

商標權的確定性與公正性

· 王春燕 ·

與一些西方國家相比，中國商標保護的歷史還不算太長，與之密切相關的商標法理論也比較薄弱。因此，研究並借鑒其他國家的商標保護制度以及相關的理論學說就成為建立、健全中國商標保護制度的一個重要途徑。¹ 本文試從商標權的確定性與公正性—實體公正—的角度，對我國商標立法中相關制度的完善提出自己的一管之見。

商標權利形成原則與商標保護的價值取向

由於歷史以及其他原因，不同法系的國家對商標法律保護的對象以及商標權利的概念有着不同的認識，因而形成了在商標權取得途徑上不同的制度。這種制度可以分為兩類：一為使用原則，一為註冊原則。世界貿易組織的《與貿易有關的知識產權協議》(TRIPS 協議)也反映了商標權取得上的這兩種原則。該協議第 16 條第 1 款在規定了註冊商標所有人所享有的專有權的同時，對基於使用取得的權利也給予認可。

根據使用原則，商標權必須並且只能通過在先使用才能獲得；根據註冊原則，商標權必須並且只能通過在先註冊申請才能獲得。使用原則以使用商標的事實作為產生商標權的充要條件，並與“先使用原則”相結合確定商標權的歸屬；而註冊原則則以註冊商標的事實作為產生商標權的充要條件，並與“先申請原則”相結合確定商標權的歸屬。在使用原則之下，受保護的是凝結於商標之上的貿易聲譽或商業信譽；在註冊原則之下，保護對象則為“商標”本身。由此可見，上述兩項原則建立在不同的保護理念之上：使用原則注重實體公正，保護使商標具有價值的主體的利益；註冊原則側重法律秩序以及與之相關的商標權的確定性。

在採用註冊原則的商標法律秩序中，商標權的確定性要求是通過法定的一系列制度保障措施來實現的。這些制度保障包括先申請原則、申請公告制度以及異議制度等。隨着國際貿易的發展，註冊所具有的確定性的特點使得它成為各國商標所有人在其他國家尋求商標保護的最佳途徑。註冊原則逐漸在多數國家的商標保護法律秩序中佔據主導地位。目前，只有美國和菲律賓的商標制度

僅僅以使用作為確立商標權的依據，其他國家則或者同時採用使用原則和註冊原則，如英國和德國，或者實行註冊原則，如法國、日本等大陸法系國家。在當前經濟全球化的形勢之下，註冊原則的主導地位只會加強而不會削弱。

然而，確定性只是法律保護的方法或形式價值，並不是法律保護的目的。法律保護的目的應該是公正。根據註冊原則，申請人憑借其在先申請行為即有可能獲得對某一商標的專有權，申請人是否使用該商標則在所不問。由此引發了註冊原則之下的一系列問題。其中，商標註冊人與商標在先使用人之間的權利衝突，以及註冊商標權的公正性問題尤為突出。為了解決上述問題，許多推行註冊原則的國家除了維持根植於自身法律傳統中的原有制度以外，也借用其它制度中體現公正要求的做法：

其一，在堅持註冊產生商標權的大前提下，有條件地承認商標在先使用人的在先權：或者在侵權訴訟中，給予能夠證明自己在先使用的被告以特定的保護，即承認在先使用人對其在先使用的未註冊商標享有一定限度的使用權，例如，意大利《商標法》第 9 條允許在先使用人享有繼續使用其商標的權利（不論其是否馳名或知名），日本《商標法》第 32 條規定，善意的在先使用者，其商標在他人申請商標註冊之前已為消費者廣為知曉，擁有在原來使用的商品或服務上繼續使用該商標的權利；或者賦予在先使用人以異議及撤銷註冊請求權，即在先使用人可對他人在後使用的，與其商標相同或類似的商標註冊，提出異議或撤銷註冊的請求。在德國、法國、英國及意大利等國的商標法中都有類似的規定。

其二，將商標的使用作為確認由註冊產生的商標權的正當性的構成因素。例如，各國普遍將商標的使用作為註冊商標存續的條件，即規定倘若註冊商標在連續若干年的期限（一般為 3 年或者 5 年）內未使用，則該註冊可被撤銷。TRIPS 協議第 19 條即以“使用要求”為題對此作出了規定。歐洲共同體《商標指令》第 12 條也規定，“若一項商標連續 5 年未在成員國於註冊時核定使用的商品或服務上實際使用，而無未作使用的正當理由，則應予撤銷。”德國《商標法》第 26 條明確規定，“因商標註冊或續展申請的提出有賴於該商標的使用，因此，除非有不使用

的正當理由，所有權人必須在本國範圍內將商標真正使用於註冊的商品或服務上。”保護商標在先使用人的正當利益以及對註冊商標的使用要求，都體現了商標保護中追求實體公正的價值取向。

外國商標保護制度對中國商標保護制度的啓示

中國商標保護制度該如何應對世界商標保護制度的發展和演變，是一個亟待研究和解決的重要課題。在經濟全球化的大背景之下，準確定位我國商標保護制度的類型，既有助於完善我國的商標保護制度，又有助於商標保護的國際協調。

