A Brave New Word:
A Neologism’s Dangerous Path to EU Trade Mark Registration

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(Also prepared as part of the Universities Network programme of the Office for Harmonization in the Internal Market)

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Academic year 2010-2011
ABSTRACT

This paper will consider the registrability of neologisms as EU trade marks in light of descriptiveness as an absolute ground of refusal and within the unique linguistic context of the EU. Guidance provided mainly by the EU courts on the registrability of neologisms in light of descriptiveness shows that there are no hard and fast rules for distinguishing descriptive neologisms from allusive ones. Assessment tools, such as the key requirement of a high level of imaginativeness, are inexorably subjective in nature. As such, the policy interests underlying the rules on descriptiveness provide direction for the use of these instruments. The raison d’être of descriptiveness as an absolute ground of refusal speaks in favour of a strict application of the guidance on registrability. Upon transposition of the above findings into the linguistic landscape of the EU, it transpires that languages have a considerable impact on the registration of neologisms. While the examination of a neologism’s descriptiveness should be assessed also from the perspective of a European consumer with imperfect linguistic skills, clear and stringent rules should be adopted for determining when and how these so-called non-native speakers are included in the equation. Such an approach would provide a balanced solution for reconciling the fairly strict requirements applying to neologisms per se with the even stricter implications raised by the linguistic wealth of the EU.
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I. Introduction

Twas brillig, and the slithy toves
Did gyre and gimble in the wabe;
All mimsy were the borogoves,
And the mome raths outgrabe.

‘Beware the Jabberwock, my son!
The jaws that bite, the claws that catch!
Beware the Jujub bird, and shun
The frumious Bandersnatch!1

Neologisms may be best remembered from their use in Lewis Carroll’s ‘Jabberwocky’ poem, a veritable eulogy to invented terms. However, they do not only appear in the field of literature, but also in the perhaps less poetic field of trade mark law.

In order to understand the difficulties raised by the registration of neologisms as community trade marks (henceforth ‘CTMs’), we must first define what ‘neologism’ means in a trade mark context. While the word may have been characterised by some as an ‘abhorrent and horrific term of reproach’2, a dictionary definition for ‘neologism’ simply reads ‘a newly coined word, or a phrase or familiar word used in a new sense’3. Trade mark neologisms can be either invented (in the sense of ‘XEROX’ or ‘HÄAGEN-DAZS’) or obtained through the deformation, combination

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1 Excerpt from the poem ‘Jabberwocky’ by Lewis Carroll, *Through the Looking Glass (And What Alice Found There)*, 1871
2 Brander Matthews, ‘Is the English Language Degenerating?’, in *Essays on English* (Charles Scribner’s Sons, 1921), p.8, satirising the views of those who would have language be fixed
3 Collins English Dictionary
or abbreviation of existing words (in the sense of ‘ALCOTEST’ or ‘LOKTHREAD’). The former type of neologism’s trade mark registration is uncontroversial from the perspective of descriptiveness, since wholly invented words are by definition not descriptive, and are likely to enjoy a highly distinctive character. One author qualifies these trade marks as ‘automatically and inherently registrable’\(^4\).\(^5\)

However, with regard to the second category of neologisms, terms based on existing words retain, although partly and indirectly, the meaning of the original word(s). The resulting term therefore calls to mind what the original word designates, and is for this reason very valuable commercially as a trade mark.\(^6\) Indeed, ‘often the best trademarks are highly suggestive’, while the purely invented terms referred to above ‘are less able to transmit a positive message to the consumer’\(^7\). Ironically, it is the second type of neologism’s greatest asset, namely its suggestive character, which also amounts to its greatest weakness on the path to registration. Indeed, if a neologism crosses the boundary of suggestiveness and ventures into the territory of descriptiveness, it becomes unregistrable by virtue of descriptiveness as an absolute ground of refusal (or if already registered, subject to invalidation). This second type of neologism based on existing words which walks the tightrope of descriptiveness will be the focus of this paper, just as it has been the focus of much of the case of law of the European courts and decisions of the Office for Harmonization in the Internal Market (henceforth ‘OHIM’ or the ‘Office’).

In practical terms, however, delimiting this second category of neologisms is not always an easy task. The absence of a dictionary entry ‘technically’ renders a term a neologism.\(^8\) On the other hand, not all combinations of words or meaningful expressions are contained in dictionaries.\(^9\) Moreover, certain words ‘produced by a combination of elements’\(^10\) may fall short of being neologisms. Indeed, the mere hyphenation of words or removal of a space between them may be deemed insufficient to create a neologism.\(^11\) Furthermore, a neologism need not necessarily be a single word, but can also be an expression such as ‘flash bronzer’\(^12\).

Keeping these considerations in mind, this paper will explore the registrability of neologisms in the European Union’s trade mark system from the angle of descriptiveness, with particular

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\(^4\) Jeremy Phillips, *Trade Mark Law – A Practical Anatomy* (Oxford University Press, 2003), para.4.01, p.58

\(^5\) On the other hand, trade marks consisting of such words risk becoming generic and being cancelled. This interesting phenomenon is however not the concern of the present paper.


\(^8\) David T. Keeling, ‘About Kinetic watches, easy banking and nappies that keep a baby dry: a review of recent European case law on absolute grounds for refusal to register trade marks’, *2 Intellectual Property Quarterly* (2003) 131, at 153

\(^9\) R 288/2008-2 (BLENDABLE), decision of 28 Feb. 2008, para.10; Note that the decisions of the OHIM Boards of Appeal are arguably more useful in defining neologisms than the judgments of the European courts, as the former have provided more practical guidance on the matter.

\(^10\) R 916/2006-1 (XTRALITE), decision of 22 Nov. 2006, para.27

\(^11\) T-339/05 *MacLean-Fogg v OHIM (Lokthread)*, [2007] ECR II-61, para.30

\(^12\) See R 1646/2008-1 (CELLS-FOR-HEALTH), decision of 26 June 2009, para.28; R 24/2008-4 (ACTIVECHARGE), decision of 31 Aug. 2009, para.18; R 270/2009-2 (GENESEARCH), decision of 19 May 2009, para.29

\(^13\) R 62/2001-1 (FLASH BRONZER), decision of 8 June 2001, para.11
attention paid to the role of languages. Part II will examine the rules, as they stand today, on assessing the descriptiveness of neologisms by first looking at the applicable legislative provisions, and secondly by reviewing the case-law of the EU courts and OHIM practice. Part III will consider how the use of the tools provided by the courts is (or should be) affected by the interests and values at stake. Finally, in part IV the significant impact of the EU’s peculiar linguistic context on the assessment of neologisms’ descriptiveness will be examined. In so doing we will firstly look at the role of the linguistic skills of the relevant consumer, followed by an analysis of the importance of the language a neologism derives from. Through this paper the author will propose a path to follow in the EU’s trade mark landscape which reconciles the rules on registrability and their application with the difficulties raised by the reality of 23 official languages.

II. The current rules on the registrability of neologisms

At the outset, it is imperative to review the EU rules concerning the registrability of neologisms from the perspective of descriptiveness as they stand today. Focus will be first cast on the applicable legislative provisions, followed by an analysis of the case-law of the EU courts and a consideration of OHIM decisions.

A - Legislative provisions

1) Art.7(1)(c) TMR – the basic rule

The basic rule against the registration of descriptive trade marks is set out in Art.7(1)(c) of Council Regulation 207/2009 on the Community Trade Mark (henceforth ‘the Trade Mark Regulation’ or ‘TMR’)14, which provides an absolute ground for refusing the registration of trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’. This rule hails from Art.6quinquies(B)(2) of the Paris Convention for the Protection of Industrial Property15.

This provision appears fairly straightforward at the outset, or as expressed in slightly different terms, it is ‘not exactly rocket science’16. Nevertheless, we will see that its practical implications may be far from clear-cut.

2) Art.7(1)(b) TMR – the link with ground (c)

At this juncture the relevance of Art.7(1)(b) TMR, which forbids the registration of trade marks ‘which are devoid of any distinctive character’, must also be noted due to the link between

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15 Paris Convention for the Protection of Industrial Property, 1883, most recently revised in 1967

refusal grounds (b) and (c). While the Court of Justice of the European Union (henceforth ‘the CJEU’ or ‘the Court’) maintains that the absolute grounds for refusal, particularly Arts.7(1)(b)-(d), are ‘independent of each other’\textsuperscript{17}, they are without a doubt inter-connected. The Court concedes that if a sign is descriptive under ground (c) it will also fail the distinctiveness-test of ground (b)\textsuperscript{18}. Furthermore, it has been argued, quite persuasively, that grounds (c) and (d) are in fact subsets of ground (b)\textsuperscript{19}.

With regard to the relationship between Arts.7(1)(b) and (c), the OHIM Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (henceforth ‘the OHIM Manual’) also acknowledges that these provisions may well overlap. In practical terms each ground must nevertheless be given a separate reasoning, and ‘in the case of word marks having a semantic meaning, the examination shall start with Article 7 (1) (c), and in a separate paragraph Article 7 (1) (b) should be addressed, clearly mentioning whether the lack of distinctiveness arises out of the same, or different, considerations, than those which lead to considering the mark descriptive’\textsuperscript{20}.

It is important to point out at this stage that while this paper will focus on descriptiveness as an absolute ground of refusal, due to its close relationship with distinctiveness, the latter will inevitably come into play from time to time. For the avoidance of doubt, the term ‘distinctive’ by itself will relate to the separate ground of refusal under Art.7(1)(b) TMR, while ‘distinctive in the broad sense’ will encompass both grounds (b) and (c).

3) Art.7(2) TMR – the unitary character

Moreover, in light of the unitary character of CTMs, Art.7(2) TMR requires that no absolute grounds for refusal exist in any part of the European Union. As we will see below, this provision has a particular importance for the registration of neologisms in the special linguistic context of the EU.

4) Art.7(3) TMR – acquired distinctiveness

Finally, an inherently descriptive sign may nonetheless be registered if it ‘has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it’ by virtue of Art.7(3) TMR\textsuperscript{21}.

The case-law relating to the registration of neologisms must be considered in light of the above legislative provisions.

\textsuperscript{17} C-265/00 Campina Melkunie v Benelux-Merkenbureau (Biomild), [2004] ECR I-1699, para.18; C-363/99 Koninklijke KPN Nederland v Benelux-Merkenbureau (Postkantoor), [2004] ECR I-1619, para.67; Also confirmed in more recent cases, see for instance C-304/06 P Eurohypo v OHIM (Eurohypo), [2008] ECR I-3297, para.54; Article 7(1)(d) TMR relates to terms that have become generic.

\textsuperscript{18} Postkantoor, see note 17 above, para.86

\textsuperscript{19} Michael Handler, ‘The distinctive problem of European trade mark law’, 27(9) European Intellectual Property Review (2005), 306

\textsuperscript{20} OHIM Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part B – Examination, most recently revised on 15 September 2010, para.7.1.1., p.22; The OHIM Manual is a more up-to-date version of the OHIM Guidelines, of which the current Part B – Examination dates from April 2008.

\textsuperscript{21} The rule of acquired distinctiveness also applies to the refusal grounds contained in Arts.7(1)(b) and (d).
B - Guidance provided by the case-law of the EU courts and OHIM decisions

A number of principles regarding the registrability of neologisms from the perspective of descriptiveness can be drawn from the case-law of the EU courts and decisions of the OHIM Boards of Appeal (henceforth ‘the BA’ or ‘the Board’). While OHIM case-law and decisions are to a large extent informed by the decisions of the EU courts, they nevertheless provide invaluable practical observations which will pepper our examination.

1) Assessment with regard to the relevant public and goods

As a first basic principle, descriptiveness is to be assessed from the angle of the relevant public and goods. Indeed, ‘for a sign to fall within the scope of the prohibition [in Art.7(1)(c) TMR], it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the goods and services in question or of one of their characteristics’22 (emphasis added).

