

On the System of Trademark Prior Use Right

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Abstract: Trademark right is an important part of intellectual property system, and also an economic right for market participants to participate in market transactions in an orderly manner. Since the introduction of Trademark Law in 2013, there have been many attempts and divergences in theory and judicial practice. This paper introduces from the overview of the trademark first use right system, analyzes and expounds the main body, object and time requirements of the system, and introduces typical judicial cases, and puts forward the viewpoints of insight. In order to provide reference for the understanding and application of the trademark first use right system.

1. An Overview of the System of Preemptive Use of Trademark Right

With the rapid development of market economy in modern times, respect for knowledge and protection of labor have become the general recognition of society, so the protection of intellectual property rights has been paid more and more attention. Intellectual property is a general term, which includes copyright, patent right and trademark right. Trademark right is the most characteristic property right of commodity economy. It develops continuously with the development of commodity economy. It is of great significance to the research and application of trademark-related, the overall development of intellectual property law and the whole society. In the trademark-related system, the trademark first-use system is a key point in which research value and significance are.

China has a clear definition of the system of prior use of trademarks. In 2013, the Trademark Law of the People's Republic of China was amended and implemented. One of its important contents is to add provisions on the prior use of trademarks. It clearly stipulates that "before the trademark registrant applies for trademark registration, others have used the same or similar trademark before the trademark registrant in the same commodity or similar commodity. Where a trademark has certain influence, the exclusive right holder of a registered trademark shall not have the right to prohibit the user from continuing to use the trademark within the scope of its original use, but may require it to attach appropriate distinctive marks [1]." The acquisition of trademark rights in China is based on registrarism and is the principle of voluntary registration. Therefore, a large number of unregistered trademarks are used and circulated in the market. Although these trademark users do not have the exclusive right to use trademarks, their priority use of trademarks has become. In fact, if the qualification of the first user is deprived because of the registration of the later trademark registrant, it is obviously not in accordance with the principle of fairness. Therefore, how to resolve the dispute of interest between the prior user and the latter registrant becomes the theory of trademark law and The problem that must be considered in practice, and this is the design purpose of the trademark first use right. However, due to the principle and abstraction of this clause, various applicable problems have emerged in the course of practice. Various trademark infringement cases related to it are common and have hindered judicial practice.

In the context of the increasingly prosperous commodity economy, the value of trademarks is not the same as before. The relevant provisions of the right of prior use of trademarks have been more and more widely used, but also face more and more disputes about their application. Therefore, the rational use of the system of trademark preemptive right is of great significance to the orderly operation of market economy. First, it is to remedy the defects of the system of trademark registration in China, balance the interests of trademark registrants and trademark preoccupants, and maintain the stability of the existing economic order. Second, it is also of great value in combating unhealthy competition and realizing the unification of judgments in judicial practice. Therefore, in

the existing trademark first use right system, find out some basic issues concerning the use of trademarks first, and through the existing laws and regulations and the cases that have been decided, thoroughly analyze the disputes concerning trademark exclusive rights. It is necessary to use existing laws to explain and solve practical problems in the real world.

2. Time Elements: Definition of Time Limit before Application for Trademark Registration

In order to satisfy the conditions for the determination of the right of prior use of trademarks, the first step is to determine the time requirement and the word "prior" to the right of prior use. In the time sequence, the user of a trademark must be at the time point before the registrant applies for the registration of a trademark. Trademarks that are identical or similar to registered trademarks have been used.

In China's Trademark Law, it is stipulated that the determination of "prior" mainly refers to when the prior use of unregistered trademarks should be counted, which is also a controversial issue in the academic circles. Some scholars believe that the right of prior use of a trademark is the right generated by comparing the right of exclusive use of a trademark, and the right of exclusive use of a trademark is acquired only when the applicant has obtained the registration of a trademark, but not immediately when the applicant applies for registration. Therefore, the time of prior use of a trademark should be earlier than the date when the trademark has been approved for registration. However, some scholars believe that the time standard should be the date of trademark publicity announcement, because only after the trademark publicity announcement can the public know the fact, and after that, the use of the trademark can be judged as an act of malicious use, even though the trademark has been registered, and before that, the use of the trademark, the use of the personnel may be without knowing it. Other scholars believe that the date on which the registrant submits the application for trademark registration should be taken as the calculation standard, which also conforms to the standards of the trademark registration system. We can learn from the relevant provisions of the Trademark Law of China [2]. It is clearly recognized that the application for trademark registration is due to the trademark registration system adopted by China, and it is more inclined to protect the trademarks registered in the first place. Therefore, when two or more registration requests for the same or similar trademarks are filed, the protection is in front. One, so it is more appropriate to submit the application for trademark registration by the registrant, and to comply with China's institutional principles and design.

