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Transliterations of Names and Surnames: Revisiting Paragraph 12(1)(A) of the *Trade-marks Act* *

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Abstract

This article proposes a revision to the analysis underlying paragraph 12(1)(a) of the *Trade-marks Act*. Currently, such analysis asks two questions: (i) is the impugned mark the name or surname of a living individual or an individual who has recently died; and (ii) if yes, is the impugned mark “primarily merely” a name or surname from the perspective of the “general public” in Canada. The term “primarily merely” is understood to mean “chief[ly]” or “principal[ly]” and “nothing more than” that. The term “general public” is understood to comprise persons of “ordinary intelligence and education in English or French”. It is argued herein that the foregoing analysis should no longer be determined from the perspective of the “general public” in Canada; rather, such analysis should be performed from the perspective of persons “who normally comprise the market” of goods and services in association with which the impugned trademark is used.

Résumé

Cet article propose une révision de l’analyse sous-jacente de l’alinéa 12(1)a) de la *Loi sur les marques de commerce*. Ce type d’analyse pose effectivement deux questions : (i) Est-ce que la marque contestée représente le nom ou le prénom d’un particulier vivant ou qui est décédé récemment? et (ii) Si oui, la marque contestée « n’est-elle principalement et uniquement » qu’un nom ou un prénom, de la perspective du « grand public » canadien. L’expression « n’est principalement et uniquement » signifie « essentiellement » ou « principalement » et « rien de plus ». L’expression « grand public » sous-entend un regroupement de personnes dotées « d’une intelligence moyenne et possédant un niveau d’instruction moyen en anglais ou en français ». Le présent article prétend que l’analyse qui précède ne devrait plus être déterminée de la perspective du « grand public » canadien; ce type d’analyse devrait plutôt être effectué de la perspective de personnes « qui forment normalement le marché » des biens et services en association avec lequel la marque de commerce contestée est employée.

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1.0 Introduction

At the end of 2016, China's Supreme People's Court ruled in favour of former basketball player Michael Jordan, and ordered Qiaodan Sports, a Chinese sportswear company, to stop using the trademark “乔丹” (a recognized Chinese transliteration of the name JORDAN [be it a first name or a last name], and pronounced as “qiao dan” in Mandarin) in association with its sporting merchandise, despite Qiaodan Sport's senior rights in the trademark “乔丹” in China. In coming to its decision, the Court found that, in China, the term “乔丹” is understood to be a direct reference to Michael Jordan, thereby entitling Michael Jordan to “name rights” in the term “乔丹”. The decision was the culmination of a four-year legal battle that snaked its way through the Chinese lower courts before ultimately arriving at China's Supreme People's Court. Given the perceived rigidity of China's first-to-file trademark system, the decision was lauded as

a success story for Michael Jordan: he had at least wrestled back his “name rights” to his Chinese “name”, “乔丹”, in China.

Despite the clear differences in script between Chinese and English or French, Chinese linguists have made a concerted effort over the past decades to standardize Chinese transliterations of location names, surnames, and first names that are expressed in the Latin script. For example, the Chinese characters “加” (pronounced as “jia” in Mandarin), “拿” (pronounced as “na” in Mandarin), and “大” (pronounced as “da” in Mandarin) each have meanings in Chinese. However, when strung together as “加拿大” (pronounced as “jia na da” in Mandarin), such term, to Chinese readers, only functions as the Chinese transliteration of, or to denote, “Canada,” and has no other recognized meaning. The same goes for other countries around the world, and the table below lists but a few examples:

Transliterated name of Country (in Chinese)	Pinyin (English transliteration of Standard Chinese)	Country (in English)
美国	mei guo	United States of <u>America</u>
巴西	ba xi	<u>Brazil</u>
英国	ying guo	<u>England</u>
法国	fa guo	<u>France</u>
墨西哥	mo xi ge	<u>Mexico</u>
乌拉圭	wu la gui	<u>Uruguay</u>
智利	zhi li	<u>Chile</u>
洪都拉斯	hong du la si	<u>Honduras</u>

Latin script-based surnames also have recognized Chinese transliterations. Examples of standardized Chinese transliterations of Latin script-based surnames include the following:

Transliterated Surname (in Chinese)	Pinyin	Actual Surname
史密斯	shi mi si	Smith
琼斯	qiong si	Jones
乔丹	qiao dan	Jordan
杜鲁多	du lu duo	Trudeau
詹姆斯	zhan mu shi	James

The Chinese transliterations above have no meaning other than the “Western” surnames to which they refer.¹

Latin script-based full names also have their own Chinese transliterations. Examples of Chinese standardized transliterations of Latin script-based names include the following:

Transliterated Full Name (in Chinese)	Pinyin	Actual Full Name
威拉德·史密斯	wei la de · shi mi si	Willard Smith
诺拉·琼斯	nuo la · qiong si	Nora Jones
乔丹·贝尔福特	qiao dan · bei er fu te	Jordan Belfort
迈克尔·乔丹	mi ke er · qiao dan	Michael Jordan
贾斯汀·杜鲁多	jia si ting · du lu duo	Justin Trudeau
亨利·詹姆斯	heng li · zhan mu shi	Henry James

¹ See footnote 6 and 7

Standardized Chinese transliterations of Latin-based words, in part, break down language barriers and allow Chinese speakers to quickly refer to and identify non-Chinese references with ease and fluidity; they also improve the likelihood of cross-cultural exchanges and influences.

Going back to Michael Jordan's legal success in China, legal success in one jurisdiction does not necessarily mean legal success in another jurisdiction. In Canada, for example, and leaving the issue of acquired distinctiveness aside, it is unclear if Michael Jordan would be able to successfully oppose a trademark application or invalidate a trademark registration for the trademark "乔丹" as used in association with sporting merchandise.

2.0 The Prevailing Law regarding Paragraph 12(1)(a) of the Trade-marks Act

With regard to the registrability of names and surnames as trademarks in Canada, paragraph 12(1)(a) of the Trade-marks Act² (subject to provisions surrounding acquired distinctiveness) states that "...a trade-mark is registrable if it is not a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years." On its face, the legislative text seems straightforward enough: names and surnames of living people or people who have died within the past 30 years are not registrable as trademarks. However, nothing is straightforward in law, and there is no shortage of case law decisions dedicated to the interpretation of paragraph 12(1)(a) of the *Trade-marks Act* and the phrase "primarily merely the name or the surname" [emphasis added] contained therein.

The seminal case on the interpretation of paragraph 12(1)(a) of the *Trade-marks Act* is *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 (E.C.C.) ("**Standard Oil**"). The case focused on the registrability of the term FIOR as a trademark in Canada, and particularly whether FIOR was "primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years." Despite having evidence before it that 15-20 individuals in North America had the last name of FIOR, the Exchequer Court, in rendering its decision, remarked as follows:

Certainly, from the point of view of the people called "Fior" and their immediate circle of friends and acquaintances, the answer is that "Fior" is principally if not exclusively a surname, and, from the point of view of the trade mark advisers of the appellant, the answer is that it is principally if not merely an invented word. The test, for the purposes of section 12(1)(a) is not, in my view, the reaction of either of these classes of persons. The test must be what, in the opinion of the respondent or the Court, as the case may be, would be the response of the general public of Canada to the word. My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely, if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that

is, by thinking of it as being the surname of one or more individuals). Indeed, I doubt very much whether such a person would respond to the word by thinking of there being an individual having it as a surname at all.

I am, therefore, of the view that it is probably not "primarily" a word that is a surname of an individual at all, but it is certainly not primarily "merely" such a word.

I have probably been influenced in coming to the conclusion that I have expressed as to how the word "primarily" in section 12(1)(a) should be applied by the fact that applying the provision solely by reference to the existence of a dictionary meaning of a proposed trade mark would make practically every invented word vulnerable to attack as a proposed trade mark by anyone assiduous enough to pursue his searches for its use as a surname somewhere in the world (or, indeed, in a country such as Canada even if the search were restricted to Canada). I cannot believe that section 12(1)(a) was intended virtually to eliminate the creation of new words for purposes of proposed trade marks.

[emphasis added]

As noted in the *Standard Oil* decision, the litmus test to be applied in an analysis under paragraph 12(1)(a) of the *Trade-marks Act* is the response of the general public to the word for which trademark protection is sought. As may be inferred from the *Standard Oil* decision, the "general public" is formed of persons "in Canada of ordinary intelligence and of ordinary education in English or French".