與其他發展中國家一樣，我國缺乏產生使用原則的土壤。以 1904 年清政府頒佈的中國歷史上第一部商標法規——《商標註冊試辦章程》——為保護商標的起點，我國歷史上均通過奉行註冊原則的成文法實現對商標的保護。我國現行《商標法》同樣實行註冊原則。在我國，商標保護以註冊保護為基本特徵，商標法只賦予註冊商標的所有人以商標權，現行《反不正當競爭法》也規定了對註冊商標的保護，而對未註冊商標的保護規定則付之闕如。

與有關國際條約及其他國家相關立法相比較，前文提出的以註冊原則為主導的商標保護制度通常借用的兩項做法未完全引入我國的商標立法中。首先，在對未註冊商標的保護問題上，我國現行的商標法律僅僅涉及未註冊馳名商標的保護，並且只限於撤銷註冊請求權的規定。有關規定見之於現行《商標法》第 27 條第 1 款及其實施細則第 25 條第 1 款。前者規定以不正當手段取得的註冊可通過兩種途徑予以撤銷；後者對以“不正當手段”取得註冊的情形作了列舉，其中“違反誠實信用原則，以複製、模仿、翻譯等方式，將他人已為公眾熟知的商標進行註冊”，涉及對未註冊馳名商標的保護問題。² 未註冊馳名商標所有人可以據此對他人的惡意（即“違反誠實信用原則”）註冊提出撤銷註冊請求。由於絕大多數《保護工業產權巴黎公約》成員國對馳名商標（包括未註冊馳名商標）提供強於一般註冊商標的特殊保護，一般的未註冊商標所受到的保護與未註冊馳名商標所受到的保護不可同日而語。其他國家的相關立法對馳名商標與一般的未註冊商標的撤銷註冊請求權多作區別規定。例如，在 1987 年生效的《比荷盧經濟聯盟統一商標法》有關不能取得商標權的註冊申請的第 4 條中，第（五）項的內容為：“未經第三人同意，申請註冊可能與巴黎公約第 6 條之 2 意義上的第三人的馳名商標相混淆的”；第（六）項則涉及惡意註冊一般的未註冊商標的情形，“註冊申請人明知或應知自申請註冊之日前三年內，第三人已善意地以正常方式於比荷盧境內在類似商品或服務上使用了近似的商標，且

註冊未經第三人同意的；……”。馳名商標的撤銷註冊請求權既適用於惡意註冊，也適用於善意註冊，一般的未註冊商標的撤銷註冊請求權只限於惡意註冊。由此可見，我國《商標法》這一保護馳名商標的規定也僅僅相當於其他國家對一般未註冊商標的保護所作的規定。

其次，雖然《商標法實施細則》將“侵犯他人合法的在先權利進行註冊”作為以“不正當手段”取得註冊的情形之一予以規定，但是，對於“在先權利”的內容缺乏明確的界定。一般將“在先權利”解釋為不包括在先商標權的其它民事權利，如著作權、專利權及商號權等。³ 商標的在先使用權也未被列入“在先權利”之中。

第三，缺乏對註冊商標使用要求的明確規定。現行《商標法》僅僅從商標使用管理的角度規定，連續 3 年停止使用註冊商標，由商標局責令限期改正或者撤銷該註冊商標。

近年來發生在商標保護領域引起廣泛關注的問題，如實踐中頻繁發生的眾說紛紜的“搶註”現象，多與商標法律規定上的漏洞直接相關。除了未註冊的馳名商標以外，大多數被他人搶先註冊的是那些已擁有了一定的市場信譽的未註冊商標。由於我國現行法律尚無保護這類商標的規定，因此，將他人使用多年的未註冊商標進行註冊，“合法”地據為己有的不正常現象屢見不鮮。而立法上對註冊商標使用要求的疏漏助長了註而不用現象的滋生。

針對我國以註冊原則為基本特徵的商標保護制度現狀，本文認為，中國商標保護制度所面臨的並不僅僅是一個單純的制度選擇問題，還是一個價值取向問題。我們應在維持以註冊原則為主導的前提下，汲取其他制度中體現實體公正的做法。無論是保護商標在先使用人的正當利益，還是提出註冊商標的使用要求，都是建立商標保護制度的本意。因為，建立這樣一個制度的宗旨就是規範市場經濟秩序，保護公平競爭，促進經濟發展。因此，我們應在保證商標權的確定性的基礎上關注商標權的公正性問題。

一方面，對未註冊商標使用人的利益給予適當的關注，逐步規範商標註冊人與商標使用人之間的關係。由於我國缺乏使用原則所賴以存在的反不正當競爭保護的法律傳統，因此不宜像德國那樣，在商標法中直接導入使用原則。⁴ 德國的做法雖然體現了註冊原則與使用原則的融合，但是這種融合被認為徒有形式，對未註冊商標的保護實際上還是依賴競爭法或侵權法。⁵ 比較可行的做法是，在立法上承認商標在先使用人在一定條件下的在先使用權。⁶ 只有首先承認商標使用人這一實體意義上的權利，才有可能討論商標使用人程序意義上的撤銷註冊請求權問題，也才有可能進一步來討論在先使用人在被訴侵權