2) Assessment with regard to the resultant whole

The second principle relating to the registrability of neologisms is that the descriptiveness of word combinations must be considered not only in relation to each word taken separately, but also in relation to the ‘resultant whole’23. Therefore, ‘[i]n order for a mark consisting of a word produced by a combination of elements [...] to be regarded as descriptive for the purposes of Article 7(1)(c) [...], it is not sufficient that each of its components be found to be descriptive. The word itself must be found to be descriptive’24. As colourfully expressed by Phillips, ‘[i]t is no longer regarded as acceptable practice to divide an applicant’s trade mark into salami slices and to consider the fitness of each slice for registration’25.

3) The creation of a neologism is not sufficient

Another principle that can be drawn from European case-law is that the mere creation of a neologism does not prevent a word combination from being descriptive. In the Biomild case26, for example, a preliminary ruling request from the Benelux Court of Justice, the Benelux Trade Mark Office (BTMO) had rejected the registration of the sign ‘Biomild’ with regard to various foodstuffs including dairy products on the basis that the composite word was exclusively descriptive. In the proceedings before the CJEU the BTMO argued that ‘the fact that a mark is a neologism is not sufficient to ensure that it enables goods or services to be distinguished. All that matters is whether the word, regardless of whether it is new or not, is apt to identify the

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23 Baby-dry, see note 22 above, paras.39 and 40
24 C-273/05 P OHIM v Celltech (Celltech), [2007] ECR I-2883, para.76; Also see Postkantoor, note 17 above, para.96; Biomild, note 17 above, para. 37; T-486/08 Earle Beauty v OHIM (Superskin), judgment of 9 Dec. 2010, para.24
25 Phillips, see note 4 above, p.89
26 Biomild, see note 17 above, para. 39
goods or services in respect of which its registration as a mark is sought\textsuperscript{27}. This appears to have been implicitly accepted by the CJEU.

Nevertheless it becomes apparent especially through the case-law of the BA that a common strategy used by trade mark applicants is to advance the argument that their sign amounts to a neologism as \textit{proof} of non-descriptiveness. Indeed, ‘\textit{m}any trade mark applicants have cloaked the paucity of their own poor offerings with the rich dignity of the term ‘invention’\textsuperscript{28}. This is so even in the case of signs that are of arguably very little creative value, such as ‘EFFICIENTGRIP\textsuperscript{29}, ‘ULTRALITE\textsuperscript{30} and ‘SEXYADS\textsuperscript{31}.

Such arguments are mostly based on the lack of the sign’s entry in a dictionary. As seen above, the lack of a dictionary entry does technically render a term a neologism\textsuperscript{32}. Nevertheless, the BA appears somewhat cautious in its use of the term ‘neologism’ in its decisions. It can be speculated whether this weariness is due to the fact that once a term is accepted as a neologism, i.e. a new word, usage or expression, qualifying it at the same time as commonplace and ordinary is paradoxical. Indeed, how can a term be new and commonplace simultaneously? This point was validly raised by a CTM applicant with regard to the sign ‘FLASH BRONZER’: ‘\textit{U}ne contradiction existe entre, d’une part, la constatation faite par l’examinateur selon laquelle le terme BRONZER n’existe pas en anglais et doit donc être considéré comme un néologisme et, d’autre part, sa conclusion que le mot doit être considéré comme banal, c’est-à-dire usuel\textsuperscript{33}. The BA ultimately reversed the decision to refuse the registration of the sign as a CTM (and qualified it as a neologism).

The conclusion to be drawn is the following: conceding that a term amounts to a neologism does not automatically mean that it is not descriptive, but nonetheless may amount to \textit{one step towards} negating descriptiveness.

4) The absence of a dictionary entry is not decisive

Related to the above point, the absence of a sign’s entry from the dictionary does not of itself negate the sign’s descriptiveness. In the \textit{Superskin} case, for instance, the General Court (henceforth ‘GC’) clearly stated that the fact that the term ‘superskin’ does not appear in English-language dictionaries is ‘not relevant’ in determining descriptiveness\textsuperscript{34}.

5) Spelling mistakes do not necessarily negate descriptiveness

\textsuperscript{27} \textit{Biomild}, see note 17 above, para. 23
\textsuperscript{28} \textit{Phillips}, see note 4 above, p.95
\textsuperscript{29} R 1460/2008-4 (EFFICIENTGRIP), decision of 27 April 2009, para.9
\textsuperscript{30} R 96/2008-2 (ULTRALITE), decision of 15 April 2008, para.9
\textsuperscript{31} R 1015/2004-1 (SEXYADS), decision of 24 May 2005, para.5
\textsuperscript{32} BLENDABLE, see note 9 above, para.10
\textsuperscript{33} FLASH BRONZER, see note 13 above, para.3; ‘A paradox exists between on the one hand the observation by the examiner that the term BRONZER does not exist in English and is to be considered a neologism, and on the other hand his conclusion that the word is to be considered banal, that is to say commonplace’ (author’s own translation).
\textsuperscript{34} \textit{Superskin}, note 24 above, para.48; Also see for instance \textit{Lokthread}, note 11 above, para.54; \textit{Paperlab}, note 22 above, para.34
Composing a neologism in such a manner that it contains a spelling mistake (or several) is not by itself sufficient to make a sign shed its descriptiveness. This was clearly stated by the GC with regard to the ‘LOKTHREAD’ mark: ‘[T]he mere fact that the neologism contains a spelling mistake in one of its components cannot support the inference that the neologism is unusual given that […] the relevant public will immediately recognise that misspelling, both phonetically and visually, and will therefore replace the misspelled word ‘lok’ with the word ‘lock’”\(^35\).

Similar opinions were expressed by the BA with regard to ‘XTRALITE’, where the Board stated that ‘[t]he misspelt forms of ‘extra’ as ‘xtra’ and ‘light’ as ‘lite’ are very commonly used in trade marks and advertising\(^36\), and with regard to ‘GLASS-GARD’, where the Board noted that ‘[i]n certain circumstances, consumers may not give any significance to misspellings, or even notice them at all’\(^37\).

6) The existence of synonyms is irrelevant

A neologism does not lose its descriptiveness merely through the existence of synonyms. The courts have held in various cases that ‘it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services’\(^38\).

7) The existence of several possible meanings is insufficient

In order to be unregistrable, it is sufficient for one of a neologism’s possible meanings to be descriptive of the underlying goods or services. This principle was set out by the CJEU in its 2003 Doublemint judgment\(^39\), and deserves closer scrutiny. The case concerned an appeal to a GC decision annulling the BA’s refusal to register the CTM ‘DOUBLEMINT’ for chewing gum. OHIM considered the sign as ‘a combination of two English words with no additional fanciful or imaginative element’\(^40\), and therefore descriptive of the underlying goods under Art.7(1)(c) TMR.

The GC, on the other hand, found ‘DOUBLEMINT’ to not be exclusively descriptive, as it ‘had an ambiguous and suggestive meaning which was open to various interpretations and did not enable the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question’\(^41\). It considered the use of the adjective ‘double’ unusual, and its combination with the word ‘mint’ meant that the neologism had two distinct meanings for the potential consumer: either twice the usual amount of mint or

\(^{35}\) Lokthread, see note 11 above, para.55
\(^{36}\) XTRALITE, see note 10 above, para.26
\(^{37}\) R 189/2004-1 (GLASS-GARD), decision of 8 July 2004, para.13
\(^{38}\) Biomild, see note 17 above, para.42; also see for instance Postkantoor, note 17 above, paras.57 and 101; joined cases T-367/02 to T-369/02 Wieland-Werke v OHIM (SnTEM, SnPUR, SnMIX), [2005] ECR II-47, para.41
\(^{39}\) C-191/01 P OHIM v WM. Wrigley Jr. Company (Doublemint), [2003] ECR I-12447
\(^{40}\) Doublemint, see note 39 above, para.7
\(^{41}\) T-193/99 Wrigley v OHIM, [2001] ECR II-417, para.30
flavoured with two varieties of mint. In addition, the word ‘mint’ could refer to several types of herb\(^{42}\).

The CJEU, however, disagreed. It took the view that the existence of several possible meanings was not sufficient to neutralise a term’s descriptive character. In other words, for a sign to be descriptive it was sufficient that ‘at least one of its possible meanings designates a characteristic of the goods or services concerned’\(^{43}\). This finding has been confirmed in numerous subsequent judgments\(^{44}\).

8) The sign need not be in use in a descriptive manner

Another essential principle is that the sign need not be in use in a descriptive manner. In the previously mentioned Doublemint case, for instance, the defendant Wrigley argued that ‘OHIM’s objective of ensuring that terms which are wholly descriptive remain freely available for use by competitors can apply only to signs in respect of which there is a reasonably clear and foreseeable need for competitors to use a particular term to describe certain characteristics of their goods’. Furthermore, the company pointed out that during the almost century-long existence of ‘DOUBLEMINT’ as a registered US trade mark, the word had not been used by the public or competitors in a descriptive manner\(^{45}\).

This argument was rejected by the CJEU which stated that ‘it is not necessary that the signs and indications composing that mark [...] actually be in use at the time of application for registration in a way that is descriptive of goods or services [...]. It is sufficient [...] that such signs and indications could be used for such purposes’\(^{46}\) (emphasis added). Subsequent case-law has confirmed this principle\(^{47}\).

9) More than the sum of its parts

The most crucial principle states that to go beyond descriptiveness a neologism must be ‘more than the sum of its parts’\(^{48}\). In the words of the CJEU, Art.7(1)(c) TMR ‘must be interpreted as meaning that [...] the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts’\(^{49}\).

\(^{42}\) Wrigley v OHIM, see note 41 above, paras.10 and 11
\(^{43}\) Doublemint, see note 39 above, para.32
\(^{44}\) See for instance T-310/09 and T-383/09 Fuller & Thaler Asset Management v OHIM (Behavioural indexing, Behavioural index), judgment of 12 April 2011, para.27; Chroma, see note 22 above, para.28; T-399/08 Clearwire v OHIM (Clearwifi), [2009] ECR II-223, para.21
\(^{45}\) All quotes in this paragraph from Doublemint, see note 39 above, para. 23
\(^{46}\) Doublemint, see note 39 above, para. 32
\(^{47}\) See for instance T-108/09 Ravensburger v OHIM (Memory), judgment of 19 May 2010, para.35; T-200/08 Interfion v OHIM (Foodlube), judgment of 29 Sep. 2010, para.44; Paperlab, see note 22 above, para.34
\(^{48}\) Biomild, see note 17 above, para. 43
\(^{49}\) Biomild, see note 17 above; See also Postkantoor, note 17 above, decided on the same day, para.100; This quote originally relates to Article 3(1)(c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to Approximate the Laws of the Member States Relating to Trade Marks (OJ L 299/25, 08.11.2008), which encompasses the same ground of refusal as Art.7(1)(c) TMR.
The OHIM Manual essentially refers to this test for assessing the descriptiveness of neologisms, interpreting it in the following manner: ‘[t]hose notions, “unusual nature of combination”, “impression sufficiently far removed” and “more than the sum of its parts” have to be interpreted as meaning that Article 7 (1) (c) does not apply when the way in which the two descriptive elements are combined is in itself fanciful’.50

The ‘more than the sum of its parts’-test revised previous criteria set out in the heavily criticised Baby-Dry ruling51, where the CJEU took the view that ‘[a]ny perceptible difference between the combination of words [...] and the terms used in the common parlance [...] is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark’52. The subsequent Biomild and Postkantoor judgments in particular raised the bar for the registration of neologisms, and have been followed in subsequent case-law53.

C - Conclusions from the current rules concerning the registrability of neologisms in the EU

Two important observations can be drawn from the key rules on neologisms’ registrability. The first is that no matter how many principles are laid down in case-law, there are no hard and fast rules to determine whether a neologism is descriptive or suggestive. Advocate General Jacobs describes the problem accurately:

It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer.54

Bertrand characterises the problem as follows: ‘La principale difficulté est d’établir la frontière entre le terme “évocateur”, suffisamment distinctif, qui peut constituer une marque valide du terme “descriptif” qui n’est pas par nature un signe distinctif susceptible de constituer une marque’55.

