

美国 商标审查指南

American
Trademark Manual of Examining Procedure

美国

商标审查指南

American

Trademark Manual of Examining Procedure

中国商标局

美国商标审查指南

美国专利商标局 译
中国工商总局商标局 校



商 務 印 書 館

2008年·北京

图书在版编目(CIP)数据

美国商标审查指南/美国专利商标局译;中国工商总局商标局校. —
北京:商务印书馆,2008

ISBN 978-7-100-05767-7

I. 美… II. ①美…②中… III. 商标法—美国
IV. D971.23

中国版本图书馆 CIP 数据核字(2008)第 017597 号

所有权利保留。

未经许可,不得以任何方式使用。

MĚIGUÓ SHANGBIĀO SHĚNCHÁ ZHĪNÁN

美国商标审查指南

美国专利商标局 译

中国工商总局商标局 校

商务印书馆出版

(北京王府井大街36号 邮政编码 100710)

商务印书馆发行

北京瑞古冠中印刷厂印刷

ISBN 978-7-100-05767-7

2008年9月第1版 开本 700×1000 1/16

2008年9月北京第1次印刷 印张 53¼ 插页 2

定价: 108.00 元



美国商务部部长兼专利商标局局长 Dudas 先生
向中国国家工商总局商标局局长安青虎先生递
交美国《商标审查指南》译稿光盘

序 言

中华人民共和国国家工商行政管理总局商标局局长

安青虎

经过中国国家工商行政管理总局商标局(CTMO)和美国专利商标局(USPTO)的共同努力,美国专利商标局《商标审查指南》(*Trademark Manual of Examining Procedure*)第四版第 1200 章(申请的实质审查)及第 1300 章(不同类型商标的审查)同读者见面了。

1972 年发表《中美上海联合公报》后,中美两国的直接贸易开始恢复并逐渐上升。自 2001 年 12 月中国加入世界贸易组织以来,中美两国经贸合作持续快速发展。据统计,2006 年中美贸易额达 2627 亿美元,同比增长 24.1%,截至 2007 年 6 月底,美国在华设立外商投资企业 2.4 万余户。美国成为中国第一大出口市场和第二大贸易伙伴。中国成为美国第三大出口市场和第二大贸易伙伴。

与此同时,在与贸易有关的重要知识产权之一的商标领域,中美的交流与合作积极发展。1979 年 12 月中国恢复商标注册后,美国来华商标申请量逐年上升。1980 年,美国企业在华商标注册申请仅为数百件,2000 年,美国企业在华商标注册申请突破 1 万件,2006 年,美国企业在华商标注册申请突破 2 万件。截至 2007 年 6 月底,美国在华累计商标注册申请量为 16.1 万件,累计商标注册量为 10.5 万件,占 130 多个外国和地区在华注册商标总量的 21%,是在中国申请和注册商标最多的国家。

2004 年 3 月,美国专利商标局局长杜达智先生首次访问中国商标局,双方均表达了希望在商标方面加强合作的愿望。同年 6 月,杜达智先生再次率团来访,双方在会谈中就具体合作项目进行了磋商。由于当时商标局正在修订《商标审查准则》,因此,我提出希望美国专利商标局能提供其《商标审查指南》的中文本,以为借鉴。杜达智先生爽快地答应了。之后不久,杜达智先生托美国驻华使馆高级知识产权专员柯恒先生捎话给我,说由于其《商标审查指南》内容繁杂,全部翻译难度较大,且费时

很长,怕来不及供中国商标局修改《商标审查准则》时参考,故拟先将其认为是对中国修改《商标审查准则》具有价值、最具参考作用的部分译出。我表示同意和理解。

2005年1月,杜达智先生访问中国,将《商标审查指南》有关章节(第1200章和第1300章)中文译稿亲手交给我。我和我的同事看后认为,该稿翻译质量具有相当水准,无须大改。于是,我又向杜达智先生提出,以两局的名义用中英文在中国出版《商标审查指南》这部分内容,以供中国更多的业内人士分享。杜达智先生欣然同意。同年11月,杜达智先生将《商标审查指南》稿件的电子版及其为该书所写的序稿面交给我。2007年6月,杜达智先生托柯恒先生捎来该序的中英文修改稿,之后又寄来该序的签名稿。对于杜达智先生积极热情的合作、富有成效的工作和认真负责的精神,我十分赞赏。

