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知识产权

## 商标被抢注，如何利用三年不使用撤销程序进行补救

### HOW TO CANCEL A SQUATTED TRADEMARK THROUGH THREE YEAR NON-USE PROCEDURE

根据商标法的规定，注册商标无正当理由连续三年不使用的，任何单位或个人可以向商标局申请撤销该注册商标。

According to the Trademark Law, where a registered trademark stays unused for three consecutive years without a reasonable reason, any company or individual can file application to cancel the trademark.

已注册商标不使用的分析，一方面可能是因为商标注册人在经营中事实上放弃了对所注册商标使用的意愿，另外，不排除一些恶意抢注商标的商标注册人（“商标抢注人”），其真实目的不在于使用商标，而是希望被抢注人能够出高价购买，这样，也可能导致商标长期没有被真正使用。

The reasons for not using a registered trademark vary. It could be because the owner of the trademark has abandoned the trademark in its business. However, if the intention of registering a trademark by a trademark squatter is to sell the trademark finally and is not for purpose of use, the registered trademark can also be not really used by the squatter.

在这种情况下，注册商标无正当理由连续三年不使用可被撤销的规定，在一定程度上给予了与注册商标存在利害关系的第三人救济的权利，特别是针对恶意抢注商标且长期不使用的，利害关系人可能由此撤销注册商标并重新获得商标权利。

Under such circumstances, the procedure of cancellation of a registered trademark with three years non-use may give remedy to a third party who has a stake in the trademark. In particular, if the trademark is squatted and not used for a long time, a third party who has a stake in the trademark (“the Applicant”) may have the opportunity to cancel the trademark and obtain it by re-registration.

本文将重点阐述商标被抢注情况下，撤销程序申请人（即被抢注人）如何利用三年不使用撤销程序启动撤销申请，并在被抢注商标被撤销后重新获得注册。

In this article, we will discuss how a squatted trademark can be cancelled through three years non-use procedure and how the trademark can be re-registered after it is cancelled.

## I. “连续三年”如何计算

### **How to calculate the three consecutive years**

连续三年的计算，应该从商标撤销申请提出之日起往前计算三年。例如，提出撤销申请日为2015年1月10日，则三年的起止期限应为2012年1月10日起至2015年1月9日。

The three consecutive years shall be three years back from the date of application for cancellation. For example, if the date of application for cancellation is January 10, 2015, then the three years shall be from January 10, 2012 to January 9, 2015.

抢注人需要证明在此期限内，存在使用商标的证据。

The trademark squatter is liable to provide evidence of using the trademark during this period.

如果自商标注册公告之日起未满三年，则不得提出商标撤销的申请。

However, if it is less than three years from the date the registered trademark is approved and announced, then the cancellation cannot be filed.

## II. 如何理解“不使用”

### **What is non-use?**

在理解“不使用”之前，需要界定何种使用形式是可被认为构成对商标的“使用”的情形。

To understand the non-use, it shall be defined that what form of use is accepted as the use of trademark.

对于商标的使用，需要满足对商标进行公开、真实、合法的商业使用的要求。

The use of trademark shall meet the requirement of public, real and legitimate commercial use.

商业使用的表现形式，包括将商标用于商品、商品包装或容器以及商品交易文书上，或者将商标用于广告宣传、展览以及其他商业活动中。

The commercial use of a registered trademark includes the use of trademark on

commodities, on the package or container for the commodities, as well as on the transaction documents in relation to the commodities, or use the trademark for advertising, exhibition or other commercial activities.

公开、真实、合法的商业使用需要满足以下要求：

In terms of public, real and legitimate commercial use of trademark, the following requirements shall be met:

1) 在公开的商业领域使用注册商标。公开使用是指商标的使用非内部使用，应当以相关公众能否知晓商标的存在和使用为判断标准，且通过该等商标的使用，可以起到区分不同商品或服务来源的功效；

1)The use of a registered trademark in public commercial field. The public use means the use is not an internal one. The criteria for public use shall be that whether the relevant public is aware of the existence and use of the trademark in the market. In addition, through the use of trademark, the public is able to identify the source of commodities/service.

2) 对注册商标的使用是真实和善意的，而非避免商标撤销目的的应付性、象征性使用；

2)The use of trademark shall be real and in good faith. It shall not be symbolic use for purpose of avoiding being cancelled.

3) 应当在核定使用的商品或服务上使用商标标识。

3)The trademark shall be used on designated commodities/service as indicated on the trademark certificate.

根据商标法的规定，如果商标注册人存在正当理由不使用的，则商标将不会被撤销。该等正当理由包括不可抗力、破产清算、政府政策性限制等情形。

In accordance with the Trademark Law, if the non-use of trademark is with reasonable reasons, the trademark shall not be cancelled. The reasonable reasons include Force Majeure, bankruptcy/liquidation, limit by the government policy etc.

### III. 提起撤销申请后，商标抢注人的举证义务及申请人的抗辩

**After the cancellation is filed, what are the burden of proof by the squatter and the possible defense by the Applicant?**

在因三年无正当理由不使用撤销过程中，被抢注人无需任何举证即可启动撤销程序，因此，提起撤销程序相对来说非常容易。

Generally speaking, the cancellation of a registered trademark can be easily brought up without any liability of proof by the Applicant.

