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Remedies for Trademark Squatting

Trademarks are relatively inexpensive to register but have the potential to deliver significant economic value and may even reward holders with 'overnight fame'. A trademark can be registered or unregistered, though companies will usually opt to register their trademark to ensure legal protection. The effectiveness of a registered trademark is territorial and is generally only effective within the jurisdiction (such as the mainland of China) in which it is registered. Registered trademarks should receive protection from public authorities who prevent unauthorized use. Pervasive phenomena such as trademark squatting, malicious registration of a large number of trademarks or malicious registration of trademarks similar to famous brands are risks that enterprises all need to be conscious of. But what can prior right holders encountering trademark squatting do to get the best possible protection of their own interests? This article will briefly introduce definitions and forms of trademark squatting, as well as remedies and strategies against it.

I. Definition of trademark squatting

"Trademark squatting", as a legal term only appears in Article 32 of "Trademark law" and is not expressly defined. According to conventional understanding, it can be defined in a narrow or broad sense. In the narrow sense, "trademark squatting" refers to the registration of a trademark which is in use but has not yet had a trademark registration application submitted; "trademark squatting" in a broader sense includes not only the registration of an unregistered trademark already in use, but also the registration of trade names, names, domain names, portraits, works etc. as a trademark. These also fall under the "Trademark law" and other relevant regulations.

In summary, "trademark squatting" in its broader sense

refers to the registration as a trademark an 'object' of the rights enjoyed by others (the prior right holder) -- the object here includes not only the trademark right (including the registered or unregistered trademark), but also the right of name, trade name, domain name, portrait, copyright, etc.

II. Common forms of trademark squatting

Based on the above generalized definition and a summary of common cases, the forms of trademarks squatting can manifest as follows:



- a) The registration of an unregistered trademark used by others, e.g. the word mark "陆虎" (a transcription


of Land Rover) registered by Geely Group (all trademarks referred to in this article are registered with the Trademark Office of China National Intellectual Property Administration [hereinafter referred to as the "Trademark Office"]);

b) The registration of an already registered trademark in a different category, e.g. the trademark „无印良品“ (the Chinese translation of „Muji“) registered in category 24 (textiles, bedding, etc.) is held by Beijing Cotton Field Textile Co., Ltd.;

c) The registration of another's trade names, abbreviations or commonly used translated names as a trademark, e.g. “广本” (Guangben) (refers to "Guangqi Bientian" or "Guangqi Honda");

d) The registration of another's name (including aliases, pen names, stage names, nicknames, or translated names that can establish a corresponding relationship with a specific person) as a trademark, such as "Papijiang", "Yang Chaoyue", "TRUMP", "Biden" and other trademarks that have been widely registered;

e) The registration of another's portrait (including a silhouette with identifiable characteristics of a specific person) as a trademark. Cases include a dispute between Bruce Lee's daughter and Shengkung Fu Restaurant over the " " trademark; and a dispute between NBA basketball player Michael Jordan and the China-registered Jordan Sports Co., Ltd. involving the " " trademark (now renamed).

f) The registration of the works of others that are protected under "copyright law" as a trademark, e.g. the " " trademark containing an animated image of the Monkey King.

g) The registration of another's domain name as a trademark.

h) The registration of another's product design as a trademark.

In practice, the first three forms mentioned above are the most common. Once an entity's trademark or trade name has been successfully squatted by others, it may face the following difficulties:

(a) Their own trademark registration application being rejected, i.e. the squatted trademark ("disputed trademark") may become an obstacle for the prior right holder to the registration of the same or similar trademarks for the same or similar goods/services. For example, due to the existence of the aforementioned trademark

"无印良品" (in simplified Chinese) registered under category 24 by Beijing Cotton Field Textiles Co., the Trademark Office rejected the application for the registration of the trademark "無印良品" (in traditional Chinese) under category 24, filed later by Ryohin Keikaku Co., Ltd.;

(b) The use of their own trademarks being restricted to the extent that they may even have to change their trademarks or trade names in China;

(c) Confusion in public perception thus diluting the brand recognition of the prior right holder;

(d) Reputation damage as a result of individuals or companies offering inferior quality products or services with an association to the prior right holder's trademark.

III. Remedies

Remedies for the prior right holder in respect to trademark squatting are mainly 'administrative' and 'judicial'. If the use of "disputed trademarks" infringes the prior right, the prior right holder may file a civil lawsuit requesting cessation of infringement and also compensation for damages. In such cases, "disputed trademark" cannot be used by those who squat the trademark according to a judgment in favor of the prior right holder. However, it is hard in civil litigation for the prior right holder to act alone. Obtaining sufficient evidence that proves infringement is a significant challenge. Applying to the Trademark Office for legal procedures and seeking remedies from public authorities is an indispensable remedy, to which the prior right holder should give priority.

