

君合专题研究报告



2018年4月28日

商标争议中的在先著作权

——“羅斯蒙特 LSMT 及图”商标争议案¹简评

一、案情

青岛得凯轮胎有限公司是第 3691497 号“羅斯蒙特 LSMT 及图”商标（简称“**诉争商标**”）的注册人，该商标的申请日为 2003 年 8 月 27 日，核定使用商品为第 12 类的汽车内胎、车辆轮胎等，专用期限至 2025 年 8 月 13 日。2013 年 3 月 1 日，彪马欧洲公司向商标评审委员会（简称“**商评委**”）提出商标争议申请；商评委裁定予以维持。彪马欧洲公司不服裁定提起诉讼；北京市第一中级人民法院判决驳回诉讼请求。彪马欧洲公司提起上诉；北京市高级人民法院认定，诉争商标侵犯彪马欧洲公司的在先著作权，判决撤销原审判决、撤销商标评审委员会裁定并判令其重做裁决。（下附商标标志图样对比）

二、判决要旨

在诉争商标申请日后取得的商标标志著作权登记证书、获得著作权合同及在中国境内外的在先商标注册证等，可以作为在先商标权人享有该商标标志著作权的初步证据。

三、判决理由

北京市高级人民法院认为：彪马欧洲公司主张依据经公证的著作权合同及补充协议、著作权登记证书及在中国境内外的商标注册证认定其享有“跳跃中的美洲豹”美术作品的在先著作权。著作权登记证书虽在诉争商标申请日之后取得登记，但结合经公证的著作权合同及补充协议，以及彪马欧洲公司在诉争商标申请日前在中国境内外的商标注册证，可以初步证明彪马欧洲公司对“跳跃中的美洲豹”图形享有在先著作权。诉争商标标志中的动物图形与彪马欧洲公司享有在先著作权的“跳跃中的美洲豹”图形在造型特征、视觉效果上基本相同，构成实质性相似，故诉争商标的注册损害了彪马欧洲公司的在先著作权。

四、评析

2013 年《商标法》三十二条一款（2001 年《商标法》三十一条一款）规定，申请商标注册不得损



1. (2017)京行终 785 号彪马欧洲公司诉商标评审委员会、青岛得凯轮胎有限公司关于第 3691497 号“羅斯蒙特 LSMT 及图”商标争议案。

害他人现有的在先权利。根据最高人民法院司法解释、北京市高级人民法院审理指南及相关法律实践，此类可以对抗他人商标的其他在先权利包括在先姓名权、肖像权、著作权、企业名称权、外观设计专利权等。对于包含一定独创性图形要素或设计要素的商标而言，商标注册人可以基于该条款，以在先著作权为权利基础，对在后各个类别上申请或注册的实质性近似商标提出异议或无效，一方面可切实保护享有在先著作权的商标标志，另一方面也可同时实现此类商标在全部商品和服务类别均获得保护的目。有一种观点认为，跨类保护仅是对于驰名商标的保护内容，对于著作权作为在先权保护的，应当予以严格限制。然而，在所有商品和服务领域保护具有独创性从而构成作品的商标标志本身是在先著作财产权的内在要求，应在著作权与商标权产生权利冲突的情况下充分考察并保护在先著作权而不应予以限制。

根据中国及各国商标法的一般规定，在先商标注册人或申请人有权禁止他人在相同或类似商品或服务上申请注册相同或近似商标，以防止造成混淆和误认。此类保护一般的前提条件包括：1) 商标相同或近似，2) 商品或服务相同或类似。在中国商标申请审查、异议及复审、驳回复审以及商标无效等程序中，商标审查员和法官首先审查上述两项前提条件，进而做出是否存在混淆可能从而核准注册、驳回申请或宣告商标无效的结论。

对商标是否近似可基于《商标审查与审理标准》和相关司法解释和规定确立的原则，通过对在后商标和在先商标的对比观察而实现；对商品和服务的类似则一般以《商品和服务区分表》为依据。对于在后在非类似商品和服务上申请注册的商标，倘若不存在规模性抢注从而适用《商标法》四十四条“欺骗或不正当手段”予以制止的情形，则一般只能寻求《商标法》十三条关于驰名商标保护的条款，在

