

在中国保护商标权的法律途径

Legal options for protecting trademark rights



苍雨春
Spring Chang
铸成律师事务所
合伙人
Partner
Chang Tsi & Partners

申会娟
Shen Huijuan
铸成律师事务所
律师
Attorney
Chang Tsi & Partners

中国的《商标法》及其相关法律法规为商标权利人提供了多种保护自身合法权益的途径选择。商标权利人除了加大主动保护力度外,还可以根据自身条件以及侵权的具体情形和特点,借助行政和司法机关的力量,选择通过如下途径保护商标权利。

行政投诉

根据《商标法》第五十三条之规定,对侵犯注册商标专用权的行为,商标注册人或者利害关系人可以请求工商行政管理部门处理。工商行政管理部门处理时,认定侵权行为成立的,责令立即停止侵权行为,没收、销毁侵权商品和专门用于制造侵权商品、伪造注册商标标识的工具,并可处以罚款。

此途径一般程序如下:权利人针对侵权行为进行投诉,当地工商行政管理部门对商标侵权行为进行调查,对侵权物品进行暂扣。如认定侵权行为成立,工商行政管理部门将做出行政处罚决定,对侵权产品进行没收,并可处以相应罚款;如权利人要求侵权人给予经济赔偿,工商行政管理部门应当事人的请求可以对赔偿事宜进行调解。对于工商行政管理部门的处理决定不服,侵权人可以向人民法院提起行政诉讼。

实际操作中,对中国的知识产权法律和保护制度比较了解的商标权利人,很多情况下倾向于通过此种途径打击侵权人,遏制侵权蔓延,因为这种途径具有方式灵活,办案费用低,时间短,见效快的特点,对打击区域性制售假冒产品有着非常好的效果。

海关备案和查扣

在中国获得注册商标的权利人,可以将注册商标在中国海关总署进行备案,同时将商标使用被许可人进行备案,以获得更充分的海关保护。各地海关执法机关在对通关的进出口货物进行检查时,一旦发现未经授权的标有备案商标的涉嫌侵权产品,将对涉嫌产品进行暂扣,并及时通知备案的商标权利人对涉嫌货物的性质进行确认。如经权利人鉴定后确定涉嫌产品为侵权产品,海关执法机关将对涉嫌产品进行扣留,并进行调查。如调查后确定涉嫌产品为侵权产品,海关执法机关将对侵权产品进行没收和处理,并可以对侵权人处以相应罚款。

在中国这样一个产品制造和出口大国,通过对商标进行海关备案获得海关保护尤为重要和必要。为了便于海关执法机关对货物性质进行判断,权利人在备案时可以对商标使用被许可人的备案信息进行限定,如限定使用时间,进出口方式和口岸等。

借助海关备案和查扣途径,商标权利人可以及时发现侵权产品,遏制侵权产品的出口,避免侵权产品流入国外市场。此种途径尤其适用于那些易于被仿冒并出口到境外的国际知名品牌。需要指出的是,对于在类似商品上使用近似商标的涉嫌侵权行为,目前各地海关的执法相对比较保守。

侵权诉讼

上述两种途径仍有一定的局限性。其一,工商行政管理部门和海关执法机关



北京市西城区北展北街
华远企业号A座7/8层
7-8th Floor Tower A, Hundred Island Park,
Bei Zhan Bei Jie Street, Xicheng District, Beijing
邮编 Postal code: 100044
电话 Tel: + 86-10-8836 9999
传真 Fax: + 86-10-8836 9996
www.ctw.com.cn
电子信箱 E-mail: mail@ctw.com.cn

做出的行政处罚决定均非最终决定,被处罚人或权利人如不服,还可以向有关机关提起行政复议或向法院提起行政诉讼;其二,工商或海关执法机关不受权利人要求侵权人支付经济赔偿的请求。因此,对于情节严重、规模较大的侵权行为,权利人可以保全证据,向有管辖权的人民法院提起民事侵权诉讼,主张要求侵权人停止侵权、赔偿损失等诉求。

诉讼程序启动比较复杂,证据水平要求较高,如案情复杂则案件处理时间也相对较长。但是,生效的法院判决书具有执行力和既判力,权利人可以凭借有利于自己的生效判决,较好的打击侵权人,获得相应的赔偿;而且,取得有利于自己的生效判决也能够为权利人今后的商标维权奠定良好的基础。

刑事调查

对于侵权行为严重,已经达到刑事案件标准的侵权案件,权利人可以向有管辖权的公安机关举报,提供案件线索。公安机关将对案件线索进行调查,对于经查证构成知识产权刑事案件的,公安机关将移交检察机关提起公诉,追究侵权人的刑事责任。

这种途径一般针对极为严重的侵权行为。如侵权行为构成犯罪,侵权人将面临牢狱之刑罚,因此该途径对侵权人的威慑力最大。由于知识产权犯罪调查程序相对比较专业,侵权的认定以及侵权产品的价格认定等都存在一定难度,在刑事案件的启动和推进过程中,商标权利人需要更多的配合公安和检察机关的工作。■

The *PRC Trademark Law* and related laws present trademark rights holders with several ways of protecting their lawful rights and interests. In addition to their own internal protection efforts, rights holders may, depending on the circumstances, enlist the help of the administrative and judicial authorities to protect their trademark rights in the following ways.