3. Object Elements: Judicial Cognition of "Commodity" and "Trademark"

As the object element of trademark prior use right, it is also the most important part of the whole trademark prior use right. In the relevant provisions of the Trademark Law, the object element, besides the trademark itself, is also the carrier of the trademark "commodity". These two important objects also occupy the most controversial points in the disputes of trademark prior use right. Therefore, it is important to have an objective standard to judge what goods and trademarks satisfy the conditions of trademark first use rights are important in both academics and applications.

3.1 Criteria for identifying "the same commodity or similar commodity"

First of all, as the carrier of trademarks, commodities are also an indispensable part of the right of prior use of trademarks. In identifying the right of prior use of trademarks, we should not only restrict the trademark itself, but also restrict the commodities to which the trademark applies. According to the provisions of Article 48 of the Trademark Law, "The use of trademarks referred to in this Law refers to the use of trademarks in commodities, commodity packaging or containers and commodity trading documents, or the use of trademarks in advertising, exhibitions and other commercial activities to identify the source of commodities." The use of trademarks in China includes not only the direct use of goods, but also the indirect use of trademarks in commercial activities such as commodity packaging, advertising and publicity. But in the related protection of the right of first use of trademarks, the protection of our country tends to protect the trademark of

first use which produces actual interests, that is, the trademark directly used in goods or services. This also conforms to the purpose of the right of first use of trademarks to protect the interests actually generated [3]. Therefore, the prior use only for packaging or advertising is not covered by the trademark first right. In the judicial practice of our country, in the case of (2007) Gaomin Zhongzi No. 1685, Pfizer sued Guangzhou Weiweiman Pharmaceutical Co., Ltd. for infringing its trademark of "Viagra", because it only advertised it and did not invest The actual use of the goods, so did not receive the support of the court. This also shows that China also adheres to the practical efficiency principle in the judgment process to promote the realization of fairness. Therefore, the goods or similar products that we are discussing now are also limited to the range of products that have practical applications and have produced real value.

Secondly, there are many disputes in judicial practice about the standard of identifying the object of commodity, that is, identical commodity or similar commodity. The International Classification of Goods and Services for Trademark Registration and the Distinction Table of Similar Goods and Services can be used as reference for judging similar goods or services. That is, "the same commodity" refers to the same commodity in terms of name, use, function, raw materials or sales channels. The same service refers to the same service in terms of its name, content, mode and object. "Similar commodities refer to commodities which have the same functions, uses, production departments, sales channels and consumers, or which are generally considered by the relevant public as having specific links and are liable to cause confusion. Similar services refer to services with the same purpose, content, mode and object, or services with specific links and confusion which are generally considered by the relevant public [4]. Therefore, it is judged that the similarity between goods and services means that there is a specific connection between goods and services, which is easy to confuse the relevant public. In the end, whether the goods or services are similarly identified should be judged by the general public's general understanding of the goods or services. Therefore, in the judgment of the same kind of goods or similar goods, it should be divided according to relevant standards and incorporate the general judgment of the public about the products or services.

3.2 Standards for the Definition of "Same or Approximate" Trademarks

In judging the same and similar trademarks, it is more complicated than the judgment of goods. According to the Trademark Law of the People's Republic of China (Amendment 2013), the trademark is the mark that can distinguish one's own goods or services from others' goods and services. Trademarks are composed of certain characters, graphics or their combination. These characters, graphics or their combination have not only their original meaning, but also their formal meaning. Trademark similarity can be divided into three types, which are similar in appearance. There are probably the following situations: composition approximation, color approximation, arrangement approximation, similarity of Chinese characters due to their writing style, and similarity of trademark shape due to differences in different languages. The pronunciation is similar, because some appearances are very different, but the pronunciation is very similar. If the pronunciation is used to identify the trademark, it is likely to cause the consumer to misunderstand; the concept is similar, if another trademark is the same in meaning or concept. Or similar, they should also be considered the same or similar trademarks.

In December 2005, the Trademark Office of the State Administration for Industry and Commerce and the Trademark Review and Adjudication Board jointly formulated and promulgated the "Trademark Review and Adjudication Standards" (hereinafter referred to as the "Standards") to specify the judgment standards for trademark approximation. The third part of the Standard, "Examination of the Same and Similar Trademarks," stipulates: "The determination of the same and similar trademarks shall first determine whether the goods or services designated for use belong to the same or similar goods or services; Secondly, we should judge whether the trademark itself is the same or similar from the aspects of shape, sound, meaning and overall expression of the trademark itself, taking the general attention of the relevant public as the standard, and adopting the method of overall observation and comparison of the main parts. " The subsequent judicial

interpretation also stipulates the following principles to judge whether trademarks are similar (1) taking the general attention of the relevant public as the standard; (2) It is necessary to carry out the overall comparison of the trademarks, and also to compare the main parts of the trademarks. The comparison should be carried out separately in the state of the comparison object; (3) If the trademark is judged to be similar, the protection should be considered. The distinctiveness and popularity of registered trademarks. In summary, the judgment of the same or similar trademark must be strictly in accordance with the standards stipulated by the law, combined with reasonable subjective judgment.

