

---

# Michael Jordan's Salm Dunk in Trademark?

*Michael Jordan vs. Qiaodan Sports Company*

---

# Where the Battle Comes From



Air Jordan XI, the Bred



Qiaodan Basketball Shoes

# History Review

The Chinese word, “乔丹”, had appeared in Chinese newspapers and on Chinese TV broadcasts of NBA games.

Qiaodan Sports filed a trademark registration for a jumping basketball player logo with additional Chinese character “乔丹”.

- Qiaodan Sports Company completed the pre-disclosure
- MJ announced he was going to sue Qiaodan Sports.

1984



- Michael Jordan joined NBA.
- Chicago Bulls picked Michael Jordan on the 3<sup>rd</sup> draft in the 1<sup>st</sup> round.

1996



1997



- Michael Jordan won his 5<sup>th</sup> NBA championship.
- A Chinese Company registered as Qiaodan Sports Company (乔丹体育).

2002



Qiaodan Sports filed a trademark registration for a jumping basketball player logo with additional Chinese character “乔丹”.

2011



- Qiaodan Sports Company filed IPO to SEC China.

2012



- Qiaodan Sports Company completed the pre-disclosure
- MJ announced he was going to sue Qiaodan Sports.

# Qiaodan Sport's IPO Pre-Disclosure

The pre-disclosure documents discussed the potential risk on trade name and trademark

序号	商标注册人	商标	类别	注册号	申请日期	核准日期至权利到期日
1	本公司	乔丹	25	3148047	2002-4-16	2003-09-28 至 2013-09-27
2	本公司	乔丹	25	3148049	2002-4-16	2004-05-07 至 2014-05-06
3	本公司	QIAODAN	25	3148050	2002-4-16	2003-10-21 至 2013-10-20
4	本公司		25	3028870	2001-12-3	2003-03-21 至 2013-03-20

## Qiaodan's registration

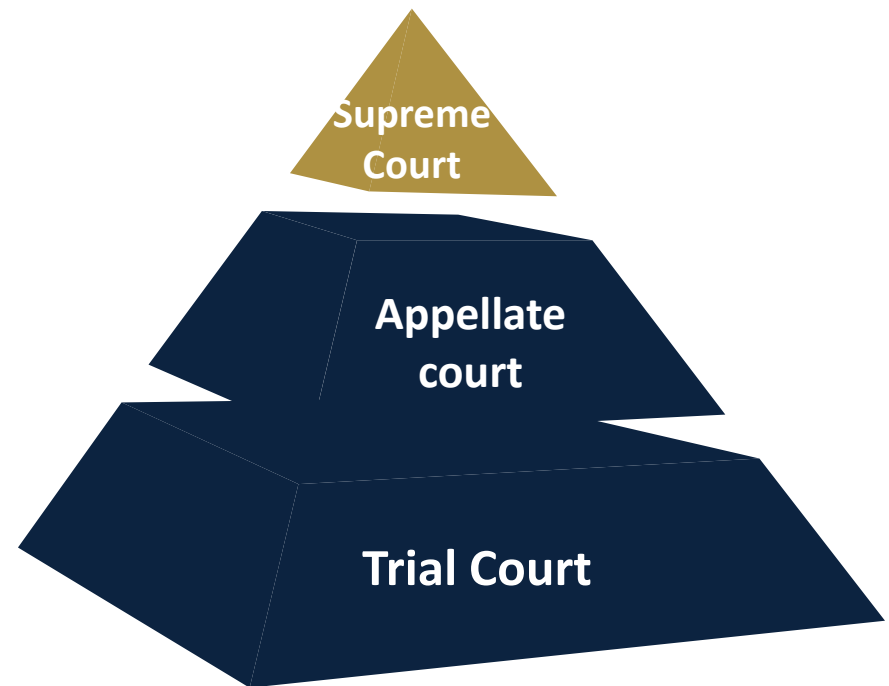
- Issuer's trade name and major product trademark “乔丹” and former U.S. professional basketball star Michael Jordan Chinese transliteration name “Michael Jordan” **shared the same last name, “乔丹”**.
- However, the issuer and Michael Jordan currently do not have any commercial partnership and has **never used his image** for promotion.
- The issuer has the **exclusive right of the registered trade name and trademark “乔丹”**. These rights are subject to legal protection in China.
- **Neither** the issuer's trade name nor the registered trademark **infringes** Michael Jordan's name or other rights.

