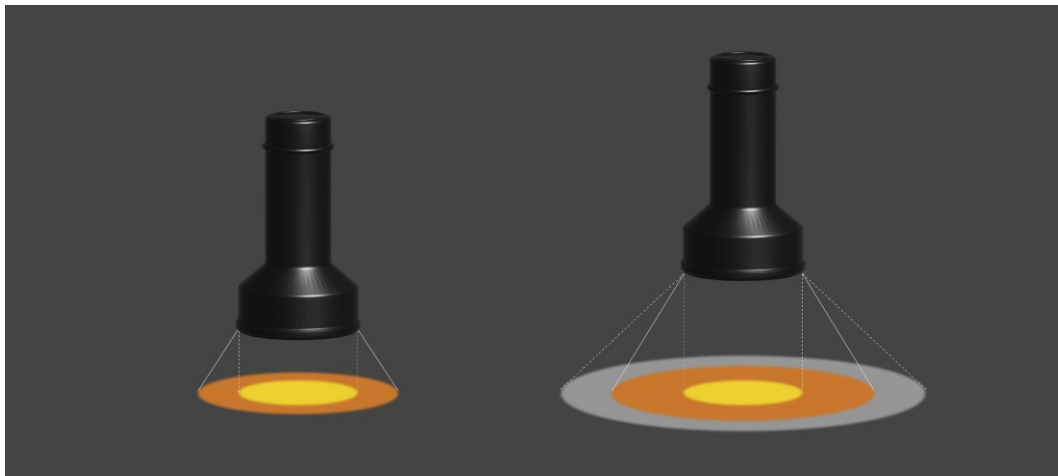


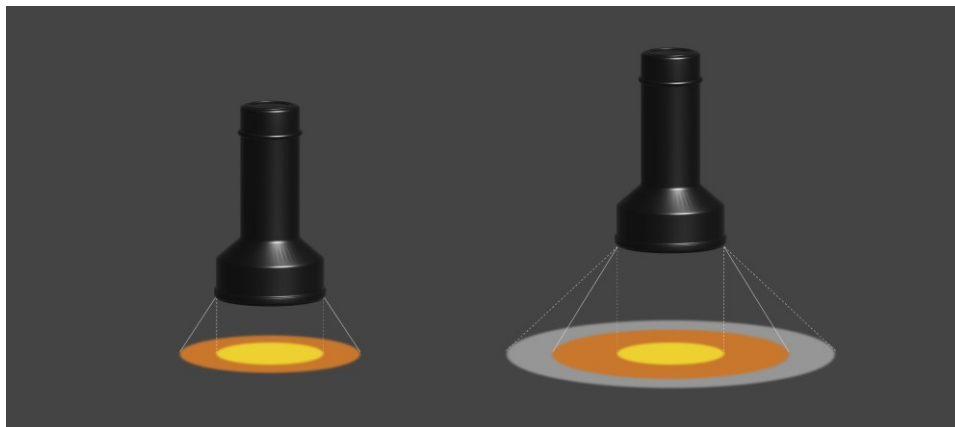
# Well-known Trademarks Protection 驰名商标保护

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Protection of **consumers**  
保护**消费者**  
against  
**Confusion 避免混淆**

Protection of consumers 保护**消费者**  
**Confusion 避免混淆**  
(wider circle) (更大的**圆圈**)  
Protection of **Trademark owner** 保护**商标**  
权利人  
**Association 避免联系**  
Blurring 减弱**显著性**  
Tarnishment 贬损**市场声誉**  
Parasitism 搭便车



## Risk of confusion for unregistered well-known trademarks 未注册驰名商标的混淆风险

### ○ Article 13.2 TML 《商标法》第13条第2款

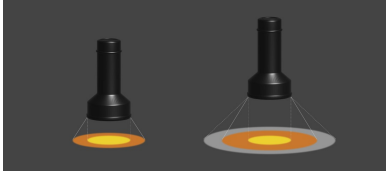
- *Where a trademark applied for registration in respect of identical or similar goods is a duplication, imitation or translation of other person's well-known trademark, which has not been registered in China and the applied trademark is likely to cause confusion, it shall not be allowed for registration and shall be forbidden from practical use.* 就相同或者类似商品申请注册的商标是复制、摹仿或者翻译他人未在中国注册的驰名商标，容易导致混淆的，不予注册并禁止使用。



