

Kluwer Trademark Blog

Your Tang isn't my Tang

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Let us start this article by asking two questions – would you be confused by a take-away Chinese and a posh Chinese restaurant in central London even if they share the same name? Will you convince yourself that a Mayfair Chinese restaurant has opened a branch in your small village and offers late-night take away?

This case gives legal answers to these questions. The claimants run a luxury Chinese restaurant at the Dorchester hotel in central London near Buckingham Palace. The defendants run a small take-away Chinese whose customers are located no more than 3-miles away in a coastal town in north England. The claimants own a UK registration No. UK00002415093 for a figurative mark where the word CHINA TANG is the dominant element. The defendants' take-away shop is called CHINA TANG. The key battlefield is the comparison of the marks.

The defendants argued that CHINA TANG lacks distinctiveness. The court agreed that CHINA is allusive for a type of food. The arguments were then concentrated on how to interpret the word TANG.

The defendants argued that TANG is a common Chinese name, but the judge decided that due to lack of evidence, “I have no idea whether it is the equivalent of Smith or Jones and cannot assume anything in that regard”. Whilst my Chinese experience tells me that Tang indeed is a common Chinese surname and Chinese speaking consumers could easily take CHINA TANG as referring to a Chinese take-away/restaurant run by a family called Tang, not adducing evidence on this crucial point but simply asking the court to take judicial notice ran the risk that the court could decide against them. Furthermore, this argument is unlikely to sufficiently prove that the mark is descriptive, because it is difficult to claim that average consumers perceive CHINA TANG as a “shorthand” of a restaurant run by Tang family and there is an immediate and direct link between them. Whilst the judge did find that the average consumer of restaurant services consists of both Chinese speaking and non-Chinese speaking consumers (for which it would be more unlikely to perceive TANG as a Chinese name), the mark CHINA TANG would not be found descriptive in the best case scenario for the defendants.

The defendants also made additional arguments that TANG is descriptive, such that TANG means China. These arguments were rejected by the court on the basis that average consumers in the UK will not make this association. Although TANG could be translated as referring to China in the minds of Chinese speaking customers, it is hard to argue that this translation (? , TANG) would create an immediate and direct link between the mark and Chinese food, because the translated

Chinese character ? will simply not be used to associate with food in Chinese language.

Subsequently, the court found marks are similar. As the court already found that the goods and services are similar, the findings of the likelihood of confusion and trade mark infringement followed. Honest concurrent use defence did not help the defendants, because the defendants did not carry out trade mark searches before using their CHINA TANG name.

If we now go back to the questions at the beginning of this article, I still think that the answer to both questions is most likely to be “no”. This explains why there was no evidence of actual confusion in this case over 12 years of co-existence between the claimants and the defendants, and why the court found no misrepresentation in the claimants’ passing off claim. The different outcomes are a reminder that passing off is based on actual goodwill accrued through use whereas trade mark infringement is based on notional and fair of the mark across the whole registration. Had the claimants not registered the trade marks, they would have lost this case.

From the defendants’ point of view, introducing evidence on crucial legal points and carrying out trade mark searches before using their mark are the lessons to learn. Although the additional evidence may not change the decision that the mark CHINA TANG is distinctive, it would help the defendants to argue that the mark has a low degree of distinctiveness. This will help the defendants to argue that there is no likelihood of confusion.

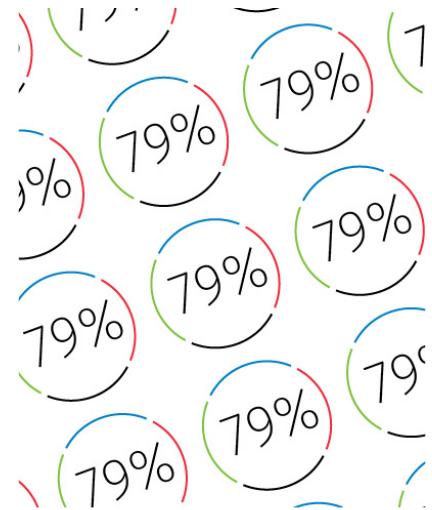
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