

如何免受通用名称问题的困扰

How to avoid the headache of your brand's 'genericisation'



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于 2014年5月1日生效的中国新《商标法》有一大亮点，就是规定了以通用名称为法律基础的撤销制度。

新商标法第四十九条第二款规定，注册商标成为其核定使用商品的通用名称的，任何单位或者个人可以向商标局申请撤销该注册商标。

新规定

从新规定中我们可以看出以下几点：1) 与新商标法生效之前的法律和实践不同，一旦注册商标成为其核定使用商品的通用名称，该商标就可能被撤销注册。不仅商标注册时是通用名称的不予注册，商标注册成功之后成为通用名称的也将被撤销注册；2) 成为通用名称的商标，任何人都可以申请撤销；3) 通用名称的撤销制度应限制在核定使用的商品/服务上。

三种情况

根据当前中国商标法律法规的规定及实践，认定诉争商标是否为通用名称通常有以下三种情况：

1. 依据法律规定或者国家标准、行业标准属于商品通用名称的，应当认定为通用名称。这是法定通用名称的认定，主要依据相关的国家或行业标准以及工具书、词典等出版物中的记载予以确定。在提供相关依据的前提下，法定通用名称的确定一般不存在问题；
2. 相关公众普遍认为某一名称能够指代一类商品的，应当认定该名称为约定俗成的通用名称。对于约定俗成的通用名称的认定，目前实践中较为通行的做法

是以相关行业的生产者认定为认定主体，结合相关行业普通消费者的认知；

3. 对于具有特殊地域限制的商品，诉争商标是否为通用名称依相关市场通行的观点确定，但对于这一点现行的商标法律实践并不统一。

疏忽的代价

有不少注册商标所有人因为疏于对其商标专用权的保护，随着其商标知名度越来越高使得其商标成为相关商品的通用名称。典型的案例有“金骏眉”通用名称商标行政纠纷案（参见北京市高级人民法院（2013）高行终字第1767号行政判决书）。鉴于新商标法已明确规定了通用名称撤销制度，为了使自己花费大量的精力和财力维持的知名商标不被淡化而成为通用名称，注册商标所有人有必要做好充分的准备。

防止淡化

已注册的知名商标的所有人可以从如下方面入手防止其知名商标被淡化而演变为通用名称：

1. 建立完善的商标监视系统，采取积极的商标维权措施。我们知道许多已注册商标最终沦为通用名称的最主要原因是商标权人疏于保护其商标权。随着商标侵权行为的增加，一些知名商标日渐成为相关行业的通用品牌，最终成为通用名称而被撤销注册。为避免这种情况的出现，商标权人有必要为其知名商标搭建完善的商标监视系统，如果发现相同的或者混淆性近似的商标，就应



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该在行政程序中或者诉讼程序中予以清除。

2. 密切关注相关市场，积极清除市场上的侵权品牌及产品。在当前中国，在特定知名品牌之前加上诸如公司商号等而形成一个新的品牌，进而与特定知名品牌共同在市场出现的情况屡见不鲜。对于这类情况，知名商标所有人应该利用其在先商标权对上述侵权主体予以打击，例如发律师函、申请工商查处、申请海关查扣等，必要时提起民事侵权诉讼甚至刑事诉讼。

进入新时代

3. 进行媒体宣传，防止知名商标被媒体误用。中国已经进入了信息快速传播的时代。由于个别媒体工作者知识水平的限制或职业操守不高等原因，在进行媒体报道或使用词条时误将某一知名商标用来泛指某一类商品的情况时有发生。针对类似情形，知名商标所有人切不可坐视不管，否则类似的报道经过多次转载必然使消费者产生错误的认识，时间一长其商标的知名度就可能被淡化而演变为通用名称。
4. 注意保存进行商标维权的各种证据，以对抗商标侵权泛滥而“被通用名称”的风险。事实上，类似“金骏眉”案件就给知名商标所有人很好的警示：倘若不提前做好准备积极打击商标侵权行为并保留商标维权的各种证据，知名商标所有人在商标侵权泛滥的情况下其商标“被通用名称”的风险无疑会增加。因此，保存各种商标维权的证据对知名商标所有人来说无疑是必要的。■

One of the major bright lights in China's new Trademark Law, which entered into effect on 1 May 2014, is that it specifies the system of cancellation on the legal basis of genericisation.

