

How to Choose Proper Chinese Trademark for Trademark in Foreign Language

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China's economy has been undergoing rapid, steady and constant development for nearly thirty years, and going along with it is the gradual increase of the domestic consumption. To date, not only foreign multinationals, but also MSEs, are interested in entering China's consumer market that has been increasingly regulated and operated in compliance with the internationally accepted business rules. When competing in the market, these foreign enterprises are faced with a great challenge of how to familiarize the Chinese consumers with their own goods. Without any doubt, a trademark, which is a form of advertisement promoting corporate goodwill, is an important tool to market these goods.

In general, a foreign business has owned its own registered mark in Roman letters. When it enters the market in China, is it necessary for it to register a corresponding mark in Chinese? Of course, the answer is yes. While there are not any compulsory regulations in the Chinese laws requiring a foreign business to register and use a Chinese mark in its operation in China, using a Chinese trademark is a good way to show its promise to the market and respect for the local culture, and, more importantly, it is a necessity for its own growth.¹

I. Necessity for creating Chinese trademark

1. Legal considerations

According to the Trademark Law and practice in China, protection of a mark composed of Roman letters (Roman-letter mark for short) should not be automatically extended to the protection of its "corresponding" Chinese mark.

In 2002, the EU approached the Chinese Government through the diplomatic channel, inquiring about "which pro-

cedure under the Chinese Trademark Law shows protection of a foreign mark that is translated into a Chinese one? If a foreign proprietor of a prior mark composed of Roman letters is applied for registration of the mark in Chinese characters, is it possible for its or his opposition to succeed? Can such a proprietor succeed in opposing to any use of its or his mark in Chinese characters?"

The Chinese Trademark Office's answer went like this: "in the practice of examination within the Trademark Office, pronunciation is one of the factors to be considered in assessing mark similarity; hence, it is possible to accord protection to a foreign trademarks that is translated or transliterated into a Chinese mark in the examination proceedings, the opposition proceedings, and the review and adjudication proceedings. As for whether a requested opposition will be successful to an application filed in China for registration, in Chinese character, of a prior mark of a foreign proprietor composed of Roman letters, accounts should be taken of the factors, such as whether said prior mark has been registered in China or not, whether the mark in the Chinese form is the official Chinese translation of said foreign mark, whether said foreign mark proprietor itself or himself has used said mark in Chinese, whether any interested party has acted in bad faith, and whether there exist any other specific circumstances in a case. No generalisation should be made on the matter. Similarly, to raise opposition to the use of its or his prior mark in Chinese, the proprietor of the registered mark composed of Roman letter should take into consideration of all these factors. Generalisation on the matter should not be made either."²

For this writer, the preceding reply has failed to address the essential issues, so it is not understandable to Westerners. As a matter of fact, most Western languages share the same origin, namely the Indo-European family. Hence, the

Western languages contain many identical roots and morphemes. More importantly, the letters making up of words and pronunciation of the words are regularly corresponding or related to each other. They, *per se*, are unnecessary to be translated, and it is relatively easy to transliterate a word of one language into that of another language in the same linguistic family. As for Chinese, the pinyin system, Chinese Phonetic Alphabets, as recognised by the International Standardisation Organisation in 1982 as the international standards to spell the Chinese, may be used to spell and pronounce Chinese characters and words. It needs to be emphasised, however, that the pinyin system is one for writing Chinese names, geographic names and Roman letters in Chinese documentation. In a broad sense, the system is a tool to represent pronunciation. From a pronunciation in Chinese may often be derived a range of transliterated words with different meanings. Therefore, a transliterated Chinese character or word is not at all corresponding to its pronunciation, nor is it possible for a Roman mark spelt and pronounced in the Chinese pinyin to get only one so-called correct transliterated Chinese mark. That's why Westerners often find it hard to understand why the protection of a registered mark composed of Roman letters would not certainly be extended to the transliterated Chinese mark.³

2. Market-related consideration

Obviously, along with its entry into the WTO, China's economy has been increasingly integrated into the global economy. English is also widely used in China. Despite this, the average Chinese consumers are relatively slow at recognising marks composed of English letters. For example, Chinese consumers are quite familiar with the Chinese characters pronounced "mai dang lao" standing for the world giant in the fast-food industry, but, believe it or not, more than 95% of them cannot correctly write out all the letter of the word "McDONALD'S". In other words, without its corresponding Chinese mark, the mark "McDONALD'S" would be hard for the average consumers in China to be identify, which would be definitely a matter of serious consequence.

