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Welcome to this issue of our occasional guide to important aspects of intellectual property in Australia, particularly highlighting some of the differences between the practice of IP in Australia and China. The current issue focuses on matters relating to trade mark law and trade mark practice in Australia, particularly details of the trade mark filing and registration process, trade mark searching and trade mark disputes. The points discussed below are largely based on enquiries that we have received from our colleagues in firms and companies in China, so please contact us if there are any matters of particular concern to you.

欢迎来到我们这一期有关澳大利亚知识产权指南栏目。在该栏目中，您可以了解到一些重要的有关中国和澳大利亚在实施知识产权保护方面的区别。本期主要涉及澳大利亚商标法、商标权实施，尤其是有关商标申请和注册、检索与商标争议方面的问题。这些讨论主要基于来自中国同行以及中国企业的咨询，欢迎大家就感兴趣的问题与我们作进一步的探讨。

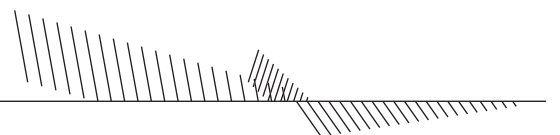
questions and answers – trade marks 问题与解答—商标

filing and registration 申请和注册

Q1. How do I protect my trade mark in Australia?
在澳大利亚如何保护商标权？

A1. The best way to protect your trade mark is to register it by filing an application to register the trade mark in the Australian Trade Marks Office. Although it is not necessary to register a trade mark, doing so confers very significant benefits. If you do not, it is much easier for your competitors to register the same or a similar trade mark.

Very importantly, without a registration, you can only protect your trade mark by relying upon a substantial reputation in a given area. A registration, on the other hand, gives Australia-wide enforceable legal rights in a trade mark, without you having to prove reputation. So enforcing your legal rights in a registered trade mark is simpler, more certain and less expensive than having to rely upon reputation.



在澳大利亚保护商标权的最佳途径是在澳大利亚商标局申请商标注册。虽然并不是一定要注册一个商标，但是这样做确实能带来很多益处。如果不进行注册，竞争对手很容易注册一个相同商标或近似商标。

最重要的是，如果不进行注册，您只能倚赖您的商标已树立的声誉在某个特定地域对其进行保护。而注册商标后，您可以在澳大利亚全境内获得保护，而不必证明它是否已获得声誉。所以，对注册的商标行使商标权要比倚赖已有的声誉要容易得多，花费也少。

Q2. How long does a trade mark registration last?

商标注册保护年限是多久？

A2. A trade mark registration lasts for 10 years, but it can be renewed for further 10-year periods indefinitely, upon payment of renewal fees. This is subject to the trade mark remaining validly registered, as discussed below.

商标注册保护期限为10年，但是可以无限期地进行10年一期的续展，根据缴纳续展费而定。这是指商标注册仍在有效期内，如以下所谈。

Q3. How long does it take to obtain registration?

需要多长时间获得一个商标注册权？

A3. It can vary, depending upon whether the Trade Marks Office raises objections to the application. It may object, for example, because of similarities with earlier registered trade marks, or because your mark lacks capacity to distinguish. If there are no objections, you can expect registration in around 6-12 months from the date of application. Naturally, if there are objections to overcome, the process can take longer. But in most cases you will get your registration within around 18 months. Only in situations where the Examiner maintains objections or it is necessary to submit evidence of use is it likely to take longer than this.

这要根据商标局是否对商标注册申请进行驳回而决定。如果申请注册的商标与已经注册的商标近似，或者缺乏显著性，那么就有可能被驳回。如果没有被驳回，那么从申请之日算起，一般在大约6-12个月左右可以注册。如果要克服驳回，那么注册需要的时间会长一些。但大多数情况下，可以在大约18个月左右获得注册。只有当审查员维持驳回，或者需要提供使用证据时，那么所需时间有可能要超过18个月。

Q4. What are the filing requirements for Australian trade mark applications?

申请注册澳大利亚商标都有哪些要求？

A4. In Australia, no Power of Attorney (POA) is required.

