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二、香港商标异议、无效、海关维权、影子公司

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1、前期尽调的重要性

企业海外并购潜在风险?











1、前期尽调的重要性

企业海外并购潜在风险?





一、跨境收购合并知识产权前期尽调及交易风险 1、前期尽调的重要性

企业海外并购潜在风险?

知识产权有那么的重要吗?

自身企业与被收购企业

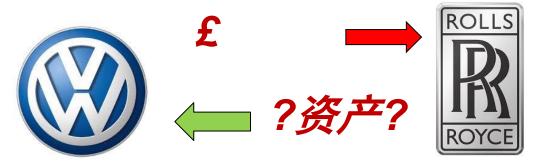
- 股价?
- 上市价?
- 收购价?
- 额外资产!!
- 日后企业业务发展与营运?



1、前期尽调的重要性

日后企业业务发展与营运

in 1998, when German carmaker Volkswagen purchased the assets of Rolls Royce and Bentley automobiles for about \$900 million. Volkswagen did not realize until after the deal was closed that the IP assets did not include the right to use the Rolls Royce trademark... The trademark was owned by another carmaker, BMW, pursuant to a prior agreement. Volkswagen had therefore acquired all the rights necessary to manufacture the car, but did not have the right to brand it as a Rolls Royce!



http://www.ipeg.com/how-to-avoid-another-rolls-royce-ip-due-diligence-in-ma-transactions/



1、前期尽调的重要性

日后企业业务发展与营运

<u>案例</u>:

- 一中国企业收购欧洲一知名电子产品品牌
- · 但电子产品商标与欧洲竞争对手在共同市 场共同持有!!



1、前期尽调的重要性

知识产权的特征与一般财产不同

- a. 无形性 非传统有形资产、核实
- b. 专属性 因无形、登记制度不一
- c. 知识产权的权属关系复杂,加之现代科技发展使所有权关系更为复杂!!



1、前期尽调的重要性

知识产权的尽调方式与不同市场

- 大陆法系国家各自法律制度、概念不同
- 大陆法系 vs. 普通法系概念与范围

例如:

- a. 著作权: 肖像权? Commissioned works?
- b. 相同或近似商标:查询、使用??
- c. 企业名称、质权登记制度
- d. 地域不同专利合法概念及授予



2、海外尽调的范围

知识产权的尽调范围可以有多大?

- <u>传统范围</u>、所有权人名义(Chain of Title)等 有否以 "Deed of Nominee" 作为隐名持有的情况??

- 广义范围: 各类合同及相关范围

- a. 目标公司、业务性质、历史背景
- b. 市场狀況、第三方、合作方、大學合作研究?
- 公司业务领域范畴、该市场竞争对手等?
- 知识产权权利存续、登記及行使制度、使用狀況?
- 知识产权是否受當地政府補助、貸款?
- 当地国政府是否有旅行相关国际公约?
- 雇員合同(职务创作所有权转让)等?

2、海外尽调的范围

知识产权的尽调范围

- 相关资产的具体范围:
 - 1。核实所有资产,对其拥有的是所有权还是使用权? 是关键的、核心资产还是周边较次资产?
 - 2。记录资产、评估进行分类其独立性、是否依赖他人知识产权? 是否受时间、地域等的限制?
 - 3。对所有知识产权效益进行分析以及市场趋势,检视各种要性
 - 4。相关权利是否中是否存有其他人的权益?
 - 5。 当地的法律法规的规定、市场情况、风险评估。



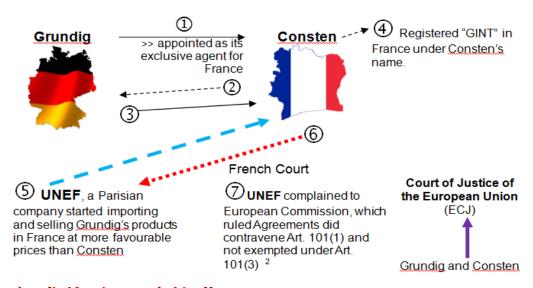
3、海外并购风险: 拟并购企业国环境

- **政策不同**:当地政府有关行业的长远以及短期政策?
- 法律制度不同:例如土地:矿权和地权分离的澳洲并购矿产,只买了权,没买地权,陷入了买了矿却不能踏足矿产所在地:知识产权领域尤其!
- 市场环境不同:
- 文化观念不同:中标不等於并购成功。
- 环保标准不同:产品进入或转移市场
- 知识产权保护标准不同:
- 劳工保护的规则不同:
- 境外政府、工会、非政府组织等各种部门机构的审查和谈判
- 履行企业社会责任方式的差别当地居民反应以及小区关系。



3、海外并购风险:反不正当竟争?

反不正当竞争,垄断? Grundig & Cousten.



因垄断审查未能完成收购,赔偿费??

"2015年伊莱克斯与美国通用电气公司的并购案中,因为未通过反垄断审查,伊莱克斯最后 交付了1. 75亿美元的分手费"

http://finance.people.com.cn/BIG5/n1/2017/0522/c1004-29289664.html



3、海外并购风险: 当地法律如何规定?

