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Marks that are descriptive in languages other than English or in
minority languages

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Abbreviations

- ✓ **BOIP** The Benelux Office for Intellectual Property.
- ✓ **CFI** Court of First Instance up to 1 December 2009, presently the General Court.
- ✓ **CJEU** The Courts of Justice of the European Union (encompasses both the General Court and the Court of Justice).
- ✓ **CTM** The Community Trade Mark.
- ✓ **CTMD** The First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.
- ✓ **CTMR** Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark.
- ✓ **CTMIR** Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community Trade Mark.
- ✓ **GC** The General Court of the European Union.
- ✓ **OHIM** The Office for Harmonisation of the Internal Market.
- ✓ **USPTO** The United States Patent and Trademark Office.

Introduction: Setting the scene

“Respect for the word is the first commandment in the discipline by which a man can be educated to maturity — intellectual, emotional, and moral.

Respect for the word — to employ it with scrupulous care and in incorruptible heartfelt love of truth — is essential if there is to be any growth in a society or in the human race.”¹

1. Even though we might not be aware of it, we are being confronted with marks on a more than daily basis. One merely has to take a look at their clothing, shoes, nutrition, beverages, car(s), cosmetics, electronic devices and so on to discover their presence. Marketing agencies - inspired by the influence of marks on consumers - have raised marks to a higher level and have turned them into a new successful business in itself.

2. One of the most popular ways to draw people’s attention to a product continues to be the use of words. However, in order to obtain a strong mark one should choose wisely, for a word mark might lose its all-important distinctive character when becoming descriptive. Although a word may be fictitious in one language, that doesn’t automatically guarantee its distinctiveness in another. This could be problematic for a Community trademark, taking into account the rich linguistic landscape that characterizes the EU. Indeed, the fact that many languages are spoken in the Community seems to be directly linked to the arising problems.²

3. From a research point of view this provides interesting material to work with. The Office for Harmonization of the Internal Market³ applies five working languages, in addition to which the official languages of all Member States of the European Union must be counted, which makes a total of 23 languages. In addition to that come semi-official languages, over a hundred regional and minority languages as well as slang and dialects. Consequently, the risk of having a mark that is descriptive in one country – or several countries – is quite real.

¹ Quote of Dag Hammarskjöld, former diplomate and secretary-general of the United Nations between 10th April 1953 and 18th September 1961.

² This has also been the conclusion drawn by the Max Planck Institute in the study they carried out upon request of the European Commission. For a detailed overview of this study: 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, 15th February 2011, nr 3.36, p140.

³ Hereafter referred to as the OHIM or the Office.

4. This thesis is built upon four key aspects. Beside a short overview of the legal framework in the first part, an analysis of recent case law in respect of descriptive marks in multiple languages – major and minor, official and non-official – will be provided in the second part. This research looks for answers as to where to draw the line between official and minority languages. Is there any noticeable distinction between the assessment of a mark in an official language or that written in a minority language? With the continuous expansion of minority languages, we slowly march towards a holistic view on Europe's linguistic landscape, welcoming the criterion of the understanding of the relevant public. Within this context multilingualism and a revision of minority languages are the two main elements.

5. The third part tends to find out how the decisive criteria have evolved along the years. Regarding the written word mark, both the characters used as well as accents are of importance. As to the phonetic assessment of word signs, pronunciation plays its role. Multiple ways of pronouncing do not just come along with one single word spoken out loud by people with distinct native idioms, but also within one and the same language – one merely needs to think of slang and dialects. Thirdly, ancient languages like Latin and Greek do not cease to influence modern day languages, be it in their original form or in a contemporary derivative.

6. Looking for possible solutions we analyse how two other core trade centres deal with marks that are descriptive in other than English. Australia and the US daily welcome new immigrants who not only import their culture, but also their own native language. In addition to that they both house many minority groups who have been there from the very beginning, but whose idioms still haven't been officially recognized. Starting from a comparative point of view, we look for alternatives that could work in the EU as well.

Part 1 Legal framework of word marks

7. What is a mark? Article 4 CMTR⁴ allows any sign to fulfill the function of a trademark. The mere statement of it already raises two other questions. Firstly, one could ask what sorts of marks are meant and how they should be represented. Secondly, it puts forward the requirements for protectability. Both issues will be described briefly and applied to word marks.

Chapter 1 Composition of word marks

§1 Graphical representation

8. As to the first question about what sorts of signs qualify as a mark, article 4, first sentence part CMTR provides us with some information, stating that they should be “*capable of being represented graphically*”⁵⁶ and then mentions words as potential marks.

9. Can be considered – among others – as word marks: invented words and fantasy names⁷⁸, surnames⁹, slogans¹⁰, abbreviations and letters¹¹ or even numbers¹². At one point the issue becomes a lot more complex, namely the use of either existing words coming from daily linguistic usage or the use of neologisms partly and indirectly containing (the meaning of) the

⁴ Council Regulation (EC) No 207/2009 of 26th February 2009 on the Community trade mark, *Pb. L.* 24th April 2009, ep 78, 1-42. Hereafter referred to as CTMR.

⁵ Article 4, first phrase CTMR.

⁶ In the Sieckmann case the European Court of Justice explained the ratio for this graphical representation requirement, which is three-fold. Firstly it allows one to determine the precise subject of the protection, secondly it enables access to the authorities for examination and thirdly it avoids any element of subjectivity. Ever since this decision courts apply a specific formula to determine whether this requirement has been fulfilled or not. Visual representation can be done either by line, images, characters or any other means, provided that they are clear, precise, self-contained, intelligible, durable, objective and easily accessible: ECJ 12th December 2002, *Sieckmann*, C-273/00, *ECR* 2002 p. I-11737.

⁷ Examples are – among others – Häagen-Dazs, Persil, Pepsi, Kodak, Nalu, Obelix and Xerox. Once said to be “*automatically and inherently registrable*”: J. PHILLIPS, *Trade Mark Law – A Practical Anatomy*, Oxford, Oxford University Press 2003, 58.

⁸ This can also be an existing word written in an incorrect way, like for instance ‘OXO’. However, it should be clear it is not always a guarantee for distinctiveness: GC 12th June 2007, *MacLean-Fogg/OHIM*, Case T-339/05, (‘Lokthread’), paragraph 55.

⁹ Examples: Philips (electronics), Christie (books), Sullivan (tobacco), MacDonald (fast food), Belmondo (cleansing product), Bob Dylan (singer songwriter) and Vandemoortele (food services). A legal restriction hereto is that trademark owners cannot prevent the use by third parties with the same surname. The latter however will have to act in accordance with the customary way of trade: Benelux Convention on Intellectual Property (Trademarks and Designs) of February 25th 2005 and F. GOTZEN en M.-C. JANSSENS, *Wegwijs in het intellectueel eigendomsrecht*, Brugge, Vanden Broele, 2009, 104.

¹⁰ Examples: “*Vorsprung durch Technik*” by Audi: Audi/OHIM 21st January 2010; “*Mannen weten waarom*” by Maes Pils.

¹¹ Such as HP (Hewlett Packard), BP (British Petroleum), MTV (Music Television), BMW (Bayerische Motoren Werke) and many others.

¹² For example: 4711 (perfume fragrances), Q8 (oil products), 727 (airplane).

original words. As such there is no objection whatsoever to the former category, provided that those words are used to indicate goods or services in a completely different context than the one in which they are normally applied.¹³ With regard to the latter category, neologisms can prove to be highly valuable from a commercial point of view, since they call to mind the designation of the original word. Although suggestive marks are capable of transmitting “*a positive message to the consumer*”¹⁴, it may be exactly that asset turning out to be a poisoned gift. Indeed, as soon as the delicate borders of suggestiveness are crossed, words head towards descriptiveness¹⁵ and therefore jeopardize their chance of registration as an absolute ground for refusal¹⁶, based on lack of distinctive character.¹⁷ A critical remark in this regard is that it suffices the mark “*could be used*” for describing the goods or services.¹⁸

§2 Distinctive character

10. As to the second question of protectability criteria, article 4, second sentence part CTMR refers to signs “*capable of distinguishing goods or services of one undertaking from those of other undertakings*”. This distinctive character is the legally most essential function of a mark.¹⁹²⁰ In other words, marks should enable consumers to identify products and denote the origin – this is the company – they come from. Furthermore, there are other requirements to be added: the sign should not be prohibited in one of the Member States and should still be available in all countries.²¹ Whereas the latter is a mere relative ground, the first two requirements are absolute refusal and cancellation grounds.

11. A mark should be distinctive in all 27 Member States. Since this requirement is an absolute ground, absence of distinctiveness constitutes an inherent problem and may therefore

¹³ Successful examples are numerous: Apple, Le Chat, Merci, Reebok, Shell and many others.

¹⁴ D. 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” in *Intellectual Property Quarterly* 2003, (131) 153.

¹⁵ There is a wide range of choices for word marks, There is an order though going from respectively the strongest to the weakest position: arbitrary, over associative and suggestive to descriptive and generic.

¹⁶ Or in case the mark has already been registered, it will become subject to invalidation.

¹⁷ Exactly that conclusion was (implicitly) drawn by the ECJ in the Biomild case: ECJ 12th February 2004, *Campina Melkunie BV/Benelux-Merkenbureau*, C-265/00, (‘Biomild’), nr 39.

¹⁸ ECJ 23rd October 2003, *WM Wrigley Jr Company/OHIM*, C-191/01, (‘Doublemint’), *ECR* 2003, I-12447, nr 32.

¹⁹ The historical significance hereof dates back to 1883, a period of industrial revolution and economic need during which farmers tried to prevent other farmers from stealing their cattle. In order to achieve that, they would burn a mark on their animals, in order for everyone to know they were his.

²⁰ Although not necessary in order to obtain protection, marks also fulfill other, more empirical functions additional to the distinctive character. Firstly there is a guarantee function (protection of goodwill). As a consumer you expect a certain quality from the brand you buy. Secondly, marks have an advertising function and even a trust function. Companies will do anything to maintain and preferably improve the guarantee labels to their products.

²¹ We will not discuss the matter of prohibited signs and availability any further, since this research aims to focus on the (loss of) distinctive character when descriptive in languages other than English.

be invoked by everyone. Especially when applying for a Community trademark, this might prove tricky, since one has to take into account the 23 official languages of the European Union.²² We will shortly describe the consequences of lack of distinctive character in either a part of the EU as well as in the whole of the EU.

a) Lack of distinctive character in a part of the EU

12. Being the most common of these two, a word mark will more likely lack distinctive character only in a specific linguistic region, rather than in the whole of the EU. Therefore the reason for refusal will often be found in the linguistic meaning of the mark, which explains why descriptiveness in one area suffices to jeopardize a potential registration of the mark, regardless of a country's size or population.²³ It is then up to the applicant to prove acquired distinctiveness in the whole of that area, yet only in that specific area in which the language at stake is spoken or understood.²⁴ A part of the Community is here to be understood as either one Member State or a group of Member States, certainly not as a part of a Member State - however large it might be. For instance, when an application for a word mark in English tends to be refused for being descriptive, the OHIM will not only look at the UK market in order to conclude to acquired distinctiveness, but also at Ireland and Malta since English is their second official language and therefore spoken amongst its habitants.²⁵ The applicant of the word mark will have to deliver proof of his sign having acquired distinctive character through use in the Ireland, Malta and the UK.²⁶ As it happens that these are the countries in which it lacked distinctiveness *ab initio*.

²² The ratio legis is the following: when investigating distinctive character the OHIM only takes into consideration the 23 official languages of the EU. These languages are: Bulgarian, Czech, Danish, Dutch, English, Estonian, Finnish, French, Gaelic, German, Greek, Hungarian, Italian, Latvian, Lithuanian, Maltese, Polish, Portuguese, Romanian, Slovak, Slovenian, Spanish and Swedish: OHIM, Guidelines concerning proceedings before the Office, Part B, Examination, Final version: 2008, 20 and European Commission survey carried out in 2005, *Europeans and their languages*, 5.

²³ *OHIM Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part B – Examination*, most recently revised on 15th September 2010, para.7.1.3, p24. 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.

²⁴ “Europolis” is considered descriptive for insurance services in the Dutch speaking part of the Benelux, since the word ‘polis’ in Dutch is quite common in order to refer to insurance contracts: ECJ 7th September 2006, *Bovemij/BOIP*, C-108/05 (‘Europolis’).

²⁵ Other examples are the following: when examining the application for a Swedish word mark, the OHIM will also have a look at the Finnish market, where Swedish is the second national language; the same goes for a Greek word mark, the OHIM will examine the Greek, but also the Cypriot market: EGC 17th May 2011, *Diagnostiko kai Therapeftiko Kentro Athinon “Ygeia”/BHIM*, T-7/10 (‘υγεία’), para 54. The term “υγεία” is Greek for “health”. In order to find out whether or not this term is descriptive, the relevant public consists of both Greek as well as Cypriot consumers.

²⁶ A small nuance is in place. At times the relevant English speaking public is to be extended to a wider territory within the EU or even the whole of the EU: cfr Part 2 European world languages versus minority languages, Chapter 1 English.

13. The general way to assess a mark's distinctive character is two-fold. On the one hand you look at the goods or services the registration of which has been applied for, on the other hand you also take into account the perception of the relevant consumers.²⁷ Nevertheless, the assessment to establish whether a word sign is understandable for the relevant consumer differs from one area to another.²⁸ If the language spoken by the people in a certain area and the language in which the sign is written are one and the same, it is presumed the relevant consumers do understand the (meaning of) the sign.²⁹ *A contrario*, this presumption does not apply when there is no match between the languages of the sign on the one hand and the language spoken in that territory. In such a case, it must be proven on a case-by-case basis the sign is indeed understandable for the relevant consumer. However, this proof is not required if it is generally known the relevant consumers have sufficient knowledge of the language in question, namely the language of the sign.

b) Lack of distinctive character in the whole of the EU

14. At times it occurs a mark lacks distinctive character in the entire European Union.³⁰ Reason may be the nature of the goods or services for which registration has been applied. Again we may give the example of an English word mark. It is no secret that the English language is probably the most common of all among the computer and software business throughout the EU. If an English sign then proves to be descriptive, it will automatically be descriptive in the whole of the Union. However, also certain combinations of letters may undergo the same fate. Depending on the specific circumstances of each situation the distinctions between the relevant public in different territories within the EU are negligible as to the interpretation of the word mark as well as the relationship between this sign and the good or services. For this reason the General Court concluded “*TDI*”³¹ to be descriptive for any goods or services within the European car sector. As it happens, cars usually are released under the same denomination throughout the entire internal market. Consequently, it is rather unlikely the relevant public in one region will assess the significance of the mark differently

²⁷ The relevant consumers are those consumers for whom the products or services are intended: EGC 25th May 2012, *Nike vs OHIM & Intermar Simanto Nahmias*, T-233/10.

²⁸ EGC 26th November 2008, *New Look/BHIM*, T-435/07 (‘New Look’), nr 22.

²⁹ Consequently one may assume an English word sign is not only understood in the UK, but also in Ireland and Malta since both nations also have English as their second official native language.

³⁰ OHIM, Guidelines concerning proceedings before the Office, Part B, Examination, Final version: 2008, 52-53.

³¹ “*TDI*” is the abbreviation of either “*Turbo Diesel Injection*” or “*Turbo Direct Injection*”.

from the relevant public elsewhere in the EU.³² The situation turns even more problematic when a sign consists only of one single character or figure. And then are certain words that are universally comprehensible. Regardless of their language of origin words such as “vino”³³ or extra”³⁴ are generally known – and therefore understood – throughout the EU.

15. Another factor to look at is exactly the relevant public, as it may consist of merely experts in a certain domain, rather than a more general public. Obviously a specialized public utilizes an adequate jargon or lingo. People working in the computer and software business for instance, will be familiar with English technical terminology, for English is the internationally accepted business language.³⁵ As a consequence, English, Irish and Maltese ICT specialist will not be the only ones to be taken into account, but all experts in this field throughout the whole of the Union. The relevant public will thus be spread across the EU in order to establish whether the mark has either had distinctive character from the beginning or has acquired it through use.

Chapter 2 Current legislation on the registrability of word marks

16. The General Court has built its case law mainly upon the refusal ground laid down in article 7, §1, b CTMR, namely all signs that “*are devoid of any distinctive character*”. *Ratio legis* is to avoid registration of marks incapable of fulfilling their utmost important task, which until today continues to be the identification of the commercial origin of the goods or services. Signs generally used by marketing agencies seem less likely to successfully fulfill this function. We talk denominations possibly interpreted as slogans, qualifications of quality or incentives to buy those goods or services.³⁶ Consumers are less keen to see such denominations as the commercial origin of the products they buy.³⁷ If the normal use would indeed serve to indicate goods or services – be it directly, be it through mentioning of the essential features – this will suffice not to register the mark.

³² GC 3rd December 2003, *Audi/OHIM*, T-16/02 (*TDF*), paragraph 38. The General Court has confirmed its decision: EGC 6th July 2011, *Audi & Volkswagen/OHIM*, T-318/09 (*TDF*), paragraph 19. As a result the application for registration as a Community Trademark had been withdrawn. The appeal at the European Court of Justice has been without due cause ever since: Disposal ECJ 5th July 2012, *Audi & Volkswagen/OHIM*, C-467/11 P (*TDF*).

³³ For the sake of accuracy: “vino” is Italian and Spanish for “wine”.

³⁴ Originates from Latin. Meaning: external, outward, except, excluded, excluding, extraordinary.

³⁵ English is not only the leading language in the ICT sector, but also in the medical sector. Doctors and pharmacists in the whole of the EU will be familiar with English scientific terms. Again for the same reason.

³⁶ GC 12th March 2008, *Suez/OHIM*, T-128/07 (*Delivering the essentials of life*), nr 18 and EGC 15th September 2005, *Citicorp/OHIM*, T-320/03 (*Live Richly*), paragraphs 65-66.

³⁷ Of course this does not necessarily hinder such signs in obtaining distinctiveness.

17. When assessing a word mark's distinctive character under article 7, §1, c CTMR the General Court sets the bar a lot higher. Sub c aims at signs or indications that from the point of view of the relevant public – either directly or indirectly – may serve to denominate the goods or services the registration of which has been applied for.³⁸ This will be the case when the sign shows a sufficiently direct en tangible connection to the goods or services involved for the people to perceive descriptiveness. In other words, the two main conditions are a *link between the sign to the goods or services provided* on the one hand and a possibility for the *public concerned* to notice the descriptive character of the sign for those goods or services.