Secondly, trade marks, arguably more so than any other intellectual property right, are not concerned with inventiveness and creativity. Their underlying rationale is not to reward and incentivise artistic creation or technical innovation. In the words of the CJEU, ‘[r]egistration of a

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50 OHIM Manual, see note 20 above, para.7.3.3, p.36
51 Baby-dry, see note 22 above; The fall from grace of the Baby-Dry judgment is perhaps best illustrated by Phillips’ observation that ‘[a]s a general rule, the more heavily an applicant’s appeal depends upon the citation of BABY-DRY the weaker its case is’; Jeremy Phillips, ‘Court of First Instance takes firm line on appeals against refusal to register Community trade marks on marginal distinctiveness’, 1(2) Journal of Intellectual Property Law & Practice (2006), 96, at 97.
52 Baby-dry, see note 22 above, para. 40
53 See for instance T-14/10 CheckMobile v OHIM (Carcheck), judgment of 24 March 2010, para.17; T-181/07 Eurocopter SAS v OHIM (Steadycontrol), [2008] ECR II-44, para.37
54 Advocate General Jacobs’ Opinion in Doublemint, see note 39 above, para. 61
55 André R. Bertrand, Droit des Marques: Signes Distinctifs – Noms de Domaine (Daloz, 2005, 2nd ed.), para.3.254, p.76; ‘The primary difficulty lies in establishing the frontier between the “allusive” term, sufficiently distinctive to constitute a valid trade mark, and the “descriptive” term, which by its nature lacks the ability to constitute a trade mark’ (author’s own translation).
sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. Nevertheless, it becomes clear from the rules on registrability that neologisms require a measure of imagination and inventiveness in order to benefit from trade mark protection. This de facto requirement is voiced in the key principle that neologisms must amount to more than the sum of their parts.

As a counter-argument to this observation one could maintain that no stricter rules apply to any specific types of marks. Indeed, ‘[t]he same level of distinctiveness [in the broad sense] is required of all types of mark’, as has numerous times been stated by the CJEU. However, ‘[t]he law does not impose different standards, but the exigencies of practical reality will impose demands from which the law shrinks’.

In light of these observations it is interesting to consider and compare how the descriptiveness of neologisms is measured in another trade mark jurisdiction.

**D - The assessment of descriptiveness in the US trade mark system**

1) The ‘Distinctiveness/Descriptiveness Continuum’ and rules for combined terms

We will now turn to consider the rules on the registrability of neologisms across the Atlantic. A comparison with the US is especially interesting in light of the fact that it possesses a well-developed trade mark system (the first US trade mark act dates from 1881), which has in addition evolved separately from the EU. We will first explore the general US approach for distinguishing descriptive signs from suggestive ones, followed by a consideration of special rules relating to neologisms.

Similar to the EU trade mark system, the US Lanham Act refuses registration to trade marks which are merely descriptive of the underlying goods or services. In the US trade mark system, marks are located on the so-called ‘distinctiveness/descriptiveness continuum’ ranging from fanciful to generic, as initially established in the 1976 *Abercrombie* judgment. The hierarchy of marks runs as follows:

At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed

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56 C-329/02 P *SAT.1 SatellitenFernsehen v OHIM (Sat.2)*, [2004] ECR I-8317, para.41
57 Phillips, see note 4 above, para.4.124, p.97
59 Phillips, see note 4 above, para.4.126, p.97
60 *Lanham (Trademark) Act*, Title 15, Chapter 22 of the United States Code
61 15 U.S.C. para.1052(e)(1); Indeed, ‘[t]he bar to the registration of exclusively descriptive marks is one of the characteristics of a mature trade mark system’, Phillips, see note 4 above, p.98
by merely descriptive matter. Finally, generic terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. ⁶³

Fanciful, arbitrary and suggestive marks are all considered inherently distinctive. Fanciful marks consist of invented terms, such as PEPSI, KODAK and EXXON ⁶⁴. Arbitrary marks consist of known words used in unexpected or uncommon ways, such as the oft-cited example of APPEL for computers ⁶⁵. Suggestive marks, however, are to be found slightly further along on the distinctiveness/descriptiveness continuum, and are harder to determine.

Suggestive marks hinge on one primary concept, mainly that of imagination. Indeed,

[s]uggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. ⁶⁶

The same principle infuses the special rules on the descriptiveness of neologisms, caught by the category of ‘combined terms’. Particularly, ‘[w]hen two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression’ ⁶⁷ (emphasis added). ‘SNO-RAKE’, for example, was deemed to not be merely descriptive of a hand-operated snow removal tool ⁶⁸, in the same manner as ‘FRANKWURST’ was deemed only suggestive of wiener sausages ⁶⁹. On the other hand, the sign ‘BATTLECAM’ was deemed descriptive of computer game software ⁷⁰, ‘SMARTTOWER’ of industrial cooling towers ⁷¹, and ‘OATNUT’ of oat and hazelnut bread ⁷².

In practical terms, US courts rely on various tests to draw the line between descriptiveness and non-descriptiveness ⁷³. The primary one is the so-called ‘imagination test’, which consists in examining whether imagination or a mental leap is required in order to reach a conclusion as to the nature of the underlying product ⁷⁴. When the test was applied to the word mark ‘ENTREPRENEUR’ for instance, the sign was deemed descriptive of magazines as ‘an entirely

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⁶⁴ USPTO TMEP, see note 63 above, para.1209.01(a), ‘Fanciful, Arbitrary, and Suggestive Marks’

⁶⁵ Ibid, para.1209.01(a), ‘Fanciful, Arbitrary, and Suggestive Marks’

⁶⁶ Ibid

⁶⁷ Ibid, para.1209.03(d), ‘Combined Terms’

⁶⁸ In re Shatts, 217 USPQ 363 (TTAB 1983)

⁶⁹ In re Vienna Sausage Mfg. Co., 156 USPQ 155 (TTAB 1967)

⁷⁰ In re Petroglyph Games, Inc., 91 USPQ2d 1332 (TTAB 2009)

⁷¹ In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002)

⁷² In re Entenmann’s Inc., 15 USPQ2d 1750 (TTAB 1990)


⁷⁴ Kevin McBride, ‘“WOULD YOU RATHER...?” Is this Trademark Distinctive?’, www.mcbride-law.com blog, 16 July 2010, retrieved on 1 May 2011
unimaginative [...] person would understand the significance of the reference (emphasis added).

Another test used by US courts, namely the so-called ‘competitors’ needs test’, consists in determining to which extent a mark is needed by competitors to identify their goods and services. Importantly, this is linked to the above imagination test, since ‘the more imagination that is required to associate a mark with a product or service, the less likely the words used will be needed by competitors to describe their products or services’.

2) Conclusions to be drawn from the comparison of the EU and US approaches

Before drawing any conclusions from the above comparison, it is important to lay down the following disclaimer for the reader. There are limits to the usefulness of a comparison between the US and EU trade mark systems. Firstly, as previously stated, the two systems have evolved quite separately, meaning that they operate in very different manners. While this is part of the attraction of using the US as comparator, it also leads to there being many differing variables.

Secondly, in the words of the BA, ‘the United States trade mark system [...] is often perceived as more liberal by Europeans’. An example that confirms this view is the permissive US approach to the registration of ‘double entendre’, i.e. words or expressions with more than one meaning when applied to the underlying goods or services, which is the polar opposite of the EU’s stricter Doublemint-doctrine.

Furthermore, registration/registrability in the US does not necessarily mean anything in the EU trade mark system. As has countless times been stated by the BA,

'[t]he registration of the mark in the United States of America is not decisive. The criteria employed by examiners of that country’s trade mark registry in determining the existence of an absolute ground of refusal are not necessarily comparable to those applied in the Office. Therefore, it follows that a mark which is found distinctive in that country does not necessarily imply that it would be found equally distinctive under the Community trade mark system.'

75 Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135 C.A.9 (Cal.) 2002, at 1142
76 McBride, see note 74 above
77 Rodeo Collection, Ltd v. West Seventh, 812 F.2d 1215, C.A.9 (Cal.), 1987, at 1218; Recently confirmed in Zobmondo Entertainment, LLC v. Falls Media, LLC, 602 F.3d 1108, C.A.9 (Cal.), 2010, at 1117
78 The existence of two formal US trade mark registers is but one such example. Certain trade marks that fall short of the registrability requirements for the Principal Register but that are nonetheless capable of distinguishing the applicant’s goods or services may be registered on the Supplemental Register, which bestows limited rights on the owner. See USPTO TMEP, note 63 above, para.801.02(a), ‘Act of 1946, Principal Register’, and (b), ‘Act of 1946, Supplemental Register’.
79 R 515/2006-2 (PREMIUM PLUS), decision of 8 Sep. 2006, para.24
80 A mark embodying a ‘double entendre’ ‘will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services’, USPTO TMEP, see note 63 above, para.1213.05(c), ‘Double Entendre’.
81 The term ‘distinctive’ is used here in the broader sense also encompassing descriptiveness; R 751/2007-2 (COMFORT SEATS), decision of 3 Sep. 2007, para.14. Also see for instance R 688/2009-2 (ECOPAD), decision of 7 Oct. 2009, para.24; R 1397/2006-2 (SUDDENLY SLIM), decision of 21 Feb. 2007, para.23. Interestingly, this argument also proves that descriptiveness is not an objective concept.
With these caveats in mind, we will now consider what conclusions can be drawn from the comparison of descriptiveness in the US and EU trade mark systems. Firstly, it confirms the finding that no hard and fast rules exist for drawing the line between descriptive and non-descriptive signs. Indeed, ‘[t]he descriptive-suggestive borderline is hardly a clear one. Its exact location in any given situation is hazy and only subjectively definable. The descriptive category almost imperceptibly shades over at its fringe into the suggestive domain”82.

Furthermore, a comparison with the US approach confirms the main finding from the study of the EU rules on the registrability of neologisms, namely that neologisms require an extra measure of imagination and originality in order to pass the hurdle of descriptiveness into the terrain of registration. They must pass the generally applied imagination-test and related competitors’ needs-test, and go even further by creating a ‘new and unique commercial impression’. This inevitably brings to mind the main test for neologisms in the EU, namely that they must amount to more than the sum of their parts. This view finds support in Bertrand’s interpretation of the two above-mentioned tests as encompassing a third, namely the degree of imagination required from the applicant in creating the trade mark83.

III. Applying the rules on the registrability of neologisms in light of the interests and values at stake

The principles provided by the EU courts for determining a neologism’s descriptiveness provide useful guidance. However, they do not fully answer the question of where the line on neologisms’ descriptiveness should be drawn. Indeed, the rules developed through case-law discussed above are merely subjective tools, whose manner of use depends (or should depend) on the underlying policy considerations. As such, the decision on where to draw the line between suggestiveness and descriptiveness hinges to a certain extent on the balance of interests at stake. We will therefore examine what public interest(s) is (are) at issue, and whose interests are being (or should be) protected.

A - The interested parties and a balance of interests

As has been expressed by MacQueen et al., ‘a number of interests require to be accommodated within the trade mark framework. Broadly they are of the trader, of competing traders, and of the consumer”84. An underlying tenet of trade mark law consists in the maintenance of a balance between the various interests at stake.

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82 McCarthy, see note 73, para.11:66
83 Bertrand, see note 55 above, para.3.254, p.76
84 Hector MacQueen, Charlotte Waelde and Graeme Laurie, Contemporary Intellectual Property – Law and Policy (Oxford University Press, 2008), para.13.5, p.540; The category of interested parties is further expanded my some authors, see for example Phillips, note 4 above, para.2.54, p.31.
Referring back to Advocate General Jacobs’ notion of sliding scales, it can be argued that at one end of the spectrum of policy approaches lies a ‘protective approach’, and at the other a ‘liberal approach’. The former focuses on the protection of consumers’ interests, hailing back to the origin function of trade marks, and/or the protection of other traders’ interests. The protective approach leads to a higher standard of descriptiveness. The liberal approach on the other hand advocates an open approach to registration which functions on a ‘first come first served’-basis, and therefore promotes a lower standard of descriptiveness. The further one travels towards either extreme, the stricter or laxer the application of the rules on descriptiveness becomes.