但是，对于撤销程序中所涉及的商标抢注人而言，需要提供符合法律规定的使用证据。如果商标抢注人事实上没有实际使用商标，但为了避免发生被撤销的后果，抢注人可能会试图提供一些虚假的证据以证明存在使用的事实。根据程序规定，商标局将首先单方面对商标抢注人提供的使用证据进行核查和判断，并作出是否撤销的决定。如果商标局作出维持的决定，在这种情况下，提出撤销程序的申请人将有权向商标评审委员会提出复审，并就商标抢注人提供的使用证据发表意见。

In the trademark cancellation procedure, the trademark squatter is liable to submit the evidence of use of trademark. However, if the trademark is not really used, for purpose of avoiding being cancelled, the trademark squatter may try to provide false evidences. According to the procedure, the Trademark Office will examine the evidences provided by the squatter and make decision over the application for cancellation. In the event the trademark is maintained by the Trademark Office, the Applicant filing the cancellation is allowed to file appeal to the TRAB (Trademark Review and Adjudication Board) and respond to the evidences provided by the squatter.

根据我们的经验，针对商标抢注人提供的证据，在提起复审的情况下，被抢注人可以从以下几个方面对商标抢注人提供的证据进行抗辩：

In our experience, in case of appeal by the Applicant, the Applicant may make defense to the evidences in relation to the use of trademark submitted by the squatter as below:

1.实际商标使用人是否为抢注人。除了商标抢注人本身使用商标外，商标被许可人的使用也将构成对商标的使用。但是，如果系商标被许可人使用的，商标抢注人有义务证明商标许可关系的存在。否则，他人对商标的使用证据不构成对商标的使用证明；

1.To examine whether the user of the trademark is the squatter. Besides the use of trademark by the squatter, the use of trademark by a licensee is also acceptable. However, in the event the evidences are related to the use of the trademark by a licensee, the squatter is liable to prove the licensor and licensee relationship between the squatter and the user of the trademark. Otherwise, the use of trademark by a third party cannot be automatically deemed as evidence in relation to the use of the registered trademark;

2.商标的使用是否构成公开、真实和合法使用；

2.To examine whether the use of trademark is a public, real and legitimate use;

3.商标是否被使用于核定使用的商品或服务。如果商标系使用于核定使用的商品或服务以外的范围，则不构成对注册商标的使用意义；

3.To examine whether the trademark is used on designated commodities/services. In the event the trademark is used on commodities/services which are not in the scope of designed ones as indicated on the trademark certificate, such use of trademark does not constitute

the one acceptable to maintain the registered trademark;

4.如果商标撤销的申请中包含对特定核定使用商品或服务的撤销申请，被抢注人需要着重核实商标抢注人提供的证据是否包含了商标在特定商品或服务上使用的证据；

4.If the application for cancellation includes the cancellation of specific designated commodities/services, the Applicant shall particularly examine whether the evidences provided by the squatter includes the one indicating the use of trademark on these specific commodities/services.

5.使用的商标标识是否与注册商标标识保持一致。

5.To examine whether the logo of the trademark in use provided by the squatter is same as the registered one.

#### IV. 注册商标被撤销后如何再次注册商标的建议

##### **Suggestions for re-registration of trademark after cancellation**

如果撤销申请人系商标被抢注人，一旦撤销的申请受到支持，则需要考虑如何成功注册商标而不会被他人再次抢注。

In the event the Applicant for cancellation is the one whose trademark is squatted, once the application of cancellation is supported, the Applicant shall consider how to re-register the trademark successfully and avoid the trademark being squatted by others again.

根据现有的规定，商标被撤销后，自撤销之日起一年内，商标局对与该商标相同或近似的商标注册申请，不予核准。因此，在商标撤销之日起一年内，商标申请将不会被核准。因此，考虑到在先申请的原则，被抢注人应当在一年期满后的首日申请注册商标。

Under current rules, within one year upon the cancellation of a registered trademark, the Trademark Office will not grant any application for same or similar trademark registration. Therefore, in consideration of the principle of earlier application, earlier being granted, the Applicant shall file the application for trademark registration on the first day following the one year period expires.

然而，如果存在第三人抢注的可能，理论上存在满一年后的第一天，相关商标被两个或两个以上申请人在同一日同时申请的情况发生。根据现有的规定，如同一日申请的，则商标局将初步审定并公告使用在先的商标，并驳回其他人的申请。

However, in theory, there is possibility that two or more applicants file the same trademark for registration on the first day following the one year period expires. Under current rules, in case of applications on the same date, the Trademark Office will approve and announce the one with prior use and reject the remaining applications.

因此，在发生一年期满后存在两个或两个以上申请人在同一或类似商品上注册同一商标的情况，商标局将要求申请人提供使用在先的证据，并据此确定优先顺序。

Therefore, if two or more applicants file for same trademarks on same or similar commodities/services, the Trademark Office will request the applicants to provide the evidence of prior use, and determine the priority in relation to the applications accordingly.

因此，我们建议在商标被撤销后，为确保注册的成功，被抢注人应当创造对商标的使用证据。为确保该等证据的公开和客观，建议通过第三方媒体进行广告宣传的方式进行，例如，在报纸、杂志或者网络上的付费广告形式。此等证据的效力将大大强于内部使用的证据形式。

To ensure successful registration, we suggest after the trademark is cancelled, the Applicant shall create evidences in relation to the use of trademark. To make sure the use of trademark is a public and real one, we suggest the Applicant can use the trademark by making advertisement on a third party media, such as on newspapers, magazines or internet. The effect of such evidences will be much stronger than the ones of internal use.

如您对本文有任何问题，请联系：

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