

# AA THORNTON

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INTELLECTUAL PROPERTY LAW

## Foreign words as Trade Marks

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**A.A. Thornton & Co.**

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- Why should Vauxhall not have called a make of car **NOVA**?



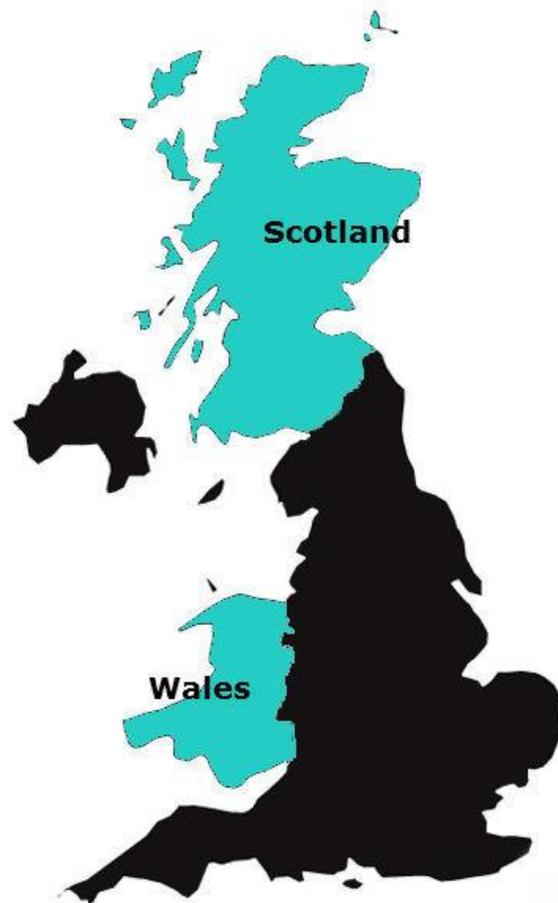
- Why should Toyota not have called a make of car MR2?



- ❑ Should Clairol have introduced the “Mist Stick”, a curling iron, into Germany?
  
- ❑ Should Honda have used the mark FITTA for a car in Nordic countries?
  
- ❑ Would you have told your client not to file a Community Trade Mark application for the mark REVA?
  
- ❑ What would you say to Colgate about the introduction of CUE toothpaste into France?
  
- ❑ Would you apply to register the mark HIJOPUTA?

- What would you say to Sharwoods before they registered the trade mark **BUNDH** on curry sauce and spent £6,000,000 on a campaign to promote it?





Gaelic and Welsh have equal status to English in Scotland and Wales

The Community Trade Mark is a unitary right





There are 5 languages used in OHIM

There are 24 official languages of the EU

There are numerous unofficial languages

- ❑ A CTM registration is a unitary right
- ❑ Article 7(2) CTMR excludes an application from registration if a ground for refusal pertains in only part of the European Union.
- ❑ The mark must be refused if it is descriptive in any of the **official** languages of the European Union
- ❑ If convincing evidence is put forwards that a mark has a meaning in a **non-official** language and is understood in part of the European Union then the application will be refused.
- ❑ This can lead to refusal on the basis the mark is in a language which has official status in a Member State, although that language is not an official language of the European Union.

# Example - Non European languages

- ❑ **HELLIM** for cheese
- ❑ Hellim is the Turkish translation of 'Halloumi', a type of cheese
- ❑ Turkish spoken by part of the population of Cyprus, and therefore the average consumer in Cyprus may understand that **HELLIM** is a descriptive term for cheese
  
- ❑ **ESPETEC** for sausage
- ❑ Espetec is descriptive in Catalan, a Spanish local language
- ❑ A ground for refusal **in part of** a Member State is sufficient to lead to refusal of the CTM application as a whole

- ❑ The same applies in the UK – if a mark is descriptive in any of the official languages of the UK - English, Welsh or Gaelic - it will be refused
- ❑ The UK IPO is currently following the European Court of Justice's (ECJ) judgement in case C-421/04 Matratzen Concord AG v Hukla Germany SA

*“there are no grounds for refusing registration of trade marks on the basis that they are relevantly descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question”*

- ❑ The UK IPO also considers the following European languages to be widely understood in the UK : French, Spanish, Italian and German
- ❑ ‘Biscuit pour Chien’ (dog biscuits).
- ❑ The mark ځ IMAR (an Arabic word – YASHMAK is the English)

- ❑ BIMBO DOUGHNUTS
- ❑ DOGHNUTS
- ❑ Case C-591/12 P, Bimbo SA v OHIM, Panrico SA



## ❑ CTM

- ❑ Article 7(1)(f) CTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality.
- ❑ If the ground for refusal exists, even in only part of the Community, then the application will be refused.

