

## INTELLECTUAL PROPERTY

# Canadians should understand Chinese marks

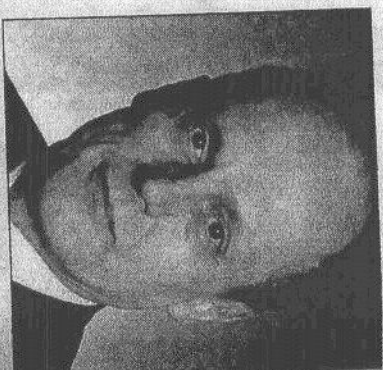
By Paul Jones

Chinese is now the third most commonly spoken language in Canada, but a recent Federal Court decision on a motion for summary judgment, *Yee Hong Centre for Geriatric Care v. Grace Christian Chapel* [2006] F.C.J. No. 825, suggests that it is not always well understood by trade-mark agents and judges. Although the users of the services would better understand the Chinese character ver-

sion of the mark, only a transliteration of the sound and a logo were registered.

The Yee Hong Centre operates nursing homes in the Toronto area for people of Chinese descent and has done so for many years. In 1999, a few months before the decision of the Federal Court in *Cheung Kong (Holdings) Limited v. Living Realty, Inc.* [1999] F.C.J. No. 1966, where the test for confusion was set as the impression of those who can read Chinese characters, they applied for registrations of the trade-marks "YEE HONG" (now registered as TMA538,223) and "YEE HONG CENTRE FOR GERIATRIC CARE DESIGN" (now registered as TMA538,222).

In defence of the passing off claim the Vancouver organization takes the position that the registration of "YEE HONG" provides very limited protection, because only the Cantonese transliteration was registered, and not the actual characters. Chinese is considered to have one writing system but seven major dialects. Some linguists consider Cantonese as different from Mandarin as Portuguese is from Romanian. In Mandarin the two characters are pronounced "yi kang".



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In Chinese the only definitive expression of a concept is in the written character, and not in the sound. In all dialects Chinese uses a very limited number of syllables so that many characters have the same pronunciation. The Chinese language acquisition occurs in a different area of the brain than English; an area associated with motion and writing, rather than one associated with listening and sounds. Thus "YEE HONG"

could also represent other characters. "Yee" or "yi" by itself is used as the sound for at least 124 characters.

The Vancouver group also claimed the two Chinese characters are generic with reference to rest homes and nursing homes. The first character is part of a expression in Chinese (see Fig. 3 meaning "to take good care of oneself so as to fulfill one's allotted lifespan." The two Chinese characters are a term used for rest home



Fig. 1

The design mark, as shown in Fig. 1, has two Chinese characters that are transliterated in the applica-



Fig. 2



Fig. 3

see YEE HONG p. 15

## Chinese market is growing

YEE HONG

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in Hong Kong as a Google search will show. When the Toronto organization registered their logo in Hong Kong (Trade-mark No. 2003B02087) they disclaimed the exclusive use of the two characters separately. The Toronto organization did not register the mark "YEE HONG" or the two characters in Hong Kong.

There appears to be less use of the two characters in association with rest homes in the People's Republic of China, where the official language is Mandarin. This may be because the concept of a rest home or retirement home is not as well-developed there. The Chinese character mark may possibly be best described as suggestive of the wares and services

rather than descriptive.

Both parties in this case submitted affidavits from experts, but these did not appear to clarify matters for the judge. In paragraph 6 of the judgment, the judge refers to "Mandarin" when the context makes it clear that she meant to refer to "Cantonese."

Although the plaintiff took the position that there was no genuine issue for trial because its rights to the marks had been established through extensive use and registration, the judge decided that because of the conflicting evidence as to the sound and meaning of the two Chinese characters that the matter could be resolved only upon the submission of a full evidentiary record at trial.

The outcome may well have been different if the two Chinese

characters had been registered by Yee Hong Centre initially. If the characters were appropriately described the issue of the variations in the pronunciation could not then have been raised as a defense. And the action could have been for infringement instead of passing off which is more difficult to prove. It is not known why the Hong Kong registration was not presented by either party in support of their position.

The Chinese speaking market is growing in importance, and an understanding of marks and their linguistic elements are important aspects in the careful preparation of trade-mark applications for use in such market.

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