

Have You Trademarked Your Chinese Name? Trademark and Chinese Translation of Foreign Names in China

The 9th IP Seminar
Global Competitiveness & Business Value
Through Innovation

Jyh-An Lee

Faculty of Law

The Chinese University of Hong Kong

August 5, 2017

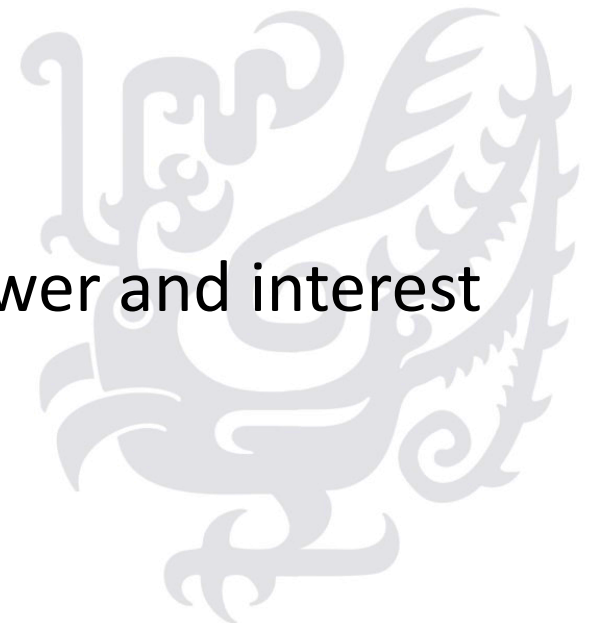
✓ Introduction

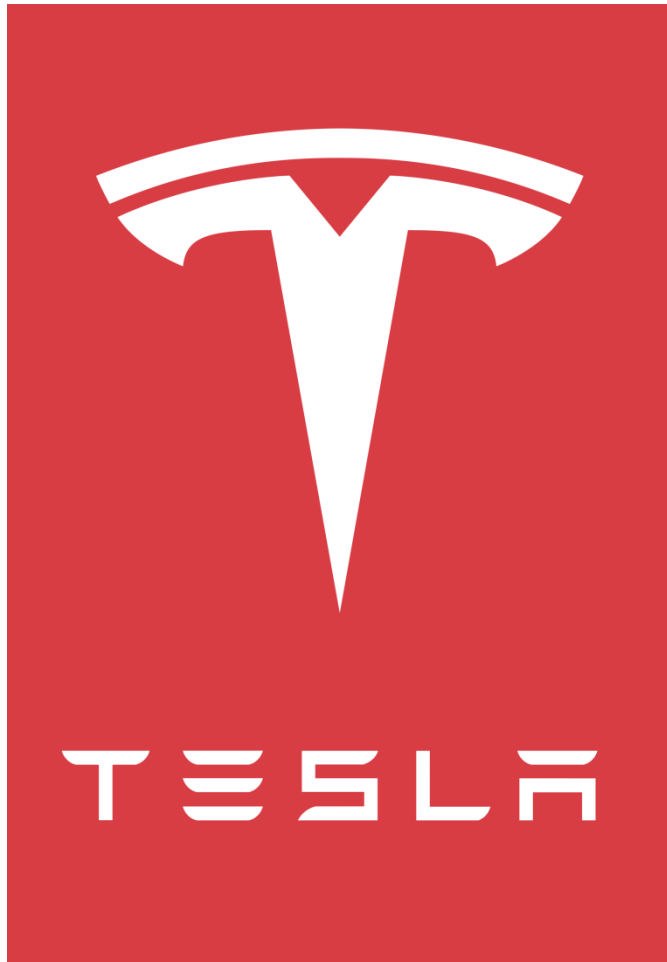
- TM Translation into Chinese
- Cases Studies
- Legal Analysis
- Conclusion



Translation of Foreign Marks

- The importance of local name in market entry
 - marketing strategy
 - advertisement resources allocation
 - corporate identity
 - Trademark issues
- China
 - Consumers' expanding buying power and interest in foreign products





- Both English and Chinese TMs as well as DN were registered in China by Zhang Baosheng 2006
- Zhang sued Tesla for TM infringement in 2014
- Settled in 2014 with undisclosed terms