Besides, it should be specially noted that if the true proprietor of a mark composed of Roman letters does not use the Chinese translation of his trademark in the market in China, the market (possibly the media, Chinese distributors, or the average consumers) would use one or several Chinese equivalents for it in news reports or advertisement. But these Chinese trademarks, absent closely verified or examined or perhaps with some legal flaw in one way or another,

are not what the proprietors want to use to stand for their marks. In this case, it is best for the proprietor to choose a corresponding Chinese trademark, and do not wait till the market chooses one for it or him as the market's or public's choice would confront it or him with the risk of losing its or his brand. As a case in point, since it is widely accepted that the mark "VIAGRA" corresponds to the Chinese mark pronounced "wei ge" (standing for the two characters meaning "unimpotent man") which has been preemptively registered in China in bad faith, Pfizer can do nothing but creates another Chinese trademark pronounced of "wei er gang" (meaning great and strong). It is known to all that a loss of a widely known Chinese mark very often possibly means damage to the corporate goodwill carried by a mark composed of Roman letters. Of course, the true proprietor of a brand may seek legal reliefs. But any effort along the line will be so time consuming that the business concerned is quite likely to lose good business opportunities in the constantly changing market regardless of what would eventually come out during the process.

Additionally, businesses that do not intend to enter the Chinese market for the time being should also watch out for the impact brought about by the global economic integration. The wide use of modern means of rapid communications and mass media, the internet included, has greatly changed our life in such a way that any brand, once announced or used in any part of the globe, is likely to be preemptively registered by someone in bad faith in China under the "first-to-file" principle immediately after it or he gets to know about it.

II. Three ways to generate Chinese mark from foreign mark

In the practice today, the three widely accepted ways to generate Chinese trademarks are transliteration, free translation and combination of the two.

1. Transliteration

By transliteration is meant a way to render a mark composed of Roman letters into phonetically identical or very similar Chinese characters or words according to its pronunciation based on the international phonetic symbols. It is characterised by keeping the original phonetic features particular to the original Roman mark, embodying the alien or original features of the goods as shown in the widely known exam-

ples, such as the Chinese marks pronounced “mo tou luola” for “MOTOLOLA”, “xi men zi” for “SIEMENS”, “ni sang” for “NISSAN” and “bai er” for “BAYER”.

2. Free translation

By free translation is meant a way to render a mark composed of Roman letters into a semantically corresponding or most similar Chinese lexical items or expression(s) according to the meaning of the original mark. It is characterised by truthfully keeping the specific information and sentimental load conveyed by the original Roman mark as shown in the widely known examples, such as the Chinese marks pronounced “da zhong qi che” (meaning “auto for the public”) for “VOLKSWAGEN” and “wei ruan” (meaning “microsoftware”) for “MICROSOFT”.

3. Combination of transliteration and free translation

By combination of transliteration and free translation is meant a way to utilize the phonetic and semantic features of Chinese characters or expressions and choose suitable character (s) or expression (s) to transliterate a part or the whole of the sound of an original Roman mark and to maximally express the rich connotation or implication of the original mark. It is characterised by utilising the multiple meaning, cultural information expressed by the Chinese characters or expressions to lead consumers' to make association. It is an effective means to convey the charm of an original mark as shown in the most successful example of rendering the mark “Coca-Cola” into its Chinese mark pronounced “ke kou ke le” (meaning “delicious and enjoyable”), which is not only identical with the original mark in pronunciation and charm, but also a rhythmic and quite articulate one in Chinese. Most importantly, this translation, well integrated with the traditional Chinese culture, and showing a happy and optimistic sentiment, is very much impressive.

Taste and choice determines best translation.

Besides, in practice, reflexible application of the ways according to the special characteristics of the source Roman trademark, character of the goods, and preference of the Chinese consumers will yield well-conceived Chinese marks.

For example, the Roman trademark “FUCHS”, meaning “fox” in German, is transliterated into “fu si”, a Chinese mark having a better meaning of “good luck and blessing” in Chinese.

