



恶意商标注册：欧洲的解决方式

Bad faith trademark applications: European Approach

艾玲 (Livia), MLL 商务律师事务所 – MLL Attorneys at Law

苏黎世 - 日内瓦 - 楚格 洛桑 - 布鲁塞尔



目录 – Agenda

1. 法律框架 – Legal Landscape
2. 恶意的定义和构成要件 – Definition and Requirements of “Bad Faith”
 - 广义概念的“恶意” – General Concept
 - 代理人抢注商标的特殊情形 – Agent’s Trademark
3. 证据和策略 – Evidence and strategic Approach
4. 法律后果 – Legal Consequences
5. 核心总结 – Take home

法律框架 – Legal Landscape

- 国内商标 – National Trademark
- 欧盟商标 – Union Trademark
 - 欧盟知识产权局
(European Office of Intellectual
Property, „EUIPO”)

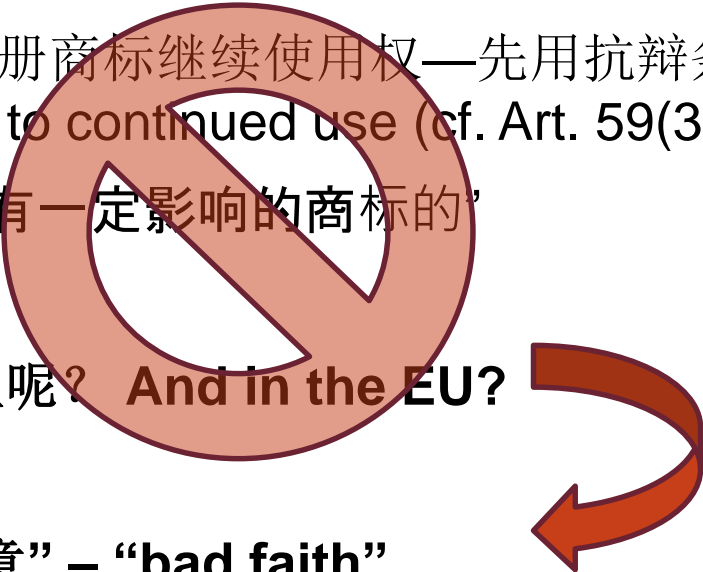


法律框架 – Legal Landscape

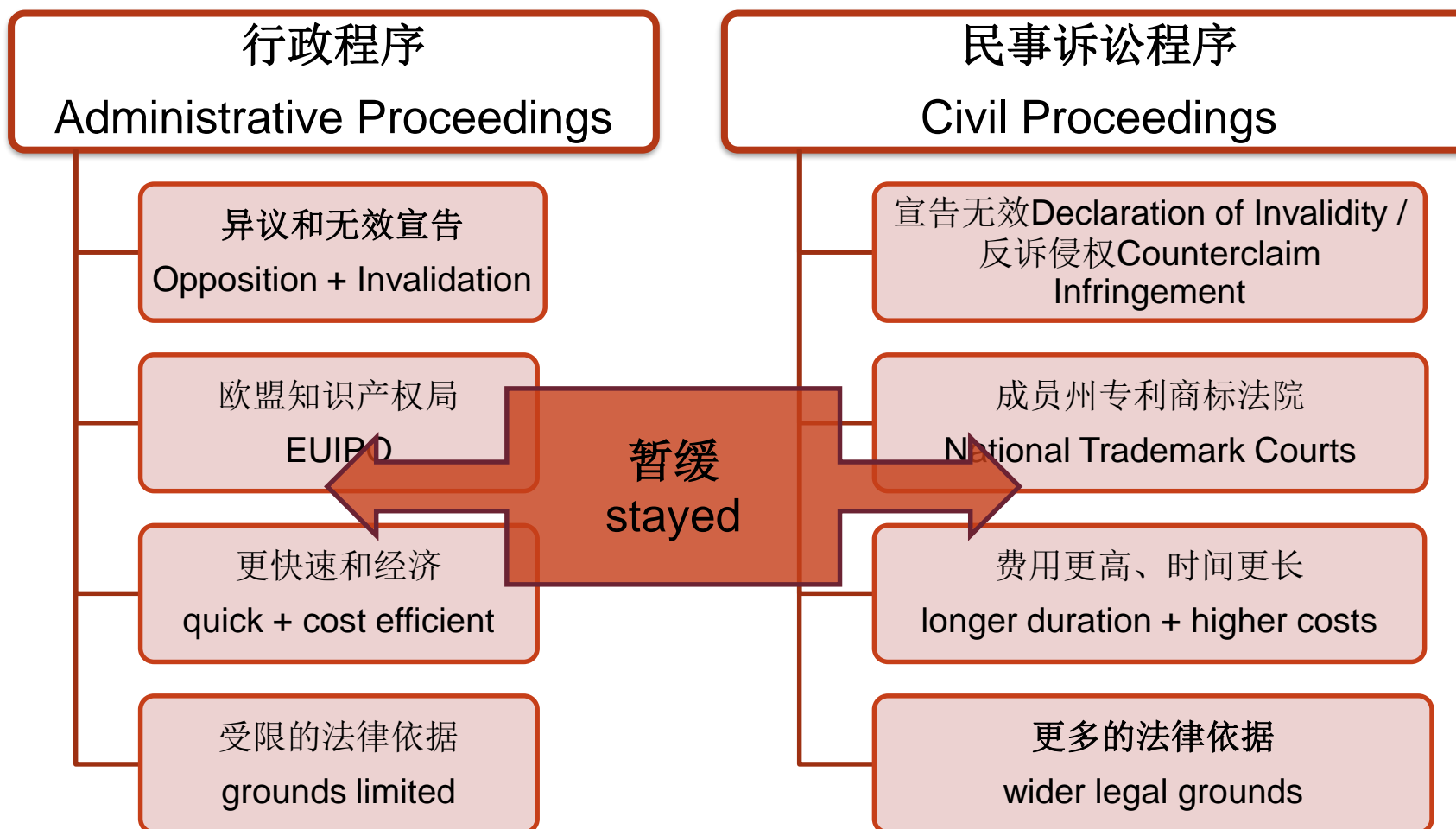
- 2017年的欧盟联合商标法 – EU Trademark Regulation 2017/1001
- 2018年的欧盟商标相关条例 – Delegated Regulation 2018/625
- 2018年的实施细则 - Implementing Regulation 2018/626
- 2018 欧盟知识产权局公布的欧盟商标审查准则 – EUIPO Guidelines for Examination
- 当地法律 – national laws