- Donald Trump's Chinese Trademark:
 - 川普 (Chuanpu)
 - 唐纳德 川普(Tangnade Chuanpu)
 - 特朗普(Telangpu)
 - 唐納德 特朗普 (Tangnade Telangpu)

序号	申请号/注册号	类号	商标名称	申请人名称	商
1	19643022	36	川普	唐纳·川普	查
2	19643047	42	DONALD TRUMP	唐纳·川普	查
3	19643012	42	特朗普	唐纳·川普	查
4	19643011	43	特朗普	唐纳·川普	查
5	19643049	37	DONALD TRUMP	唐纳·川普	查
6	19643024	44	TRUMP	唐纳·川普	查
7	19643048	41	DONALD TRUMP	唐纳·川普	查
8	19643027	41	TRUMP	唐纳·川普	查
9	19643026	42	TRUMP	唐纳·川普	查
10	19643031	44	唐纳德·川普	唐纳·川普	查
11	19643028	37	TRUMP	唐纳·川普	查
12	19643046	44	DONALD TRUMP	唐纳·川普	查
13	19643030	35	TRUMP	唐纳·川普	查
14	19643029	36	TRUMP	唐纳·川普	查
15	19643035	37	唐纳德·川普	唐纳·川普	查
16	19643037	35	唐纳德·川普	唐纳·川普	查
17	19643044	35	唐纳德·特朗普	唐纳·川普	查
18	19643023	35	川普	唐纳·川普	查
19	19643043	36	唐纳德·特朗普	唐纳·川普	查
20	19643034	41	唐纳德·川普	唐纳·川普	查
21	19643032	43	唐纳德·川普	唐纳·川普	查
22	19643041	41	唐纳德·特朗普	唐纳·川普	查
23	19643013	41	特朗普	唐纳·川普	查
24	19643039	43	唐纳德·特朗普	唐纳·川普	查
25	19643051	35	DONALD TRUMP	唐纳·川普	查
26	19643021	37	川普	唐纳·川普	查
27	19643016	35	特朗普	唐纳·川普	查
28	19643020	41	川普	唐纳·川普	查
29	19643036	36	唐纳德·川普	唐纳·川普	查
30	19643038	44	唐纳德·特朗普	唐纳·川普	查
31	19643045	43	DONALD TRUMP	唐纳·川普	查
32	19643019	42	川普	唐纳·川普	查
33	19643050	36	DONALD TRUMP	唐纳·川普	查
34	19643010	44	特朗普	唐纳·川普	查
35	19643040	42	唐纳德·特朗普	唐纳·川普	查
36	19643025	43	TRUMP	唐纳·川普	查
37	19643018	43	川普	唐纳·川普	查
38	19643014	37	特朗普	唐纳·川普	查
39	19643015	36	特朗普	唐纳·川普	查
40	19643042	37	唐纳德·特朗普	唐纳·川普	查
41	19643033	42	唐纳德·川普	唐纳·川普	查

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- ✓ **TM Translation into Chinese**
- Cases Studies
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TM Translation into Chinese

- ✓ Phonetic Translation
- Semantic Translation
- Phonosemantic Translation



Phonetic Translation

- Using Chinese characters with similar pronunciation as that of the original foreign brand names.
- Examples:
 - Suoni (索尼) for Sony
 - Maidanglao (麦当劳) for McDonald's

SONY



TM Translation into Chinese

- Phonetic Translation
- ✓ Semantic Translation
- Phonosemantic Translation



Semantic Translation

- Literal translation of the foreign mark based on its meaning
- Chinese pronunciation will be different from its original one
- Examples
 - Pinguo (苹果) for Apple (computer)
 - Kepai (壳牌) for Shell (Oil Company)



TM Translation into Chinese

- Phonetic Translation
- Semantic Translation
- ✓ Phonosemantic Translation



Phonosemantic Translation

- Phonetic-conceptual method is the most desirable method for trademark translation
- Examples:
 - KeKou Kele (可口可樂) for Coke-Cola, means “delicious and delightful” in Chinese
 - Duufen (多芬) for Dove soap, means “much fragrance” in Chinese



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Case Studies

✓ Michael Jordan Case

- New Balance Case
- Viagra Case



Michael Jordan Case

- Qiodan Sports was granted the Qiaodan (乔丹) trademark, the Chinese translation of Jordan, for “sneakers and sportswear” in 2001
- The Qiodan trademark was recognized as “well-known trademark” by the Trademark office in 2003