The Roman trademark “Rejoice”, meaning “delight or joy”, is semantically translated into a Chinese mark “piao rou”, meaning “waving slightly and soft”, used in respect of “shampoo”; the Chinese mark obviously makes people asso-

ciate the goods with the wavy softness of hair washed with the product.

The Roman trademark “BMW” is translated into the Chinese mark pronounced “bao ma” and meaning “precious horse” in Chinese. Given the global reputation of the series of vehicles made by the Bayerische Motoren Werke AG, its Chinese “bao ma” mark is obviously well conceived to suitably and vividly represent the products.

III. Varied requirements for creative conception of Chinese marks

A Chinese mark merely having a signaling function is not interesting at all, or even resentful to some Chinese consumers, or makes them much less desirous to buy the goods in respect of which the mark is used. Therefore, a well-conceived Chinese trademark is true to its original Roman trademark, and, as well, loaded with beautiful implication to make it possible for the mark to be fully understandable to the consumers in the Chinese market.

To this end, a good Chinese mark should meet the two requirements as follows:

1. Legal requirements (with account taken of intrinsic distinctiveness)

Under the Chinese Trademark Law, only distinctive marks are registrable. Unlike translation in the ordinary sense of a word, what is most important about the creative conception of a Chinese mark is always its distinctiveness. A well-conceived Chinese mark that cannot be successfully registered would make all the money put in advertisement in the early days to no avail, with the consequence of delayed marketing the products at least, or being unfavourable to the future brand promotion of the Chinese mark at the worst owing to its legal flaws or inadequacy. This is obviously what all businesses should try hard to avoid.

For example, the Toyota Jidosha Kabushiki Kaisha once made a large-sized SUV type vehicle “PARDO”, a vehicle very well received in the market in China. When Reported, the vehicle was referred to in the auto media in China as “ba dao” (meaning “domination” and “road” respectively in Chinese) as its Chinese mark. Literally, it was not a bad Chinese trademark to go with the Roman counterpart, but the Chinese trademark, as a whole, merely has an absolutely derogative dictionary meaning of “arbitrariness”. Under the Chinese Trademark Law, the Chinese trademark would be held to be

“detrimental to the socialist morality or having ill effect”.⁴ Finally, the Toyota Jidosha Kabushiki Kaisha did not use “ba dao” as the Chinese mark for its Roman trademark, and instead, it used and registered the full transliteration of “ba la duo” for its original “PARDO” mark.

2. Cognitive requirements (with account taken of market promotion)

Besides being distinctive, a good Chinese mark should be conceived with account taken of the possible cognitive effect on market promotion. As the Chinese saying goes, “anything lacking substance will not go far.” A business trademark in Chinese must be compatible with its corporate image or the image of its products, and convenient for market promotion. To this end, it is better not to use any character or expression that is difficult to pronounce, write or read, and unpleasant in its phonetic or lexical shape. In other words, a good Chinese trademark should be brief, unique, vivid, and easy to pronounce and unforgettable. As a case in point, the Inter Ikea Systems B.V. has created the Chinese mark pronounced “yi jia” (meaning “suitable or appropriate home”) for its Roman trademark “IKEA” by way of combining of transliteration and free translation. As a whole, the Chinese trademark “yi jia” for “IKEA” has the meaning of “suited to bring harmony to a family”.

In conceiving a Chinese mark this way, account should also be taken of the imagery association between the character of the goods and the corporate brand in order to enhance its cognitive effect on the market.

Take for another example, the Volkswagen AG has created a Chinese trademark “tu an” by way of combining of transliteration and free translation for its MPV bearing the mark “TOURAN” marketed in China, wherein the character “tu” means “road or route”, and “an” “quiet and safe”. It is a wonderful Chinese trademark composed of such Chinese characters which mean wishing the driver and passengers “safe on the road”. The character “an” in the first tone really makes people feel safe and secure. Indeed, this Chinese trademark has wonderfully interpreted the intrinsic character and concept of humanistic concern as shown in the model of vehicle.

