

# 商标的准确界定及对实务的影响

## Accurately defining a trademark and the effect of this on practice



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遍观全球各国的商标法以及有关国际协定，对商标都不约而同的要求必须能够识别商品的来源，这一对于商标功能性的要求，是商标的本质。凡是不具备该功能的，就不可能构成商标。理解这一点，就抓住了商标法的关键，有助于解决很多实务中的法律问题。

关于“贴牌加工”领域的“商标”使用行为，目前仍存在是否构成侵权的争议。贴牌加工英文为 Original Equipment Manufacturer (OEM)，主要是指某国厂家根据境外另一厂家的要求为其生产商品，商品所使用的“商标”由委托人提供。

当境外委托人提供的商标与国内商标权利人的商标发生冲突，便可能出现侵权纠纷，此类纠纷最常见的处理机关是海关和人民法院。目前，不仅在海关与法院之间，而且在海关和法院的内部，也未就此类案件达成共识。

### 主流观点

但是，据笔者观察和总结，主流的观点已经倾向于认定不侵权。认定不侵权的理由是：在贴牌加工领域，由于商品不面向中国的消费者，商标尚不能发挥识别来源的作用，不构成商标使用。

根据中国的商标法，在相同或类似的商品上使用相同或近似的商标才有可能构成侵权，如果连使用都不构成，自然也就不构成侵权。

但是，如果换一个角度从商标的本质出发，可知对于中国的消费者而言，贴牌加工的商品上所使用的“商标”并不是为了向中国的消费者昭示商品来源，其作用至多只是一个标志或装潢而已。该标志与商品

的其他组成部分无本质差别，只有在进口国的消费者认牌购物时，该标志才成为商标，属性发生了变化。

因此，要透过现象看到本质，大胆地否定贴牌加工中存在商标法意义上的商标，从而釜底抽薪地否定侵权。

### 合理使用

关于注册商标的合理使用问题，原商标法实施条例第四十九条以及2014年新商标法的第五十九条均规定了商标的合理使用情形。例如，注册商标中含有的本商品的通用名称、图形、型号，或者直接表示商品的质量、主要原料、功能、用途、重量、数量及其他特点，或者注册商标含有的地名等，注册商标专用权人无权禁止他人正当使用。

在法律明确规定的合理使用的情形之外，也存在其他形式的商标合理使用，包括使用他人的注册商标并不是为了识别自己商品的来源，而是出于单纯的解释或说明目的。例如在对比广告中，不可避免地要使用他人的商标，该使用并不是用于说明自己商品的来源，其作用仍然是识别商标注册人的商品。因此，对比广告中确实存在商标及商标的使用，这是第一层的理解。接下来根据新商标法的规定，由于对比广告的特性，相关公众显然不会将他人的商标认为是广告发布者的商品，因此不存在

“任何人不得以不正当手段抢先注册他人先使用并有一定影响的商标”



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混淆，也就不构成商标侵权。当然，对比广告是否合法，还要视乎《反不正当竞争法》、《广告法》等其他法律而定。

### 商标抢注

关于商标的“抢注”问题。抢注有各种形式，其中商标法第三十一条规定，任何人不得以不正当手段抢先注册他人先使用并有一定影响的商标。该条适用的前提是：在先使用的应当是商标。换句话说，不能识别商品来源的标志，例如缺乏显著性又未通过实际使用获得显著性的标志，均不当受到第三十一条的保护。典型的案例就是内蒙古小肥羊与西安小肥羊争夺“小肥羊”商标的纠纷案件。

西安小肥羊在先申请注册“小肥羊”，但因为缺乏显著性被驳回。后来内蒙古小肥羊申请“小肥羊”，西安小肥羊提出异议但并未获得支持，理由即是西安小肥羊的使用规模有限，其“小肥羊”尚未获得显著性，不构成商标。内蒙古小肥羊通过大规模使用，已经使得其“小肥羊”具有了显著性，当然可以申请并获得注册。请注意，在此类案件中，对通过使用获得显著性的相应要求已经超过了“有一定影响”。

### 商标本质

运用商标的本质分析问题的思路已经体现在商标法的不同规定中。

例如，关于判定企业名称或商品名称是否侵犯了商标权，法律规定都将名称是否能误导公众作为重要考虑因素，这实质上就是考虑企业名称或商品名称能够指示商品的来源。■

Looking at the trademark laws of countries around the world, and relevant international agreements, one can see that they all require trademarks to be capable of identifying the source of goods. This functional requirement is at the very essence of trademarks. Anything that does not have this function cannot constitute a trademark. By understanding this point, one grasps the crux of trademark law, which is helpful in resolving many legal issues encountered in practice.