Michael Jordan Case



- Michael Jordan sued Trademark Review and Adjudication Board (TRAB) to cancel the trademark registration, but lost the case in the 1st and 2nd instances
- The Supreme People's Court (SPC) decided on Dec. 7, 2016 that the subject trademark should be cancelled because it has infringed Jordan's name right, a prior right protected by Art. 31 of the PRC Trademark Law

Case Studies

- Michael Jordan Case
- ✓ New Balance Case
- Viagra Case



New Balance Case

- Xin Bailun(新百伦) is one of the Chinese Translations of “New Balance”
 - “Xin”(新) is the semantic translation of “New”
 - “Bailun”(百伦) is the phonetic translation of “Balance”



New Balance Case

- Lelun Zhou
 - obtained the trademark “Bailun” ”(百伦) for “clothes, shoes, hats, and socks” from a transaction made in 2004
 - Applied to register the trademark “Xin Bailun”(新百伦) for “shoes (footwear), boot, slipper, t-shirt, clothes, leather jacket, socks, tie, belt, and sportswear”, which was approved by the Trademark Office in 2008

商标名称	百伦	注册号/申请号	865609
国际分类号	25	申请日期	
申请人名称(中文)	周乐伦 查看TA所有商标 	申请人地址(中文)	广州市珠江新城临江大道海滨花园厚德轩7楼C座
申请人名称(英文)		申请人地址(英文)	
商标图像		类似群	2501 2507 2508 2509
		商品服务列表	服装, 鞋, 帽, 袜

New Balance Case

- New Balance has used few Chinese translations of its mark, including
 - Xin Pingheng (新平衡 semantic)
 - Niubalun (纽巴伦 phonetic)
 - Xin Bailun (新百伦 combination of semantic and phonetic)

国际分类	25	法律状态	已注册	初审公告	1090/761
注册号	4100879	商标中文	新百伦	商标拼音	
商标英文		商标字头		商标数字	
申请日期	2004-06-04	初审日期	2007-10-07	注册日期	2008-01-07
商标类型	普通	注册公告	1102/2262	截止日期	2018-01-06
商标流程	撤销连续三年	是否可售		预售价格	
注册人	周乐伦				全类检索
原注册人					
注册地址	广东省广州市天河区华穗路263号11楼[2015.09.27 第1473期变]				
代理组织					全类检索
使用商品	鞋(脚上的穿着物), 靴, 拖鞋, T恤衫, 服装, 皮衣, 袜, 领带, 皮带(服饰用), 运动衫				

新百伦

New Balance Case

- New Balance widely used “Xin Bailun” in its advertisement, product, brochure, etc, and was sued by Lelun Zhou for trademark infringement
- New Balance claimed that “Xin Bailun” was its business name, and it only used for advertisement, not used on the products
- The Guangdong High Court ruled against New Balance on June 16, 2016 for RMB\$500 million



Case Studies

- Michael Jordan Case
- New Balance Case
- ✓ Viagra Case



Viagra Case

- Pfizer's Trademark in Taiwan: Mighty & Strong as Steel (威而钢)
 - This mark was deemed to contain sexually explicit connotations, therefore, not allowed by the Chinese authorities.
- Pfizer registered Wan-Ai-Ke (万艾可) for Viagra trademark in China, which turned out to be a marketing mistake



Viagra Case



- The term, meaning “Great Elder Brother,” first appeared in World Journal on 30 April, 1998
- Weige (伟哥)
 - 伟 means “great,” “grand,” or “competent”
 - 哥
 - Elder brother
 - Chinese often use this word at the end of someone’s name as a gesture of affection and respect
- The term Weige (伟哥) was well received because
 - The subtlety of its implication of a wonderful sex life
 - Its in line with conservative Chinese attitudes towards sex

Viagra Case

- Apr. 30, 1998, World Journal (世界日報)
- May 20, 1998, Guangzhou Viamen (威尔曼药业公司) applied for trademark registration, and other related marks, such as “Great Elder Sister,” “Great Man,” and “Great Lady”
- May 29, 1998, Pfizer applied for 偉哥 trademark in Hong Kong
- Aug. 12, 1998, Pfizer applied for 伟哥 trademark with SIPO, China

