

# 涉外商标许可中存在的法律问题

## Legal issues existing in foreign-related trademark licensing



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**本**文所称的涉外商标许可，是指外国公司将其所拥有的商标许可给中国境内公司使用的法律行为。近年来，随着中国经济的持续稳定发展，越来越多的外国公司将其业务拓展到中国市场。而伴随着此类经济活动，涉外商标许可法律问题也日渐凸显。笔者现就实践中注意到的相关法律问题发表如下看法，与大家探讨。

### 中国涉外商标许可相关法律规定

对于在中国境内的商标许可，目前主要法律规定是以《中华人民共和国商标法》、《中华人民共和国商标法实施条例》及其相应司法解释为主的法律规范体系（合称“商标法”）。此外，对于包含商标许可在内的特许经营行为，还有《商业特许经营管理条例》等行政法规进行规制。

### 涉外商标许可之现状

外国公司在中国进行的商标许可存在两种情况：该商标在其本国和中国均已经获得注册；该商标在其本国已经注册，但在中国尚未获得注册（例如尚在申请阶段）。

第一种情况虽具有涉外因素，但实际上是中国注册商标在中国的许可使用，与普通国内商标许可并无二致。对于第二种情况，由于该商标尚未获得注册，因此也无法进行商标许可合同备案，但这并不影响商标许可合同本身的效力。在这方面，现行有效的商标法已较修改前有了很大程度的改善。例如，修订前商标法规定商标许

可合同严格受到政府管制，必须进行备案并由商标局公告，否则将可能受到罚款直至撤销该注册商标的行政处罚。而根据目前的商标法及最高人民法院的司法解释，商标许可合同即便不备案也仍然有效，仅不得对抗善意第三人。

因此，虽然我们仍建议外国公司在中国进行商标许可时应尽量先取得商标注册，但在特定情况下若将处于申请阶段的商标进行许可，只要充分告知对方当事人商标状态，且双方当事人协商一致，仍然具有法律效力。

### 被许可人的情况查明

在商标许可前，查明被许可人的法律状态也是一个重要环节。主要包含两个方面：

第一，查明被许可人的公司是否为中国注册成立并合法存续的公司。在实践中，我们遇到过将国外公司作为整个中国大陆地区的被许可人的情况。而实际上国外公司，甚至香港、澳门注册的公司本身是不能直接在中国大陆地区从事经营活动的，这就可能造成商标许可合同无法实际履行。

第二，必须查明被许可人的经营资质，尤其应注意被许可的商标所指定的商品和服务是否属于国家限制的范围。因此，查明被许可人的法律状态可以保证商标许可合同的合法性和有效性能够在中国境内受到充分的法律支持。

### 许可合同的内容

在涉外商标许可中最主要的法律文件

就是商标许可合同。同样重要的是合同中规定的有效解决争端的条款，它包含三方面的内容：

即法律适用、争端解决方式和管辖。通常而言，法律适用一般可选择中国法或许可人所在地外国法；争端解决方式主要为诉讼或仲裁；管辖地一般为许可人所在地或被许可人所在地；对以仲裁方式解决的，约定由许可人和被许可人所在地之外的其他地区国际仲裁机构仲裁的情况也不罕见。

在进行上述约定时，须考虑到将来发生纠纷时合同能否得到有效执行。鉴于多数情况下执行是发生在中国境内，因此选择中国管辖机构，如国际经济贸易仲裁委员会仲裁，将会方便将来对裁决的执行。此外，香港国际仲裁中心和新加坡国际仲裁中心也是较为常见的争端仲裁机构。值得注意的是，在实践中中国法院目前对于外国法院判决的承认和执行一般仅限于与中国签署双边司法协助协定的国家。若双方约定争端由外国法院管辖，且该外国与中国并未签署双边司法协助协定，则该外国法院判决将可能在中国得不到有效执行。

### 总结

总之，在涉外商标许可的过程中，虽然许可协议可以约定适用外国法并且争端由外国机构管辖，但须注意最终的协议履行及争端产生后的处理仍须在中国境内进行并须得到中国司法机构的支持。因此，充分理解中国相关法律规定及司法实践，并得到相应法律支持，将会更为有效地保障涉外商标许可双方当事人的合法权益。■



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The term “foreign-related trademark licensing” refers to the legal act whereby a foreign company licenses use of a trademark that it owns to a company in the PRC. With the growth and internationalization of the PRC economy, legal issues involving foreign-related trademark licensing have become increasingly salient.