For the prior right holder, applicable administrative remedies mainly include opposition, invalidation and cancellation procedures for the "disputed trademark", that is, requesting that the "Trademark Office" makes a decision to reject the application of registration, to cancel the "disputed trademark" or to declare it invalid. As for which administrative remedy to take, firstly, legal status of the "disputed trademark" should be taken into account. Secondly, it should be reviewed in consideration of previous cases.

A brief description of trademarks' different legal statuses, corresponding applicable administrative remedies and the differences between the various administrative remedies is set out below:

Legal Status		Remedies	Remarks / Suggestions
Under substantive examination		—	<ul style="list-style-type: none"> ■ The statutory period for examination of a trademark is 9 months, during which the prior right holders should monitor the status of a “disputed trademark” (of course, the best solution is early and proactive protection of their trademarks). ■ In cases of refusal of the “disputed trademark”, the prior right holders needn’t take any administrative measures. ■ Conversely, if the “disputed trademark” is preliminarily approved for registration, the prior right holder may consider initiating trademark opposition procedures within a three-month period of public notice (as follows).
Within the period of public notice for preliminary examination		➢ Filing an opposition	<ul style="list-style-type: none"> ■ A trademark that has been examined and preliminarily approved for registration will be subject to a three-month period of public notice, during which the prior right holder may file an opposition according to Article 33 of the Trademark Law. ■ Once opposition procedures have commenced, public notice of preliminary examination of the “disputed trademark” will be invalid, i.e. the trademark will be in the status of non-entitlement. ■ The legal status of a “disputed trademark” (whether or not it is approved for registration) will not be determined until the end of opposition procedures, during which the squatting registrant of “disputed trademark” cannot use the trademark as a registered trademark and not enjoy the rights of registered trademarks under the Trademark Law.
Approved for registration	Less than 3 years from the date of registration	➢ Application for the invalidation of a registered trademark	<ul style="list-style-type: none"> ■ Provided that the aforementioned period for opposition has expired, the registration of the “disputed trademark” will be approved and the Trademark Registration Certificate will be issued. ■ If it is within 3 years of the trademark’s registration, the prior right holder may only apply for the invalidation procedures based on article 44 of the “Trademark Law”. ■ The grounds for invalidity are essentially the same as those mentioned above for opposition, including absolute and relative grounds. ■ In contrast to opposition, the absolute grounds for invalidation also include “the registration is obtained by fraudulent means or other improper means”. In practice, if the registrant squats a large number of trademarks maliciously, it will likely be considered as “obtaining the registration by improper means”. In our experience, invalidation of the “disputed trademark” on these grounds is more likely to succeed. ■ The fees for invalidation procedures (RMB 750 Yuan for one trademark under one category) are marginally higher than that for the opposition procedures (RMB 500 Yuan for one trademark under one category); ■ However, different from the abovementioned opposition procedures, the “disputed trademark” will remain valid until an effective ruling on the invalidation is made (including the administrative invalidation in respect of the invalidation ruling [first instance, second instance and retrial]); <p>Therefore, we recommend that if trademark squatting is discovered during the public notice period, the opposition procedure should be initiated as soon as possible to prevent the “disputed trademark” being approved for registration.</p>