**B - The public interests underlying Arts.7(1)(c) and (b) TMR**

1) **Art.7(1)(c) TMR public interest(s)**

The public interest underlying Art.7(1)(c) TMR and guiding its application is primarily the protection of other traders and/or competitors. Certain signs should be freely available for all, and their availability should not be unduly restricted *vis à vis* competitors offering similar goods. The OHIM Manual expresses this in the following terms: ‘no exclusive rights should be created in purely descriptive terms which other traders might wish to use as well’85. However, the interests of the consumer are also relevant, and hail back to the origin function of trade marks. Indeed, the Manual also refers to the interest of the public ‘that terms which have a purely informational value should not be reserved for one single trader’86.

It may be useful to note at this point that the category ‘other traders’ interests’ is a somewhat normative concept, as opposed to concrete. The OHIM takes the view that ‘it is not appropriate to make the standards on assessment of descriptiveness contingent to the *number* of competitors that could be affected (in the sense of “the less competitors there are, the more descriptive must the mark be to be refused”)87 (emphasis added). This idea is derived from the CJEU’s ruling in the *Chiemsee* case were it stated that ‘the application of [Art.7(1)(c) TMR] does not depend on there being a real, current or serious need to leave a sign or indication free’88, thereby rejecting the German concept of *Freihaltebedürfnis*.

A related comment may be made about the category ‘consumers’ interests’. It is important to remember that trade mark law does not grant consumers rights. Phillips colourfully qualifies the consumer as

> a canary in a cage, taken down the coal mine to see if the air is wholesome. If the canary dies, the miners know they must leave the mine; in the same way, if the consumer is confused, the copyists know they must cease their acts of imitation. Neither the consumer nor the canary derives any great personal benefit from its experience.89

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85 OHIM Manual, see note 20 above, para.7.3.1, p.28
86 OHIM Manual, see note 20 above, para.7.3.1, p.28
87 OHIM Manual, see note 20 above, para.7.3.1, p.29
89 Phillips, see note 4 above, para.2.15, p.21
While this comment is made in the context of infringement, it undoubtedly also applies at the earlier registration stage of a trade mark’s life. In other words, what is being protected is consumers’ interests, not rights.

2) Art.7(1)(b) TMR public interest(s)

Notwithstanding the fact that Art.7(1)(c) TMR can be viewed as a subset of Art.7(1)(b) and a branch of the tree of distinctiveness (as discussed above), the public interest underlying Art.7(1)(b) is of a different nature. The OHIM Manual states that ‘[a] mark is distinctive if it can fulfil its essential function to guarantee the identity of the origin of the marked goods or services to the consumer by enabling him without any possibility of confusion to distinguish the goods or services from others which have another origin’. This principle originates from well-established case-law of the EU courts. The public interest underlying ground (b) is important to note although it is merely subsidiary for the purposes of this article.

C - Conclusions to be drawn from the interests at stake

The conclusion to draw from our succinct study of the public interests at stake when assessing a neologism’s descriptiveness is a fairly apparent, but nonetheless important one. While some criticise the ‘prevailing free market orthodoxy’, the public interest underlying the EU trade mark system’s rules against the registration of descriptive signs is primarily the protection of other traders’ interests. Therefore assessing a neologism’s descriptiveness takes place on the abovementioned scale closer to the ‘protective’ end than the ‘liberal’. A fairly strict use of the instruments for assessing descriptiveness is hence justified, or even required by their underlying raison d’être.

IV. The application of the rules on the registrability of neologisms in the linguistic context of the EU

So far, we have explored the current rules in the EU trade mark system concerning the registrability of neologisms, as well as considering how the tools provided by the case-law are (or should be) utilised in view of the various interests at stake. However, our study so far does not paint the entire picture in the EU. Indeed, much of our study so far could (and does) apply within the context of national trade mark systems. Hence we now need to consider a major factor that affects the registration of neologisms specifically in the EU, namely its unique linguistic context. As stated in the recent Commission study carried out by the Max Planck

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90 OHIM Manual, see note 20 above, para.7.5, p.41
Institute, ‘[t]he problems that arise are often linked to the fact that there are many languages spoken in the Community’.93

This paper intends to demonstrate that language impacts on the registrability of neologisms as CTMs in view of descriptiveness in two ways. Firstly, the linguistic skills of the person whose perspective descriptiveness is determined from are important in setting the standard of descriptiveness. Secondly, the language that a neologism derives from also matters in the path to registration.

The significant difference in approach to languages in the EU trade mark system and the national context will first be highlighted to illustrate the unitary character of the CTM regime. Following this we will see what the role of European consumers with imperfect linguistic skills is in assessing descriptiveness. We will then turn to the problem of determining which so-called non-native speakers are to be taken into account. Finally, the EU approach will be compared with the US method of dealing with the language issue to attempt to provide a solution on how a multilingual trade mark landscape can be reconciled with the rules on registration and their application in light of policy concerns.

A - The unitary character of the EU trade mark system

1) The practical impact of the unitary character in the linguistic context of the EU

It is crucial to keep in mind that the EU trade mark system is characterised by its unitary character, which finds expression in Art.1(2) TMR as well as the third Recital of the Preamble to the Regulation. This essential concept is further articulated in Art.7(2) TMR, which requires that no absolute grounds for refusal exist in any part of the Community. From a language perspective this means that a CTM application will be refused registration if it is descriptive in any of the 23 EU languages. While this may appear straightforward, the significant practical impact of this principle may be best perceived through practical illustrations.

In concreto, Art.7(2) TMR means that when a British company applies to register the word mark ‘TIKKA TIKKA’ as a CTM for various categories of goods including games, the Office must assess registrability, and particularly descriptiveness, in light of the fact that one possible definition of the word ‘tikka’ in the Finnish language refers to a dart game94.

In a similar manner, the registration of the Finnish neologism ‘PUTKIREFORMI’ as a CTM by a Finnish applicant was refused in light of the fact that ‘putkireformi’, roughly meaning ‘plumbing reform’, was deemed descriptive in Finnish of the concerned goods and services, mainly construction-related products and training services95. The word mark ‘RAUTARUUKKI’, roughly

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93 Study on the Overall Functioning of the European Trade Mark System, commissioned by the European Commission and presented by the Max Planck Institute for Intellectual Property and Competition Law (henceforth ‘the Max Planck study’), 15 February 2011, para.3.36, p.140
94 See R 746/2005-4 (TIKKA TIKKA), decision of 31 March 2006; One can doubt whether the British applicant applying for this CTM really had prior knowledge of this unfortunate linguistic coincidence.
95 See R 485/2009-2 (PUTKIREFORMI), decision of 25 June 2009
meaning ‘iron works’ in Finnish, met a similar fate when it was subject to a CTM application for various metal goods 96.

Furthermore, with regard to Art.7(1)(b) TMR, the distinctive character of the word marks ‘OIVA’ 97 and ‘AUTAN’ 98 was tested in light of the meaning these words have in Finnish, although they appear to be gibberish in the other EU languages. This is so despite the fact that Finnish speakers represent roughly only 1 percent of the total population of the EU. As clearly stated by the Office, ‘it suffices for a refusal if the mark is descriptive, or lacks distinctive character, in one or more official languages of the European Community, regardless of the size of the respective Member State or the number of the population of that Member State’ 99 (emphasis added).

2) The EU trade mark system’s approach to languages compared to the national context

It is important to point out at this juncture that the unitary character of the EU trade mark system leads to a significant difference in terms of approach to languages when compared to national practice within the Member States. As a general rule, most national systems in the EU are not concerned with descriptiveness in any other language but their own official one(s), unless the term would nevertheless be understood as descriptive in the local market. Philips characterises this as ‘immaterial descriptiveness’ 100. Indeed, ‘[e]n vertu du principe de territorialité, il est d’usage ancien d’apprécier le caractère de la marque en fonction uniquement du marché national’ 101.

The GC has recognised this approach ‘when it concluded that a national trade mark is not descriptive if the element of description is couched in a language which the nationals of that country do not understand’ 102. Indeed, the CJEU has found that ‘MATRATZEN’, the German word for ‘mattresses’, amounted to a valid Spanish trade mark for mattresses 103. It is interesting to note that this judgment lead to a significant relaxing of the rules relating to the registration of foreign words in a jurisdiction that previously maintained relatively strict rules, namely the UK 104.

This interesting dichotomy in terms of the role of languages in the EU trade mark system and the national trade mark systems within the EU is expressed in the following manner by Phillips:

In terms of European trade mark practice, the linguistic dimension which the law accords to descriptiveness may thus seem in theory to be somewhat ambivalent. While an

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96 T-269/06 Rautaruukki v OHIM (Rautaruukki), [2008] ECR II–273
97 See R 1500/2009–1 (OIVA), decision of 29 April 2010, meaning ‘good’, ‘clever’
98 See R 352/2009–2 (AUTAN), decision of 13 July 2009, meaning ‘I help’
99 OHIM Manual, see note 20 above, para.7.1.3, p.24
100 Philips, see note 4 above, p.103
101 Antoine Braun and Emmanuel Cornu, Précis des Marques (Larcier, 2009, 5th ed.), p.134; ‘As a result of the principle of territoriality it is a well-established practice that a mark’s character is assessed solely in relation to the domestic market’ (author’s own translation).
102 Philips, see note 4 above, p.103
103 C-421/04 Matratzen Concord v Hukla Germany (Matratzen), [2006] ECR I–2303, see para.32
104 See UK Intellectual Property Office (IPO) Practice Amendment Notice (PAN 12/06), 13 June 2006, on the Registrability of Non-English Words, amending the IPO Manual of Trade Marks Practice; Also see Jeremy Phillips, ‘It’s those d****d foreign words again’, 24 July 2006, on The IPKat blog, retrieved from ip.kitten.blogspot.com on 15 May 2011
application for a CTM will fail on absolute grounds if it is descriptive in any of the [23] languages of the EU [...], it can also fail on relative grounds if a prior national trade mark has been registered before it. This is so even if that prior mark is descriptive in every language of the EU except that of the one country in which it is registered. 105

It is clear from the above that languages impact the registration of neologisms in a very different manner in the EU trade mark system and the national context. Languages have a much greater impact at the EU level, which we will now explore.

B - The role of the linguistic skills of the person whose perspective descriptiveness is assessed from

1) Why and how do the linguistic skills of the person whose perspective descriptiveness is assessed from matter?

As we have seen, no matter what guidelines and tools are devised to weed out descriptive neologisms from merely allusive ones, the assessment is no exact science and will always involve a certain measure of subjectivity. Therefore the public whose point of view descriptiveness is determined from becomes all the more important, especially in terms of its linguistic skills.

It is well established in case-law that the absolute grounds of refusal must be assessed with regard to the relevant public and in light of the claimed goods and services 106. While bars to registration ‘will normally pertain to the Community as a whole’ 107, an absolute ground of refusal relating to the semantic meaning of a word will often have to be delimited linguistically and/or geographically as well. Indeed, the OHIM Manual states that ‘examiners should use clear and neat language when referring to the language or Member State to which a ground for refusal relates’ 108. Hence it may not be enough to define the relevant public as ‘the public at large’ or ‘medical professionals’, it may need to be defined instead as ‘the English-speaking public at large’, or ‘medical professionals in Member States x, y and z’.

The issue this paper is concerned with does not relate to coincidental occurrences of a word in one languages also existing in another, albeit with a totally different meaning. The word ‘handy’, meaning practical in English and designating mobile phones in German, is but one such example 109. Rather, it relates to the fact that the EU is not a Babel where inhabitants of one country only speak and understand one language, which is different from that of all other

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105 Phillips, see note 4 above, p.104
106 With regard to descriptiveness specifically, see for instance Chroma, note 22 above, para.45; with regard to distinctiveness in general see for instance C-265/09 P OHMI v Borco-Marken-Import Matthiesen, judgment of 9 Sep. 2009, para.32; Eurohypo, note 17 above, para.67; joined cases C-473/01 P and C-474/01 P Procter & Gamble v OHIM, para.33; generally see TIKKA TIKKA, note 94 above, para.16
107 OHIM Manual, see note 20 above, para.7.1.3, p.24
108 OHIM Manual, see note 20 above, para.1.3, p.3
109 This example was used by Advocate General Jacobs in his Opinion in Doublemint, note 39 above, para.86. The approach for screening for and dealing with linguistic coincidences is clearly set out in the OHIM Manual: ‘As regards the meaning of a word, all the official languages of the European Community must be consulted. To this end, a language check is undertaken in all these languages. If, for example, a trade mark consists of a word which in French is the name of the goods or services then the examiner must object, irrespective of the language in which the application was filed’ (OHIM Manual, see note 20 above, para.1.3, p.3).
countries. As pointed out by the Max Planck study, in reality languages ‘do not necessarily coincide with the frontiers of countries. Some languages are official languages in more than one Member State’. This linguistic reality provides a somewhat difficult terrain for the CTM system to function on.