18. Thirdly, article 7, §2 CTMR stresses the unitary character of the EU trademark system³⁹, stating no absolute refusal grounds shall exist throughout the whole of the EU. Given the exceptional European linguistic context, this article is of great importance.

19. Finally, article 7, §3 CTMR reflects the possibility for inherently descriptive marks to be registered anyway on the condition their use has made them distinctive in relation to the goods or services registration has been applied for.

³⁸ ECJ 20th September 2001, *Procter & Gamble/OHIM*, C-383/99 P ('Baby-Dry'), nr 39 and EGC 3rd December 2003, *Audi/OHIM*, T-16/02 ('TDI'), paragraph 27.

³⁹ The unitary character also finds its expression in article 1, §2 CTMR and Recital 3 of the Preamble to the Regulation.

Part 2 European world languages versus minority languages

20. In this part we will investigate the differing assessments of a mark's distinctive character in either a major (world) language or in a minority language. What distinguishes a major language from a minor one? To what extent does the amount of speakers affect such distinction? By means of successively English, the four remaining OHIM working languages, several smaller European languages and some minority languages we will analyse the General Court's recent case law regarding these issues.

Chapter 1 English

21. Marks composed of one word or a combination of words in a well-established language within the borders of the EU face quite some challenges to be distinctive. If registration of a mark in this situation will be refused, the refusal ground is most likely to be applicable in a wider area of the EU, if not in the entire territory of the Union. The most obvious example would be English, *primus inter pares*. Though not within the scope of this research, a look at Shakespeare's language might come in useful, since it provides us with some interesting insights in how to define the relevant public.

22. According to the General Court's case law any sign consisting of English words, the combination of which is grammatically correct, may not only have a significance to native English speakers, but also to any audience in any other Member State with a sufficient knowledge of the English language.⁴⁰ Therefore the relevant public for word marks originating from daily used idioms⁴¹ will be two-tiered. On the one hand this relevant public will consist of people from Member States that have English as their national language and spoken by a vast majority of their habitants.⁴² The General Court confirmed this with regard to the UK and Ireland, stating that the term "Basics" for all sorts of paint is merely descriptive. *A fortiori* – the Court uses the words "*above all*" – this goes for the UK and

⁴⁰ GC 12th March 2008, *Suez/OHIM*, T-128/07 ('*Delivering the essentials of life*'), nr 22 and GC 15th September 2005, *Citicorp/OHIM*, T-320/03 ('*Live Richly*'), paragraph 76.

⁴¹ According to the General Court "New Look" is a trivial term. As such it is part of the daily linguistic usage. There is no linguistic difficulty whatsoever for people to understand this notion: GC 26th November 2008, *New Look/OHIM*, T-435/07 ('*New Look*'), paragraph 20.

⁴² This will be the UK, Ireland and Malta, for whom English is the mother tongue.

Ireland, since English is the leading language in both countries.⁴³ Remarkable is that Malta is not included, even though English is its second official language and therefore spoken by the Maltese. On the other hand also non-native English speakers with a sufficient knowledge of English will be considered part of the relevant public.⁴⁴ Moreover, it is “a well-known fact” that the general public in Finland, Scandinavia (this is Denmark and Sweden) and the Netherlands is adequately skilled in English.⁴⁵

23. In order to establish whether an English word mark is descriptive of goods or services in non-English speaking countries research should be done with regard to the normal use of the term from the viewpoint of the relevant public. There are two ways to find out.⁴⁶ One manner would be that the English word has become a standard in that State’s official language, which differs from English.⁴⁷ The relevant consumers actually use the English term as a substitute to equivalent offered by their own national language. The second method would be a combination of English and the national language in order to draw people’s attention to the goods or services. Is English not explicitly used for exactly this purpose, then a widely spread knowledge of English amongst (a large part of) the relevant public won’t do the trick.⁴⁸ The mere fact that the relevant public moderates English sufficiently does not automatically result in the public drawing an immediate connection between the word at issue and the related

⁴³ The fact that the Court explicitly refers to the UK and Ireland does not imply other Member States should not be taken into account. Thus, the sign at issue may also be understandable elsewhere: EGC 12th September 2007, *ColArt/Americas/OHIM*, T-164/06 (‘Basics’), paragraph 24.

⁴⁴ Recently confirmed in the Eventer case: GC (6th Chamber) 21st March 2013, *Event/OHIM - CBT Comunicación Multimedia*, T-353/11, (‘Eventer Event Management Systems’), paragraph 78.

⁴⁵ GC 9th December 2010, *Liz Earle Beauty/OHIM*, T-307/09 (‘Naturally Active’), paragraph 53 and GC 26th November 2008, *New Look/OHIM*, T-435/07 (‘New Look’), paragraph 23. A similar conclusion was drawn with regard to the word ‘sport’ in the K2 Sports case: GC (5th Chamber) 31st January 2013, *KS Sports Europe/OHIM – Karhu Sports Ibérica*, T-54/12, (‘sport’), paragraph 26. See also the Euro Automatic Payment case: GC (4th Chamber) 12th April 2011, *Euro-Information/OHIM*, T-28/10, (‘Euro Automatic Payment’), paragraphs 47 and 81.

⁴⁶ GC 15th October 2008, *Powerserv Personalservice/OHIM & Manpower*, T-405/05 (‘Manpower’), paragraphs 75-76.

⁴⁷ In that sense the General Court decided the term ‘Manpower’ to be descriptive in German with respect to services provided by an employment agency. German speaking consumers – consumers in Germany, Austria and Switzerland – immediately and without second thought see a direct connection between the notion itself and the services. The term has become part of the German language, since it had been included in the dictionary where it is brought forward as a synonym for ‘Arbeitskraft’: GC 15th Oktober 2008, *Powerserv Personalservice/OHIM - Manpower*, T-405/05, paragraphs 77-80 (‘Manpower’). Recently the GC took a similar decision, appeal to which has been dismissed: GC (4th Chamber) 15th January 2013, *BSH v OHIM*, T-625/11, paragraph 7 (‘ecoDoor’) and GC 8th February 2013, *BSH/OHIM*, T-625/11, paragraph 7 (‘ecoDoor’).

⁴⁸ As said before the Board of Appeal at the OHIM ‘Manpower’ is descriptive in those Member States where a significant part of the relevant public knows and uses commercial English to a satisfactory extent, more specifically in Denmark, Finland, Sweden and The Netherlands. This is the consequence of English being the internationally accepted common business language, as well as the official working language of many international organisations. Even students in business course nowadays are confronted with English texts on a much larger scale. In the above mentioned countries the presence of knowledge and use of the English language has been clearly experienced according to the Board of Appeal. Again, the General Court disagrees: GC 15th October 2008, *Powerserv Personalservice/OHIM - Manpower*, T-405/05 (‘Manpower’), paragraphs 81-94.

goods or services. For instance, doctors and pharmacists may understand the descriptive meaning of a Latin name whereas the average end consumer of pharmaceuticals may not.⁴⁹

24. Unfortunately, the matter is much more complicated. The number of Member States to which this so-called well-known fact is being extended, tends to vary from time to time. Although English is Malta's second official language, it is considered to be one of those countries in which English is 'generally known' rather than being part of the first category.⁵⁰ Unlike Cyprus where Greek and Turkish are the two official languages, but which is nonetheless in the same category as Malta.⁵¹ On top of that, one should be aware of the exact date of application for registration. If that dates back to the time before these countries' accession to the EU, the OHIM will not take them into consideration regarding the relevant public.

25. Whereas the General Court is rather reluctant to broaden the relevant territory towards all EU Member States, the Board of Appeal at the OHIM tends to do quite the opposite. Thus far the Board has already extended the relevant territory in which exists a refusal ground to "*all countries where basic English words are understood, hereby referring to all members of the EU*".⁵² The General Court adds to this that the Member States in which (basic) English is understood by the people is much more numerous than the amount of Member States that have acknowledged English as their official language.⁵³ In other words, the territory in which distinctive character could be failing *ab initio* sure can comprise several Member States when the sign consists of simple English wordings. Since this does not necessarily imply the whole of the EU, one must always stay vigilant not to jump to conclusions too fast. As such, the average public in Europe's fashion centers cannot be presumed to have such a high level in English as to conclude they would understand every single expression.⁵⁴ Neither does the fact

⁴⁹ Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, paragraph 27, 4th part, www.ipo.gov.uk. For a more detailed analysis in a specific case cfr ECJ 5th October 2004, *Alcon/OHIM*, C-192/03 P ('BSS') confirming GC 5th March 2003, *Alcon/OHIM*, T-237/01, paragraph 42 ('BSS').

⁵⁰ Although more recently the General court seems to head in a different direction: The relevant territory is fixed to be France, Belgium, Luxemburg, the UK, Ireland and Malta: EGC 1st February 2013, *Ferrari/OHIM*, T-104/11, ('perle'), paragraph 39.

⁵¹ GC 9th December 2010, *Liz Earle Beauty/OHIM*, T-307/09, paragraph 53 ('Naturally Active').

⁵² The relevant consumers then being referred to as "*European English speakers*". The Office however sees no reason to specifically define the meaning of this notion: OHIM (Board of Appeal) 11th May 2009, *Liz Earle Beauty*, R 24/2009-2 ('Naturally Active'), paragraph 33.

⁵³ GC 9th December 2010, *Liz Earle Beauty/OHIM*, T-307/09 ('Naturally Active'), paragraph 25.

⁵⁴ The Board of Appeal at the OHIM stated, with regard to the "New Look" case, that such a notion lacks distinctive character in all areas of which fashion is the heart of commercial activities. The General Court however disagreed, saying such a definition is too vague to distinguish a certain territory from the relevant public: GC 26th November 2008, *New Look/OHIM*, T-435/07 ('New Look'), paragraph 24.

that English is the most widely spoken foreign language throughout the European Union imply that knowledge of English is spread equally in all Member States.⁵⁵ On the contrary, only 27% of the Spanish population is said to have sufficient skills in English to have a conversation in that language.⁵⁶

Chapter 2 Major versus minor languages

26. Apart from English the most widely spread and understood languages throughout the EU are French, German, Italian and Spanish – all officially acknowledged by the OHIM as their working languages.⁵⁷ Even though the greater majority of European consumers cannot be expected to be fluent in these languages, most of them will have at least some notions of the more common words.⁵⁸

27. In addition to these five ‘European world languages’, the EU counts eighteen more official languages, which generally are not so commonly spread. A positive side so to say of – for instance – Dutch, Finnish, Greek or Swedish – is that word marks in such a language will often only, if at all, lack distinctive character in very few Member States, depending on the language at issue.

28. Ultimately, the European Union houses no less than sixty-five regional and minority languages.⁵⁹ Despite the fact we keep them strictly separated from the official languages, the continuously evolving migration of people around Europe seems to call for a rearrangement.

⁵⁵ GC (4th Chamber) 13th November 2012, *Tesa/OHIM – Superquímica*, T-555/11, (‘Tesa Tack’), paragraph 27 juncto paragraph 32.

⁵⁶ European Commission survey carried out in 2005, *Europeans and their languages*.

⁵⁷ Article 119, §1 CTMR.

⁵⁸ As so-called ‘European world languages’ English (61.3 million), German (96.9 million), French (62.4 million), Italian and Spanish (39.4 million) are not only spoken internationally, but also learned by many people as a second language. They are characterized by the number of speakers – both natives as well as second language speakers – on the one hand and their geographical distribution on the other hand: www.ieg-ego.eu. A recent study of the European Commission revealed Europeans show a positive attitude towards multilingualism. 67% see English as one of the two most useful languages for themselves. Among the others, most frequently cited as useful are German (17%), French (16%), Spanish (14%) and Chinese (6%): European Commission survey carried out in 2012, *Europeans and their languages*, 10 and http://ec.europa.eu/languages/languages-of-europe/eurobarometer-survey_en.htm. Also consult J. GERRY and C. RUBINO (eds), *Facts About the World’s Languages: An Encyclopedia of the World’s Major Languages, Past and Present*, 2001, 268.

⁵⁹ For a good understanding of minority languages, it is crucial to make the distinction with non-territorial languages such as those of the Roma or Jewish communities in the EU that speak Romani and Yiddish: *Speaking for Europe: Languages in the European Union*, European Commission Directorate-General for Communication, Office for Official Publications of the European Communities, 2008 Luxembourg, 9. Apart from that there are also languages, which are spoken by immigrant communities in the EU. They are referred to as non-indigenous languages and lack a formal status. These languages include a wide range of tongues from other parts of the world: Maghreb Arabic mainly in France, Germany, Spain, and Belgium;

§1 Relevance of the distinction

29. The distinction between three categories of languages set out above proves relevant on two levels. Firstly, the most obvious distinction is that between official and non-official – or so-called minority – languages. Secondly, we should also separate larger major languages from those, which are spoken by a significantly smaller amount of people.

a) Official versus non-official languages

30. Usually, minority languages are spoken by a minority group of the population in one member state. However, some are officially acknowledged in a Member State and enjoy recognition in the EU. Until recently the OHIM did not take into account languages such as Basque, Breton, Catalan, Galician⁶⁰, Sardinian, Turkish or Welsh^{61 62}.

b) Big versus small languages

31. Applying article 7, §2 CTMR literally, the OHIM will assess the application for word marks in light of the signs' possible meaning(s) in all 23 official languages. Since English is the most widely spread language throughout the EU, chances are quite high citizens whose native idiom differs from English have notions or even good knowledge of this language.⁶³ To what extent will that facilitate them avoiding the trap of descriptiveness in both their mother tongue as well as in English and does this imply an advantage in comparison to native English-speakers? The application for “Tikka Tikka” by a British company concerning multiple categories *inter alia* games and food was refused. The word ‘tikka’ is found to be descriptive both in English for a type of food or spices for such food as well as in the Finnish

Russian in the Baltic States; Urdu, Bengali and Hindi spoken by immigrants from the Indian subcontinent in the United Kingdom: R. CREECH, *Law and Language in the European Union: the Paradox of a Babel United in Diversity*, European Law Publishing, 2005, 50.

⁶⁰ Since 2006 Basque, Catalan and Galician are considered semi-official languages which implies that certain EU documents have to be translated into these languages at the cost of the Spanish government.

⁶¹ It should be noted however that Welsh has an equally important status as English in Wales. For national trade marks in the UK word marks in Welsh are therefore being treated in the same way as are trademarks containing the equivalent English word: Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, paragraph 27, 7th part, www.ipo.gov.uk.

⁶² STUDY ON THE OVERALL FUNCTIONING OF THE EUROPEAN TRADE MARK SYSTEM (ALLENBACH STUDY), nr 3.40.

⁶³ Opinion of Advocate General Colomer in ECJ 12th February 2004, *Koninklijke KPN Nederland/Benelux-Merkenbureau*, C-363/99, ECR 2004, I-1619, (‘Postkantoor’), paragraph 68. The same reasoning goes for English, French, German, Italian and Spanish. Many more people than just the native speakers have at least some knowledge of these ‘major’ EU languages.

language, where it refers to dart games.⁶⁴ Although regarding the food the company should have known the risk of descriptiveness, one could question the British applicant's prior knowledge as to the Finnish meaning of the word.

32. For countries such as Finland, whose official language is neither spoken nor understood in any other Member State, the situation seems fairly simple at first sight.⁶⁵ Finnish word marks will be assessed from the perspective of native Finnish speakers, and the relevant linguistic/geographical territory will be limited to Finland. One might think it will be a lot easier for Finnish companies to know at least whether their word sign is descriptive in their own language. If companies succeed to circumvent that, they have a much greater certainty with regard to distinctive character in the whole of the EU. However, such reasoning would be blunt. Applications for "Putkireformi"⁶⁶ (referring to plumbing reforms) and "Rautaruukki"⁶⁷ (meaning iron works) by Finnish companies with regard to respectively construction-related goods and metal goods have been declined, based on their descriptive character. Rautaruukki Oyj did not question the descriptiveness of its mark, but stated that distinctive character had been acquired through long-term, extensive and established use.⁶⁸ The display of the company's history in Finland however is not of such nature that it alters the sign's descriptiveness.⁶⁹

33. It is thus up to the applicant to master his native language in such a way he personally can be the first judge in assessing his own word mark's distinctive character. The Swedish company Steninge Slott AB seeking registration for a Community word mark "Steninge Slott" for design products of glass, crystal and porcelain has experienced this.⁷⁰ Its opponent Hammarplast AB opposed on the basis of their earlier Swedish word mark "Steninge Keramik" for inner and outer flowerpots made of ceramics.⁷¹ According to Hammarplast the

⁶⁴ R 746/2005-4 ('Tikka Tikka'), decision of 31st March 2006, paragraph 2.

⁶⁵ For a more extensive overview of Finnish word marks: E.-L. RÄIKKÖNEN, "A Brave New World: A Neologism's Dangerous Path to EU Trade Mark Registration", *IRDI* 2011, 303-319.

⁶⁶ R 485/2009-2 ('Putkireformi'), decision of 25th June 2009.

⁶⁷ GC (8th Chamber) 19th November 2008, *Rautaruukki/OHIM*, T-269/06, ('Rautaruukki').

⁶⁸ In assessing whether a mark has acquired distinctive character through use, multiple factors must be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. For a detailed overview of this topic cfr C. DE SCHRYVER, "Inburgering van een gemeenschapsmerk: waar?" in *IRDI* 2013-1, 7 and C. DE SCHRYVER, *Het gebruik van het Gemeenschapsmerk vanuit geografisch perspectief: inburgering, bekendheid en normaal gebruik*, master thesis Law KULeuven, 2011-2012, 91p, <http://oami.europa.eu>

⁶⁹ GC (8th Chamber) 19th November 2008, *Rautaruukki/OHIM*, T-269/06, ('Rautaruukki'), paragraph 51.

⁷⁰ Class 21 of the Nice Agreement.