The *Standard Oil* decision was followed by the Supreme Court of Canada decision in *Registrar of Trade Marks v. Coles Book Stores Ltd.*, [1974] S.C.R. 438 ("**Coles Books**"). In the *Coles Books* decision, clarity was added to the meaning of the terms "primarily" and "merely". According to the Court, the following is the question to ask in an analysis under paragraph 12(1)(a) of the *Trade-marks Act*: is "the primary (chief) (principal) (first in importance) meaning of the word merely (only) (nothing more than) a surname" [page 441; emphasis added]? In the *Coles Books* decision, the Court referred to dictionary definitions for guidance on the interpretation of the term "Coles."

Subsequent case law decisions have applied the rulings in the *Standard Oil* and *Coles Books* decisions. For example, in *Gerhard Horn Investments Ltd. v. Registrar of Trade Marks* (1983), 73 C.P.R. (2d) 23 (F.C.T.D.) ("**Gerhard Horn**"), an appeal of the unregistrability of the fictitious name "MARCO PECCI" was allowed (see trademark registration number TMA306967).³ In allowing the appeal, the Court noted that the test under paragraph 12(1)(a) of the *Trade-marks Act* is whether "the general public of Canada would think the words to be the name of a living individual if there be a living individual of that name and not because the general public so thinks that makes it the name of a living individual" [page 32; emphasis added]. As also stated at page 31 of the *Gerhard Horn* decision:

It is not enough that the fictitious name may resemble the name that could be borne by

² R.S.C., 1985, c. T-13.

³ At the time of the *Gerhard Horn* decision, there was no evidence that any individual in Canada had the name "Marco Pecci."

an actual person or might be thought by the public to be names or surnames. That thought only becomes material when it is established by evidence that there is a living person of the name or surname in question.

[emphasis added]

In *Galanos v. Registrar of Trade Marks* (1982), 69 C.P.R. (2d) 144 (F.C.T.D.) ("**Galanos**"), an appeal of the unregistrability of the term "GALANOS" was allowed despite the fact that GALANOS is a surname (albeit an uncommon one) and has a meaning in Spanish.⁴ The Court's reasoning in the *Galanos* decision may be summarized in the following passages:

Both like facts to those before Mr. Justice Marceau are present. Galanos is a surname but not a widely known one. It is meaningless in the French and English languages.

But being meaningless the word does have another significance.

That significance is that being a foreign word without meaning in English or French it is a coined, fancy or invented word sought to be used as a trade mark. The quoted statement of the registrar confirms this to be so.

On this circumstance being so the matter is on all fours with the circumstance before the court in the *Standard Oil Co. case*, supra, and the question is would the response of the general public of Canada to the word "Galanos" be that it is a surname of one or more individuals or is it a brand or trade mark of some business?

I have difficulty in appreciating that the purchasing public would respond to the word "Galanos" prominently displayed on the label of a bottle of toilet water by spontaneously thinking of it as being the surname of an individual.

In my opinion a Canadian of ordinary intelligence and education in English or French would be as likely, if not more likely, to respond to the word by thinking of it as a coined, fanciful or invented word used as a brand or trade mark of a business as by thinking of it as primarily merely the surname of an individual.

[emphasis added]

The essence of the foregoing case law decisions was then summarized in *Jurak Holdings Ltd v Matol Biotech Laboratories Ltd* (2007), 64 C.P.R. (4th) 195 (T.M.O.B.) ("**Jurak**") at ¶16:

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of*

Trade-marks v. Coles Book Stores Ltd., 1972 CanLII 176 (SCC), [1974] S.C.R. 438, 4 C.P.R. (2d) 1, *Gerhard Horn Investments Ltd. v. Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 (F.C.T.D.), and *Standard Oil Co. v. Canada (Registrar of Trade Marks)*, [1968] 2 Ex.C.R. 523, 55 C.P.R. 49. As set out in those cases the test under s. 12(1) (a) is two fold:

1) The first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died:

2) If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the Mark is "primarily merely" a name or surname rather than something else.

[emphasis added]

The *Jurak* decision was affirmed in *Matol Biotech Laboratories Ltd v Jurak Holdings Ltd*, 2008 FC 1082.