The determination of the relevant Member States for assessing descriptiveness is crucial due to the following. If the relevant territory is composed solely of EU countries where the language of the sign is an official language, the trade mark will in effect be examined from the point of view of a native speaker consumer. If, on the other hand, the relevant territory includes other countries where the relevant language is not an official language, but nevertheless understood and used, the trade mark may also fall to be examined from the point of view of a non-native speaker consumer.

It can be fairly safely stated that non-native speakers will perceive neologisms differently from native speakers, since linguistic intricacies are blurred in the case of the former. In other words, the relevant consumer’s linguistic skills affect his perception of descriptiveness. However, this is where the safe terrain ends, as there appears to be disagreement on how linguistic skills affect perception of descriptiveness.

According to one view, the poorer the language skills of the consumer, the more easily a term will be perceived as descriptive. AG Colomer illustrates this by pointing out that the word mark ‘BABY-DRY’ may appear allusive rather than descriptive to native speakers of English due to its alleged unusual syntax and juxtaposition; however, non-native speakers would perceive no difference between ‘BABY-DRY’ and ‘DRY-BABY’, making both equally descriptive. Others have also voiced their support for this view. One commentator noted that ‘whilst BABY-DRY might appear as a “syntactically unusual juxtaposition” to a native English speaker, such linguistic refinement may be lost on the large majority of consumers in the European Union’.

According to another view, the better the language skills of the consumer, the more easily a term will be perceived as descriptive. To illustrate this Keeling argues that while the meaning of the signs ‘DOBLEMINT’ and ‘EASYBANK’ may not be straightforward for non-native speakers, native speakers ‘would understand without much mental effort’.

The present author is of the view that the first argument is more convincing. Indeed, the poorer the linguistic skills of the relevant consumer, the more imagination and inventiveness a neologism will require to cross the border from descriptiveness to suggestiveness. In addition to the above examples, this is well illustrated by a recent GC decision on the likelihood of confusion between the word sign ‘BINGO SHOWALL’ and a figurative CTM prominently including the term ‘SHOW BALL’. While these two expressions would hardly confuse a native English-speaker, the

110 Max Planck study, see note 93 above, para.3.39, p.141
111 See Opinion of Advocate General Colomer in Postkantoor, note 17 above, footnote 46
112 Annette Kur, ‘Examining Word Marks after BABY-DRY – Still a Worthwhile Exercise?’, 4 IPRinfo 2001
113 Keeling, see note 8 above, at 156
114 T-179/10 Zitra IP v OHIM (Bingo Showall), judgment of 13 April 2011
former was refused registration on the basis that the relevant public, ‘which understands very little English or none’\textsuperscript{115}, would not genuinely distinguish between the two.

In light of these observations, we will first explore whose perspective the EU trade mark system examines descriptiveness from; whether only native speakers are relevant for examining word marks, or only non-native speakers, or both; whether the relevant geographic area comprises only those countries in which the language of the mark is an official language, or only other countries where it is understood and used, or both.

2) Whose perspective is neologisms’ descriptiveness assessed from in the EU’s linguistic context?

(a) The EU courts’ lingering hesitancy as to the role of non-native speakers

When considering the case-law of the EU courts, three broad approaches to defining the relevant public linguistically/geographically emerge. A first method consists in assessing absolute grounds from the perspective of native speakers only. In Europig, for instance, the GC stated that since the sign at issue consists of words taken from the English language, the relevant public consists of ‘the average English-speaking consumer’\textsuperscript{116}, here meaning the average native English-speaker\textsuperscript{117}.

A second method acknowledges that the perception of non-native speakers may matter, but exercises judicial economy. In Companyline, for instance, the GC stated that since the sign in question was not distinctive in English-speaking areas, ‘it was clearly not necessary […] to consider the impression it might make on speakers of other Community languages’\textsuperscript{118}. Such statements suggest that the perception of non-native speakers may matter, but they fail to explain in what circumstances and how.

A third method includes non-native speakers in the relevant public. In Carcheck, for instance, the GC stated the following: ‘le signe verbal en cause étant composé de deux mots anglais, le public pertinent est un public principalement anglophone, voire un public non anglophone mais ayant une connaissance suffisante de la langue anglaise’\textsuperscript{119}.

One could understandably conjecture that the differing approaches are couched in time, in the sense that only looking at the understanding of native speakers represents a more traditional

\textsuperscript{115} Laetitia Lagarde, 'What a ball at the bingo show!', 27 April 2011, in Class 46-blog, retrieved from www.marques.org/class46 on 15 May 2011; Also see Bingo Showall, note 114 above, para.22

\textsuperscript{116} T-207/06 Europig v OHIM (Europig), [2007] ECR II-1961, para.32; also see for example T-346/07 Dino Sweden v OHIM (Easycover), [2008] ECR II-263, para.47; Lokthread, note 11 above, para.40; T-348/02 Quick v OHIM (Quick), [2003] ECR II-5071, para.30

\textsuperscript{117} See Europig, note 116 above, para.52

\textsuperscript{118} T-19/99 DKV Deutsche Krankenversicherung v OHIM (Companyline), [2000] ECR II-1, para.40; also see for example T-270/02 MLP Finanzdienstleistungen v OHIM (Bestpartner), [2004] ECR II-2837, para.21

\textsuperscript{119} Carcheck, see note 53 above, para.19 ; also see for example T-320/03 Citicorp v OHIM (Live richly), [2005] ECR II-3411, para.76; 'The word sign at issue being composed of two English words, the relevant public is primarily an English-speaking one, or perhaps even a non English-speaking public nonetheless possessing a sufficient knowledge of the English language' (author’s own translation).
method, while acknowledging and even taking into account the perception of non-native speakers is a more modern trend. However, an examination of the recent case-law does not support this theory. While it does appear to have become increasingly common to take non-native speakers into account, the approach of the courts remains somewhat unpredictable.

(b) The conclusions from the EU courts’ practice

While the varying approaches suggest that there is some uncertainty in this area, the case-law of the EU courts confirms that the perception of non-native speakers is far from irrelevant. Indeed, ‘[p]roposed marks are examined for descriptiveness simultaneously in virtually all of the languages of the community. This examination [...] may take into consideration the understanding of the original language of the mark by non-native speakers of that language’120. As has been argued, the lesser the linguistic skills of the relevant consumer, the more imaginative a neologism will have to be to amount to ‘more than the sum of its parts’. It therefore appears that a neologism’s path to CTM registration may be more difficult than registration as a national trade mark. Indeed, ‘[a] play on words [in English] that is registrable in the United Kingdom frequently runs aground at OHIM’121.

However, it is important to point out that no case has yet refused the registration of a word mark as a CTM on the basis of descriptiveness in a non-native speaking country alone. Therefore it is fairly safe to say that at the moment the yardstick is not solely a non-native speaker, and that the departure point is the consumer fluent in the concerned language. Indeed, ‘[i]t is clear that when an application is made to register a trade mark which consists of terms drawn from a language used in trade in the Community, the first stage of the assessment under Article 7(1)(c) must be from the standpoint of a native speaker of the language concerned’122. (Nevertheless, as will be discussed below, it is this author’s view that assessment from the perspective of a native speaker should not be the only step involved.)

From case-law we can furthermore distinguish two characteristics that render a word mark more likely to be assessed also from the perspective of a non-native speaker. Firstly, banal word marks enjoying a low level of inherent distinctiveness may convey ‘a highly descriptive message to a multi-linguistic public’123, and are therefore more likely to be understood by persons with even a rudimentary knowledge of the concerned language. Therefore the linguistic/geographical territory for their examination is likely to be broader.

Secondly, and perhaps most importantly, word marks from broadly understood and spoken languages are more likely to be examined from the perspective of non-native speakers. This brings us to another important point, namely that the language a neologism derives from also matters on the path to registration.

C - The importance of the language a neologism derives from

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122 Opinion of Advocate General Jacobs in Doubblemint, see note 39 above, para.83
123 See the Opinion of Advocate General Colomer in Postkantoor, note 17 above, para.68
At this point one might object to the above title, arguing that invented terms do not necessarily belong to any language. While this may hold true for purely invented words (such as the examples KODAK and HÄAGEN DAZS given above), this is not the case for the combined terms this paper is concerned with. Such terms necessarily derive from a certain language (or several, as will be seen below), and this holds true even in the case of misspellings as has been confirmed by the GC\textsuperscript{124}.

As we have seen, the more broadly spoken the language a neologism derives from, the more likely it is to be assessed from the perspective of non-native speakers, the higher the hurdle of descriptiveness becomes. In other words, how broadly a language is spoken will determine when the perception of non-native speakers is taken into account. From this we can draw the conclusion that neologisms in certain languages will be harder to register as CTMs than neologisms in other languages.

However, the language a neologism derives from is also significant in a second, and perhaps more practical, sense. The more broadly spoken the language, the more Member States are part of the relevant linguistic/geographical territory, the harder it will be for a CTM to surmount objections of descriptiveness through proof of acquired distinctiveness through use under Art.7(3) TMR. This merely confirms the ‘inequality’ of EU languages in terms of CTM registration.

This ‘inequality’ is perhaps best demonstrated through a case-study. Hence we will now consider the registration of neologisms in the English language to illustrate both of our two main findings, namely that the perception of non-native speakers matters in the EU trade mark system and that certain languages are harder to register than others.

D - The difficulty of registering English language neologisms as CTMs

1) Why English in particular?

For countries such as Finland, the main language of which is neither spoken nor understood in any other Member State, the situation is fairly simple: Finnish word marks will be assessed from the perspective of native Finnish speakers, and the relevant linguistic/geographical territory will be limited to Finland.

However, as can be seen from case-law, problems arise primarily with regard to English. In addition to being the main language in the UK and Ireland, the ‘lingua franca of our time’ is understood and used to varying degrees of fluency in a number of other Member States\textsuperscript{125}. In addition, English stands out as having become the standard in a number of sectors\textsuperscript{126}.

\textsuperscript{124} The applicant of the word mark ‘LOKTHREAD’ tried to argue that the mark does not belong to any language as it is an invented word, an argument which was promptly dismissed by the GC; Løkthread, note 11 above, paras. 36 and 40.
\textsuperscript{125} Opinion of Advocate General Colomer in Postkantoor, note 17 above, para. 68
\textsuperscript{126} See Ismail Kirca and Hakan Karan, ‘The application in Turkey of Art.3(1)(c) and (g) of the First Directive 89/104 of the Council of 1988 with regard to foreign word marks’, 28(8) European Intellectual Property Review (2006) 446, at 447
The problem remaining to this day is that the crucial notions of ‘European English-speakers’ and ‘the EU’s English-speaking territories’ are not clearly defined. Indeed, ‘[t]he geographic scope of English-language words has recently become a bone of contention’. In light of this situation, it is hardly surprising that some practitioners lament the ‘inconsistency on which EU countries are relevant to assessing the descriptiveness of an English word mark’.

2) The approach of the courts to defining ‘the EU’s English-speaking territories’

We have previously seen that the EU courts have adopted varying approaches to taking into account the understanding of non-native speakers. However, it is clear from case-law that the latter is far from irrelevant. Having established this, the next step is determining which non-native speakers to take into consideration. This is no easy task. The uncertainty in defining the relevant linguistic/geographical territory for English word marks is well embodied in two fairly recent and somewhat contradictory judgments from the GC. We will first explore the facts and findings of both of these cases, followed by an appraisal of their merits and impact.

(a) The Manpower case

In a case that has been overlooked to a surprising extent by both subsequent case-law and academic writing, the GC laid down a clear set of guidelines for defining the relevant linguistic/geographical territory in late 2008. This was arguably the first time a European court had provided such coherent guidance, and therefore deserves particular scrutiny.

