevant public**. No minimum percentage. Case by case assessment.
使用范围: **被相关公众的一大部分所知晓, 无最低比例要求, 逐案评估。**

MEANS OF EVIDENCE 证据形式

- **company profiles, annual reports 公司资料、年报**
- **Affidavits 宣誓书**
- **statements from third parties 第三方声明**
- **market surveys 市场调查**
- **ranking, recognitions, awards 排名、表彰、奖项**
- **press articles 新闻稿**

MEANS OF EVIDENCE 证据形式

- sales turnover, **market share** 销售额、**市场份额**
- invoices, delivery notes 发票、交货单
- **advertising** expenditure **广告支出**
- advertising and promotional material 广告和宣传资料
- sponsorship of cultural, sports events, merchandising 文化体育活动
赞助、销售规划
- previous national or EU court decisions 成员国或欧盟法院判例
- successful enforcement track record 成功的权利行使记录

LINK BETWEEN THE SIGNS 标识之间的关联

- In order to find an injury under Article 8(5) EUTMR, the **relevant public** must establish a **link** between the marks (LoC not necessary)
要构成《欧盟商标条例》第8(5)条规定的损害，**相关公众必须在标识之间建立关联**
(不以混淆可能性为必要条件)
- A link exists when **the later mark calls the earlier trade mark to mind**
- **在后商标引发对在先商标的联想，即存在关联**



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Coca-Cola

- (unusual) Spenserian script **斯宾塞字体** (不常见)
- ‘tail’ of the M calls to mind the ‘tail’ of the first ‘C’ in Coca Cola **字母M的尾巴让人联想到可口可乐首字母C的尾巴**

LINK BETWEEN THE SIGNS 标识之间的关联



Master



Coca-Cola

- ✓ similarity of signs 标识的近似性
 - lower level required than for likelihood of confusion: only to the extent that the contested mark calls the earlier reputed mark to mind
 - 比混淆可能性的要求低: 涉争标识仅引起对在先知名商标的联想
- ✓ degree of reputation 知名度
- ✓ overlap of public 公众的重叠
 - spillover beyond the relevant public for the G&S of the earlier reputed mark
 - 超过在先知名商标对应商品和服务的相关公众范围
- ✓ proximity of the market sectors 市场行业的接近度

THREE FORMS OF INJURY 三种损害形式

- a) **FREE RIDING: unfair advantage** taken of the repute or distinctive character of the earlier reputed mark
搭便车：攀附在先知名商标的声誉或显著特征

- b) **DILUTION: detriment to the distinctive character** of the earlier reputed mark
淡化：有损在先知名商标的显著特征

- c) **TARNISHMENT: detriment to the reputation** of the earlier reputed mark
丑化：有损在先商标的声誉

a) Free riding 搭便车

- *exploitation and ‘free-riding on the coat-tails’ of a famous mark,*
- *or an attempt to trade upon its reputation*
- *对知名商标进行攀附或搭便车，或试图利用其知名度谋利*

- **The nature of the injury 损害的性质**
- Unfair advantage focuses on the benefit to the later mark rather than on the harm to the earlier mark
- 攀附方面，重点在于在后商标的获利，而非在先商标的损失
- Art. 8(5) prohibits the exploitation of the earlier reputed mark by the proprietor of the later mark.
- 第8(5)条禁止在后商标权利人攀附在先知名商标

a) Free riding 搭便车



theatre productions 戏剧制作

ROYAL SHAKESPEARE

*non-alcoholic and alcoholic drinks, providing of food and drinks
非酒精和酒精饮料, 供应食品饮料*

General Court: the EUTM applicant would benefit from the power of attraction, the reputation and the prestige of the earlier trade mark for its beers and other beverages and services of providing food and drinks.