美国是普通法国家。在商标审查工作中,美国专利商标局依据美国商标法和联邦法规的规定确立了一整套应用法律的具体原则,并结合多年的商标审查实践积累起大量对后来的相似案件具有很强指导作用的判例以及适用于各审查环节的应用程序。《商标审查指南》是美国专利商标局审查员所遵守的审查指南和程序,对美国商标申请人、代理人进行商标工作也具有参考意义。内容包括审查员手册及信息和解释,大致描述了审查员在审查过程中所需遵守或需授权遵守的程序。

该《商标审查指南》于1974年1月制定,之后于1993年、2002年、2005年作了三次修修订,以适应美国联邦法院系统的新判决对美国专利商标局的影响。目前执行的第四版共19章,1005页,具体章节标题为:基本情况、申请日期、申请书件的提交和受理、申请书件处理和费用、所有权变更、代理人或代表人、申请的审查程序、申请要求、商业使用、国际协议下的申请、意图使用与相关文件、申请的实质审查、不同种类商标的审查、商品和服务的分类与确认、审查后程序、注册和注册后程序、提交局长的事项、申请和注册的公众查询、马德里协议。

本书尽管只是其中两章,但内容涉及商标申请中的实质审查部分,内容丰富,案例众多,其中的很多案例都是经过指南的编写者精心挑选出来的,具有较高的参考价值。中国商标局在修订《商标审查准则》、商标评审委员会在制定《商标审理标准》的过程中,均参考和借鉴了这两章的部分内容。2005年12月,中国商标局和商标评审委员会共同发布了《商标审查及审理标准》,并在中国商标局的官方网站“中国商标局”(www.ctmo.gov.cn)上全文刊载。

本书的成功出版,是中美两国商标领域合作交流的一项重要成果。本书不仅对中国的商标审查人员具有参考价值,而且对中国知识产权领域的立法人员、法官、学者、代理人、企业家等均具有借鉴意义。我衷心希望,中美两国的有关机构能继续保持并不断深化和加强双方在商标领域的合作,为保护知识产权,促进中美经济和贸易的不断发展作出更大的贡献。

By Mr. An Qinghai, Director General of
State Administration for Industry and Commerce

The People's Republic of China



2007年8月

With the joint efforts by the Trademark Office of the State Administration for Industry and Commerce of the People's Republic of China (CTMO) and the United States Patent and Trademark Office (USPTO), Chapter 1300 (Substantive Examination of Applications) and Chapter 1301 (Examination of Different Types of Marks) of the Trademark Manual of Examination Procedure (TMPEP) of the USPTO is now available to readers.

Since the Sino-US Joint Communiqué was published in 1978, the direct trade between China and US has resumed and risen gradually. The bilateral economic and trade cooperation has witnessed continuous and even rapid increase since China entered into the World Trade Organization (WTO) in December 2001. According to statistics, the trade volume reported a 24.1% year-on-year increase to 382.7 billion USD in 2006. By the end of June 2007, there had been 34,000 US-invested enterprises in China. The United States of America has become China's largest export destination and the second largest trade partner. And China is the US's third largest export destination and the second largest trade partner.

Meanwhile, the two countries have also developed exchanges and cooperation in the trademark field, which is one of the important intellectual property rights related to trade. Since China resumed trademark registration in December 1979, there has been a steady growth of trademark applications from the United States. In 1980, only a few hundreds of applications for trademark registration from the

Foreword

By Mr. An Qinghu, Director General of Trademark Office
State Administration for Industry and Commerce

 The People's Republic of China

2008年8月

With the joint efforts by the Trademark Office of the State Administration for Industry and Commerce of the People's Republic of China (CTMO) and the United States Patent and Trademark Office (USPTO), Chapter 1200 (Substantive Examination of Applications) and Chapter 1300 (Examination of Different Types of Marks) of the *Trademark Manual of Examination Procedure* (TMEP) of the USPTO is now available to readers.

