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Protection principles and recommendations on the right of personal name registration in China

Kevin Xu (Xu Kai) and Mandy Wang (Wang Xi), HongFangLaw, discuss the complicated laws of personal name registration in China, closely investigating a variety of different cases and situations.

Among the numerous formulations of trademark right cases, those involving the prior right of personal name are considered quite complicated. Although superficially, the prior rights among those cases are the same, namely the prior rights of personal name. However, in real practice, due to diverse situations, the definition of, as well as the application of, laws of the prior right of personal name in each case can be completely different. This also leads to the diverse judgment standards taken by trademark review institutions and the courts for each individual case. In this article, the authors are going to introduce the principle of the protection of the prior right of personal name by analyzing highly debated cases in recent years, together with the cases the authors have personally experienced.

In this article, the prior "right of personal name" shall be construed using an expanding interpretation, with "right of personal name" including the rights of a living celebrity, the rights of a living individual, and the rights of a dead celebrity. The authors, taking into account the relevant cases, have analyzed these different types of rights of personal name respectively.

The general right of personal name

In general, the definition of the right of personal name is mainly described in the *General Principles of the Civil Law,* which will not be explained further here. The protection of the general right of personal name in the *Trademark Law* is mainly described in Article 32 of the *Trademark Law.* According to relevant interpretation, the so-called right of personal name includes legally registered names, nicknames and pseudonyms, etc. In principle, the awareness or popularity of a right holder is not an essential element that triggers the protection of the right of personal name. As long as third parties have the unjustified objective to use the name, it can be established that the third party's act of use has infringed the prior right of personal name. Of course, it is quite difficult to establish the "obtaining of unjustified objective" in real practice, since the burden of proof lies on the right holder to prove the "full awareness" as well as the "unjustified objective" of the other party, which undoubtedly increases the burden of proof of the right holder. However, because of the non-uniqueness and high repetitiveness of personal names, the authors believe it is complied with legislative principle to increase the burden of proof of the right holders in this type of cases.

The right of personal name of a celebrity, in the case where the name and the person have established the only corresponding relationship between each other

Among the intellectual property cases, there are massive cases where the burden of proof lies on the right holder to establish the "bad faith" of the infringer or the trademark applicant (namely the "obtaining of unjustified objective" as mentioned above). Among those cases, the "bad faith" can be established by proving the "full awareness" or the "should-have-known awareness" of the other party. The

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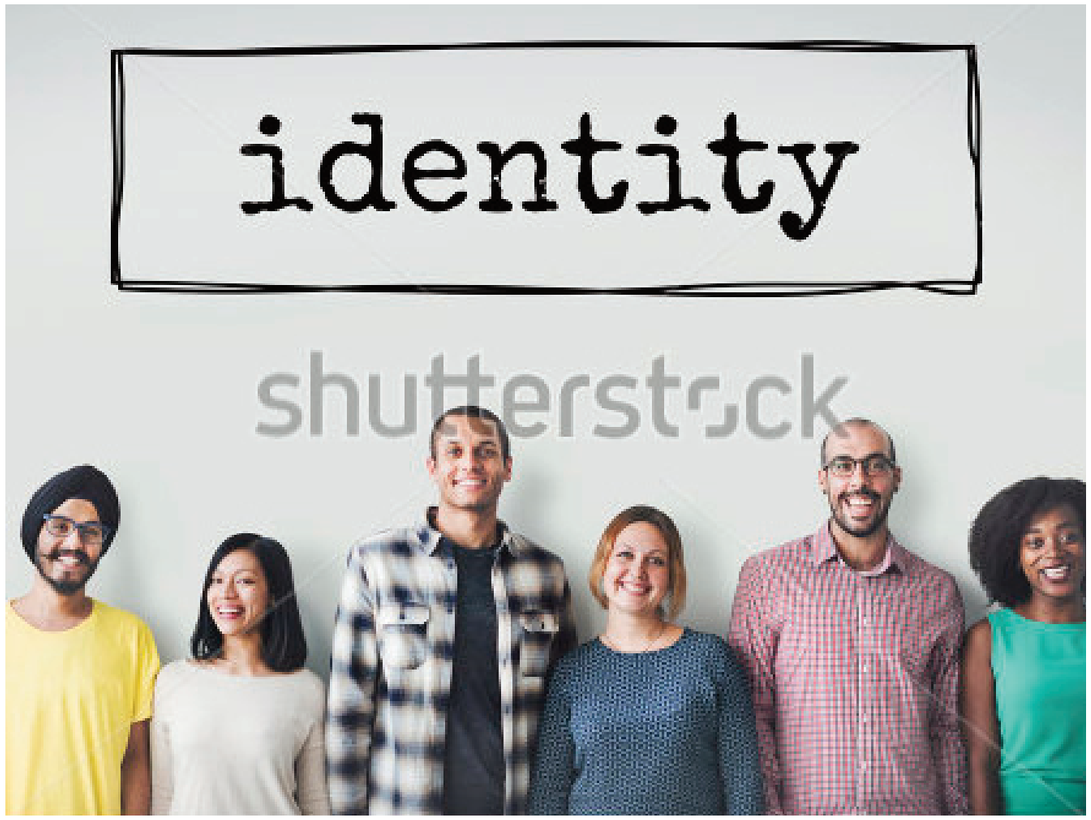

