

商业合作中如何保护商标权 Foreign enterprises need trademark protection in co-operation contracts



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作为制造大国和出口贸易大国，中国吸引了大量的外国公司和个人来华开展商业合作。如在商业合作中未明确约定商标权的使用及保护问题，在商业合作的过程中甚至合作结束后，都有可能引发知识产权纠纷，其中尤为突出的是商标抢注。笔者在近年来的办案中发现，有不少外国企业在与中国的企业或个人的合作中遭遇商标抢注，致使其在中国的业务严重影响甚至无法开展。关于如何避免此类纠纷，笔者根据多年的经验结合现行法律，提出以下建议。

及时、全面注册

从笔者多年来经手的案件中看，外方企业遭遇商标抢注的原因主要归结为三种类型。

一是忽视了知识产权的保护。此种类型在委托加工类合作中尤为常见。委托方在中国只进行委托加工生产(OEM)，因此认为没有必要进行商标注册，导致他人对商标进行了注册。

二是没有认识到商标保护的地域性原则和在先注册原则。很多国外企业在其所在国家或地区拥有商标注册，但没有注意到商标权的地域性，品牌进入中国大陆后，未在中国大陆进行注册。有些则是认为使用就产生权利，没有注意到中国的商标专用权的产生是注册在先原则。

三是没有注意到中国商品分类的特点，导致注册范围不准确或者不全面。中国的商品和服务区分表虽然是以WIPO提供的分类为基础，但又其独特之处，例如各个大类中又划分为几个子类(subclass)，有的子类中不同段落的商品、服务不构成类似

等。如果注册时商品、服务指定得不准确或不完整，就为抢注人留下了可乘之机。

为了避免商标遭他人抢注，建议品牌进入中国之前聘请当地的专业机构，事先做好商标的注册评估，提供商标的注册和保护策略，及时、全面注册。

另外，还需要注意的是中文商标的及时注册。很多外方企业忽视了商标的本地化，未对中文商标进行及时、有效的注册，导致中文商标被抢注，无法使用市场已经认可的中文名称，最终被迫无奈启用新的中文商标。

完善的合同约定

在抢注人中，很多是与外方企业曾经有过加工、经销、贸易等商业合作关系。合作一方注意到对方的商标未在中国注册，或者注册不全面，而双方合同中对于商标方面又没有约定，于是合作一方进行了商标抢注。

如果双方的商业合同约定包含了知识产权条款，这些问题是可以在一定程度上进行预防，且一旦出现违约行为，可以依据该条款通过合同约定解决问题。另外该合同还可以作为重要证据，支持商标撤销程序。因此，我们建议在商业合同中增加知识产权条款，明确双方的知识产权的内容、归属、使用的方式和范围，并约定禁止一方对另一方的知识产权作为商标、域名、企业

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名称注册。如发生此类抢注，则需按照合同将该项知识产权无偿转让给另一方或进行注销，并约定相应的违约责任。

另外，企业应当重视合同以及与双方合作有关的文件等证据的保管，一旦发生纠纷，此类证据将成为获胜的重要筹码。

积极有效的维权

一旦商标被他人抢注，企业需要积极、及时采取法律行动，争取重新获得商标权。如前文提及，很多企业在发现商标抢注之时，对方的商标已经获准注册，此时，应及时调研情况，如调研对方注册是否已满三年，近三年来是否有在指定使用的商品或服务上使用；如果没有，则可提起连续三年不使用之撤销程序，同时立即提交新申请。

如对方商标已经投入使用，则需要尽快提起商标无效宣告程序。因商标注册满五年后，无效宣告申请人需要主张商标驰名以支持无效宣告申请，而驰名认定的条件非常高，无效宣告申请人的举证任务沉重。因此及时发现抢注、及时提出无效宣告申请十分重要。

要做到及时维权，首先要能及时发现抢注行为。因此，建议外方企业委托专业机构做全面的商标注册监控，以及市场监控，以便及时发现抢注及侵权，并制定相应策略。

外方企业如熟悉中国的商标法律和制度，充分认识到商标注册的价值和重要性，并制定好商标的注册和保护策略，则不但可以从商业合作中赢得商业利益，同时也可以让自己的品牌在商业合作中得到保值、增值。■



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As an important manufacturing and export trading country, China attracts numerous foreign companies and entrepreneurs for business co-operation. If there is no specific agreement on the exercise and protection of trademark rights between the parties in the business co-operation, IP disputes, especially involving trademark piracy, are likely to arise, in the midst or even after the co-operation. In recent years, this author has seen many international enterprises suffer from trademark piracy at the hands of Chinese counterparties in co-operation. Some of these foreign companies found themselves so badly affected by trademark piracy that expanding their business in China proved difficult. To prevent these types of disputes, this author has the following recommendations based on experience and current law.

