

重估商标保护的**法律基础**

Reassessing the foundations of trade mark protection



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任何企业要在中国取得知识产权保护的胜利，都必须具备全局眼光，并懂得未雨绸缪，为未来的成功铺路。虽然所有法律体系都有其薄弱环节，但是那些善于洞察不同法律体系的有利条款，并为己所用的企业，往往能为其将来的知识产权保护奠定更坚实的基础。

中国对商标权的法律保护具有三个显著特点：商标注册审查的时间相对较长；商标注册用商品和服务分类进一步细化；外国商标本土化（中文版本）的重要性。如果中国本土企业和外国企业能关注并解决这三个问题，就能为自身商标权利的保护打下良好的基础。

商标注册

中国的商标注册程序分为三个阶段。第一个阶段是商标注册审查阶段，目前通常需要两到三年的时间。商标注册申请被核准后会在《商标公告》中予以公告，然后进入第二阶段，即初步审定阶段。初步审定阶段会持续三个月时间，在此期间主要处理对初步审定的商标提出的异议。如果三个月期满没有出现任何异议，则予以核准注册。这是典型的商标注册“申请”程序，是其取得商标专用权的第一要件。然而，商标注册实际操作中的问题要复杂的多，而且可能会非常棘手，例如中国的商标注册用商品和服务分类实践。

商品分类进一步细化

中国采用的是基于《商标注册用商品和服务国际分类尼斯协定》（简称《尼斯协定》）确定的国际分类体系。然而，中国

在实践中对上述分类体系进行了拓展，就是将《尼斯协定》里列出的45种商品类别进一步细分为子群组，并据此判断有关商品或服务是否相同、近似或不相似。要真正了解和解决这一问题，关键是要对国家工商总局商标局编制的最新版的《类似商品和服务区分表》进行深入研究。

此《区分表》详细列明了商标局在审核商标注册申请时，如何根据申请商标所在的商品或服务群组来判断申请商标是否与注册在先的商标相同、近似或不相似。例如，在当前的实践中，如果两个商标在外观和发音上近似，但是注册在不同的群组下，他们会被认定为不相似。因此，那些包含了许多子群组的商品或服务类别，例如第7类和第9类，可能会构成商标注册申请的最大障碍。然而，在某些特定情况下，跨群组注册的商标也可能被视为近似商标。例如，商标局的审理人员可能认为第1402群组（首饰盒）和第1403群组（珠宝首饰）近似，但是第1402群组（首饰盒）和第1404群组（手表）不相似。

一个商标是否与注册在先的商标在外观和/或发音上相同、近似或不相似，由商标注册审查人员判定。因此，对商标注册申请人来说，了解申请商标所在的商品（服务）类别的属性，懂得审查人员的个人判断所起的作用，就显得非常重要。而审查人员或消费者的个人判断，在很大程度上会取决于商标中具有显著特征的文字。所以，对于外文商标来说，注册一个中文版的商标尤为重要。

外文商标的中文版本

注册一个外文商标的中文版本，有助于



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在商标行政审查以及商标诉讼案件中，证明商标驰名的证据的来源地极其重要。在目前的司法实践中，有说服力的证据必须形成于中国国内，来自国外的证据仅具有补充说明的效力。比如，在对“宝马”和“可口可乐”这两个中文商标与其标准外文商标BMW和Coca-cola在中国的普及程度进行对比后，你会发现，这些外文商标的中文版本显然更为知名。

尽管与中国本土企业相比，注册双语商标目前来看似乎与外国企业更加利益攸关，但是对于计划进行海外扩张的中国企业来说，注册双语商标也同样会让他们受益匪浅。这一策略看似简单，然而，很多时候，恰恰是这些最基本的知识和策略却最容易被企业所忽视。

在制定商标保护通盘战略、获益于中国商标法保护的同时，企业需要持续评估构成其商标专用权的法律基础。通过评估并研究相关的法律条款在实践中如何运用，企业可做到一劳永逸，并避免在今后的知识产权保护和法律强制程序中引发不必要的麻烦。商标注册程序，商品类别的细分，双语商标的重要性，这些只是企业在中国建立商标保护体系所需完成的诸多基础工作中的三个环节。但是，这并不代表这三个环节不重要，相反，只有建立起商标保护体系，才能为以后的商标保护工作和法律强制程序提供坚实的基础。■

Success in intellectual property protection in China lies in the hands of those who can see the big picture, and who take action now to lay the foundations for success in the future. Inevitably, there are weaknesses in any set of laws and regulations. However, those who can access and exploit the strengths that also exist in any system will find themselves on a more sturdy foundation for enforcement.