With respect to the use of “marks” in the original equipment manufacturing (OEM) sector, there remains a debate as to whether it constitutes infringement. OEM mainly refers to the production of goods by a manufacturer in a certain country, based on the requirements of another manufacturer located in another country, with the “mark” used for the goods provided by the client.

When the trademark provided by the foreign client conflicts with the trademark of a domestic trademark rights holder, an infringement dispute may arise, with the authorities most often dealing with such disputes being customs and people’s courts. At present, not only has no consensus been reached on such cases between customs and courts, but such consensus is also absent within customs and within the courts.

### Mainstream view

However, the author believes the mainstream view is tilting toward its not being infringement, because in the OEM sector the goods are not targeted at consumers in China, a trademark cannot fulfil its function of identifying the source of the goods, and therefore does not constitute use of a trademark. Pursuant to the Trademark Law, infringement can only be constituted when an identical or similar trademark is used for identical or similar goods, therefore where even use is not constituted, infringement cannot be constituted.

However, changing perspective and approaching the issue from the essence of a trademark, it can be seen that, for the consumer in China, the “mark” used on OEM goods is not there for the purpose of indicating the source of the goods to the Chinese consumer, its function at most being that of a sign or decoration. There is no essential difference between that sign and the other constituent parts of the good, such sign only

becoming a trademark when consumers in the importing country see the brand and are shopping, whereupon its attribute changes. Accordingly, it is necessary to go beyond appearances and look at the essence, boldly deny that trademarks as contemplated in the Trademark Law exist in OEM processing, and thereby cut to the chase and deny infringement.

### Reasonable use

Both article 49 of the previous version of the Implementing Regulations for the Trademark Law and article 59 of the new 2014 version of the Trademark Law set out the circumstances that constitute reasonable use of a trademark.

For example, where a registered trademark contains the generic name, depiction or model number of the goods concerned, directly indicates the quality, main raw materials, functions, intended purpose, weight, quantity or other characteristic of the goods, or contains a place name, the holder of the exclusive right to use the registered trademark does not have the right to prohibit others from making reasonable use of it.

In addition to the cases of reasonable use expressly specified in law, there exist other forms of reasonable use of trademarks, including using another’s registered trademark not for the purpose of identifying the source of one’s goods, but simply for purposes of explanation or elucidation. For example, in a comparative advertisement where the use of another’s trademark is unavoidable, such use is not for the purpose of explaining the source of one’s goods, and its function remains that of identifying the goods of the trademark rights holder. This is the top layer explanation.

Next, pursuant to the new Trademark Law, due to the special nature of comparative advertisements, it is clear that the relevant public will not mistake another’s trademark as the goods of the publisher of the advertisement. Accordingly, there is no confusion and trademark infringement is not constituted. Of course, the question of whether comparative advertising is lawful is still dependent on other laws, such as the Law Against Unfair Competition, the Advertising Law, etc.

### Pirate registrations

The “pirate registration” of trademarks comes in many forms, among which article 31 of the Trademark Law specifies

“No one may use unfair means to pre-emptively register another’s trademark”

that no one may use unfair means to pre-emptively register another’s trademark that has prior use and has a certain degree of influence. The precondition to the application of this provision is that the thing that has prior use is a trademark, in other words, a sign that does not identify the source of goods, e.g. a sign that lacks distinctiveness and has not achieved such distinctiveness through actual use is not subject to the protection of article 31.

An illustrative case is the dispute between Inner Mongolia Little Sheep and Xi’an Little Sheep over the trademark 小肥羊 (Chinese characters for “little sheep”). Xi’an Little Sheep applied for registration of 小肥羊 first, but was rejected because it lacked distinctiveness.

Subsequently, Inner Mongolia Little Sheep applied for 小肥羊, to which Xi’an Little Sheep filed an opposition which was, however, rejected on the grounds that Xi’an Little Sheep’s scope of use was limited, and its 小肥羊 had not yet achieved distinctiveness, and thus did not constitute a trademark.

Through wide-ranging use, Inner Mongolia Little Sheep, on the other hand, had caused its 小肥羊 to achieve distinctiveness and, naturally, could apply for and secure registration. Please note that in such cases, the requirements in respect of distinctiveness achieved through use exceed having “a certain degree of influence”.

The approach of using the essence of trademarks to analyse issues is reflected in different provisions of the Trademark Law. For example, with regard to determining whether an enterprise name, or the name of a product, infringes upon trademark rights, provisions of laws all make whether such name misleads the public an important factor to be considered, and this, in essence, is taking into consideration whether the enterprise name, or the name of the product, indicates the source of the product. ■

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