

## **Asian characters: a good fit for trademarks in the EU?**

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How is a trademark containing or composed solely of Asian characters assessed in the EU? This question is especially of interest to Asia-based businesses seeking to bring their brands to the EU market while retaining the corporate identity that they have developed in their home countries.

While the question can be put simply enough, the answer turns out to be more complex. From the standpoint of a counsel advising a business on how best to protect such a mark when entering the EU market, several headache-inducing questions may come up concerning the relationship between the elements of the mark and the protection granted by the registration, as well as the ease with which the trademark's rights can be enforced. For example:

- ✓ What is the scope of protection of a sign composed solely of Asian characters? Would a registration create rights which can be enforced properly?
- ✓ Can the end consumer in the EU even memorize such a sign, hence linking it to a single commercial entity?
- ✓ If the sign is composed of word elements in Latin characters next to the Asian characters, will the later even be taken into consideration in the assessment of the risk of confusion?

Even if the answers to these questions ultimately depend on the specifics of the mark being assessed, one can nevertheless discern some general ideas that can help a counsel orient an assessment of the situation. With this in mind, here are some pain-relieving guidelines for making the right decisions when considering the use and registration of such trademarks in EU territory.

### The end consumer in the EU can neither voice nor assign a meaning to them

The first thing to consider is that Japanese, Chinese, Korean, or other Asian languages or scripts are not official languages in the EU. Thus in principle, they are not considered to be understood by the end consumer. Moreover, even if we cannot deny that the EU includes many people speaking and reading various Asian languages, it is hard to tell whether as a group they represent a substantial proportion of all of the consumers in the EU. Except in the rare cases where a brand targets a very specific consumer base that can read them, these scripts are thus considered as being illegible to a European consumer base.

In general, the relevant public in the EU will not be able to pronounce Asian characters or link them to a specific meaning. With this in mind, visual similarities remain as the only basis of comparison when considering two signs made up solely of Asian characters. That being said, as end consumers in the EU would in general be unable to read these characters and assign them a specific meaning, they can

hardly be expected to retain the visual form of the sign, let alone reliably and consistently tell it apart from other signs composed of Asian characters.

When confronted with a sign composed solely of an Asian script, end consumers in the EU will very likely perceive it as an abstract, graphical sign. At best, they will guess that the use of an Asian script signals the Asian origin of the sign. At worst, they will have trouble memorizing – and hence, recognizing – the sign, as they are not familiar with Asian scripts and cannot anchor them to anything they recognize or link them to a meaning.

These considerations indicate to us that the scope of protection of a sign composed solely of Asian characters is limited and that such rights are difficult to enforce in the EU. This is definitely something to take into consideration when entering the EU market with such brands.

### From Tokyo to Alicante

We can see that Asian script occurring in a sign will be assessed as a purely abstract, figurative element. But what will its impact be when assessing signs which are composed of Asian characters alongside Latin characters?

Taking Asian script into consideration when comparing two signs will depend on the context of the case and on the particulars of each sign. While there is no rule that governs each case, it is worth keeping in mind that on the basis of the size and positioning of the Asian characters in relation to the other elements of the mark (e.g. words in Latin characters), the Asian script will bear greater or less weight in the comparison.

Depending on the overall impression that the signs may be interpreted as giving to the consumer, the Asian characters may sometimes be perceived as making a difference, in that they function as an eye-catching allusion to an Asian origin. Other times, however, they may just become part of the background of the sign, as the consumer may not be able to memorize such characters and differentiate two signs based on them solely.

But in general, it is safe to assume that, if the signs are identical or quasi-identical on the basis of the Latin characters which compose them, it is very unlikely that the use of Asian characters will change this perception.

### What to do with all that?

When assessing whether or not to enter the market with a brand containing or composed solely of Asian characters, the following elements need to be considered in the decision:

- ✓ The registration of a trademark composed solely of Asian characters will enjoy a limited scope of protection and the rights attached to it may be difficult to enforce.
- ✓ When the trademark is composed of Asian characters alongside Latin characters, the Asian characters may or may not shift the balance when assessing the similarities between the signs.
- ✓ If the word elements appearing in Latin characters are identical or quasi-identical, the addition of Asian characters will not change the fact that similarity will be granted.

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After earning her Master's Degree in Law at the University of Geneva, Anca Draganescu worked for several years in communications and branding in the business, cultural, and not-for-profit sectors. She most recently served as the Director of Communications at a global organization, where she was in charge of internal and external corporate communications. She thus brings broad and deep knowledge of different corporate settings, which informs her legal advice.

Before joining Novagraaf Switzerland SA, Anca worked as a consultant for the WIPO and as an IP counsel at different firms in Geneva, where her clients included both local small businesses and major global corporations. She specializes in trademarks, domain names, branding and visual identity creation, designs, and copyright.

Anca also holds a Master's Degree in Anthropology and the History of Religions from the University of Chicago. She is a member of the AROPI (Association Romande de Propriété Intellectuelle) and speaks French, English, Romanian (working knowledge of German and Italian).