時以在先使用進行抗辯的問題。應在承認在先使用權的基礎上,根據註冊人主觀意圖的不同分別作出規定。⁷

對於惡意註冊,未註冊商標的在先使用人應享有撤銷註冊請求權。如前所述,許多並非馳名商標的未註冊商標被他人搶先註冊,這些未註冊商標經過其所有人的長期使用都已包含了相當的價值(這也是它們被搶註的直接原因),一旦被他人搶先註冊,原商標使用人就喪失對該商標的使用權。從法理上講,使用人對其未註冊商標所享有的利益應受到保護。因此,強調註冊的善意性應在我國的商標法律中充分地體現出來。其實,對註冊的善意性要求在許多方面都有體現:在1993年修訂《商標法》時,增設現行《商標法》第27條中有關禁止以不正當手段取得註冊的規定,正是為了防範“以不正當手段將他人長期使用並具有一定信譽的商標搶先註冊,牟取非法利益”的行為;⁸國家工商行政管理局在1999年4月5日發佈的《關於解決商標與企業名稱中若干問題的意見》中規定,“商標專用權……的取得,應當遵循《民法通則》和《反不正當競爭法》中的誠實信用原則,不得利用他人商標或企業名稱的信譽進行不正當競爭”;我國從事商標評審工作的人士也明確指出,“我們所主張的申請在先是一種善意、不違背誠實信用原則、不損害他人利益的正當的申請在先,而不是‘搶註’”。⁹我們認為,上述認識應當貫穿於包括未註冊商標保護在內的法律實踐之中。執法實踐其實也已經向人們提供了保護具有一定知名度的未註冊商標的實例。例如,在2000年1月4日發佈的商評字(1999)第3862號《“扭扭”商標註冊不當終局裁定書》中,國家工商行政管理局商標評審委員會認為,“扭扭”已起到標識申請人所生產食品,包括膨化食品的作用,具有了一定的知名度。被申請人的行為已構成對他人具有一定知名度的商標模仿註冊,申請人所提註冊不當理由成立。因此,裁定撤銷被申請人的第1200997號“扭扭”商標註冊。

對於善意註冊,商標的在先使用人不具有撤銷註冊請求權,但應享有在原有範圍內對原商標的繼續使用權;同時,在先使用人可以憑借在先權利在被訴侵權時進行抗辯。由於現行商標法律沒有賦予在先使用人以在先使用權,以及與此相關的以在先使用進行抗辯的權利,商標使用人往往處於動輒得咎的處境。最高人民法院知識產權庭在就商標法修訂草案第一稿所提出的修訂意見中,提出了在先使用人的繼續使用權問題。該項意見係針對搶註商標的情形下,正當使用人被訴侵權,“判決結果往往合法不合理”的現象而提出的。¹⁰如果在立法上明確規定了未註冊商標使用人的撤銷註冊請求權,那麼將會是另外一種情形。對於惡意註冊,商標使用人可請求予以撤銷,正當使用人被訴侵權的情形將不可能發生,這樣就可

完全避免上述“合法不合理”結果的出現,而商標使用人的使用權自然也會“安然無恙”;對於善意註冊,由於商標在先使用人不能對其行使撤銷註冊請求權,商標使用人極有可能遭遇商標註冊人的侵權指控,因此,在這種情形下才會產生使用人的繼續使用權問題。我們認為,商標使用人的使用權是以使用人自己合法使用為基礎所產生的正當利益,它的存滅取決於使用人自己的意志,而不應取決於其它民事主體的行為(及其主觀狀態)。善意註冊情形下的商標權人也無權通過註冊這種旨在創設權利的方式去剝奪他人合法獲取的正當利益。因此,商標使用人應擁有繼續使用權。對於不同的主體使用同一商標而可能出現的混淆,可以採取上述最高人民法院知識產權庭所提的意見:“要求使用人在商品或者服務上添加適當標記以區別與商標權人的商品或者服務”。

在以註冊原則為主導的商標法律制度中,有條件地承認商標的在先使用人的在先權,賦予商標在先使用人以撤銷註冊請求權,符合商標保護的根本目的,並不會影響註冊原則的實行。與商標註冊人所擁有的商標權相比,在先使用人的這種權利無論在實體意義上還是在程序意義上都有很大的局限性。¹¹由於對未註冊商標使用人提供的保護所受到的局限性,它不會對我國現行的註冊制度構成威脅。¹²

與此同時,在商標立法中應當明確規定註冊商標的使用要求,將註冊商標的使用作為一種權利存續的條件,而不僅僅是商標主管機關進行行政管理的要求。惟有進行這種性質上的改變,才能真正樹立起註冊商標權的公正性。

