

2015 年 7 月

知识产权

如何在中国保护被抢注的未注册商标

HOW TO PROTECT UNREGISTERED TRADEMARK WHICH IS SQUATTED IN CHINA

在我们所接触的商标案例中，经常会发生一些客户因未及时在中国注册商标而被其商业伙伴、竞争对手、甚至雇员恶意抢注商标的情况。当发生这种情况时，客户往往希望知道其是否有机会从抢注者手中夺回被抢注商标，如果采取走法律途径，则存在多大的成功几率。

In our experience in dealing with trademark disputes, we have seen frequent occurrence of trademarks squatted by business partners, competitors and even employees due to the delay in filing the same for registration by the clients. After this situation happens, the clients will be eager to know if there is any chance to get back the trademark and in case of legal action, what will be chance for success.

中国商标法对在先使用但未注册商标的保护，主要体现在如下两个方面：

The protection for unregistered trademark with prior use under China Trademark Law is reflected as below:

-《商标法》第 13 条所规定的对未在中国注册的驰名商标的保护。由于中国法律对驰名商标认定的要求较高，在大部分案例中运用该规定对抗在先注册商标的情况并不多见；

-Article 13 of the Trademark Law is for protection of well-known trademarks which has not been registered in China. However, since the condition for being a well-known trademark is quite strict and in most cases, to challenge a prior registered trademark on the basis of being an unregistered but well-known trademark does not occur frequently.

-《商标法》第 32 条所规定的情况：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。该规定赋予在两种情况下对被抢注商标提出异议或撤销申请，一是如果提出异议或撤销申请的一方对被抢注商标享有在先权利的，此处在先权利，包括了中国法律所赋予的合法权利，包括肖像权、姓名权、著作权、专利权、字号权等。二是如果商标所有人是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。

-According to Article 32 of the Trademark Law: an application for the registration of a trademark shall not create any prejudice to the prior right of another person, nor unfair means be used to pre-emptively register the trademark of some influence another person has used. This regulation allows for opposition or cancellation for trademark being squatted in one of the following situations: (a) an opposition or cancellation can be filed by a party if he enjoys prior right to the trademark which is squatted. The prior right refer to any

legitimate right including the right of portraiture, name, copyright, patent, business name etc. (b) an opposition or cancellation can be filed if the trademark is pre-emptively registered by unfair means while the trademark has been used before being squatted and with some influence.

在此，我们将详细说明如何正确理解和运用“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”作为提出商标异议或撤销申请的理由。根据对该规定的理解，需要满足的条件包括：

We hereby will illustrate how to understand and use the above regulation of “using improper means to pre-emptively register the trademark that is already in use and enjoys certain influence” as the reason for opposition or cancellation in China. According to this regulation, the following conditions shall be met:

- 抢注人以不正当手段抢注了商标；
-The trademark is pre-emptively registered by a squatter through improper means;
- 被抢注人已经使用该商标；
-The trademark has already been used by another party;
- 被抢注人对商标的使用有一定影响力。
-The trademark used by another party enjoys certain influence.

I. “不正当手段”的界定 **Definition of improper means**

《商标法》并未进一步说明何种方式系“不正当手段”，由于中国商标法律保护采取的是在先申请原则，抢注人注册商标行为本身并不存在正当或者不正当的区别，因此，在把握该要件时，需要从抢注人的主观意图进行判断。

The Trademark Law does not further define what “improper means” shall refer to. As China’s Trademark Law applies the principle of Earlier Application, Earlier Being Granted, the registration of trademark by the squatter itself does not indicate such registration is with improper means or not. Therefore, when we understand this condition, the intention of the squatter shall be analyzed.

也就是说，如果抢注人在知道或者应当知道他人已经使用并有一定影响的商标而予以抢注的，则可推定其采用了不正当手段。

In other words, if the squatter registers the trademark when he is aware or should be aware that the trademark has been already used by another party and enjoys certain influence, then it can be presumed that the squatter takes improper means.

