



Bad faith

Legislation and practices on bad faith
trademarks registration

规制恶意商标注册

立法与实践



Bad faith – Legislation

恶意注册 – 立法

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

欧洲议会和欧洲理事会2015年12月16日第2015/2436号指令，以协调成员国有关商标的法律

Article 4(2)
第4条第2款

A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in **bad faith** by the applicant. Any Member State may also provide that such a trade mark is not to be registered.

申请人**恶意**申请商标注册的，商标可被宣告无效。成员国亦可对该商标做出不予注册决定。

The Danish Trademarks Act provide for both refusal of application and invalidation of registrations on the basis of “bad faith”.

丹麦商标法规定，“恶意注册”是驳回商标注册申请和宣布商标注册无效的理由。



The concept of “Bad faith” “恶意”概念辨析

Bad faith presupposes a **dishonest state of mind or intention**

“恶意”以不诚实信用的主观状态或意图为前提。

“Undermining interests of a Third Party”

“损害第三方利益”

- Application is filed not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties
 - 商标注册申请不以参与公平竞争为目的，其目的在于损害第三方利益

“Abuse of the Trade Mark system”

“滥用商标制度”

- Application is filed with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trademark
 - 商标注册申请系以获得商标功能以外的专有权为目的，甚至不针对特定的第三方



The concept of “Bad faith” “恶意”概念辨析

The assessment of “bad faith” – a fact based assessment
基于事实判断是否存在“恶意”

- A finding of “bad faith” **does not require** absolute and irrefutable evidence of the applicants actual “bad faith” intentions or state of mind
对“恶意”的认定**无需**能够证明申请人“恶意”主观状态或意图的毋庸置疑、无可辩驳的证据
- On the contrary, bad faith can be established on the basis of the **objective circumstances of the case, taking into account all relevant factors**
相反，可以根据案件的**客观情况**，综合考虑相关因素，判断是否存在“恶意”。



The concept of “Bad faith” “恶意”概念辨析

“Relevant factors” “相关因素”

All factual circumstances must be taken into account, and no finite list of factors can be given. However, a number of frequently occurring factors can be identified: 必须全盘考虑实际情况，因此不存在完整罗列“相关因素”的清单。不过，有些因素较常出现：

- The Applicants knowledge of the earlier right 申请人知悉在先权利
 - Is it a reputed Trade Mark? A “luxury” Trade Mark? A Trade Mark that is gaining momentum internationally? 是否为知名商标？“奢侈品”商标？处于全球名气上升期的商标？
 - Has the applicant “copied” a complex mark? How likely is it that the applicant could have developed the mark without knowing the earlier mark? 申请人是否对复杂商标进行了“拷贝”？在不知悉在先商标的情况下，申请人独立设计在后商标的可能性有多大？
- The commercial logic behind the application 注册申请背后的商业逻辑
 - Has the applicant given a convincing explanation for applying for that exact Trade Mark? 申请人是否已就申请该商标作出了合理的解释？
 - And if so – is the reason consistent with “fair competition”? 如果是一一解释的理由是否合乎“公平竞争”原则？
 - Or is the applicant silent on the reasons for filing the application? 亦或申请人对提出注册申请的理由闭口不谈？



Bad faith – Practice

打击恶意注册 – 实践

“Bad faith” trademark registrations is not a new concept ”

恶意“商标注册并非新现象

Danish Supreme Court decision of 13th February 1924

丹麦最高法院1924年2月13日的裁决

“Ranja”registered by Danish company in 1921 for i.a. “Lemonade” 丹麦公司为“柠檬水”注册的“Ranja”商标

Dutch company filing Danish TM application for “Ranja – C P”in 1922 荷兰公司于1922年提交了丹麦商标申请“Ranja-C P”

Danish Supreme Court: 丹麦最高法院 :

“misappropriation of rights” “盗用权利”



Bad faith – Practice 打击恶意注册 – 实践



Danish Maritime and Commercial Court decision of 24 June 1999 丹麦海事和商事法院1999年6月24日的裁决

RED LOBSTER registered by a Danish National in 1995
1995年，一位丹麦自然人申请注册“RED LOBSTER”（红龙虾）商标