注册号	商标	类别	申请日期	核准日期至权利到期日
605003	MICHAEL JORDAN	25	1991-5-25	1992-07-29 至 2012-07-29
643806		25	1992-6-12	1993-05-27 至 2013-05-27
4932232		28	2005-10-8	2009-06-28 至 2019-06-27
6700479	迈克尔乔丹	28	2008-5-04	申请中（驳回复审）
7350128	JORDAN	18	2009-4-24	商标已无效
7752574		18	2009-10-13	申请中（驳回复审）
7752573		28	2009-10-13	申请中（驳回复审）
7752572		35	2009-10-13	申请中（驳回复审）
7752571		25	2009-10-13	申请中（驳回复审）
7455399		25	2009-6-9	申请中（驳回复审）

## Nike's registration

# Trial Procedure

- ✗ In December, 2016, the Supreme Court partially affirmed and partially reversed lower courts' decisions.
- ✓ In July, 2015, the Appellate Court affirmed the lower courts Decision.
- ✓ In October, 2014, the Trial Court ruled in favor of Qiaodan Sports Company and decided there was no trademark violation.



# Chinese Lower Courts' Judgment



- First file, first to have right (China)
  - Somewhat like UCC filing system
  - Different from U.S. trademark system
    - First to use, first to have right (USA)
- Shadowy jumping logo does not infringe
  - “The image of the disputed trademark is a human body in a **shadowy design**, which **does not clearly reflect the major appearances** of the figure. It is **hard** for the relevant public to recognize the image as Michael Jordan.”

## *Regulation on the Implementation of the Trademark Law of the People's Republic of China*

### – Article 31:

- No trademark application shall infringe upon another party's **existing prior rights**.
- Nor shall an applicant rush to register in an unfair manner a mark that is **already in use by another party** and enjoys **substantial influence**.

# Issues in the Supreme Court



The two issues in the Supreme Court is about the application of Article 31 in Chinese trademark law:

- (1) Whether MJ has a prior right to his Chinese name “乔丹”.
- (2) Whether MJ has a prior right to his Chinese name pronunciation spelling “qiaodan”.



# Supreme Court's Benchmark Criteria



The Supreme Court set a 3-step benchmark criteria to determine whether Michael Jordan has any **prior right**

to make Article 31 applicable; And

to make Qiaodan Company's registration *void*:

- The name/trademark has a certain reputation in China and is known to the public
- The public use the name/trademark to refer to the natural person
- The specific name/trademark has established a stable correspondence with the natural person

# Finding of Fact/Evidence Submitted



## Michael Jordan submitted the following evidence:

- Evidence to prove Michael Jordan's popularity in China
- Evidence to prove Michael Jordan's **specific basketball image**
- Reports on Michael Jordan's involvement in business activities and his business value
- Evidence to prove the relationship between Jordan and other companies (Nike)
- Other trademark registration information of Chinese Qiaodan Company and its affiliates
- Other evidence to support Chinese Qiaodan Company's malicious registration
- Median reports and public commentary materials related to the case
- Court dockets from trial court and appellate court
- Investigation report, related due diligence reports and comments on the public's perception of "Jordan" and **misidentification of the relationship** between Qiaodan and Michael Jordan
- Other relevant evidence. Evidence from media reports submitted by Michael Jordan shows that since 1984, Michael Jordan has been regarded as a basketball star by "Contemporary Sports", "Sports Expo", "New Sports", "Basketball", "World of Sports", "China Newsweek", "Encyclopedia of Middle School Students", "Chinese Advertisement", "Business and Management", etc. **Most Chinese media have reported that they use "乔丹" to refer to Michael Jordan.**