Approved for registration	More than 3 years, but less than 5 years	<ul style="list-style-type: none"> ➤ Application for invalidation and/or ➤ Application for revocation on the grounds that the registered trademark has not been used for three years consecutively without proper reason. 	<ul style="list-style-type: none"> ■ If three years have lapsed since the date of registration of the “disputed trademark”, in addition to the abovementioned invalidation procedure, the prior rights holder may also initiate a cancellation procedure due to non-use for three years. ■ For a cancellation due to non-use, it is important to confirm whether the “disputed trademark” has been put into use. Therefore, it is best to inquire through public channels before applying for a cancellation procedure. If it is found after inquiry that the “disputed trademark” has been put into use by the squatting registrant (pay attention to the definition of “use”), there is no need to start the cancellation procedure; ■ The advantage of cancellation due to non-use for three years over the invalidation procedure is that the burden of proof is on the squatting registrant, i.e. so long as the squatting registrant cannot provide evidence that the trademark has been put the mark into use, the trademark will be revoked. The burden of proof on the prior right holder is somewhat reduced. ■ The fees for cancellation due to non-use for three years (500 yuan for one trademark under one category) are also marginally lower than that for the invalidation procedure; ■ However, the legal consequences of “invalidation” and “cancellation due to non-use for three years” are different. The invalidation of a trademark “ means that it is invalid <i>ex tunc</i>, while cancellation means that it is invalid <i>ex nunc</i>, i.e. in respect of the infringement involving the registered trademark before the revocation of the trademark, the squatting registrant still has the right to bring an infringement lawsuit. However, “the trademark has not been used” may be a defense against the assumption of compensation. <p>Of course, prior right holders may consider the simultaneous initiation of invalidation and cancellation procedures if their budget permits.</p>
	More than 5 years	<ul style="list-style-type: none"> ➤ Application for cancellation due to non-use for three years ➤ Application for invalidation (<i>applicable only to well-known trademark protection, or in the case of absolute grounds of invalidation</i>) 	<p>The invalidation of a trademark must be applied within 5 years, i.e. if it has been five years since the approval of registration for the “disputed trademark”, the prior right holder may only consider initiating the cancellation procedure due to non-use for three years, unless the aforesaid absolute grounds of invalidation exist or the trademark used by the prior right holder has reached the standard of well-known trademark (in practice, it is hard to be recognized as a well-known trademark due to the relatively high requirements).</p>
The trademark has been rejected/invalid/revoked / cancelled		No measures required	—

Attention: None of the aforesaid periods (the three-month period of public notice and the five-year invalidation period) are subject to suspension or interruption, nor is there any period of grace. In other words, if the above-mentioned periods are missed, the prior rights holder will lose the right to file an opposition or invalidation of the trademark.

IV. Conclusion

Both administrative and judicial remedies are *ex post facto*, for which the prior right holder will inevitably pay more time and costs. In the case of the "Qiaodan trademark", the prior right holder, Michael Jordan, required nearly eight years to obtain the support of the Supreme People's Court of China for his claim against the squatting of his trademark by a domestic enterprise after a cancellation application, first and second instance administrative litigation, and retrial, highlighting the progress of intellectual property protection in China and also reminding enterprises of the importance of plan for trademark registration and compliance. We advise enterprises, especially foreign enterprises intending to enter the Chinese market, to formulate their own protection strategies for trademark and other intellectual properties in a timely manner, to register and maintain their (proposed) used trademarks under the necessary categories and items as early as possible, and to monitor the status of trademarks on a regular basis on their own or through professional agents so as to detect and thus avoid their trademarks being squatted. Proactive trademark protection is the best way to avoid restrictions to their business, incurring economic losses, damage to goodwill and huge costs defending their right to a trademark.



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商标被抢注的救济途径


商标的注册和维护成本较低，而潜在的经济价值却可能很可观甚至“一夜成名”。商标有未注册商标与注册商标之分；为获得充分保护的目的，其使用人通常会选择将商标注册。注册商标的权利效力具有地域性，一般情况下仅在向特定法域（例如中国内地）内主管商标当局办妥注册登记后方在本法域内生效，获得公权力保护，从而排除他人的未经授权使用。长期以来，商标抢注以及商标“囤积”、“傍名牌”等现象层出不穷。而面对抢注行为，在先权利人应当如何应对才能最大程度地保护自身利益呢？本文将从商标抢注的含义、表现形式、救济途径和策略建议几个方面进行简要介绍。


一、“商标抢注”的含义


“抢先注册”作为法律术语仅在《商标法》第32条^[1]中出现过，且法律并未对“抢先注册”或“抢注”作出明确的定义。按照对“抢注”一词的惯常理解，其概念有狭义和广义之分。其中狭义的“抢注”是指将他人使用但并未申请注册的商标抢先注册为商标的行为；而广义的“抢注”不仅包括将他人未注册商标注册为商标的行为，还包括将他人字号、姓名、域名、肖像、作品等注册为商标的行为，认定其不正当性的依据亦来源于《商标法》和其他相关法律规定。概况来说，所谓“商标抢注”是指将他人（在先权利人）依法享有的权利客体注册为商标的行为——此处的权利客体不仅包括商标权（包括注册或未注册商标），还包括姓名权、字号权、域名权、肖像权、著作权等。

