中国司法机关对商标法意义上“商标使用”的观点

Judicial authorities differ on Trademark Law interpretations

尽管对“中国制造”有不同评价，“贴牌生产＋出口”的商业模式在中国迅速发展。OEM (original equipment manufacturer) 也称为贴牌加工，指海外公司委托中国企业生产并贴上委托方的商标标识再出口该国销售的模式。由于一些商业优势，在华企业成为海外品牌热选的供应商，同时也催生一系列法律问题，包括备受关注的商标侵权纠纷。

十多年来中国已有不少这方面的司法案例，从判决结果来看司法机关并没有统一认定标准。事实上，现行《商标法》《商标法实施条例》及相关司法解释亦没有明确规定 OEM 使用的商标如与他人在国内注册商标相同或近似是否构成侵权，因此造成一些判决结果截然相反。审理焦点在于贴牌生产是否构成《商标法》上的商标使用，司法和行政机关在审理案件时的主要法律依据是《商标法》第七章第五十七条及第六章第四十八条，我们称之为商标法的“金标准”。

2001 年耐克公司与嘉兴市某制衣厂的“NIKE”商标纠纷、诺基亚公司与无锡市某科技公司的“NOKIA EGYPT”商标纠纷，显示出广东和上海的法院对 OEM 侵权认定持有肯定的观点。法院认为商标权的地域特性使域外公司的商标不受中国法律保护，OEM 行为属于商标使用。

当我们以为这是司法界审理 OEM 商标纠纷的“肯定”基调时，却被最高院近期提审的侵权案件否定了。香港莱斯公司在大陆注册引证商标（如图），但发现宁波浦江亚环公司生产的挂锁上使用与其相同的两个涉案商标（如图），因而将亚环诉之法院。亚环公司自 2010 年起受墨西哥储伯公司委托生产带有涉案商标的挂锁并出口至墨西哥。储伯公司在墨西哥注册了涉案商标。2011 年莱斯公司以亚环公司侵犯其商标专用权为由诉至宁波中级人民法院。

引证商标
Reference mark

涉案商标一
Case mark 1

涉案商标二
Case mark 2

Regardless of the different opinions on “made in China”, the “OEM plus export” business model has developed rapidly in China. OEM (original equipment manufacturer) is a model where an overseas company engages a Chinese enterprise to do production and affix representations of the client’s trademark for re-export to the originating country for sale. Due to certain commercial advantages, enterprises in China have become the favoured suppliers for overseas brands, while simultaneously giving rise to a series of legal issues including trademark infringements.

In the past 10-20 years, China has witnessed quite a few of these types of cases, and from ensuing judgments it can be seen that judicial authorities lack uniform criteria for coming to their findings. In fact, the current Trademark Law, Implementing Regulations for the Trademark Law and related judicial interpretations also do not expressly specify whether infringement is constituted when the trademark used by an OEM is identical or similar to a trademark registered in China by a third party, giving rise to certain judgments that have been diametrically opposed. The focal point lies in whether OEM production constitutes trademark use for the purposes of the Trademark Law. The main legal basis when judicial authorities and administrative authorities hear cases are article 57 of chapter 7, and article 48 of chapter 6 of the Trademark Law, the so-called “gold standards” of the Trademark Law.

The 2001 “NIKE” trademark dispute between Nike and a certain clothing manufacturer in Jiaxing, and the “NOKIA EGYPT” trademark dispute between Nokia and a certain technology company in Wuxi, show that courts in Guangdong and Shanghai hold a positive viewpoint in respect of the finding of OEM infringement. The courts held that the territorial nature of trademark rights causes the trademarks of companies from outside the territory not to be subject to the protection of Chinese laws, and OEM acts constitute trademark use.

Just when we thought that this was a positive for OEM trademark disputes, it was negated in a recent infringement case appealed to the Supreme People’s Court (SPC). Hong Kong Foster registered a reference mark in mainland China (see the figure), but discovered that Ningbo Pujiang Yahuan used two case marks (see the figure) that are identical to its own on the padlocks that it produces. Accordingly, Foster took Yahuan to court.