## ❑ UK

- ❑ Section 3(3)(a) of the 1994 Act states “*a trade mark shall not be registered if it is contrary to public policy or to accepted principles of morality*”
- ❑ If the ground for refusal exists in just part of the UK then the application will be refused.

| <b>Basis for refusal</b> | <b>CTM</b>                           |
|--------------------------|--------------------------------------|
| Descriptiveness          | Evidence of acquired distinctiveness |

- ❑ To overcome the objection the evidence must show that the mark has acquired a distinctive character in the portion of the Community in which the absolute grounds exist
- ❑ Thus if the mark lacks a distinctive character only in part of the Community then the evidence only needs to prove it has acquired a distinctive character in that part of the Community.

| Basis for refusal | CTM                                  |
|-------------------|--------------------------------------|
| Descriptiveness   | Evidence of acquired distinctiveness |

- ❑ German is an official language in Germany, Austria, Luxembourg and Belgium
- ❑ English is an official language in the United Kingdom, in the Republic of Ireland and Malta
- ❑ Acquired distinctiveness through use must be provided for all the countries where the language is used
- ❑ If you can show the mark has acquired a distinctive character in the relevant part of the European Community a registration will be granted

| <b>Basis for refusal</b> | <b>CTM</b>                           | <b>UK</b>                            |
|--------------------------|--------------------------------------|--------------------------------------|
| Descriptiveness          | Evidence of acquired distinctiveness | Evidence of acquired distinctiveness |

- ❑ The same basic principles apply in the UK
- ❑ If you can prove a mark has acquired a distinctive character for the group or area to which the objection applies then a registration will be granted

| <b>Basis for refusal</b> | <b>CTM</b>                           | <b>UK</b>                            |
|--------------------------|--------------------------------------|--------------------------------------|
| Descriptiveness          | Evidence of acquired distinctiveness | Evidence of acquired distinctiveness |
| Descriptiveness          | Conversion                           |                                      |

- ❑ A CTM application can be converted
- ❑ You cannot convert in the countries where the grounds of objection apply
- ❑ National offices can still raise objection on absolute grounds

| <b>Basis for refusal</b> | <b>CTM</b>                           | <b>UK</b>                            |
|--------------------------|--------------------------------------|--------------------------------------|
| Descriptiveness          | Evidence of acquired distinctiveness | Evidence of acquired distinctiveness |
| Descriptiveness          | Conversion                           | N/A                                  |

- ❑ There is no equivalent to conversion in the UK

| <b>Basis for refusal</b> | <b>CTM</b>                           | <b>UK</b>                            |
|--------------------------|--------------------------------------|--------------------------------------|
| Descriptiveness          | Evidence of acquired distinctiveness | Evidence of acquired distinctiveness |
| Descriptiveness          | Conversion                           |                                      |
| Contrary to morality     | Conversion                           | N/A                                  |

- ❑ The same options are available to marks which are refused because they are contrary to morality

**Q:** Why should Vauxhall not have called a make of car **NOVA**?

**A:** *Means NO GO in Spanish. Not good for a car.*

**Q:** Why should Toyota not have called a make of car **MR2**?

**A:** *Pronounced m-er-deux or “merdeux” meaning crap. Change to MR for France.*

**Q:** Should Clairol have introduced the **MIST STICK**, a curling iron, in Germany?

**A:** *“Mist” means manure in German.*

**Q:** Should Honda have used the mark **FITTA** for a car in Nordic countries?

**A:** *Fitta is a vulgar swear word in Nordic countries. Changed to **FIT***

**Q:** Would you have told your client not to file a Community Trade Mark application for the mark **REVA**?

**A:** *Reva is a vulgar swear word in Finland.*

**Q:** What would you say to Colgate about the introduction of **CUE** toothpaste into France?

**A:** *Cue is the name of a French adult magazine.*

**Q:** Would you apply to register the mark **HIJOPUTA**?

**A:** *Hijoputa is a vulgar swear word in Spain.*

**Q:** What would you say to Sharwoods before they registered the trade mark BUNDH on curry sauce and spent £6,000,000 on a campaign to promote it?

*"deliciously rich", it would "change the way consumers make curry"*



**Q:** What would you say to Sharwoods before they registered the trade mark BUNDH on curry sauce and spent £6,000,000 on a campaign to promote it?