Since the *Shanghai Sino-US Joint Communique* was publicized in 1972, the direct trade between China and US has resumed and risen gradually. The bilateral economic and trade cooperation has witnessed continuous and even rapid increase since China entered into the World Trade Organization (WTO) in December 2001. According to statistics, the trade volume reported a 24.1% year on year increase to 262.7 billion USD in 2006. By the end of June 2007, there had been 24,000 US-invested enterprises in China. The United States of America has become China's largest export destination and the second largest trade partner. And China is the US's third largest export destination and the second largest trade partner.

Meanwhile, the two countries have also developed exchanges and cooperation in the trademark field, which is one of the important intellectual property rights related to trade. Since China resumed trademark registration in December 1979, there has been a steady growth of trademark applications from the United States. In 1980, only a few hundreds of applications for trademark registration from the

United States were received. While in 2000, the figure was more than 10,000 and in 2006, it exceeded 20,000. By the end of June 2007, there had been accumulatively 161,000 applications for trademark registration from the United States, with 105,000 trademark registrations in total, accounting for 21% of the total registered trademarks by 130 foreign countries and regions. Among the foreign countries, the United States ranks first in terms of trademark applications and registrations in China.

In March 2004, Mr. Jon W. Dudas, Under Secretary of Commerce for Intellectual Property and Director of the USPTO paid his first visit to CTMO when the two Offices expressed wishes to strengthen the cooperation in the trademark field. In June when Mr. Dudas headed a delegation to visit the CTMO again, both sides discussed cooperative programs in details. Since at that time CTMO was revising its *Trademark Examination Guidelines*, I asked if USPTO could provide its TMEP in Chinese version for our reference. And I got a positive answer. Soon after that, Mr. Mark Cohen, the Intellectual Property Attache of the U.S. Embassy in Beijing passed on a message of Mr. Dudas to me, that due to the complexity of the TMEP, the USPTO would probably be unable to have it translated in time. He suggested that the most useful parts be translated first. I agreed and expressed my understanding.

In January 2005, Mr. Dudas visited China and in person gave me the Chinese version of related Chapters (Chapter 1200 and Chapter 1300) of the TMEP. My colleagues and I thought the translated version was of such high quality that there would be no need for further amendment. Then I proposed that the chapters be published both in Chinese and English in the name of the two Offices so that more practitioners can share the content. Mr. Dudas agreed. In November the same year, Mr. Dudas sent me the electronic version as well as his preface for publication. In June 2007, Mr. Dudas asked Mr. Cohen to send me the revised preface both in Chinese and English, and soon the signed preface. I appreciate the active cooperation, fruitful work and responsible attitude of Mr. Dudas very much.

The United States uses a system of common law. In its trademark examination, USPTO has established a whole set of concrete principles of applying laws in accordance with the provisions of the US Lanham Act and relevant federal acts. In addition, combined with years of practices there have been case laws that can be applied to similar cases as well as some procedures that are applicable to various processes. The TMEP is the guidance for USPTO examiners, and also offers references for trademark applicants and agents. It contains the examiners' manual, information and explanation, which describe the procedures that examiners should abide by or should be authorized to abide by during examination.

The TMEP was formulated in January 1974 and was revised three times in 1993, 2002 and 2005 respectively in order to be adapted to the new judgment of the federal court. The current fourth edition of the manual is composed of 19 chapters and 1005 pages in total. The captions of each chapter are as follows: General Information; Application Filing Date; Filing and Receipt of Documents; Processing Documents and Fees; Change of Ownership; Attorney and Representative; Procedure for Examining Applications; Application Requirements; Use in Commerce; Applications under International Agreements; Intent-to-Use Applications and Related Documents; Substantive Examination of Applications; Examination of Different Types of Marks; Classification and Identification of Goods and Services; Post-Examination Procedures; Registration and Post-Registration Procedures; Matters Submitted to the Director; Public Inquiries about Applications and Registrations; Madrid Protocol.

Although the publication only includes two chapters, it contains the substantive examination of trademark applications. Many of the cases are cautiously selected by compilers to provide references. Both CTMO and Trademark Review and Adjudication Board (TRAB) referred to and borrowed parts of the two chapters when they revised and drafted their trademark examination guidelines respectively. In December 2005, CTMO and TRAB jointly publicized the *Trademark Examination and Guidelines* on CTMO's official website www.ctmo.gov.cn.