作者:中國人民大學法學院副教授

1. 我們所指的借鑒是指對其它國家法律制度以及相關理論的研究、分析、採納,而不是簡單的條文上的拿來主義。我國學者在設計中國知識產權保護制度的過程中,不時參考其他國家的相關制度,取法上見仁見智。有些分歧其實是研究方法上的不同所致。
2. 這裡的“公衆熟知的商標”指馳名商標。在執法實踐中,該條款被作為保護馳名商標的法律依據。參見范漢雲:《中國關於撤銷不當註冊商標的法律規定及實施》,《中國專利與商標》1999年第3期。但是,“公衆熟知的商標”不是一個規範的概念,對此可有不同的解釋,如“馳名”或“知名”。如果解釋為“知名”,則涵蓋了雖不馳名但具有一定知名度的商標。這樣易導致法律適用的一致。例如,在“‘扭扭’商標註冊不當終局裁定書”中,國家工商行政管理局商標評審委員會以被申請人的行為已構成對他人具有一定知名度的商標模仿註冊為由,裁定撤銷被申請人的“扭扭”商標註冊。見商評字(1999)第3862號《“扭扭”商標註冊不當終局裁定書》。
3. 見范漢雲:《中國關於撤銷不當註冊商標的法律規定及實施》,

Establishedness and Justness of Trademark Right

Wang Chunyan

Compared with some Western countries, China has a rather short history of trademark protection and relatively weak in trademark theory closely related thereto. For this reason, studying and drawing on the trademark protection systems in other countries and the relevant theories thereof become an important approach to establishing and amplifying the trademark protection system in China.¹ This article is intended to present some opinions of this writer regarding the amplification of the relevant system under the trademark legislation in China from the perspective of establishedness and justness — substantive justness — of trademark right.

Trademark Right Formation Principle and Value in Trademark Protection

For historical and other reasons, views on objects of

legal trademark protection and concepts of trademark right are different from one country to another adopting different legal systems, which results in the different systems for the acquisition of trademark right. These systems can be divided into two categories: those based on use-based principle and on registration-based principle, which are reflected in the TRIPS Agreement, Article 16 (1) of which provides that the owner of a registered trademark have the exclusive right and, at the same time, recognise the rights made available on the basis of use.

According to the use-based principle, trademark right must and can only be acquired through prior use; according to the registration-based principle, trademark right must and can only be obtained through prior registration. The former takes the fact of use as the necessary and sufficient condition for making a trademark right available, and establishes the ownership of a trademark right in

《中國專利與商標》1999年第3期。

4. 1995年1月生效的德國現行商標法擴展了商標保護的獲得途徑。該法明確規定，商標保護應同等地產生於註冊或使用。該法第4條具體規定了產生商標保護的三種情形：第一，一個標誌在專利局設立的註冊簿中作為商標註冊；第二，一個標誌通過在商業過程中使用，在相關的交易圈內獲得了作為商標的第二含義；第三，一個標誌屬於《保護工業產權巴黎公約》第6條之2意義上的馳名商標。

5. Horst-Peter Gotting: Protection of Well-Known, Unregistered Marks in Europe and the United States, IIC Vol. 31, No. 4/2000, p395-396.

6. 商標使用人的在先權問題已引起人們的關注。例見金溪：《商標在先使用人的利益及其保護》，《中國專利與商標》1999年第1期；劉曉海：《對商標權取得原則和商標“反向假冒”的思考》，《知識產權》1999年第1期。

7. 馳名商標的情形則與此不同。對於馳名商標的保護，主要是在現行立法的基礎上加以完善的問題。具體而言，一是完善現有的撤銷請求權的規定，將現有規定僅限於對馳名商標的惡意註冊的提出撤銷請求的權利擴大到對馳名商標的善意註冊的撤銷請求權，並以善意和惡意作為請求權時效的區分依據；二是在現有的撤銷註冊請求權的規定基礎上，增加禁止使用請求權的規定。

8. 見劉敏學：《關於〈中華人民共和國商標法修正案（草案）〉的說明》，《中華人民共和國商標法律法規匯編》，中國法制出版社，第10頁。

9. 同前註3。

10. 見中華人民共和國最高人民法院知識產權審判庭編：《知識產權審判指導與參考》，法律出版社，2000年12月第1版，第637-639頁。

11. 對於商標權，其實體意義上的權利表現為主體對有關商標擁有控制與支配的權利（包括使用權、許可權、轉讓權以及禁用權）；其程序意義上的權利表現為主體對他人在相關的商品或服務上，就與其註冊商標相同或近似的商標所提出的商標註冊申請或者商標註冊，提出異議或者無效申請（對抗他人申請或者註冊）的權利。而對於在先使用權，在實體意義上至多體現為在一定範圍內（通常限於原使用商標的商品或服務及其市場範圍內）有效的使用權；在程序意義上則僅表現為，未註冊商標所有人對他人基於惡意的商標註冊有權提起撤銷註冊請求。

12. 不同的看法請參見鄭祝君：《適法者要用正確行動引導法律功能的實現——幾起撤銷註冊商標案評析》，《法商研究》1998年第6期。

combination with the “first-to-use” principle; while the latter takes the fact of registration as the necessary and sufficient condition for making a trademark right available, and establishes the ownership of a trademark right in combination with the “first-to-file” principle. Under the use-based principle, what is protected is the trade reputation or commercial good will attached to a trademark; under the registration-based principle, the object of protection is the “trademark” per se. This shows that the two principles are based on different concepts of trademark protection: the “first-to-use” principle stresses substantive justness in respect of subject entity, protecting the interests of the trademark owner who makes a trademark valuable; the registration-based principle stresses the order of law and the relevant establishedness of trademark right.

