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Foreign words as Trade Marks in Europe and UK

A brief outline of the presentation delivered by Ian Gill, Partner at the International Federation of Intellectual Property Attorneys 15th Open Forum in Barcelona on 7 November 2014

Marks which are descriptive or contrary to public policy or morality cannot be registered. Objections raised to applications on this basis are referred to as objections on "absolute grounds". Objections on absolute grounds can raise particular problems when filing applications in multilingual regions such as the European Community Trade Mark (CTM) system.

There are twenty four official languages used in CTM countries, and numerous unofficial languages like Catalan and Basque.

A Community Trade Mark registration is a unitary right – it must cover all the countries of the European Community, and if an objection based on absolute grounds exists then the CTM Office will object to the application. An objection will be raised even if the objection only applies in one country, or part of one country.

The CTM Office will conduct searches of all twenty four official languages of the European Union, and it is open to third parties to file evidence that a mark should face objection because of a meaning in an unofficial language. For example an application for the mark ESPETEC was refused registration for sausages because the term has that meaning in Catalan, a language spoken in the Spanish region of Catalonia. Similarly, the mark HELLIM was refused registration for cheese because it is a Turkish term describing Halloumi cheese, and whilst Turkish is not an official language of the European Union it is a language which is understood in Cyprus.

Similar considerations do apply to the United Kingdom application as Welsh and Gaelic have equal status to English in Wales and Scotland respectively, and so for example a mark which is descriptive in Welsh will be refused registration for the United Kingdom as a whole. The United Kingdom Intellectual Property Office will also raise objections to commonly understood words in French, Spanish, Italian and German so for example "Biscuit pour Chien" will be understood by the average customer as meaning dog biscuits and will face objection for those goods.

Objections based on absolute grounds can be overcome if you can show that a mark has acquired a distinctive character as a result of the use that has been made of it. If the objection applies to just part of the territory then you only need to provide evidence for that part of the territory where the objection applies, but you should note that because a large proportion of the European population have a good understanding of English then marks consisting of elementary English words may require evidence that relates to acquired distinctiveness in all CTM countries.

If it is not possible to overcome the objection then a CTM application can be converted into national applications in the countries where the objection does not apply, but a UK application cannot be converted.

The risk of issues of this type can be reduced with simple internet searches in conjunction with more comprehensive registered trade mark searches and the filing of trade

mark applications as early as possible in the development of the trade mark.

How can we help?

At A.A. Thornton & Co. our trade mark attorneys are qualified to advise on all aspects of trade mark law. The services of our trade mark attorneys include:

- Advising on your choice of trade marks and their registrability
- Trade Mark Audits and IP portfolio management
- Due diligence of trade mark rights
- Searches, investigations and advice on filing strategies
- Preparing, filing and prosecuting national, EU or international trade mark applications
- Facilitating registration of trade marks overseas
- Managing renewals of trade marks
- Trade mark watches to identify competitors' applications and registrations
- Handling oppositions, cancellations and appeals
- Negotiating amicable settlements and co-existence agreements
- Negotiating and drafting licence agreements and assignments
- Advising on infringement of trade mark registrations and attacks on validity
- Liaising with solicitors and barristers in the enforcement or defence of registered and common law rights

Contact

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