The successful publication is a significant fruit of cooperative exchanges in Sino-US trademark realm. The publication provides reference not only to the Chinese trademark examiners, but also to law-makers, judges, scholars, agents as well as applicants who are intending to apply for trademark registration in the US. I sincerely hope that the relevant bodies of the two countries can maintain and further reinforce their trademark cooperation, and make more contributions to IPR protection as well as economic and trade development of the two countries.

美国的商标注册审查程序与中国的比较 August 2007

一、美国商标注册。美国商标注册审查程序与中国的比较，主要涉及以下几个方面：(一) 美国商标注册的审查程序。美国商标注册审查程序分为两个阶段：(1) 形式审查。美国商标注册审查程序首先进行形式审查，即对申请人的申请材料进行初步审查，包括申请人的身份、申请人的资格、申请人的材料是否齐全等。(2) 实质审查。美国商标注册审查程序在形式审查通过后，进入实质审查阶段。实质审查是指商标局对申请人的申请材料进行实质性审查，包括申请人的材料是否符合《美国专利法》的要求、申请人的材料是否真实、申请人的材料是否具有新颖性等。美国商标注册审查程序在实质审查通过后，进入公告阶段。公告是指商标局将申请人的申请材料在《美国专利公报》上进行公告，以便公众查阅。公告期为30天。如果在此期间内没有人提出异议，则申请人的材料将被注册为商标。如果在此期间内有人提出异议，则商标局将启动异议程序。异议程序是指商标局对申请人的材料进行进一步审查，以决定是否注册为商标。异议程序分为两个阶段：(1) 异议受理。商标局收到异议申请后，将对申请人的材料进行初步审查，以决定是否受理异议申请。(2) 异议审理。商标局受理异议申请后，将对申请人的材料进行实质性审查，以决定是否注册为商标。异议审理程序分为两个阶段：(1) 异议答辩。异议受理后，申请人应在规定的时间内对异议申请进行答辩。(2) 异议裁决。商标局将对申请人的答辩进行审查，并作出最终的裁决。如果商标局裁定异议成立，则申请人的材料将被驳回。如果商标局裁定异议不成立，则申请人的材料将被注册为商标。

<http://www.uspto.gov/tmtrb/trbq/>

二、美国商标注册的审查程序。美国商标注册审查程序与中国的比较，主要涉及以下几个方面：(一) 美国商标注册的审查程序。美国商标注册审查程序分为两个阶段：(1) 形式审查。美国商标注册审查程序首先进行形式审查，即对申请人的申请材料进行初步审查，包括申请人的身份、申请人的资格、申请人的材料是否齐全等。(2) 实质审查。美国商标注册审查程序在形式审查通过后，进入实质审查阶段。实质审查是指商标局对申请人的申请材料进行实质性审查，包括申请人的材料是否符合《美国专利法》的要求、申请人的材料是否真实、申请人的材料是否具有新颖性等。美国商标注册审查程序在实质审查通过后，进入公告阶段。公告是指商标局将申请人的申请材料在《美国专利公报》上进行公告，以便公众查阅。公告期为30天。如果在此期间内没有人提出异议，则申请人的材料将被注册为商标。如果在此期间内有人提出异议，则商标局将启动异议程序。异议程序是指商标局对申请人的材料进行进一步审查，以决定是否注册为商标。异议程序分为两个阶段：(1) 异议受理。商标局收到异议申请后，将对申请人的材料进行初步审查，以决定是否受理异议申请。(2) 异议审理。商标局受理异议申请后，将对申请人的材料进行实质性审查，以决定是否注册为商标。异议审理程序分为两个阶段：(1) 异议答辩。异议受理后，申请人应在规定的时间内对异议申请进行答辩。(2) 异议裁决。商标局将对申请人的答辩进行审查，并作出最终的裁决。如果商标局裁定异议成立，则申请人的材料将被驳回。如果商标局裁定异议不成立，则申请人的材料将被注册为商标。

