



# **Do in Rome as Romans Do?**

**--Trademark practice beyond the Latin alphabet**

**FICPI 16th Open Forum**

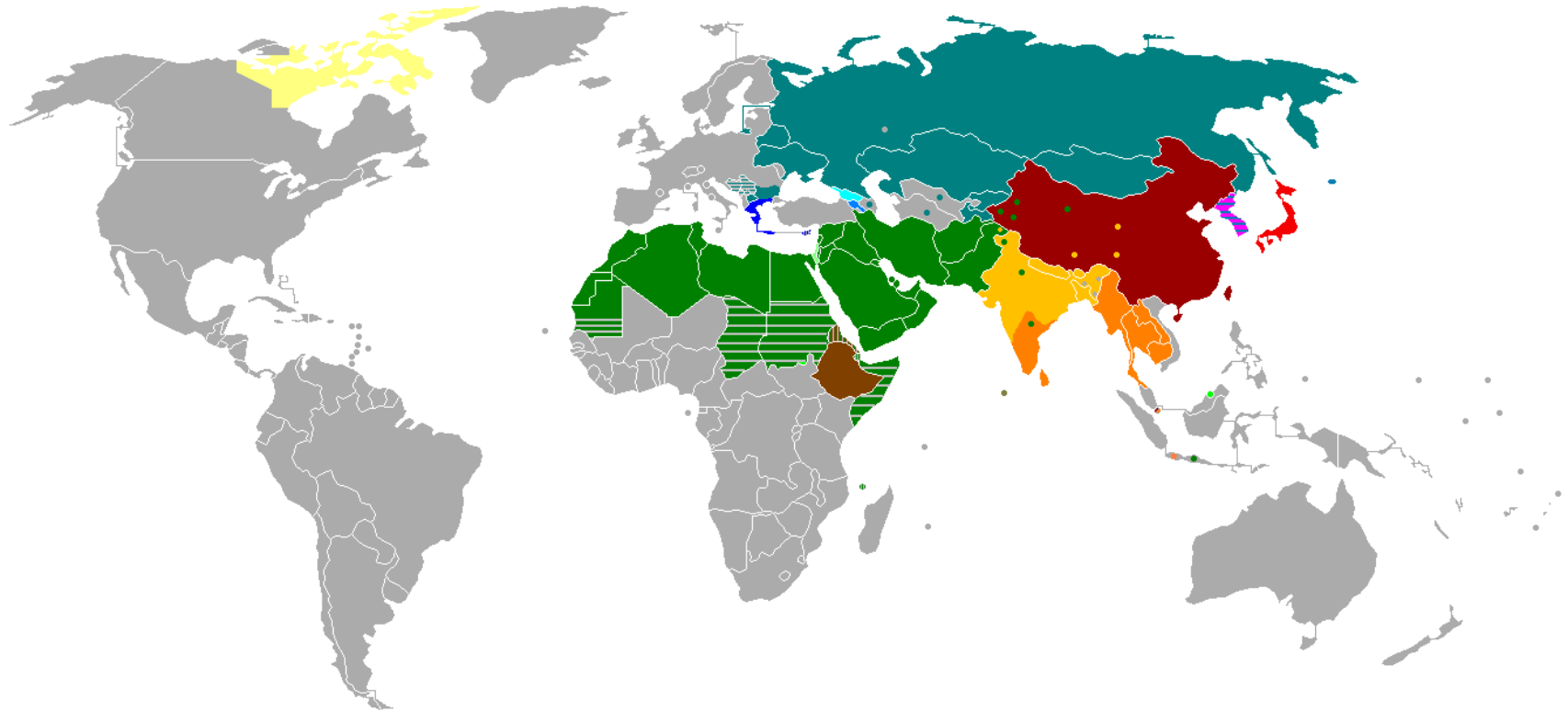
**St. Petersburg, Russia Federation**

**October 6, 2016**



# Panelists

	 <u>Goddag</u>	<b>Mr. Johan Løje</b>		<a href="mailto:jl@iplaw.dk">jl@iplaw.dk</a>
	 Hello	<b>Ms. Leigh A. Walters</b>		<a href="mailto:walters@simip.com">walters@simip.com</a>
	 привет	<b>Mr. Mikhail Mozhaisky</b>		<a href="mailto:mikhail@mozhaisky.com">mikhail@mozhaisky.com</a>
	 Здравейте!	<b>Ms. Elena Miller</b>		<a href="mailto:eb@ptmbojinov.com">eb@ptmbojinov.com</a> <a href="mailto:office@ptmbojinov.com">office@ptmbojinov.com</a>
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Writing systems worldwide. Principal scripts at the national level, with selected regional and minority scripts.

**Alphabets:** Latin, Cyrillic, Georgian, Greek, Armenian **Abjads:** Arabic (Uyghur uses an Arabic-based alphabet, not an abjad), Hebrew and Arabic, Arabic and Neo-Tifinagh (Neo-Tifinagh is an alphabet, not an abjad) **Abugidas:** North Indic, South Indic, Ethiopic, Thaana, Canadian **Syllabic** (Latin alphabet co-official), **Logographic+syllabic:** Pure logographic, Mixed logographic and syllabaries, Featural-alphabet + limited logographic, Featural-alphabet



Coca-Cola®

可口可乐®

蝌蚪啃蜡



bite





# Canasian culinary Culture







# The signature dish 'CANASIAN'





العربية

## Translations vs. Transliterations

한글

Which one to Choose???