Additionally, the Volkswagen AG has marketed another model of SUV with mark “TOUAREG” in China. It is said that the Roman trademark derives from the name of a tribe that have survived the severe natural environment in the Sahara Desert. Unfortunately, it is very hard to pronounce. Creating a Chinese trademark for it requires correct understanding of

the implication of the mark to arrive at a Chinese rendition combining the semantic load and phonetic charm. Eventually, the Volkswagen AG decided on the Chinese trademark pronounced “tu rui”, with the character “rui” meaning “acute, sharp and vigorous” in Chinese. This forth-tone character conveys a sense of strength and courage. The Chinese trademark “tu rui”, portraying an image of running foreword and irresistibly, is a term indeed very well suitable to stand for the SUV model.

Both the Chinese trademark “tu rui” for the SUV model of “TOUAREG” and the Chinese trademark “tu an” for the MPV model of “TOURAN” are resonant and articulate. It is praiseworthy that the same Chinese character “tu” has been chosen to be the first character of the two Chinese trademarks, which is a fine example of excellent collocation in Chinese showing both distinctive character of the image of the two vehicle models and the intrinsic association between the two brands.

IV. Recommendations for the creation of Chinese trademarks

Foreign businesses that have just entered the market in China need to have their Chinese marks corresponding to their Roman marks, and those now operating in the market in China and having got their Chinese marks would also find it possible to design new and better-conceived Chinese marks to create a good image in the marketplace. To this end, how to create a good Chinese mark? This writer would like to make the recommendations as to the following on the basis of his years of practice as a trademark attorney:

1. House mark: transliteration only

Adoption of a Chinese mark generated by way of transliteration of a Roman mark will lay a good foundation for the simultaneous development of localisation and globalisation of a brand. From the perspective of the globalised business operation, a business should first consider the unity of its brand image (at least the phonetic unity). Only in this way is it possible to keep the sound of its Chinese mark consistent and intrinsically related to its Roman trademark under the environment of global economic integration. In fact, some foreign businesses have long been aware of this, and adopted their Chinese trademarks transliterated from their respective Roman trademarks to replace those generated by way of free translation from their Roman trademarks as

shown in the examples, such as “MAXELL” from “wan sheng” (a Chinese trademark of free translation) to the transliterated “mai ke sai er”; “LEXUS” from its Chinese trademark pronounced “ling zhi” to “lei ke sa si”, all with the latter Chinese trademark more phonetically consistent to the original Roman trademark.

2. Average mark: free translation or combination of free translation and transliteration, with well-kept distinctiveness

From the perspective of marketing, a mark somewhat implying the feature of its goods is viewed as a good mark. An implicit mark meets and reflects consumers’ specific cultural background and psychological demands, and is, as well, more cost-effective in brand promotion. As the practice shows, adoption of free translation, particularly using the way of combining free translation and transliteration, of a Roman-letter mark will exactly generate a Chinese mark with some implicitness and localised expression as is the case with the Chinese trademark pronounced “fen ling” a Finnish company uses for its Roman trademark “FEELINGS” in respect of such goods as “coating material, paint”, with the Chinese character “fen” meaning “fragrance” and identical with the first character of the Chinese word “fen lan” for the country of Finland and the other character “lin” meaning “beautiful jade”. This Chinese trademark skillfully implies that the goods in respect of which the Chinese trademark is used comes from Finland and is environmentally friendly.

3. Way of presentation: simple and brief

Only a simple or brief mark, be it English or Chinese, is impressive. With such huge quantities of information available every where, being the most attention-catching is most important to any business. A simple but impressive mark is evidently easy to remember. For that reason, it should be kept in mind to use simple, other than complicated, Chinese characters or words as its Chinese trademark composed of no more than four Chinese characters with simple, clear and easy-to-write strokes.

4. Audio effect: not using homophones of derogatory lexical items

Different pronunciation of Chinese trademarks has different audio effect, and creates different association on the part of consumers. For the sake of market communication, a good Chinese trademark should be easy to articulate, rhythmic, and pleasant to consumers. Any creation of Chinese trademark should be avoided whose homophonic lexical items brings bad association due to their derogatory meaning. Take for example the Chinese trademark pronounced

“shi bai”. While the two characters composing the mark are not improper *per se*, the fatal defect thereof lies in the fact that they are the exact homophones with another Chinese word that is pronounced “shi bai”, and means “failure”. Using such Chinese trademark would show that the proprietor’s business is possibly not far from failure.