三、美国商标注册的审查程序。美国商标注册审查程序与中国的比较，主要涉及以下几个方面：(一) 美国商标注册的审查程序。美国商标注册审查程序分为两个阶段：(1) 形式审查。美国商标注册审查程序首先进行形式审查，即对申请人的申请材料进行初步审查，包括申请人的身份、申请人的资格、申请人的材料是否齐全等。(2) 实质审查。美国商标注册审查程序在形式审查通过后，进入实质审查阶段。实质审查是指商标局对申请人的申请材料进行实质性审查，包括申请人的材料是否符合《美国专利法》的要求、申请人的材料是否真实、申请人的材料是否具有新颖性等。美国商标注册审查程序在实质审查通过后，进入公告阶段。公告是指商标局将申请人的申请材料在《美国专利公报》上进行公告，以便公众查阅。公告期为30天。如果在此期间内没有人提出异议，则申请人的材料将被注册为商标。如果在此期间内有人提出异议，则商标局将启动异议程序。异议程序是指商标局对申请人的材料进行进一步审查，以决定是否注册为商标。异议程序分为两个阶段：(1) 异议受理。商标局收到异议申请后，将对申请人的材料进行初步审查，以决定是否受理异议申请。(2) 异议审理。商标局受理异议申请后，将对申请人的材料进行实质性审查，以决定是否注册为商标。异议审理程序分为两个阶段：(1) 异议答辩。异议受理后，申请人应在规定的时间内对异议申请进行答辩。(2) 异议裁决。商标局将对申请人的答辩进行审查，并作出最终的裁决。如果商标局裁定异议成立，则申请人的材料将被驳回。如果商标局裁定异议不成立，则申请人的材料将被注册为商标。

美报社

序 言

美国商务部主管知识产权副部长兼专利商标局局长

杜 达 智

首先感谢您对美国专利商标局商标审查指南的关注。

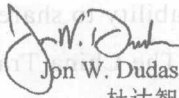
能与中国的同事分享我们的审查指南是一个非常难得的机会。中国商标局是一个令人印象如此深刻的商标主管机关。中国商标局的同事都是工作勤奋且具有相当学术水平的专家,领导层则目光远大,无私奉献。应中国商标局安青虎局长的要求,美国专利商标局非常高兴能提供《美国商标审查指南》第四版第 1200 章(申请的实质审查)和第 1300 章(不同类型商标的审查)的中译本,内容主要涉及美国专利商标局在商标实质审查中的实践经验。至于完整的最新修订版的审查指南,请参照网页 <http://tess2.uspto.gov/tmdb/tmep/>。

本审查指南具有多重意义:1. 为商标审查员规定了统一标准。2. 由于标准统一,我们可以利用本审查指南协助评估审查员的工作质量。3. 由于任何人都可以登陆美国专利商标局网站免费查阅本审查指南,申请人和商标从业者据此可以正确预测商标审查结果。4. 由于申请人或其代理人能够看到本审查指南,他们可以据此质疑任何不正确的审查实践,也可以更好地理解商标局提出某些具体要求或作出驳回决定的理由。5. 世界各国商标局的同事可以据此对美国专利商标局的审查实践进行评价。

我们赞赏中国商标局在进行第三次商标法修改过程中向国内外商标所有人及包括美国专利商标局在内的其他各国商标主管机关征求意见的做法。在安青虎局长的领导下,中国商标局在改善权利人在华保护商标权和商标执法方面作出了巨大的努力。中国商标局的网站 <http://www.ctmo.gov.cn>, 不仅提供中国有关商标保护的综合公共信息,同时也提供中国商标审查及审理标准和商标注册信息网上查询系统的链接。

我们将继续与中国商标局共同努力,进一步推动这些合作,尤其是支持中国商标局应用最新技术优化审查流程,减少案件积压的努力。同时,中国商标局和美国专利商标局已经同意共同采取措施,例如编写和交换信息小册子,以帮助中小型企业更好地了解如何在对方国家保护自己的商标。这个由安青虎局长提议的项目,主要是考虑到中国培育更多国际知名商标的需要,鼓励中国企业使用美国专利商标局商标在线查询系统,并且在美国申请注册他们的商标。同时,也帮助美国企业了解在中国注册和保护商标的法律及程序。

我谨代表美国专利商标局全体雇员,期待着与中国商标局在上述各方面以及其他重要领域进行更多的合作,以促进双方的知识产权保护工作。



Jon W. Dudas
杜达智

United States Patent and Trademark Office Trademark Manual of Examining Procedure, 4th Edition (TMEP) Chapters 1200 (Substantive Examination of Applications) and 1300 (Examination of Different Types of Marks)

Foreword from the Under Secretary for Intellectual Property and Director of the United States Patent and Trademark Office Jon W. Dudas:

Welcome and thank you for your interest in this guide to examination of trademarks by the United States Patent and Trademark Office (USPTO).