3.3 The Standard of Trademark Judgment with a Certain Impact

In the whole process of determining whether the right of first use of a trademark is satisfied, the most important point is to judge the influence of a trademark. The establishment of trademark preemptive right is actually a balance between the interests of the applicant for trademark registration and the preemptive right holder of trademark. Therefore, the establishment of influential elements can make the interests of both parties more balanced, while taking into account the legitimate interests of the applicant for trademark registration. But the trademark that satisfies the prior use of trademark must be the trademark that has had a greater practical impact, but such an abstract judgment standard is difficult to judge the specific size of the impact, similar to the judgment of well-known trademark [5]. Unregistered first-use trademarks are also trademarks with certain influence, but due to the difficulty in quantifying and unifying their judgment standards, many controversies have arisen in practical applications.

In stipulating this influential element, some scholars worry that the requirement of influential condition standard is too high, which will damage the rights and interests of the first user of trademark, and make the establishment of this right not achieve the desired effect. But at the same time, we should estimate the trademark registration system adopted in our country. This influential standard can not be too low, which will lead to "the right holder of the exclusive right of trademark registration". Interests are in a state of extreme instability, and the function of the whole trademark law will be cut in pieces [6]. Nor can it be absolutely protected against the trademarks used in advance, so the "degree" of this influence determination is a crucial point to achieve the balance of interests, so the provisions made when specifying the influence requirements are "certain influences". Such a more moderate range.

According to Article 14 of the Trademark Law of China, the factors that determine the influence of well-known trademarks include the public's awareness of the trademark, the duration of the use of the trademark, the duration of any publicity work, the extent and geographical scope of the trademark as a record of the protection of well-known trademarks. The influence factors of trademark judging the right of first use of trademark are similar to those of trademark judging, but the standard is lower than that of well-known trademark judging. However, in the Trademark Law, it is not clear how to judge the influence of the first trademark, so in judicial practice, whether to consider the influence of the first trademark has become a controversial issue. For example, in *Zhejiang Zhongkai Technology Co., Ltd. v. Shanghai Kaibao Electric Co., Ltd.* infringement of trademark rights, the parties claimed that the trademark first right, in addition to the application date of the registered trademark, must also meet the unregistered trademark before the application date. Has already had a certain impact on the requirements. Therefore, the retrial court considered this influence requirement and rejected the party's appeal by not satisfying the requirement. At other times, however, the court made a situation in which the judgment was made directly for other reasons without considering or considering the influence requirements. It can also be seen that at this stage, the use of influence elements by Chinese courts is not uniform, and there are different usage situations in various cases in various regions.

4. Subject Elements: Analysis of Users' Rights and Duties

Trademark preemption involves two main bodies: the trademark preemptor and the trademark registration applicant. Unlike other rights, the exercise of the right of prior use of trademarks has

many restrictions, while the content of the restriction of the right of prior use of trademarks. Whether the rights or obligations are concentrated on the trademark users, there are more controversies and problems, and more detailed regulations are required for the rights and obligations of trademark users.

4.1 The Continuation of Use of the "Original Use Range"

Under the trademark registration system of our country, once the trademark registration has been completed, it can exercise its rights in a relatively wide range, but in the use of trademarks after the first employer has obtained the right to use the trademark first. However, it is stipulated in the original scope of application. This kind of regulation is actually a balance between the interests of the trademark first-user and the trademark registrant, so it is reasonable, but how to understand the original scope of the abstract still needs further explanation of.

The nature of the trademark itself determines that the scope of use of the trademark is not only related to itself, but also cannot leave behind the goods and services as carriers behind the trademark. Therefore, the limitation of the scope of use needs to consider the use of the trademark. It is also necessary to consider the scope of use of the goods and services involved, but in the use of goods and services, it is necessary to face whether the trademarks used in the original products can be expanded to similar goods and services.