日本

漢語  
汉语

ישראל



# Translations

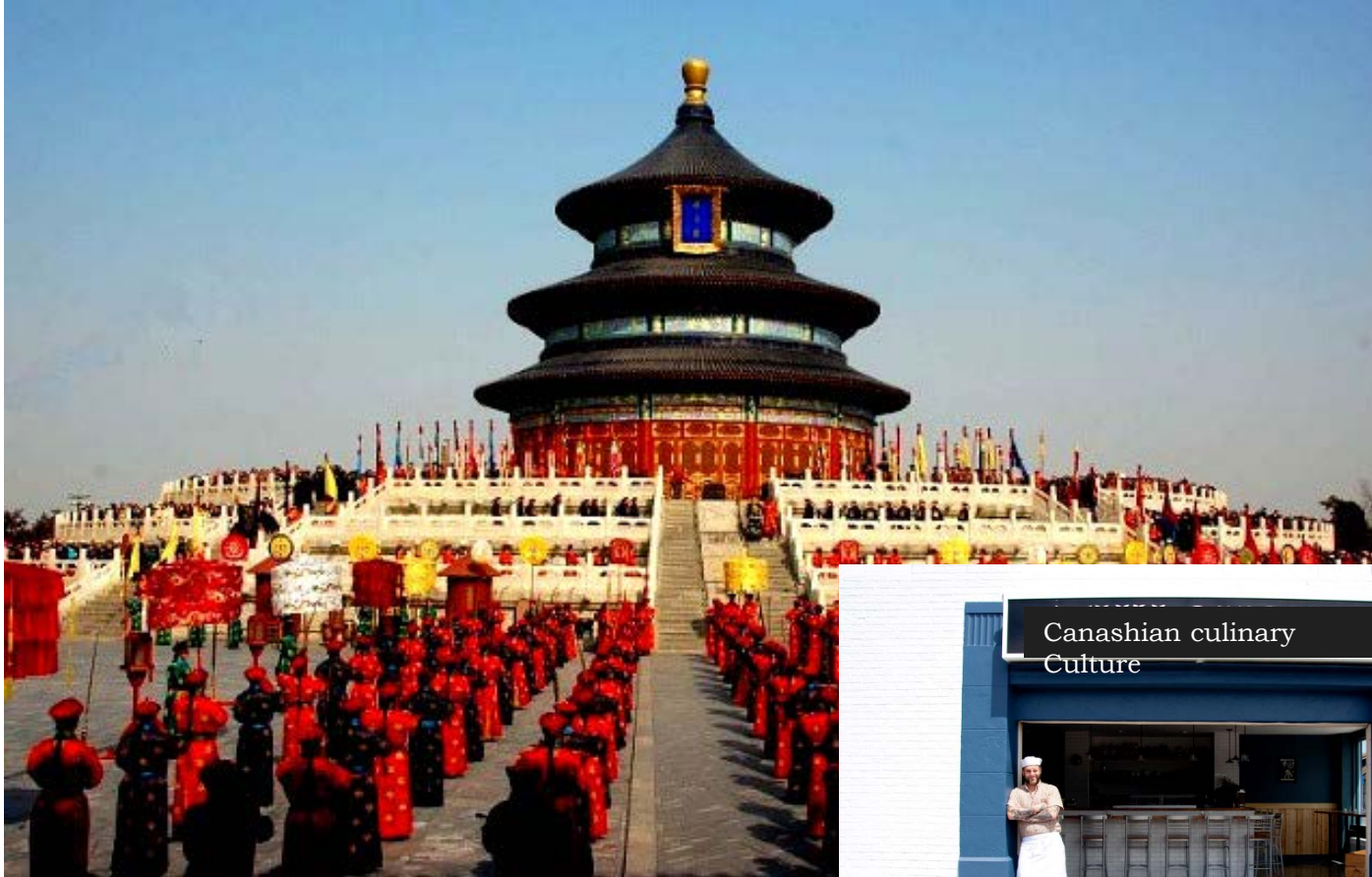
PROS	CONS
Consistent message / meaning in each jurisdiction	May be not available translation if word is a coined word or on not found in the non-roman language characters
Possibly a cheaper project – only requires a single translation and not multiple iterations	Meaning may have negative connotations or no meaning (ex. proverbs /play on words that don't exist in that culture)
No/less need to get buy in from stake holders- with transliterations there may be differences of opinion as to the message to be sent and/or sound of the mark	Length of the mark may be too long – general preference to have character marks to be between 3-5 characters for “core brands”
Translation may be the same/similar in both traditional and simplified characters in Chinese	





# Transliterations

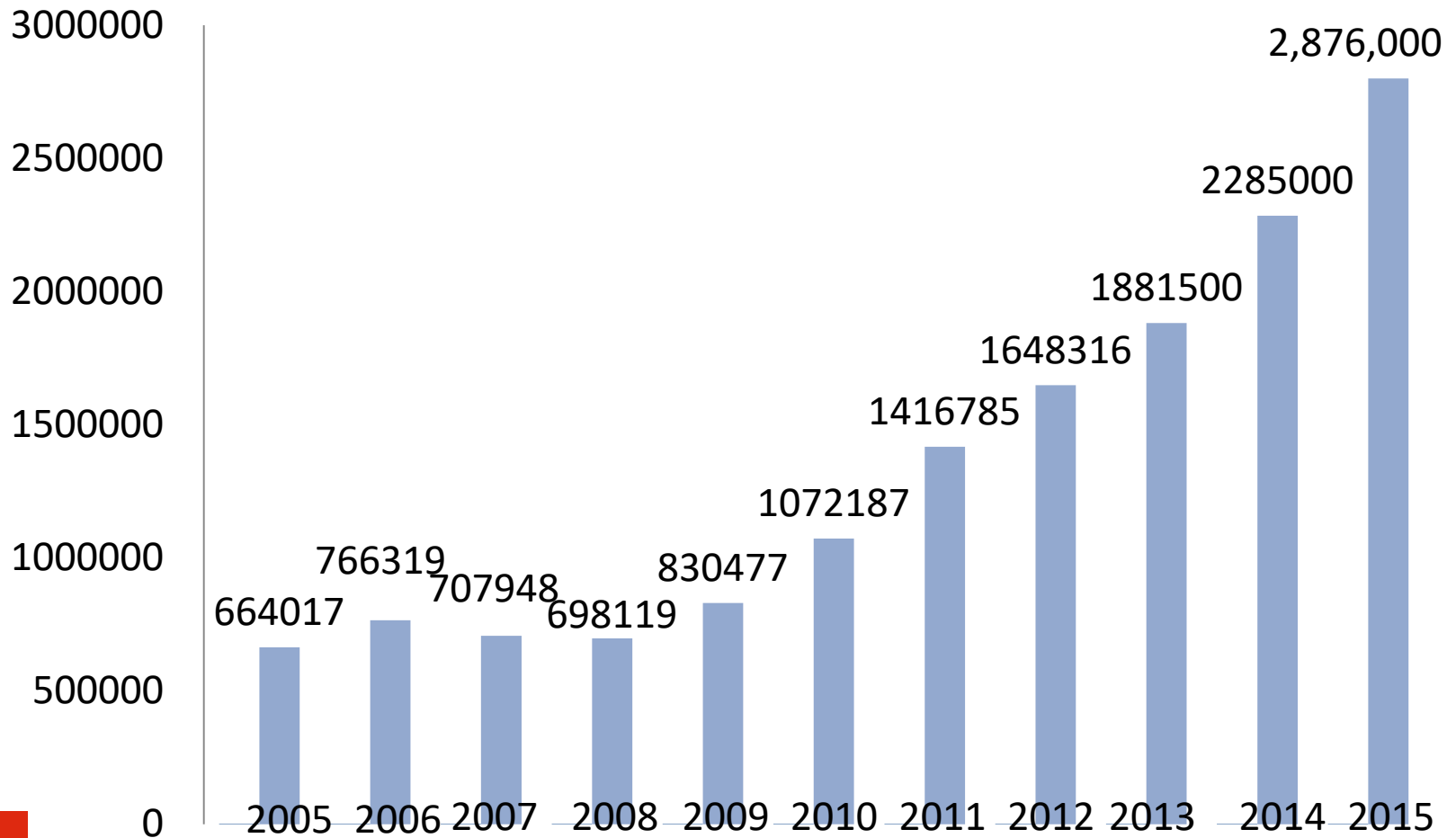
PROS	CONS
Mark will have a similar sound to roman alphabet mark – may assist with developing international reputation	Mark may have different meanings across different jurisdictions
Even if a mark is not a straight translation, the “essence” or general meaning of a mark can still be communicated	It may not be possible to create a transliteration that is sufficiently similar in sound to the original mark
Further, there is an opportunity to create a mark that sends a new/positive/commercially appealing message	Your transliteration could be interpreted in different ways by different consumers since the concept can be one of sound over meaning
	For the Chinese language, may not be possible for the mark to be the same in traditional and simplified characters