Yahuan has been engaged by Truper Herramientas of Mexico since 2010 to produce the case mark bearing padlocks for export to Mexico. Truper Herramientas had registered the case marks in Mexico. In 2011, Foster sued Yahuan in the Ningbo In-


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宁波中院认为亚环公司与储伯公司构成涉外定牌加工关系。根据《商标法实施条例》第三条和《商标法》第五十二条，亚环公司的行为构成商标法意义上的“使用”，其涉案商标二构成对引证商标的侵权，应停止侵权并赔偿莱斯公司人民币五万元，使用涉案商标一的行为不构成侵权。双方均上诉。浙江高院于 2012 年审判该案，撤消一审判决，认定亚环公司使用两个涉案商标均构成侵权，将赔偿额增至八万元。亚环公司决定向最高人民法院提出再审。

最高院于 2015 年 11 月 26 日作出终审判决，同时撤销一、二审判决并认定亚环公司使用 PRETUL 相关标识的行为不构成商标法意义上的使用，不构成商标侵权。

主审法官如此评价商标使用：“商标法保护商标的基本功能，是保护其识别性。判断在相同商品上使用相同的商标，或者判断在相同商品上使用近似的商标，或者判断在类似商品上使用相同或者近似的商标是否容易导致混淆，要以商标发挥或者可能发挥识别功能为前提。也就是说是否破坏商标的识别功能，是判断是否构成侵害商标权的基础。在商标并不能发挥识别作用，并非商标法意义上的商标使用的情况下，判断是否在相同商品上使用相同的商标，或者判断在相同商品上使用近似的商标，或者判断在类似商品上使用相同或者近似的商标是否容易导致混淆，都不具实际意义。”

可见，最高院对“商标法意义上的使用”持有与一审、二审法院截然相反的观点。

PRETUL 案件对司法实践及行政保护有深远影响。首先，加大了海关执法难度。海关为保护权利人在海关总署备案的知识产权，会查扣可疑侵权物品。而按照最高院的观点，海关可能会遭受当事人的起诉，且胜诉难度大，这对海关执法积极性有消极影响。此外，跨国企业加大在华打击假冒行为的决心也会受到动摇。不过，这对未在中国注册商标或其品牌被抢注的公司来说却是好消息，他们可以减少对使用中国 OEM 供应商带来纠纷的顾虑。

中国不适用判例法，OEM 之争不会就此终结。有趣的是 PRETUL 案件中的三级审判结果虽截然不同，但法院主要依据皆是《商标法》第五十二条。

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termediate People's Court for infringement of its exclusive right to use the trademark.

The Ningbo court held that a foreign-related OEM relationship existed between Yahuan and Truper Herramientas. Pursuant to article 3 of the Implementing Regulations for the Trademark Law, and article 52 of the Trademark Law, Yahuan's act constituted "use" for the purposes of the Trademark Law, its case mark 2 infringed the reference mark and it was required to cease the infringement and pay Foster compensation in the amount of RMB50,000 (US$7,700). The act of using case mark 1 did not constitute infringement.

Both parties appealed the case. The Zhejiang High Court tried the case in 2012, quashed the judgment at first instance, found that Yahuan's use of both case marks constituted infringement and increased the measure of damages to RMB80,000. Yahuan decided to appeal to the SPC.

The SPC rendered a final judgment on 26 November 2015, quashing both judgments at first instance and appeal, and finding that Yahuan's act of using the PRETUL related representations did not constitute use for the purposes of the Trademark Law, and did not constitute trademark infringement.

The presiding judge assessed trademark use as follows: "The Trademark Law protects the basic function of trademarks, their function of identification. To determine whether the use of identical trademarks for identical goods, or similar trademarks for identical goods or identical or similar trademarks for similar goods is likely to result in confusion, it is necessary to take a trademark's ability to fulfill its identification function as the precondition. That is to say, whether the trademark's identification function is compromised is the basis for determining whether the trademark rights have been infringed. Where a trademark cannot possibly fulfil its identification function and trademark use for the purposes of the Trademark Law is not constituted, determining whether the use of identical trademarks for identical goods, or similar trademarks for identical goods, or identical or similar trademarks for similar goods, is likely to result in confusion does not have any actual significance."

From this it can be seen that the SPC holds an opinion on "use for the purposes of the Trademark Law" that is diametrically opposed to that held by the court at first instance and the appeals court.

The PRETUL case has a profound impact on judicial practice and administrative protection. First, it makes law enforcement by customs more difficult. To protect the IP of rights holders that has been filed with the General Administration of Customs, customs checks and seizes suspected infringing articles. However, customs could have a legal action instituted against it by the concerned party based on the SPC's opinion, an action in which it may have difficulty prevailing.

This will have a negative impact on an active customs approach to law enforcement. Furthermore, this will shake multinational corporations' resolve on cracking down on acts of passing off in China. However, it is good news for companies that have not registered trademarks, or whose brands have been preemptively registered in China, reducing their apprehension of disputes arising from the use of Chinese OEM suppliers.

As China does not apply case law, the end of OEM disputes is not in sight. A curious point in the PRETUL case is that although diametrically different outcomes were rendered in the trials at the three different levels, each court mainly based its judgment on article 52 of the Trademark Law.