- **SPC Interpretation on administrative trademark disputes (2017)**  
**最高法院关于审理商标授权确权行政案件若干问题的规定〔2017〕**

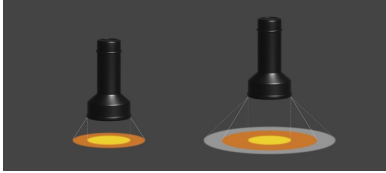
(Art 12): **flexibility** (第12条) : **灵活度**

1. *The extent of similarity of the trademarks*; 商标标志的近似程度;
2. *The extent of similarity of the goods on which the trademarks are designated to be used*; 商品的类似程度;
3. *The extent of distinctiveness and reputation of the trademark that requests protection*; 请求保护商标的显著性和知名程度;
4. *The degree of attention of the relevant public; and 相关公众的注意程度*; 以及
5. *Other pertinent factors.* 其他相关因素。



- **Risk of association for registered trademarks 注册商标的联系风险**
  - **Article 13.3 TML 《商标法》第13条第3款**
  - *Where a trademark applied for registration in respect of **different goods** is a duplication, imitation or translation of other person's well-known trademark which has been registered in China and the applied trademark is **likely to mislead** the public and **harm the interests** of the registrant of the well-known trademark, it shall not be allowed for registration and shall be forbidden from practical use.*

就**不相同商品**申请注册的商标是复制、摹仿或者翻译他人已经在中国注册的驰名商标，**误导**公众，致使该驰名商标注册人的**利益可能受到损害的**，不予注册并禁止使用。
  - **"Mislead..."** is ... misleading and implies a certain degree of confusion... **“误导”** 二字具有误导性，并暗示存在一定程度的混淆.....



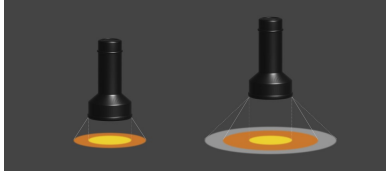
## TRIPS 16.3 《与贸易有关的知识产权协定》第16条第3款

*Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.*

《巴黎公约》（1967）第六条之二在细节上作必要修改后应适用于与已注册商标的货物或服务不相类似的货物或服务，只要该商标在对那些货物或服务的使用方面可表明这些货物或服务与该注册商标所有权人之间存在联系，且此类使用有可能损害该注册商标所有权人的利益。

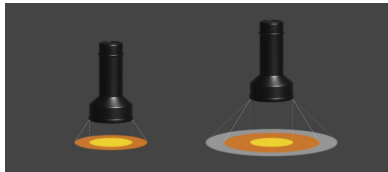
"indicate a connection" ... not the same as ..... "mislead" “存在联系”与“误导”不同





- **SPC Interpretation 2009** on civil disputes involving wellknown trademarks (Article 9.2)  
**最高法院**关于审理涉及驰名商标保护的民事纠纷案件应用法律若干问题的**解释**（法释〔2009〕3号，第9条第2款）
- About Article 13.3 TML 关于《商标法》第13条第2款
- **The terms “mislead the public and cause harm to the interests of the registrant of the well-known trademark” mentioned in the second paragraph of Article 13 of the Trademark Law refer to an infringing trademark, which may cause the relevant public to believe that it has a considerable degree of association with an existing well-known trademark in such a way as to blur the distinctiveness of the well-known trademark or tarnish its market reputation, or which improperly takes advantage of the well-known trademark’s market reputation.**

足以使相关公众认为被诉商标与驰名商标具有相当程度的联系，而减弱驰名商标的显著性、贬损驰名商标的市场声誉，或者不正当利用驰名商标的市场声誉的，属于商标法第十三条第二款规定的“误导公众，致使该驰名商标注册人的利益可能受到损害”。