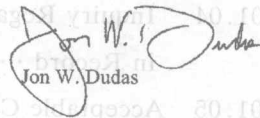
The ability to share our TMEP with colleagues in China is an incredible opportunity. The China Trademark Office (CTMO) is quite an impressive organization. Our colleagues at the CTMO are hard-working professionals with scholarly ability, and the CTMO leadership is visionary and dedicated. In response to the request of CTMO's Director General An Qinghu, the USPTO is pleased to provide a translation of Chapters 1200 (Substantive Examination of Applications) and 1300 (Examination of Different Types of Marks) of the 4th Edition of USPTO's *Trademark Manual of Examining Procedure* (TMEP). These two chapters contain the most pertinent information about the USPTO's examination practice as to substantive trademark law issues. The complete TMEP featuring all of the latest updates is available online at <http://tess2.uspto.gov/tmdb/tmep/>.

The TMEP serves several purposes. First, it provides uniform guidance to our trademark examining attorneys. Second, because of the uniform guidance, we use the TMEP to help us assess the quality of work performed by our examiners. Third, applicants and practitioners know what to expect, because the TMEP is available, free of charge, to everyone at USPTO's website. Fourth, because applicants and their representatives can read the TMEP, they are able to challenge any incorrect practices — or better understand why a particular requirement or rejection is made. Finally, the TMEP gives our colleagues in trademark offices around the world the opportunity to review our examination practices at the USPTO.

We applaud the CTMO's leadership in soliciting input from foreign and domestic brand owners and from other trademark offices, including the USPTO, in undertaking the third revision to China's Trademark Law. Under Director General An, the CTMO has instituted significant changes to improve right holders' ability to protect and enforce their trademarks in China. The CTMO's website, <http://www.ctmo.gov.cn>, serves as a comprehensive public resource of information about protecting trademarks in China, with links to the trademark examination guidelines and to the online trademark search database.

We continue to work with the CTMO to further these advances and, in particular, to support the CTMO in realizing its vision to streamline operations and improve pendency by implementing the latest technological advancements. Together, the CTMO and the USPTO have agreed to take steps, including the development and exchange of informational brochures, to help smaller businesses better understand how to protect their marks in our respective countries. This project, initiated by Director General An, is designed in large part to encourage Chinese companies to consult the USPTO online trademark search database and apply to register their marks as China develops more international brands. At the same time, it would help U.S. enterprises understand the laws and procedures relating to trademark registration and protection in China.

On behalf of all the Trademark Office employees at the USPTO, we look forward to working with the CTMO on these and other important efforts to advance intellectual property rights protection for all.



Jon W. Dudas

Contents

Chapter 1200

Substantive Examination of Applications

1201 Ownership of Mark	2
1201.01 Claim of Ownership May Be Based on Use By Related Companies	4
1201.02 Identifying the Applicant in the Application	6
1201.02(a) Identifying the Applicant Properly	6
1201.02(b) Application Void if Wrong Party Identified as the Applicant	6
1201.02(c) Correcting Errors in How the Applicant Is Identified [R-1]	8
1201.02(d) Operating Divisions	12
1201.02(e) Changes in Ownership After Application Is Filed	14
1201.03 Use by Related Companies	14
1201.03(a) Use Solely by Related Company Must be Disclosed	16
1201.03(b) No Explanation of Applicant's Control Over Use of Mark by Related Companies Required	18
1201.03(c) Wholly Owned Related Companies	20
1201.03(d) Common Stockholders, Directors or Officers	20
1201.03(e) Sister Corporations	22
1201.03(f) License and Franchise Situations	24
1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record	26
1201.05 Acceptable Claim of Ownership Based on Applicant's Own Use	28
1201.06 Special Situations Pertaining to Ownership	28
1201.06(a) Applicant Is Merely Distributor or Importer	28
1201.06(b) Goods Manufactured in a Country Other than Where	