拟被并购企业知识产权是否:

- 部分內容涉及属于国家机密?
- 属于禁止输出项目?
- 拟被并购企业国家是否相关公约、条约成员?欧洲、 美国
- 涉及知识产权诉讼系属?
- 拥有研发部门?分布其他国家?如有,如何确保完 全取得,包含其中的知识产权?



4、保障收购公司

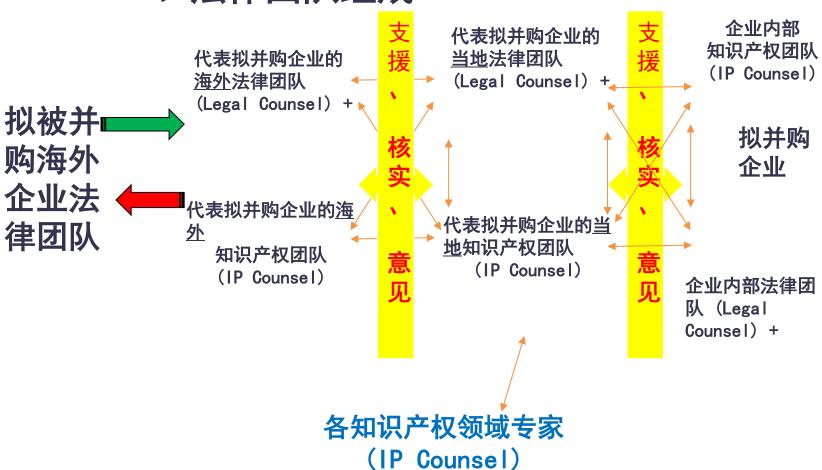
要求出售方或其股東弥偿以防万一:

- 1. 要求出让方提供较长的弥偿期限以及较广的 范围;
- 2. 要求出让方提供无上限的弥偿义务;
- 不受限弥偿限制事项:如对方欺诈叙述、误导、违反承诺等;
- 4. 维权、抗辩的协助义务;

等风险降至最低:宜<u>尽早</u>/优先(<u>第一时间</u>)进行尽调



5、法律团队组成





6、提早海外布局以及确实保护到位

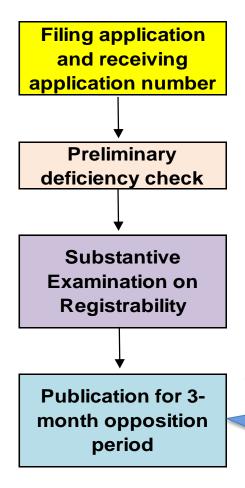




Trade Mark Opposition (商标异议)

5 months from filing

On average, 2 months after issues revealed at preliminary deficiency check are cleared



Absolute and/or relative grounds for refusal



Trade Mark Opposition (商标异议)

(1) Publication of particulars of trademark to be registered

(2) Filing opposition by OP

(3) Filing counter-statement by AP

(4) Case management conference

(5) Filing evidence by OP

(6) Filing evidence by AP

(7) Filing further evidence by OP (reply to (6) only)

AP: applicant of the trade mark registration (申请人) OP: opponent to the trade mark application (凡对方)

within 3 months after (1) (can extend once for 2 months)

within 3 months after receipt of notice of (2) (can extend once for 2 months)

within 6 months after receipt of (3) (or any agreed extended date)

within 6 months after receipt of (5) (or any agreed extended date)

within 6 months after receipt of (6) (or any agreed extended date)



Trade Mark Opposition (商标异议)

only with leave of the Registrar; OP has the (8) Filing further evidence right to be the last to file evidence (9) Case management conference if evidence does not support the pleadings (10) Filing notice of intention to attend within 14 days after receipt of notice of hearing date hearing (11) Pre-hearing review (12) Hearing open to public written decision usually delivered 6-12 (13) Decision months after hearing date filing notice of motion (to appeal) within 28 (14) Appeal days after decision was given



Trade Mark Invalidation (商标注册无效)

- To invalidate a trade mark that is already registered
- Mark should not be qualified for registration in the very first place (s.53 of the Ordinance)
- Grounds of invalidation
 - 1) Mark registered in bad faith;
 - 2) Mark registered in contravention of the absolute grounds for refusal of registration; and/or
 - 3) Mark registered in contravention of the relative grounds for refusal of registration in respect of an earlier trade mark.
- Dealt by the Trade Mark Registry ("TMR") or the Court



Trade Mark Invalidation (商标注册无效)

- If prior mark owner has acquiesced (默许) for a continuous period of 5 years in the use of a registered trade mark in Hong Kong and is aware of that use (s.59 of the Ordinance)
- → Cannot apply for declaration of invalidity or opposition
- → Unless the later mark is registered in bad faith



AP: applicant of the Invalidation to registration (申请人)

Trade Mark Invalidation (商标注册无效)