ACTING FOR THE IP PROFESSION WORLD WIDE

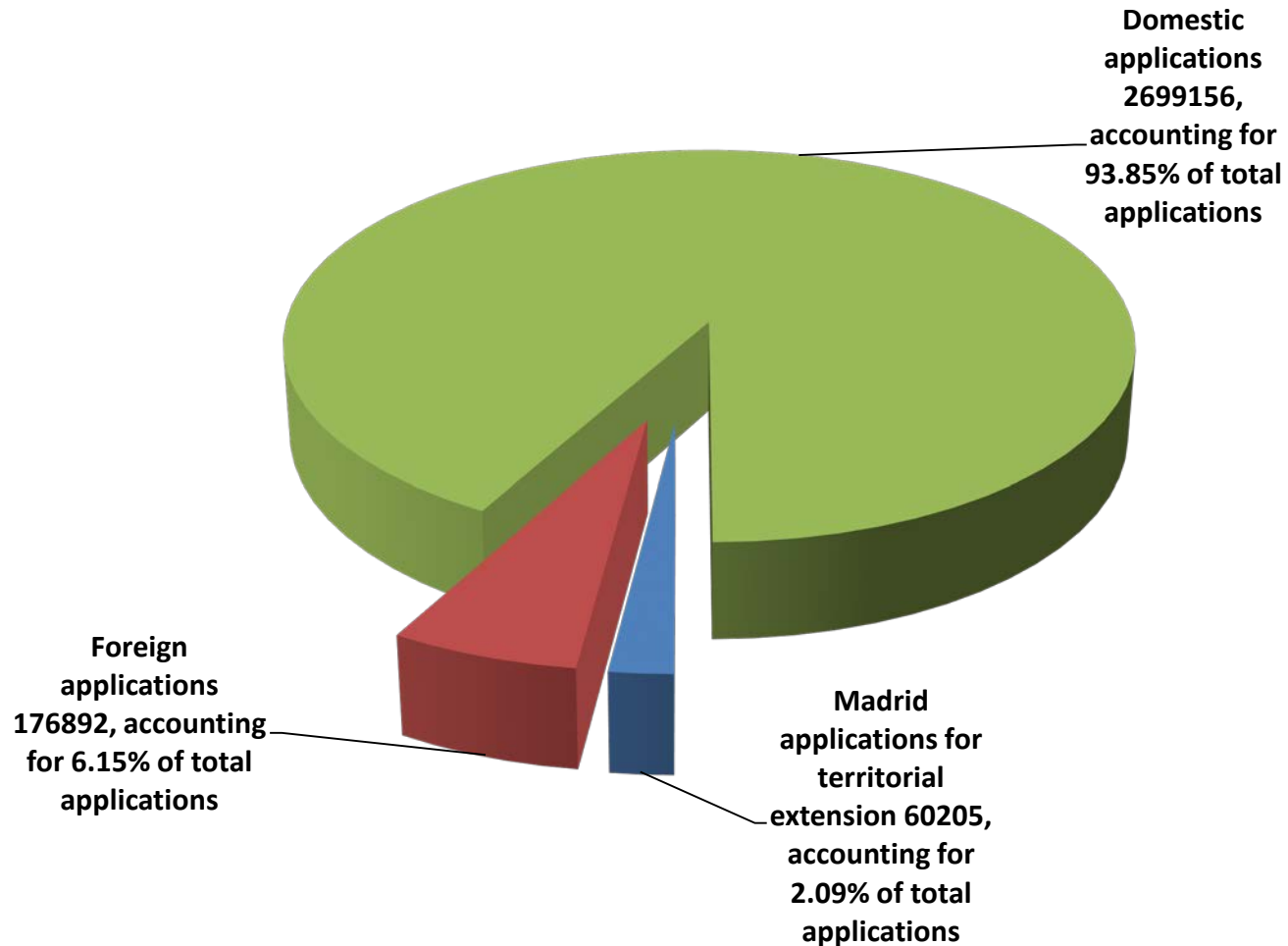


# Trademark Registration Applications before CTO



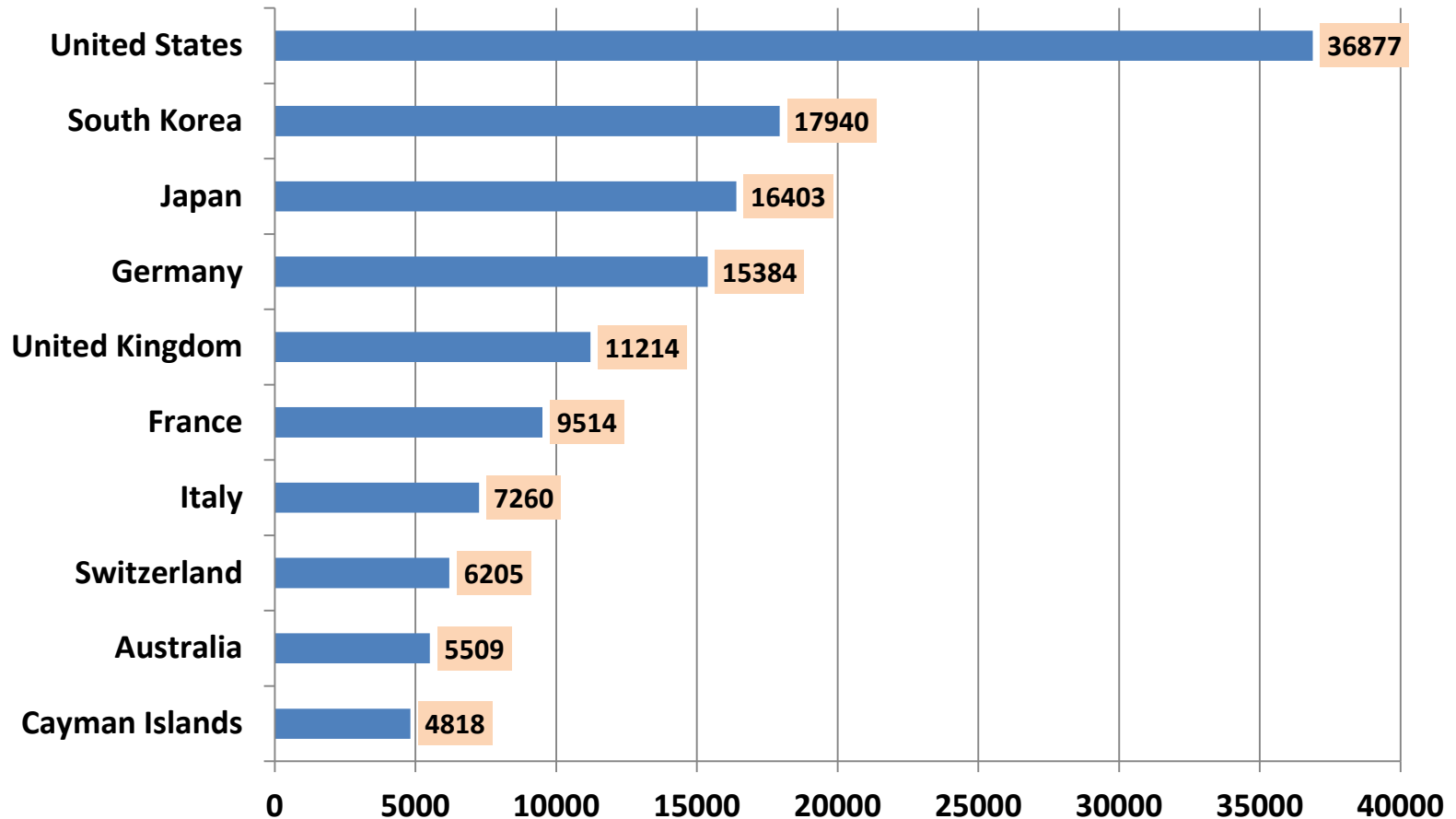


# Chinese TM registration applications filed in 2015





# Top 10 Foreign countries for TM filing in China in 2015



Many of these applicants have problems in creating Chinese character trademarks





## Concerns:

1. Whether it is necessary to create a Chinese character trademark
2. Whether it is necessary to use a Chinese character trademark
3. How to create it
4. What is the protection of it
5. Other concerns