Three characteristics of protecting trade mark rights in China are the comparatively long trade mark registration process, extended subclass practice for trademarks, and the importance of creating a Chinese version of a foreign mark. Local and foreign enterprises alike can ensure a good foundation for trade mark protection and enforcement through comprehensively addressing these three characteristics.

Trade mark registration

The trade mark registration process in China has three stages. The first stage of registration is the application review process that currently lasts an average of two to three years. Once an application has been approved, it is published in the *China Trademark Gazette* and enters the second stage, provisional registration. The provisional registration period lasts three months and is a window for opposition proceedings. If the trade mark is not opposed within the three month window, it matures into registration.

This is what is typically known as a straightforward application process, and is the first foundation of trade mark establishment. However, addressing the complexities of registration that may sometimes arise can prove to be difficult. One such complexity is China's characteristic extended subclass practice.

Extended subclass practice

China uses and honours the *Nice Agreement Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks* (the Nice Agreement), and the International Classification system. However, one expanded characteristic of China's trademark classification regime is to break down the 45 classes of trade mark listed in the Nice Agreement into

specific subclasses, and to use these subclasses to determine whether goods or services are identical, similar, or dissimilar.

In order to fully address and understand this issue, an in-depth study of the current edition of the *Distinguishing Similar Goods and Services Manual* is crucial. This manual clearly outlines the different practices by which the China Trademark Office (CTMO) distinguishes whether or not the subclass specified in a trade mark application renders the trade mark identical, similar or dissimilar to a previously registered trade mark. For example, in current practice, if two trade marks are similar in appearance and pronunciation, but registered in different subclasses, they are likely to be deemed dissimilar.

Thus, classes that are categorized into many subclasses can pose the biggest obstacle, such as classes 7 and 9 which have a comparatively large amount of subclasses.

However, in certain cases, cross-subclass trade marks may also be deemed as similar. For example, an examiner at the CTMO may deem subclass 1402 (jewellery cases) and 1403 (jewellery) as similar, but subclass 1402 (jewellery cases) and 1404 (watches) as dissimilar.

Whether or not a trade mark is judged identical, similar, or dissimilar in appearance and/or pronunciation to an existing mark is at the discretion of the examiner who is handling the case. Therefore, it is important to be well acquainted with the specific nature of classification for every filing, and to understand the role that the discretion of each individual examiner plays in distinguishing between similar and dissimilar goods or services. The discretion of an examiner or a consumer may also be greatly influenced by the prominent language used in a trade mark. Therefore, creating a Chinese version of a foreign trade mark is extremely important.

Chinese version of foreign mark

Establishing a Chinese version of a foreign mark is important to help CTMO examiners and consumers to understand the link between a trade mark in a foreign language and its local equivalent. Without creating a Chinese version of a foreign mark, an owner of a well-

known foreign trade mark takes the risk that anybody may register the Chinese equivalent of its trademark and 'freely-ride' off of its reputation. This often happens, and can lead to very complex legal proceedings.

In both administrative and judicial proceedings, the place where the evidence of a well-known trademark is formed is of extreme importance. Under current practice, persuasive evidence in a legal proceeding must be formed in China, and evidence formed outside of China is considered as supplementary. Some examples of this are the popularity of the terms "Baoma" and "Kekou Kele", which are the Chinese names of BMW and Coca-cola, respectively. The Chinese version of these trademarks is better known in China than their foreign equivalents.

Even though creating a dual language trade mark may currently be more relevant to foreign enterprises than local, local enterprises can also greatly benefit from the same principle in their preparation to expand their business overseas. Many times it may be fundamental knowledge and tactics that are most easily overlooked.

In creating a comprehensive strategy and enjoying the benefits of the *PRC Trademark Law*, it is important continually to reassess the foundations of your trademarks in China. Through continual reassessment, and careful examination of how the written law translates into actual practice, a company can enjoy long term success and avoid the unwarranted complexities of later protection and enforcement actions.

The trade mark registration process, the subclass practice, and the importance of dual language trade marks are just three sections of a much larger foundation for the establishment of trademark protection in China. But establishment is the foundation of later protection and enforcement. ■

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