⁷¹ GC (2nd Chamber) 17th October 2006, *Hammarplast/OHIM - Steninge Slott*, T-499/04 ('Steninge Slott').

first word element, to know ‘Steninge’, shared by both sign holders is the dominant element of the earlier mark.⁷² The remaining word parts ‘keramik’ and ‘slott’ would merely be secondary, especially ‘keramik’ which would be purely descriptive according to holder of the earlier Swedish word mark. The Office stated that the relevant territory is Sweden since ‘Steninge’ refers to a locality in Seden, ‘slott’ is Swedish for castle and ‘Keramik’ meaning ceramics is indeed exclusively descriptive in Swedish.⁷³

§2 The traditional criterion: official character

34. Just as less as twenty-one native Dutch million speakers outweigh four hundred thousand native Maltese speakers, do sixty-three million native Turkish speakers spread among several European countries⁷⁴ outweigh four million native Finnish speakers. The first two are both official languages, which implies they share an equally decisive part in the assessment of a word mark’s distinctive character, regardless of the amount of their native speakers. In the second comparison the non-official language, based on the official character criterion, would not be able to have any effect at all when it comes to assessing distinctiveness, unlike the rather ‘small’ language that is Finnish, purely on the ground that it is official.

35. Until recently only official languages have been taken into consideration when assessing a word mark’s distinctive character. According to the Office a part of a Member State – however large it may be – could not be considered as “a part of the Community” in which a mark may lack distinctive character. Consequently, any language only workable in such part of a Member State could not serve as an idiom to be taken into account when assessing a word mark’s distinctiveness.

⁷² Consumers tend to pay more attention to the beginning of any sign and consequently remember said part easier.

⁷³ GC (2nd Chamber) 17th October 2006, *Hammarplast/OHIM - Steninge Slott*, T-499/04 (‘Steninge Slott’) paragraphs 41 and 49.

⁷⁴ Turkish-speaking minorities exist in countries that formerly (in whole or partly) belonged to the Ottoman Empire, such as Bulgaria, Cyprus, Greece, the Republic of Macedonia, Romania, and Serbia. More than two million Turkish speakers live in Germany; and there are significant Turkish-speaking communities in the United States, France, The Netherlands, Austria, Belgium, Switzerland, and the United Kingdom: R.G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 582.

Chapter 3 Towards a holistic view on the EU's linguistic landscape

36. Despite the long lasting use of the official character criterion, more recently the OHIM seems to slightly have adapted its approach towards these minority languages. From now on languages that are not one of the official languages within the EU are to be understood in a different perspective.⁷⁵ This change of course will be illustrated through Catalan, which is a minority language in one particular Member State as well as through Turkish, which is one of Europe's most widely spread minority languages.

§1 Examples of upcoming minority languages

a) Catalan

37. In particular with regard to Catalan – which generally is seen as a minority language, but by Spain is recognized as one of its official languages – the OHIM took a remarkable decision when refusing registration of “Espetec”. “Espetec” (or its synonym ‘fuet’) – Catalan for “*a type of sausage that is not cooked but left to dry in order to be eaten*” (typically Catalan) – was denied registration as a mark for goods in class 29, containing amongst others raw pork and dried meat on grounds of article 7, §1, b and c CTMR.⁷⁶ As the OHIM decision was appealed, the General Court had the chance to acknowledge the implications of such monopolies.⁷⁷

38. As regards sub c the Court examined a word the signification of which is, according to the Office, easily comprehensible for those who speak – or for that matter understand – Catalan, especially in such regions of the Spanish territory where said language is used on a frequent basis. This is the case in Catalonia, Balearic Isles and the Valencian region. The applicant however argued that even though the etymologic significance of ‘espetec’ may be descriptive, this word also contains four other meanings on the one hand and ‘espetec’ does not appear as a synonym for ‘fuet’ in the dictionary.⁷⁸ If it had not been for the company Casa Tarradellas

⁷⁵ GC (8th Chamber) 13th June 2012, *Organismos Kypriakis Galaktokomikis Viomichanias/OHIM – Garmo*, T-534/10 (‘Hellim’), paragraphs 10 and 36.

⁷⁶ R 312/2010-2 (‘Espetec’), OHIM Boards of Appeal, *Yearly Overview, Decisions of the Boards of Appeal 2010*, nr 7.3.2, available online.

⁷⁷ GC (7th Chamber) 13th September 2012, *Sogepi Consulting y Publicidad/OHIM*, T-72/11 (‘Espetec’).

⁷⁸ The applicant bases his argument on the online dictionary of a research centre.

recycling the term ‘espetec’ in order to bring its own ‘fuet’ meat onto the market, the word would have been forgotten by the Community as merely being a part of the ancient Catalan language.⁷⁹ Moreover, since the Office only recognizes 23 official EU languages in which Catalan is not included, the OHIM erred in refusing registration. The Court refutes said argument stating that ‘a part of the Community’ as referred to by article 7 CTMR may constitute a single Member State.⁸⁰ However that does not preclude that the relevant territory might also be a region smaller than the contours of a Member State. *Ratio legis* was to prevent descriptive character in a part of the Union, whether a part of one or several Member States. As such, the scope of application of said article should not be restricted in relation to the official languages of either a Member State and/or the entire EU.⁸¹

39. In this context it is worth mentioning that some official EU languages are less widely spread than Catalan, which is spoken by more than ten million people.⁸² Based on this factual statement, one could argue whether Catalan is indeed a minority language or rather just being kept one. On the one hand the official character of a language no longer seems to be the decisive criterion for descriptiveness. On the other hand we still make the distinction between ‘major’ and ‘minority’ languages. The first group refers to languages that are not only official throughout the EU, but are also spoken and understood by many people other than natives. The latter refers to those languages, which are not officially acknowledged in the EU, but often spoken by more people than some official languages. *Quid?*⁸³

b) Turkish

40. Although Turkish is still considered a non-indigenous languages with significant immigrant communities in *inter alia* Germany, Belgium, and the Netherlands⁸⁴, it should not

⁷⁹ However, the survey on which the applicant based his argument 37% of the questioned people associated ‘espetec’ spontaneously with the company Casa Tarradellas. A figure much higher than published in similar surveys carried out by the same company during the past ten years: EGC (7th Chamber) 13th September 2012, *Sogepi Consulting y Publicidad/OHIM*, T-72/11 (‘Espetec’), paragraph 77.

⁸⁰ ECJ 22nd June 2006, *August Storck/OHIM*, C-25/05 P (candy shape), paragraph 83.

⁸¹ GC (7th Chamber) 13th September 2012, *Sogepi Consulting y Publicidad/OHIM*, T-72/11 (‘Espetec’), paragraphs 35-36.

⁸² With regard to the amount of speakers Catalan is the 13th language of the European community. For a complete in-depth overview of Europe’s mosaic of languages, please consult www.ieg-ego.eu. Mr Harald Haarmann sharply analyses both history and developments of the linguistic richness throughout Europe.

⁸³ Cfr Paragraph 42.

⁸⁴ For the sake of accuracy, Turkish-speaking minorities exist in countries that formerly (in whole or partly) belonged to the Ottoman Empire, such as Bulgaria, Cyprus, Greece, the Republic of Macedonia, Romania, and Serbia. More than two million Turkish speakers live in Germany; and there are significant Turkish-speaking communities in the United States, France, The Netherlands, Austria, Belgium, Switzerland, and the United Kingdom: R. CREECH, *Law and Language in the European Union: the Paradox of a Babel United in Diversity*, European Law Publishing, 2005, 50 and R.G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 582.

be neglected either. Whereas the word mark “Gazoz” – Turkish for sparkling mineral water – had been registered as a Community mark⁸⁵, infringement actions against the use of the sign on water bottles distributed in Turkish grocery shops in Germany were dismissed on grounds of descriptive character.⁸⁶

41. When the General Court had to decide whether “Hellim” as a trade mark for milk products caused a likelihood of confusion with the earlier word mark “Halloumi” for cheese, it concluded there is definitely a conceptual similarity. In a country such as Cyprus with both Greek and Turkish as official idioms, the average consumer understands that ‘hellim’ is the Turkish translation of the Greek word ‘halloumi’ and that both words therefore refer to the same Cypriot specialty cheese.⁸⁷ Given the descriptive character of both words the mere conceptual similarity however is not sufficient to give rise to a likelihood of confusion.

§2 The new criterion: understanding of the relevant public

42. As shown by the Catalan and Turkish cases – and as may seem logic – the Office more and more leans towards the new criterion of understanding of the relevant public in the assessment of descriptiveness, rather than whether it concerns an official language.⁸⁸ The reason behind it is that we should not make it a political issue by merely looking at the twenty-three initial European languages and therefore excluding all others.⁸⁹ However, with this development also certain implications come along. In other words, if the official character is no longer the decisive criterion, then where should draw the line between major and minor languages?⁹⁰ After all, many so-called minority languages are often spoken by many more people than some of the EU’s officially acknowledged operative languages. In the long run,

⁸⁵ Class 32 Nice Agreement.

⁸⁶ German Supreme Court, Case I ZR 23/02.

⁸⁷ GC (8th Chamber) 13th June 2012, *Organismos Kypriakis Galaktokomikis Viomichanias/OHIM – Garmo*, T-534/10 (‘Hellim’), paragraphs 41-42. In the same direction: EGC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraph 51. The applicant explained that the northern area of Cyprus is occupied by Turkey, that therefore the whole of that territory is part of the EU. Greek and Turkish speaking communities are even less isolated from one another as the demarcation zone is crossed by millions of Greek and Turkish Cypriots. As a consequence, Cypriots know that the terms ‘halloumi’ and ‘hellim’ designate one and the same product, namely the national cheese of Cyprus: GC (8th Chamber) 13th June 2012, *Organismos Kypriakis Galaktokomikis Viomichanias/OHIM – Garmo*, T-534/10 (‘Hellim’), paragraph 60.

⁸⁸ This has been explicitly expressed by Mr Theophile Margellos during the Research Sessions at the OHIM 6-7th May 2013.

⁸⁹ As made clear by Mr Gregor Schneider during the Research Sessions at the OHIM 6-7th May 2013.

⁹⁰ This question has already been raised in paragraph 39 and will be set out extensively in *infra* c) Revision of minority languages.

this may lead to the irrelevance of Europe's initial languages' official character for it has already led to a complete new interpretation of the relevant territory.

a) Definition of the relevant public

43. Whereas the gateway to registration normally entails the Community as a whole, an absolute ground of refusal relating to the semantic meaning of a word will often – out of necessity – have to be limited linguistically and/or geographically as well. In that regard, 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*'.⁹¹ In other words, it might not always be satisfactory to define the relevant public as 'the public at large' or 'medical professionals'. On the contrary, the relevant public may rather need to be defined as 'the English-speaking public at large', or 'medical professionals in Member States x, y and z'.

44. The Royal KPN of the Netherlands⁹² wanted a Benelux registration for the mark "Postkantoor" for *inter alia* paper, advertisement and telecommunication.⁹³ Considered to be descriptive for the goods and services concerned, registration was refused. KPN went to court, which led to a prejudicial question to the European Court of Justice.⁹⁴ Two issues were to be investigated, namely whether the descriptive character of a sign for certain goods or services necessarily implies descriptiveness for other goods and services registration of which has been applied for as well and whether – in case the answer to that question would be negative – regarding the assessment of distinctive character for those goods and services for which it is not descriptive, it should be taken into account that the relevant public possibly does see the mark as descriptive.⁹⁵

45. With regard to the first question, the Court states that the refusal grounds of article 7, §1 CTMR are independent of one another and therefore require an independent investigation. As a result, the fact that one refusal ground does not apply in a certain case, does not exclude the

⁹¹ OHIM Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part B – Examination, most recently revised on 15th September 2010, paragraph 1.3, p3.

⁹² Koninklijke KPN Nederland NV, hereafter 'KPN'.

⁹³ Classes 16, 35-39, 41 and 42 of the Nice Arrangement.

⁹⁴ ECJ 12th February 2004, *Koninklijke KPN Nederland/Benelux-Merkenbureau*, C-363/99, ECR 2004, I-1619, ('Postkantoor').

⁹⁵ ECJ 12th February 2004, *Koninklijke KPN Nederland/Benelux-Merkenbureau*, C-363/99, ECR 2004, I-1619, ('Postkantoor'), paragraphs 18 and 62.

applicability of another refusal ground. Therefore, and in spite of the fact that distinctiveness should always be assessed in relation to the goods and services for which registration has been sought, the competent authority can't conclude to a mark's distinctive character for certain goods or services, purely based upon the fact it does not describe those goods or services.⁹⁶ For each and every of the goods and services concerned an authority may come to differing conclusions.

46. As to the second question, it should be pointed out that distinctive character should always be assessed in relation to the goods and services for which registration has been sought on the one hand and the perception of the relevant public on the other hand.⁹⁷ In that aspect it is irrelevant whether the sign at issue – in the eyes of the normally informed, average consumer of other goods and services who is prudent and cautious – is perceived as descriptive for other goods and services. Descriptiveness of some goods and services, does therefore not stand in the way of that sign's distinctive character for the goods and services at stake.⁹⁸

47. The relevant public cannot always easily be determined, especially when a product passes several stages before it reaches the consumer. The *Bostongurka* case provides more insight.⁹⁹ The Swedish company *Björnekulla* brought proceedings against *Procordia* stating their trademark had become a generic name for chopped pickled gherkins, based on two market researches carried out by *Björnekulla*. Opponent *Procordia* counter argued with another market survey containing questionnaires of operators in the grocery and mass catering services. The essential question here is whether the relevant class of persons comprises solely consumers, operators dealing with the product commercially or consumers which may – depending on the particular situation – also include specific intermediaries? Hereby it is very important to interpret and apply Community provisions uniformly in the light of the versions existing in the remaining Community languages.¹⁰⁰ The vast majority of the other versions tend to opt for the broadest interpretation possible, namely the inclusion of not only

⁹⁶ ECJ 12th February 2004, *Koninklijke KPN Nederland/Benelux-Merkenbureau*, C-363/99, ECR 2004, I-1619, ('Postkantoor'), paragraphs 70 and 74.

⁹⁷ Again, this will be the normally informed, average consumer who is prudent and cautious.

⁹⁸ ECJ 12th February 2004, *Koninklijke KPN Nederland/Benelux-Merkenbureau*, C-363/99, ECR 2004, I-1619, ('Postkantoor'), paragraph 79.

⁹⁹ ECJ (6th Chamber) 29th April 2004, *Björnekulla Fruktindustrier AB/Procordia Food AB*, C-371/02, ECR 2004, I-5811-5821 ('Bostongurka').

¹⁰⁰ At stake is the correct interpretation of article 12, §2, a First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ 1989 L 40, 1.

consumers and end users, but also operators distributing the product.¹⁰¹ It is true that from a general viewpoint the perception of consumers or end users will be the most decisive one. After all, the trademark's function to indicate the product's origin might influence the way they behave on the market.¹⁰² However, the impact of intermediaries to purchase the product at issue should not be underestimated either. In other words, whenever intermediaries are involved in the distribution process and “*depending on the features of the market concerned, all those in the trade who deal with that product commercially*”¹⁰³ should be comprised in the class of relevant people when determining whether the trademark has become the common name in that specific sector.

b) Multilingualism: the perception of the relevant public

48. On the one hand of course, examining word marks only from the perspective of consumers that are native speakers (or official language of the country for that matter) surely would increase legal certainty. This could come in handy for applicants of Community trademarks. After all, the more languages and linguistic notions are spread within the EU, the lesser the potential of registrability if a growing amount of non-native speakers are being added to the equation. It should be noted however that such a system cannot be allowed to affect the unitary character of territoriality in spite of the clear partition of multilingual jurisdictions throughout Europe.¹⁰⁴

49. On the other hand, assessing word marks merely from the perspective of native speakers does not take into consideration the current developments of the EU market and demonstrates a certain lack of dynamics. Indeed, the internationalization of products and markets are indisputable facts, automatically implying that consumers will be confronted with marks in foreign languages, regardless of what their level of understanding of those languages is. Even more so in a context where speakers of diverse official languages share a common – European

¹⁰¹ Consideration of the different language versions of Article 12(2)(a) of the Directive shows that the expressions used in the English and Finnish versions ('in the trade' and 'elinkeinoiminnassa') refer to trade circles alone, while those used in the Spanish, Danish, German, Greek, French, Italian, Dutch, Portuguese and Swedish versions ('en el comercio', 'inden for handelen', 'im geschäftlichen Verkehr', 'συνήθης εμπορική ονομασία', 'dans le commerce', 'la generica denominazione commerciale', 'in de handel', 'no comércio' and 'i handeln') refer both to consumers and end users as well as to the operators who distribute the product.

¹⁰² ECJ (6th Chamber) 29th April 2004, *Björnekulla Fruktindustrier AB/Procordia Food AB*, C-371/02, ECR 2004, I-5811-5821 ('Bostongurka'), paragraph 23.

¹⁰³ ECJ (6th Chamber) 29th April 2004, *Björnekulla Fruktindustrier AB/Procordia Food AB*, C-371/02, ECR 2004, I-5811-5821 ('Bostongurka'), paragraph 26.

¹⁰⁴ J. PHILIPS, *Trade marks at the limit*, Cheltenham, Edward Elgar Publishing Limited, 2006, 224.

– public space, there is a huge need to revise our understanding of those languages bound to specific territories and defined as either official, state, regional, majority or minority language. The mounting mobility of European citizens has made the European Commission emphasize even more on promoting multilingualism. In other words, apart from their native idiom, citizens across Europe now generally also master at least one vehicular language. Whenever travelling abroad, speakers of any European language find themselves almost always in a minority like situation. Hence, it is crucial we try to integrate the European public in an advanced, functional balance.¹⁰⁵

50. Even though thus far no application has been denied registration of a Community word mark on the basis of descriptiveness in a non-native speaking country alone, the weight of their share is on the increase. Word marks from broadly understood and spoken languages are more likely to be examined from the perspective of non-native speakers. Foreign terms should be analyzed in light of the understanding the relevant consumer has of (one of) the language(s) in which the mark is written.