  - (1) Pinyin (phonetic alphabet)
  - (2) Chinese character domain name







# It is important to create and use a Chinese character trademark when doing business in China

Possible exception:

**FACEBOOK**

脸书

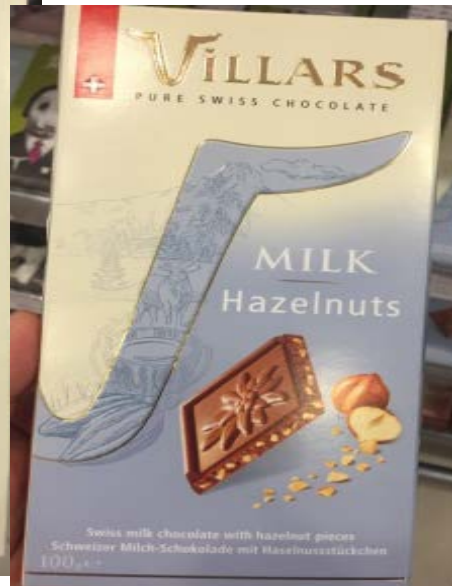
**IBM**





# It is important to create and use a Chinese character trademark when doing business in China

1. One survey in Shanghai shows only 1.6% can speak good English
2. Others may create a Chinese name for you, e.g., Chinese importers
3. If you use but do not register your Chinese character TM, others may register it