Register mark promptly

In this author's experience, there are three main reasons why foreign enterprises suffer from trademark piracy. First, there is lack of awareness of the need for IP protection. This is typical in co-operations with original equipment manufacturers (OEMs), under which circumstances only entrusted production is conducted in China. The foreign enterprises therefore deem it unnecessary to carry out trademark registration in China, leaving their trademarks open to pre-emptive filings by other parties.

Second, they do not recognise the principles of territoriality and the "first to file" rule. Many foreign enterprises have registered their trademarks in their home countries or regions, and some are unaware of the territorial nature of trademark rights. When bringing their brands into China, they do not obtain Chinese registrations, perhaps under the impression that trademark rights can be originally obtained through prior use, while the fact in China is that the exclusive trademark right is obtained through registration.

Finally, they may not notice the uniqueness of China's classification of similar goods and services, which can result in an inaccurate or incomplete scope of registration. Although China's classification is based on the classification provided by the World Intellectual Property Organisation, it has its own particular wrinkles. For example, each class is further subdivided into several subclasses, and some goods or services in different paragraphs in the same subclass may not be deemed as similar. If goods or services are not accurately or completely designated at the time of registration, loopholes are created for pirates to take advantage of.

To avoid pirate trademarks registered by others, this author recommends that a local professional firm be engaged, before the brand is introduced into China, to duly carry out a trademark registration assessment and provide a trademark registration and protection strategy, enabling the prompt and comprehensive registration of the trademark.

One more thing deserving attention is the timely registration of the Chinese equivalents of trademarks. Many foreign enterprises overlook the localisation of their trademarks and fail to register their marks in the Chinese language. This can result in the pirate registration of Chinese-equivalent trademarks, making it impossible for them to use the Chinese name for their brand that may already be well recognised in the market, and ultimately driving them, in frustration, to turn to a new Chinese-language trademark.

Sound contract with co-operator

Among trademark pirates or copycats, many once entered into business co-operation with foreign parties to undertake processing, distribution or trade. But in this case, the co-operator files the pirate application of the client's trademark, knowing that the foreign party's trademark has not been registered or fully registered in all relevant goods and services in China, and the contract between the parties is silent on trademark-related matters.

If the commercial contract between the parties had well set out IP terms, the pirate problems could have been contained to a certain extent, for if a breach of contract arose, the issue could have been resolved by the contractual terms. Also, the contract is important evidence in a trademark cancellation procedure.

Accordingly, this author recommends that IP terms be added to any commercial contract, expressly stating the content, ownership, method and scope of use of the parties' IP rights, and preventing one party from applying for or registering the other party's IP rights including but not limited to trademark, domain name or enterprise name. In case of such a pirate registration, the IP rights in question must be transferred to the other party free of charge, or deregistered in accordance with the contract, and the breaching party should assume corresponding liability for the breach.

Furthermore, a company should pay attention to evidence preservation of such a contract and supporting documents, in case of any dispute when such evidence may be crucial for winning the case.

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Once the pirate registration of a trademark has been filed, the affected enterprise should take prompt legal action to recover the rights. In the above-mentioned case that the pirate trademark is already registered by the time the enterprise discovers it, an investigation on trademark use is recommended to find out whether the mark has already been registered for over three years, and whether the trademark has been used on designated goods or services during the past three years. If it was not put into use in the past three years since registration, the affected enterprise may launch a non-use cancellation, and simultaneously file a new application for the mark.

Invalidation procedures

If the pirate trademark has already been put into use, immediate invalidation procedures against the mark are recommended. That is because after registration for five years, a registered trademark can only be invalidated based on the "well known trademark" claim. Given that it is very difficult and there is a heavy burden of proof to meet the requirement of recognising a trademark as well known in China, it is important to discover the pirate trademark and launch invalidation procedures in time.

To well protect clients' IP rights, it is important to discover the pirate trademark application and registration in time. This author recommends that foreign enterprises engage a professional firm to comprehensively monitor both trademark registrations and the market, in order to discover pirate registrations and infringements, and formulate a timely strategy.

In the end, international business ventures can not only benefit from business co-operation, but also preserve and even increase the value of their brands if they are more familiar with China's trademark laws and regulations, fully realising the value and importance of trademark registration and formulating a trademark registration and protection strategy. ■

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