The case concerned the registration of the word mark ‘MANPOWER’ as a CTM for employment agency services, and related goods and services. The German company Powerserv opposed the registration, claiming that the mark had been registered in breach of Arts.7(1)(c) and 7(3) TMR as it was descriptive throughout the EU, and that no evidence of acquired distinctiveness had been submitted for a substantial part of the EU.

OHIM’s Cancellation Division dismissed the opposition based on its view of the relevant territory for determining descriptiveness. It took the view that since the term is descriptive in English only, consumers outside the UK and Ireland will not identify it as a descriptive term. Indeed, ‘for the other parts of the European Union this term is not descriptive of the goods and services. The term “MANPOWER” outside the UK and Ireland is seen as a fanciful or suggestive expression.’

The BA, however, disagreed. It took the view that the term was not only descriptive for consumers in the UK and Ireland, but also in Germany, Austria, the Netherlands, Sweden, Denmark and Finland. Indeed it stated that ‘[i]n the opinion of the Board, the word is not only descriptive for these consumers in the United Kingdom and Ireland, where English is the mother tongue, and the German-speaking countries, where the word is listed in dictionaries, but also in

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127 Term taken from Naturally active, see note 91 above, paras.26 and 45
129 Stürman and Humphreys, see note 128 above, at 794
130 Jenkins, see note 121 above, p.1
131 T-405/05 Powerserv Personalservice v OHIM – Manpower (Manpower), [2008] ECR II-2883
132 Decision of the Cancellation Division of 29/04/2004, para.10
those Member States in which a substantial part of the respective clients has sufficient knowledge and practice in business English\(^\text{133}\).

The crucial part of the General Court’s response on appeal is the following. The GC stated that the key question for determining whether non-English speaking Member States should be taken into account when assessing descriptiveness is \textit{whether, from the perspective of the relevant consumer, a) the English word has been received into the local language, or b) English is used, as an alternative to the local language, in the relevant business sector}\(^\text{134}\). The first scenario in this case specifically would mean that ‘members of [the target] public, confronted in their national linguistic context with the word ‘manpower’, would perceive it at once as a reference to the ‘work-force’ or to ‘labour’\(^\text{135}\). With regard to the second scenario, the GC specified that ‘the sole fact of a widespread knowledge of English, on the part of the relevant public or a significant section thereof, is not sufficient if English is not actually used in that context to address that public\(^\text{136}\).

Having concluded that the term at issue was descriptive in the UK and Ireland, the GC agreed with the BA’s finding that the term had ‘entered into German business language’\(^\text{137}\) (scenario a) above), and that it was also descriptive in the German-speaking Member States, namely Germany and Austria.

The GC then turned to consider the other non-English speaking Member States concerned in this case, namely the Netherlands, Sweden, Denmark and Finland. It found that neither scenario a) nor b) applied in these countries, rejecting dubious evidence submitted by the applicant\(^\text{138, 139}\).

Before turning to the impact and merits of this judgment, one needs to consider a very different judgment rendered by the GC less than a month after \textit{Manpower}.

\((b)\) The \textit{New Look} case

The \textit{New Look} judgment\(^\text{140}\), rendered less than a month after \textit{Manpower}, concerned the registration of the word mark ‘NEW LOOK’ for various categories of goods including clothing, accessories and cosmetics. On appeal to the GC the CTM applicant argued that the BA had infringed Art.7(3)TMR by requiring proof of acquired distinctiveness to be submitted for Member States other than the UK and Ireland.

\(^{133}\) All quotes from R 499/2004-4 (MANPOWER), decision of 22 July 2005, para.16

\(^{134}\) \textit{Manpower}, see note 131 above, paras.73, 75-76

\(^{135}\) \textit{Manpower}, see note 131 above, para.75

\(^{136}\) \textit{Ibid}, para.76

\(^{137}\) \textit{Ibid}, para.77

\(^{138}\) The applicant Powerserv attempted to show that even if only German and English are to be taken into account, the word ‘manpower’ is descriptive throughout the EU. It pointed to statistics of the European Commission on knowledge of foreign languages in the Community, showing that 32 percent of Community inhabitants speak German, while the corresponding figure for the English language is 47 percent (\textit{Manpower}, note 131 above, para.28).

\(^{139}\) Interestingly the CJEU refused to overturn the lower court’s findings on this point on appeal, on the basis that the matter related to findings of a factual nature, outside the scope of appeal (C-553/08 P, \textit{Powerserv Personalservice v OHIM} – \textit{Manpower}, [2009] ECR I-11361, para.52). However, neither did it confirm the principle set out by the GC.

\(^{140}\) T-435/07 \textit{New Look v OHIM (New Look)}, [2008] ECR II-296
Indeed, the BA had found that the relevant public included, in addition to the general public of the United Kingdom and Ireland, that of Malta, Cyprus, the Scandinavia countries, the Netherlands, Finland and ‘all places where fashion is an important commercial activity’\textsuperscript{141}.

The GC rejected the BA’s assertion that the relevant territory included ‘all places where fashion is an important commercial activity’ as overly vague. It also excluded Malta and Cyprus, as these countries had not yet acceded to the EU at the time of the CTM application\textsuperscript{142}.

However, the GC crucially stated the following with regard to ascertaining whether a word mark in a specific language will be understood by the target public in other territories:

Such an understanding may be assumed to exist if a sign is applied for in respect of a territory in which the language of the sign is the native language of the population of the territory and has to be proved in territories in which the relevant language is not the native language of the population, \textit{unless a sufficient knowledge of the language of the sign on part of the target public in those territories is a well-known fact} (emphasis added).\textsuperscript{143}

With regard to the latter part, the GC took the view that ‘[i]n the present case, at the very least, a basic understanding of English on the part of the general public, in any event, in the Scandinavian countries, the Netherlands and Finland must be regarded as a well-known fact’\textsuperscript{144}. As such, it found that the word mark lacked inherent distinctive character in those countries as it would be understood to mean ‘new appearance’.

While the GC narrowed the BA’s definition of the relevant linguistic area, the inclusion of the Netherlands, the Scandinavian countries and Finland is significant. It led to the dismissal of the appeal, since the applicant had not adduced evidence of acquired distinctiveness in these markets.

The GC responded to the applicant’s complaints by stating the following:

Inasmuch as the applicant takes the view that such an approach is tantamount to requiring an applicant for a Community trade mark to guess at the level of understanding of English with regard to a specific mark throughout the Community, thus entailing an extremely complex assessment for which there is no reliable data, it must be pointed out that, contrary to what the applicant claims, it is not complex in the present case, to establish either the level of command of English which is sufficient to understand the sign applied for or the level of command of English in the territories referred to in the contested decision.\textsuperscript{145}

It must be pointed out at this juncture that the GC examined the case explicitly on the basis of Art.7(1)(b), not Art.7(1)(c) TMR. The OHIM examiner’s initial refusal to register the mark had been based on both grounds (b) and (c). On appeal the BA first considered ground (b), and

\textsuperscript{141} \textit{New Look}, see note 140 above, para.18
\textsuperscript{142} \textit{Ibid}, para.24
\textsuperscript{143} \textit{Ibid}, para.22
\textsuperscript{144} \textit{Ibid}, para.23
\textsuperscript{145} \textit{Ibid}, para.25
having found that it applied, exercised judicial economy and stated that examination under ground (c) was not necessary\(^\text{146}\). It followed that the GC examined only ground (b). However, the judgment has been interpreted as upholding the OHIM decision to refuse registration on the basis of descriptiveness and lack of distinctive character\(^\text{147}\). Furthermore, there is nothing to suggest that the GC would have come to any different a conclusion using the explicit basis of Art.7(1)(c) TMR.

(c) What can be drawn from the Manpower and New Look cases?

So what do the Manpower and New Look cases mean? Firstly, they confirm that the perspective of non-native speakers for determining descriptiveness may indeed matter. However, their guidance differs on how to delimit the relevant linguistic/geographical area, i.e. how to determine which non-native speakers are to be taken into consideration. This is so despite the fact that both cases concerned word marks of a banal character and very broad publics.

*Manpower* provides a fairly clear set of guidelines for assessing, case-by-case, the relevant countries. Indeed, the judgment clarified that the descriptiveness of an English-language word mark is not to be automatically assessed only based on its perception in the UK and Ireland; on the other hand, neither is there a set list of countries in which English is presumed to be understood for the purposes of examining English-language word marks\(^\text{148}\).

The *Manpower* decision was indeed welcomed by some practitioners as providing ‘a more structured and consistent approach to the examination of word marks, and an end to seemingly arbitrary, one-size-fits-all lists of countries in which English is deemed understood for the purposes of examination’\(^\text{149}\). Any such jubilation was however tempered soon after by the *New Look* decision.

*New Look* states that an understanding by non-native speakers must be ‘proved’ for countries where the relevant language is not the native language, unless this understanding is a well-known fact. This statement is unquestionably far-reaching. Furthermore, the GC’s assertion that a basic understanding of English by the general public in the Netherlands, the Scandinavian countries and Finland is a well-known fact and therefore requires no evidence arguably shifts the burden of proof from the Office onto the shoulders of CTM applicants to disprove that these countries are part of the relevant geographical area in a given case. This is in contrast with the *Manpower* decision: as there was a lack of evidence suggesting that the word ‘manpower’ had been received into the local language of any other country than Germany and Austria, the GC declined to find that it had been\(^\text{150}\).

It must be remembered that what is at stake in defining the relevant linguistic/geographical area is far from trivial. Depending on the delimitation of the territory an applicant wishing to register an English word mark must be prepared to defend its distinctive character (in a broad sense,

\(^{146}\) R 670/2007-2 (NEW LOOK), decision of 3 Sep. 2007, para.24

\(^{147}\) ‘Acquired Distinctiveness of “New Look” Had to be Shown Outside UK and Ireland’, 245 EU Focus (2009) 32, at 32

\(^{148}\) See Jenkins, note 121 above, p.4

\(^{149}\) Jenkins, note 121 above, p.1

\(^{150}\) Ibid, p.5
encompassing both grounds (b) and (c)) not only in countries where English is a native language, but also in countries where English is spoken, although not at native level. The applicant must also be prepared to submit evidence of acquired distinctiveness in a number of countries. If he fails to prove acquired distinctiveness, he is furthermore blocked from converting his CTM application into national applications in a number of Member States.\textsuperscript{151}

The application of both the \textit{Manpower} and \textit{New Look} guidance can lead to the above ‘nightmare scenario’ for a CTM applicant. However, the crucial difference lies in the fact that the \textit{Manpower} assessment is carried out on a case-by-case basis, without prior preconceptions, and with much more stringent criteria. In other words, Member States are not added to the relevant territory lightly. This approach seems to strike a balance with the dire consequences such an addition may have to the applicant.

Having outlined these two conflicting GC rulings, it is of course imperative to examine their impact. In other words, which set of guidance has been followed subsequently?

(d) The aftermath of the \textit{Manpower} and \textit{New Look} cases

Interestingly, the \textit{Manpower} case does not appear to have been cited in subsequent GC rulings in relation to its guidance on defining the relevant linguistic area. The \textit{New Look} judgment, on the other hand, has. In December 2010 the GC gave its decision in the \textit{Naturally Active} case\textsuperscript{152}. This concerned an appeal of the BA’s refusal to register the word mark ‘NATURALLY ACTIVE’ for cosmetics and related goods and services on the basis of Art.7(1)(b) TMR (Art.7(1)(c) was explicitly deemed not to apply by the BA) and lack of sufficient proof under Art.7(3) TMR.

The definition of the relevant linguistic territory, and the notion of ‘European English-speakers’ more specifically, were central to this dispute. The BA defined the relevant public as the average European English-speaking consumer. The Board and the applicant, however, disagreed on the meaning of ‘European English-speakers’.