# Finding of Fact/Evidence Submitted



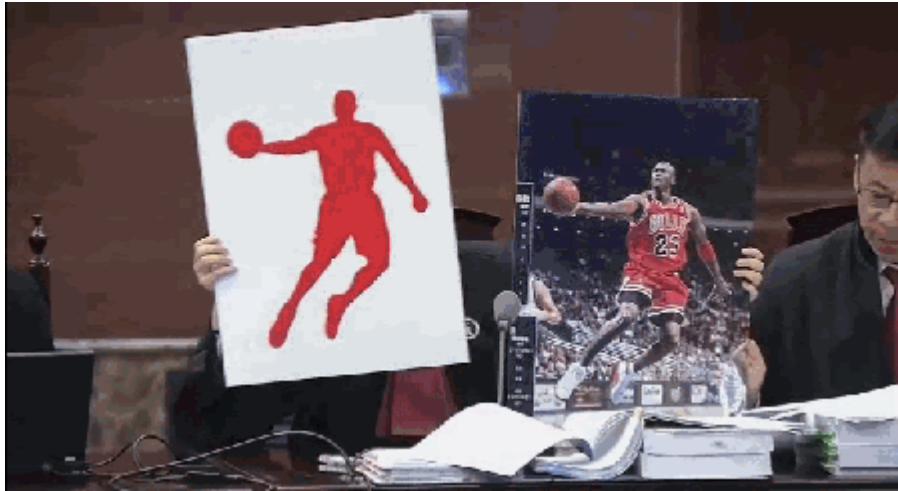
## Qiaodan Sports Company submitted the following evidence:

- An explanation of the term “乔丹” , reports from other celebrities whose last name is “乔丹” , statistics on the Chinese citizen ’s name “乔丹”
  - “乔丹” **means beautiful woods in the south in Madrin**
- Evidence to prove that there is no corresponding relationship between the disputed trademark and Michael Jordan
- Qiaodan company trade name registration, evidence of usage & Qiaodan company trademark registration certificate
- Qiaodan Company's advertising audit report, advertising contract, payment document, delivery report and other advertising evidence
- Qiaodan Company's internal financial statement audit report, operating evidence such as the opening of brand stores
- Qiaodan Company's sponsorship of sports events, public welfare activities, honors, etc.
- Honors obtained Qiaodan Company's trademarks and products
- Evidence to prove Qiaodan Company's related trademark is being protected, along with evidence to prove it is **"well-known trademarks"**
- Evidence used to prove that Jordan did not intentionally mislead the public
- Qiaodan's financial conditions, marketing activities and taxes paid in mainland China

# Supreme Court's Final Decision UNIVERSITY OF NOTRE DAME

- Chinese Supreme Court held that Qiaodan Sports Company could not continue to produce athletic shoes, clothing, and gear bearing the trademark “乔丹”, which is the Chinese transliteration of famed NBA player Michael Jordan's last name.
- The Court also ruled that Qiaodan Sports Company could continue to use the Chinese Pronunciation spelling--*Qiaodan*.
  - The Court found that the evidence was insufficient to show that Chinese consumers associated Michael Jordan with the spelling word *Qiaodan*.
    - Media will not use English pronunciations--/'dʒɔːdən/-- in articles and reports, make sense?

# Personal Criticism on the Final Judgment



*Oh!*

*Who is the shadowy image?*

Michael Jordan's attorney from Fangda Partners, best law firm in China, is presenting the image to the judge.

From my point of view, the shadowy logo should also be ruled as void because it creates sufficient confusion for the customers and mislead the majority to correlate this figure with Michael Jordan.