- **SPC Interpretation 2017 (Art 13)**

## 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〔2017〕，第13条

1. *The **distinctiveness and extent of reputation** of the Cited trademark;* 引证商标的显著性和知名程度;
2. *Whether the **trademarks are sufficiently similar**;* 商标标志是否足够近似;
3. *The **goods** on which the trademarks are designated to be used;* 指定使用的商品情况;
4. *The **extent of overlapping of the relevant public and the degree of attention thereof**;* 相关公众的重合程度及注意程度;
5. *Signs similar to the Cited trademark that are legitimately used by other market entities or other pertinent factors.*  
与引证商标近似的标志被其他市场主体合法使用的情况或者其他相关因素。

## Draft amendment 《商标法》修订草案

- Article 13 of the TML is split in two: 将第13条一拆为二：
  - Article 10 combines 13.1 and 14 TML 第10条结合《商标法》第13条第1款和第14条
  - Article 18 corresponds to 13.2 and 13.3 TML plus a new paragraph 第18条对应《商标法》第13条第2款、第3款，并新增一段

## Draft Article 10 《商标法》修订草案第10条

- 10.1 = 13.1 TLM (no change) 第10条第1款 = 《商标法》第13条第1款 (无变化)
- 10.2: case by case confirmation 第10条第2款: 个案确认
- 10.3: scope of protection proportional to distinctiveness and reputation 第10条第3款: 驰名商标的保护范围和强度应当与其显著特征和知名度相适应
- 10.4: status of WKTМ is a fact to be confirmed or handling a case 第10条第4款: 商标驰名情况应当.....作为处理涉及商标案件需要认定的事实进行确认。
- 10.5: same criteria of recognition 第10条第5款: 确认商标驰名情况的因素不变
  - Degree of recognition by **relevant public 相关公众**对该商标的知晓程度
  - Duration, method, geographical scope of use 商标使用的持续时间、方式和地域范围
  - Publicity (duration, extent, geographical scope) 商标的任何宣传工作的持续时间、程度和地理范围
  - Number of registrations (at home and abroad) 商标在国内和国外的申请及注册情况
  - Record of protection as a WKTМ 商标受保护的记录, 尤其是作为驰名商标受保护的记录
  - **Value** of the trademark (*needs more explanation*) **商标**的价值 (需要进一步解释)

## Draft Article 18 《商标法》修订草案第18条

18.1 → 13.2 TLM (no change) 第18条第1款 → 《商标法》第13条第2款 (无变化)

18.2 → 13.3 TLM (three words deleted) **第18条第2款** → 《商标法》第13条第3款 (删去三处)

- *If a trademark, for which an application for registration is made, or which is used, for **dissimilar** commodities, is a reproduction, imitation or translation of a well-known trademark **registered in China**, which is **misleading the public and may cause harm** to the interests of the holder of the well-known trademark, it shall not be used and shall not be registered.* 在**不相类似**商品上使用、申请注册的商标是复制、摹仿或者翻译他人**在中国注册的**驰名商标，**误导公众**，致使该驰名商标持有人的**利益可能受到损害的**，禁止使用并不予注册。
- The "**cross category**" protection (→ dissimilar goods) is extended to all well-known trademarks, registered or unregistered. "**跨类**" 保护 (→ 不相类似商品) 扩展至所有已注册或未注册的驰名商标。
- However, the **misleading word "misleading"** is still in place 然而，**具有误导性的 "误导" 二字**依然存在

## Draft Article 18.3 《商标法》修订草案第18条第3款

- *If a trademark, for which an application for registration is made, or which is used, is a reproduction, imitation or translation of a trademark which is **well-known** to the **general public**, which is sufficient to make the **relevant public** believe that the said trademark and the well-known trademark are **related to a certain extent**, thereby **weakening the distinctiveness** of the well-known trademark, or **tarnishing its market reputation**, or taking **undue advantage** of the market reputation of the well-known trademark, the applied trademark shall not be used and shall not be registered.*

使用、申请注册的商标是复制、摹仿或者翻译他人为**广大公众**所**熟知**的驰名商标，足以使相关公众认为该商标与该驰名商标具有**相当程度的联系**，而**减弱**驰名商标的**显著特征**、**贬损**驰名商标的**市场声誉**，或者**不正当利用**驰名商标的**市场声誉**的，禁止使用并不予注册。

