

# Is there any interest in protecting Chinese character marks in the European Union?

Categories : [Marques](#), [Trademark](#)

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According to the EUIPO's 2018 Annual Report, China is ranked third among the top 10 filing countries (*which represent 71.71% of total filings in the European Union*). The European Union remains one of the biggest territories of interest for Chinese applicants after the United States and South-East Asia.

We recently noticed a growing demand from Chinese companies for registering Chinese character marks in the European Union. This "behaviour" is surprising, as Chinese companies used to adapt their brand's name to the countries in which they would be implemented, as European companies do (*for example, the French brand Evian became "??" [Y? yún] in China, and the Chinese company ?? [xi?om?] became "Xiaomi" in Western countries*).

The problem with these filings is that European consumers are presumed not to read or understand the Chinese character marks during their purchasing experience and using services. Although the Chinese language is the most spoken in the world, the EUIPO does not consider Chinese speaking people as "*a substantial part of consumers in the European Union*"<sup>[1]</sup>.

This approach leads to the following consequences:

## 1. Chinese character marks are figurative marks by nature.

According to the EUIPO's guidelines, the trademarks which are composed of "*letters from non-EU alphabets*" are **figurative marks**. Indeed, the EUIPO has consistently held that Chinese characters represent "*purely figurative element or ornamental elements*"<sup>[2]</sup>, "*illegible element*"<sup>[3]</sup> or "*mere calligraphic and abstract signs*"<sup>[4]</sup> in the eyes of the European Union's consumers.

## 2. At the time of filing, the EUIPO does not request the applicant to provide any description, translation nor transliteration of the Chinese character mark to be filed.

This means that a Chinese character mark, which would have a descriptive signification for a Chinese speaking consumer, could be easily registered in the European Union.

For example, the trademark



n° 013334801 is registered for the goods “ *Tofu or bean curd; Fried tofu pieces [Abura-age]; Freeze-dried tofu pieces [Kohri-dofu]*” in class 29, while the English translation of the Chinese characters is *Tofu*.

**3. During opposition proceedings, the EUIPO compares the Chinese marks only from a visual standpoint (*without taking into account the pronunciation nor the meaning of the marks*).**

In the case

vs

(Opposition EUIPO No B 3 064 528, 17/10/2019): The Chinese characters of the earlier marks “?” are fully included within the contested sign

. However, the EUIPO held that the signs were different because of their length, overall structure and display direction (*horizontal/vertical*).

**4. During opposition proceedings, if the trademarks are composed of both Latin word and Chinese characters, the latter would be considered as a secondary element.**

For example, in the case **LOUIS XIII v**

(*OPP 19-0953/MLE; 27/06/2019*): By making a comparison between the verbal elements “LOUIS XIII” and “LOUIS CANTIR”, the French Intellectual Property Office has held that the signs were different. The Office did not mention the presence of the Chinese characters when comparing the marks, thus giving these figurative elements a secondary position (*or even, a non-existent position*).

**5. Pinyin and Latin equivalent of Chinese characters could play a part in the proof of use of a Chinese character mark in the European Union.**

In a recent case<sup>[5]</sup>, the French wine producer Castel Freres received a revocation action against their EUTM

(Pinyin “KASITE”) n°006785109, which has been used in relation with Chinese wines (a niche segment on the French wine market). The EUTM

has been always used by Castel Freres on the label of the wine bottles in association with the following elements: Latin words “DRAGON DE CHINE (Dragon of China in French)”, a picture of dragon and its Pinyin “KA SI TE”.

Below three of the labels of wine provided by Castel Freres:

It is worth mentioning the followings points raised by the EUIPO:

- When purchasing a bottle of wine showing one of the abovementioned labels, French consumers who are aware of purchasing a Chinese wine are **“very likely to understand that “KA SI TE” is the Latin equivalent to the Chinese characters “**

” ;

- As a result, to assess and determine whether or not the use is genuine, all the invoices provided by the wine company that refer to Pinyin “KA SI TE” which is the transliteration of the Chinese characters could be linked to the EUTM

and must hence be taken into account.

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Finally, a summary of legal and commercial advantages/disadvantages when filing a Chinese character marks in the European Union could be presented as follows:

In conclusion, applying for Chinese character marks can neither be perceived as a right nor a wrong filing strategy, as such judgment will always depend on particular context (*e.g. kind of products or services concerned, population targeted, whether in B2B or B2C, etc.*).

Therefore, from a legal perspective, we consider that there is currently not much sense in filing a wholly Chinese character mark in the European Union.

However, we believe that there is a legal interest in combining both Chinese and Latin characters in the registration or use of a European Union trademark. In that regard, the Chinese characters, even without the Latin ones, could be recognizable and distinguishable by the European consumers (*for example, the following part of Uniqlo's logo* “



*” would easily be recognisable by the non-Japanese speaking consumers). On the other hand, the Latin equivalent of a Chinese mark could be taken into account by the EUIPO when assessing whether the latter has been genuinely used in the European Union by its proprietor (as above-mentioned in the Castel Freres’ recent case).*

Due to the increasing expansion of Chinese business activity and tourism in the European Union, along with the important number of Chinese speaking people, we could legitimately imagine some changes in the EUIPO’s practice as well as in European Union Trademark law.

As for instance, we notice that when applying for a figurative trademark before the EUIPO, the platform automatically detects and transcribes some Chinese characters elements of the uploaded picture, as displayed below:

What will be the next steps?

Do not hesitate to contact Inlex Ip Expertise ([contact@inlex.com](mailto:contact@inlex.com)) for further assistance, it would be our pleasure to assist you.

Wendy LAM

IP Lawyer

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[1] Opposition EUIPO No B 3 064 528, 17/10/2019

[2] OHIM No B 1 196 874, 24/11/2008

[3] EUIPO Board of Appeal, R 2310/2018-4, 06/08/2019 - Chinese characters, § 25

[4] EUIPO Board of Appeal, R 2000/2010-4, 03/05/2011 - 'FORERUNNER' / 'FORERUNNER', § 15; EUIPO Board of Appeal, R 2310/2018-4, 06/08/2019, - Chinese characters, § 24

[5] EUIPO, Cancellation action n° 000022601 C, April 03, 2020. To be continued as the decision is still subject to appeal.

[6] *Pinyin* is an official tool that defines the pronunciation of each Chinese characters. It represents the official "Latinization" system for Chinese language.