- Guangzhou Viamen (威尔曼药业公司) was granted the “伟哥” trademark in 2002
 - It's estimated Pfizer suffered a big loss in brand equity between US\$85 million to US\$120 millions



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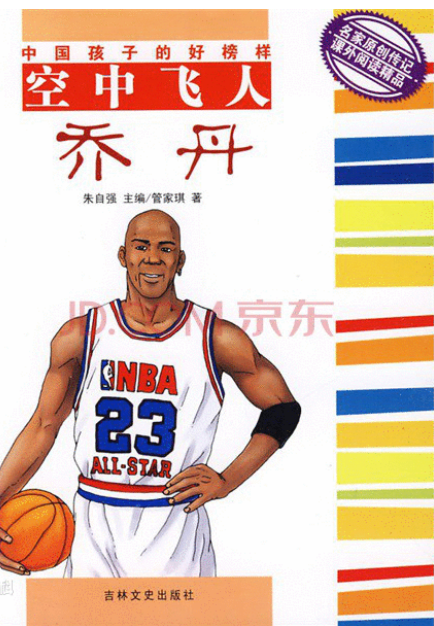


Analysis

- Media's use of the Chinese name to refer the foreign mark

– Jordan

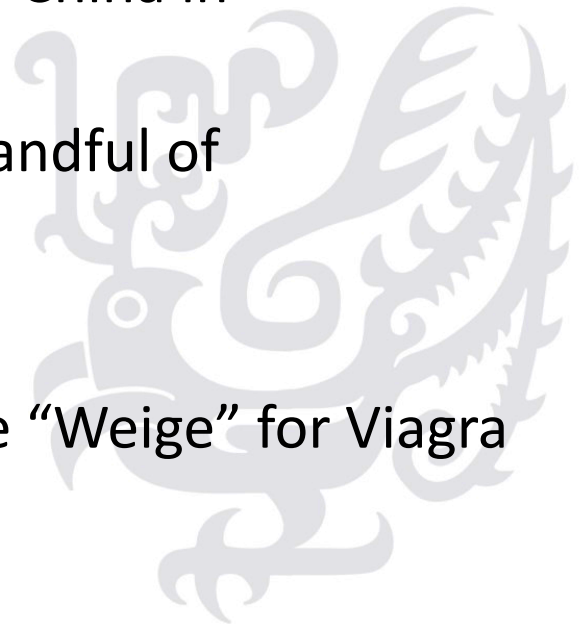
- 282 articles in mainstream newspapers (such as Renmin Ribao) from 1984 to 2010
- 1,376 articles in periodicals from 1985 to 2012
- 14 books from 1984 to 2011
- Mainstream websites such as QQ (腾讯网), ChinaNews (中国新闻网), Shanghai Online (上海热线), China Daily (中国日报网)





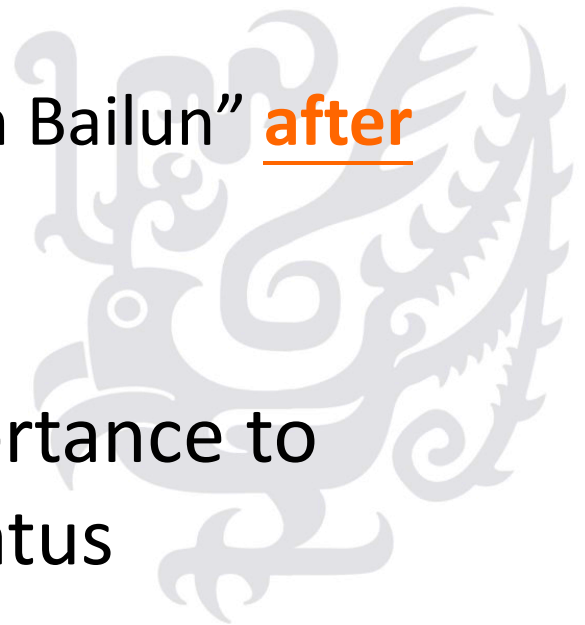
Analysis

- Media's use of the Chinese name to refer the foreign mark
 - New Balance
 - Yes, when New Balance entered into China in November 2003
 - The Guangdong High Court: Just a handful of nonmainstream media report
 - Viagra
 - World Journal first created the name “Weige” for Viagra



