

The Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Famous Trademarks

Announcement of the Supreme People's Court

The Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Famous Trademarks, which were adopted at the 1467th meeting of the Judicial Committee of the Supreme People's Court on April 22, 2009, are hereby promulgated and shall come into force as of May 1, 2009.

Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Famous Trademarks

(Adopted at the 1467th meeting of the Judicial Committee of the Supreme People's Court on April 22, 2009 Judicial Interpretation No. 3 [2009] of the Supreme People's Court)

To protect the famous trademarks in the trial of cases of civil disputes over trademark right infringement, these Interpretations are formulated in accordance with the Trademark Law of the People's Republic of China, Anti-unfair Competition Law of the People's Republic of China, Civil Procedural Law of the People's Republic of China and other relevant laws and regulations, and by taking into account the judicial actualities.

Article 1 The term "famous trademark" as mentioned in these Interpretations refers to a trademark widely known by the corresponding general public within China.

Article 2 With regard to any of the following cases of civil disputes, in which a party concerned believes that its trademark is famous and takes this as the factual basis, the people's court shall determine whether the trademark involved therein is famous or not in light of the concrete circumstances if it deems it really necessary:

1. a trademark right infringement lawsuit initiated on the ground of violation of Article 13 of the Trademark Law;
2. a trademark right infringement or unfair competition lawsuit initiated by a party on the ground that an enterprise's name is identical with or similar to its famous trademark; or
3. a counterargument or counterclaim as prescribed in Article 6 of these Interpretations.

Article 3 With regard to either of the following cases of civil disputes, the people's court will not examine whether the trademark involved therein is famous or not:

1. Whether the trademark involved therein is famous shall not be the factual basis for the establishment of the trademark right infringement or unfair competition sued; or
2. The trademark right infringement or unfair competition sued is not established due to the absence of other elements as prescribed in law.

An infringement lawsuit, which is lodged by the plaintiff on the grounds that the domain name registered or used by the defendant is identical with or similar to the plaintiff's registered trademark and that the electronic business – the trading of relevant commodities through the domain name – is sufficient to mislead the relevant general public, shall be governed by the provisions in subparagraph 1 of the preceding paragraph.

Article 4 To determine whether a trademark is famous or not, the people's court shall regard the fact, which can demonstrate the popularity of the trademark, as the basis and comprehensively take into consideration all factors as prescribed in Article 14 of the Trademark Law, unless, in light of the concrete circumstance of the case, it is sufficient to determine the popularity of the trademark without taking into consideration all of the aforesaid factors.

Article 5 To allege the popularity of a trademark, a party concerned shall, in light of the concrete circumstances of the case, provide the following proofs to demonstrate that its trademark is already famous at the time of occurrence of the trademark right infringement or unfair competition:

1. the market share, marketing regions, profits, taxes, etc. of the commodities using the trademark;
2. the duration which the trademark has been continuously used;
3. the manner, duration, extent, money input, and geographical scope of publicity or promotion of the trademark;
4. the records that the trademark has ever been protected as a famous trademark;
5. the market reputation of the trademark; and
6. other facts that can demonstrate that the trademark is famous.

The duration, scope, manner, etc. as described in the preceding paragraph regarding the use of the trademark shall include the information about the continuous use of the said trademark prior to the examination and approval of the registration thereof.

The people's court shall, by taking into consideration other proofs for determining the popularity of the trademark, objectively and thoroughly examine such proofs as the length of use of the trademark, industrial ranking thereof, market investigation report, market value assessment report, and whether it has ever been certified as a famous trademark.

Article 6 For a civil lawsuit lodged by the plaintiff on the ground that the use of the trademark involved therein infringes its exclusive right to use the registered trademark, if the defendant makes a counterargument or initiates a counterclaim on the ground that the plaintiff's registered trademark is a copy, imitation or translation of its earlier un-registered famous trademark, it shall bear the burden of proof to support the popularity of the earlier un-registered trademark.

Article 7 If the trademark had ever been determined as a famous trademark by the people's court or by the industry and commerce administrative department of the State Council prior to the occurrence of the trademark infringement or unfair competition against which a lawsuit was lodged, and if the defendant does not object to the fact that the said trademark is famous, the people's court shall determine that the trademark is a famous one. If the defendant raises any objection, the plaintiff shall still bear the burden of proof to support the popularity of the trademark.

Unless it is otherwise provided by these Interpretations, the people's court shall not apply the self-admission rule for evidence of civil lawsuit to the fact in respect of the popularity of a trademark.

Article 8 For a trademark which is widely known by the general public within China, if the plaintiff has furnished the basic proofs to support the popularity of its trademark, or if the defendant does not have any objection, the people's court shall determine the fact that the trademark is famous.

Article 9 Where it is sufficient to make the relevant general public be confused about the origin of the commodity with regard to the use of the famous trademark and the trademark against which the lawsuit is lodged or it is sufficient to make the relevant general public believe that there exists a licensed use, relationship of affiliated enterprises or any other particular connection between the use of the famous trademark and the business operator of the trademark against which the lawsuit is lodged, this would fall within the circumstance of being "likely to cause confusion" as described in paragraph 1 of Article 13 of the Trademark Law.

Where it is sufficient to make the relevant general public believe that there is a certain connection between the trademark against which the lawsuit is lodged and the famous trademark and as a result the distinctiveness of the famous trademark is diluted and the market reputation of the famous trademark is degraded or the market reputation of the famous trademark is improperly utilized, this would fall within the circumstance as provided in paragraph 2 of Article 13 of the Trademark Law: "...misleads the general public and leads to possible damage to the interests of the registrant of that famous trademark" .

Article 10 If the plaintiff files a motion to enjoin the defendant from using the trademark, which is identical with or similar to its famous registered trademark, or enterprise name on dissimilar commodities, the people's court shall, in light of the concrete circumstance of the case, make a ruling after comprehensively taking into account the following factors:

1. the distinctiveness of the said famous trademark;
2. how well the famous trademark is known by the relevant general public that use the commodities using the trademark against which the lawsuit is filed or using the enterprise name;
3. the connection between the commodities using the famous trademark and the commodities using the trademark against which the lawsuit is filed or using the enterprise name; and
4. other relevant factors.

Article 11 If the registered trademark used by the defendant is a copy, imitation or translation of the plaintiff's famous trademark and if a trademark right infringement is constituted as a result of violation of Article 13 of the Trademark Law, the people's court shall, upon motion of the plaintiff, make a ruling on enjoining the defendant from using the said trademark, but it shall not support the plaintiff's motion under either of the following circumstances:

1. The time limit for applying for requesting the revocation of trademark as prescribed in paragraph 2 of Article 41 of Trademark Law has expired; or
2. The plaintiff's trademark is not famous when the defendant files a registration application.

Article 12 If the un-registered famous trademark which the party requests for protection falls within any of the

circumstances as described in Articles 10 through 12 of the Trademark Law under which it is not allowed to be used as a trademark or to be registered, the people's court shall not support the request.

Article 13 In a case of civil disputes involving the protection of a famous trademark, the determination of the popularity of the trademark by the people's court shall merely be regarded as the fact of the case and reason for the judgment, which shall not be included in the main content of the judgment. If a case is closed by mediation, the document of mediation shall not cover the determination of the popularity of the trademark.

Article 14 If there is any discrepancy between any prior judicial interpretation of this Court and these Interpretations, these Interpretations shall prevail.