案件中则需要提交大量在先使用及知名度证据请求认定商标构成驰名。然而，商标主管机关长期以来对驰名商标的认定十分严格，一方面有效抑制了因追逐“驰名商标”名号而带来的异化现象，另一方面也不可避免因认定严格而造成在先较高知名度商标在非类似商品或服务上难以受到保护的窘境。

对于具有独创性的在先图形商标或文字图形组合商标而言，在先权人基于《商标法》三十二条主张在先著作权，可有效解决跨类保护问题而避免驰名商标的认定困难。本案中，诉争商标在 2003 年 8 月提出申请，指定了与 25 类服装无类似和关联关系的 12 类“汽车内胎、车辆轮胎”等商品。彪马公司如基于十三条驰名商标保护条款，需要举证证明 2003 年时其“跳跃中的美洲豹”图形已在中国成为 25 类运动服装和鞋类领域的驰名商标，举证难度较大。此时彪马公司选择以在先著作权为法律基础，合法合理。

那么，如何在商标行政案件中证明在先商标标志享有在先著作权？根据北京市高级人民法院《关于商标授权确权行政案件的审理指南》，在先权人一般应提供该商标标志的设计底稿、取得权利的委托设计合同、著作权转让合同、诉争商标申请日之前的著作权登记证书等作为证明著作权归属的初步证据，仅有在诉争商标申请日后取得的著作权登记证书无法证明该商标标志著作权的归属。

上述规则是 2017 年最高人民法院《关于审理商标授权确权行政案件若干问题的规定》（简称“**最高法院司法解释**”）出台之前的规则，对于制止恶意抢注他人商标的行为有一定积极意义。2017 年最高法院司法解释出台，该规则被更便利的规则所取代。最高法院司法解释第十九条第三款规定：“商标公告、商标注册证等可以作为确定商标申请人为有权主张商标标志著作权的利害关系人的初步证据。”这就是说，异议人或无效宣告请求人在提出主张时

无需主张自己是在先商标标志的著作权人，可主张其为在先著作权的利害关系人，而支持其主张的证据也无需再提交著作权登记证书、创作底稿等证明著作权归属的证据，而只提供商标注册证或商标公告即可，这对于无效宣告请求人或者异议申请人更加便利。北京市高级人民法院在同期审理的另一案²中也已开始适用最高法院司法解释的上述规则。最高人民法院在近期审理的“鲨鱼图形”无效宣告请求案³中再审判决中则直接以诉争商标申请日之后取得的商标标志的著作权证书，结合诉争商标申请日之前取得的意大利商标注册证等，认定达马公司有权主张该图形的著作权，据此实际给予了在9类眼镜商品上的跨类保护。需要特别强调的是，在此一情形下，无效宣告请求人或者异议申请人不需要主张自己是在先商标标志的著作权人，而应主张是著作权的利害关系人，否则一方面存在举证困难，另一方面也可能被争议商标申请注册人抓住漏洞，致使自己的主张无法得到法院支持。

对参与市场竞争的商业主体而言，其往往拥有代表公司或产品形象的造型设计文字商标、图形商标或文字图形组合商标。作为上述案例的启示，为实现品牌的全方位保护，包括实现此类商标在商品和服务的跨类别保护，公司应充分重视著作权保护条款在品牌保护中的重要意义。一方面，公司应通过商标确权程序在核心和重要商品上取得商标注册；另一方面，针对有一定独创性而可获著作权保护的作品标志，应取得著作权权属证明，包括设计底稿、委托设计合同或著作权转让合同等，同时及早取得版权登记证，作为著作权权属的初始证据。外国权利人在中国提出商标异议或无效，应注意若以著作权人身份主张，则举证责任加大，需提交商标标志的设计底稿、合同、首次发表证据、诉争商标申请日前的著作权登记等。如商标在国内外已取得注册证，则可根据最高法院司法解释，以在后著作权证书、在先国内外商标注册证等作为初始证据证明其为在先著作权的利害关系人，以获得《商标法》三十二条一款对在先著作权的保护。