愛瑪仕      爱玛仕  
愛馬仕      爱马仕





# EXAMPLES of Chinese character trademarks for some foreign brands





L'ORÉAL  
PARIS

欧莱雅  
L'ORÉAL



百事可乐



感动常在 佳能

Canon  
Delighting You Always

HSBC 滙豐



amazon.com

亚马逊  
amazon.cn



塔塔

Tata

Google  
谷歌

Google



# World top 100 brands and their Chinese names

Ranking	Brand	Ranking	Brand	Ranking	Brand	Ranking	Brand
1	苹果/Apple	26	美国运通/American Express	51	Zara	76	飞利浦/Philips
2	微软/Microsoft	27	吉列/Gillette	52	富国银行/Wells Fargo	77	美国迪尔/John Deere
3	谷歌/Google	28	百事/Pepsi	53	摩根大通/J.P. Morgan	78	安联/Allianz
4	可口可乐/Coca-Cola	29	雀巢咖啡/Nescafe	54	电子港湾/Ebay	79	香奈儿/Chanel
5	IBM	30	万宝路/Marlboro	55	卡夫/Kraft	80	起亚汽车/KIA Motors
6	麦当劳/McDonald's	31	H&M	56	大众/Volkswagen	81	埃克森美孚/Exxon Mobil
7	通用电气/General Electric	32	欧莱雅/L'Oréal	57	卡特彼勒/Caterpillar	82	桑坦德银行/Santander
8	三星/Samsung	33	维萨/Visa	58	寇驰/Coach	83	喜力/Heineken
9	丰田/Toyota	34	汇丰/HSBC	59	汤森路透/Thomson Reuters	84	拉夫·劳伦/Ralph Lauren
10	路易威登/Louis Vuitton	35	娱乐与体育节目电视网/ESPN	60	万事达/MasterCard	85	赛百味/Subway
11	宝马/BMW	36	惠普/Hewlett-Packard	61	星巴克/Starbucks	86	联邦快递/FedEx
12	思科/Cisco	37	西门子/Siemens	62	雪佛兰/Chevrolet	87	加拿大皇家银行/RBC
13	英特尔/Intel	38	奥迪/Audi	63	卡地亚/Cartier	88	Chase
14	迪士尼/Disney	39	古驰/Gucci	64	高露洁/Colgate	89	保时捷/Porsche
15	甲骨文/Oracle	40	宜家/IKEA	65	凯洛格/Kellogg's	90	兰蔻/Lancome
16	美国电话电报/AT&T	41	雀巢咖啡/Nestle	66	壳牌/Shell	91	乐高/LEGO
17	梅赛德斯-奔驰/Mercedes-Benz	42	菲多利/Frito-Lay	67	佳能/Canon	92	爱立信/Ericsson
18	Facebook	43	家得宝/Home Depot	68	日产/Nissan	93	高盛/Goldman Sachs
19	沃尔玛/Wal-Mart	44	联合包裹运送服务/UPS	69	普拉达/Prada	94	博柏利/Burberry
20	本田/Honda	45	福特/Ford	70	阿迪达斯/Adidas	95	雪碧/Sprite
21	耐克/NIKE	46	达能/Danone	71	现代/Hyundai	96	亨氏/Heinz
22	威瑞森/Verizon	47	爱马仕/Hermès	72	劳力士/Rolox	97	波音/Boeing
23	百威/Budweiser	48	福克斯/Fox	73	雷克萨斯/Lexus	98	花旗银行/Citi
24	亚马逊/Amazon.com	49	埃森哲/Accenture	74	红牛/Red Bull	99	MTV全球音乐电视台/MTV
25	思爱普/SAP	50	帮宝适/Pampers	75	美国银行/Bank of America	100	戴尔/Dell







How to create a Chinese character trademark?

**Original TM: CANASIAN CULINARY CULTURE**

**Industry: restaurant**





# Rules of Creating a Chinese Name

1. Transliteration: creating according to the pronunciation
2. Translation: creating according to the meaning
3. Translation & Transliteration: combining both rules
4. Being innovative: creating a Chinese name according to the market's needs without consideration of the original version



## It is not easy to create a good Chinese character trademark

- In 2015, TM filing number in China is 2.876 million.
- by 2015, there are over 10 million valid trademark registrations in China.
- Commonly used Chinese characters are only 3,500 or even less.
- Each Chinese character has meanings and not all of them have good meaning.
- Many Chinese characters share the same pronunciation but look and mean differently and some share the same meaning but look and sound differently.
- It is not good to have a too many Chinese character trademark and 2-4 is preferred.





# How to create a Chinese character trademark?

Original TM: CANASIAN CULINARY CULTURE

Industry: restaurant

- Direct translation:
1. 加拿大亚洲(Canada Asia)烹饪文化
  2. 加拿大亚洲(Canada Asia)厨房文化

		<b>Proposals</b>	<b>Pronunciation</b>	<b>Note</b>
CANASIAN CULTURE	CULINARY	加亚烹饪文化	[driʌ] [ja:] [pɛŋ] [rɛŋ]] [wen] [hwʌ]	
CANASIAN CULTURE	CULINARY	加亚食坊	[driʌ] [ja:] [ʃi:] [fæŋ]	食坊 means “the place to eat”
CANASIAN		加亚	[driʌ] [ja:]	
CANASIAN CULTURE	CULINARY	加纳斯烹饪文化	[driʌ] [na:] [s] [pɛŋ] [rɛŋ]] [wen] [hwʌ]	
CANASIAN CULTURE	CULINARY	加纳斯食坊	[driʌ] [na:] [s] [ʃi:] [fæŋ]	
CANASIAN		加纳斯	[driʌ] [na:] [s]	





## What is the protection of a Chinese character trademark?

Can a Latin letter trademark registration stop others from registering or using the Chinese character trademark?

LOGOS (13634004) ◊	v. ◊	理念 (6658923) ◊
CUCKOO (6171617) ◊	v. ◊	 市谷鸟 (1434885) ◊
超级公园 (14377613) ◊	v. ◊	 (13763146) ◊
 在路上 (16171221) ◊	v. ◊	 (6261102) ◊ 在路上 On The Way (11662673) ◊
暴雪(5112894) ◊	v. ◊	BLIZZARD (3494911) ◊  (1215994) ◊





## What is the protection of a Chinese character trademark?

Can a Chinese character trademark registration stop others from using other Chinese transliteration/translation of the Latin letter trademark?