## Draft Article 18.3 《商标法》修订草案第18条第3款

- This new article corresponds to the SPC interpretation of 2009 (article 9.2). 本条对应最高法院2009年司法解释的第9条第2款。
- Applies to **registered and unregistered** trademarks 适用于**注册和未注册**商标
- **Applies to identical /similar goods.** 适用于**相同/类似商品**。

### CONCLUSION: 结论:

- Article 18.2 should be deleted (contradiction with 18.3) **第18条第2款应当删除 (与第18条第3款矛盾)**

## Which public? 哪个公众?

- SPC 2009: interpretation of Article 13.3 TML → "*relevant public*" 最高院2009年对商标法第13条第3款的司法解释 → “相关公众”
- Draft Article 10: definition of a well-known trademark → "A trademark well-known to the *relevant public*"..."the degree of recognition of the trademark by the *relevant public*" 《商标法》修订草案第10条：驰名商标的定义 → “为相关公众所熟知的商标” ..... “相关公众对该商标的知晓程度”
- Draft Article 18.3: "well-known to the **general public** "... make the *relevant public* believe that ...« 《商标法》修订草案第18条第3款： “为**广大公众**所熟知” ..... “使**相关公众**认为.....”



## Which public? 哪个公众?

- "General public" “广大公众”
  - Too high 标准太高
  - Contradicts Article 10 (Draft) which defines the well-known trademarks (relevant public) 与《商标法》修订草案第10条对驰名商标的界定相矛盾（相关公众）
- European Court of Justice – *Intel vs. CPM United Kingdom* - 27/11/2008  
欧洲法院：**英特尔诉CPM英国** – 2008年11月27日
  - If the harm caused is **dilution**, or **tarnishment**, → relevant public consumers of the goods designated by the **plaintiff's trademark** 如果造成的损害是商标**淡化或贬损** → 相关公众是**原告商标**指定商品的相关消费者
  - If the harm is **taking undue advantage** of the reputation → relevant public is consumers of the goods designated by the **defendant's trademark** 如果造成的损害是**不正当利用**商标市场声誉 → 相关公众是**被告商标**指定商品的相关消费者

## About damages 关于损害赔偿

- All the articles on well-known trademarks end up with: 关于驰名商标的条款均有如下表述:

" [the trademark] .....*shall not be registered and its **use shall be prohibited***".

" [商标] .....**禁止使用**并不予注册" 。

- Therefore → refusal or invalidation + injunction to stop using 因此 → 驳回申请或宣告无效 + 禁制令 (禁止使用)
- But, how about damages ? Compensation for the prejudice caused by infringement? 但是，侵权造成的损害赔偿如何处理？

# Damages 损害赔偿

- Article 57 TML → **Article 72 Draft : definition of infringement** 《商标法》第57条 → 《商标法》修订草案第72条：**侵权的定义**
  - Identical sign on identical goods 在同一种商品上使用与其注册商标相同的商标
  - Similar sign on identical goods 在同一种商品上使用与注册商标近似的商标
  - Identical or similar sign on similar goods → risk of confusion 在类似商品上使用与注册商标相同或者近似的商标 → 容易导致混淆的

## For registered trademarks 对于注册商标

- No provision concerning the infringement of well-known trademarks (either unregistered or registered but used on dissimilar goods). 没有关于侵犯驰名商标专用权（在不相类似商品上使用未注册或已注册驰名商标）的条款。
- **It should be added in the law that violation of WKTМ is an act of infringement 应在《商标法》修订草案中补充：违法使用驰名商标属于侵犯注册商标专用权**

# Damages 损害赔偿

- **Registered well-known trademarks: 注册驰名商标:**
  - SPC Interpretation (civil cases) 2002 - Article 1.2 最高院 关于审理商标民事纠纷案件适用法律若干问题的解释〔2002〕，第1条第2款
    - Using a sign identical or similar to a registered well-known trademark is an "**act causing other harm to a registered trademark**" 使用与注册驰名商标相同或者近似的标志，属于“给他人注册商标专用权**造成其他损害**的行为”
    - Therefore, qualified as an act of infringement 因此，构成**侵权行为**