The following information is required to file a trade mark application in Australia:

- the applicant's full name and address;
- a clear representation of the trade mark (preferably in electronic format if a logo);
- if the trade mark has Chinese characters, a translation of those characters and a transliteration into English (eg 'Pinyin' or other suitable phonetic form);
- the class(es) in which the application is to be filed;
- a description of the goods and/or services to be covered by the trade mark; and
- details of any Convention priority claim.

- 在澳大利亚申请商标注册，不需要委托书。但是需要如下信息：
- 申请人姓名和地址；
- 清晰的商标表征（如果商标是图形的话，最好是电子版）；
- 如果商标是中文汉字，要将其翻译成英文和音译（如汉语拼音或其它的语音形式）；
- 要申请的商标注册类别（或多个类别）；
- 商标所涵盖的商品和/或服务的描述；以及
- 任何巴黎公约要求优先权的信息。

Q5. Are multi-class and series of marks applications available in Australia?
在澳大利亚可以进行多个类别和系列商标注册吗？

A5. Yes, multi-class applications are available in Australia.

It is possible to file for a series of marks if the marks resemble each other in material particulars and differ only in respect of statements or representations as to goods or services, statements or representations as to number, price, quality or names of places, or the colour of any part of the trade mark.

可以。澳大利亚接受多个类别申请。

也可以申请系列商标，如果每一个商标相互之间很相似，只是商品或服务的状态或表征不同，数字、价格、质量或地名的状态或表征不同，或者商标任何部分的颜色不同。

Q6. Is it necessary to file an application based on 'use' or 'intention to use'? What relevant evidence is required during the application process?
一定要基于“使用”或“意向使用”的商标才可以申请注册商标吗？需要什么相关证据？

A6. It is necessary for an applicant to be using the trade mark, or to have an intention to use the trade mark (including use through an exclusive licensee). It is also possible to file an application if the applicant intends to assign the application to a body corporate that is about to be constituted. However, during the application, it is not necessary to prove the use or the intention to use.

It is possible to oppose registration of a trade mark on the basis that there was no intention to use the mark at the time of filing. However, in such a case the opponent has the burden of showing the applicant's lack of intention – a difficult thing to prove.

申请人正在使用或者打算使用商标（包括通过专有被许可人来使用）是必要的。如果申请人打算将申请转让给一个欲要形成的法人，这种申请也是可行的。但是在申请期间，没有必要证明使用或意向使用商标。

基于没有意向使用商标的理由，而在商标注册申请时对其提起异议也是可行的。但这会对异议人构成一种负担——因为很难证明申请人缺乏意向使用。

Q7. How long does it take to get an application number and a registration number after filing?
递交申请多久可以得到申请号和注册号？

A7. Within approximately one week after filing the application it is allocated a number. This is the application number and will become the registration number once the mark is registered (see Questions Q3 and Q8).

递交申请后大约一个星期左右可以得到一个序号，这是一个申请号，在商标获得注册后便成为注册号（参见问题3和8）。

Q8. Is it possible to expedite the registration of a trade mark registration?
What are the requirements for such a request?

可以加速申请注册商标吗？有什么要求？

A8. It is possible to request expedited examination of a trade mark application, and commonly this is done when the mark is filed. With the request, it is necessary to submit a statutory declaration (which we can prepare) which gives the reason(s) for the request. Typically, such a statutory declaration simply states that for commercial reasons it is necessary for the applicant to have its rights determined, and for that reason expedited examination is requested. There is no official fee for requesting expedited examination, but an attorney fee is usually required for preparing the application and the statutory declaration.

可以要求加速审查商标注册申请，一般在递交申请时提出。提出这个要求之后，需要递交说明书说明理由（可由我方准备）。该说明书简单地说明由于商业原因，申请人有必要获得商标权，并且需要加速审查。提出加速审查请求不必缴纳官费，但需要缴付代理费，用于准备申请文件和说明书。

Q9. How are Geographical Indicators (GI) treated?
如何处理地理标记(GI)？

A9. Australian trade mark law restricts the use of a GI for the purpose of identifying a particular type of product, unless the product (or its constituent materials) originates from a particular area and/or meet certain standards.