Bottega Veneta      宝缦嘉  
                                 葆蝶家

Oracle      甲骨文  
                 神谕、先知







## Can a foreign language trademark protect its Chinese version?

### Factors to consider:

- (1) Whether the concerned Chinese version is the unique correspondence to the foreign language trademark
- (2) To what degree the Chinese public know this foreign language
- (3) Whether there is any confusion in the real use





## Other concerns

**(1) Pinyin (phonetic alphabet):** it is worthwhile to register Pinyin of your Chinese character trademark?

沈 shen

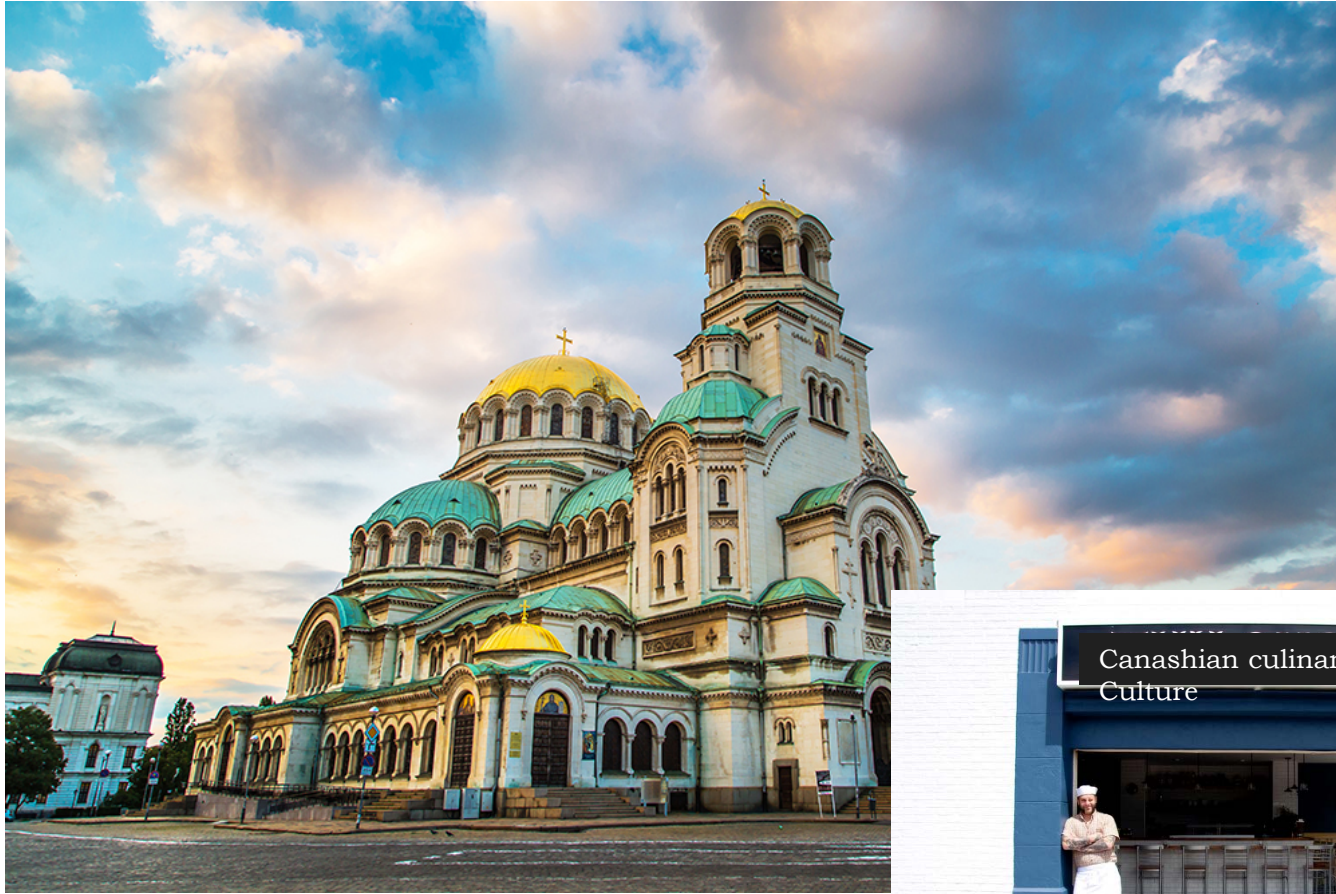
Apple 苹果 Pingguo

**(2) Chinese character domain name**

.中国 (China) .公司 (company) .网络 (internet)

.商标 (TM)(only registered trademark owner can register it)





ACTING FOR THE IP PROFESSION WORLD WIDE



# Bulgaria-Trademarks in Cyrillic

- Bulgaria is a member of the EU as of 2007
- Official language Bulgarian and the Cyrillic alphabet is used
- Cyrillic alphabets are based on the Cyrillic script developed during the First Bulgarian Empire in the 9<sup>th</sup> Century AD by the two brothers Cyril and Methodii
- As of 2011 around 252million people in Eurasia use it as official alphabet





# Bulgarian Alphabet

А а	Б б	В в	Г г	Д д	Е е	Ж ж	З з	И и	Й й
а	бъ	въ	гъ	дъ	е	жъ	зъ	и	и кратко
a	b	v	g	d	e	zh	z	i	y
[a/ɐ]	[b/p]	[v/f]	[g/k]	[d/t]	[ɛ]	[ʒ/ʃ]	[z/s]	[i]	[j]
К к	Л л	М м	Н н	О о	П п	Р р	С с	Т т	У у
къ	лъ	мъ	нъ	о	пъ	ръ	съ	тъ	у
k	l	m	n	o	p	r	s	t	u
[k/g]	[l/t]	[m]	[n]	[ɔ/o]	[p]	[r]	[s/z]	[t/d]	[u/o]
Ф ф	Х х	Ц ц	Ч ч	Ш ш	Щ щ	Ъ ъ	Ь ь	Ю ю	Я я
фъ	хъ	цъ	чъ	шъ	щъ	ер голям	ер малък	ю	я
f	h	ts	ch	sh	sht	a	'	yu	ya
[f]	[x]	[ts]	[tʃ]	[ʃ]	[ʃt]	[ɣ/ɐ]	[j/-]	[ju/u]	[ja/a]
								[jo/o]	[ja/a]





