

“乔丹/QIAODAN” NAME RIGHT INFRINGEMENT CASE IN CHINA MICHAEL JORDAN VS QIAODAN SPORTS

BACKGROUND

Qiaodan Sports is a Chinese manufacturer of sports products and apparel (“Qiaodan Sports”), founded in 1984. It filed several trademark applications for “乔丹” (QIAO DAN in Chinese characters) and “QIAO DAN” in class 25 which were approved for registration in 1998 and 1999 respectively. It also filed trademark applications for “” in 1999, which were approved for registration in 2001. At present, it has registered more than a hundred trademarks for “QIAO DAN”/“乔丹”/“”.

Michael Jordan, the former NBA superstar (“Jordan”), is widely recognized as “QIAO DAN” (being a transliteration of “Jordan”) in China. Qiaodan Sports used “QIAO DAN” as its trademark and trade name, which misled the public that there is some relationship between Michael Jordan and Qiaodan Sports, or that the use of the trademark and trade name by Qiaodan Sports is authorized by Jordan. A market survey in Shanghai shows that 90% of 400 local people believed that Qiaodan Sports was Jordan's brand.

In February 2012, Jordan sued Qiaodan for name right infringement with the Court of Haidian District of Beijing. However, the case was rejected, since the Court held the view that the surname of “Jordan” is a common surname in the USA, is not unique, and there is not an exclusively relationship between “QIAO DAN” and “Michael Jordan”.

Subsequently, Jordan filed a lawsuit with the Second Intermediate Court of Shanghai, which was accepted on 6 March 2012. Jordan claimed that Qiaodan Sports infringed upon his name right. At present, the court hearing has not yet been held.

RELEVANT LAWS GOVERNING THE PROTECTION OF NAME RIGHT IN CHINA

- 1) Under Article 99 of the Civil Law, “Citizens shall enjoy the right of his personal name and shall be entitled to determine, use or change their personal names in accordance with relevant provisions”.
- 2) Under Article 31 of the Trademark Law, “No trademark application shall prejudice another person’s existing prior rights and unfair means shall not be used to preempt the registration of the reputable trademark of another”. In this case, “prior rights” refers to rights apart from trademark rights, such as trade name right, copyright, rights to the name of a natural person, etc.
- 3) Under Article 5(3) of the Anti-Unfair Competition Law, a business operator should not adopt unfair means in their business transactions so as to damage their competitors. This can include using the name of another individual, and causing confusion.

However, in this case, Qiaodan Sports only adopted the Chinese transliteration of the surname of Michael Jordan. If Jordan sued Qiaodan Sports, he should provide evidence to prove that there is an exclusive relationship between “Michael Jordan” and “QIAO DAN” or “QIAO DAN in Chinese characters”, which caused confusion among the consumers.

CANCELLATION ACTIONS AGAINST A REGISTERED MARK IN CHINA

In China, actions for cancellation of a registered mark should be filed with the China Trademark Office (“CTMO”) and Trademark Review and Adjudication Board (“TRAB”). After going through these administrative proceedings, if either party disagrees with these decisions, it may file an appeal with the Court.

There are two kinds of cancellation proceedings in China: (1) cancellation based on non-use for three consecutive years and (2) cancellation based on improper registration, which shall be filed within 5 years from date of registration. For bad-faith registrations, the owner of a well-known trademark is not bound by the five-year limitation.

In this case, non-use cancellation is obviously not applicable since Qiaodan Sports has used the mark for over ten years. Furthermore, the marks “QIAO DAN”/ “乔丹”/ “ ” were approved for registration over ten years ago, so cancellation based on improper registration is also not applicable.

As such, Jordan filed an action on infringement against his name right. If he succeeds, the remedies available will be awards of damages, prohibition of use of the marks by Qiaodan Sports, etc., but he will not be able to cancel the registrations.

SIMILAR CASE IN CHINA – “YI JIAN LIAN”

Yi Jian Lian, (“Mr. Yi”) is a very famous basketball star in China. He is widely regarded as China's most promising rising star since Yao Ming. A Chinese enterprise, in Fujiang Province, located in the same area as Qiaodan Sports, registered the mark “ ” in class 25. There is no relationship between Mr. Yi and YI JIAN LIAN Sports.

Mr. Yi filed a cancellation action based on improper registration against this registration. TRAB held that the right to one’s name is one of the prior rights as prescribed in Article 31 of the Trademark Law. However, when deciding whether the trademark in dispute has caused damage to the prior name right of a person, the popularity of the person shall be taken into consideration.

In this case, Mr. Yi was able to provide substantial evidence to establish his popularity in China before the filing date of the mark in dispute, such as the awards that Mr. Yi had obtained in the basketball games. Therefore, TRAB decided that the mark in dispute infringed upon the name right of Mr. Yi, and the mark was cancelled.

YI JIAN LIAN Sports did not agree with the TRAB’s decision, and appealed to the First Intermediate Court of Beijing, then to the Higher Court of Beijing, but failed. The mark “ ” was finally cancelled.

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