51. However, the acceptance of a new criterion does not imply that at least all official languages are still on the same level. Not always will the descriptive character in German or Dutch of a word mark in respectively one of either languages be taken into account. When the Heidelberger MLP Finanzdienstleistungen AG tried to register “BestPartner” as a word mark for insurances and certain internet services¹⁰⁶, this was said to be a frequently used descriptive slogan without any distinctive character in the English speaking part of the European Union¹⁰⁷, as prohibited by article 7, §1, b CTMR. In the first place ‘best’ and ‘partner’ are English words, however, they also appear in the German and Dutch language. It is true that lack of distinctiveness in a part of the EU suffices as refusal ground for registration in the whole of the EU. Descriptiveness in the English speaking part would therefore be sufficient, without further effect for possible descriptive character in other parts. Remarkable in this case however is that despite the words ‘best’ and ‘partner’ existing in Germany and the applicant being German, English seems to prevail for the relevant public has been limited to those

¹⁰⁵ A similar reasoning can be found with Dr Michael Hornsby: M. HORNSBY and T. AGARIN, “The end of minority languages? Europe’s regional languages in perspective” in *JEMIE* 2012, (88) 88-89.

¹⁰⁶ GC (2nd Chamber) 8th July 2004, *MLP Finanzdienstleistungen/OHIM*, T-270/02 (‘bestpartner’).

¹⁰⁷ The English speaking part of the EU is here to be understood as the UK, Ireland. Malta isn’t included in the list, despite its official language English. This follows implicitly from EGC (2nd Chamber) 8th July 2004, *MLP Finanzdienstleistungen/OHIM*, T-270/02 (‘bestpartner’), paragraph 21.

consumers who speak English in the sense that it is their native language.¹⁰⁸ Neither was taken into account – regardless of the language – the fact that ‘bestpartner’ serves as an indication that a partnership with the company in question might be one of high standards, rather than being descriptive of the goods and services provided.¹⁰⁹

52. There are plenty proverbial fish in the sea. Although it would take wine traders to exactly understand descriptions concerning French wine, the average wine consumer would know that ‘Bourgogne’ is the French word for the Burgundy region. The same reasoning goes for the word ‘Toscana’, which the general public can be assumed to know it refers to Tuscany. As a result, names like that are not suited to be registered as a mark for wine and olive oil, respectively. Non-English words having become generic cross-border are excluded as well. The German term “auto”¹¹⁰ for example will not be fit for registration when it comes to cars or their components, nor will the Italian word “panini” be for sandwiches.

53. Worth looking at in detail is the Ferrari case. Ferrari applied for registration of a figurative mark containing the word ‘perle’ for goods in classes in 3, 25 and 33 the Second Board of Appeal refused to accept registration for the goods of class 33, to know wines and sparkling wines.¹¹¹ According to the Board of Appeal the relevant public consisted of both merchants and wine consumers. Each of these categories – especially those for whom the native language is English or French – understands the concept of ‘vin perlé’ since the term appears frequently in those two languages’ dictionaries.¹¹² In the context of wine trading ‘perlé’ refers to light sparkling or bubbly wines which makes the mark applied for descriptive.¹¹³ The applicant argued that only the average end consumer who – according to the applicant that is – is not familiar with the term at stake should be considered to be the relevant public. This would then rule professionals out as part of the relevant public. This argument remains without any success. As the Office rightfully stated wine also implies a cultural aspect. A large part of the public consists of wine lovers that do have some knowledge based on exactly that passion they have in common. Those consumers with no oenological knowledge will turn

¹⁰⁸ In another case the General Court did look however at the average German consumer as being the relevant public for the English word ‘life’. Since he would not associate this word (or its German equivalent ‘Leben’) with the durability of telecommunications: GC (8th Chamber) 20th January 2010, *Nokia/OHIM – Medion*, T-460/07 (‘Life Blog’).

¹⁰⁹ GC (2nd Chamber) 8th July 2004, *MLP Finanzdienstleistungen/OHIM*, T-270/02 (‘bestpartner’), paragraph 23.

¹¹⁰ ‘Auto’ as such is not just a German word, but also a Dutch.

¹¹¹ R 1249/2010-2 (‘perle’), decision of 8th December 2010.

¹¹² The relevant territory is fixed to be France, Belgium, Luxemburg, the UK, Ireland and Malta: GC 1st February 2013, *Ferrari/OHIM*, T-104/11, (‘perle’), paragraph 39.

¹¹³ GC 1st February 2013, *Ferrari/OHIM*, T-104/11, (‘perle’).

to professionals for assistance. Given those facts, understanding of the concept is easily achieved.

54. Also de Cervantes' language provide us with some interesting cases. The Consejo Regulador de la Denominación de Origen Txakoli applied for a collective trademark "Txakoli", *inter alia* for goods such as IT networks, educational activities and technological services.¹¹⁴ The Office however refused to register since 'chacolí' in the Spanish language stands for a "light wine, slightly acidic, produced in the Basque Country, in Cantabria and in Chile".¹¹⁵ On these grounds the OHIM considered this word sign to be descriptive for the average Spanish consumer might think the goods and services provided are this specific type of wine¹¹⁶, denomination of which is prohibited by article 7, §1, k CTMR. Nonetheless, other traditional terms may very well be claimed as a trademark.¹¹⁷ In the present case parties failed to provide for indications of previous wines or geographical zones in the same situation comprising another traditional term that had been granted registration as trade mark. Therefore, such contention is ought to be irrelevant, given the fact that this so-called exclusivity is a mere consequence of the wine legislation. In another case 'La Española' was said to be descriptive for said term is widely used making its meaning familiar even to consumers in non-Spanish speaking countries.¹¹⁸ Consequently the word is descriptive suggesting a reference to the geographical origin of the goods, *in casu* edible oils. Moreover, the words are present in approximately a hundred marks throughout Spain¹¹⁹ and have become a general term in everyday language as well as a common reference in the food sector.¹²⁰

55. Sometimes the applicant may try to bend the meaning of a word sign to their advantage. The German company Present□Service Ullrich GmbH & Co. KG stated 'babilu' is the Akkadian variety of the Greek word 'Babylon', meaning 'gateway to God' and the imperative

¹¹⁴ GC (4th chamber) 17th May 2011, *Consejo Regulador de la Denominacion de Origen Txakoli de Alava and Others/OHIM*, T-341/09 ('Txakoli').

¹¹⁵ Diccionario de la lengua española (Dictionary of the Spanish language) of the Real Academia Española.

¹¹⁶ The Board of Appeal stated that the relevant public would perceive this word not as a mark but as the description of a specific type of wine: EGC (4th chamber) 17th May 2011, *Consejo Regulador de la Denominacion de Origen Txakoli de Alava and Others/OHIM*, T-341/09 ('Txakoli'), paragraph 22.

¹¹⁷ Article 23 Regulation 753/2002.

¹¹⁸ GC (1st Chamber) 12th September 2007, *Koipe/OHIM - Aceites del Sur*, T-363/04 ('La Española').

¹¹⁹ More than twelve of which can be found in class 12 of the Nice Agreement: GC (1st Chamber) 12th September 2007, *Koipe/OHIM - Aceites del Sur*, T-363/04 ('La Española'), paragraph 12.

¹²⁰ Contrary to what the Office holds in this case, in its decision of 22nd February 2000 it held that since the common element in the two marks was weakly distinctive, the consumer's attention would not be drawn by the expression 'la española', but by the figurative element of the mark applied for.

of ‘babili’, Esperanto for ‘to chat’.¹²¹ Akkadian is an extinct Semitic language once spoken in Mesopotamia and Esperanto has a limited amount of speakers in the EU. Only very few consumers of the relevant public in the Community would be able to understand the word in one of above mentioned meanings.

56. It has been said before¹²², single letters can be accepted as word marks, though this will not always be evident.¹²³ The application for registration of “α” for alcoholic beverages (wine and beer excluded) had been refused on all levels, for it was found confusing from the perception of the Greek consumer.¹²⁴ The Court of Justice however did not preclude its distinctive character *a priori*.¹²⁵ The fact that distinctiveness is more difficult to establish does not alter this, be it that the assessment is always to be done *in concreto*. The same goes for the registration of “Omega 3” for margarine, dried and cooked fruits and vegetables, meat and milk products in Spain.¹²⁶ This word element is not part of everyday language and the relevant public will, at the very most, be able to identify the word ‘omega’ as the last letter of the Greek alphabet. Only a selected specialist public however will draw a conceptual link between the word element ‘omega 3’ and the kind of polyunsaturated fatty acids of the same name known for its medicinal properties.¹²⁷

57. With regard to the registrability of such non-English words, the Intellectual Property Office in the UK issued an interesting document guiding applicants who can’t see the wood for the trees anymore.¹²⁸ The Notice mainly focuses on these words the registration of which most probably would be refused on grounds of descriptiveness and / or lack of distinctive character had they been applied for in their English equivalent. In line with the European Court of Justice’s case law a registration is thought more likely to be rejected when the relevant trade recognises the sign to be a description of characteristics of the goods or

¹²¹ GC (5th Chamber) 31st January 2013, *Present-Service Ullrich/OHIM - Punt Nou*, T-66/11 (‘babili’), paragraphs 68 and 71.

¹²² Cfr *supra* paragraph 9.

¹²³ Even figurative marks can contain single letters. In order for them to be pronounced – and as such play a role in the assessment of phonetical similarity – the figurative element should resemble a letter of the alphabet: EGC (5th Chamber) 31st January 2013, *KS Sports Europe/OHIM – Karhu Sports Ibérica*, T-54/12, (‘sport’), paragraphs 37-38 and 42.

¹²⁴ GC (6th Chamber) 29th April 2009, *BORCO-Marken-Import Matthiesen/OHIM*, T- 23/07, ECR II-861 (‘α’) and R 808/2006-4 (‘α’), decision of 30th November 2006.

¹²⁵ ECJ 9th September 2010, *OHIM/BORCO*, C-265/09.

¹²⁶ GC (5th Chamber) 18th October 2007, *Ekabe International/OHIM - Ebro Puleva*, T-28/05 (‘Omega 3’).

¹²⁷ GC (5th Chamber) 18th October 2007, *Ekabe International/OHIM - Ebro Puleva*, T-28/05 (‘Omega 3’), paragraphs 16 and 30.

¹²⁸ Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, www.ipo.gov.uk. Hereafter referred to as The Notice.

services.¹²⁹ *A contrario*, neither descriptiveness nor non-distinctiveness in another language is of such a nature to disable registration if the relevant public does not understand it.¹³⁰ Even if the meaning of the word would be apparent to the relevant consumer, in some sectors the word still is registrable.¹³¹ In that regard the name “Prêt à Manger” for catering services is not likely to be regarded by the relevant public as descriptive, even if they know what the French word entails. However, the situation is more complex when the non-English descriptive word closely resembles its English equivalent.¹³² In that sense the Italian “Caffè Fresco” ought to be refused as a trade mark for coffee since any consumer with a basic notion of English would understand these words to mean fresh coffee.

58. The conceptual similarity of marks seems closely related to linguistic issues. When Dynamiki Zoi AE applied for the registration of “Fitcoin” as a trade mark, Coin Spa opposed upon their earlier trade mark “Coin”.¹³³ The Board of Appeal considered the word ‘coin’ to be understood by both an English speaking public as well as by French speaking consumers, be it as two distinct concepts. Whereas the English-speaking consumer tends to understand it as some sort of round metal disc generally used as money, French-speaking consumers think of it as a place or corner. In combination with the word ‘fit’ – by all consumers perceived as an English word, in the sense of being in good shape or health¹³⁴ – some relevant consumers might see this as a juxtaposition of both words whilst others will perceive the mark as a word either consisting of the prefix ‘fit’ or the suffix ‘coin’.¹³⁵ A third category of consumers might even consider it an invented term lacking any meaning whatsoever. An interesting remark however can be made with regard to the pronunciation. During the investigation of the likelihood of confusion it hadn’t been mentioned, but since English and French speaking consumers pronounce ‘coin’ differently, it would have been unlikely to conclude to phonetic similarity.¹³⁶

¹²⁹ Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, paragraph 27, 3rd part, www.ipo.gov.uk.

¹³⁰ ECJ 9th March 2006, *Matratzen Concord AG v Hukla Germany SA*, C-421/04, ECR 2006, I-02303, (‘Matratzen’). For a good understanding, the relevant public *in casu* are those in the UK specialized in trading in mattresses: Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, paragraph 27, 4th part, www.ipo.gov.uk.

¹³¹ These sectors are travel, transport, catering and language services.

¹³² Practice Amendment Notice PAN 12/06, issued 13th June 2006 as to replace paragraphs 27 to 27.4 of the Work Manual, paragraph 27,3 www.ipo.gov.uk.

¹³³ GC (7th Chamber) 1st February 2013, *Coin/OHIM – Dynamiki Zoi*, T-272/11 (‘fitcoin’).

¹³⁴ GC (7th Chamber) 1st February 2013, *Coin/OHIM – Dynamiki Zoi*, T-272/11, paragraphs 12 and 28 (‘fitcoin’).

¹³⁵ Regardless of this interpretation of the word ‘fit’, the Board thought this element could not be seen as descriptive by the relevant consumers understanding this meaning, when used in combination with ‘coin’ for any goods other than games and playthings; gymnastic and sporting articles (except clothing); playing cards (class 28).

¹³⁶ The Board of Appeal considered that the degree of phonetic similarity was of limited importance, be it “*due to the way in which the goods at issue were marketed and that the degree of attentiveness of the relevant public was high for the services*”

59. That language indeed plays a role with regard to the conceptual similarity between signs had already been established in the *Scandic Distilleries* case.¹³⁷ This Romanian brewery had applied for a figurative trade mark containing the word ‘Bürger’. The German brewer August Röhm & Söhne KG was not pleased with the so-called infringement to their earlier word mark “Bürgerbräu”. On the one hand there was no doubt ‘Bürger’ being the dominant element both signs have in common.¹³⁸ Although the non-German speaking part of the EU public does not understand its concept, German speakers will know that the exact meaning referred to is citizen. On the other hand the second half of the contested mark – ‘bräu’, in the sense of brewing beer – is perceived as descriptive for the goods concerned by all average consumers.¹³⁹ Consequently, the general German-speaking consumer is more likely to pay particular attention to ‘Bürger’.¹⁴⁰ In spite of the EU as a whole being the relevant territory, it was therefore considered sufficient to downsize to the EU’s German speaking part.

60. The opposite, however, happens too. When *Duschprodukt Skandinavien* applied for “Duschy”, its competitor *Duscholux Ibérica* opposed on the basis of their earlier mark “Duscho harmony”.¹⁴¹ Given the fact that ‘dusch’ comes from the German word for shower ‘Dusche’, every sign containing the word element ‘dusch’ will be devoid of distinctive character, even more since other European languages provide for equivalents.¹⁴² As a consequence, these and related terms will definitely be understood by consumers throughout

in Classes 35 and 36 and for the education services in Class 41”: EGC (7th Chamber) 1st February 2013, *Coin/OHIM – Dynamiki Zoi*, T-272/11, paragraph 12 (‘fitcoin’).

¹³⁷ GC 18th September 2012, *Scandic Distilleries/OHIM – Bürgerbräu, Röhm und Söhne*, T-460/11 (‘Bürger’).

¹³⁸ For marks composed of both word elements as well as figurative elements, the former are - generally - more distinctive than the latter, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element of the mark: EGC 31st January 2012, *Cervecería Modelo/OHIM – Plataforma Continental*, T-205/10, not published in the *ECR* (‘La Victoria De Mexico’), paragraph 38. In the same reasoning consumers pay more attention to the first element of word marks: Joined Cases EGC (4th Chamber) 17th March 2004, *El Corte Inglés/OHIM – González Cabello and Iberia Líneas Aéreas de España* (‘Mundicor’), T-183/02 and T-184/02, *ECR* II-965, paragraph 81.

¹³⁹ GC 18th September 2012, *Scandic Distilleries/OHIM – Bürgerbräu, Röhm und Söhne*, T-460/11, paragraph 53 (‘Bürger’).

¹⁴⁰ For sake of accuracy it should be pointed out that the assessment of similarity can only be carried out solely on basis of the dominant element when all other components the mark consists of are negligible: EGC (5th Chamber) 31st January 2013, *KS Sports Europe/OHIM – Karhu Sports Ibérica*, T-54/12, (‘sport’), paragraph 23 and ECJ 20th September 2007, *Nestlé/OHIM*, C-193/06 P, not published in the *ECR*, paragraph 42.

¹⁴¹ GC (5th Chamber) 12th September 2012, *Duscholux Ibérica/OHIM – Duschprodukt Skandinavien AB*, T-295/11 (‘duschy’).

¹⁴² In French and Dutch (‘douche’); Italian (‘doccia’); Spanish (‘ducha’); and Portuguese (‘duche’): GC (5th Chamber) 12th September 2012, *Duscholux Ibérica/OHIM – Duschprodukt Skandinavien AB*, T-295/11 (‘duschy’), paragraph 26 *juncto* paragraph 75.

most of the Member States, which then leads to a relevant public consisting of Swedish, German, Spanish, Portuguese, Italian and French consumers.¹⁴³

61. In other cases, the outcome differs once again. The registration of the word mark “Hai” – both German and Finnish for ‘shark’ – in Austria and the Community leads to a relevant territory consisting of the whole of the EU in which distinctive character will be assessed.¹⁴⁴ Logical as this may seem, it does result in some complications. Firstly, though there may be deviations when written, pure phonetically, the term ‘hai’ in this meaning will be pronounced in the exact same way in Danish, Dutch, Swedish, on top of the understanding of this term in certain Italian and French peripheral areas.¹⁴⁵ Secondly, there are phonetic similarities with the English word ‘high’.¹⁴⁶ Thirdly, in the Nordic regions people have knowledge of English and German, which implies a conceptual understanding of both ‘hai’ as well as ‘high’.¹⁴⁷ As a result, neither German nor Dutch speaking consumers will immediately and without further thought interpret the word sign “Hai” as associated with sharks.¹⁴⁸ Focus should therefore lie on consumers from all over the European Union, but special attention should go to Austria and other German speaking Member States, such as Germany and Belgium.¹⁴⁹

62. Nevertheless, a trademark system, which enables the inclusion of the perception of such consumers, would thus reflect the EU with its twenty-three official languages, plus the numerous regional and minority languages in a more genuine and holistic way. Although minority languages’ status does not yet allow them to be taken into account when assessing a word mark’s distinctive character, they do play a role during cancellation proceedings if a jurisdiction discovers descriptiveness in one minority language and considers that sufficient.¹⁵⁰ From a comparative viewpoint it may be interesting to draw a connection with a

¹⁴³ GC (5th Chamber) 12th September 2012, *Duscholux Ibérica/OHIM – Duschprodukter Skandinavien AB*, T-295/11, paragraph 74 (‘duschy’).