In particular, under the *Australian Wine and Brandy Corporation Act 1980*, an extensive regime for controlling the use of wine names has been established. Protected names are kept on a Register of Protected Names. These names and names which are similar cannot be registered under the *Trade Marks Act 1995*. If these names are part of a composite mark, it may be necessary to enter an endorsement on the Trade Marks Register that the trade mark will only be used in respect of wines that originate from the named area.

澳大利亚商标法限制使用将地理标记用于识别某一特定类型商品的目的，除非该商品（或者它的组成物）来自某一特定的区域和/或者符合特定的标准。

根据澳大利亚酒类和白兰地公司法1980，一项严密的控制使用酒类名称的制度已经建立。受到保护的名称已经在保护名称登记簿中入册。根据商标法1995，这些名称以及与其相似的名称都不能在商标登记簿中注册。如果这些名称是一个组合商标的一部分，有必要在商标登记簿中记录这一情况，说明该商标只能用于原产于所命名地的酒类。

searching 检索

Q10. Is it necessary to conduct a preliminary search before filing a trade mark application in Australia?

在递交商标申请之前，有必要进行检索吗？

A10. Searching before filing is not necessary, but it is always advisable. Not only will a search of the register reveal marks which are the subject of a similar prior application or registration which may block registration of the proposed mark, but we can also conduct searches of the market in Australia, such as telephone books, company and business name registers and the Internet, in order to ascertain if the proposed mark has previously been used by others in Australia and whether it has a reputation in Australia. Trade marks which have been used first in Australia take priority over trade marks which have been filed first. A trade mark which has been used in Australia (but not registered) and for which a reputation has been established, may form the basis of a challenge to the use or registration of a similar mark.

It is therefore important to conduct a search before using and filing a trade mark in Australia for the first time, to avoid the risk that the use may amount to trade mark infringement, misleading and deceptive conduct or passing off the goods and services as belonging to another entity.

递交申请之前的检索不是必需的，但是我们鼓励做检索。这并不仅仅是要查询登记簿中是否已登记有在先申请的近似商标，或者可能阻碍欲注册商标的已注册商标，而且还要检索澳大利亚市场，比如电话簿、公司和商家名称登记簿以及互联网，以查明要注册的商标在澳大利亚是否已经被使用或者在澳大利亚是否已建立声誉。首先在澳大利亚使用的商标对首先申请注册的商标具有优先权。在澳大利亚已经使用的商标（还未注册），并且该商标已建立声誉，可以构成对抗使用或注册一个近似商标的基础。

所以在澳大利亚第一次使用和申请一个商标之前进行检索是非常重要的，可以避免使用该商标而导致侵权、误导、欺骗或假冒他人商品和服务的风险。

Q11. If the proposed mark includes a word and a design, how is such a mark searched?

如果要注册的商标包含文字和图形，针对这样的商标如何进行检索？

A11. In such situations, we conduct two separate searches, one for the word and one for the design. However, for such work the professional charges are generally significantly lower than would be the case for two wholly separate searches.

For example, if the mark is a Chinese character mark, we will carry out both word and design searches.

针对这种情况，我们分别进行两个检索，一个是检索文字，另一个检索图形。这种检索的专业代理费用要远低于两个完全无关的检索的收费。

例如，如果一个商标是中文汉字，那么我们要进行文字以及图形的检索。

Q12. If the trade mark is in color (rather than black and white), does this affect the search strategy and search cost?

如果商标是有颜色的（不是黑色与白色），会影响检索方法和检索费用吗？

A12. No, unless the colour is a dominant component of the mark, or the registration is limited to a particular colour. The strategy will be the same, and we do not levy any extra search charge for searching or filing an application for a colour mark.

