

# 如何保护未注册商标的知名品牌

## Protecting well-known brands not registered as trademarks



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**国**外知名品牌在中国面临着各式各样的侵权困扰，尽管中国的法律制度以及司法实践已经渐趋完善，知识产权法相关法规也可以对知名品牌提供多角度的法律保护。然而不可否认的是，现实中仍然存在着诸多问题，其中比较突出的难题之一是当国外知名品牌在中国未进行商标注册时能否得到保护以及何种程度的保护。

### 未注册商标保护的局限性

国外知名品牌如已在国内办理了知识产权（包括商标、外观设计、著作权等）注册登记，则其在中国境内诉求行政或司法保护时就会有合法的权利依据。然而，如果国外知名品牌在中国未实施任何申请、使用和注册行为，则其在寻求法律救济时就会面临尴尬境地，难以获得法律的有效保护。这又可分为以下两种情况：国外知名品牌在中国未注册但有知名度，以及国外知名品牌在中国未注册并且也无知名度。

### 未注册但有知名度

这种情况是指，国外知名品牌虽未在中国注册，但在中国境内有一定的知名度。此种情形下，对国外知名品牌提供保护的法律法规源于国际公约。《保护工业产权巴黎公约》第6条规定，对于在某个成员国已经驰名而尚未注册的商标，他人不得在相同或类似商品上进行注册或使用。《与贸易有关的知识产权协议》(TRIPS协议)不但作出了同样的规定，而且还将其延展到服务商标。

中国《商标法》第13条第1款与上述公约的规定基本保持了一致，该条款表述为：“就相同或者类似商品申请注册的商标是复制、摹仿或者翻译他人未在中国注册的驰名商标，容易导致混淆的，不予注册并禁止使用。”

众所周知，商标的功能在于识别和区分商品和服务的来源。同样，对于业经实际使用且已事实上具有识别和区分来源作用的商品或服务标识，尽管未经注册，仍然有必要提供法律保护。请注意，实际使用和事实上已具备一定程度的市场知名度，是未注册商标可获得法律保护的两个关键要件。《商标法》第13条第1款中“驰名商标”以及第31条中“已经使用并有一定影响的商标”均是对这两个法律要件的体现。

需要指出的，对在中国未注册的国外驰名商标，《商标法》所给予的保护是不跨类的，即对于在不相同或者不相类似商品上申请注册他人驰名商标的行为，法律并未明文禁止。

### 未注册且无知名度

另一种情况是，国外知名品牌虽然在外国注册并具有很高的知名度，但在中国既没有使用也没有一定的知名度。问题是，当该品牌在中国被抢注时是否能够获得中国法律的保护？

笔者个人意见，该国外品牌在此种情形下是极难获得保护的。理由在于，包括商标权在内的知识产权权利具有地域性的属性，在国外注册的知名商标在国外所享有的法律保护并不当然及于中国的法域。换言之，其欲获得在中国的法律保



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护，首先要形成中国法律下的商标权或在先权利；而不在中国注册或者使用就不会形成商标权，亦不会形成在先权利，该国外商标权利人从而无从主张中国商标法的保护。

### 申请商标注册的必要性

中国是实行商标注册制度的国家，尽管《商标法》也承认某些情形下通过使用可获得一定的商标权利，但通过注册取得商标权利是根本原则。在中国《商标法》中，对未注册商标保护的主要依据为第13条、第15条和第31条，这三项条文皆是从禁止恶意抢注的角度来保护具有在先使用情形的未注册商标的。《反不正当竞争法》对知名商品特有的商品名称、包装装潢的保护，也是一种对未注册商标或商品标识的保护。但这些规定对权利人的保护范围和程度有限。

国外知名品牌的权利人如尚未在中国注册其商标，为了获得中国法律的保护，除保留好其商标在国外驰名的证据外，现实的做法是尽早就其商品或服务的有关标识提出在中国的注册申请，包括商标、外观设计专利和著作权等。

这一做法实现不了未雨绸缪和事先预防的目的，不能有效惩戒针对未注册知名品牌已发生的侵权行为，例如对于已发生的抢注行为，如果权利人不能提供对方恶意抢注以及己方商标具有一定知名度的证据，要想获得满意的法律保护近乎不可能。但是，这一做法可以起到亡羊补牢的作用，为权利人针对将来可能发生的侵权行为采取法律措施提供有效的权利依据。■

**W**ell known foreign brands face infringement headaches of many kinds in China.

The legal system and judicial practice in the PRC are improving, and intellectual property law can provide some protection for well-known brands. However, many problems still exist, one of the most prominent being the question of to what extent a well-known foreign brand that has not been registered as a trademark in the PRC can obtain protection.