因此，对“不正当手段”的证明，我们建议从如下方面收集并提供证据：

Evidences as suggested below can be collected by the applicant for opposition or cancellation in order to prove the existence of improper means by the squatter:

- 抢注人和被抢注人曾经或当前存在一定的业务关系或者其他联系，且抢注人知道被抢注人使用商标的；

-Business relationship or similar relationship exists between the squatter and the applicant in the past or currently, and the squatter is aware of the trademark used by the applicant;

-如抢注人和被抢注人直接的业务关系不存在的，则被抢注人需要证明对未注册商标的使用范围、时间、频率等，以说明抢注人知道或者应当知道未注册商标已被使用的事实。但是，具体证据的证明力，还有待于商标评审委员会或者法院作出判断。

-In the event no direct business relationship exists between the squatter and the applicant, the applicant shall prove the scope, time duration, frequency etc in relation to the use of unregistered trademark to prove the squatter knows or should know the fact of the use of unregistered trademark by the applicant. However, the specific evidences shall be subject to the examination by TRAB (the Trademark Review and Adjudication Board) or the court.

II. 被抢注人已经使用该商标

The trademark has been used by the applicant

被抢注人应当提出有关其已经使用未注册商标的证据。在此，有关商标的使用，需要注意以下方面：

The applicant shall submit evidences in relation to the use of the unregistered trademark. In this regard, the followings shall be noted:

-有关商标使用的方式，可以包括在商品、商品包装、交易文书、广告宣传、展览等在商业活动中的使用；

-As for the use of the unregistered trademark, it can be the use on commodities, commodity packaging, transaction documents, advertising, exhibition, etc.

-需要注意的是，如果被抢注人系境外客户，其提供的商标使用的证据应当着重提供在中国市场的使用证据；

-It shall be noted that if the applicant is a foreign client, the evidences in relation to the use of trademark shall be mainly those indicating the use of the unregistered trademark in China;

-单纯的商标许可行为，不构成对商标的使用行为。

-Trademark license shall not constitute the use of trademark.

III. 被抢注人对商标的使用有一定影响力

The trademark used by the applicant enjoys certain influence

对于“有一定影响力”的证明，实际是对商标知名度方面的要求。对此，被抢注人可以从以下几个方面来举证：

The influence of the trademark refers to the market awareness of the trademark. In this regard, the applicant can prove from the following aspects:

-商标使用的时间；

-The time duration in relation to the use of the trademark;

-商标使用的区域范围；

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- The scope of area the trademark is used;
- 相关商品的销售量;
- Sales volume of the relevant commodities in relation to the trademark;
- 对商标的广告宣传和广告宣传费的支出;
- The advertising of the trademark as well as the expenditure in relation to the advertising for the trademark;
- 著名商标等商标荣誉的获得情况
- The reputation received such as the recognition of famous trademark by local authority.

IV. 建议:

Suggestions:

综上，在处理商标抢注案件中，被抢注人对未注册商标的使用及未注册商标的知名度的证明是成功的关键所在。因此，被抢注人应当注意尽可能收集多的证据来予以证明，而不仅仅依赖于单份被抢注人认为关键的证据。因为在此认定方面，商品评审委员会和法院还是具有一定的自由裁量的权利。要获得好的结果，就必须同时注重证据的量和质。

In conclusion, in dealing with the cases of trademark squatting, the key point for success lies in the proving of the use of unregistered trademark and the influence enjoyed by the unregistered trademark. The applicant shall collect evidences as much as possible to prove the use of the trademark and its market influence and shall not only rely on single evidence which the applicant may think important. This is because in those cases, TRAB and the court may still have substantial discretion power in examining and accepting the evidences. If the applicant wants to have a good result, he shall pay attention to both of the quantity and the quality of the evidences.

如您对本文有任何问题，请联系：

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