For the BA, this category included consumers in the whole of the EU. As such, it found that the absolute ground for refusal applied in and proof of acquired distinctiveness needed to be shown for all countries where ‘basic English words could be understood’\textsuperscript{153}, i.e. all 27 Member States of the EU. The applicant countered that ‘European English-speakers cannot include people with only a very rudimentary knowledge of English.’\textsuperscript{154}

The GC found that the BA had ‘construed the concept of ‘European English-speakers’ too broadly’\textsuperscript{155}. However, it also pointed out that this category ‘does not only consist of nationals of the United Kingdom and Ireland whose mother tongue is English’\textsuperscript{156}. Pointing to the \textit{New Look} precedent, the GC referred to the basic understanding of English by the general public in the Netherlands, the Scandinavian countries and Finland as ‘a matter of common knowledge’\textsuperscript{157}, and

\begin{footnotesize}
\begin{enumerate}
\item \textsuperscript{151} For an in-depth discussion on this interesting topic see Stürmann and Humphreys, note 128 above.
\item \textsuperscript{152} \textit{Naturally Active}, see note 91 above
\item \textsuperscript{153} \textit{Naturally Active}, see note 91 above, para.50
\item \textsuperscript{154} \textit{Ibid}, para.45
\item \textsuperscript{155} \textit{Ibid}, para.52
\item \textsuperscript{156} \textit{Ibid}, para.52
\item \textsuperscript{157} \textit{Ibid}, para.28
\end{enumerate}
\end{footnotesize}
also added Malta and Cyprus to the lot. Since the applicant had only produced evidence of acquired distinctiveness through use concerning the United Kingdom, Ireland and Germany, the appeal was dismissed.

As for the BA, it is uncertain whether it will follow the Manpower or New Look guidance. Subsequent decisions appear to send mixed signals. On one occasion the Board rejected the assumption that the relevant public in Belgium, the Netherlands and Luxembourg has sufficient English skills to understand the term ‘Easy Living’ in relation to printed products. The basis for this decision was that sufficient evidence of the understanding of English by the Benelux public had not been submitted, as required by the GC in Manpower. However, another BA decision two months later implicitly confirms the New Look doctrine, while disregarding an appellant’s explicit reference to the Manpower judgment.

Hence it appears that the evidentiary burden for English-language word marks has indeed shifted in respect of the Netherlands, the Scandinavian countries, Finland, Malta and Cyprus, where an understanding of English, at least at a basic level, is presumed to exist. The Benelux as a whole, however, does not appear to form part of this presumption (yet). In addition, the BA has indicated that ‘[w]ith respect to the other (old) Member States [...] experience shows a certain reluctance to use the English language’, and this appears to have been accepted so far. Nevertheless, as language spreads and the linguistic skills of European consumers improve, the relevant linguistic/geographical territory for English word marks is only likely to grow.

3) Conclusions to be drawn from the recent case-law

It is evident that the case-law is still unsettled on the tricky issue of defining the relevant linguistic territory for assessing absolute grounds of refusal. It is clear, however, that the understanding of non-native speakers may matter. On the other hand, the question of how and when that will be the case is still somewhat unclear. Indeed, the recent Max Planck study found that some respondents ‘stress that it would be important to have a clarification of the territorial scope in respect of which acquired distinctiveness of a CTM must be shown’. (While this comment explicitly relates to acquired distinctiveness, it also implicitly concerns absolute grounds of refusal, since acquired distinctiveness must be shown for those territories where absolute grounds of refusal exist.)

Nevertheless, a consideration of recent case-law and OHIM practice inexorably confirms the curious observation that EU languages are de facto not equal when it comes to registration as CTMs. Expressed differently, neologisms derived from certain languages will have a harder path to CTM registration than those from other languages. The most decisive factor is the extent and depth of the understanding and use of any given language. The more widespread the

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158 R 562/2008-1 (EASY LIVING), decision of 3 Feb. 2009, para.32
159 According to the Board, ‘[t]he examiner deemed that the relevant territory includes the United Kingdom, Ireland, Cyprus and Malta, although other countries where English is commonly understood could have been taken into consideration, such as the Netherlands, Denmark, Sweden and Finland etc.’; R 1578/2008-1 (DIRECT LINE), decision of 30 April 2009, para.24.
160 DIRECT LINE, see note 159 above
161 MANPOWER, see note 133 above, para.18
162 Max Planck study, see note 93 above, para.3.61, p.145
understanding and use of a language, the potentially larger the relevant territory and the harder the path to registration.

This inequality is probably best illustrated by the difficulty of registering word marks in English, as we have seen. Indeed, ‘[g]iven the tendency towards an impressive ability in speaking and understanding English among a wide-ranging population in many Member States, one might expect that it would prove to be more difficult for an applicant to register a mark [...] comprising an English word [...] in Europe than it might be to register words from other languages’\textsuperscript{163}. One writer further argues with regard to the registration of neologisms deriving from the English language at OHIM that ‘the assessment as to whether a neologism is more than the sum of the parts becomes less predictable or certain in outcome than it may have been at the [UK Intellectual Property Office]’\textsuperscript{164}.

This has lead practitioners to criticise the ‘anti-English language position [...] taken by the authorities’ and the ‘severely disadvantaged’ situation that English word marks finds themselves in\textsuperscript{165}. It is also prophesised that the French and German languages may meet a similar fate (if that has not already occurred) due to the widespread knowledge of French in Belgium and Luxembourg, and German in Denmark and the Netherlands\textsuperscript{166}.

One can therefore visualise a spectrum ranging from languages in which neologisms are hardest to register to those for which registration is easiest. At the ‘hardest’ end, one would undoubtedly find English, as well as perhaps other Germanic and Romance languages. Finno-Ugric languages (mainly Finnish and Hungarian), in a league of their own, would be closest to the ‘easiest’ end, with other EU languages falling somewhere inbetween.

\textbf{E - Acknowledging and embracing the linguistic realities of the EU market in the assessment of neologisms’ descriptiveness}

The \textit{de facto} inequality of EU languages with regard to CTM registration is of course not stated in any legislation or guidelines, nor is it explicitly acknowledged by the EU courts. Rather it plainly arises from the linguistic reality of our time. Formally, all EU languages are equal in the EU trade mark system; however, in the spirit of Orwell’s famous dictum, some languages simply end up being more equal than others. The question that inevitably arises from this is whether it is ‘\textit{fair}’ that EU languages are \textit{de facto} treated unequally. This is perhaps all the more relevant since the difference in treatment could to a great extent be solved in a very simple fashion, namely by refusing to assess word marks from the perspective of anyone but a native speaker. Hence, \textit{should} CTMs only be assessed from the perspective of native speakers? Direction in this matter could be sought from across the Atlantic.

1) The US ‘foreign equivalents’ doctrine

\textsuperscript{165} Jenkins, see note 121 above, p.21
\textsuperscript{166} Jenkins, see note 121 above, p.21
We will now consider how the US trade mark system deals with the registration of trade marks in various languages in its multilingual society. As has been previously stated, a comparison with the US is interesting mainly in light of the well-developed nature of its trade mark system. However, the US approach is especially pertinent to consider from a linguistic perspective due to the genuinely multi-cultural nature of the consuming public of both the EU and the US\textsuperscript{167}.

In dealing with the registration of foreign language word marks in the US, the United States Patent and Trademark Office (USPTO) has opted for a fairly straightforward, but nonetheless fascinating solution known as the ‘foreign equivalents’ doctrine. The doctrine applies to a number of statutory bars to registration, namely refusal on the basis of likelihood of confusion, mistake or deception; descriptiveness; geographic significance; and surnames\textsuperscript{168}.

With regard to descriptiveness in particular, foreign word marks are translated into English, and if this translation produces a descriptive or generic term \textit{vis à vis} the underlying goods the mark will be refused registration. In other words the US trade mark system takes the view that ‘[t]he foreign equivalent of a merely descriptive English word is no more registrable than the English word itself\textsuperscript{169}. Therefore ‘marks in foreign languages are translated into English and tested for the statutory bars to registration, instead of being tested in their original form\textsuperscript{170}.

There is, however a caveat to this rule, namely that the doctrine of foreign equivalents ‘is not an absolute rule, but merely a guideline’. It should be applied ‘only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent’. Furthermore, the doctrine mainly concerns modern languages, and no translation is required in the case of ‘dead or obscure’ languages\textsuperscript{171}.

As such, ‘MATZOOON’ was refused registration for a fermented milk-based food of Armenian origin on the basis that the term is descriptive in Armenian\textsuperscript{172}. Similarly, ‘Ha-Lush-Ka’, a hyphenated, phonetically spelled version of the word ‘haluska’, was refused registration in connection with a type of noodle based on the fact that the term is used to describe the product in Hungarian\textsuperscript{173}.

The foreign equivalents practice even applies to languages that use a non-Latin alphabet. Hence the word mark ‘AYUMI’ and its Japanese-character equivalent were held to be merely descriptive for footwear on the basis that the primary meaning of these terms is ‘walking’\textsuperscript{174}. In a similar vein, the Chinese characters meaning ‘Oriental Daily News’ were found to be merely descriptive of newspapers\textsuperscript{175}.

2) The comparison between the US and EU approaches

\textsuperscript{167} See Bowman, note 120 above, at 514
\textsuperscript{168} See USPTO TMEP, note 63 above, paras.1207, 1209-1211
\textsuperscript{169} USPTO TMEP, see note 63 above, para.1209.03(g) Foreign Equivalents
\textsuperscript{171} All quotes in this paragraph from USPTO TMEP, see note 63 above, para 1209.03(g)
\textsuperscript{172} Dadirian v. Yacubian, 98 F. 872, C.A.1, 1900
\textsuperscript{173} Weiss Noodle Company v. Golden Cracknel and Speciality Company, 290 F.2d 845, CCPA, 1961
\textsuperscript{174} In re Tokutake Indus. Co., 87 USPQ2d 1697 (TTAB 2008)
\textsuperscript{175} In re Oriental Daily News, Inc., 230 USPQ 637 (TTAB 1986)
In one writer’s words, ‘[s]triking similarities exist in the purpose of the [TMR], [...] and that of the trademark law of the United States [...]. Striking disparities between the trademark laws of the United States and Europe exist in the treatment of proposed verbal marks based on the respective interpretations of the distinctive nature of these marks in a linguistic context’\textsuperscript{176}. The most crucial divergence relates to the role of the non-native speaker.

Comparing the US approach to the EU’s, the former has one baseline, namely the English language, against which to assess descriptiveness. The EU, however, cannot have such a baseline. Instead it has a varying baseline which changes according to the language of the sign being examined. If a word mark is in French, its descriptiveness will be assessed in relation to the French language. This in itself is not an issue.

The crucial difference lies in the fact that the assessment of descriptiveness in the US is done from the perspective of a native speaker. Indeed, the US doctrine firstly looks at how a consumer fluent in the language of the foreign mark perceives the sign; the crucial question then is whether the translated, English term is descriptive of the underlying goods or services for a native English-speaker\textsuperscript{177}. In the EU, the perception of non-native speakers also matters.

It is evident that the US approach is not without its flaws. The foreign equivalents doctrine has met with staunch criticism, mainly due to its alleged lack of clarity and the incoherence in its application\textsuperscript{178}. In particular, the trigger for the application of the doctrine is the likelihood of the ‘ordinary American purchaser’ stopping and translating the foreign term\textsuperscript{179}, which is far from easy to determine. Moreover, as stated by Rest, ‘the act of translation, itself, is an imprecise task’\textsuperscript{180}. This translation issue is undoubtedly all the more problematic when it comes to neologisms. It is therefore obvious that the US approach is no shining example to blindly follow. However, what this paper suggests is that the US practice of considering word marks from the perspective of native speakers is worth reflecting on.

3) Conclusions on how the EU trade mark system should embrace linguistic diversity

We set out to compare the approaches adopted by the US and EU trade mark systems regarding the registration of word marks in a multilingual context in an attempt to answer the following question: \textit{should the EU trade mark system adopt the US practice of assessing word marks purely from the perspective of a native speaker?}

The US foreign equivalents doctrine operates in a manner completely its own, as well as in a very different context from the CTM system. Nevertheless, adopting only native speakers as yardstick may appear an attractive option for the EU as well. Indeed, Bertrand argues that the EU trade mark system (as well as national systems) should adopt the two major tenets of the foreign

\textsuperscript{176} Bowman, see note 120 above, at 514
\textsuperscript{177} See USPTO TMEP, note 63 above, para.1209.03(g); Rest, note 7 above, at 1226; Krimnus, note 170 above, at 173
\textsuperscript{178} Krimnus argues that ‘the doctrine is ridden with confusion and in many cases, an utter lack of reasoning’ (see note 170 above, at 202), while Rest talks of ‘uncertainty and inconsistency’ (see note 7 above, at 1212).
\textsuperscript{179} USPTO TMEP, see note 63 above, para.1209.03(g)
\textsuperscript{180} Rest, see note 7 above, at 1223
equivalents doctrine, namely that foreign terms are analysed in light of the understanding of the consumer who has knowledge of the language at hand, and that people’s ignorance should not be a basis for a property right\textsuperscript{181}.