However, Chinese law addressing misidentification has a critical assumption: The original trademark/image must get registered.

- No registration, no right.
- If anyone registers this picture in China as trademark, then Qiaodan Sports Company's use of this shadowy logo will be a violation.

# After the judgment

- After the case, SEC China has never approved Qiaodan Sports Company's IPO application.
  - Now it is 2020 and its IPO is still pending.
  - Perhaps there is no possibility for this company to go IPO again.
- Qiaodan Sports Company started closing its retail store.
- All the other retail stores are taking off the “乔丹” word and only the shadowy jumping man logo left.



BEFORE



AFTER

# After the judgment

If we turn back to the trademark registration page:

序号	商标注册人	商标	类别	注册号	申请日期	核准日期至 权利到期日
1	本		25	3148047	2002-4-16	2003-10-21 至 2013-09-27
2	本		25	3148049	2002-4-16	2004-05-07 至 2014-04-06
3	本公司	<b>QIAODAN</b>	25	3148050	2002-4-16	2003-10-21 至 2013-10-20
4	本公司		25	3028870	2001-12-3	2003-03-21 至 2013-03-20

Trademark No. 3148047 and No. 3148049 are void.



# Takeaways

For foreigners who have strong business relationship with China:

Always Remember:

First to file, first to have right.

Learn from Lebron James:

Starting in 2004, Lebron James formed a limited liability corporation called LBJ TRADEMARKS, LLC dealing with his personal trademark affairs in China.

That LLC have filed 44 trademark registration for Lebron, including his Chinese legal name, Chinese nicknames as well as English legal name and English nicknames.



*I am also the King in the business world!  
Use your legal weapon, dude!*



# Takeaways

## Lebron's registered trademark list:

序号	申请/注册号	国际分类	申请日期	商标名称	申请人
1	14713213	3	2014年07月15日	LEBRON JAMES	勒布朗詹姆斯商标有限责任公司
2	14691222	25	2014年07月14日	勒布朗	勒布朗詹姆斯商标有限责任公司
3	14691218	14	2014年07月14日	LEBRON	勒布朗詹姆斯商标有限责任公司
4	14691218	9	2014年07月14日	LEBRON	勒布朗詹姆斯商标有限责任公司
5	9126549	28	2011年02月17日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
6	6282750	25	2007年09月18日	勒布朗	勒布朗詹姆斯商标有限责任公司
7	4986468	9	2005年11月07日	JAMES	勒布朗詹姆斯商标有限责任公司
8	4986466	18	2005年11月07日	JAMES	勒布朗詹姆斯商标有限责任公司
9	4986465	25	2005年11月07日	JAMES	勒布朗詹姆斯商标有限责任公司
10	4986464	28	2005年11月07日	JAMES	勒布朗詹姆斯商标有限责任公司
11	4903848	28	2005年09月19日	勒布朗詹姆斯	勒布朗詹姆斯商标有限责任公司
12	4903847	25	2005年09月19日	勒布朗詹姆斯	勒布朗詹姆斯商标有限责任公司
13	4903846	18	2005年09月19日	勒布朗詹姆斯	勒布朗詹姆斯商标有限责任公司
14	4903845	14	2005年09月19日	勒布朗詹姆斯	勒布朗詹姆斯商标有限责任公司
15	4903844	9	2005年09月19日	勒布朗詹姆斯	勒布朗詹姆斯商标有限责任公司
16	4903843	28	2005年09月19日	詹姆斯	勒布朗詹姆斯商标有限责任公司
17	4903842	25	2005年09月19日	詹姆斯	勒布朗詹姆斯商标有限责任公司
18	4903841	18	2005年09月19日	詹姆斯	勒布朗詹姆斯商标有限责任公司
19	4903840	14	2005年09月19日	詹姆斯	勒布朗詹姆斯商标有限责任公司
20	4903839	9	2005年09月19日	詹姆斯	勒布朗詹姆斯商标有限责任公司
21	4903828	28	2005年09月19日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
22	4903827	25	2005年09月19日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
23	4903826	18	2005年09月19日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
24	4903825	14	2005年09月19日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
25	4903824	9	2005年09月19日	天王詹姆斯	勒布朗詹姆斯商标有限责任公司
26	4903823	28	2005年09月19日	詹姆斯王	勒布朗詹姆斯商标有限责任公司
27	4903822	25	2005年09月19日	詹姆斯王	勒布朗詹姆斯商标有限责任公司
28	4903821	18	2005年09月19日	詹姆斯王	勒布朗詹姆斯商标有限责任公司
29	4903820	14	2005年09月19日	詹姆斯王	勒布朗詹姆斯商标有限责任公司