# Damages 损害赔偿

- **Unregistered well-known trademarks: 未注册驰名商标:**
  - France: Article L713-5 of IP Code : Not infringement, but civil liability 法国知识产权法典第L713-5条：非侵权行为，系民事责任
  - Beijing IP Court – **Xinhua Dictionary** (The Commercial Press vs. Sinolingua) 28/12/17  
北京知识产权法院——**新华字典**（商务印书馆诉华语出版社），2017年12月28日



- "Xinhua Dictionary" → unregistered well-known trademark “新华字典” → 未注册驰名商标
- Unfair competition : the product is famous / the decoration is peculiar → "source identifier"  
不正当竞争：知名商品 / 特有包装装潢 → “商品来源的识别作用”
- Therefore, injunction to stop using 因此，禁止使用

# Damages 损害赔偿



- Damages ... **Tort Liability Law: 损害赔偿.....侵权责任法:**
  - When **civil rights** are violated, the violator should compensate the damage caused **民事权利受到侵害的**, 侵权人应当赔偿所造成的损害
  - **Trademark rights are civil rights 商标权是民事权利**
  - The Tort Liability law does not distinguish between registered and unregistered trademarks 侵权责任法不区分注册商标和未注册商标
  - Therefore, damages are due, and even in this case, **punitive damages** 因此, 侵权人应当承担损害赔偿 (甚至是**惩罚性损害赔偿**) 责任
- The case was selected as **SPC's Top 10 IPR Cases in 2017** 入选**最高院2017年十大知识产权案件**

## The punitive damages ... 惩罚性赔偿.....



- Illegal profit was calculated : RMB 2,293,017 经计算，违法所得为2,293,017元
- The court decided to impose punitive damages :  $x 1.5 = 3,439,600$  RMB 法院认定适用惩罚性赔偿 (1.5倍) ， 即3,439,600元
- However, the claim was 3 million 然而， 由于原告索赔金额为300万元
- So, the court awarded 3 million ... 法院判决给予300万元赔偿.....

*A matter to be discussed...* (punitive damages are a Common Law concept which needs to be adapted)  
有待讨论..... (惩罚性赔偿是普通法概念， 需要进行相应修改)

## About the use of trademarks 关于商标的使用

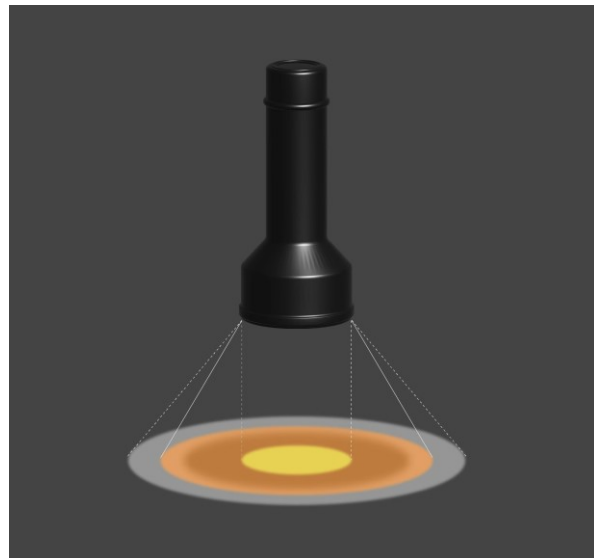
- The Declaration of intent to use, a US concept 使用意向声明（美国法律概念）
- The EU solution: link protection and use 欧盟方案：将保护和使用相联系
  - If a trademark is registered for more than 5 years, 如果商标注册时间超过5年，
  - The defendant (opposition, invalidation, civil action) may request evidence of use 被告（在商标异议、请求宣告无效、民事诉讼程序中）可以要求提供使用证据



## Defensive trademarks 防御性商标

The need for defensive trademarks is proportional to the difficulty to obtain the recognition of the well-known status, on a case by case basis.

注册防御性商标的必要性应与认证驰名商标的难度相称，根据案件的具体情况而定。



THANK YOU!  
感谢!