¹⁴⁴ GC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’).

¹⁴⁵ From a conceptual point of view, it is clear that the English term ‘shark’ will be translated by ‘hai’ in German and Finnish, by ‘haai’ in Dutch and by ‘haj’ in Danish and Swedish. Europeans with one of the previous languages as their native language will therefore be likely to understand the same under ‘shark’ and ‘hai’: EGC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraphs 26 and 51. Such conceptual similarity depends on preliminary translation though: EGC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraphs 51 and 53.

¹⁴⁶ This goes especially for the relevant public that consists of young people who generally have sufficient knowledge of the English language. They understand ‘shark’ to be something different than ‘high’: EGC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraph 51.

¹⁴⁷ GC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraph 52.

¹⁴⁸ GC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraph 33.

¹⁴⁹ GC (4th Chamber) 9th March 2005, *Osotspa/OHIM - Distribution & Marketing*, T-33/03, (‘Hai’), paragraph 38.

¹⁵⁰ J. PHILIPS, *Trade marks at the limit*, Cheltenham, Edward Elgar Publishing Limited, 2006, 224.

Swiss case in which the Federal Supreme Court decided that the name of a Turkish brandy “Yeni Raki” is descriptive from the perception of Turkish inhabitants, which were to be considered the relevant public. Accordingly, the term was precluded from registration.¹⁵¹

63. Ultimately, with the implementation of this new criterion also come certain side effects the consequences of which may not always be clear-cut *ab initio*. When the German company PAKI Logistics GmbH applied for registration of “PAKI” as a Community trademark for transport palettes surely they wouldn’t have suspected the Indian-speaking minority in the UK would take such word as offensive.¹⁵² ‘Paki’, short for Pakistan, has all sorts of racist inspired connotations and has been used to degrade people from Asian descent.¹⁵³ Even though *in casu* there was not even an issue whether the term could be understood – and thus interpreted as descriptive for the goods concerned – it did cause quite some reaction, purely based in the fact it is discriminating towards a specific minority group as is forbidden by article 7, §1, f CTMR. This is by far not a plea to limit, let alone restrict, the extent to which we should accept minority languages. On the contrary, integrating minority languages into the assessment of distinctiveness would reflect our Europe of today much better. Nonetheless, in doing so, we must not forget just how far the introduction of minority languages could lead us. It does not simply end when we answer the question whether minority groups perceive a word mark as descriptive for the goods or services concerned, but can go as far as the rejection of a Community mark based on completely different grounds, such as racist terms. Additionally, the caveat is to be cautious anyhow. After all, all idioms deviating from the official state language are minority languages and should then be taken into consideration. In other words, by opening up the door towards minority languages, we just might not be able to keep control of the continuous inflow, for language is vivid and changes constantly.

c) Revision of minority languages

64. Whereas in the nineteenth century use of regional languages both in public and in private was actively discouraged, many regions throughout Europe where minority languages are being spoken currently experience some serious revitalization efforts. Wales in the UK; Catalonia, Galicia and the Basque Country in Spain; Friesland in the Netherlands, are but a few of many examples. Most of these regions once used to be entities independent of the

¹⁵¹ Swiss Federal Supreme Court decision ATF 120 II 144 (‘Yeni Raki’) and J. PHILIPS, *Trade marks at the limit*, Cheltenham, Edward Elgar Publishing Limited, 2006, 224-225.

¹⁵² GC (3rd Chamber) 5th October 2011, *PAKI Logistics/OHIM*, T-526/09 (‘PAKI’).

¹⁵³ Unlike abbreviations like ‘Brit’ and ‘Aussie’ which do not carry those negative connotations with them.

nation-state which they now find themselves part of.¹⁵⁴

65. Given the fact that some so-called minority languages are spoken by more people than several of the EU's official languages and therefore outnumbering them, how should we make the distinction? Put differently, it is a fine line between official 'small' languages on the one hand and non-official 'big' languages. Let's look at the example of Estonian and Latvian, two Baltic languages. Neither the 0,8 million Estonian speakers, nor the 1,3 million Latvian speakers will be hindered any more than the 15 million people that speak Hungarian or 5 million Finns when going abroad. Many monolingual national language speakers migrating towards another EU country are unlikely to benefit from the knowledge of their native language. The experience of Latvia and Estonia illustrates that while language promotion has fairly good chances of succeeding on the territory where its status is protected, protectionism can easily result in provincialization of the speakers of those languages in the context of an increasingly mobile and decisively multilingual Europe, unless it is coupled to proficiency in a vehicular language.

66. Moreover, small state languages (such as Estonian or Latvian) do *"have an increased likelihood of survival compared to their stateless cousins [i.e. minority languages], but it would be a great mistake to assume that the acquisition of official status by a small language means that a corner has been decisively turned"*.¹⁵⁵ Small state languages are subject to the exact same push and pull factors of globalization as small and stateless languages.

67. However, territorially defined languages haven't always been in a better position than those still lacking territorial reference today, such as Romani in Hungary.¹⁵⁶ Many only gained this status thanks to neighbour states' languages becoming official EU languages. These language varieties included minority languages in any given territory and small majority languages that were territorially and demographically restricted in the past. A common characteristic of languages enjoying official EU status, at all times seems to have been that they are framed in instrumental terms as to facilitate all communication between the EU and the Member State on the one hand, between the nation-state and minority

¹⁵⁴ For an extensive overview on Europe's recent evolutions regarding minority languages: M. HORNSBY and T. AGARIN, "The end of minority languages? Europe's regional languages in perspective" in *JEMIE* 2012, 88-116.

¹⁵⁵ M. HANDLER, "The distinctive problem of European trade mark law", 27(9) *European Intellectual Property Review* 2005, (306) 307.

¹⁵⁶ As said before in footnote 59, Romani is a non-territorial language and should therefore not be confused with minority languages.

communities on the other hand.

68. Due to political redress many minority languages previously kept away from the public sphere are now restored and being granted an official status, as is the case for Breton, Catalanian and Welsh. Ironically, for these languages the number of actual speakers seems to be on the decrease.¹⁵⁷ Certain countries provide legal support for some minorities, but not for others. The United Kingdom does recognize Irish, Scottish Gaelic and Welsh. Cornish, Manx, Channel Island French and Scots however receive less support, making them much more dependent of bottom-up initiatives.

69. Despite the decrease of amount of native speakers and Gaelic still being considered somewhat a minority language, it is acknowledged as one of Europe's official languages and therefore needs to be taken into account when assessing any word mark's distinctive character. What is the moving spirit why some minority languages get (all) the benefits while others do not even count? The underlying reason can be found in the historical position occupied by certain languages in the collective psyche of a nation or regional group emerging into hierarchies that often go unquestioned. In Wales, as in many other areas where a minority language is being revitalized, the territorial principle has taken precedence over the identity principle. Over the past few decades the Principality of Wales has benefitted from a number of initiatives, which have only improved the status of the Welsh language.¹⁵⁸

70. The competing language ideologies of minorities where identity is juxtaposed against arguments of territoriality, as seen in France and Norway, could lead to what experts call "schizoglossia", a personality split which leaves many people both linguistically divided as well as uncertain.¹⁵⁹ By attempting to compete on the same terms as those espoused by the state, and to insist on the same services in local languages as provided in the official national language¹⁶⁰, linguistic minorities play the conflict "game" by their adversary's rules.¹⁶¹ Insisting on the use of Breton in exactly the same way French is currently used in Brittany

¹⁵⁷ J. PHILLIPS, *Trade Mark Law – A Practical Anatomy*, Oxford, Oxford University Press 2003, 445.

¹⁵⁸ Welsh has been acknowledged as a core curriculum subject in the 1988 Education Act, stimulating loads of secondary schools introducing Welsh as a teaching tool. The start of an all-Welsh television status since 1982 has lead to employment possibilities. The Welsh Language Act of 1993 has secured a higher status for the language in a number of areas by requiring public bodies to treat English and Welsh equally.

¹⁵⁹ CH. GIELEN and V. VON BOMHARD (eds), *Concise European Trade Mark and Design Law*, Wolters Kluwer, Alphen aan den Rijn, 2011, 375.

¹⁶⁰ E.g. education, local government and media.

¹⁶¹ CH. GIELEN and V. VON BOMHARD (eds), *Concise European Trade Mark and Design Law*, Wolters Kluwer, Alphen aan den Rijn, 2011, 384.

today merely reinforces, albeit ironically, the idea that Breton is less useful and less prestigious than French.¹⁶² Brittany provides an example of “*unanticipated results in language management*”.¹⁶³ Attempts at reviving the language have produced a hybrid variety, which has been dubbed ‘neo-Breton’¹⁶⁴, and stands in marked contrast to the variety spoken by older, traditional speakers. While such hybridity has immediate and obvious advantages for language activists and others interested in the Breton language, it can and does alienate other sections of the Breton society. In other words, conceiving of Breton (or other) identities and language varieties as hybrids may obscure the distinctiveness of each specific hybrid phenomenon.¹⁶⁵

71. Revived languages are unlikely to have a single parent, which in the case of Breton means that the new form of the language (that is becoming increasingly popular) has both Breton and French as “parent languages”, in much the same way as revived Hebrew has Hebrew, Yiddish, Polish, Russian and other languages as parent languages.¹⁶⁶ The changing role of the language undergoing revitalization impacts the perceptions of revivalist speakers themselves and makes them doubt the authenticity of their language planning, without however hindering them from accepting such a hybridity as a necessary step to depart from idealistic perceptions of linguistic community and move towards a view of language as a functional tool of institutions. Yet of course many languages, *in casu* Celtic languages specifically, are not usually widely accepted as genuine, and if they are it is only grudgingly.

72. More productive would be greater metalinguistic awareness of the need for more realistic expectations of the end results of language planning. In other words, reviving a language implies the expectation to end up with a hybrid.¹⁶⁷ If expectations in the Breton speech community were to shift more in the direction of the acceptability of new, hybrid forms, then

¹⁶² R. G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 466.

¹⁶³ M. HANDLER, “The distinctive problem of European trade mark law”, 27(9) *European Intellectual Property Review* 2005, (306) 309.

¹⁶⁴ R. G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 467.

¹⁶⁵ CH. GIELEN and V. VON BOMHARD (eds), *Concise European Trade Mark and Design Law*, Wolters Kluwer, Alphen aan den Rijn, 2011, 401.

¹⁶⁶ R. CREECH, *Law and Language in the European Union: the Paradox of a Babel United in Diversity*, European Law Publishing, 2005, 36.

¹⁶⁷ R. CREECH, *Law and Language in the European Union: the Paradox of a Babel United in Diversity*, European Law Publishing, 2005, 36. Hybridity in language is symptomatic of the hybrid identities which are developing, due to increased social, regional and global migration and is not, in itself, a phenomenon which exists in isolation from other modern trends. The obstacles facing acceptance of such linguistic and identity hybridity is its largely modern nature. Whereas linguistic hybridity historically has been evident in many situations of language contact, for example, the Limburg Frankish dialect in the Netherlands, which displays French linguistic influence: R. G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 485.

intercommunal tensions would diminish at a moment in the history of the Breton language when it needs all the advantages it can muster. Modernization in its French form would have seen the demise of regional languages. Neo-Breton, similar to Welsh in the twenty-first century, is evolving and acquiring new functions with a certain “naturalness” to these changes, which will be hard to resist.¹⁶⁸

73. Language regulations have long encouraged citizens to shift linguistic loyalties away from the lesser-used varieties, towards official languages. No matter how powerful the argument, the earlier understanding of relations between linguistic, cultural and national communities needs to be reconsidered in the face of an increasingly multilingual European citizenry. Multilingual communities have long existed across Europe, but growing territorial mobility calls for a revision of individual states’ technocratic approach to linguistic loyalties and challenges these states’ understanding of citizenry as being monolingual.

74. The status of Latvian and Estonian as official languages of the EU highlights important issues about the lesser-used languages in the region and beyond. Firstly, the experiences with promotion of state languages at the expense of more widely used “foreign” language in the two countries suggest more than ever that the future of multilingual Europe is heavily dependent on the equality of opportunities available to speakers of different languages, whether these are recognized as official or not. Secondly, the cost of implementing monolingual policies in those two states has been extremely high, especially with regard to the shifting the patterns of multilingualism.¹⁶⁹ The cost of acquiring multilingual skills in the course of reorientation from Russian- to English-language learning, is likely to boost levels of individual multilingualism in the short run, but prove a strain for native speakers of state languages in the long run. As many linguistic communities that speak official EU languages are downsizing in numbers, the costs of language support will need to be readjusted to the realities of an increasingly multilingual Europe.

75. Unlike the case of Welsh and Breton, policies regulating the use of Latvian and Estonian indicate a preference for the localization approach, which are unlikely to remain sustainable even in the short run. As with many other states that have promoted monolingual policies over

¹⁶⁸ J. PHILLIPS., *Trade Mark Law – A Practical Anatomy*, Oxford, Oxford University Press 2003, 456.

¹⁶⁹ Also called the ‘Zero Sum Game’: M. HANDLER, “The distinctive problem of European trade mark law”, 27(9) *European Intellectual Property Review* 2005, (306) 310.

the past decades, Estonia and Latvia have been fairly successful in ensuring advantages for native speakers of their state language in some public domains. However, as in the UK, monolingual speakers of the state language are usually outpaced by speakers of minority languages in areas where minority languages are on an equal footing with the national language. Naturally, analyses of language use among the minority point to the positive impact that an external state and its institutions can have on the maintenance of language skills among minorities, such as Hungarian-speakers outside Hungary, or even support from regionally devolved governments, as in Wales or the Basque Country. However, most of Europe's regional languages lack an institutional backdrop, which leaves speakers of most regional languages entirely dependent on societal networks that they must activate and maintain through their own, scarce resources.¹⁷⁰

76. Activists promoting the use of minority, regional and/or non-standard language variations have been vocally pointing out the inherent disadvantages for speakers of non-state languages in accessing and participating in political decision-making across Europe. This draws particular attention to the limits imposed on minority language use in the public sphere across European states, which *de facto* favours state languages at the expense of minority languages. In doing so however, both the EU and nation-states alike have already contributed to further marginalization of linguistic communities speaking non-state languages and have given space to their militant, identity-driven claims. Moreover, the anticipated enlargements will keep adding languages to the list of those that are officially recognized.

77. What do these indications tell us about the long-term future of languages tied to and supported by a diverse set of European, national and regional policies? Most strikingly, the policies supporting language territorialization can have a positive impact on language use, and ultimately on its survival.¹⁷¹ As hinted above, without the promotion of Estonian and Latvian as the sole state languages in their respective countries, no comparable results in language acquisition would have been achieved on the part of the Russian speakers over a relatively short period of time.¹⁷²

78. On the flip side however, state support for monolingual policies stands in sharp contrast to

¹⁷⁰ R. G. GORDON (ed), *Ethnologue: Languages of the World*, SIL International 2005, 544.

¹⁷¹ R. CREECH, *Law and Language in the European Union: the Paradox of a Babel United in Diversity*, European Law Publishing, 2005, 89.

¹⁷² J. PHILLIPS, *Trade Mark Law – A Practical Anatomy*, Oxford, Oxford University Press 2003, 645.

current European objectives earmarking the emergence of multilingual citizenry, befitting the European Commission's 'native plus two languages' strategy. Whereas Western European states encourage their citizens to acquire knowledge of further languages, the Baltic States not only reject recognition of the *de facto* minority language in their country, but suggest that Russian speakers opt for more widely used languages with a European appeal such as English, rather than the state languages that ultimately guarantee access to participation and resources in the respective nation-states. By doing so, Baltic language policy planners are perpetuating the same 'minoritization' outcomes that affected Welsh and Breton some centuries ago. This may appear particularly surprising given the fact that Russian features as the fifth most widely understood language across the EU, after English, German, French and Spanish.¹⁷³ However, the policies make perfect sense in the context of recent state and nation building exercises. Efforts by these states to promote monolingual practices in official languages have already resulted in an increasing standardization of the official variety at the expense of linguistic diversity and a partial loss of non-standard varieties in both states. The gradual decline of Southern Estonian Võru and Latgalian in Eastern Latvia are testament to just how difficult it has been for the Estonian and Latvian authorities to halt language shift in these areas.

79. Current linguistic policies of Estonia and Latvia should be read as efforts to protect the relatively small state languages from a real and powerful competitor, which to date is not even granted the status of a minority language. Being implemented at the expense of the Russian language, which is spoken by more than a third of the states' residents, results in decreasing levels of communication between the increasingly monolingual members of the titular ethnic group, local minorities, foreign nationals, and European visitors. One could further read the lack of political recognition of Russian in the region as undermining potential claims of Russian speakers for greater accommodation of their linguistic identities within the framework of the EU. Failure to sustain the level of competence in Russian among speakers of the state languages has inevitably led to the isolation of residents of the Baltic States vis-à-vis the locally numerical minority, marginalizing members of the minority.¹⁷⁴

80. Minority languages that have undergone successful revitalization over the past decades

¹⁷³ More than Italian, which is one of the Office's working languages: Eurobarometer, 2006, http://ec.europa.eu/languages/languages-of-europe/eurobarometer-survey_en.htm.

¹⁷⁴ M. HANDLER, "The distinctive problem of European trade mark law", 27(9) *European Intellectual Property Review* 2005, (306) 310.

are highly dependent on support from their ‘native’ territorial unit in the medium and long run. The successful titularization of Catalonia and the Basque Country have seen similar shifts in linguistic loyalties and the gradual reinterpretation of language policies away from identity-driven claims in favour of territorial arguments in support of the languages. Needless to say, while neither in the case of Welsh nor Breton are we likely to see the emergence of monolingual communities that are unable to use English or French, regionalization practices of language revitalization aim to increase the currency of the ‘minoritized’ majority language, with the consequences for both majority and minority languages that we notice in the Baltic States today.¹⁷⁵

81. It is in this context that we need to consider the loyalties of different linguistic communities and the opportunities they have to use ‘their’ language. While across the EU today, most members of minority linguistic communities, if proficient in one or several of the EU’s official languages, can enjoy definite extra-linguistic advantages over those who are able to use fewer languages in their everyday life. The situation today is that the speakers of Europe’s minority languages are *de facto* better equipped to guarantee the survival of their languages and their claims to linguistic identity if they avoid references to language territorialization at the European, national or regional levels.