不会，除非该颜色是商标的一个极为重要的组成部分，或者所要注册的就是一种特定的颜色。检索方法是一样的，并且不会因为检索或申请一个颜色商标而产生额外的检索费用。

Q13. The cost of searching can be higher than that for registering a trade mark (from filing to grant) in Australia? Why?

为什么澳大利亚检索的费用可能会高于申请注册一个商标（从申请到授权）？

A13. Ideally a trade mark infringement or availability search should be conducted prior to filing any application, although we understand that the cost of doing so and the attendant delays in obtaining and analysing search results can present a significant burden to some applicants. Some trade mark owners, especially if they have not yet commenced use of their trade mark in Australia, elect to bypass searching and file an application in the first instance, and then await the results of the official search conducted by the Australian Trade Marks Office to assess any risks or barriers to use or registration.

However, as discussed above, we generally recommend conducting a trade mark search prior to filing. Subject to the limitations inherent in any searching, conducting a trade mark search prior to using and registering a trade mark reduces the likelihood of inadvertently infringing the trade mark rights of others. This can help a trade mark owner avoid adopting trade marks with potential problems and reduces the scope for conflict. The costs associated with defending a trade mark opposition or an infringement claim are inevitably significantly higher than the costs for conducting a trade mark search, and carrying out searches before filing or using a mark is therefore a very prudent practice.

The costs associated with a trade mark search relate not only to the actual online search process, but more significantly to the time taken by a qualified attorney or lawyer to analyse the search results (which can sometimes be voluminous) and provide an expert opinion based on those results.

一般来说，商标侵权检索或者是可用性检索要在递交申请之前进行，虽然我们理解这样做从花费上以及等待获得分析检索结果的时间上对某些申请人来说，会构成一种负担。有一些商标所有人，尤其是如果他们还没有开始在澳大利亚使用他们的商标，选择绕开检索先进行申请，然后等待澳大利亚商标局的官方检索报告，来评估使用或注册的任何风险或障碍。

然而，如以上所述，我们一般建议在递交申请之前进行检索。虽然任何一种检索都有固有的限制，但是在使用和注册一个商标之前进行检索可以减少无意中侵犯到他人商标权的可能性，从而帮助商标所有人避免使用具有潜在问题的商标以及减少争议的范围。而为一个商标异议或一件侵权主张进行抗辩的费用不可避免地要远远高于对商标进行检索的费用。所以在递交申请或者使用一个商标之前进行检索，是一项很慎重的选择。

进行商标检索的费用不仅涉及在网上进行检索，更重要的是涉及到一名合格的代理人或律师分析检索结果所需要的时间（工作量往往非常大），以及提供一份基于这些结果的专业报告。

Q14. How long does it take to carry out a trade mark search?

商标检索需要多长时间？

- A14. At Allens, it usually takes up to about a week to provide the results of a trade mark search. However, in urgent cases, the results can be provided in approximately two days. If a potential obstacle to use and registration is identified through this process, we may recommend that further investigations be conducted into use of the mark in Australia. This can of course add to the overall time required.

我们事务所一般需要大约一个星期左右提供一份检索结果。但如果是加急的话，可以在大约2天之内拿到结果。在检索过程中如果发现对使用和注册商标有潜在障碍的话，我们会建议对在澳大利亚使用该商标做进一步的调查，这当然需要投入更多的时间。

trade mark disputes 商标争议

Q15. Can a trade mark application be opposed?

对商标申请可以提起异议吗？

- A15. When acceptance of a trade mark application has been published there is a period of three months in which any interested person may file a Notice of Opposition against the registration of the mark. It is possible to file an application to extend this time period (by a maximum period of three months), but only one such extension application is available on only limited grounds, which are stated in the legislation.

Three months after filing a Notice of Opposition, the opponent must file evidence in support of the opposition. The applicant then has three months to file evidence in answer and the opponent then has three more months in which to file evidence in reply. Extensions of time are available at any stage, usually around six months if the parties are not negotiating a settlement agreement, and around 12 months if the parties are in the process of negotiating a settlement agreement. However, the extensions of time allowed will depend on the particular circumstances applying in each situation. If both parties are negotiating and give consent, it may be possible to suspend an opposition without the need to apply for and pay for extension of time fees.

