

Methods for challenging bad faith filings 应对恶意注册的方法

TRAB OF SAIC
工商总局商标评审委员会
Liu Yinying 刘胤颖
2016.12

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Art.7.1 PRC TM Law

商标法第七条第一款

Any application or usage of a trademark shall
abide by **principles of good faith**.

申请注册和使用商标，应当遵循诚实信用原则。

- New article in the TM law.

商标法新增条款

- It is the principle of law, not the specific
rules of law.

该款系原则性规定，并不是具体条款。

Art.15.1 PRC TM Law

商标法第十五条第一款

Where an agent or representative, without the
authorization of the principal, seeks to register
the principal's trademark in the agent's name
and where the principal objects, registration
shall be refused and the use of the mark shall
be prohibited.

未经授权，代理人或者代表人以自己的名
义将被代理人或者被代表人的商标进行注
册，被代理人或者被代表人提出异议的，
不予注册并禁止使用。

Art.15.1 PRC TM Law

商标法第十五条第一款

- > Agent:
not only trademark registration agent, or agent in the civil law, also including the distributors
代理人：不限于商标注册代理人，以及存在民法上的民事代理关系的代理人，也包括经销商。
- > Representative:
Legal representative, director, supervisor, manager
代表人：法定代表人、董事、监事、经理等企业高级管理人员。

Art.15.1 PRC TM Law

商标法第十五条第二款

Where a trademark for which a registration is applied is identical or similar to an early used trademark of another party that is not registered, in respect of the same or similar goods, and where the applicant being of contract, business or other relationship except the relationship referred to in the preceding paragraph, is fully aware of the existence of the trademark owned by the other party, the trademark shall not be registered, if the other party raises an opposition.

就同一种商品或者类似商品申请注册的商标与他人已在先使用的未注册商标相同或者近似，申请人与该他人具有前款规定以外的合同、业务往来关系或者其他关系而明知该他人商标存在，该他人提出异议的，不予注册。

Art.32 PRC TM Law

商标法第三十二条

No trademark application shall infringe upon another party's existing prior rights. Nor shall an applicant rush to register a mark in an unfair manner which is already in use by another party and enjoys certain influence.

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。

- > An very important paragraph to prevent registrations on bad faith.
制止恶意抢注的重要条款
- > The bad faith VS Certain influence
恶意 VS 一定影响

搜 狗
sougou

1. SOHU company is well-known enterprises in the field of the Internet. On August 3th, 2004, SOHU company officially launched the Chinese professional search site "Sogou" (www.sogou.com). Many of the media had reported this event.

2. On August 4th, 2004, a company from Beijing filed the registration of sougou mark.

- > Generally the evidence of use should be the use of the trademark in mainland China; if the evidence submitted is the use in the extraterritorial, it should be proven that the extraterritorial use already extends influence to the mainland China relevant public.

——例: "NUXE" opposition case

NUXE



The applicant of the opposition submits evidence of use in European and American countries as well as Hongkong, Taiwan region.

The evidence also includes history records that the Chinese Internet users to visit their web site www.nuxe.com before the application date of the registration, and the domestic cosmetics forum on the NUXE product information.

The protection of other prior rights 其他在先权利的保护

- -Copyright 著作权
- - industrial design patent 外观设计专利权
- - company name 商号权
- - name of physical person 自然人姓名权

乔治·阿玛尼



Giorgio Armani
For clothes

For tea

The protection of well-known mark 驰名商标的保护

- Unregistered well-known trademarks:
protection on the same or similar goods
未注册驰名商标：在相同或者类似商品上保护
- Registered well-known trademarks:
cross class protection
已注册驰名商标：跨类保护
- ✓ The malicious registration of well-known trademarks
is not subject to the limitation of the period of five
year's request for invalidation.
对恶意注册的，驰名商标所有人不受五年的时间限制。

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The protection of well-known mark 驰名商标的保护

- Unregistered well-known trademarks

—Art.13.2 PRC TM Law: "Where a mark is a reproduction, imitation, or translation of a third-party's well-known trademark which has not been registered in China and where the goods are identical or similar, which may cause public confusion, no registration shall be granted and the use of the mark shall be prohibited."

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。

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The protection of well-known mark 驰名商标的保护

■ Registered well-known trademarks

—Art.13.3 PRC TM Law: "Where a mark is a reproduction, imitation, or translation of a third-party's well-known trademark which has been registered in China and where the goods are not identical or dissimilar, which may mislead the public and cause injury to the interests of the registrant of the well-known trademark, no registration shall be granted and the use of the mark shall be prohibited."

就不相同或者不相类似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。

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mislead the public and cause injury to the interests of the registrant

误导公众，致使注册人的利益受到损害

■ Decrease the distinctiveness of the well-known trademark market

淡化驰名商标的显著性

■ Make depreciation of the reputation of well-known trademarks

贬损驰名商标声誉

■ Improperly use the reputation of well-known trademarks

不正当利用驰名商标的商誉

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Trend—the protection based on antidilution 趋势——基于反淡化的保护

- In real cases: Identified "Baidu" for the well-known trademark on the Internet search engine service, cross class protection to condoms; identified "Casio" for the well-known trademark on electronic calculators, electronic watch, electronic musical instrument product, cross class protection to the floor drain; identified "Aupres" for the well-known trademark on cosmetics, cross class protection to condoms; identified "Chanel" for the well-known trademark on makeup, clothes, cross class protection to sanitary towel.

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