While not explicitly stated in the *Jurak* decision, it appears to be understood that the term "average Canadian consumer" refers to "a Canadian of ordinary intelligence and education in English or French" (see ¶52-56, ¶168) and by extension the "general public" in Canada.

3.0 Application of the Prevailing Canadian Case Law to "乔丹"

Based on the principles of the prevailing case law decisions in Canada surrounding the interpretation of paragraph 12(1)(a) of the *Trade-marks Act*, it appears that the term "乔丹" (*i.e.* the Chinese transliteration for JORDAN) would be registrable as a trademark by any applicant in Canada. The reasons may at least be summarized as follows:

1. The term "乔丹" is written in Chinese characters, and the analysis under paragraph 12(1)(a) of the *Trade-marks Act* is done from the perspective of the "general public in Canada," the general public being comprised of persons in Canada "of ordinary intelligence and of ordinary education in English or French". It will likely be determined that the general public in Canada has little to no grasp of the Chinese language.
2. The term "乔丹" is meaningless in the French and English languages, similar to how the term "galanos" is meaningless in the French and English languages (see the *Galanos* decision).
3. The term "乔丹", by virtue of being without meaning in English or French, may therefore be a coined,

⁴ See Canadian trademark registration number TMA290391, subsequently expunged for failure to pay renewal fees.

fancy or invented word sought to be used as a trademark (see the *Galanos* decision).

4. An applicant may bypass an Examiner's scrutiny under Rule 29 of the *Trade-mark Regulations*⁵ by choosing to translate the Chinese characters of “乔” and “丹” separately, rather than draw attention to the fact that the term “乔丹” is a recognized Chinese transliteration of the name or surname JORDAN.⁶

With reference to paragraph 12(1)(a) of the *Trade-marks Act* only, and without regard to other sections of the *Trademarks Act* which may also impact the registrability of names or surnames (e.g. paragraphs 12(1)(e) and 9(1)(k) of the *Trade-marks Act*), prevailing case law suggests that it would be open to any third party to successfully register the Chinese characters “乔丹” as a trademark, despite the fact that the term “乔丹” is a recognized Chinese transliteration of the term JORDAN,⁷ and that JORDAN, in itself, could very well be understood in Canada to be “primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years”. As such, under the prevailing law in Canada, former basketball player Michael Jordan may not receive a favourable result in an opposition or invalidation proceeding against a hypothetical trademark application or registration for the term “乔丹” in Canada. Simply put, it is not likely that the general public in Canada, which is understood to be formed of persons of ordinary intelligence and of ordinary education in English or French, would recognize the term “乔丹” to be merely a surname or a name, let alone a recognized Chinese transliteration for JORDAN referring (whether exclusively or generally) to former basketball player Michael Jordan.

4.0 Revisiting the Analysis under Paragraph 12(1)(a) of the *Trade-marks Act*

Not all aspects of Canadian trademark law are viewed from the perspective of a “person in Canada of ordinary intelligence and of ordinary education in English or French.” For example, Canadian trademark confusion analysis is done from the perspective of the “average consumer” who is understood to be a person who is likely to buy the goods or subscribe to the services in question (*Canadian Schenley Distilleries Ltd v. Canada's Manitoba Distillery Ltd*, [1975] 25 C.P.R. (2d) 1, p.5 (F.C.T.D.) (“*Schenley*”)):

To determine whether two trade marks are confusing one with the other it is the persons

who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer.

The *Schenley* decision was cited with approval at paragraph 45 of the subsequent case *Saint Honore Cake Shop Limited v. Cheung's Bakery Products Ltd.*, 2013 FC 935 (“*Saint Honore*”). The *Saint Honore* decision dealt with confusing trademarks comprising Chinese characters, and the Court therein decided to not disturb the Trade-marks Opposition Board's decision to assess trademark confusion from the perspective of the actual consumers who, in the *Saint Honore* case, read and understood the meaning of the Chinese characters in the disputed trademarks (see ¶46-47). Perhaps it would be suitable to adopt a similar approach for the analysis under paragraph 12(1)(a) of the *Trade-marks Act*.