For this problem, the author's point of view is that it can't be extended to the same kind of goods or services. The reason is that the right of prior use of trademarks is not a complete exclusive right to use and dispose of trademarks, but only a right of defense. The original use of trademarks is limited to a particular kind of goods or services, and there is no trademark because of its prior use. Registered but had some influence and continued to use. For the problem, the author's point of view is that it can't be extended to the same kind of goods or services. The reason is that the right of prior use of trademarks is not a complete exclusive right to use and dispose of trademarks, But only a right of defense. The original use of trademarks is limited to a particular kind of goods or services, and there is no trademark because of its prior use. Registered but had some influence and continued to use

Similarly, the author holds different opinions on whether the original regional use can be expanded from the same kind of goods to the same kind of goods. Because of the unity of the market, it is difficult for us to control the circulation of a certain commodity or a certain service only in the same region, which means that although the law gives the trademark user the right of first use of the trademark, the author holds different opinions on whether it can be expanded from the same kind of goods to the same kind of goods. But they refuse to give them the chance to continue their development. The author believes that this is unreasonable, and contrary to the above argument against the expansion of the same kind of goods, the commodity is the most important and extensive carrier of the trademark, and the expansion of its bearing actually means the expansion of the trademark. The scope of use, but the expansion in circulation only involves the relevant strategies of its operation and development, and does not further expand its true scope of use, still used on the same kind of goods and services, the scope is reasonable and acceptable of.

4.2 Related Issues of "Additional Distinguishing Marks"

Another restriction on the first user of goods in our country is that it is necessary to add appropriate distinctive marks to distinguish the original ones. Although some scholars believe that "the first user has the right not only to continue to use, but also to require the registrant to use in a differentiable way," [7]. However, in all academic researches in China, there is no exception to the agreement that the additional distinction mark is the obligation to use the person first. The author also believes that this is also in line with the principle of protecting the trademark registration system of China, but whether the additional distinguishing mark can really distinguish the original After the trademark and the subsequent trademark, after the difference mark, whether it can no longer be restricted by the scope of its use and thus expand the scope of use, are issues that need to be explored and studied.

Firstly, in the relevant provisions of the Trademark Law, additional distinctive marks are added

to the standard of "appropriate" distinctive marks and what is "appropriate", which has become a difficult point to distinguish in specific cases by abstract laws and regulations. The author believes that this distinction can be recognized by increasing the appropriateness of the logo to reduce the similarity between the trademark and the original trademark, and such additional logo behavior is significantly unaffected by the influence of the registered trademark. The proper conduct is therefore acknowledgable, but if the trademark user attaches the distinctive mark to the similarity of the two trademarks, it cannot be recognized, but should be regarded as an unreasonable or illegal act.

Secondly, the author considers that it is also necessary to discuss whether it can expand its original restricted scope of use after adding distinctive marks. If the additional difference marks are less obvious, but there are subtle differences, it is necessary to consider whether the public can distinguish them and other factors, and decide whether they should still be restricted according to the original scope of application. If it is still difficult to distinguish clearly, it should be Still in accordance with the original use restrictions.

5. Conclusion

As a supplementary system of trademark protection, the system of prior use of trademarks plays an important role in balancing the interests of trademark registrants and prior users, protecting legitimate rights and interests and maintaining fairness, and has a wide range of application, but because the provisions are more abstract, Therefore, in practice, it is inevitable to encounter various disputes and problems. A more detailed understanding and analysis of existing laws and regulations will help to better use the trademark first right to resolve disputes in practice and reconcile the legality of all parties. Rights and interests, promote the consent and justice of judicial decisions, and maintain market economic order.

References

- [1] "Trademark Law of the People's Republic of China" Article 59, paragraph 3.
- [2] "Opinions of the Supreme People's Court on Several Issues Concerning the Trial of Administrative Cases Involving Trademark Affirmation and Authorization" Article 17, Paragraph 2: The people's court's examination and judgment of whether the trademark in dispute damages other people's prior right shall generally be based on the application date of the trademark in dispute.
- [3] Teacher Liu Chuntian pointed out: "In principle, that kind of trademark is only registered as a trademark. In fact, it should not be counted as a trademark that has never been used before, let alone a trademark right." Entity trademark right is generated by actual use, not registration. Referring to Liu Chuntian, "Discrimination of Trademarks and Trademark Rights", in "Chinese Patents and Trademarks", No.1, 1998
- [4] Article 11 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in Trial of Trademark Civil Dispute Cases.
- [5] Yumin Zhang: "Expression of Prior Use of Trademarks", in "Chinese Trademarks", No.2, 2002
- [6] [Japan] Kuroda Ji: Lecture Notes on Intellectual Property Law (Volume III), Tokyo: Yuhikaku Publishing, 2005 Edition, 218 pages.
- [7] Yumin Zhang, Huang Hui: "Between Registration and Use-Reflections on the Objects Protected by Trademark Law", in Yumin Zhang's Editor-in-Chief: "Theory and Practice of Intellectual Property Rights", Law Press, 2003, p. 10.