Firstly, assessing word marks only from the perspective of consumers in countries where the language of the mark is an official language would increase legal certainty. This is especially true with regard to CTM applicants, who lament the current state of uncertainty\textsuperscript{182}. Secondly, there is something intellectually satisfying about not allowing the law to protect ‘ignorance’\textsuperscript{183}. Furthermore, as languages and linguistic knowledge spreads within the EU, the scope of registrability may progressively get narrower and narrower if increasing amounts of non-native speakers are allowed to be added to the equation.

Despite these arguments, it is this author’s view that only examining word marks from the perspective of native speakers does not take account of the current realities of the EU market. Indeed, the internationalisation of products and markets is a fact of life, and means that an increasing amount of trade marks consist of foreign terms\textsuperscript{184}. Consumers are confronted with marks in foreign languages, regardless of what their level of understanding of those languages is. A trade mark system which takes into consideration the point of view of such ‘imperfect’ consumers arguably gives a more genuine and holistic reflection of the EU market.

In addition, if the argument that trade marks should be assessed purely \textit{from the perspective of} native speakers is taken to its logical end, should the assessment itself not also be carried out purely \textit{by} native speakers, even at the level of the European courts? As far as OHIM is concerned, this already seems to be the case at a first instance. Indeed, ‘[f]iles are allocated on a language basis first […]. CTM applications are put under the scrutinizing eyes of a native speaker of each of the […] EU languages to assess whether the mark is descriptive in any of them\textsuperscript{185}.

Nevertheless, it is interesting to consider that AG Colomer has strongly criticised the fact that CJEU went beyond questions of law in the \textit{Baby-dry} judgment, and decided on the descriptiveness of the mark despite having only one native English speaker on board\textsuperscript{186}. Indeed, ‘[w]hilst it might have been possible for the case of BABY-DRY to be resolved on the basis of the presumed proficiency of the members of the Court of Justice in English, that is unlikely to be true of marks expressed, for example, in Finnish. And it would be aberrant for the type of appellate review to vary according to the language of the sign\textsuperscript{187}.

While AG Colomer’s criticism is of course primarily aimed at the Court over-stepping its role and going beyond questions of law, it does raise the question of whether word marks should purely be assessed by native speakers. The present author believes that a situation where CTMs could only be assessed in the EU courts by native speakers would not necessarily be practicable.

\textsuperscript{181} Bertrand, see note 55 above, para.3.256, p.79
\textsuperscript{182} See Jenkins, note 121 above
\textsuperscript{183} Bertrand, see note 55 above, para.3.256, p.79
\textsuperscript{184} Bertrand, see note 55 above, para.3.256, p.77
\textsuperscript{185} Véronique Musson, ‘Finding its feet: 10 years of OHIM practice’, (3) \textit{World Trademark Review} (September/October 2006), 15, at 15
\textsuperscript{186} Opinion of Advocate General Colomer in \textit{Postkantoor}, see note 17 above, footnote 46
\textsuperscript{187} Opinion of Advocate General Colomer in \textit{Companyline}, see note 118 above, footnote 20
Moreover, and more importantly, it is not desirable. EU judges’ impressive, but nonetheless inevitably imperfect linguistic skills reflect those of the EU consumers in reality.

Perhaps the US foreign equivalents doctrine, which adopts English as a baseline and the native English-speaker as yardstick, will have to be rethought in the near future. One survey showed that 82 percent of the US population speak English, while 11 percent speak Spanish. This suggests firstly that the primacy of the English language might become harder to justify as other languages become increasingly common, and secondly that a large part of the population does not speak English as a mother tongue, if at all. It is therefore not inconceivable that the US trade mark system may one day seek direction from the EU to truly address the realities of its multilingual market.

However, if non-native speakers are to be taken into account in the EU trade mark system, certain considerations must be borne in mind. Crucially, the EU’s linguistic diversity is a treasure worth protecting, and this is well recognised in Art.3(3) of the Treaty on European Union, which states that ‘[The Union] shall respect its rich [...] linguistic diversity’, among other important values and aims. However, it should never be allowed to become a hindrance, as it clearly has in the process of creating a unitary EU patent right.

There is little to fault per se in the rules regarding the registrability of neologisms set out in the case-law of the EU courts as they stand today. The reliance on a ‘more than the sum of its parts’-test, applied in light of the underlying rationale of Art.7(1)(c) TMR, i.e. the protection of other traders’ interests, is as useful a tool as can be hoped for in drawing the line between descriptive and allusive marks. The difficulty lies rather in the application of the rules in the EU’s multilingual context.

Therefore in order to stop linguistic diversity from becoming a burden and to avoid turning the ‘more than the sum of its parts’-test into ‘a linguistic rule whose slavish application could have perverse results’ in a context of 23 official languages, the following factors should be considered. Firstly, clear and stringent rules should be adopted for determining which non-native speakers matter, i.e. which countries are relevant for assessing absolute grounds in any given situation. Adherence to the clear and strict guidelines set out by the GC in the Manpower case could fulfil this condition. Furthermore, in line with the Manpower judgment, trade marks should be assessed on a case-by-case basis, and reliance on ‘usual suspect’ country lists should be avoided.

In light of all these difficulties, perhaps the safest path to CTM registration opens up to ‘European’ neologisms combining terms from two or more languages. Indeed, the OHIM Manual states that ‘[c]ombinations made up of two words from two different languages are registrable, provided however, that the use of the respective other term in both languages is unusual’, giving

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188 Fluency in all of the EU’s 23 official languages would indeed be quite a feat.
191 Smith, see note 164 above, at 806
192 As discussed above, see p.30, and Manpower, note 131 above, paras.73, 75-76
the example ‘PAN SPEZIALITÄTEN’\(^{193}\). Interestingly, such marks also avoid being caught by the US foreign equivalents doctrine, to the effect that ‘LA YOGURT’ could be registered for yogurt and ‘GLACE LITE’ for ice cream, sherbet, frozen yogurt and non-dairy frozen desserts\(^{194}\).

It is furthermore very interesting to consider the rationale behind the US foreign equivalents doctrine. It not only recognises ‘the cosmopolitan character of populations’, but also importantly acknowledges ‘the international character of trade’\(^{195}\). Indeed,

[T]he policy behind the doctrine is one of international comity. Because U.S. companies would be impaired in international trade if foreign countries granted trademark protection to generic or merely descriptive English words in their countries, the U.S. reciprocates and refuses trademark protection to generic or merely descriptive foreign words.\(^ {196}\)

In comparison, the CTM system only looks at EU languages, and official ones at that\(^ {197}\). As has been argued before, not all EU languages are de facto treated equally within the EU. However, the EU also ‘discriminates’ between EU and non-EU languages. This is so even if the latter are de facto spoken by a not insignificant part of the population in Member States, as is the case for Turkish and Arabic in France and Germany, and Russian in the Baltic countries\(^ {198}\). As succinctly expressed by Bowman, the US foreign equivalents doctrine is ‘outward-looking’ and takes into consideration any language, while the EU approach is ‘inward-looking’ and only considers EU languages\(^ {199}\).

As such, it can be argued that the EU takes a very stringent approach vis à vis marks in official EU languages by taking into account the understanding of non-native speakers, while at the same time adopting a very lax attitude once the linguistic borders of the EU are crossed. This is well illustrated by the EU’s so-called ‘big bang enlargement’ of 2004. Before the enlargement words in Hungarian, Estonian and Latvian, for instance, could be registered as CTMs even if they plainly described the underlying goods or services. However, after 1 May 2004, such words ‘became’ descriptive overnight\(^ {200}\). The above-mentioned Hungarian ‘Ha-Lush-Ka’ word mark, refused registration in the US in 1961, would indeed have had a different fate as a CTM.

The recent Max Planck study acknowledges that ‘[i]t may seem arbitrary to distinguish between “official” languages and other languages even though the “other” languages may be more widely spoken than some of the “official” languages’\(^ {201}\). It nevertheless concludes that the status quo

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\(^{193}\) OHIM Manual, para.7.3.3, p.36

\(^{194}\) In re Johanna Farms Inc., 8 USPQ2d 1408 (TTAB 1988) and In re Sweet Victory, Inc., 228 USPQ 959 (TTAB 1986)

\(^{195}\) Rest, see note 7 above, at 1222

\(^{196}\) Rest, see note 7 above, at 1222

\(^{197}\) See Max Planck study, note 93 above, para.3.40, p.141

\(^{198}\) See Max Planck study, note 93 above, para.3.41, p.141

\(^{199}\) Bowman, see note 120 above, at 522

\(^{200}\) Absolute grounds of refusal relating to one of the new languages could not, however, be used to invalidate a previously registered CTM. See Eva Szigeti and Zsófia Klauber, ‘Enlargement of the European Union: Trade Mark Issues in Hungary and Other New EU States’, 94 The Trademark Reporter (July-August 2004), 924

\(^{201}\) Max Planck study, see note 93 above, para.3.67, p.146
should be maintained, as ‘allowing even other than the official languages to prevent registration of a CTM if the mark is descriptive or non-distinctive in that other language would constitute an unwarranted extension of the unitary principle’. It remains to be seen whether the Commission will follow this recommendation, which seems to present the unitary character of the EU regime as an end rather than as a means to a well-functioning trade mark system.

V. Conclusion

The EU’s unique linguistic context provides a difficult terrain for the CTM system to work on, especially when providing entry visas for neologisms into the land of CTM registration. Nevertheless, it is the present author’s view that this difficult terrain should be bravely acknowledged, and roads built to facilitate certainty and make passage possible, albeit subject to certain check points.

Firstly, the understanding of neologisms by European consumers not fully fluent in the language of the sign should be taken into consideration when determining descriptiveness. Such an approach merely reflects the realities of the EU market.

Case-law of the EU courts and OHIM practice show that the understanding by such ‘imperfect’ consumers is taken into account, but in a very irregular manner. It is true that ‘weak’ word marks (i.e. marks with a low level of inherent distinctiveness) and marks derived from broadly used languages appear more likely to be considered also from the perspective of non-native speakers. Nevertheless, there is a lack of clarity and coordination as to when only the perception of native speakers is considered, and when non-native speakers will be included in the relevant public. Therefore both the EU courts and OHIM should adopt a more coherent and sanguine attitude to admitting that the perception of consumers with imperfect language skills also matters.

Nevertheless, considering the perception of non-native speakers should be done in an informed manner. A neologism’s path to registration is already strewn with a number of obstacles. Neologisms firstly require an extra measure of imaginativeness in order to fulfil the primary requirement that they amount to ‘more than the sum of their parts’. Secondly, the public interest underlying Art.7(1)(c) TMR mainly speaks in favour of other traders’ interests. Therefore the EU’s particular linguistic context should be dealt with carefully in order not to entirely block off the path to registration.

While the perception of non-native speakers matters, there should be clear and stringent rules on when and how this is the case. Crucially, it should be clarified which non-native speakers are to be taken into consideration. It is this author’s view that the delimitation of the relevant linguistic/geographical territory should be carried out on a case-by-case basis, instead of falling

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202 Max Planck study, see note 93 above, para.3.67, p.146
203 Jeremy Philips mordantly points out that the Commission’s double disclaimer relating to the study ‘does not look like an enthusiastic endorsement’; Jeremy Philips, ‘Maxing out on Trade Mark Reform in the EU: the Study is here’, 8 March 2011, on The IPKat blog, retrieved from ipkitten.blogspot.com on 18 May 2011.
back on ‘usual suspect’ country lists, which arguably shift the burden of proof unduly onto the shoulders of the CTM applicant.

It is perhaps not entirely without irony that in a Union of 23 official languages, neologisms with ‘dual nationality’ combining terms from two or more languages can more easily cross into the promised land of EU trade mark registration.

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