Owner: registered owner of the trade mark (所有权人) (1) Filing application for revocation by AP (2) Filing counter-statement by Owner within 6 months after receipt of (1) (3) Filing further evidence by AP within 6 months after receipt of (2) only with leave of the Registrar; AP has the right to be the last to (4) Filing further evidence file evidence (5) Case management conference if evidence does not support the pleadings, or some of them (6) Filing notice of intention to attend within 14 days after receipt of notice of hearing date hearing (7) Pre-hearing review open to public (8) Hearing (9) Decision written decision usually delivered 6-12 months after hearing date filing notice of motion (to appeal) within 28 days after decision (10) Appeal was given



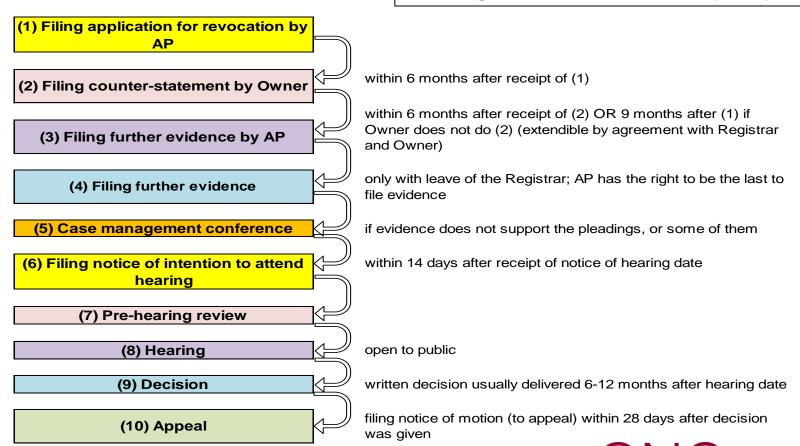
Revocation/cancellation based on Non-Use (因没使用而撤销/取消商标注册)

- One of the most common grounds used to revoke a trade mark that is already registered
- Not genuinely used in Hong Kong in relation to the goods and services for which it is registered for a continuous period of at least 3 years and there are no valid reasons for non-use (s.52 of the Ordinance)
- Valid reasons for non-use: e.g. import restrictions on, or governmental requirements for, goods or services protected by the trade mark.
- Dealt by the TMR or the Court



Revocation/cancellation based on Non-Use (因没使用而撤销/取消商标注册)

AP: applicant of the opposition to registration (申请人)
Owner: registered owner of the trade mark (注册人)



Customs Power & Procedures (海关权力及海关行动程序)

香港海关

Customs and Excise Department

假冒 (Counterfeit) / 盗版商品 (pirated goods)

《商品说明条例》 (Trade Descriptions Ordinance) (Cap 362)

→ 针对假冒商标或虚假商品说明

香港法院

民事诉讼程序



法院





Customs Power & Procedures (海关权力及海关行动程序)

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→ 针对假冒商标或虚假商品说明

HKD\$88

"鲍鱼炒饭"

被海关检控「供应/要约供应应用虚假商品说明的货品」

海关备案??

仅仅依据当事人要求采取行动 → 官方行動前登錄/纪录制度

官方留察名單



Customs Power & Procedures (海关权力及海关行动程序)

如何向海关投诉?

- 提供相关香港商标注册证;
- 提供在香港市场取得的正版商品以及相关假冒商品樣版、 以及相关发票;
- 制定审核专家或审查员;
- 其它海关认为所需文件等。





Company Name Dispute (影子公司名称争议)

- 恶意登记注册类似公司名称,即所称"影子公司"
- 通常是使用他人商标、公司名称作为公司名称显著部分

主要处理方法:

- (1) 香港公司注册署(Companies Registry of Hong Kong)投诉
 - 香港公司注册署审核后指控成立, 指令相关公司更改名称
 - 该公司登记成立后12个月以內,依据:
 - 名称与一间已经登记注册公司名称太近似;
 - 名称可能误导致使影响公众利益受损; 或
 - 公司名称具冒犯性或违反公众利益



Company Name Dispute (影子公司名称争议)

投诉期限!

香港公司注册署需时至少一个月的调查时间

中国移动有限公司 vs. 中國移動通信集團網路服務有限公司

→ 香港公司注册署

中國移動通信集團網路服務有限公司

公司注册标号1799382有限公司



Company Name Dispute (影子公司名称争议)

主要处理方法:

(2) 该公司无实际运作(No Operation),继而申请Strike Off > 解散例如:多年未提交公司年報,如連續三年为由。

(3) 遵循法院程序提出撤銷或变更名称 即以商标侵权以及/或假冒 (Passing Off)方式进行

發出敬告函 (Cease and desist letter)



Passing off (假冒)

- Action based on common law for protecting business goodwill
- When a trader unlawfully misrepresents (acts misleadingly) that his goods or services are those of another trader
- Applicable to also unregistered trade marks or marks which are undergoing the process of registration!
- 3 elements to be proved:
 - 1) Goodwill or reputation attached to the goods/ services
 - 2) Misrepresentation by the defendant to the public
 - leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff
 - whether or not intentional
 - 3) Damage
 - suffers or is likely to suffer
 - due to the erroneous belief engendered by the defendant's misrepresentation



谢谢!

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solutions • not complications