At present, trademark licensing in the PRC is primarily governed by the *PRC Trademark Law*, the *PRC Trademark Law Implementing Regulations* and relevant judicial interpretations. Additionally, the act of franchising, which also includes trademark licensing, is governed by such administrative laws as the *Administration of Commercial Franchising Regulations*.

### Licensed trademark rights

Trademarks licensed in the PRC by foreign companies may have been registered in both the foreign company's home country and the PRC, or may have been registered in the foreign company's home country but not yet registered in the PRC (e.g. a trademark that is still at the application stage).

Although the first scenario includes foreign-related elements, it in fact involves the licensing and use in the PRC of a trademark registered in the PRC, and is in no way different from the licensing of ordinary domestic trademarks. In the second scenario, as the trademark concerned has not been granted registration, it is not possible to file a trademark license contract for the record, but this in no way affects the validity of the trademark license contract itself. In this respect, the current *PRC Trademark Law* has improved greatly as compared to the pre-amendment version. For example, the pre-amendment version of the law specified that trademark license contracts were subject to strict government control, and had to be filed for the record and announced by the Trademark Office, failing which administrative penalties ranging from imposition of a fine up to cancellation of the registered trademark could be imposed. In contrast, under the current Trademark Law and the judicial interpretations of the Supreme People's Court, even though a trademark license contract has not been filed for the record, it remains valid, with the caveat that it cannot be used to oppose a bona fide third party.

Accordingly, we recommend to

foreign companies intending to license a trademark in the PRC that they should, to the extent possible, first secure trademark registration. However, in specific circumstances, such as where a trademark that is at the application stage is being licensed, as long as the other party is fully apprised of the status of the trademark and the parties have reached a consensus on the matter, the license will nevertheless be legally valid.

### Circumstances of the licensee

It is also important to ascertain the legal status of the licensee before licensing a trademark.

First, it should be ascertained whether the licensee company is incorporated and duly existing in the PRC. In practice, we have encountered situations where a foreign company purports to be a licensee for the whole of the PRC. However, a foreign company, or even a company registered in Hong Kong or Macao, may not directly engage in business activities in the PRC. This situation could make the trademark license contract impossible to actually perform.

Second, the business qualifications of the licensee must be ascertained. In particular, attention should be paid as to whether the goods or services for which the licensed trademark is designated fall within a scope restricted by the state. Accordingly, ascertaining the legal status of the licensee can ensure that the lawfulness and validity of the trademark license contract will be accorded due legal support in the PRC.

### Provisions of license contract

The most important document involved in foreign-related trademark licensing is the trademark license contract. It is crucially important to include an effective dispute resolution clause in this contract.

Dispute resolution provisions need to take account of three main points: namely the governing law, the method of dispute resolution and jurisdiction. Generally speaking, either the law of the PRC or the law of the licensor's home country can be selected as the governing law; the main methods of dispute resolution are litigation or arbitration; and the jurisdiction is either the place where the licensor is located or the place where the licensee is located. With respect to ar-

bitration as the method of dispute resolution, it is not unusual to see parties opting for arbitration by a foreign arbitration institution in a place other than the places where the licensor and the licensee are located.

When deciding on the abovementioned provisions, consideration must be given to whether the contract can be effectively enforced in the event that a dispute arises in future. Given that in many circumstances enforcement will occur in the PRC, the selection of a competent PRC arbitration institution, such as the China International Economic and Trade Arbitration Commission, can facilitate future enforcement of the award. The Hong Kong International Arbitration Centre and the Singapore International Arbitration Centre are also regularly used. One point that needs to be noted is that at present, PRC courts will generally recognize and enforce only foreign court judgments of those countries with which the PRC has signed bilateral judicial assistance agreements. If the parties provide that a foreign court will have jurisdiction over disputes and such country does not have a judicial assistance agreement with the PRC, it is possible that a judgment from such foreign court will not be able effectively to be enforced in the PRC.

### Summary

In summary, although in the course of foreign-related trademark licensing the license agreement may specify the law of a foreign country as the governing law and provide that a foreign institution will have jurisdiction, the ultimate performance of the agreement and the handling of any disputes once they arise will take place in the PRC and will require the support of the PRC judicial authorities. Accordingly, a sound understanding of relevant PRC laws, regulations and judicial practice and securing of the relevant legal support will more effectively safeguard the lawful rights and interests of parties involved. ■

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