马 强 合伙人 电话：86-10 8519 2496 邮箱地址：maq@junhe.com

本文仅为分享信息之目的提供。本文的任何内容均不构成君合律师事务所的任何法律意见或建议。如您想获得更多信息，敬请关注君合官方网站“www.junhe.com”或君合微信公众号“君合法律评论”/微信号“JUNHE_LegalUpdates”。



² (2017)京行终5374号国家录制艺术与科学院有限公司诉商评委、郑裕早案。

³ (2017)最高法行申7174号达马股份有限公司诉商标评审委员会、温州市伊久亮光学有限公司“鲨鱼图形”商标无效宣告案。

JUNHE SPECIAL REPORT



April 28, 2018

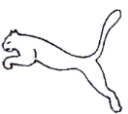



Prior Copyright Protection in Trademark Dispute Cases

— A Brief Comment on the Trademark Dispute over Mark “羅斯蒙特 & LSMT & Device”¹

1. Background

On Aug. 27, 2003, Qingdao Dekai Tyre Co., Ltd. filed an application for trademark “羅斯蒙特 & LSMT & Device” No. 3691497 on goods “automobile inner tubes; vehicle tyres; etc.” in class 12 (hereinafter referred to as “**the Disputed Mark**”), which was granted a validity period up to Aug. 13, 2025. In March 1, 2013, PUMA SE applied to the Trademark Review and Adjudication Board (**the Appeal Board**) for trademark dispute against the Disputed Mark, but the Appeal Board

ruled to maintain the registration of the Mark. Dissatisfied with the ruling, PUMA SE filed a lawsuit before the Beijing First Intermediate People's Court, which rejected its claim. It then appealed to the Beijing High People's Court, which held that the Disputed Mark infringed on the prior copyright of PUMA SE, cancelled the original verdict and also the ruling made by the Appeal Board, and ordered the Appeal Board to re-hear the case. (Here attached is the comparison table for the images of the Disputed Mark and prior marks.)

| Prior Trademarks (Works Enjoying Prior Copyright) | | | Later Trademark (The Disputed Mark) |
|---|---|---|---|
|  |  |  |  羅斯蒙特 No. 3691497 |

2. Key Points

Evidential materials like copyright registration certificates of trademark images, copyright contracts, registration certificates of prior international and Chinese trademarks, etc. obtained after the application date of a disputed mark can be used as preliminary evidence proving the copyright over trademark images enjoyed by

the holder of prior trademarks.

3. Legal Grounds

The Beijing High People's Court held that: PUMA SE requested to recognize its prior copyright over the art work “The Jumping Puma” based on the notarized materials including the Copyright Contract and Supplementary Agreements, the

¹ The Second Instance Judgement Numbered (2017) 785 on Lawsuit on Trademark Dispute of PUMA SE against the Trademark Review and Adjudication Board & Qingdao Dekai Tyre Co., Ltd. in Respect of Trademark “羅斯蒙特 & LSMT & Device” No. 3691497.

Copyright Registration Certificate, and Registration Certificates of international and Chinese trademarks. Although the Copyright Registration Certificate was obtained after the application date of the Disputed Mark, it can still be preliminarily proved that PUMA SE held prior copyright over the art work “The Jumping Puma” based on the notarized Copyright Contract and Supplementary Agreements, as well as the Registration Certificates of its prior international and Chinese trademarks. The animal image in the Disputed Mark is nearly identical to the art work “The Jumping Puma” in terms of design style and visual effect, which constitutes substantial similarity to the same. Therefore, the registration of the Disputed Mark would cause damages to the prior copyright of PUMA SE.