Within the order of trademark law adopting the registration-based principle, the requirement for establishing the trademark right is realised by a series of systematic protective measures. These measures include the registration-based principle and the application publication and opposition systems. With the development of international trade; establishedness derived from registration has made it the best way for owners of trademark from one country to seek trademark protection in another. The registration-based principle has gradually taken hold in the order of law for trademark protection in most countries. To date, only the United States and the Philippines take prior use as the basis for establishing trademark right under their trademark systems, while the other countries either adopt the two principles, say in the United Kingdom and Germany, or follow the registration-based principle as in the civil law countries like France and Japan. In the ongoing process of economic globalisation, the position of the registration-based principle is only to be enhanced, not weakened.

However, establishedness is no more than an approach or formal value, but not an objective of legal protection. The objective should be justness. Under the registration-based principle, it is possible for an applicant to obtain an exclusive trademark right by its act of prior registration, and no one will ask whether it uses said trademark, which has given rise to a series of problems, among which collision of rights between a trademark registrant and a prior trademark user and the justness of registered trademark right, are the most striking. To resolve these problems, many countries adopting the registration-based principle borrow, for their own use, practices embodying justness requirements from other systems in addition to upholding the original system rooted in their history of law.

First, these countries, sticking to the registration-based principle, conditionally recognise the priority right of the prior user of a trademark, or, in

infringement litigation, accord specific protection to defendants who are able to attest their prior use, namely recognising that the prior users enjoy some right to use a trademark they use before registration. As a case in point, Article 9 of the Italian Trademark Law allows a prior user to have the right to continue to use its trademark (whether it is well-known or known). Again, Article 32 of the Japanese Trademark Law provides that a prior good-faith user whose trademark is well known to consumers before another person files an application for registration thereof has the right to continue to use the trademark on the original goods or service, or the prior user is empowered to raise opposition and to file a request for revocation of the registration. That is, the prior user may raise opposition or request for revocation of registration of a trademark which is subsequently used and identical with or similar to its own trademark. Similar provisions can also be found in the trademark laws of Germany, France, the United Kingdom and Italy.

Second, use of a trademark is taken as a factor for establishing the rightfulness of trademark right made available through registration. For example, the various countries take use of a trademark as a pre-condition for the maintenance of a registered trademark. It is provided that if a registered trademark is not used for a continuous period (usually three or five years), then the registration may be cancelled. Article 19 of the TRIPS Agreement sets forth the provision entitled “Requirement of Use”. Article 12 of the Trademark Directive of the European Economic Community provides that “A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member States in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.” Article 26 of the German Trademark Law expressly provides that “Insofar as the assertion of claims resulting from a registered trade mark or the maintenance of the registration depends on the use of the trade mark, the proprietor must have put the trade mark to genuine use in this country in connection with the goods and services in respect of which it is registered, unless there are proper reasons for non-use.” Protection of the lawful interests of a prior user of a trademark and the requirement of use for trademark registration embodies the value sought in trademark protection.

Message from Trademark Protection Systems in Foreign Countries for Trademark Protection System in China

How the trademark protection system in China reacts to the development and evolution of the world trademark protection system is an important subject matter to be

urgently studied and addressed. Against the backdrop of economic globalisation, correctly establishing the type of trademark protection system for China helps amplify its trademark protection system and facilitates the international harmonisation of trademark protection.

Like other developing countries, China lacks the soil for the use-based principle. Starting from the Tentative Ordinance of Trademark Registration—the first trademark law or regulation issued in the Qing Dynasty in 1904 as the point of departure, the registration-based principle has always been adopted for trademark protection in the statutory laws to protect trademarks in China. This is also the case with the current Chinese Trademark Law. In China, the basic characteristic of trademark protection is protection through registration, and the Trademark Law only grants trademark right to owners of registered trademark, but is still wanting in provision for protection of unregistered trademarks.

Compared with the relevant international treaties and legislation of other countries, two practices usually borrowed by the aforementioned trademark protection system adopting the registration-based principle are not completely introduced to the Chinese trademark legislation. First, in respect of the issue of protection of unregistered trademark, the present Chinese trademark law only relates to the protection of unregistered well-known trademark, and is only limited to provisions for the right to request for revocation. The relevant provisions can be found in Article 27 (1) of the current Trademark Law and Rule 25 (1) of its Implementing Regulations. The former provides that registration acquired by unfair means are cancelled in two ways; the latter enlists the circumstances of acquisition of trademarks by unfair means, of which “to violate the principle of honesty and good faith and plagiarise, counterfeit or translate any well-known trademark of another party in the registration” relates to the issue of protection for unregistered well-known marks.² The owner of an unregistered well-known trademark may request for revocation of registration by another person in bad faith (i. e. “in violation of the principle of honesty and good faith”). Since most members of the Paris Convention for the Protection of Industrial Property grant better protection to well-known marks (including unregistered well-known trademarks) than that for the ordinary registered trademarks. The protection of the latter is a far cry from that for unregistered well-known trademark. The relevant legislation of other countries sets forth different provisions for the right to request for revocation of registration of well-known marks and ordinary unregistered trademarks. For example, the Uniform Trademark Law of the Economic Union of Benelux sets forth in Article 4 (5) relating to registration applications that cannot obtain trademark right, “the filing of a mark likely to cause confusion with a