在商标申请受理公布后有一个3个月的异议期。在此期间，任何相关人士可以提交异议通知反对该商标进行注册。还可以申请延长异议期（最长达3个月），但是根据有限的已规定的理由，只能有一次延期异议申请。

在递交异议通知后的3个月当中，异议人必须要提交证据以支持异议。这时商标申请人有3个月的时间提交证据以应对异议，然后异议人又有3个月的时间提交证据应答。在任何阶段延期都可行，通常在6个月左右，如果双方当事人没有签订和解协议的话；如果双方正处于签订和解协议过程中，那么延期到12个月左右。但是，所允许的延期期限都将视具体情况而定。如果双方当事人签订协议并和解，有可能使异议延期，但不必申请异议延期和支付延期费用。

Q16. Can a trade mark registration be removed?

已注册商标可以被撤回吗？

- A16. A trade mark registration can be removed from the Australian Trade Mark Register on a number of grounds. Generally this requires court action, which can be a very expensive process. However, removal for non-use can be undertaken through the Australian Trade Marks Office, and such a process is significantly less costly and more straightforward than a court action.

Once a mark has been registered for five years, the registration can be removed on application by another party if it has not been used for a period of three consecutive years ending one month prior to the lodgement of the non-use action. A partial removal is possible if the mark has been used on some of the goods or services in the relevant period. Generally only a small amount of use of a trade mark will be sufficient to defend a non-use action.

由于各种理由，一个已注册的商标可以从澳大利亚商标注册簿上撤回。一般这个过程需要法院行为，费用昂贵。但是如果是因为非使用进行撤回的话，可以通过澳大利亚商标局进行，那么费用相对要低而且比通过法院行为要容易进行。

如果一个商标已经注册了5年，但是另一方申诉该商标在提交非使用申请一个月前已经连续3年未经使用的话，该项登记可以被撤回。部分撤回也是可行的，如果该商标在相应的期限内已经在某些商品或服务上使用的话。一般来讲，即使一小部分的使用商标也足以抗辩非使用诉讼。

Q17. Famous marks – what happens if a famous Chinese trade mark has been maliciously filed in Australia?

驰名商标—如果中国的驰名商标在澳大利亚被恶意抢注，会有什么后果？

- A17. It is possible to oppose an Australian trade mark application (of a famous Chinese trade mark which has not been registered in Australia and which has been filed maliciously by a third party) on the basis that the mark would be likely to deceive or cause confusion having regard to the reputation of the famous Chinese trade mark. However, in order to be successful on this ground, it is necessary to demonstrate that the Chinese trade mark had acquired a reputation in Australia prior to the filing date of the mark applied for. That reputation may also be the basis of an action for passing off or misleading and deceptive conduct in order to prevent use of the mark in Australia.

However, if the famous Chinese trade mark has not previously been used in Australia and does not have a reputation in Australia, it may be difficult to succeed in preventing use and registration of this mark by a third party. The best course of action is therefore always to file an Australian trade mark application as early a date as possible.

一个还未在澳大利亚申请注册的中国驰名商标被第三方在澳大利亚恶意抢注，异议这样的商标注册是可以的，如果理由是该商标可能是一种欺骗或者对中国驰名商标的声誉进行误导。然而要使这个理由成立，必须证明该中国驰名商标已经在申请日之前在澳大利亚获有声誉。这个声誉还可以作为对该假冒行为或误导和欺骗手段采取法律行为的基础，以阻止该商标在澳大利亚使用。

但是，如果该中国驰名商标之前从未在澳大利亚使用过而且没有在澳大利亚树立声誉的话，那就很难阻止第三方去使用和注册该商标。所以最好的途径是尽可能早地在澳大利亚申请商标注册。

(Further information on the trade mark application process and related matters can be found on our website at www.aar.com.au/patentattorneys)

(有关更详细的商标申请程序及相关问题，还可浏览我们的网页www.aar.com.au/patentattorneys)

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