

Using China's Multi-Track System to Fight against Trademark Squatting

LEI Yongjian

Partner

leiyongjian@wanhuida.com

Using China's Multi-Track System: Fight against Trademark Squatting

- 1. Prosecution: Proactivity of the CNIPA**
- 2. Administrative: Actions by local AMRs**
 - Complaints against whom?
 - Under what situations?
 - Through what channels?
- 3. Civil: Attempts by courts**
 - What if bad-faith registrants sue first?
 - What if genuine brand owners sue?

1. Prosecution: Proactivity of the CNIPA

- Publication of decisions
Transparency, evidential value
- Ex-officio investigation/refusal
OA
- Blacklisting
Internal policy, unpredictability
- Success rates
Incredibly high

关于第54489533号商标驳回通知书

信息来源：商标局

关于第54489533号商标驳回通知书

Ex-officio refusal
based on bad faith

申请人：昇起（上海）智能科技有限公司
委托代理人：邮睿办理

经审查，根据《商标法》第四条第一款的规定，我局决定驳回上述商标注册申请，理由如下：
你公司短期内提交了包含该申请在内的大量商标注册申请，明显超出正常经营活动需要，属于不以使用为目的的恶意商标注册申请，应予以驳回。

根据《商标法》第三十四条的规定，商标注册申请人如果对本驳回决定不服，可以自收到本通知之日起十五日内向国家知识产权局申请复审。

特此通知。

2021年07月05日

Review of opposition	16 Feb 2020-15 Mar 2020	698	841	83.00%
	16 Feb 2021-15 Mar 2021	198	232	85.34%
Invalidation	16 Feb 2020-15 Mar 2020	1,164	1,738	66.97%
	16 Feb 2021-15 Mar 2021	3,160	4,345	72.73%
Review of non-use cancellation	16 Feb 2020-15 Mar 2020	77	106	72.64%
	16 Feb 2021-15 Mar 2021	863	1,075	80.28%

2. Administrative: Actions by local AMRs

- **Complaints against whom?**
Bad-faith applicants and TM agencies
- **Under what situations?**
 - ✓ Backed up by favorable decisions
 - ✓ **Massive bad-faith filing**, well-known, **business relationship**, **prior use**, **prior rights**, and others including unhealthy influence, disrupting the agency market by unfair means, fabricating
- **Through what channels?**
 - ✓ CNIPA transfer
 - ✓ Onsite complaining
 - ✓ Online complaining and feedback
- **Consequences**
 - ✓ Warning, suspension of agency business, criminal
 - ✓ Fine of USD 4,600/USD15,000



全国 12315 平台
国家工商总局

GET



2.7K RATINGS

1.6



AGE

4+

Years Old

CHART

No.88

Lifestyle

DEVELOPER



国家工商总局

处理单位 福建省/泉州市/晋江市市场监督管理局

Responsible AMR

立案情况 Case summary

告知时间

2021-01-26

Date of response

告知内容

不立案

Contents of response

不立案原因

经营，举报事项不予立案，理由：现场检查未发现该公司有存在商标侵权行为，分别于2021年元月20日下午15:00及2021年元月21日15:26拨打投诉人委托律师电话详细了解情况均没有接听。

Reasoning of response

Blue Sky Action 2019-2020

1,095 rectifications

330 investigations

182 penalty decisions

3. Civil: Attempts by courts – if bad-faith registrants sue first

Bad faith of infringing prior rights

The GLEAS case, August 2014, Supreme People's Court

- Registration on bags vs. prior registration on clothing, prior trade name, distinctiveness of TM
- Abuse of right and non-infringement



歌力思
GLEAS

歌力思

歌力思

Bad faith of massive TM filing and high assignment fee

The Uniqlo case, December 2018, Supreme People's Court

- Over 2,000 filings, no intention of use, serial malicious civil actions after TM sale attempt failed
- Abuse of right and non-infringement

UL



Bad faith of malicious Taobao online complaints

The Coppertone case, March 2018, Yuhang District Court

- Counterclaim or a separate lawsuit
- Registration on sunscreen, massive filing, professional complainant, no use, sale of TM vs. prior copyright
- Damages caused by takedown, unfair competition



3. Civil: Attempts by courts – if genuine brand owner registrants sue

Bad-faith filing + trademark infringement

The Bridgestone case, 2020, Suzhou Intermediate Court

- Trademark infringement activities
- Besides damages, reasonable costs around RMB 290,000 granted including expenditures in TM prosecution cases



普利司通

FULISITONG
福力思通

BRIDGESTONE

Is the bad-faith filing per se actionable? NO.

The Afton case, December 2020, Beijing IP Court

- Unfair competition law
- Not a cause of action, case not accepted
- Appeal pending



雅富顿

Is the bad-faith filing per se actionable? YES.

The In-Sink-Erator case, April 2021, Xiamen Intermediate Court

- Unfair competition law, tort liability law
- Precedents concerning opposition confirming bad faith Injunction and RMB 1,200,000 damages granted
- Appeal pending



in sink erator

爱适易

Thanks for Listening!

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Partner

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