The second paragraph of article 49 of the Trademark Law specifies that if a registered trademark becomes the generic name of the good for which it has been approved, any entity or individual may apply to the Trademark Office to have the registered trademark cancelled.

From the new provision, we can discern the following points: (1) in contrast with the law and practice before the implementation of the new Trademark Law, once a registered trademark becomes the generic name of the good for which it has been approved, the registration of that trademark can be cancelled. Now, not only are generic names not able to be registered at the time of trademark registration, but a trademark may be cancelled after it has been successfully registered, if it becomes genericised; (2) anyone may apply to have a genericised trademark cancelled; and (3) the system of cancellation based on genericisation should be limited to the goods or services for which a trademark is approved.

Three circumstances

Based on current Chinese trademark laws, regulations and practice, the three circumstances under which a disputed trademark will commonly be found to have been genericised are as follows:

1. Where, based on laws, or national or industry standards, it is the generic name of a good, it should be found to be the generic name. This is the recognition of a statutory generic name and is mainly determined based on the relevant national or industry standard, as well as what is recorded in reference books, dictionaries, etc. Provided the relevant basis is given, the determination of a statutory generic name is generally not problematic.
2. Where the relevant public generally is of the opinion that a certain name can refer to a class of goods, it should be found that such name has become genericised through common usage. For a finding of genericisation through common usage, the most common method is to take the producers in the relevant industry as the determining entities, while taking into account the cognition of the general consumer of the industry.

3. For a good that is restricted to a specific geographical area, the question of whether a disputed trademark is a generic name is determined based on the common point of view in the relevant market, although current trademark law practice on this point is far from unanimous.

Costly negligence

A significant number of registered trademark owners have, due to negligence in protecting the right to the exclusive use of their trademarks, seen their trademarks become the generic name of the relevant good as the name's notoriety increased. A typical case would be the “Jinjunmei” generic name administrative trademark case (see administrative judgment [2013] Gao Xing Zhong Zi No. 1767 of the Beijing Municipal Higher People's Court). Given that the new Trademark Law has set out the system of cancellation based on genericisation, trademark owners must make the proper preparations to prevent their well known trademarks, on which they have expended a great deal of effort and money to maintain, from weakening and becoming genericised.

Owners of registered well known trademarks may approach the problem of preventing the weakening and genericisation of these trademarks by the following means:

1. Establishing a sound trademark monitoring system and adopting proactive trademark right protection measures. We know the main reason that many registered trademarks ultimately suffered “genericide” was that the trademark rights holders were negligent in protecting their trademark rights. With the increase in trademark infringement, certain well known trademarks gradually became the generic brand of the relevant industry, and ultimately the genericised name, following which their registration was cancelled. To avoid this fate, a trademark rights holder must erect a sound trademark monitoring system for its well known trademark, and if it discovers an identical or confusingly similar trademark, it should have it eliminated in an administrative procedure or trial procedure.
2. Keeping a close watch on the relevant market and actively purging infringing brands and products from the market. In present day China, situations where a company's trade name, etc., is added before a specific well known brand, thereby constituting a so-called new brand that then appears concurrently in the market with the well known brand, have become common. In such a situation, the holder of the well known trademark should use its prior trademark right to crack down on the above-mentioned infringing entity, e.g. by issuing it a lawyer's letter, applying for investigation and handling by the administration for industry and commerce, applying for customs investigation and seizure, etc., and where necessary instituting a civil infringement procedure, or even a criminal procedure.
3. Carrying out media publicity and guarding against erroneous use of the well known trademark by the media. China has entered the era of rapid dissemination of information. Due to reasons such as the limited knowledge level or the low professional standards of individual media workers, the erroneous use of well known trademarks to indicate a certain class of goods in the course of media reports, or use of a term, occasionally occurs. In the face of this the owner of the well known trademark cannot just sit idle. If it fails to act, the repeated reprinting of similar reports will give rise to misunderstanding among consumers, and with time the notoriety of the trademark could be weakened and it could become a generic name.
4. Preserving evidence of efforts to safeguard trademark rights to combat the risk of genericisation of the trademark due to a flood of infringements. Cases like the “Jinjunmei” case provide an excellent warning for owners of well known trademarks. If preparations are not made in advance to actively combat trademark infringements and evidence of efforts to safeguard trademark rights is not kept, the risk of a trademark owner's well known brand becoming genericised will increase where there is a flood of trademark infringements. Accordingly, preserving evidence of efforts to safeguard trademark rights is absolutely necessary. ■

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