# Protection of TMs in Cyrillic for the territory of Bulgaria

- The LMGI, does not require filing of trademarks in Cyrillic
  
- Exceptions: Required by the Bulgarian Drug Agency:  
TMs concerning pharmaceuticals
- ✓ filing within one TM application:

**AULIN/АУЛИН**







# CANASIAN CULINARY CULTURE in Cyrillic

☐ CANASIAN CULINARY CULTURE

☐ КАНАЗИАН КУЛИНАРИ КЪЛТЧЪР

*Transliteration*

☐ КУЛИНАРНА КУРТУРА КАНАЗИАН

*Translation*





# Transliteration issues for the territory of the EU and Bulgaria

- Use
  - ✓ Is use of a TM in Cyrillic characters considered use when the same has been registered in Roman characters?
- Similarity of signs/Infringement
  - ✓ Case T-485/14 ECJ





# Transliteration issues for the territory of the EU and Bulgaria

✓ Case R2165/2010-4 (relevant territory DE)

*EUTM* **MERIDIANS**PA /

*EUTM* **МЕРИДИАН** МАЧ (MERIDIAN MATCH)

✓ Opposition B 2 311 804/13.05.2015 (relevant territory BG)

*BG TM* **ХЕМОПЛАСТ/HEMOPLAST** /

*EUTM* **HEMOLEAST**

✓ Cancellation No.4946C /28.01.2015 (relevant territory BG)

*BG TM* **ВЕЖЕН** /

*EUTM* **VEZEN** [VEZHEN]



# Transliteration issues for the territory of the EU and Bulgaria

✓ Opposition B 1 862 096/19.02.2012 (relevant territory EU)

*EUTM* **SYNBIAS PHARMA /**

*EUTM* **СИНБИАС [SINBIAS]**

✓ Decision No. 861/27.01.2016 Supreme Administrative Court,  
BG

*EUTM* **BIONADE /**

*TM* **БИОНАДА**





# Transliteration issues for the territory of the EU and Bulgaria

## ☐ Infringement cases

✓ Decision No. 630/25.04.2014 Sofia City Court

*TM REMAX v Company name (РимаксБГ) RemaxBG*

✓ Decision No.467/01.07.2013 of the Supreme Cassation Court

TM



v TM

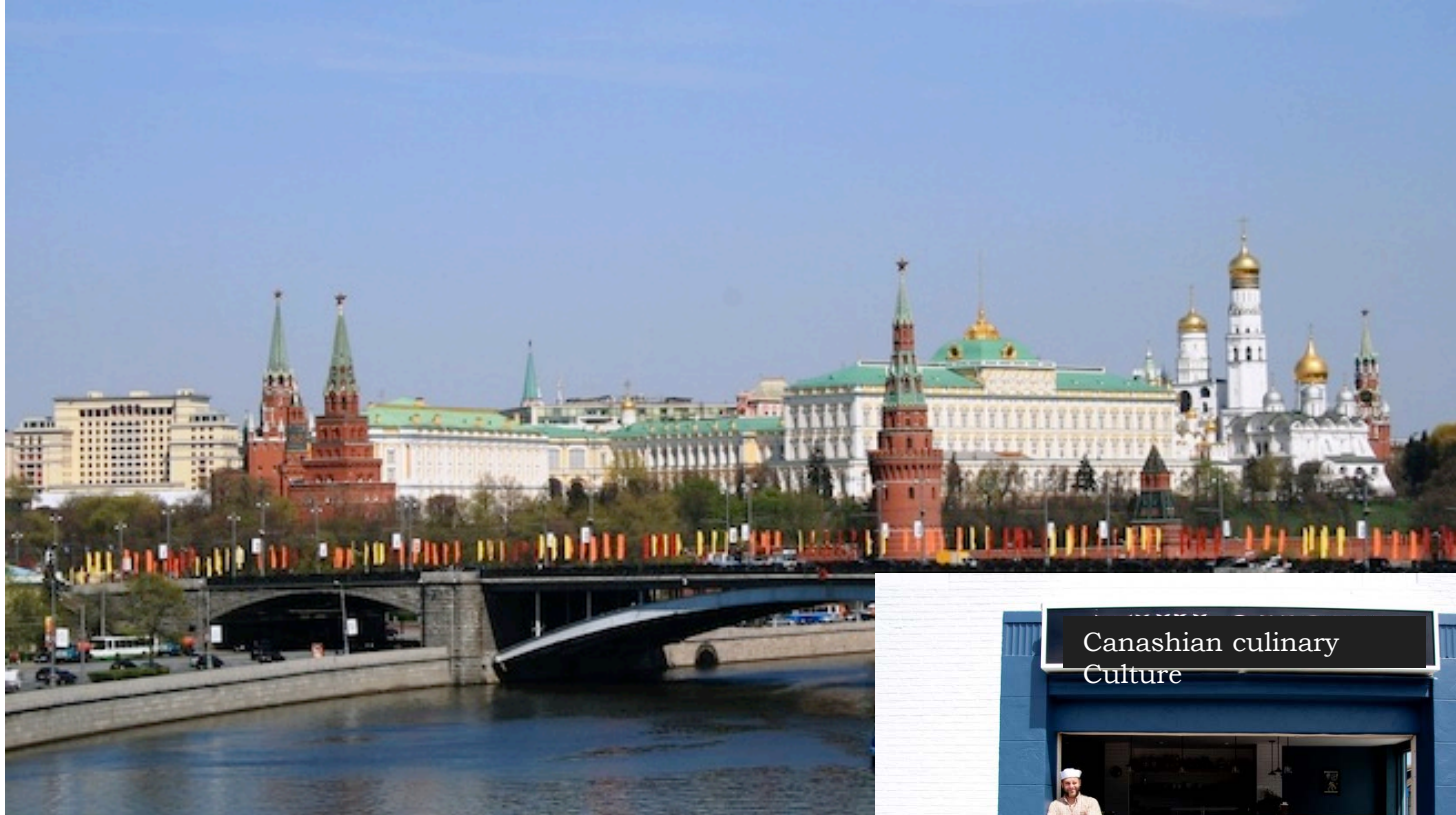




# Transliteration issues for the territory of Bulgaria

- Domain Name Issues-.bg Domain name registrations
- ✓ .bg domains are subject to registration before the domain name registration agency REGISTER.BG. The agency is not a signatory to any agreements, .bg registrations are not subject to UDRP but only to an Arbitration proceeding before the Agency
- ✓ In accordance with the Regulations of the Agency there are two types of domains protected and unprotected
- ✓ In accordance with 5.5.1.1. and 5.5.2.14 the domain may be registered on the grounds of a valid company name
- A legal entity applies for registration of a domain on the grounds of its company name “Цаназиан.БГ ООД” and the domain registration sought is CANASIAN.BG. The Agency registers the domain as protected on the grounds of the company name, more specifically finding that the domain represents transliteration of the company name. The Agency does not note that the correct transliteration is „Tsanansian.BG”.