Administrative complaints

Pursuant to article 53 of the *PRC Trademark Law*, a trademark registrant or other interested party may request that the Administration for Industry and Commerce (AIC) deal with an infringement of its exclusive right to use its registered trademark. If the AIC determines that infringement has indeed occurred, it will order the infringer immediately to cease the infringement, confiscate and destroy the infringing goods and the tools used to manufacture the infringing goods or create the representations of the registered trademark, and may also impose a fine.

In such a case, the rights holder typically lodges a complaint in respect of the alleged infringement, following which the local AIC conducts an investigation of the infringement, temporarily seizing the infringing articles. If it determines that infringement has indeed taken place, the AIC will impose an administrative punishment, confiscate the infringing products and may impose a corresponding fine. If the rights holder demands that the infringer pay economic damages, the AIC may, at the request of either or both of the parties, attempt mediation. If the infringer is dissatisfied with the decision imposed by the AIC, it may institute an administrative action in a people's court.

In practice, trademark rights holders who are familiar with intellectual property law and practice in the PRC will, in many circumstances, tend to choose this option. It is flexible, inexpensive and quick, and often yields quick results. This option is very effective for cracking down on the manufacture and/or sale of counterfeit products within a defined area.

Recordal, investigation and seizure

A rights holder that has registered its trademark in the PRC may opt to file that trademark, as well as the names of

the persons licensed to use it, with the General Administration of Customs for the record, so as to secure fuller customs protection. If a local customs authority, in examining imported or exported goods passing through customs, discovers a suspected infringing product carrying a trademark that is on file but for which no licence has been granted, it will temporarily seize the goods and promptly notify the trademark rights holder, asking it to confirm the nature of the suspected goods. If the rights holder believes the suspected goods to be infringing goods, the customs authority will detain the goods and conduct an investigation. If, after its investigation, it determines that the suspected goods are infringing goods, it will confiscate and dispose of them, and may impose a corresponding fine on the infringer.

In a major manufacturing and exporting country like the PRC, the recordal of trademarks with customs so as to secure customs protection is especially important. To facilitate the determination by the customs authorities of the nature of the goods, the rights holder may, at the time of recordal, define limits in the recorded particulars of trademark licensees, such as limitations on the duration of use, and the method and port of import or export.

Through customs recordal and investigation or seizure, a trademark rights holder can quickly discover and stop the export of infringing products. This option is particularly applicable to famous international brands that are likely to be counterfeited and exported overseas. It should be noted that, with respect to infringement that involves the use of similar trademarks on similar goods, customs offices currently tend to be rather conservative when it comes to enforcement.

Infringement suits

The two options mentioned above are limited in their application. First, administrative punishments imposed by AICs and customs authorities are not final; if either the punished party or the rights holder is dissatisfied with the decision, it may file for administrative reconsideration with the relevant authority or institute an administrative action in court. Second, AICs and customs authorities do not accept petitions that seek payment of economic damages by the infringer. Accordingly, with respect to serious or

large-scale infringements, rights holders may have evidence preserved and institute a civil infringement suit in the competent people's court, demanding that the infringer halt the infringement or pay damages.

The procedure for commencing a lawsuit is relatively complex, the standards of evidence are more stringent and, if the case is complex, it may take more time. However, an effective court judgment has the advantages of being enforceable and final. A rights holder can, on the basis of an effective judgment in his favour, crack down more effectively on the infringer and obtain corresponding damages. Furthermore, a favourable judgment can also lay a solid foundation for the rights holder's future efforts to safeguard his trademark rights.

Criminal investigation

With respect to infringements that are serious enough to meet the criteria for a criminal case, the rights holder may lodge a report with, and provide leads to, the competent public security authority. The public security authority will investigate the leads and if, through its investigation, it determines that a criminal IP case is constituted, it will transfer the case to the prosecutorial authority for public prosecution.

In general, this option addresses extremely serious instances of infringement. If the infringement does constitute a criminal offence, the infringer faces the prospect of a prison sentence. Accordingly, this option has the greatest deterrent effect on infringers. As the investigation procedure for IP crimes is relatively specialized and there are substantial difficulties in determining that infringement has occurred and the value of infringing products, trademark rights holders need to cooperate closely in the work of the public security authority and the prosecutorial authority in both the instigation and the progress of a criminal case. ■

春雨春是铸成律师事务所的创始合伙人, 知识产权业务负责人

Spring Chang is a co-founder of and partner at Chang Tsi & Partners. Her practice focuses on intellectual property

申会娟是铸成律师事务所律师

Shen Huijuan is an attorney at Chang Tsi & Partners