二、商标抢注的常见表现形式

基于上述广义概念，根据对常见情形的总结，商标抢注的表现形式大致有以下几种：

1. 将他人在先使用但未注册的商标申请注册为商标，例如：吉利集团申请注册的“陆虎”商标（指在中国国家知识产权局商标局（“商标局”）注册的商标；下同）；
2. 将他人已注册的商标，在不同类别上申请注册为商标，例如：北京棉田纺织品有限公司在第24类（纺织品、床上用品等等）注册并依然持有的“无印良品”商标；
3. 将他人字号、简称、惯用译名申请注册为商标，例如：“广本”商标（对应“广汽本田”）；
4. 将他人姓名（包括别名、笔名、艺名、雅号、绰号、能够与特定的自然人建立起对应关系的译名）申请注册为商标，例如：被大量注册的“Papi酱”、“杨超越”、“TRUMP”、“拜登”等商标；
5. 将他人肖像（包括含有可识别特定自然人个性特征的剪影）注册为商标。具体案例有李小龙之女与真功夫餐饮涉及“ ”商标的纠纷，以及美国NBA篮球运动员迈克尔·乔丹与注册于中国的乔丹体

育股份有限公司（现已更名为“中乔体育股份有限公司”）就“ ”商标的争议案件；

6. 将他人受著作权法保护的作品注册为商标，例如，包含动画形象孙悟空的“ ”商标；
7. 将他人域名注册为商标；
8. 将他人产品外观设计注册为商标。

实践中，以上述前三种情形最为常见和普遍。而对于企业来说，一旦商标或字号被他人成功抢注，则可能会面临如下困境：

1. 自身商标注册申请无法获得核准，即他人抢先注册的商标（“诉争商标”）的存在可能成为阻碍在先权利人就相同或近似商标在相同或类似商品/服务上进行商标注册的障碍。例如，因前述北京棉田纺织品有限公司抢先在第24类注册的“无印良品”商标的存在，导致日本株式会社良品计画在后提交的“無印良品”商标在第24类的注册申请因其与“无印良品”商标构成近似而被商标局驳回；
2. 自身商标使用受到限制，甚至不得不变更在中国的商标或字号；
3. 容易造成公众认知混淆，从而弱化在先权利人的品牌识别度；
4. 通常抢注人都是个人或者规模较小的企业公司，其产品或服务无法得到保障，进而可能会影响在先权利人的商誉。

三、救济途径

针对他人抢注商标的行为，在先权利人可以寻求的救济手段，主要包括行政救济和司法救济。如果抢注人使用诉争商标的行为侵犯了在先权利，在先权利人可以考虑直接提起民事诉讼，在请求停止侵权行为的同时，还可以请求损害赔偿。此种情况下，一旦拿到生效的胜诉判决，抢注人即无法再使用诉争商标。但是，在民事诉讼过程中，单凭在先权利人（“被侵权人”）一己之力，特别是在取证证明侵权行为的构成方面有所不易，而向商标局申请启动法定程序，寻求公权力的救济，就成为不可或缺乃至当事人应当优先考虑的救济途径。

对于在先权利人而言，适用的行政救济途径主要包括针对诉争商标的异议、无效和撤销程序，即请求商标局就诉争商标作出不予核准注册、予以撤销或宣告无效的决定。至于采取何种行政措施，一是需要考虑诉争商标的法律状态，二是需要结合具体的案件进行分析。