well-known mark, within the meaning of Article 6bis of the Paris Convention, and owned by a third party who has not given his consent” and in (6) thereof “filing effected by a person who knows or has no valid excuse for not knowing that within the preceding three years a third party has, in good faith and in the normal manner, used a like mark for similar goods or services on Benelux territory, and the said third party has not given his consent.” The right to request for revocation of well-known marks applies to registration in both bad and good faith, while that of the ordinary unregistered trademark only applies to registration in bad faith. As this indicates, the provision of the Chinese Trademark Law for well-known trademark protection is equivalent to that of other countries for the protection of ordinary unregistered trademarks.

Next, although the Implementing Regulations of the Trademark Law provides that “registration in violation of another person’s lawful prior right” is one of the circumstances of registration acquired “by unfair means”, no express definition is made as to the content of “the prior right”; the “prior right” is generally interpreted as other civil rights like copyright, patent right and trade name right, excluding prior trademark right.³ The prior right of trademark use is not incorporated into the “prior right”.

Third, there lacks express provision for requirements of use of registered trademarks. The current Trademark Law only provides, from the angle of the administration of use of trademarks, that where a registered trademark is not in use for a continuous period of three years, the Trademark Office shall order rectification or cancellation of the registered trademarks within a time limit.

In recent years, the issues that have drawn wide attention in the field of trademark protection, such as the controversial phenomenon of frequent “pre-emptive registration”, are most related to the loopholes of the provisions of the trademark law. In addition to unregistered well-known trademarks, most trademarks that are pre-emptively registered by other parties are unregistered trademarks that enjoy some reputation in the market place. Since no provisions are set forth in the present laws in China for the protection of this category of trademarks, there have arisen a lot of abnormal phenomena of registering and “lawfully” taking for ones’ own use unregistered trademarks other people have used for years. And the inadequate requirement in the legislation of use of registered trademark helps the widespread of the phenomenon of registration without use.

As regards the present situation of trademark protection system based on registration-based principle, it is held in this article, that what the trademark protection system in China is faced with is not only a matter of choice of system to be adopted, but a matter of orientation toward certain value as well. We should stick to the system as

such, and, at the same time, draw on the practices of other systems that embody the substantive justness. Both to protect the lawful interests of a prior user of a trademark and to require for use of registered trademarks are the primary objective of establishing the trademark protection system. For this reason, the final goal for establishing the trademark protection system is to regulate the market-oriented economic order, protect fair competition, and promote the economic development. To this end, we should pay attention to the issue of the justness of trademark right while ensuring the establishedness thereof.

Proper attention should be given to the interests of unregistered trademark users, and work done to gradually regulate the relations between trademark registrants and trademark users. Without the legal tradition of protection against unfair competition on which the use-based principle depends on, it is not advisable to directly introduce the principle in the trademark law as in Germany.⁴ Although the German practice embodies the integration between the principles of registration and use, the integration is deemed formal without practical effect as the unfair competition law or infringement law is still depended on for the protection of unregistered trademarks.⁵ A relatively feasible practice is to recognise, in the legislation, the prior trademark user's prior right to use the trademark under certain conditions.⁶ Only by first recognising this substantive right of the trademark user is it possible to address the issue of the trademark user's right to request for revocation of registration in procedural sense, and to go a step further to discuss the issue of counterclaim by the prior user on the basis of prior use when it is accused of infringement. Provisions should be separately set forth according to the subjective intention of the registrant on the basis of recognising the right in prior use.⁷

As regards bad-faith registration, the prior user of an unregistered trademark should enjoy the right to request for revocation of registration. As aforementioned, many unregistered trademarks that are not well known are pre-emptively registered by other parties. These trademarks are of considerable value after being used by the owners for a long time (that is the direct reason they are registered by other parties in bad faith), and the original trademark users would lose the right to use them once they are pre-emptively registered. Jurisprudentially speaking, the interests of the users of the unregistered trademark should be protected. Hence, stress on the good faith in registration should be fully embodied in the trademark law in China, and this is actually true in various aspects. As a case in point, the provision of Article 27 was added to the current Trademark Law, when it was being revised in 1993, for the prohibition of registration by unfair means to prohibit acts of "pre-emptive registration, by unfair means for seeking illegal interests, of trademark which another