§3 Official character as an indication

82. The choice for a new criterion is quite understandable, given the fact that the status of a language is not always clear-cut, as seen above. Two examples may clarify. Although German is one of Belgium’s three official languages, it is not understood – let alone spoken – by all its inhabitants. The contrary occurs too. We do not doubt Germans speak German, we rarely assume many Germans speak Danish or Sorbian and that these languages are allowed to be used in communication with authorities.¹⁷⁶

¹⁷⁵ More often than not, speakers of the state language can have much easier access to state services and are better positioned to use their ‘native’ linguistic skills to reach further than second- language speakers. On the other hand, however, speakers of state languages are disadvantaged vis-à-vis the speakers of the usually bi- or multilingual minority language speakers.

¹⁷⁶ For a good understanding: the Sorbian languages (Serbsce and Serbski) are two closely related languages spoken by the Sorbs, a slavic minority in the Lusatia region in Eastern Germany and classified under the West-Slavic branch of Indo-European languages. They are not to be confused with the Serbian language.

83. Nevertheless, using the official character of a language in relation to a specific state's number of citizens as some indication that the relevant public understands the language at stake could prove to be of great value. We could at least take into account this element, without giving it decisive weight. The cases concerning Catalan (official in Spain) and Turkish (official in Cyprus, yet not in Germany or Belgium) have clarified this. Particularly the 'Hellim' case shows that an official status implies habitants master the idiom in question. In the same reasoning the Max Planck Institute strongly advises to maintain the present distinction between official and non-official languages, regardless whether those languages are acknowledged throughout the entire country or merely in a region thereof.¹⁷⁷ However, their recent study acknowledges that "*it 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.*"¹⁷⁸

84. Some say that the EU 'discriminates' between EU and non-EU languages.¹⁷⁹ This would be 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, as well as for Russian in the Baltic countries. This seems not entirely true however. Even the Max Planck Institute states that other than the official languages should be allowed to prevent registration of a Community mark if the sign is descriptive or non-distinctive in that other language.¹⁸⁰ Up to this point it remains unsure whether the Commission will follow this recommendation. Thus far it seems to present the unitary character of the EU regime as an end rather than as a means to a well-functioning trademark system.

¹⁷⁷ MAX PLANCK INSTITUTE FOR INTELLECTUAL PROPERTY AND COMPETITION LAW, *Study on the Overall Functioning of the European Trade Mark System*, 15th February 2011, http://ec.europa.eu/internal_market/indprop/docs/tm/20110308_allensbach-study_en.pdf, 146. According to the survey carried out by the European Commission these languages are considered non-indigenous languages.

¹⁷⁸ MAX PLANCK INSTITUTE FOR INTELLECTUAL PROPERTY AND COMPETITION LAW, *Study on the Overall Functioning of the European Trade Mark System*, 15th February 2011, http://ec.europa.eu/internal_market/indprop/docs/tm/20110308_allensbach-study_en.pdf, paragraph 3,67, p146. According to the survey carried out by the European Commission these languages are considered non-indigenous languages.

¹⁷⁹ E. E. BOWMAN, 'Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States' in *San Diego International Law Journal* 2003, (513) 522.

¹⁸⁰ MAX PLANCK INSTITUTE FOR INTELLECTUAL PROPERTY AND COMPETITION LAW, *Study on the Overall Functioning of the European Trade Mark System*, 15th February 2011, http://ec.europa.eu/internal_market/indprop/docs/tm/20110308_allensbach-study_en.pdf, paragraph 3,67, p146. According to the survey carried out by the European Commission these languages are considered non-indigenous languages.

Part 3 Evolution of decisive criteria

85. With the transition from official character to understanding of the relevant public, a new list of decisive criteria comes along. We will analyze to what extent different written characters are of importance to a word marks' descriptiveness. Even more important turns out to be the pronunciation of words, not only in case when people with distinct native languages pronounce one single word differently, but especially when words generate a different meaning in slang or dialect. Finally, we have a look at the impact of ancient languages such as Latin on word marks in contemporary languages.

Chapter 1 Written language

86. Understanding of the relevant public may lie in small things, like the type of characters or accents that are used. Exactly how significant these differences work on the relevant public's perception will be exposed by means of specific linguistic examples.

§1 Used characters

87. The Greek language is ideally placed to show the relevance of the characters used in word marks. In this regard Homer's idiom offers two interesting cases, with not quite the same outcome.

a) Chroma vs χρώμα

88. The Deutsche Steinzeug Cremer & Breuer AG sought registration in the Community for the word mark "Chroma" concerning sinks, shower trays, bathtubs, toilets and building

materials.¹⁸¹ Given the fact that ‘chroma’ (‘χρώμα’) in Greek stands for ‘colour’ the examiner at the Office found the sign is descriptive in Greece and Cyprus. On the basis of article 7, §1, b and c CTMR. The applicant strongly doubts that with a two-fold reasoning. Firstly, he sees no reason to put ‘chroma’ in its Latin character appearance on the same level as the Greek word ‘χρώμα’.¹⁸² By doing so, one would indeed encourage assimilation of both words and therefore cause descriptiveness.¹⁸³ Secondly, the mere use of the word ‘colour’ – in any language – does not designate any property of goods whatsoever as it does not refer to a specific colour. It is obvious that all goods necessarily have colours, whether painted or natural. According to the Court the distinction between characters in Greek and Latin is irrelevant in general and *a fortiori* in this case, since the Latin transcription is reliable and understandable for Greek speaking consumers.¹⁸⁴ As to the second argument, the Court finds the concept of ‘colour’ mainly refers to a variety of colours other than black and white. The message hereby transferred to the relevant public is a range of goods available in various colours. From the perception of Greek speaking consumers ‘chroma’ can most certainly serve as an indication for the goods in question.¹⁸⁵ In other words, it designates a relevant characteristic in terms of marketing of the goods concerned. Placing ‘chroma’ in its Latin character appearance on the same level as the Greek word ‘χρώμα’ does not cause any risk of assimilation between both words and consequently descriptiveness. Generally, the distinction between characters in Greek and Latin is irrelevant since Latin transcriptions are reliable and understandable for Greek speaking consumers.

b) ΔΕΛΤΑ vs DELTA

89. The Court – even the same Chamber – also decided on the opposite situation to what extent the average European consumer is capable of pronouncing ‘ΔΕΛΤΑ’ or whether they rather read it as the Latin word ‘delta’.¹⁸⁶ A Greek company had applied for a figurative mark

¹⁸¹ Classes 11 and 19 of the Nice Arrangement.

¹⁸² The relevance of this distinction would be that χρώμα refers to general characteristics of goods and not to specific qualities or characteristics of the goods concerned.

¹⁸³ The applicant was inspired by earlier registrations of similar word marks such as “dimension” (extent, size or dimension in English), “brilliance” (lustre, splendour or sparkle in English) or “tinta” (ink, shade or tinged in Spanish). An argument which has been declined for the legality of earlier registrations cannot be invoked as a general right: EGC (5th Chamber) 16th December 2010, *Deutsche Steinzeug Cremer & Breuer/OHIM*, T-281/09 (‘Chroma’), paragraphs 43-45.

¹⁸⁴ GC (5th Chamber) 16th December 2010, *Deutsche Steinzeug Cremer & Breuer/OHIM*, T-281/09 (‘Chroma’), paragraphs 34-35. The General Court bases its opinion upon the earlier *Electronica* case: EGC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraph 40.

¹⁸⁵ For the mark is considered descriptive in Greek, the relevant territory consists of that part in the EU where Greek is spoken, that is to say Greece and Cyprus: GC 17th May 2011, *Diagnostiko kai Therapeftiko Kentro Athinon “Ygeia”/OHIM*, T-7/10 (‘υγεία’), paragraph 54.

¹⁸⁶ GC (5th Chamber) 10th June 2009, *Vivartia/OHIM - Kraft Foods Schweiz*, T-204/06 (‘milko ΔΕΛΤΑ’).

“Milko ΔΕΛΤΑ”, which was not to the amusement of Kraft Foods, owner of the earlier figurative Community mark “Milka”. Within the mark as a whole the second element ‘ΔΕΛΤΑ’ is of less importance and the focus of the relevant public lies on the first element ‘milko’. According to the applicant the latter component is more difficult for non-Greek speaking consumers (who are not familiar with the Greek alphabet) to pronounce, let alone to understand. Nonetheless, it is wrong to conclude that consumers unable to read ‘ΔΕΛΤΑ’ correctly in Greek would tend to transcript it to its Latin equivalent ‘delta’. In order for that to happen, those consumers would be presumed to be at least familiar with the Greek capital letters ‘Δ’ (D) and ‘Λ’ (L), which is a *conditio sine qua non*.¹⁸⁷ Had that been true, they would also have been capable of pronouncing the entire word ‘ΔΕΛΤΑ’, since the remaining letters do not cause any difficulty, *quod non*. Consequently, the Court finds there is no concept behind ‘ΔΕΛΤΑ’ for non-Greek speaking consumers to associate with the mark registration of which has been applied for.¹⁸⁸

§2 Accents

90. Accents as well are of significant importance when assessing a word mark’s distinctive character, as demonstrated by the “Electronica” case. After a successful registration in the Benelux, France, Italy and the former GDR, the German undertaking Messe München GmbH wanted to register “Electronica” as a Community character mark¹⁸⁹ for catalogues and trade fairs for electronic components and structures.¹⁹⁰ In accordance with article 7, §1, b and c CTMR the Office refused for the mark was devoid of any distinctive character and purely descriptive of the goods and services provided. Obviously this descriptiveness goes for English, which until today continues to be the leading language in electronics.¹⁹¹ According to the Office descriptive character was also found in Dutch and Spanish. Messe counter argued that ‘electronica’ in Dutch is written with ‘k’ instead of ‘c’ and can therefore not be descriptive. They came up with a similar reasoning for the so-called descriptiveness in

¹⁸⁷ Unfortunately, only a category of more erudite consumers is familiar with the Greek alphabet: EGC (5th Chamber) 10th June 2009, *Vivartia/OHIM - Kraft Foods Schweiz*, T-204/06 (‘milko ΔΕΛΤΑ’), paragraphs 43-44 and 46.

¹⁸⁸ Unfortunately, only a category of more erudite consumers is familiar with the Greek alphabet: EGC (5th Chamber) 10th June 2009, *Vivartia/OHIM - Kraft Foods Schweiz*, T-204/06 (‘milko ΔΕΛΤΑ’), paragraph 46.

¹⁸⁹ The request formulary mentions the following options with regard to the several types of marks: ‘word mark’, ‘figurative mark’, ‘3D mark’ and ‘other’. The applicant chose the last option, specifying ‘characters’ (‘Schriftzug’). Choosing the last option implies nothing but an application for a word mark: GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraph 1 juncto paragraphs 31-32.

¹⁹⁰ GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’).

¹⁹¹ GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraph 20.

Spanish, according to which the same word would be written with an accent on the ‘o’: “electrónica”.¹⁹² Again, there would be no descriptive character. The OHIM nevertheless made it clear the sign in question is descriptive without any doubt in all languages of the Community¹⁹³ and especially in Dutch, German, English and Spanish.¹⁹⁴ The four latter languages are sufficient in order to conclude to lack of distinctive character in the EU.¹⁹⁵

Chapter 2 Impact of pronunciation

91. As the case law set out above may already have shown, the new criterion focuses on the understanding of the relevant public. This implies that the pronunciation of words does play an increasing role when assessing a sign’s distinctive character. Possible effects can be ranked anywhere between mere phonetic resemblance to conceptual similarity. To what extent this influences the descriptiveness of a mark will be analyzed by means of pronunciations differing from one state to another on the one hand, slang and dialects within member states on the other hand.

§1 One word, two pronunciations

92. Several sets of rules have been developed for indexing words according to their pronunciation. They code those words with a string of characters in order to be able to find a correspondence between them. The most used ones are the Kölner Phonetik for German and the Soundex as well as the Metaphone for English. In the K2 Sports case the General Court made it quite clear that pronunciation depends on national linguistic habits within the relevant territories and therefore influences the phonetic comparison of marks.¹⁹⁶ *In concreto* this means that German consumers will pronounce “K2 Sports” as ‘ka-tsvai chports’ whereas it will be pronounced as ‘kei-tu sports’ in English. As a result there will only be a phonetic identity in the word element ‘sports’ and even in respect to the latter there will be a slightly

¹⁹² The typical accent frequently used in the Spanish language on several vowels is called ‘tilde’ and can appear either as ‘ or ‘.

¹⁹³ Even in Latin and Greek there are supposed transcriptions for ‘electronica’: “ilektronika” (Latin) and ‘ηλεκτρονικα’ (Greek): GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraph 40.

¹⁹⁴ GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraphs 37-40 and 50.

¹⁹⁵ GC (4th Chamber) 5th December 2000, *Messe München/OHIM*, T-32/00 (‘electronica’), paragraph 27.

¹⁹⁶ GC (5th Chamber) 31st January 2013, *KS Sports Europe/OHIM – Karhu Sports Ibérica*, T-54/12, (‘sport’), paragraph 42.

distinction between English and German consumers following the sound made when pronouncing the final letter ‘s’. Bearing in mind that ‘sports’ does not suffice to conclude to phonetic similarity and that consumers generally pay more attention to the beginning of a sign¹⁹⁷, the alphanumeric combination ‘K2’ is the key element in the assessment of similarity since the latter has an impact on rhythm, number of syllables and intonation of the marks in question.¹⁹⁸

93. More recently the Court seems to slightly have adapted its opinion towards the importance of pronunciation though. The Milan-based company Daniel e Mayer Srl owns a national Italian word mark “DANIEL & MAYER MADE IN ITALY”.¹⁹⁹ When David Mayer Naman applied for a Community figurative mark “DAVID MAYER” concerning (imitation) leather, clothing and shoes²⁰⁰ the earlier trade mark owner opposed on grounds of likelihood of confusion, which was accepted. David Mayer however states that from a phonetical point of view the differences between the pronunciation of ‘Daniel’ and ‘David’ on the one hand and the presence of the words ‘made in Italy’ in the earlier sign on the other hand hadn’t been taken into consideration carefully, an element which surely would have been noticed by the average consumer. There is no question both signs consist of two dominant elements (DANIEL/DAVID respectively and MAYER) each of which contains two syllables. Neither is there any discussion as to the pronunciation of the second element ‘MAYER’, which is identical in both marks. Given the fact the first word element of said marks begins with the syllable ‘da’ they will be pronounced almost similar.²⁰¹ Nevertheless, a more in-depth analysis will show how important it is to assess the relevant public correctly. In spite of ‘Daniel’ and ‘David’ being two English names, *in casu* however the pronunciation by Italian consumers must be taken into account, not that of an Englishman.²⁰² Consequently, the stress on ‘da’ will only lie on – and therefore only be audible – in the pronunciation of the Italian name ‘Davide’, since the stress on the other Italian name, ‘Daniele’, will be found on the second syllable. As a result, the ampersand pronounced as ‘e’ by the relevant public will then only draw the attention of this specific relevant public. These findings alone do not suffice to

¹⁹⁷ GC 7th September 2006, *Meric/OHIM – Arbora & Ausonia*, T-133/05 (‘Pam-Pim’s Baby□Prop’) ECR II-2737, paragraph 51.

¹⁹⁸ GC (5th Chamber) 31st January 2013, *KS Sports Europe/OHIM – Karhu Sports Ibérica*, T-54/12, (‘sport’), paragraph 44.

¹⁹⁹ GC (1st Chamber) 8th March 2013, *Mayer Naman/OHMI - Daniel e Mayer*, T-498/10 (‘David Mayer’).

²⁰⁰ Classes 18 and 25 of the Nice Arrangement.

²⁰¹ GC (1st Chamber) 8th March 2013, *Mayer Naman/OHMI - Daniel e Mayer*, T-498/10 (‘David Mayer’), paragraph 89.

²⁰² With regard to the names ‘Daniel’ and ‘David’, the relevant public will understand them to be first names, strongly resembling the Italian first names ‘Daniele’ and ‘Davide’. After all, the names in question do share a common Yiddish root as confirmed by the Board of Appeal: R 413/2009-1 (‘David Mayer’), decision of 26th July 2010, paragraph 31.

exclude phonetic similarity. The addition of the words ‘made in Italy’ does not alter this, for they are merely descriptive and therefore negligible.²⁰³

§2 *One language, two pronunciations*

94. Given the fact that understanding is the new, decisive criterium to conclude to descriptive character, it suffices when the sign at stake consists of a word understood by the relevant public. In the broadest possible interpretation this implies that whenever the relevant public perceives – or better said ‘hears’ – the word mark as descriptive, be it on grounds of slang or their dialect, even within one and the same language.

a) Slang

95. According to the Oxford Dictionary slang is “*a type of language consisting of words and phrases that are regarded as very informal, are more common in speech than writing, and are typically restricted to a particular context or group of people*”.²⁰⁴ Language is a vivid thing. The group probably the most grateful for the fact that language is vivid usually consists of youngsters who are the most creative when it comes to inventing new words or coming up with neologisms. Whether such a word has made it to the country’s official dictionary or not is of little importance in this context. Lack of insertion is no safeguard for distinctive character. The main issue is whether the relevant public is able to understand the word.²⁰⁵

96. As unlikely chances that this will occur in everyday life may seem, the Court has already decided upon a similar situation in which a US based company applied for the registration of the alphanumeric sign “16PF” regarding computer software and data processing services. The 16PF appears on computers to indicate a specific function in programs. Although ICT professionals have developed their own typical slang and buzz words, this particular sign is not part of it, neither has it been used in everyday speech.²⁰⁶ In spite of the parties both being English-speaking and the standard language in the ICT sector continuing to be English, the

²⁰³ GC (1st Chamber) 8th March 2013, *Mayer Naman/OHMI - Daniel e Mayer*, T-498/10 (‘David Mayer’), paragraphs 90, 98 and 103.

