

AA THORNTON

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INTELLECTUAL PROPERTY LAW

## Foreign words as Trade Marks

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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 خ 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.

| Basis for refusal | CTM                                  |
|-------------------|--------------------------------------|
| 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

| Basis for refusal | CTM                                  | UK                                   |
|-------------------|--------------------------------------|--------------------------------------|
| 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

| Basis for refusal | CTM                                  | UK                                   |
|-------------------|--------------------------------------|--------------------------------------|
| 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

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

- ❑ There is no equivalent to conversion in the UK

| Basis for refusal    | CTM                                  | UK                                   |
|----------------------|--------------------------------------|--------------------------------------|
| 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.

- ❑ *Blooper proves bum deal for Sharwoods*
- ❑ *Curry lovers give sauce a bum rap*
- ❑ *Spanking new curry sauce angers Punjabis*
- ❑ *UK Sauce A Bummer With Punjabis*

# 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<br>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<br>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