### Unregistered trademarks

If IP registration (including registration of trademarks, designs and copyrights) has been carried out in the PRC for a well-known foreign brand, it will have lawful rights when claiming administrative or judicial protection. However, if no applications for, use or registration of a well-known foreign brand has been made or carried out in the PRC, it will be difficult to secure effective legal protection.

The following two scenarios may arise: trademarks that are not registered but enjoy public recognition, and trademarks that are not registered and do not enjoy public recognition.

### Not registered but recognized

In this scenario, the well-known foreign brand is not registered in the PRC, but nevertheless it enjoys a substantial degree of recognition among the public.

In such circumstances, the legal basis for according protection to well-known foreign brands is to be found in international conventions. Article 6 of the *Paris Convention for the Protection of Industrial Property* provides that if an unregistered trademark has become well-known in a country which is a signatory to the Convention, a third party may not register or use that trademark for or on identical or similar goods. The *Agreement on Trade-Related Aspects of Intellectual Property Rights* (known as TRIPS) contains similar provisions, and also extends them to service marks.

The first paragraph of article 13 of the *PRC Trademark Law* is essentially consistent with the abovementioned conventions, reading: “A trademark which constitutes a reproduction,

imitation or translation, liable to create confusion, of another’s well-known trademark not registered in China and which is the subject of an application for registration for identical or similar goods shall be refused, and its use shall be prohibited.”

The function of a trademark is to identify and distinguish the source of goods and services. Similarly, a trade or service mark that has actually been used and which in reality serves to identify and distinguish the source of particular goods and services needs to be accorded legal protection, even if it has not been registered. Actual use and having a significant degree of public recognition in the market are two key conditions for determining whether an unregistered trademark can be accorded legal protection. Both the terms “well-known trademark” in the first paragraph of article 13, and “trademark which is already in use and which has a certain degree of influence”, in article 31 of the Trademark Law, reflect these two key legal conditions.

It should be noted that the protection afforded to well-known foreign trademarks not registered in the PRC does not cross classes. The law does not expressly prohibit applying for registration of another’s well-known trademark for non-identical or non-similar goods.

### Not registered, not recognized

In the other scenario, the well-known foreign brand is registered and has a high degree of public recognition abroad, but is not used and does not enjoy a substantial degree of public recognition in the PRC. The question is, when another party registers the same brand in the PRC, is the original brand-owner protected under PRC law? Protection is extremely difficult to obtain in such circumstances. Intellectual property rights, including trademark rights, are territorially defined; the legal protection enjoyed by a well-known trademark registered in a foreign country does not automatically extend to the PRC. To obtain legal protection in the PRC, trademark rights or a prior use right must arise under PRC law. If a mark is neither registered nor used in the PRC, trademark rights or prior use rights cannot arise, and

the foreign trademark rights holder will have no ground upon which to claim protection under the *PRC Trademark Law*.

### The need to register a trademark

The PRC implements a trademark registration system. While the Trademark Law acknowledges that under certain circumstances, trademark rights can be obtained through the use of a mark, the securing of trademark rights through registration is the fundamental principle. The main basis for the protection of unregistered trademarks in the Trademark Law can be found in articles 13, 15 and 31. Each of these articles protects unregistered trademarks which can display prior use by prohibiting malicious pirate registration.

The protection offered by the *PRC Anti-Unfair Competition Law* to the name or trade dress peculiar to a well-known product is also a form of protection of unregistered trademarks or trade logos. However, the scope and degree of protection offered by these provisions are limited. If a holder of rights in a well-known foreign brand that has not been registered as a trademark in the PRC wishes to obtain the protection of PRC law, it must file an application in the PRC for registration of the relevant logo for its goods or services as a trademark, design patent or copyright. It should also preserve evidence of its trademark being well known abroad.

Doing this will not effectively punish infringements against an unregistered well-known brand that have already occurred. For example, if a rights holder cannot, with respect to a ‘pirate’ registration that has already taken place, provide evidence that the other party made the registration in bad faith and that its trademark has a substantial degree of public recognition, it will be almost impossible to obtain satisfactory legal protection.

However, proceeding in this manner is better late than never, providing an effective basis for the rights holder to take legal measures against future infringements. ■

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