*"deliciously rich", it would "change the way consumers make curry"*

**A:** It means 'arse' in Punjabi.

# Reliance on IPO examination

| Mark               | Issue                                |
|--------------------|--------------------------------------|
| NOVA               | Unfortunate meaning in Spain         |
| MR2                | Unfortunate pronunciation in France  |
| MIST STICK         | Swear word in German                 |
| REVA               | Taboo swear word in Finland          |
| FITTA              | Taboo swear word in Nordic countries |
| CUE                | Name of French adult magazine        |
| HIJOPUTA           | Taboo swear word in Spain            |
| BUNDH              | Unfortunate meaning in local dialect |
| BIMBO<br>DOUGHNUTS | Not descriptive in local language    |

# Reliance on IPO examination

| Mark               | Issue                                       | Objection raised<br>OHIM/UKIPO? |
|--------------------|---|---------------------------------|
| NOVA               | Unfortunate meaning in Spain                | No                              |
| MR2                | Unfortunate pronunciation in France         | No                              |
| MIST STICK         | Swear word in German                        | No                              |
| REVA               | <b>Taboo</b> swear word in Finland          | <b>Yes</b>                      |
| FITTA              | <b>Taboo</b> swear word in Nordic countries | <b>Yes</b>                      |
| CUE                | Name of French adult magazine               | No                              |
| HIJOPUTA           | <b>Taboo</b> swear word in Spain            | <b>Yes</b>                      |
| BUNDH              | Unfortunate meaning in local dialect        | No                              |
| BIMBO<br>DOUGHNUTS | Not descriptive in local language           | No                              |

# Local attorney searches

| Mark            | Issue                                | Raised as concern by local attorney |
|-----------------|--------------------------------------|-------------------------------------|
| NOVA            | Unfortunate meaning in Spain         | ?                                   |
| MR2             | Unfortunate pronunciation in France  | ?                                   |
| MIST STICK      | Swear word in German                 | Yes                                 |
| REVA            | Taboo swear word in Finland          | Yes                                 |
| FITTA           | Taboo swear word in Nordic countries | Yes                                 |
| CUE             | Name of French adult magazine        | ?                                   |
| HIJOPUTA        | Taboo swear word in Spain            | Yes                                 |
| BUNDH           | Unfortunate meaning in local dialect | ?                                   |
| BIMBO DOUGHNUTS | Not descriptive in local language    | ?                                   |

| Mark            | Issue                                | Simple internet search |
|-----------------|--------------------------------------|------------------------|
| NOVA            | Unfortunate meaning in Spain         | ?                      |
| MR2             | Unfortunate pronunciation in France  | ?                      |
| MIST STICK      | Swear word in German                 | Yes                    |
| REVA            | Taboo swear word in Finland          | Yes                    |
| FITTA           | Taboo swear word in Nordic countries | Yes                    |
| CUE             | Name of French adult magazine        | Possibly               |
| HIJOPUTA        | Taboo swear word in Spain            | Yes                    |
| BUNDH           | Unfortunate meaning in local dialect | Possibly               |
| BIMBO DOUGHNUTS | Not descriptive in local language    | Possibly               |

- ❑ Always keeping in mind that there might be a “non-obvious” inherent registerability issue
- ❑ Conducting basic interest searches for all marks to check for unexpected meanings
- ❑ Where budget allows, taking advice from local attorneys
- ❑ Filing an application as early as possible in the development of the brand



**Ian Gill**  
**Partner**

- A Partner since 2001 and with over 15 years' experience in the field, Ian specialises in contentious and non-contentious issues relating to trademarks and design
- His professional qualifications include: Registered Trade Mark Attorney, European Trade Mark & Designs attorney, Chartered Patent Attorney and European Patent Attorney
- Ian's clients span a diverse range of industries, but his particular focus is in the food & beverage and fashion sectors
- Ian's technical expertise includes contentious and non-contentious issues, spanning the full spectrum of intellectual property law, including trademarks, registered designs and patents. The bulk of his work relates to trade mark prosecution and enforcement, including related issues such as intellectual property portfolio management and domain name dispute resolution proceedings
- Ian was ranked a "Leading Individual" or equivalent from 2010 through to 2013 in the Chambers & Partners guide to the world's best lawyers
- Member of ITMA, INTA, CIPA, FICPI and PTMG

#### **Core responsibilities and activities**

- Coordinating the worldwide IP portfolios of a number of major companies
- Representing the patent and trade mark interests of a broad range of SMEs and private individuals
- Ian's technical expertise includes contentious and non-contentious issues, spanning the full spectrum of intellectual property law, including trademarks, registered designs, patents and copyright
- Trade Mark prosecution and enforcement, including related issues such as intellectual property portfolio management and domain name dispute resolution proceedings

If you would like more information on this topic or to speak to one of our attorneys please visit our website at [www.aathornton.com](http://www.aathornton.com) for attorney profiles or email us at [aat@aathornton.com](mailto:aat@aathornton.com)

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