

## Protecting Name Rights of Foreigners under Trademark Law in China

Registering a foreign celebrity's name as a trademark has been frequently seen in China for a shortcut to occupy the market, from Leonardo da Vinci and Air Jordan in the past to the present Jeremy Lin and Taylor Swift. Can a name right be protected?

Article 32 of the Trademark Law of the People's Republic of China (the "Trademark Law") provides "that the application for trademark registration shall not damage others' existing earlier rights," which, in fact, covers the protection of name rights. Although the name rights of foreigners have not been specified in the Chinese General Principles of the Civil Law, Chinese courts, in practice, have been enforcing them.

This short article lays out, together with case briefs, certain requirements to assert prior name rights against later registrations of trademarks, and provides a general guide and practical tips.

### I. Requirements To Assert Prior Name Rights Against Later Registrations

#### 1. *The disputed mark is the same as the name of a natural person*

In the Examination Criteria for Trademark

Review and Adjudication, it is explicitly stated that the person is a living natural person, which has been supported by court rulings. For example, in an administrative litigation of reviewing the opposition decision with regard to the No. 3106951 trademark, the court clearly pointed out that, "[t]he right of name is to protect the right of a living natural person. In view that Canadian famous hockey player Tim Horton involved in this case has passed away, the claim filed by TDL Group Co., Ltd. asserting that the opposed trademark infringes Tim Horton's name right is not tenable."<sup>i</sup>

Further, the name of a natural person includes both his/her foreign name with Latin letters and the translated name with Chinese characters, provided that the translated name is related to the owner of name right in the knowledge of relevant public. For example, in the "乔丹" (Jordan in Chinese) case, Beijing High People's Court held that, "the 'Michael Jordan' is translated into '迈克尔·乔丹', but the "乔丹" in the opposed trademark is not uniquely corresponding to 'Michael Jordan.' In addition, "Jordan" is not a given name but a common surname of American people. Therefore, the

existing evidence is not sufficient to prove that ‘乔丹’ is definitely related to ‘Michael Jordan’ nor ‘迈克尔·乔丹’, and thus, Michael Jordan’s claim that the opposed trademark damages his name right lacks sufficient basis.”<sup>ii</sup>

The above holding also elaborated the requirement of the sameness, *i.e.*, the disputed mark shall be the same as the name of a natural person and be grounded on the person’s name right. While the translated name is different from the foreign name in form, uniqueness and one-to-one correspondence is required. The Michael Jordan’s claim fell short on this requirement.

2. *The registration/use of the disputed mark has caused or may cause damage to the name right of a natural person*

A factor to be considered as to the damage to the name right is the fame of the natural person, while the fame is not a prerequisite for protection of name right. *See* a Guide issued by Beijing High People’s Court concerning the Trials of Administration Cases of Trademark Authorization and Confirmation, which furthers that “but the fame may be a factor to be considered when determining whether the relevant public regards a certain name as having a corresponding relationship with a specific natural person.” In the

trademark dispute case concerning the trademark “布兰妮 (Britney in Chinese) Britney” No. 1713409, the court maintained the registration of the disputed mark reasoning that, “the existing evidence is not sufficient to prove that the plaintiff’s name “BRITNEY SPEARS” or its Chinese translation “布兰尼·斯比尔斯” is well-known to Chinese relevant public in mainland China, nor to prove a unique correspondence is established between “Britney” or “布兰妮” and the plaintiff’s name in the knowledge of Chinese relevant public before the application date of the opposed trademark, and thus, the plaintiff’s claim [*i.e.*, damages to the prior name right of Britney] will not be upheld”.<sup>iii</sup>

Another factor is the bad faith of the trademark squatters, who deliberately registered the mark of a natural person to undermine the corresponding relationship between the related symbols and the true name right owner, which has caused or may cause damage to the interest of the name right owner. For example, in the administrative dispute with regard to the trademark “KATE MOSS 凯特·苔藓 (Kate Moss in Chinese)” with No. 3271558, the court considered that, “in condition that the plaintiff does not give logical explanation why adopting the phrase in the disputed trademark, the court, by taking into consideration that the applicant of the

disputed trademark is an operator of the clothing industry and has higher knowledge on this industry than common public, and KATE MOSS has ever acted as the spokesman of Ports brand clothing in spring and summer of 2002, holds that the plaintiff's use of the disputed trademark on the goods such as clothing in Class 25 is of the purpose of making profit by unfairly using the name "KATE MOSS". Therefore, the registration and use of the disputed trademark have damaged the name right of KATE MOSS.<sup>iv</sup>

Others factors, such as the originality of the name, the correlation between the designated goods/services and the fields in which the natural person is involved, and confusion and misidentification among consumers, would be considered by courts.

### *3. The asserted party shall be the name right owner or an authorized person*

Generally, the name right shall be claimed by the owner. However, in practices, considering the circumstance of authorizing the use to others, and combining with the provisions of Article 41 of the Trademark Law, an authorized person may also claim the right of personal name as the interested party. In practice, it is also very common that the owner of the right of name entrusts others to claim the right. For example, in reviewing the

opposition decision with regard to the trademark "LADYGAGA" No. 7636714, ATE MY HEART INC. claimed that the opposed trademark infringed the name right of Ms. Lady Gaga, an American popular singer and composer. In that case, ATE MY HEART INC. submitted an affidavit from Ms. Lady Gaga stating that it's her true intention to authorize ATE MY HEART INC. to lodge this case. The Trademark Review and Adjudication Board ascertained the authenticity of this statement, and accepted ATE MY HEART INC. to lodge this case in its own name.<sup>v</sup>

## **II. General Guide and Practical Tips**

In summary, to assert a prior name right of a foreigner against later registration of a mark according to Article 32 of the Trademark Law, the party needs to meet the burden of proof regarding (1) whether the disputed mark is identical to the foreigner's name; (2) whether the name right owner has certain popularity among relevant public in China before the application date of the trademark; (3) whether the use of trademark has caused or may cause damages to the right name owner; (4) whether the party is the owner or has obtained the authorization and license from the owner.

In practice, ambiguities exist when determining damages to the right name owner.

From the above Kate Moss case, the court ruled damages existed on the ground that the disputed mark unfairly registered in the Class 25 for clothing from a point of view of infringement and unfair competition. Nevertheless, the provision in Article 32 of the Trademark Law should have a broader construction of damages, which, we believe, exist as long as a confusingly similar mark is likely to undermine the corresponding relationship between the related symbols and the true name right owner, and therefore damage the interest of the owner and cause confusion among consumers. Moreover, if the name of a natural person has been used in business which helps

consumers identify the particular product or service, the natural person may assert his/her right relying on another provision in Article 32 for the protection of unregistered trademarks.

More in practice, when judging the conflict between name right and the trademark right, we need to balance between the rights and interests of the owner (when relevant public associate the goods bearing the trademark at issue with the right name owner) and the interests of the public (when the protection scope of the right of name is excessively expanded to the extent of the abuse of the name right).

*The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here. For further information, please contact one of the attorneys listed below. General e-mail messages may be sent using [ltbj@lungtin.com](mailto:ltbj@lungtin.com) which also can be found at [www.lungtin.com](http://www.lungtin.com).*

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<sup>i</sup>(2010) Yi Zhong Zhi Xing Chu Zi No. 2772

<sup>ii</sup>(2015) Gao Xing (Zhi) Zhong Zi No. 1577

<sup>iii</sup>(2010) Yi Zhong Zhi Xing Chu Zi No. 1861

<sup>iv</sup>(2011) Gao Xing Zhong Zi No. 723

<sup>v</sup>Shang Ping Zi [2014] No. 031736