法律框架 – Legal Landscape

- 先申请原则 – “first-to-file”
- 纠正措施 – corrective measures:
 1. 未注册商标继续使用权—先用抗辩条款（《中国商标法》第59条第3款）
right to continued use (cf. Art. 59(3) CTML);
→ “有一定影响的商标的”

欧盟呢？ And in the EU?

 2. “恶意” – “bad faith”

法律框架 – Legal Landscape



恶意的定义和构成要件 – Definition and Requirements of “Bad Faith”

广义的“恶意 – bad faith

代理人抢注
商标的
特殊情形 -
„Agent’s
Trademark“

广义概念的“恶意” – General Concept

- 行政撤销程序或者民事诉讼程序中 - administrative cancellation proceedings or civil proceedings

“any and all conduct which departs from the accepted principles of ethical behavior or honest commercial and business practices”

→ 总体评定 – overall assessment

- 考虑因素 – factors?

→ Case ECJ C-529/07: **“Gold Bunny”** (金兔子)

(Court of Justice of the European Union, 2009 年06月11日)

Chocoladefabriken Lindt & Sprüngli AG (CH) v Franz Hauswirth GmbH (Austria)





广义概念的“恶意” – General Concept

1. 知晓其在先使用情况 – knowledge of use

→ 不可能不知道---明知或应知

→ trademark owner could **NOT** have been **UN**aware

广义概念的“恶意” – General Concept

2. 并非基于诚信目的 – dishonest intention



广义概念的“恶意” – General Concept

1. 知晓其在先使用 – knowledge of use
2. 并非基于诚信目的 – dishonest intention
3. 双方商标受到法律保护的程度 – degree of legal protection of both signs



广义概念的“恶意” – General Concept

■ “NEYMAR”?



1. 知晓其在先使用 – knowledge of use
2. 并非基于诚信目的 – dishonest intention
3. 双方商标受到法律保护的程度 – degree of legal protection of both signs

- „我喜欢这个词的发音“ – „I just liked the sound“
- 网络报道证实 – 恶意 net and newspaper articles
- IKER CASILLAS



代理人抢注商标的特殊情形 – Agent's Trademark

- ≈ 中国《商标法》第15条 (Art. 15 CTML)
- 异议和无效宣告 – opposition + invalidation
- 诚信义务 – loyalty obligation
- 无效宣告：
Invalidation:  转让该商标
direct assignment

证据和策略 – Evidence and strategic Approach

- 举证任务 – burden of proof
 1. 善意
 2. 初步证据 “有恶意” – **prima facie evidence** of bad faith
 3. 反驳: “没有恶意” – **rebuttal** that there is no bad faith

- 邮件 – emails ✓

法律后果 – Legal Consequences

- 完全的商标无效 – cancelled in full
- 金钱的后果 – **financial consequences**
 - 代理人的服务 – agent's costs
 - 支付费用 – advance of costs
 - 输了的一方需要支付 – “**loser pays**”
 - 行政程序由 – administrative proceedings (approx. ¥15'000 – 50'000)
 - 民事诉讼 – civil proceedings (> ¥50'000)
 - 刑责：罚金 – criminal liability: fine
 - 损害赔偿 – damages

法律后果 – Legal Consequences

- 执行 – Enforcement

- 在所有成员国的快速执行 – quick enforcement in all Member States

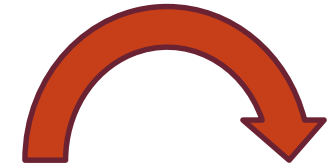


- 针对公司和公司的代表或负责人 against companies and companies' representatives



核心总结 – Take home

- 暂缓 – stay of proceedings
- (商标注册的代理人) 转让该商标 – direct assignment
- 败诉方需要支付 – „loser pays” principle
 - 行政程序和民事诉讼程序
 - administrative and civil proceedings
- 个人责任 – personal liability of involved individuals



问题? Questions?



Practice Areas

- Trademarks, Design & Advertising
- Patents and Life Sciences
- Know-how and NDAs
- General Contract Law

Languages

德文, 英文, 法文, 中文

livia.anderstatt@mll-legal.com

电话: +41 44 396 91 91

Practice Areas

- Trademarks, Design & Advertising
- Patents and Life Sciences
- Know-how and NDAs
- General Contract Law

Languages

German, English, French, Mandarin

livia.anderstatt@mll-legal.com

Phone: +41 44 396 91 91