establishment of the "full awareness" expects high evidential requirements and varies greatly based on the nature of the case itself. While in the "should-have-known awareness" scenario, the popularity of the prior right is an essential element to presume the "should-have-known awareness" of the applicant. In respect of the protection of the prior right of personal name, the right of personal name of a celebrity is obviously over protected, where the popularity of the name of a celebrity can directly infer the "unjustified objective" obtained by the applicant (e.g. Yi Jianlian case[1], NBA star Iverson case[2], etc.). In the Yi Jianlian case, Beijing Higher People's Court held that "whether the right of personal name has been infringed because of the application or registration of the disputed trademark lies on whether the name has obtained certain popularity."

In the case where the right holder obtains certain popularity and the designated goods of the disputed mark are related to the right holder's business

Among the aforementioned Yi Jianlian and Iverson cases, as they are already super stars in China they, and their names, have constituted "the only correspondence relationship" between each other. Therefore, as long as there is no reasonable ground raised by the applicant, it can be established that the applicant has obtained the "unjustified objective". Some people might have doubts that, as there are 45 international classes in the trademark classification, if the right of personal name of a celebrity can always be deemed an obstacle to others' trademark applications in those 45 classes. Such judgment standard seems to be unfair while the protection of the name of the celebrity is similar to the act of monopoly, with which the authors disagree.

> *"The true challenge lies on the protection of the right of personal name of a deceased individual."*

In the "KATE MOSS"[3] case, "KATE MOSS" is the name of a model. Although the evidence submitted by the right holder was not sufficient to prove the popularity of the right holder in China, since the trademark applicant was engaged in the clothing industry, which was highly related to the clothing endorsements KATE MOSS (model) was engaged in, the Court held that the applicant had obtained unjustified objective to use the name "KATE MOSS" for profits and thus held the trademark application had infringed the right of personal name of "KATE MOSS". Let us take another perspective: if the trademark applicant applied the "KATE MOSS" trademark covering food or industrial products, since the popularity of "KATE MOSS" was only limited to clothing and fashion industry, the Court would not consider that the applicant's trademark application had infringed the right of personal name.

[1] Beijing Higher People's Court (2010) Gao_Xing_Zhong_Zi No. 818 Administrative Judgment.
[2] Beijing No. 1 Intermediate Court (2012) Yi_Zhong_Xing_Chu_Zi No. 1386 Administrative Judgment.
[3] Beijing No. 1 Intermediate Court (2010) Yi_Zhong_Zhi_Xing_Chu_Zi No. 534 Administrative Judgment.

The protection of right of personal name of a deceased individual

The protection of right of personal name mentioned above is within the scope of the right of personal name stipulated in the laws. In real practice, the true challenge lies on the protection of the right of personal name of a deceased individual.

In the "I·IA·Churin" trademark opposition appeal case, the Plaintiff claimed that the opposed trademark had infringed the right of personal name of its founder Ivan Yakovlevich Churin (in short I·IA·Churin). The Trademark Review and Adjudication Board believes that the right of personal name refers to the right of a living person to decide, in accordance with the provisions of the use and change of their names, and prohibits interference from others; theft, counterfeiting rights, name rights and living individual rights cannot be separated. In this case, although the opposed trademark was the abbreviation of the name of the founder Ivan Yakovlevich Churin of a foreign firm, as the person was dead, its right of personal name was no longer existent. Therefore, the opposed trademark application did not infringe the right of personal name of others.[4] Such decision clearly indicates that the trademark review institutions and the courts have construed the "right of personal name" using a restrictive interpretation. If that is the case, does that mean the right of personal name of a dead individual cannot be protected whatsoever? The authors disagree. According to the author, the right of personal name of a dead individual can be protected in two situations:

1) **In the case where the applicant has applied the trademark in bad faith, articles of the *Trademark Law* in connection with the "bad faith" can be applied**

In respect of registering the name of a dead individual as trademarks in bad faith with tarnishing, insulting, and derogating nature, articles of the *Trademark Law* in connection with the "bad faith" can be applied so that the public authority can protect the name of a deceased individual. Such as Article 7 "In the application for registration or use of a trademark, the principle of good faith shall be followed." and Article 10 (8) "Signs detrimental to socialist morality or mores or having any other adverse effect." of the *Trademark Law.* Of course, because of the different judgment standard of "bad faith", the application of the "bad faith" clause would definitely expand the discretion of the examiners and increase the uncertainty of the right holder's claim for prior right protection.

2. **In the case where celebrities of certain popularity have passed away, if their names are highly related to the industries where they were engaged when they were alive, while the names of the celebrities have obtained commercial characteristics among the relevant industries, such names can be protected as prior merchandising right.**

Merchandising right, also called the characteristic right, is a prior right established in advanced foreign legislations, mostly applied to the copyright law. In China, after the recent amendment of the *Trademark Law,* many experts have come up with the proposal of recognizing the "merchandising right" on a legislative level in the exposure draft of judicial interpretation. Although the acknowledgement of the merchandising right has been highly supported, so far, the court has not yet expressed its attitude towards whether the "merchandising right" shall be considered a definite prior right in the formulation of trademark right cases.

"In the circumstance where the realistic demands have been brought to the judicial adjudication regarding the same issue over and over again, and where the society demands judicial adjudication to make a judgment which can be broadly accepted by the general public. The Court shall not be over cautious to make a judgment regarding this issue and wait for the legal provision to be explicitly stipulated. Through years of theoretical discussion, the research on 'merchandising right' becomes increasingly deepened."[5]

In the authors' opinion, now is a good time to consider adding the "characteristic right" into the protection scope of the *Trademark Law.* If a celebrity has devoted his/her whole life in a certain field and has enjoyed extremely high popularity and market reputation in that particular field, with the general public involuntarily connecting the celebrity with the field he/she is engaged in, it can be affirmed that the name of the celebrity has been merchandised in such field, which ought to be protected even after the death of the celebrity. Of course, the "characteristic right" can only be protected as prior right under the precondition that the name of the dead celebrity is still in business use with certain property interests.

The competent subjects that can claim the protection of the right of personal name of a dead individual

In respect of the protection of the right of personal name of a living individual, the laws have stipulated the competent subjects, which are "the person himself/herself or an interested person". Regarding the protection of the right of personal name of a dead individual, in the authors' opinion, anyone can be deemed as competent subject where the applicant has registered the trademark in bad faith as the public authority is involved. While the lawful successor of a person can be deemed as competent subject in the case where the name has been merchandised. Some legally incorporated and state-recognized non-governmental organizations or right successor organizations have the right to claim the protection of the right of personal name of the celebrities in certain field in their own names. In the trademark oppositions against "Monet Garden" and "莫奈花园" (in Chinese characters) handled by the authors, Monet is a world-renowned painter whose name has been widely commercially used. The ACADEMIE DES BEAUX ARTS, as the right successor organization of Monet, has filed several oppositions against "Monet Garden" and "莫奈花园" and other trademarks preliminarily approved for registration, according to Article 32 of the *Trademark Law.* The oppositions are currently under examination.

[4] Beijing Higher People's Court (2009) Gao_Xing_Zhong_Zi No. 120 Administrative Judgment.
[5] Zhang Dandan, *The research of merchandising right,* doctorate dissertation of Jilin University (2008); Hong Wei and Zheng Xing, "The analysis of the merchandising right within the personal right", *Zhejiang Social Science (2008) vol 12,* pp.40-47; Xu Yiqi, "The analysis of the protection of merchandising right of the general public", *New Academy (2008) vol 3,* pp.207-208; Li Linqi, "The analysis of the legal concept of 'personalized merchandising right'", *Chinese Incubator (2012) vol 5,* pp.128-130; Zhang Dandan, "Balance and conflict of interest inside the merchandising right", *Shandong Social Science (2011) vol 12,* pp.72-75.