person has used for a long time and which enjoys high reputation."⁸ Besides, it is provided in the Opinions on Resolution of Several Issues Concerning Trademark and Enterprise Names issued by the State Administration for Industry and Commerce (SAIC) on 5 April 1999, that "the exclusive trademark right ... shall be acquired in accordance with the principle of honesty and good faith set forth in the General Principles of the Civil Law and the Unfair Competition Law, without committing unfair competition by making use of the reputation of another person's trademark or enterprise' name". Some Chinese trademark review and adjudication workers have also expressly pointed out that "what we advocate is the good-faith, registration-based principle that does not violate the principle of honesty and good faith and the prior application that inflicts no damages to the interests of another person, but not 'pre-emptive' registration".⁹ For us, these conception should be observed in all the legal practice including the protection of unregistered trademarks. The enforcement practice, in fact, has offered us the precedents of protection of known but unregistered trademark. For example, in the Final Ruling in Writing on the Improper Registration of the Trademark "扭扭" No. Shangpingzi 3862/1999 issued on 4 January 2000, the Trademark Review and Adjudication Board of SAIC holds that the Trademark "扭扭", as a mark for the foodstuff, including dilated food, manufactured by the applicant, enjoys high reputation in the market and the respondent's act constitutes registration of a counterfeiting trademark thereof. Accordingly, the applicant's ground for the action that the trademark is registered improperly is tenable. Therefore, it is ruled to revoke the registration of the respondent's Trademark "扭扭" No. 1200997.

As for good-faith registration, the prior user of a trademark has no right to request for revocation of its registration, but should enjoy the right to continue to use the trademark in connection with the original scope of goods or services; meanwhile, it may raise counterclaim based on its prior right in the infringement litigation. Since the current trademark law does not give the prior user the prior right in the trademark, nor the right to counterclaim based on the relevant prior use, the trademark users are, more often than not, put in an unfavourable situation. In its comments on the first draft Amendment of the Trademark Law, the Intellectual Property Tribunal of the Supreme People's Court raises the issue of the right for prior users to continue to use their trademarks. This issue is raised against the phenomenon in which lawful users are charged with infringement when their trademarks are pre-emptively registered, and "the ruling, are often made lawfully, but unreasonably".¹⁰ If the legislation expressly provides for the right of users of unregistered trademark to request for revocation of registration, then the situation would be

different.

As for bad-faith registration, trademark users may request for revocation thereof, and there would not arise such a situation in which a lawful user is charged with infringement, the above “lawful but not unreasonable” result be avoided. Besides, the trademark users’ right to use their trademarks naturally remain “secure”. As regards good-faith registration, since a prior trademark user cannot exercise the right to request for revocation thereof, it is highly possible for the trademark users to be accused of infringement by the trademark registrant. And, it is in this case that the issue of user’s right to continue to use the trademark would arise. For us, a trademark user’s right to use its trademark is a lawful interest based on its own lawful use thereof. The maintenance or loss of the trademark depends on the users’ own will, but should not on the act (and mental state) of another civil entity. A trademark holder in the situation of good-faith registration has no right to deprive another person of its lawful interests it has acquired lawfully by way of registration which is meant to create the right in the first place. Therefore, trademark users should enjoy the right to continue to use their trademarks. The above opinion as raised by the Intellectual Property Tribunal of the Supreme People’s Court may be adopted to handle the confusions that are likely to arise owing to the use of the same trademark by different subjects: “The users are required to add proper sign on their goods or services in order to set them apart from that of the trademark owner.”

Under the system adopting the registration-based principle, it conforms to the fundamental purpose of trademark protection to conditionally recognise the prior right of the prior users of trademarks, and give them the right to request for revocation of registration, which would not affect the implementation of the registration-based principle. Compared with the trademark right owned by trademark registrants, such rights of prior users are limited both in substantive and procedural terms.¹¹ Since the protection for users of unregistered trademark is limited, it would not pose any threat on the established registration system in China.¹²

Meanwhile, the requirement of use of registered trademark should be expressly set forth in the trademark legislation, taking it as a condition for the right to exist in the trademark legislation. It is not merely to require the competent trademark authority to undertake administration. Only by this substantive change is it possible to establish the justness of trademark right.

The author: Associate Professor of the School of Law, the People's University of China

1. By “drawing on” here is meant the study, analysis and adoption of

the legal system of other countries, but not simply by taking provisions therefrom. The Chinese scholars often refer to the relevant systems of other countries, in designing the system for IP protection in China, in ways they think proper. Some differences among them are actually brought about by the different methodology in research.

2. “Trademarks well known to the public” refer to well-known trademarks. In the enforcement practice, this provision serves as the legal basis for the protection of well-known trademarks. See Fan Hanyun, *Laws and Regulations Governing Revocation of Improperly Registered Trademark and Their Enforcement in China*, in the *China Patents & Trademarks*, 1999 No. 3. However it is not a standard concept, and is differently interpreted as, e. g. “well-known”, or “known”. If interpreted as “known”, then a trademark is not well known but with some reputation are included, which is apt to cause inconsistency in the application of law. For example, in the Final Ruling in Writing on the Improper Registration of the Trademark “扭扭” by the Trademark Review and Adjudication Board of SAIC made to revoke the respondent’s registered trademark “扭扭” on the ground that its act has constituted registration by counterfeiting of the trademark of another person that enjoys some reputation. See the Final Ruling in Writing on the Improper Registration of the Trademark. “扭扭” No. Shangpingzi 3862/1999.

3. See Fan Hanyun, *Laws and Regulations Governing Revocation of Improperly Registered Trademark and Their Enforcement in China*, in the *China Patents & Trademarks*, 1999 No. 3.