In the context of the analysis under paragraph 12(1)(a) of the *Trade-marks Act*, there are benefits to assessing a foreign language trademark from the perspective of the average Canadian consumer who reads and understands that foreign language. For example, the likelihood and occurrence of applicants gaining trademark rights throughout Canada to foreign transliterations of English or French words that are themselves primarily merely names or surnames would be minimized, thus preserving the essence of paragraph 12(1)(a) of the *Trade-marks Act*, which is to prevent traders from restraining other traders of the same name from using that same name.^{8,9} At least in view of the changing cultural demographics in Canada,¹⁰ it may be appropriate to address trademark issues under paragraph 12(1)(a) of the *Trade-marks Act* from the perspective of persons “who normally comprise the market” or “the ultimate consumer,” as suggested in the *Schenley* decision (albeit for a different analysis under the *Trademarks Act*), and not merely from the perspective of the “general public” in Canada.

5.0 Conclusion

In evaluating whether a word is “primarily merely the name or the surname of an individual who is living or has died within the past thirty years,” it is incompatible with Canada's growing multiculturalism to merely rely on the perspective of the “person in Canada of ordinary intelligence and of ordinary education in English or French.” With particular emphasis on trademarks written in a non-Latin-based script, it may be appropriate to also consider the perspective of the average Canadian consumer who: (i) subscribes to the goods and services associated with those trademarks; and (ii) is able to read and understand the language in which the

5 SOR/96-195.

6 In the author's view, an argument can be made that there is nothing unbecoming in defining the Chinese characters of “乔” and “丹” separately, since these characters each carry a meaning that is not primarily merely a surname or a name.

7 To further complicate the term “乔丹” specifically, please note that “乔丹” could also be the actual full name of a Chinese-Canadian, since the character “乔” is recognized as a last name and “丹” could be used as a first name. The implications of such is left out of this article, but would presumably be guided by the ruling in the *Gerhard Horn* decision.

8 It is important to recognize that foreign transliterations themselves often carry no meaning in the foreign language but for the Latin script-based surnames or names that they are equated to.

9 This point also appears to be somewhat reflected, albeit to a limited extent, in subsection 20(1.1) of the *Trade-marks Act*.

10 Census in Brief: Linguistic diversity and multilingualism in Canadian homes, <http://www12.statcan.gc.ca/census-recensement/2016/as-sa/98-200-x/2016010/98-200-x2016010-eng.cfm>, accessed December 18, 2017.

trademark is presented; when analyzing whether a word is “primarily merely the name or the surname of an individual who is living or has died within the past thirty years”. Such a shift in analysis would be appropriate so as to avoid the situation where trademark protection for foreign equivalents of recognized English or French last names could be granted (leaving aside the issue of acquired distinctiveness, of course).

The foregoing shift in analysis is not one that would likely impact the work of a trademark Examiner. Given that Canadian trademark Examiners are generally individuals who speak English, French, or both, it would be unreasonable to expect that they be fully attuned to all issues concerning foreign transliterations of Latin script-based surnames and names. After all, a trademark Examiner will have discharged his/her duties as long as he/she is “not satisfied that an application for registration of a trademark should be refused pursuant to subsection 37(1)” of the *Trade-marks Act*.¹¹ Rather, the onus would fall on: (i) an opponent to an application or registration to adduce appropriate evidence demonstrating that the impugned trademark is primarily merely a foreign transliteration of a Latin script-based surname or name; and (ii) the administrative or judicial authority to adopt an analysis under paragraph 12(1)(a) of the *Trade-marks Act* that is not simply restricted to the perspective of the “general public in Canada” as understood per the *Standard Oil* decision.

The law is ever changing, and constantly influenced by the fact patterns to which it is applied. Just as the Canadian Constitution is seen as a “living tree,” the laws and legal analyses thereunder should also adapt with the times. In Canada’s growing multicultural environment, it is important that jurisprudence evolve in a manner that is just and equitable in all circumstances.¹²

11 Rule 34, *Trade-mark Regulations* (SOR/96-195).

12 At the time that this article was submitted for review, the Canadian Intellectual Property Office (“CIPO”) was in the process of changing its practice with regard to paragraph 12(1)(a) of the *Trade-marks Act*, and it appears that Examiners would no longer be limited to referring to just a Canadian telephone directory in an analysis under paragraph 12(1)(a) of the *Trade-marks Act*.