4. Comments

Article 32.1 of Trademark Law 2013 (Article 31.1 of Trademark Law 2001) stipulated that trademark applications shall not infringe upon others’ prior existing rights. According to judicial interpretations of the Supreme People’s Court, the adjudication guidelines of the Beijing High People’s Court, and relative law practices, such prior rights, which may be asserted to object to other’s trademarks, include the right to name and portrait, copyright, the right to trade name and patent of industrial design, etc. Where a trademark contains special figures or designs with originality, the trademark holder may file oppositions or invalidations against substantially similar upcoming trademarks in any classes based on its prior copyright as regulated in this Article. Such legal actions not only protect the image of the trademark which grants its holder with prior copyright, but also provide extended protection to the mark concerning goods and services in all the 45 classes. Some have opined that cross-class protections are only for well-known trademarks and if copyright is protected as prior right, it shall be restricted from being granted such strong protection. However, such protection

is indeed an inherent requirement for protecting proprietorship of a prior copyrighted works against later marks on all goods and services. When there is conflict between a prior copyrighted works symbol and a later trademark, sufficient consideration shall be given so that the prior copyright be fully protected rather than limited.

According to general provisions in trademark laws of China and other nations, the registrant or applicant of a prior trademark has the right to prevent others from applying for registration of identical or similar marks in respect of identical or similar goods or services, so as to avoid any confusion and misrecognition. This trademark protection method shall be subject to the following two preconditions: 1) the upcoming trademark is identical with or similar to the prior trademark; 2) the designated goods or services covered by the two marks are also identical or similar. In the processes of trademark examination, opposition and opposition review, refusal review, nullification, etc., examiners and judges would first carry out examination upon the above two preconditions, then decide whether there is a likelihood of confusion, which determines their decision of approving for registration, rejecting the application or announcing invalidation.

Similarity between a prior mark and an upcoming mark can be determined by conducting a comparison and observation based on the principles established in the Trademark Review and Adjudication Standards, relevant judicial explanations and regulations; while the similarity between the goods or services of two marks can refer to the *Classification Guide for Goods and Services*. In the event that an upcoming trademark is filed on non-similar goods or services, and it does not constitute a preemptive registration, which applies to trademarks “acquired by fraud or any other improper means” as stipulated in Article 44 of Trademark Law, prior trademark holders can only seek protection of well-known marks in

accordance with Article 13 of the Trademark Law, and must submit sufficient evidence of prior trademark use and popularity in order to prove the well-known status of the mark. But this is a heavy burden -- trademark authorities always adopt a very stringent approach in determining the well-known status of a mark, which on one hand has effectively controlled the alienation trend of pursuing the well-known recognition, and on the other hand has inevitably caused the phenomenon that some prior marks with certain popularities face difficulties in seeking protection against their use in dissimilar goods or services.

If a prior device mark or word & device mark acquires certain originalities, its holder may claim copyright protection based on provisions in Article 32 of Trademark Law, which can not only realize cross-class protection, but also spare all the troubles in recognizing well-known marks. In the subject case, the Disputed Mark's owners applied for registration in Aug. 2003 and filed on goods "automobile inner tubes; vehicle tyres; etc." in class 12, which are dissimilar and unrelated to "clothing" in class 25. According to the provisions of well-known marks in Article 13 of Trademark Law, PUMA SE shall submit evidential materials to prove that "The Jumping Puma" serial marks have become well-known on goods "sportswear and shoes" in class 25 in China in the year of 2003, which is of substantial difficulty. Thus, it is rightful and reasonable for PUMA SE to take prior copyright as its legal basis for protection.

In this regard, how does one prove the existence of prior copyright over the image of a prior trademark, in administrative cases concerning trademarks? According to the *Adjudication Guidelines on the Administrative Cases Involving the Authorization and Determination of Trademark Rights* issued by the Beijing High People's Court, the prior trademark holder shall provide all of the

following evidential materials as preliminary evidence of holding a prior copyright: manuscripts of creating the design, design commission agreement and copyright transfer contract proving the obtainment of the copyright, and copyright registration certificate before the application date of the disputed mark. For obvious reasons, a copyright registration certificate obtained after the application date of the disputed mark alone is not sufficient to prove the holding of a prior copyright.