²⁰⁴ www.oxforddictionaries.com

²⁰⁵ With regard to the term ‘superskin’ the General Court clearly stated its absence in English language dictionaries is irrelevant in determining descriptiveness: GC 9th December 2010, *Earle Beauty/OHIM*, T-486/08 (‘Superskin’), paragraph 48. Similar conclusions were drawn in GC 12th June 2007, *MacLean/Fogg/OHIM*, T-339/05 (‘Lokthread’), ECR 2007, II-61, paragraph 54 and GC (4th Chamber) 22nd June 2005, *Metso Paper Automation/OHIM*, T-19/04 (‘Paperlab’), ECR 2005, II-2383, paragraph 34.

²⁰⁶ GC (2nd Chamber) 7th June 2011, *Psytech International Ltd/OHIM - Institute for Personality & Ability Testing Inc*, T-507/08, (‘16PF’), paragraph 78.

sign at stake is not much more than a combination of two letters and two figures, it can hardly be considered a word and surely cannot be found in the dictionary. Nevertheless, any computer professional or amateur, any end user really, can definitely understand it. It shows just quite how far the scope of the newly adopted criterion can go.

b) Dialects

97. Slightly different are dialects, which often differ from one province or department to another. The Oxford Dictionary definition reads as follows: “*A regional or social variety of a language distinguished by pronunciation, grammar, or vocabulary, especially a variety of speech differing from the standard literary language or speech pattern of the culture in which it exists*”.²⁰⁷ Indeed, they usually seem to find their limit in the boundaries of particularly small territories. This however does not imply dialects are not a cross-border phenomenon. Both in Germany and in Austria citizens speak German, be it that their accents are quite different from one another, due to regional dialects.

98. Doesn't this imply the territory would be too small to be significant in the all-over assessment? Moreover, the pronunciation of such dialects – differing from the pronunciation of the country's official language – does not change or influence the understanding as such in any way. Indeed, if a company seeks registration throughout the Community for its word sign “CA' MARINA” in the wine sector, only the second word element will be taken into account.²⁰⁸ The fact that the word element ‘CA’ is the abbreviation of ‘casa’ in local Venetian dialect – standing for a house situated near the coast of Venice – is of no effect to wine consumers in other parts of the European Union. Despite its worldwide fame, no consumer in the entire European Union outside Venice will understand the semantic meaning behind ‘CA’.²⁰⁹ No other but the Venetian consumer familiar with their own dialect would know the origin of the archaic term that is ‘CA’. The referral to famous buildings carrying this word in their names does not alter that.²¹⁰ The understanding of such a specific term stays limited to a

²⁰⁷ www.oxforddictionaries.com

²⁰⁸ The term ‘marina’ on the contrary reminds the consumer – especially those who speak either English, French, German, Italian or Spanish – of the sea, beaches and all things maritime related. In relation to wines, it is sufficiently distinctive: GC (1st Chamber) 14th May 2013, *Masottina SpA/OHIM – Bodeags Cooperativas de Alicante Coop V*, T-393/11 (‘CA’MARINA’), paragraph 37.

²⁰⁹ This archaic term can be related to many names: Ca’ Foscari, the Ca’ Rizzonico, office of the Fondazione Musei Civici di Venezia, and the Venetian palaces, Ca’ d’oro, Ca’ Dario, Ca’ Farsetti, Ca’ Cirvan, Ca’ del Duca. None of them ring a bell for the average consumer.

²¹⁰ GC (1st Chamber) 14th May 2013, *Masottina SpA/OHIM – Bodeags Cooperativas de Alicante Coop V*, T-393/11 (‘CA’MARINA’), paragraph 39.

small group of consumers who understand the Venetian dialect. Those who speak English, French, German, Italian or Spanish – in other words the greater part of the relevant public – do not make that same connection. With its geographical limit also come a limited number of speakers, which all together makes that such a small part of the relevant public is not yet capable to hinder a (descriptive) word mark's from being registred.

Chapter 3 The continuous influence of Latin

99. At first sight dead languages clearly seem to find themselves in a comfort zone with regard to distinctiveness. An in-depth analysis shows reality is not always that crystal-clear.

§1 Words directly taken from Latin

100. At least the above-mentioned reasoning goes for words directly taken from an extinct language with no immediate contemporary equivalent. The Latin term “Garum”²¹¹ for a condiment popular in the ancient Roman Empire was refused by the OHIM as a trademark for (canned) fish in class 29. The General Court however annulled the Boards of Appeal's decision, stating that the average consumer does not understand Latin nor is familiar with specialized Latin words, which are no longer in use.²¹² Neither is there any evidence that restaurant owners would know the term in its original form or even that it would be used in Europe's gastronomic sector. In other words, looking at both the average consumers as well as traders in this specific industry, the Court concluded ‘Garum’ is not descriptive based on article 7, §1, b CTMR. “Garum” is thus fit to serve as a trademark, since the consumer does not see the link.²¹³

101. Such decision may appear logical enough. The vast majority of people nowadays do not speak, nor understand Latin anymore. When a company uses the word “IUS” as a trademark for information regarding divorce, which they provide on the internet targeting a general

²¹¹ The Latin word ‘garum’ derives from the ancient Greek ‘garon’ or ‘γάρον’.

²¹² GC (3rd Chamber) 12th March 2008, *Compagnie générale de diététique SAS/OHIM*, T-341/06 (‘garum’).

²¹³ Unlike for example “TEK” as a trademark for garden furniture. Such registration was refused based upon the word's resemblance with the wooden material ‘teak’, which might lead to confusion: GC (5th Chamber) 20th November 2007, *Tegometall International AG/OHIM*, T-458/05 (‘TEK’).

public with a non-legal background, their mark cannot be considered descriptive for the services. The average person seeking justice is not aware ‘ius’ is the Latin translation of law.²¹⁴ The term has thus no obvious meaning to the relevant public as set out above. At this point the risk a word from a dead language might become part of daily language is non-existing.²¹⁵

§2 Words derived from Latin

102. When coated in a modern twist, Latin words however can invoke descriptiveness. To what extent this may affect the burden of proof for the applicant has been made clear by the General Court in the Maharishi case.²¹⁶ Failure to prove acquired distinctiveness through use had led to rejection²¹⁷ of registration as a trade mark for the word combination “Méditation Transcendantale” concerning – among others – teaching materials, education and medical services.²¹⁸ Considering its French character the sign was said to be descriptive in the EU’s two French-speaking member states: Belgium and France, later to be extended to Luxemburg.²¹⁹ However, in the broad sense referring to an “*act of reflecting, thinking deeply on a subject that goes beyond the world of the senses*”²²⁰ “Méditation Transcendantale” will immediately and without further thought be understood by the public at large in the above mentioned meaning, especially since its Latin origin²²¹ is present in almost all official EU languages²²², except for Bulgarian and Greek. Such an implicit, yet logical enlargement of the

²¹⁴ Brussel 13th October 2009, *ICIP* 2009, 4, 600.

²¹⁵ However it should be noted that the Benelux Office for Intellectual Property who refused registration did not agree with such decision and therefore went to court. Belgium’s highest Court, Hof van Cassatie, decided that the Court of Appeal did not answer claimant’s argument correctly as to why the absolute refusal ground only requires an indication of characteristics of the goods or services at issue. So far a different judicial outcome is yet to come: Cass 27th May 2011, C.10.0131.N.

²¹⁶ GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11 (‘méditation transcendantale’) and T-412/11 (‘transcendental meditation’).

²¹⁷ The refusal was based on article 7, §1, b and c and article 7, §3 CTMR.

²¹⁸ Classes 16, 41, 44 and 45 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15th June 1957.

²¹⁹ The Board corrected this slight error made by the examiner: GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11, paragraph 11 (‘méditation transcendantale’) and T-412/11 (‘transcendental meditation’).

²²⁰ GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11, (‘méditation transcendantale’), paragraphs 8 and 76.

²²¹ Latin origin: “meditatio transcendens”.

²²² ‘meditación transcendental’ in Spanish, ‘transcendentni meditace’ in Czech, ‘transcendental meditation’ in Danish, English and Swedish, ‘transzendente meditation’ in German, ‘transsendentaalne meditatsioon’ in Estonian, ‘meditazione trascendentale’ in Italian, ‘transcendental meditazzjoni’ in Maltese, ‘transcendentală meditația’ in Latvian, ‘transcendentali meditačija’ in Lithuanian, ‘transcendens meditáció’ in Hungarian, ‘transcendente meditatie’ in Dutch, ‘medytacja transcendentalna’ in Polish, ‘meditação transcendental’ in Portuguese, ‘meditație transcendentală’ in Romanian, ‘transcendentalna meditácia’ in Slovak, ‘transcendentalna meditačija’ in Slovenian and ‘transscendenttinen meditaatio’ in Finnish. Cfr infra paragraph 60: the General Court came to a similar conclusion in the *Duscholux* Case: GC (5th Chamber) 12th September 2012, *Duscholux Ibérica/OHIM – Duschprodukter Skandinavien AB*, T-295/11 (‘duschy’).

relevant territory carried out by the Board of Appeal²²³ and confirmed by the General Court has a direct impact on the evidence to be brought forward by the applicant for he now needs to demonstrate acquired distinctiveness in twenty four out of the twenty seven EU member states. Although French is not as widely spread as English, its Latin descent seems to (almost equally) hinder the proof of distinctive character in three possible ways. Firstly, a distinction in both writing and pronunciation of these multiple translations does not alter their shared linguistic stem.²²⁴ It speaks for itself that different languages derived from Latin have each developed their own variations to their common root. Secondly, the inversion of words' normal syntax doesn't confuse the public in non-Romanic countries. They are familiar or at least aware of the stylistic effect this has for rhetorical, poetic or other purposes.²²⁵ Thirdly, *in casu* the distinction between linguistic environments, for instance technical wordings, is therefore of less importance.²²⁶

103. The “Meditation Transcendantale” case provides us with plenty of food for thought. The ancient Roman Empire did not just construct the foundations of our present European society. Also its ‘official’ language Latin can be seen as rightful nourisher of other Romanic languages of which Italian, Spanish and French are but the most obvious examples. The question that then comes to mind, is to what extent Latin leaves traces on all modern languages, on some more than on others, since it carries the root of so many idioms.²²⁷

104. Despite its continuous major impact on vivid languages, Latin does not always affect the distinctive character of a word sign. Mülhens GmbH & Co. filed an application for “MINERAL SPA” for goods in class three of the Nice Arrangement²²⁸, which was granted.²²⁹

²²³ With regard to the application for registration of “Transcendental Meditation” the Board of Appeal justified this enlargement by analogy with the GC’s earlier judgment in which it confirmed basic English can be understood in a greater number of countries compared to the amount of countries in which English is the native language: GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11 (‘méditation transcendantale’) and T-412/11, paragraphs 7 and 69 (‘transcendental meditation’). Earlier case law of the GC the Office referred to: GC 9th December 2010, *Liz Earle Beauty/OHIM*, T-307/09 (‘Naturally Active’), paragraph 53 and GC 26th November 2008, *New Look/OHIM*, T-435/07 (‘New Look’), paragraph 23.

²²⁴ GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11, paragraph 66 (‘méditation transcendantale’) and T-412/11, paragraph 67 (‘transcendental meditation’)

²²⁵ GC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11 (‘méditation transcendantale’), paragraph 65 and T-412/11 (‘transcendental meditation’), paragraph 66.

²²⁶ The applicant did not dispute the goods and services were intended for the public at large, except for the instructional and teaching material which aimed at a professional audience: EGC (2nd Chamber) 6th February 2013, *Maharishi Foundation/OHIM*, T-426/11, paragraph 57 and T-412/11 (‘méditation transcendantale’).

²²⁷ Latin seems to be present in the least expected place, as demonstrated by the following ‘fait divers’: the famous car brand “Audi” is no less than the stem of the Latin verb ‘audere’, which translates as ‘to hear’ or in German ‘hören’. Interesting detail, Audi’s founder, August Horch’s surname is a degeneration of the German verb ‘hören’.

²²⁸ ‘Soaps, perfumeries, essential oils, preparations for body and beauty care, preparations for the hair, dentifrices’.

²²⁹ GC (8th Chamber) 19th June 2008, *Mülhens/OHMI - Spa Monopole*, T-93/06, (‘Mineral Spa’).

Spa Monopole, a well-known Belgian manufacturer of mineral waters and other non-alcoholic beverages²³⁰, intervened through means of opposition based upon its earlier Benelux trade mark “SPA”. The applicant argued that ‘spa’ would be a descriptive word in Dutch, English and French because of its Latin descent, standing for ‘sanus per aquam’.²³¹ The Board rejected such viewpoint saying this particular word element is actually the most distinctive one.²³² Rather the word element ‘mineral’ lacks distinctiveness, since their use is common not only in the sector of waters, but also in that of cosmetics.²³³ The reason can be found in the earlier trademark holder’s reputation throughout the Benelux where “SPA” has developed a complete new, secondary meaning and acquired a strong distinctive character with regard to other mineral waters, through use.²³⁴ After all, the abbreviation ‘spa’ may deviate from Latin words; as such it is nothing but an abbreviation and thus not a Latin word. The fact that these concepts are variable seems closely connected to the linguistic meanings behind word marks, which may also differ from one region to another.

§3 Continuous influence of other ancient languages?

105. Although our focus here lies upon Latin, a similar reasoning also goes for ancient Greek. The Court came to such a conclusion when Eurohypo AG applied for registration of the word mark “Eurohypo” for financial and real estate affairs.²³⁵ The examiner had refused to register upon ground of Article 7, §1,b and c CTMR. There was no question as to possible associations with the European currency and the German word ‘Hypothek’ (mortgage).²³⁶ Nevertheless, ‘hypo’ does not necessarily have to be linked with this German term, but is

²³⁰ Class 32 of the Nice Arrangement: ‘mineral water and aerated waters and other non-alcoholic beverages, syrups and other preparations to make beverages’.

²³¹ Other reasons for descriptiveness would have been the name of the Belgian town ‘Spa’, Formula One circuit at Spa-Francorchamps and the increasing success of health and wellness resorts: EGC (8th Chamber) 19th June 2008, *Mülhens/OHMI - Spa Monopole*, T-93/06, (‘Mineral Spa’), paragraph 21.

²³² Leaving the word element ‘mineral’ to be far more descriptive: GC (8th Chamber) 19th June 2008, *Mülhens/OHMI - Spa Monopole*, T-93/06, (‘Mineral Spa’), paragraph 10.

²³³ GC (8th Chamber) 19th June 2008, *Mülhens/OHMI - Spa Monopole*, T-93/06, (‘Mineral Spa’), paragraphs 10 and 30.

²³⁴ This will be when a substantial part of the relevant public identifies the goods and services concerned as coming from a certain undertaking, based on this particular sign: ECJ 18th June 2002, *Philips Electronics/Remington*, C-299/99 (shape shaver), paragraph 61; ECJ 4th May 1999, *Windsurfing Chiensee/Huber*, C-108/97 and C-109/97, paragraph 51 (‘Chiemsee’); GC 6th March 2012, *ThyssenKrupp Steel Europe v OHIM*, T-565/10, not published in the *ECR*, (‘Highprotect’); GC 25th February 2010, *Lancôme v OHIM – CMS Hasche Sigle*, T-160/07, *ECR* II-1733, paragraph 44 (‘Color Edition’) and GC 29th April 2004, *Eurocermex/OHIM*, T-399/02 (shape beer bottle).

²³⁵ GC (3rd Chamber) 3rd May 2006, *Eurohypo/OHIM*, T-439/04 (‘Eurohypo’).

²³⁶ Nonetheless, ‘euro’ does not only designate the currency of the European Union, but is also the abbreviation of ‘Europe’, as in the name of the ‘Euro-fighter’ aircraft or the name of one of the applicant’s companies ‘Eurohypo Europäische Hypothekenbank der Deutschen Bank AG’.

actually derived from Greek.²³⁷ As such the abbreviation ‘hypo’ is unusual for the German public²³⁸ and on that ground cannot constitute a description of the services provided according to the applicant. The OHIM disagreed however saying the relevant public will perceive ‘hypo’ as the abbreviation of the word ‘Hypothek’. Any other meaning of ‘hypo’ put forward by the applicant is irrelevant, as it has no connection with the financial services concerned.²³⁹ Its ancient Greek meaning does not affect this.²⁴⁰

²³⁷ As shown by the German words ‘Hypothese’ (hypothesis), ‘Hypotenuse’ (hypotenuse), ‘Hypochonder’ (hypochondriac) and ‘Hypozenrum’ (hypocentre).

²³⁸ Especially in comparison with other abbreviations such as ‘Disco’ for ‘Discothek’ (discotheque) and ‘Auto’ for ‘Automobil’ (automobile).

²³⁹ GC (3rd Chamber) 3rd May 2006, *Eurohypo/OHIM*, T-439/04 (‘Eurohypo’), paragraph 33.

²⁴⁰ GC (3rd Chamber) 3rd May 2006, *Eurohypo/OHIM*, T-439/04 (‘Eurohypo’), paragraphs 52 and 57.

Part 4 Comparative analysis in search of an alternative

106. It is beyond doubt that a mixture of cultures offers valuable diversity. However, by far it is not a sinecure finding the right balance between all the linguistic and grammatical backgrounds that come with it. In trademark law it is no different. In order to find a perhaps slightly more diversity-embracing alternative, we may find some options across the oceans. Australia and the United States – two Anglo-Saxon law systems – like no other, know how difficult, yet not impossible, it is to fuse.

Chapter 1 The Australian system

107. In Australia many languages other than English are understood as a significant number of its population either come from a non-English speaking background or have studied a foreign language.²⁴¹ It must therefore be determined whether the foreign language trade mark has a meaning which is likely to be required for use by other traders.

§1 Foreign words

108. The same principles apply to trademarks consisting of foreign words as with English words. Trade marks in a foreign language well known in Australia that contain a word or words that, if in English would not sufficiently be capable of distinguishing the applicant's goods or services, would similarly not be sufficiently capable of distinguishing the applicant's goods or services. Examiners should refer to foreign language dictionaries as well as to the translation which must be provided by the applicant.

109. If there is a rather small chance the foreign word, originating from a language other than English, will be known by a significant proportion of the Australian population, then no ground exists to turn down the application for registration. In that respect, the word

²⁴¹ TMO Manual of Practice and Procedure, <http://xeno.ipaustralia.gov.au/D:/Exmanual/cnts-num.htm>.

