

Protecting Famous Names in China – Michael Jordan and His Eight-Year Trademark Battle in China

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On March 26, 2020, the Chinese Supreme People's Court (the "**SPC**"), the highest court in China and thus China's equivalent to the United States Supreme Court, issued its re-trial decision, giving Michael Jordan an assist against Registration No. 6020578 for the mark "Qiaodan in Chinese characters & Design" in Class 25 owned by

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Qiaodan Sports Co., Ltd ("**Qiaodan Sports**"), a Chinese sportswear company based in Fujian Province of China. "Qiaodan" in Chinese characters is a commonly recognized phonetic translation for the name "Jordan" and the design in the mark is that of a basketball player in midair attempting a layup.

China's top court ruled in favor of Michael Jordan in the re-trial decision by recognizing the former National Basketball Association superstar's prior rights in the name "Qiaodan in Chinese characters", in which an established link to Michael Jordan was found by the SPC based on the evidence in the trial. Specifically, Qiaodan Sports had argued in the previous proceedings as well as in the re-trial that there was a lack of an exclusive link between Michael Jordan and "Qiaodan in Chinese characters" because (1) "Qiaodan in

Chinese characters” has its own meaning -- “grass and trees of the south” in Chinese and (2) even if “Qiaodan in Chinese characters” can be regarded as the corresponding Chinese translation for the name “Jordan”, “Jordan” itself is merely an ordinary surname in English and an exclusive link to Michael Jordan had not been established based on the evidence in the trial.

These arguments were not entertained by the SPC. In its re-trial decision, the SPC went through the evidence on the use and reputation of Michael Jordan in detail and took the view that the evidence established a link between “Qiaodan in Chinese characters” and Michael Jordan, which gave rise to the necessary name rights protection to Michael Jordan. Therefore, the SPC quashed the decisions of the lower courts and ordered the invalidation case to be returned to the China National Intellectual Property Administration for re-review (the **CNIPA** has merged the previous PRC Trademark Review and Adjudication Board (“**TRAB**”)) . As such, it is almost a foregone conclusion that the CNIPA’s re-review decision will result in a victory for Michael Jordan.

This case is the last of a series of high profile trademark invalidation actions that Michael Jordan had commenced in 2012 with the TRAB against Qiaodan Sports’ 78 objectionable trademark registrations for marks that the former NBA basketball player believed infringed his name rights, among other legal violations. These actions failed in the TRAB as well as in the subsequent appeal to the Beijing First Intermediate People’s Court and the further appeal to the Beijing High People’s Court in 2014 to 2015. In rejecting Michael Jordan’s claim for protection of his name rights, the Beijing High People’s Court held that there was insufficient evidence to establish an exclusive link between the mark “Qiaodan in Chinese characters” and Michael Jordan.

Michael Jordan sought the SPC’s leave for a re-trial of the 78 cases. The SPC granted leave for re-trial in 10 cases and eventually ruled in favor of Michael Jordan in four of the re-trial decisions, including the present one. This means that Michael Jordan wins 4 of the 78 cases against Qiaodan Sports. It is reported that the main reason for the low success rate of Michael Jordan’s actions is the undue delay in the commencement of those actions because Chinese Trademark Law provides a five-year time bar on the invalidation of a trademark registration in China. Most of the 78 trademark registrations of Qiaodan Sports had been registered for more than five (5) years in 2012 when the actions were commenced.

It can be seen from the re-trial decision that the SPC has shifted from the “exclusive link” approach adopted by the Chinese courts in the past (such as by the Beijing High People’s Court in the further appeal of the present case) to a more relaxed “established link” approach. This is like an alley-oop to rights owners, as it sends out a message to the public that China will be less likely to tolerate the free-riding activities of trademark squatters who register famous names as trademarks.

On April 8, 2020, Qiaodan Sports posted an announcement via its official Weibo account to its business partners that based on the company’s win in 74 of the 78 cases, including those relating to the company’s core registrations for the mark “Qiaodan in Chinese characters”, “Design” and “QIAODAN”, the present re-trial decision will not affect the

company's use of its existing trademarks and will not affect the company's normal business operations.

Qiaodan Sports' announcement might not quite reflect the real situation. Here's an instant replay: around the same time of the commencement of the 78 trademark invalidation actions in 2012, Michael Jordan also filed a civil lawsuit against Qiaodan Sports for infringement of his name rights and portrait rights with the Shanghai Second Intermediate People's Court. This last minute civil action frustrated Qiaodan Sports' first IPO in China, which had been scheduled for listing in March 2012. The civil action with the Shanghai Court is still pending. Qiaodan Sports came back with its second attempt of an IPO in April 2019 in China. Its IPO application has passed the preliminary review and is pending the second review at the China Securities Regulatory Committee. The SPC re-trial decision issued at this critical period has overshadowed Qiaodan Sports' second IPO application and has brought uncertainty to its outcome. The decision will also provide great support to Michael Jordan's civil action in Shanghai.

We will likely see an increasingly stronger defensive strategy in the form of IP protection in China going forward. The best way forward for Qiaodan Sports is perhaps to pivot and re-brand away from the current infringing name.

From a U.S. standpoint, this case demonstrates the importance of worldwide protection of trademarks and protection of the right of publicity, where applicable. As celebrities' stars shine brighter, it is important to also think about the value and monetization of a personal brand, and to protect that brand by registering it with trademark offices in key jurisdictions where there are lots of fans and where goods and services are sold, licensed, and/or manufactured.

In addition to the right of publicity protection that is available to celebrities in most U.S. states, federal trademark registration is possible in the U.S. for names and symbols used by celebrities to offer goods and services. It follows that international registration is also available for celebrities who sell and license products and services to consumers in other countries using their names and symbols. We at the TMCA have published numerous blog articles about celebrities protecting and enforcing their personal brands in the U.S. (some more successful than others), including [Beyoncé](#), [Lindsay Lohan](#), and even newborn [Psalm West](#). Celebrities with international appeal should take heed of the **Qiaodan Sports** litigation saga as a case in point where acting early to protect global rights would have saved Michael Jordan from eight years of litigation and a Chinese doppelgänger brand clouding his image.

Beyond the U.S. and a few other common law countries that allow for protection of unregistered names and symbols, it can be difficult to enforce trademark rights against an unauthorized user of a mark if they were first to file a trademark. Such "first to file" countries do have laws against bad faith squatters as well as special laws protecting famous marks. However, the evidentiary standards can create hurdles, especially in cases like the **Qiaodan Sports** case in China, where the mark might be subject to various translations and it may be difficult to show an "established link" let alone an "exclusive link" between the infringing mark and the celebrity based on the available

evidence. This case is helpful for rights holders going forward in China, though filing early and often remains the best strategy for global branding.

For previous articles written by Dorsey on this topic, please see: [Protecting famous names](#) and [It's all in the name: protect your own in China](#).