Red Lobster was at the time of filing a famous brand for a chain of restaurants in the USA
红龙虾是当时知名的美国连锁餐饮品牌

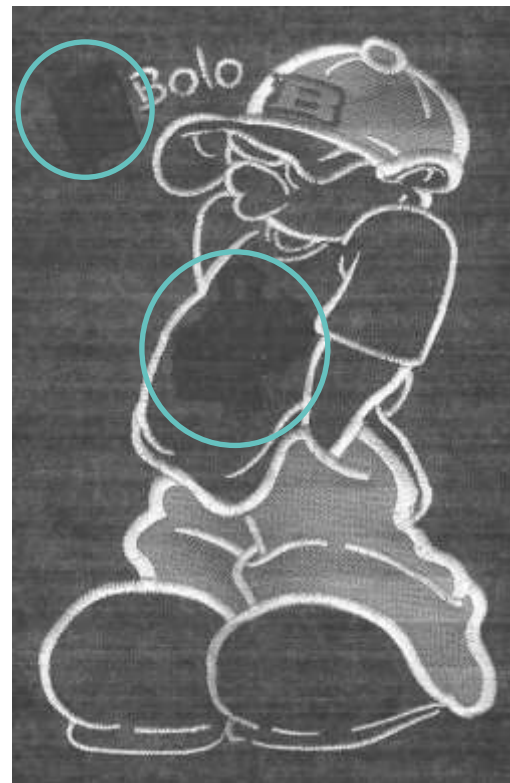
- Turnover in 1995 ~ 1.7 billion USD 1995年营业额接近17亿美元
 - 650 restaurants in the US 在美国共有650家餐厅
- Bought food products from 37 countries world wide, including from Denmark 从全球37个国家（包括丹麦）采购食材

“Bad faith” “恶意”注册



Bad faith – Practice

打击恶意注册 – 实践





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Bad faith – Practice 打击恶意注册 – 实践

C - 320/12, Malaysia Dairy Industries Pte. Ltd vs. Danish Board of Appeal
马来西亚乳业公司诉丹麦上诉委员会

Danish Supreme Court Decision of April 3, 2014 丹麦最高法院2014年4月3日的裁决

- Earlier Japanese design and trade mark (Japanese owner) 日方系在先外观设计和商标的权利人
- Registered by Malayan applicant in Malaysia 马方（马来西亚乳业公司）后在马来西亚申请注册商标
- Co-existence agreement between parties in relation to some jurisdictions in Asia 双方就亚洲某些地区订立了共存协议
- Application filed in Denmark in 1995 but mark never used in EU by the Malayan applicant 1995年，马方在丹麦申请注册商标，但之前从未在欧盟使用过该商标
- Japanese proprietor has used the mark in the EU (factory in Holland since 1994) 日方已在欧盟使用该商标（1994年即在荷兰设立工厂）

Danish Supreme Court 丹麦最高法院

Application filed by the Malayan company with the intention to block the competitor from the European market 马方申请注册商标，目的是为了阻止竞争对手进入欧洲市场

“Bad faith” established 认定“恶意”注册





Summary

总结

- The assessment of bad faith is a fact based assessment 对“恶意”的判断要基于事实
- The aim of the assessment is to determine the (likely) intentions of the Trade Mark Applicant when filing the application 目的是明确申请人在申请注册商标时（较为可能的）意图
- All relevant circumstances must be taken into account in the assessment 必须全盘考虑相关情况
- A finite list of relevant factors cannot be made and all cases must be examined on the basis of the merits of each case 不存在完整罗列“相关因素”的清单；必须根据个案是非曲直进行审查
- Most common reasons for filing in “bad faith” is misappropriation of a third parties rights or the attempt to block a market or force a “partnership” upon the original rightsholder “恶意”注册的最常见原因是盗用第三方权利、妨碍市场竞争、强迫在先权利人进行“商业合作”

If the objective circumstances of the case points to a sinister motive on the part of the Trade Mark Applicant, then a ruling of “bad faith” is appropriate 如果案件的客观情况表明，商标申请人动机险恶，则应裁定“恶意”注册



Thank you for your
attention



感谢聆听