30	4903819	9	2005年09月19日	詹姆斯王	勒布朗詹姆斯商标有限责任公司
31	3937311	28	2004年03月02日	KING JAMES	勒布朗詹姆斯商标有限责任公司
32	3937240	28	2004年03月02日	LEBRON	勒布朗詹姆斯商标有限责任公司
33	3937239	9	2004年03月02日	KING JAMES	勒布朗詹姆斯商标有限责任公司
34	3937238	14	2004年03月02日	KING JAMES	勒布朗詹姆斯商标有限责任公司
35	3937237	18	2004年03月02日	KING JAMES	勒布朗詹姆斯商标有限责任公司
36	3937229	9	2004年03月02日	LBJ	勒布朗詹姆斯商标有限责任公司
37	3937228	14	2004年03月02日	LBJ	勒布朗詹姆斯商标有限责任公司
38	3937227	18	2004年03月02日	LBJ	勒布朗詹姆斯商标有限责任公司
39	3937226	25	2004年03月02日	LBJ	勒布朗詹姆斯商标有限责任公司
40	3937225	28	2004年03月02日	LBJ	勒布朗詹姆斯商标有限责任公司
41	3937224	9	2004年03月02日	LEBRON	勒布朗詹姆斯商标有限责任公司
42	3937223	14	2004年03月02日	LEBRON	勒布朗詹姆斯商标有限责任公司
43	3937222	18	2004年03月02日	LEBRON	勒布朗詹姆斯商标有限责任公司
44	3937221	25	2004年03月02日	LEBRON	勒布朗詹姆斯商标有限责任公司



# Takeaways

For Chinese local clothing companies:

Always Remember:

- Act in good faith and participate in fair dealing;
- Developing company's own culture by combining Chinese tradition with modern fashion.

A great example is Li-Ning Company. (*Dwyane Wade* signed a life-time contract with Li-Ning after his contract with Nike expired.)

It has its unique design which combines traditional Chinese elements and western fashion, which I believe is the core advantage to a clothing company.



New York Fashion Show

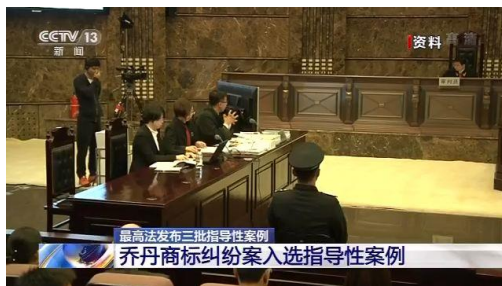
Li-Ning FW18

2018

# Follow-up questions

I still have some questions for us to discuss:

- In this case, why did Michael Jordan sue Qiaodan Sports Company rather than Nike?
- Is there any policy reason which is not written in the judgement but might affect the final decision?
  - Qiaodan IPO disclosure's financial part might give us some hints.
- The final hearing was live-streamed and both sides applies great presentation tools which are most often used by consulting companies.
  - Is it necessary for lawyers to have some business presentation skills for career development? Duty of Competence?



HD streaming (with Youtube video as the hyperlink, 4-hour long)

---

# Thank you!