“OOMOO” designating ‘choice’ in one of Australia’s Aboriginal languages, for wines and spirits was said not to signify anything to the ordinary English speaking citizen.²⁴²

110. When elements are taken from more than one language, the result will almost automatically be registrable.²⁴³ If the trade mark applied for consists of foreign characters which nonetheless are translations of English words incapable of distinguishing, this is a ground for rejecting the application. It is the examiner’s task to ascertain the meaning of the characters and consider both translations and transliterations provided by the applicant.

§2 Trademarks in a foreign language

111. In general, tests for comparing word signs are only run when words rendered in a foreign language are deceptively similar to word marks that are already registered. In this context it is of no importance whether those marks are written either in Roman, Arab or Chinese characters.

112. The visual or phonetical comparison should be made together with considerations with regard to the nature of the goods or services specified and the way in which they are marketed.²⁴⁴ The most important aspect of the assessment is to establish the likelihood average purchasers of the goods or services will understand the meaning of the foreign words constituting the trademark. Due to the nature of the particular goods or services results may vary. The following examples give a better overview:

- If the goods are mass marketed, for example clothing or foodstuffs, the purchase may be made purely on the basis of a large visual selection. The trademark may be part of a package which displays other similar textual material and the purchaser may be part of the general (monolingual) Australian public. In such case the meaning of the respective trademarks would be irrelevant. The main tests would be visual and phonetic, as far as verbalisation of the trademark is possible. In so far Arab and Asian

²⁴² United Kingdom case - *Burgoyne's Trade Mark*, 6 RPC 227.

²⁴³ *Smitsvonk* case 72 RPC 117, *Simplug* case, (1957) RPC 173 and *Wacker-chemie* case, (1957) RPC 278.

²⁴⁴ This kind of comparisons are extensively described in inter alia *Pianotist Co's Application* (33 RPC 774).

characters are concerned, consumers who are not literate in these languages would be expected to pay particular attention to the graphics involved.

- Newspapers, books and similar publications or professional services, such as medical or legal services, for which a trademark fully consisting of words coming from a foreign language is used, are unlikely to be purchased by the general Australian public. They will be targeted towards a particular sector familiar with that language. The meaning of the word or words comprising the trademark must therefore be taken into account, as well as the visual and phonetic similarities. If the meanings are quite different, it is much less likely that visual or phonetic similarities will lead to deception or confusion.
- If the goods or services are very specialised and/or expensive, considerable care would be practised in their selection and purchase. In such circumstances even the smallest differentiations between trademarks might serve to differentiate the goods or services.

113. When the comparison is between a foreign language trademark and an English trademark, the same principles apply. Generally – except where the words are visually or phonetically similar – the English equivalent of a foreign language trade mark will not be cited as the basis for rejecting an application under section 44. For example, “Red Man” will not be cited against “Rouge Homme” nor against the Chinese or Arab characters meaning ‘red man’.

Chapter 2 The US foreign equivalents doctrine

114. The American trademark system is governed by the Lanham Act²⁴⁵, which dates back to 1946. The equivalents to article 3, §1, c TMD and article 7§ 1, c CTMR are sections 2 and 3 of above-mentioned Act, prohibiting the registration of marks that are merely descriptive for the goods or services concerned.²⁴⁶ As a strategic center for world trade, the US house not only their own official language English, but also many minority and immigrant languages –

²⁴⁵ 15 U.S.C. §§ 1051-1127.

²⁴⁶ 15 U.S.C. §1051(e)(1).

of which Spanish is the idiom of the largest minority group that is still on the increase. The current status of their population calls for recognition of the multilingual character of word marks.²⁴⁷

115. According to the Trademark Manual of Examining Procedure²⁴⁸ of the United States Patent and Trademark Office²⁴⁹ the doctrine of foreign equivalents seeks to find out whether "*to those American buyers familiar with the foreign language, the word would denote its English equivalent*".²⁵⁰ In order to do so, foreign words are to be translated into English before assessing their distinctive (or descriptive for that matter) character.²⁵¹ The attorney who examines the mark containing foreign words should do research regarding the English translation of those words. During this investigation, the examiner can make use of all kinds of resources such as dictionaries, the Internet and online databases in order to find sufficient supporting evidence for the application of the doctrine.²⁵² Nonetheless, the test is not absolute and merely serves as a guideline.²⁵³ Instead the doctrine should be applied only when it is likely that the ordinary American purchaser would "*stop and translate into its English equivalent*".²⁵⁴ The *Palm Bay Imports* case suggests that the same test applies when foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.

116. If there is proof that the English translation is "*literal and correct*"²⁵⁵ with no contradictory evidence of other relevant meanings or shades of meaning, the doctrine has to be applied. An example is the cancellation of the word mark "HA-LUSH-KA" under US law. Halushka is the phonetic spelling of the Hungarian word for noodles.²⁵⁶ Similarly, the word mark "La Peregrina" for jewelry and precious stones meaning 'pilgrim' in Spanish was likely

²⁴⁷ R. SCHECHTER and J. THOMAS, *Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States*, San Diego Int'l LJ, Vol 4 513, 2003, p 521.

²⁴⁸ Henceforth referred to as "TMEP".

²⁴⁹ Hereafter referred to as the USPTO.

²⁵⁰ TMEP § 1207.01(b)(vi), 1209-1211. 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.

²⁵¹ *Examination Guide 1-08 The Doctrine of Foreign Equivalents and Likelihood of Confusion*, USPTO, Issued 23rd April 2008, III available online: http://www.uspto.gov/trademarks/resources/exam/examguide1_08.jsp.

²⁵² One of the databases at the disposal of the examiner is LEXISNEXIS®.

²⁵³ *Palm Bay Imports Inc/Neuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed Circuit 2005).

²⁵⁴ *Palm Bay Imports*, citing *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976).

²⁵⁵ H. VANHEES, "Boekbespreking: Handboek merkenrecht (Benelux, communautair, internationaal)" in *RW* 2010, ep 33, 565.

²⁵⁶ R. SCHECHTER and J. THOMAS, *Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States*, 88.

to be confused with the mark “PILGRIM”, also for jewelry. Both terms were equivalent in meaning without dictionary evidence to the contrary.²⁵⁷ The French language mark “Marché Noir” for jewelry (in English ‘Black Market’) is likely to be confused with the mark “Black Market Minerals” for retail jewelry and mineral store services. The word element ‘minerals’ was said not to suffice to distinguish both marks from one another.²⁵⁸ Finally, also the “Matzoon” was refused registration for fermented milk-based food of Armenian origin for reasons that it is descriptive in that language.²⁵⁹

117. The status granted to words in foreign countries is of no importance to their registration in the US. In the *Anheuser-Busch Inc/Stroh Brewery Co* case the court rejected the generic use of “L.A. Beer” in Australia for low alcohol beer as irrelevant.²⁶⁰ In *Seiko Sporting Goods USA, Inc. v. Kabushiki Kaisha Hattori Tokeiten* the court stated that in spite of Seiko being a generic term in Japanese it not so in the US. Consequently, the mark must still be regarded as arbitrary and fanciful within the United States.²⁶¹

118. This doctrine also proves its use in court proceedings. When the word sign “Otokoyma” was considered descriptive of a type of Japanese Sake during an infringement procedure, the Court applied the doctrine of foreign equivalents, thereby granting a preliminary injunction.²⁶² Courts also apply the foreign equivalents doctrine for trademarks consisting of several words whereby only one is descriptive. The Court considered the word ‘chupa’ in the registered trademark “CHUPA CHUPS” to be descriptive of lollipops, for it is commonly used in the Spanish language.²⁶³ Consequently, the court vacated a preliminary injunction against “CHUPA GURTS,” since only the non-generic parts of these trademarks were compared and were found not to be similar. Granting a preliminary injunction by the district court was an abuse of discretion because it had been based on erroneous likelihood of confusion.²⁶⁴

²⁵⁷ USPQ2d at slip op. at 10, 15-16.

²⁵⁸ *La Peregrina*, Thomas , 79 USPQ2d at 1021.

²⁵⁹ *Dadirrian v. Yacubian*, 98 F. 872, C.A.1, 1900.

²⁶⁰ *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 641-42 (8th Cir. 1984).

²⁶¹ *Seiko Sporting Goods USA, Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F. Supp. 221, 226 (S.D.N.Y. 1982).

²⁶² *Otokoyama Co., Ltd/Wine of Japan Import Inc.*, 175 F.3d 266 (2d Cir. 1999).

²⁶³ *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, (5th Cir. 2000).

²⁶⁴ *Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States.*

§1 *The relevant consumer*

119. In *Palm Bay* the relevant consumer was described as the “*ordinary American purchaser*”. Shortly afterwards, in the *In re Thomas* case this definition has been interpreted as only those purchasers “*familiar with the foreign language*”.²⁶⁵ Narrowing down the scope of the definition has led to an effective application in practically every case involving foreign word marks for those who master a non-English language are presumed to translate words into English.²⁶⁶ However, the Federal Circuit refined the interpretation into “*all American purchasers, including those proficient in a non-English language*”.²⁶⁷

§2 *Dead, obscure and unusual languages*

120. The doctrine of foreign equivalents applies to all words or terms common to all modern languages.²⁶⁸ Afrikaans serves as an example of a common, modern and not-obscure language even though only 0.096% of Americans speak Afrikaans. The examining attorney submitted a report from the USPTO translator stating that Afrikaans is a well-established language recognized by all of the advanced and developed nations, it is a form of old Dutch and is a European language that is familiar in the United States, and it is one of the principal Germanic languages spoken by more than 20 million people.²⁶⁹ This information is sufficient to apply the doctrine.²⁷⁰

121. In other words dead, obscure or unusual languages are excluded for they may be “*so unfamiliar to the American buying public that they should not be translated into English for descriptiveness purposes*”.²⁷¹ “Cohiba” for example is a mark not diminished by its Taino

²⁶⁵ *In re Thomas* 9 U.S.P.Q.2d 1021, 1024 (T.T.A.B. 2006).

²⁶⁶ W. MCGEVEREN (ed), *World Almanac and Book of Facts 2004*, World Almanac 2004, 766.

²⁶⁷ *In re Spirits Int'l*, N.V., 563 F.3d 1347, 1352 (Fed. Cir. 2009).

²⁶⁸ Common, modern languages have been found to include Spanish, French, Italian, German, Chinese, Japanese, Russian, Polish, Hungarian, Serbian and Yiddish.

²⁶⁹ Sources that were used include the following: W. MCGEVEREN (ed), *World Almanac and Book of Facts 2004*, which states that six million people speak the language, with significant numbers in ten countries and J. GERRY and C. RUBINO (eds), *Facts About the World's Languages: An Encyclopedia of the World's Major Languages, Past and Present*, 2001, which states that Afrikaans is the home language of 6.2 million people in South Africa (out of a total population of 44 million people).

²⁷⁰ *In re Savisa* (Pty.) Ltd., Ser. No. 78154196, 2005 TTAB LEXIS 91, at *6-12 (Feb. 24, 2005).

²⁷¹ TMEP § 1209.03(g).

Indian meaning ‘tobacco’, based on the fact that the Taino language is an obscure one.²⁷² A refining is in place however. Whereas “Dictaphone” was found not only registerable, but also a strong mark because although it is derived from the Latin ‘dicere’²⁷³ and the Greek ‘phonos’²⁷⁴, it had no inherent meaning to the relevant purchasing public, there are chances trademark registration will be rejected for words that are considered either descriptive or generic when translated from languages such as ancient Greek or Latin.²⁷⁵

Chapter 3 Comparison with the European approach

122. By drawing a comparison between the Australian and US case law on the one hand and the European cases on the other hand, it immediately strikes that the eye-catching difference is the linguistic context in which verbal marks are to be assessed.²⁷⁶ Whereas the first two mentioned countries basically start from English, the EU houses twenty-three official languages, which are all equal.

123. A more detailed look at things however reveals that the actual distinction lies in the perception of the non-native speaker. Both Australian and US doctrine look at whether native speakers of a foreign language would understand a questionable word mark in that same idiom. Given the unique linguistic diversity in the EU, the European system is forced to take the perception of non-native speakers into account as well.

124. Applying a similar doctrine in the EU could mean a step in the right direction avoiding descriptive word signs. After all, the US foreign equivalents doctrine tends to be ‘outward-looking’ taking almost all languages into consideration, whilst the EU approach is rather ‘inward-looking’ (thus far) only considering European languages. Nonetheless, the Australian and American systems are not completely without flaws either. Determining the ‘ordinary American purchaser’ who would stop and translate the foreign word is not an exact science.

²⁷² General Cigar Co./G.D.M. Inc., 988 F. Supp. 647, 660 (S.D.N.Y. 1997) (quoting 1 McCarthy § 11.14, p. 464-65).

²⁷³ ‘to say’.

²⁷⁴ ‘voice’ or ‘sound’.

²⁷⁵ TMEP § 1207.01(b)(vi).

²⁷⁶ Bowman seems to share this point of view: E. E. BOWMAN, “Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States” in *San Diego International Law Journal* (2003), 514.

Conclusion

125. The little we are aware of word marks in daily life, the more they are present everywhere. And so is the risk of creating a descriptive mark in one of the European Union's many languages. These linguistic treasures are numerous, the EU houses twenty-three official languages (of which five world idioms) and sixty-five regional/minority languages. Indeed, the exact same element which gives Europe its unique characteristic, also seems to be a trap on the way to obtaining a Community word mark. Deciding which idioms should be taken into account and which should not, is not a sinecure however. An analysis of the General Court's case law has given an insight in the factors one needs to bear in mind when filing an application.

126. Key is to distinguish major languages from the minor ones. Easy as this may seem, in reality there is a fine line between idioms that count few speakers, yet are official and others that are spoken by millions of people but which are nonetheless not officially acknowledged. Though the initial criterion of having an official status was straightforward, it is no longer suited for representing modern day Europe in all its diversity. By means of two rapidly increasing 'minority' languages – Catalan and Turkish – it has been illustrated how we are definitely moving towards a new, holistic view on our linguistic landscape with the introduction of a new criterion, namely the understanding of the relevant public.

127. With that certain implications come along. Firstly, a new definition of the relevant public is in place, for intermediaries involved in the distribution process can also be a part of it if the market features allow it. Secondly, citizens' perception of a mark should be assessed according to their multilingual skills. The "Paki" case illustrates to which extent the understanding of the public reaches. In third place, we need to revise our vision on minority languages. The latter plays quite an important role when it comes to the transition from the old to the new criterion. Many regions throughout the EU currently experience revitalizations of minority groups, calling for attention towards their language. The same goes within the context of assessing a word sign's distinctive character. After all, all idioms deviating from the official state language are minority languages and should then be taken into consideration. In other words, by opening up the door towards minority languages – and in spite of the

urgent necessity to do so – we just might not be able to keep control of the continuous inflow, for language is vivid and changes constantly.

128. Hence, it could be an option to use the official status of a language, in combination with the country's population that is, as an indication whether the relevant public actually understands the idiom in which the mark is written. Based on the Catalan and Turkish cases this could prove to work really well, allowing languages other than merely the official ones to prevent registration of a Community mark if the sign is descriptive or non-distinctive in that other language. The Max Planck Institute seems open towards the idea.

129. Also other elements have come into play with recent judicial evolutions. With regard to written language, the “χρώμα” case has shown that the relevant public consisting of Greek consumers is able to understand words in their idiom, be it written in Latin characters. On the other hand, non-Greek speaking consumers are less likely to transcript a Greek word like ‘ΔΕΛΤΑ’ into Latin characters for they lack sufficient knowledge of the Greek alphabet to do so. Accents are of significant importance as well, as demonstrated by the “Electronica” case, though not able to alter a mark's descriptive character in a particular language of the EU. A similar conclusion could be drawn from words that can be pronounced in two or more different ways. A simple word combination like ‘K2’ is pronounced and consequently perceived differently depending on the language one speaks. Another interesting issue is when several people from the relevant public do speak the same language, though have a different way of pronouncing words. Without necessarily leading to descriptiveness all-over, slang and dialects do have a growing weight upon the assessment of word marks. At the other end of the road we encounter classical languages, such as Latin. Words directly borrowed from the ancient Roman Empire's idiom do not cause any difficulties for most people do not understand Latin anymore. Modern day words from Latin descent however are problematic. As the “Méditation Transcendantale” case explained French – and many other European languages – still carry this root until today. Such a shared stem implies risk of descriptiveness in all of these languages.

130. In an attempt to find a good balance with a more diversity-embracing alternative, we took a look at Australia and the United States. The Australian system applies the same principles to trademarks containing non-English words as for marks in English. If such a foreign word is well known and would have been descriptive to the goods or services

concerned had it been in English, it will be considered descriptive in this specific foreign language too. Marks with words from several idioms, practically always are registrable. It is up to the examiner to ascertain the meaning of all characters and he should do so consulting foreign language dictionaries. Comparison tests – always in relation to the nature of the goods or services and their marketing – are only carried out when there is a risk of deception with registered word marks, regardless of the characters in which they are written. Objective is to establish whether people understand the meaning of these foreign words or not. In this context we distinguish three situations: mass marketed goods/services, human-interest goods/services and specialized goods/services.

131. The US system employs the foreign equivalents doctrine, striving to find out whether Americans with a foreign native language understand word marks with foreign words in its English equivalent, but only then if an average consumer is presumed to stop and translate. Before the actual assessment, foreign words are translated into English. In this task examiners can rely on research regarding English translations. If the English translation is ought to be correct and literal the test should applied anyhow. The relevant consumer is herein defined as the average American consumer who finds himself familiar with the foreign language. As in Europe, classic idioms are generally safeguarded from descriptiveness, even though cases exist in which Greek and Latin have proven to be a possible obstacle on the way to registered word mark.

132. By drawing a comparison between the Australian and US case law on the one hand and the European cases on the other hand, we have exposed the major difference that is the linguistic context in which verbal marks are to be assessed. Underneath lies the bigger distinction between the perceptions of said consumers. Whereas Australian and the US look at whether native speakers of a foreign language would understand a questionable word mark in that same idiom, the EU takes the perception of non-native speakers into account as well. Applying a similar doctrine in the EU could mean a step in the right direction avoiding descriptive word signs and to being more ‘outward-looking’.

133. No need to say the discussion about where to draw the line will continue, for language is highly vivid. After all, as Samuel Johnson already concluded in the eighteenth century, *“language is the dress of thought”*.

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