5. Form of writing: written in common printing font

For a foreign person, the Chinese characters are nothing but pictographic. Especially, the characters in the simplified form used in mainland China are quite different in form from those in the complicated form used in the Taiwan region, Hong Kong SAR, Macao SAR and Singapore. According to the practice under the Trademark Law in China, protection of Chinese trademarks in the simplified form is automatically extended to those written in the complicated form, or vice versa. But the spreading of simplified Chinese characters is inevitable due to the economic development in mainland China. It is a far-reaching and wise choice to use a Chinese mark in simplified Chinese characters.

Besides, a Chinese mark may also be written in a special calligraphic form. As a form of artistic creation, the calligraphic form, which is highly artistically expressive and visually appealing, is quite attention catching. However, a Chinese mark written in a standard printing font is clearer and easier to write. Further, according to the practice under the Trademark Law in China, protection of Chinese trademarks in a standard printing font is automatically extended to those written in any other calligraphic form; hence, normally, Chinese trademarks should be in the common written form.

6. Adapting, in a timely manner, Chinese marks to the changed position of brands

As the Chinese saying goes, “one has to go along with the times”. Very often, it is necessary to make proper adjustment of Chinese trademark of a foreign brand in response to the changed market position of that brand, by altering some Chinese character or word in the Chinese mark to enhance its expressiveness without changing the over-all form of said mark.

For example, when just entering the Chinese market, Philips used the Chinese trademark pronounced “fei li pu”, with the first character in the form of “菲”. It is a straight and narrow transliterated Chinese trademark, and it is in the common phonetic form of the “Philips” as a foreign surname. This Chinese trademark helps Chinese consumers realise that the brand comes from a foreign family business. Later, the Chinese trademark of “PHILIPS” is changed into one

pronounced “fei li pu” with the first character written in the form of “飞”. Though different in only one character, the two Chinese trademarks of “PHILIPS” result in varied sense and sensitivity. The former Chinese character “fei (菲)” means “humble or unworthy”, while the latter “fei (飞)” “flying or swift”. This change has added a touch of localisation and intimacy, weakened foreign element or implication, and reduced the association with family. Furthermore, the revised Chinese trademark seems to be more dynamic and energetic, depicting Philips’ corporate conception of dedication to technological innovation in response to the rapidly developing world.

V. Conclusion

It is no easy job to render a mark from one language into another while keeping the original style and implication intact. Conceiving or creating a successful Chinese trademark has a bearing on the survival and growth of a business in the ferociously competitive market. As a process of recreation, creating a Chinese trademark involves considered reflection of the special corporate character and respect for the public aesthetic sentiment, and attention to cultural difference to achieve a harmony of the lexical and phonetic charm within the Chinese trademark.

The trademark practitioners with Chinese as their native language obviously should be professionally insightful, and fully aware of the corporate culture and brand image of foreign businesses. In this regard, foreign businesses are advised to appoint experienced senior professional trademark attorneys to plan and design well-conceived Chinese trademarks for them. Only in this way is it possible to innovatively create Chinese trademarks that perfectly present the inner meaning of their brands, present the charm of their products, and are compatible with the culture and customs of the consumers on the basis of correct understanding of their original Roman marks to attract consumers and eventually turn their Chinese marks into their valuable intangible assets. ■

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¹ It needs to be noted that some local governments have issued regulations and rules, requiring businesses to use Chinese marks at the venue of their business operation. For example, Article 11 of the Measures for

Implementing the Law of the People’s Republic of China on the National General Language and Writing System issued by the Shanghai Government becoming effective on 1 March 2006 that the “standard written characters or words should be used on the packages, specifications, signboards of goods marketed in Shanghai”. Since then, on all foreign brands solely with English indications in the stores and markets in Shanghai must be attached with Chinese marks at the proper, conspicuous places.

² See the Chinese Trademark Office’s Official Letter No. 20/2001; Letter of Reply to the Questions on the Follow-up Trademark Issues Raised by the EU and Japan.

³ Some globally renowned trademark search authorities used to determine whether Chinese trademarks were similar to Roman trademarks according to the composition of Chinese pinyin of Chinese trademarks under watch. Obviously, this is a wrong way of comparison, and any conclusion made this way is not convincing.

⁴ See Article 10, paragraph one (8) of the Trademark Law.