普通法院：在先商标的吸引力、声誉和声望会使商标申请人的啤酒和其他饮料及其供应服务获利。

- **Exceptional reputation** of the earlier mark 在先商标的卓越声誉
- Certain **proximity** between the goods and services at issue 涉争商品和服务之间的特定接近性
- The relevant UK public would be able to make a **link** when seeing a beer with the contested trade mark in a supermarket or in a bar 相关英国公众在商超或酒吧看到带有涉争商标的啤酒时, 会产生关联。

b) Dilution (detriment to the distinctive character of the earlier mark) 淡化 (伤害在先商标的显著特征)

Use of the later mark leads to the **dispersion of the identity of the earlier mark**.
在后商标的使用会**稀释在先商标的特性**。

The reputed mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is **weakened**

该知名商标识别对应商品和服务来自商标权利人的功能**被削弱**

- Relevant public : Average consumers of the goods or services of the earlier reputed mark.
- 相关公众：在先知名商标的商品或服务的普通消费者
- ‘change in the economic behaviour’ or a serious likelihood that such a change will occur in the future.
- 经济行为发生变化或未来发生该变化的较高可能性
- Higher standard of proof : it is possible to use logical deductions, not mere suppositions, but must be founded on an **analysis of the probabilities** that takes account of the normal practice in the relevant commercial sector and all the other circumstances of the case.
- 证明标准更高：可使用逻辑演绎，而非单纯假设，但必须在考虑相关行业常规做法、该案所有其他情节后，通过**可能性分析**形成依据。

c) Tarnishment (detriment to the repute) **丑化** (损害声誉)

➤ **The nature of the injury 损害的性质**

An association which is degrading to the image, prestige of the earlier mark.
损害在先商标形象、声望的联想。

➤ **Relevant public 相关公众**

Average consumers of the goods or services of the earlier reputed mark.
在先商标商品或服务的普通消费者。

➤ **The assessment 评估**

Use of the contested mark would prompt inappropriate or negative mental associations with the earlier trade mark, or associations conflicting with the image it has acquired in the market.
涉争商标的使用会引起对在先商标的不当或负面心理联想，或与在先商标已在市场获得的形象相冲突的联想。

c) Tarnishment 丑化

EMILIO PUCCI

clothes and shoes for women

女装和女鞋

Emidio Tucci

non-perfumed toilet paper

无香厕纸

General Court: use of the sign ‘Emidio Tucci’ in respect of toilet paper is likely to cause undesired and negative associations with the earlier mark ‘Emilio Pucci’ which has acquired reputation in the luxury clothing sector.

普通法院：在厕纸领域使用Emidio Tucci标识，对业已在高级时装行业获得知名度的在先商标Emilio Pucci可能引起负面不良联想。

HOW TO PROVE THE RISK OF INJURY 如何证明损害风险

Evidence of actual infringement 实际侵权的证据?

Contested mark in opposition:
异议申请中的涉争商标

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Contested mark as used in trade:
商业使用中的涉争商标:



Coca-Cola

HOW TO PROVE THE RISK OF INJURY 如何证明伤害风险

Evidence of actual infringement 实际侵权的证据

*GC: it is possible to take into account any evidence intended to facilitate the analysis of the probabilities as regards the **intentions** of the proprietor of the trade mark applied for, and — a fortiori — any evidence relating to the **actual commercial use** of the mark applied for.*

*普通法院：关于商标权利人的**意图**，可以考虑任何有助于可能性分析的证据，当然更可以考虑与商标**实际商业使用**相关的证据。*

*The evidence produced by Coca-Cola manifestly constitutes relevant evidence for the purposes of establishing such a **risk of free-riding***

*可口可乐提供的证据显然构成**搭便车等风险**的相关证据*

(judgment of 11 December 2014, T-480/12, ‘Master’, paragraphs 88-90)

(2014年12月11日 T-480/12 号案件判决书，“正文”部分第88-80段)

ABSENCE OF **DUE CAUSE** 无正当理由

- Successful due-cause defence - extremely rare
- 依据“正当理由”成功抗辩的个案数量极少

- Examples of possible justifications 可能的抗辩理由，试举例：
 - A previous agreement expressly authorised use of the mark
 - 在先协议对该商标作出明确授权
 - longstanding, undisturbed coexistence in the same market
 - 长期、互不干扰地共存于同一市场

- Burden of proof reversed 举证责任倒置

- Due cause to be examined only if the other conditions of Article 8(5) are otherwise met 只有当第8(5)条其他条件均满足后，才考察正当理由



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