

Bad Faith Trademark Registration and Counter Actions

恶意商标注册与应对措施

- Practice perspective in China

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Statistics

- Trademark Applications/Registrations in the last 2 years:

Year	Appln.	Registration	Refusal	Opposition	Cancellation	Invalidation
2014	2,285,235	1,375,104	879,421	43,398	30,233	5,129
2015	2,876,048	2,226,411	883,650	59,122	39,786	11,951

Ratio of bad faith applications/registrations?

Use of Mark

- 1) for registered trademark
- 2) in opposition/invalidation actions
- 3) in infringement case
- 4) in non-use cancellation action

Use of Mark

for protection against **non-use cancellation**:

- a) identical mark on designated goods/services
- b) “identical” meaning exactly same with registration
- c) “use” referring to commercial use
- d) evidence

Use of Mark

■ Non-use cancellation

- a) Trademark owner's obligation to submit evidence of use;
- b) "Use" must be in commercial environment

Case: TAMASHI

Possible procedures against a trademark application/registration

- 1. **Opposition** (against a published application);
- 2. **Invalidation** (against a registered trademark for less 5 years);
- 3. **Non-use cancellation** action against a registration for over 3 years.

Opposition/Invalidation

- **Major basis for successful action**
- (1) Prior trademark registration/Application of identical/similar mark in respect of same/similar goods/services
- (2) Prior right
- (3) Prior use

Opposition/Invalidation

- (1) Prior trademark registration/Application
- Article 30. Where a trademark application does not comply with the relevant provisions in this Law or is identical with or similar to a registered trademark used in connection with the same or similar goods, its registration shall be refused by the Trademark Office after examination and the mark shall not be published.

Opposition/Invalidation

- Major basis for successful action
- (1) Prior trademark registration/Application of identical/similar mark in respect of same or similar goods/services, against
 - a) published/registered marks caused by examiner's neglect,
 - b) different view/criteria of "identical/similar" marks and/or same/similar goods/services;
- Case: "RUBBERMAID"

Opposition/Invalidation

- (2) Prior right
- **Article 32.** No trademark application shall violate another party's existing prior rights, nor shall an applicant rush to register in an unfair manner another party's mark already in use with a certain influence.

Opposition/Invalidation

■ (2) Prior right:

- a) only copyright, design or other right can be accepted as “prior right”
- b) No trademark right is considered in this rule

Case: *Souris Mini*

(Article 32, part 1)

Opposition/Invalidation

■ (3) Prior use

- a) mark: identical or similar
- b) goods: same or similar, or closely related
- c) evidence

Key Point: "use" must be earlier than the filing date of the mark to be opposed/invalidated.

(Article 32, part 2)

Opposition/Invalidation

■ (3) Prior use



Case: “**HAMA**” (Opposition/Review)

■ (Article 32, part 2)

Use of Mark

3) in **infringement case**

a) mark: identical or similar

b) goods/services: same, similar or closely related

c) evidence:

d) ways of enforcement: Administrative and/or lawsuit

f) damages: 3 means to calculate damages

Article 15, Opposition/Invalidation/Infringement action

- Article 15. Where an agent or representative, without the authorization of the principal, seeks to register in the agent's name the principal's trademark and where the principal objects, registration shall be refused and the use of the mark shall be prohibited. Where a trademark used on an identical or similar product that is considered for registration and that is the same or similar to a prior user of an unregistered trademark, the registrant, where no prior contractual agreement or business relationship exists between the registrant and prior user, may not register its trademark where the prior user's mark is clearly in use and an opposition to the trademark's registration has been filed.

Article 15

Case: RUHOF v 鲁沃夫

Actions against infringement

- Customs Recordal (one of the pre-action measures for stopping unauthorized import/export)
- AIC action
- Lawsuit

Case Study - “新百伦” vs “New Balance”

第 25 类

第 4100879 号

申请日期 2004 年 6 月 4 日

商 标

新百伦

使用商品 鞋(脚上的穿着物); 靴; 拖鞋; T恤衫; 服装; 皮衣; 袜; 领带; 皮带(服饰用); 运动衫

申 请 人 周乐伦

地 址 广东省广州市珠江新城临江大道海滨花园
厚德轩7楼C座

Case Study - “新百伦” vs “New Balance”

Class 25

Mark: 百伦

Filing Date: Aug. 25, 1994

Registration Date: Aug. 21, 1996

Reg. No. 865609

Registrant: 潮阳市工商经济发展总公司鞋帽公司

Assigned to 周乐衡 and published on June 28, 1998

Assigned to 周乐伦 and published on Apr. 21, 2004

(several marks were assigned simultaneously)

Among 77 trademark registrations/application owned by 周乐伦, 2 were opposed.

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- **Thank You**

Jinshan Liu

Aug. 6, 2016