Analysis

- Did the foreign mark owner use the subject Chinese name before domestic party's registration?
 - Michael Jordan: **No**
 - New Balance: **No**
 - New Balance use the mark “Xin Bailun” after registration
 - Viagra: **No**
- Use of the mark is of great importance to establish “**well-known mark**” status



Analysis



- Bad faith registration

- Qiodan: ✓

- Registrant changed its name to Qiodan in 2000 when Michael Jordan is publicly known as Qiodan
 - Registrant also applied to register other Jordan related names, such as “Jiefuli Jordan” and “Makusi Jordan”
 - Registrant explained that Qiodan in Chinese means “flora in the south”, “thing of beauty”, or “beatiful willingness”
 - Prospectus

Analysis

- Bad faith registration

- Xin Bailun: **X**

- The Zhou family applied to register “Bailun” in 1994, much earlier than New Balance’s entrance into the Chinese market
- Zou applied to register “Xin Bailun” in 2004. “Xin” is a reasonable addition.
 - Despite of the fact that New Balance entered into the Chinese market in November 2003

商标的详细信息			
打印		关闭	
注册/申请号	4100879	国际分类号	25
申请日期	2004年06月04日		
申请人名称(中文)	周乐伦	申请人地址(中文)	广东省广州市天河区华穗路263号11楼
申请人名称(英文)		申请人地址(英文)	
商 标 图 像		商 品 / 服 务 列 表	类 似 群
初审公告号	1090	注册公告号	1102
初审公告日期	2007年10月07日	注册公告日期	2008年01月07日
专用期限	2008年01月07日 - 2018年01月06日		
国际注册日期		后期指定日期	
优先权日期		代理人名称	一般
颜色组合		商标类型	一般
是否共有商标	否		

Analysis



- Why only Michael Jordan won the case?
 - Art. 31 of PRC Trademark Law
 - “No applicant for trademark application may infringe upon another party’s prior right...”
 - Prior rights include: “[the] right[s] on a trade name, copyright, design patent, name right, and portrait right”. (Trademark Adjudication Standard (TAS) promulgated jointly by CTMO and TRAB, 2009)

Analysis

- Michael Jordan owns the name right of “Qiaodan”
- Only natural persons (individuals) can claim name right (GPCL §99, Tort Liability Law §2)



Analysis



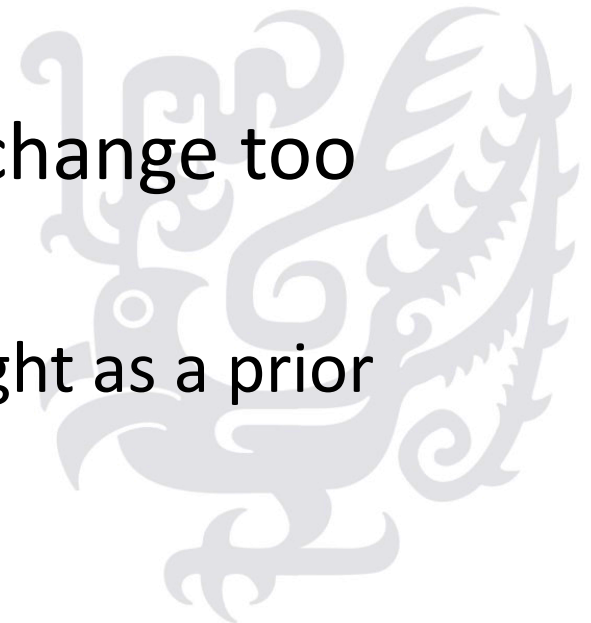
- Under what circumstances can a foreign party claim name right for the Chinese name?
 - The Chinese name is well known by the relevant public
 - the relevant public use the Chinese name to refer to that specific natural person
 - There is a stable corresponding relations between the Chinese name and the specific natural person
- Does it mean the MNEs start to be well protected for their unused Chinese name?

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Conclusion

- Timing and Branding Strategy in China
- Unregistered Well-known Trademarks
 - Difficulty: most foreign mark owners had not used the Chinese name before they were registered by domestic parties
- Michael Jordan case does NOT change too much
 - Enterprises cannot claim name right as a prior right





Thank You
== For Your Attention ==