ACTING FOR THE IP PROFESSION WORLD WIDE



## FACTS ABOUT THE RUSSIAN LANGUAGE

- ❑ Russian is an Eastern Slavic language spoken mainly in Russia and many other countries by about 260 million people, 150 million of whom are native speakers.
- ❑ This makes Russian the largest native language in Europe, the eighth most spoken language in the world by number of native speakers and the seventh by total number of speakers.
- ❑ The language is one of the six official languages of the United Nations.







## FACTS ABOUT THE RUSSIAN LANGUAGE

- ❑ Russian is an official language in Russia, Belarus, Kazakhstan, Kyrgyzstan, and many minor or unrecognised territories.
- ❑ It is an unofficial but widely-spoken language in Ukraine, Latvia, Estonia, and to a lesser extent, the other countries that were once constituent republics of the Soviet Union and former participants of the Eastern Bloc.
- ❑ It is also recognised as a minority language in Romania, Finland, Norway, Armenia, Poland, the Czech Republic, Slovakia, Turkmenistan and Uzbekistan.





## RUSSIAN LETTERS: HOW TO PRONOUNCE

А а	a as in father	К к	к as in class	Х х	h as in loch
Б б	b as in but	Л л	l as in love	Ц ц	ts as in its
В в	v as in van	М м	m as mother	Ч ч	ch as in chess
Г г	g as in get	Н н	n as in name	Ш ш	sh as in fish
Д д	d as in dress	О о	o as in bottle	Щ щ	shsh as in fresh chat
Е е	ye as in yesterday	П п	p as in paper	Ъ ъ	"hard sign"
Е ё	yo as in yonder	Р р	r as in error	Ы ы	i as in bill
Ж ж	zh as in measure	С с	s as in smile	Ь ь	"soft sign"
З з	z as in zoo	Т т	t as in ten	Э э	e as in bet
И и	ee as in meet	У у	u as in cool	Ю ю	yu as in Yugoslavia
Й й	y as in toy	Ф ф	f as in farm	Я я	ya as in yard





## Frequently asked questions:

- Is it required to protect my trademark also in Russian letters?
- Is it recommended to protect my trademark also in Russian letters?
- Is there a risk that my trademark is rejected because of an earlier registration in Russian letters?
- Can I seek protection of both Latin and Russian versions of my trademark in one application?





Is it required to protect my trademark also in Russian letters?

No.

**NOTE:** Russian PTO requires that application for a word mark in a foreign language shall comprise transliteration with Russian letters and translation (in case the trademark has a meaning).





Is it recommended to protect my trademark also in Russian letters?

This is debatable. On one hand, a word trademark gives reasonable protection against any word trademark that sounds the same, even when presented in another alphabet. On the other hand, protection is stronger if both Latin and Russian versions are protected. Apparently, customers may take a trademark in Russian as more familiar.





- APPLE
- GOOGLE
- MICROSOFT
- COCA COLA
- FACEBOOK
- TOYOTA
- IBM
- DISNEY
- McDonald's
- GE
- ЭППЛ
- ГУГЛ
- МАЙКРОСОФТ
- КОКА-КОЛА
- ФЕЙСБУК
- ТОЙОТА
- ИБМ
- ДИСНЕЙ
- Макдоналдс
- ДЖИ И

**LOOKING UP FOR THE LEADERS: FORBES TOP 10 BRANDS 2016 ALL PROTECTED IN RUSSIAN**





❑ Is it recommended to protect my trademark also in Russian letters?

One psychological consideration: a Russian trademark may bring the customer to the conclusion that the goods are produced domestically. Meanwhile, many Russians do not trust domestic goods ever since the Soviet era.

Thus, there is a tendency that Russian firms prefer using trademarks in Latin.





**INCITY** ladie's wear

**Henderson** men's wear

**Paolo Conte** business attire

**TOM KLAIM** ladie's wear

**RALF RINGER** footwear

**TERVOLINA** footwear

**O'STIN** clothing

**SAVAGE** clothing

**OGGI** clothing

**Sela** casual clothing

**ZOLLA** clothing

**KANZLER** men's wear

**Mascotte** footwear

**Westland** blue jeans

**TJ collection** footwear

**Carlo Pazolini** footwear

**FiNN FIARE** clothing

**Fabio Paoloni** men's wear

**BGN** ladies's wear

**Erich Krause** office stationery

**Russian brands that pretend to be foreign by using Latin letters**







- ❑ Is there a risk that my trademark is rejected because of an earlier registration in Russian letters?

Yes, and here is one example:

Claimed trademark



Cited trademark





## CANASIAN CULINARY CULTURE in Russian

Transliteration:

**КЭНЭЙЖН КАЛИНЭРИ КАЛЧЕ**

Translation:

**??????? КУЛИНАРНАЯ КУЛЬТУРА**

Modified translation:

**КАНАДСКО-АЗИАТСКАЯ КУЛИНАРНАЯ КУЛЬТУРА**

Back translation:

**CANADIAN-ASIAN CULINARY CULTURE**





ACTING FOR THE IP PROFESSION WORLD WIDE



# Confusion???

- Recent Canadian case relating to “duelling” Chinese transliterations

CHEUNG'S BAKERY	SAINT HONORE CAKE SHOP LIMITED
安 娜 餅 屋	
安 Anna's 娜 Cake 餅 House 屋	
<b>ANNA'S CAKE HOUSE</b>	
	





# QUESTIONS?