4. The current German Trademark Law as effective in January 1995 has extended the approach to acquisition of trademark protection. It is expressly provided therein that trade mark protection shall accrue: 1. By registration of a sign as a trade mark in the Register kept at the Patent Office; 2. Through the use of a sign in the course of trade, insofar as the sign has a secondary meaning as a trade mark within the affected trade circles; 3. By notoriety as a trade mark within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (the Paris Convention).

5. Horst-Peter Gotting: *Protection of Well-Known, Unregistered Marks in Europe and the United States*, IIC Vol. 31, No. 4/2000, Pp. 395-396.

6. The issue of the trademark users’ prior right has drawn wide attention. See Jin Xi, *Interests and Protection of Prior Trademark Users*, in the *China Patents & Trademarks*, 1999 No. 1; Liu Xiaohai, *Reflection on the Principle for Acquisition of Trademark Right and “Reverse Counterfeiting” of Trademark*, in the *Intellectual Property*, 1999 No. 1.

7. This is not the case with well-known trademarks. Protection for well-known trademarks is just a matter of improvement of the current legislation. To be specific, first is to improve the provision for the right to request for revocation by extending the specified right to request for revocation of bad-faith registration of well-known trademarks to that to the right to request for revocation of good-faith registration of well-known trademarks, and by taking good faith and bad faith as the basis for different limitation for the right of the nature. Second is to incorporate the provision for prohibition of the use of the right to request for revocation into the present provisions for right to

request for revocation of registration.

8. See Liu Minxue, the Explanation of the Draft Amendment of the Trademark Law of the People's Republic of China, the Collection of Trademark Laws and Regulations of the People's Republic of China, the China Rule of Law Publishing House, P. 10.

9. Supra Note 3.


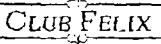

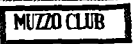

10. See Guidance and Norm of Reference for Hearing IP Cases compiled by the Intellectual Property Tribunal of the Supreme People's Court of the People's Republic of China, the Publishing House of Law, first edition, December 2000, Pp. 637-639.

11. The trademark right in its substantive sense is shown as the rights subjects to control over relevant trademarks (including the rights of use, license, assignment and prohibition); the trademark right in its procedural sense refers to the right for a subject to raise opposition to or to apply for invalidation of another person's trademark registration,

application or trademark registration of any trademark identical with or similar to its own registered trademark in connection with relevant goods or service (to raise opposition to its application or registration), while the right of prior use in the substantive sense is at most embodied in a valid right of use of a given scope (usually limited to the scope of the goods or service in respect of which the trademark is used and of their market), and the right in its procedural sense is that an owner of an unregistered trademark has the right to file a request for revocation of a trademark which another person has registered in bad faith.

12. For different opinions see Zheng Zhujun, Those Applying the Law Should Lead the Realisation of the Function of Law by the Right Action — Comments and Analysis of Several Cases of Revocation of Registered Trademarks, in the Study of Law and Commerce, 1998, No. 8.

滿利洋行 (MULITEX LIMITED) 是下列商標的所有人。這些商標已由中華人民共和國國家工商行政管理局商標局批准獲得註冊。滿利洋行享有這些註冊商標的專用權, 任何人士未經滿利洋行書面許可, 在同一類或類似的商品上使用這些註冊商標, 滿利洋行必採取法律行動予以追究。

商標	註冊號	使用商品	分類	商標	註冊號	使用商品	分類
PINO BLANCO	1323289 1999/10/14	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	URBAN EXPOSURE	1315811 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25
SPRING CREEK	1323285 1999/10/14	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	COHIBA	1316007 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25
FURRUCHE	1323288 1999/10/14	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	 CLUB FELIX	1310793 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25
LARIDAS	1323290 1999/10/14	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	BUNGY SPORTS	1230570 1998/12/14	T 襯衣, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋	25
OXWORD	1323291 1999/10/14	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	WILD ORCHIDS	1350909 2000/01/07	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25
FADI	1307109 1999/08/21	自行車	12	ATOMIC CLUB	1350911 2000/01/07	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25
 CLUB FELIX	1310794 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	 COMFI	893725 1996/11/07	鞋, 帽, 手套, 腰帶, 襪子	25
MISCHIEF	1315813 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	 MUZZO CLUB	881926 1996/10/14	服裝, 鞋, 帽, 領帶, 腰帶, 手套, 圍巾	25
PROXY	1310785 1999/09/21	T 恤衫, 外套, 內衣, 襯衣, 褲子, 背心, 短褲, 童裝, 靴, 拖鞋, 鞋, 襪	25	 BLACK STALLION	893492 1996/11/07	服裝, 鞋, 帽, 手套, 腰帶, 襪子, 領帶	25
COASTAL NAVIGATOR	1174745 1998/05/14	服裝, 鞋, 帽	25	JULIAN CHARLES	1174748 1998/05/14	服裝, 鞋, 帽	25
JUMPING JACK FLASH	1174746 1998/05/14	服裝, 鞋, 帽	25	FERNANDO PENA	1174749 1998/05/14	服裝, 鞋, 帽	25
				TIME IS NOW	1174747 1998/05/14	服裝, 鞋, 帽	25