The above-mentioned Adjudication Guidelines were of positive significance in curbing malicious and preemptive registrations of others' prior trademarks, and were superseded by the issuance of the *Regulations on Several Issues Concerning the Trial of Administrative Cases Involving the Authorization and Determination of Trademark Rights* by the Supreme People's Court in 2017 (hereinafter referred to as "**the Judicial Explanation**"). Article 19.3 of the Judicial Explanation stipulated that: "the public announcement and registration certificate of a trademark, etc. can be used as preliminary evidence to prove that the trademark applicant is an interested party with rights to claim copyright over the image of a registered trademark." Therefore, a party initiating an opposition or invalidation does not necessarily need to claim itself as the copyright holder to the image of a prior trademark, instead it can claim to be an interested party of prior copyright. By so doing, it can be free from the burden of submitting all the evidential materials such as the copyright registration certificate, manuscripts of creating the design, and other materials proving the prior obtainment of the copyright. By contrast, an interested party of prior copyright is only required to submit the trademark registration certificates or publication announcements. The Judicial Explanation had been applied in another case

² before the Beijing High People's Court at the same period of time as the subject case. The Supreme People's Court, in the recent retrial decision on the "Shark Device" case ³, recognized that the petitioner, DAMA S.P.A., could claim the copyright over the device based on the copyright registration certificate obtained after the application date of the mark in dispute combined with the Italian trademark registration certificates issued in the 1980s. The Court accordingly granted cross-class protection in respect of "eyeglasses" in Class 9. What needs to be particularly emphasized is that the party who initiated an opposition or invalidation claimed to be an interested party of copyright, instead of the copyright holder of a prior trademark. This difference allowed the claimant to avoid both the difficulties associated with providing the evidential materials required of a copyright holder, as well as the risk of more vulnerabilities being found in the evidential materials, which could lead to the rejection of its claim.

When participating in the market competition, businesses usually apply for various stylized word marks, device marks or word & device marks symbolizing the image of their company or products. In light of the subject case, market entities shall attach great importance to the role of copyright protection in realizing overall brand protection, including inter-class protection of the designated goods or services of such marks. On the one hand, they may need to apply for

trademark registrations in core goods and services through the determination process of trademark rights; on the other hand, they may obtain evidence of copyright ownership over images of prior marks, such as manuscripts of creating the design, design commission agreement and copyright transfer contract proving the obtainment of the copyright.

In the meantime, the copyright registration certificates shall also be obtained as early as possible. Such documents or certificates are all preliminary evidence proving the holding of copyright. Foreign right holders who initiate oppositions or invalidations against Chinese trademarks, if they claim as the holder of copyright, would face many more difficulties in providing evidential materials like manuscripts of creating the design, copyright contracts, first publication proofs, copyright registration certificates before the application date of the disputed marks. If they have obtained trademark registration certificates in China and overseas, according to the Judicial Explanation of the Supreme People's Court, foreign right holders instead may claim to be an interested party to prior copyrights, and simply use preliminary evidential materials such as prior trademark registration certificates and copyright registration certificates obtained after the application date of disputed marks, so as to be seek prior copyright protection in accordance with Article 32.1 of Trademark Law.

Ma Qiang Partner Tel: 86-10 8519 2496 Email: maq@junhe.com

This document is provided for and only for the purposes of information sharing. Nothing contained in this document constitutes any legal advice or opinion of Jun He Law Offices. For more information, please visit our official website at www.junhe.com or our WeChat public account "君合法律评论"/WeChat account "JUNHE_LegalUpdates".



² The Second Instance Judgement Numbered (2017) 5374 on Lawsuit of National Academy of Recording Arts and Sciences against the Trademark Review and Adjudication Board & Zheng Yuzao.

³ PRC Supreme Court, Retrial Case 7174 Dama S.P.A. v. TRAB, Wenzhou Yijiuliang Trademark Invalidation Case.