就不同法律状态下的商标，可采取的行政救济，以及各个行政措施之间的区别，简介如下：

法律状态		救济途径	评述 / 建议
实质审查中		—	<ul style="list-style-type: none"> ■ 商标的法定审查期限为9个月，在先权利人应随时关注诉争商标的动态（当然，最根本的解决之道还是及早主动保护自己的商标）； ■ 如果经审查，诉争商标被驳回，则在先权利人无需采取任何行政措施； ■ 相反，如果诉争商标被初步核准注册，则在先权利人可考虑在3个月的公告期内启动商标异议程序（具体如下）。
初审公告期内		<ul style="list-style-type: none"> ➢ 商标异议申请 	<ul style="list-style-type: none"> ■ 商标经审查被初步核准注册的，将进入<u>3个月</u>的初审公告期，在此期间，在先权利人可以依据《商标法》第33条提出异议； ■ 一旦进入异议程序，诉争商标的初审公告将无效，即商标处于无权状态； ■ 诉争商标的法律状态（核准注册或不予核准注册），将直至异议程序结束才能确定，在此之前商标抢注人不能将诉争商标作为注册商标使用，也不享有《商标法》下的与注册商标相关的权利。
已核准注册， 且自注册之日起	不满3年	<ul style="list-style-type: none"> ➢ 商标无效申请 	<ul style="list-style-type: none"> ■ 如果错过了上述提出异议的期限，诉争商标将被核准注册，并获得商标注册证书； ■ 就已核准注册的商标，且自核准注册之日起不满3年的，在先权利人只能基于《商标法》第44条启动无效程序； ■ 无效的理由与前述异议的理由基本一致，包括绝对事由[2]和相对事由[3]； ■ 与异议相比，无效的绝对事由还包括“以欺骗手段或者其他不正当手段取得注册的”。实践中，如果抢注人存在大量抢注、囤积商标的行为，则很大可能会被认为“以不正当手段取得注册”。另，根据我们的经验，以此理由成功无效诉争商标的概率更高； ■ 无效程序的官费（一标一类750元）略高于异议程序（一标一类500元）； ■ 但是，与上述异议程序不同，无效程序过程中，诉争商标将一直处于有效状态，直至作出生效的商标注册无效裁定（包括无效行政程序，和针对无效裁定的行政诉讼（一审、二审、再审））； ■ 因此，我们建议，如果是在公告期内发现商标抢注，应尽早启动异议程序，以阻止诉争商标进入核准注册状态。
	已满3年，但 未滿5年	<ul style="list-style-type: none"> ➢ 商标无效申请；和/或 ➢ 商标“撤三”[4]申请 	<ul style="list-style-type: none"> ■ 如果诉争商标自核准注册之日起已满3年，除了上述的无效程序外，在先权利人还可以选择启动“撤三”程序； ■ “撤三”的关键在于诉争商标有没有被投入使用，因此，在启动“撤三”程序前，最好先通过公开途径进行查询。如果经查询，发现诉争商标已被抢注人投入使用（须注意“使用”的定义），则没有必要再启动程序； ■ 与无效程序相比，“撤三”的好处在于：举证责任在于抢注人，即只要抢注人不能提供证据证明其已经将商标投入使用，则商标就会被撤销。如此一来，可以在一定程度上减轻权利人的举证义务；

		<ul style="list-style-type: none"> ■ 从官费上来讲，“撤三”的官费（一标一类500元）也略低于无效程序； ■ 但是，“无效”和“撤三”的法律后果不同：商标被“无效”则意味着自始至终无效，而“撤三”则是从撤销之日起无效。也就是说，从理论上讲，针对商标被撤销之前的涉及已注册商标的侵权行为，抢注人仍有权提起侵权诉讼，不过“商标未被投入使用”可以作为不承担赔偿的抗辩事由； ■ 当然，在先权利人在预算允许的情况下也可以考虑同时启动无效和“撤三”程序。
	已满5年 <ul style="list-style-type: none"> ➢ 商标“撤三”申请 ➢ 商标无效申请（只适用于驰名商标保护，或存在绝对无效事由的情形） 	<ul style="list-style-type: none"> ■ 提起无效的期限限制是5年，即若诉争商标自核准注册已满5年，则在先权利人只能考虑启动“撤三”程序，除非存在前述的绝对无效事由，或在先权利人在先使用的商标已达到了驰名商标的程度（实践中，驰名商标的认定条件相对很高，成功的概率较低）。
已被驳回/无效/撤销/注销	无需采取措施	—

值得注意的是，上述期限（3个月的公告期；5年的无效期）均不适用中止、中断，也没有任何的宽限期。换句话说，上述的期限一旦错过，在先权利人将丧失提起商标异议或商标无效的权利。

四、结语

无论是行政救济途径还是司法救济途径，均为事后救济，在先权利人需要付出的时间和经济成本较高。“乔丹”商标一案，在先权利人迈克尔·乔丹历时近八年，历经撤销申请、行政诉讼一审和二审、以及再审，其针对被境内企业抢注商标的诉请终于获得中国最高人民法院支持，彰显了我国知识产权保护的进步，也提醒了企业，事先进行商标布局、预防诉争是何等的重要。我们建议企业，特别是尚未进入但有意开拓中国市场的境外企业，及时制定自己的在华商标和其他知识产权保护战略，及早将自己（拟将）使用的商标在必要的类别、项目下注册并维持使用，同时定期自行或者委托专业代理进行商标监测，以便及早发现侵权行为并采取举措，从而避免商标被人抢注，令自己的市场业务受限，给自己造成经济、商誉损失和维权的巨大成本支出。

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- [1] 《商标法》第32条：申请商标注册不得损害他人现有的在先权利，也不得以不正当手段抢注他人已经使用并有一定影响的商标。
- [2] 绝对事由主要包括：不以使用为目的的恶意注册、有损公共利益、以及商标缺乏显著性。
- [3] 相对理由主要包括：与他人在相同或类似商品/服务上在先注册的商标相同或相近似、以及损害他人在先权利。
- [4] 《商标法》第49条：……没有正当理由连续三年不使用的，任何单位或者个人可以向商标局申请撤销该注册商标……