

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

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I. INTRODUCTION

The Council of the European Union adopted Council Regulation 40/94 on the Community trade mark on the twentieth of December 1993.¹ The purpose of this regulation was to promote the harmonious development and expansion of economic activities in the European Union's internal market by offering conditions similar to those of national markets.² Striking similarities exist in the purpose of this regulation, which provides an overarching trademark scheme for a collection of member states with their own trademark laws, and that of the trademark law of the United States, with a parallel overarching trademark scheme for a collection of states having their own laws on unfair competition. Striking disparities between the trademark laws of the United States and Europe exist in the treatment of proposed verbal marks based on the respective interpretations of the distinctive nature of these marks in a linguistic context.

This Comment will examine the similarities and differences between these trademark protection laws with regard to the multi-cultural nature of the consuming public of the European Union and that of the United States, and then will recommend ways in which the laws can be harmonized to promote the congruent development and expansion of economic activities globally. This harmonization is necessary in light of the interplay between these schemes for protection of marks and the protection provided under the Paris Convention for the Protection of Industrial Property,³ the Madrid Agreement Concerning the International Registration of Marks⁴, and the

1. Council Regulation 40/94, 1994 O.J. (L11) 1 [hereinafter CTMR]. Specific articles from the CTMR will be cited as Article XX CTMR, where XX is replaced by the article number.

2. *Id.*

3. PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, Mar. 20, 1883, 37 Stat. 1645 [hereinafter PARIS CONVENTION].

4. MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, Apr. 14, 1891, 23 U.S.T. 1353. The United States is not a contracting country for this agreement.

Madrid Protocol.⁵ The dependence of international protection of a mark registered under the Madrid Protocol upon the validity of the mark in its country of origin⁶ argues for a similar treatment of validity of the mark in all countries of origin.

II. THE COMMUNITY TRADE MARK

Community trade mark laws are laid out in Council Regulation 40/94.⁷ To administrate the Community trade mark, the Office for Harmonization in the Internal Market (trade marks and designs) (OHIM) was established.⁸ OHIM examines marks for which Community trade mark registration is sought for compliance with the requirements of Community trade marks,⁹ publishes marks that are eligible for registration,¹⁰ decides oppositions to

5. PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, June 28, 1989, WIPO Pub. No. 204(E), available at <http://wipo.org/eng/iplex/index.htm> (last visited Oct. 1, 2002) [hereinafter MADRID PROTOCOL]. Membership in the Madrid Protocol treaty seems imminent for the United States. Bruce A. McDonald, *International Intellectual Property Rights*, 35 INT'L LAW. 465, 471 (2001). The granting of the advice and consent of the Senate to the Madrid Protocol was recommended by the Senate Foreign Relations Committee on November 14, 2001. Barbara Grahn, *The Madrid Protocol—Are We Finally There?*, 20 IPL NEWSLETTER 45 (Winter 2002). The House passed The Madrid Protocol Implementation Act on March 14, 2001; this act is awaiting Senate approval. *Id.*

6. See MADRID PROTOCOL, *supra* note 5, art. 6(3). This Article prevents invocation of international protection in the case of marks that have been cancelled, revoked, or rejected in the country of origin during the first five years of registration under the protocol. *Id.* Article 5 of the Protocol allows contracting parties to refuse protection to a mark based on the grounds of the Paris Convention (lack of distinctiveness amongst others). *Id.* art. 5(1); PARIS CONVENTION, *supra* note 3, art. 6 quinquies. Disparate treatment of distinctiveness under the Community Trade Mark law and United States Trademark law could result in a situation where a mark with an origin outside of the European Union (the United States for example) could be denied protection by the Community as a whole, but would be provided protection by the individual member states.

7. CTMR, *supra* note 1. This regulation was modified by Council Regulation 3288/94, 1994 O.J. (L349) 83, to comply with the Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay round Vol. 31, 33 I.L.M. 81 (1994) [hereinafter TRIPS]. The implementing rules for the Community trade mark were laid out in Commission Regulation 2868/95, 1995 OJ (L 303) 1 [hereinafter IR]. Specific rules from the IR will be cited as Rule XX IR, where XX is replaced by the rule number.

8. Article 2 CTMR.

9. Articles 36–39 CTMR; Rules 9–11 IR. These examinations are conducted in accordance with a set of examination guidelines adopted by OHIM in 1996. Examination Guidelines, 1996 O.J. OHIM 1324, available at <http://oami.eu.int/en/marque/directives/exam.htm> (Mar. 26, 1996) [hereinafter Examination Guidelines].

10. Articles 40–41 CTMR; Rule 12 IR.

registration,¹¹ and either registers or refuses to register the marks.¹² If OHIM refuses to register a mark, this refusal may be appealed to a Board of Appeal within OHIM.¹³ Additionally, OHIM considers revocation or invalidity of registered marks when challenged.¹⁴ The results of these proceedings may also be appealed to a Board of Appeal.¹⁵ Adverse decisions by the Board of Appeals may be appealed to the Court of First Instance of the European Communities.¹⁶

III. GROUNDS FOR REFUSAL OF COMMUNITY TRADE MARK REGISTRATION

Registration of a mark may be refused on the basis of two broad categories of reasons, those that are absolute grounds for refusal¹⁷ and those that are relative grounds for refusal.¹⁸ The relative grounds for refusal are based on a comparison of the mark with earlier trade marks, which are defined to include Community trade marks, trade marks of Member States,¹⁹ trade marks registered under international arrangements having effect in a Member State, applications for such trade marks, and trade marks that are well-known in a Member State.²⁰ This comparison is made only upon opposition of the registration by the proprietor of the earlier mark, and will preclude the registration of marks that are identical or sufficiently similar to the earlier mark to present a likelihood of confusion on the part of the consuming public for the earlier mark.²¹

The Community Trade Mark Regulation provides a listing of the absolute grounds for refusal to register a trade mark.²² Applications for marks are examined with regard to these grounds during the examination process.²³ It is in the absolute grounds for refusal that the linguistic and multicultural aspects of the Union become apparent.

11. Articles 42–43 CTMR; Rules 15–22 IR.

12. Articles 36.4, 37.1, 38.1, 43.5, 45 CTMR; Rule 23 IR.

13. Articles 57–62 CTMR; Rules 48–51 IR; Commission Regulation 216/96, 1996 O.J. (L28) 11.

14. Articles 55–56 CTMR; Rules 37–41 IR.

15. Articles 57–62 CTMR; Rules 15–22 IR.

16. Council Decision 99/951/ECSC, Euratom of 24 October 1988 Establishing a Court of First Instance of the European Communities, 1988 O.J. (L319); 1989 O.J. (L241).

17. Article 7 CTMR.

18. Article 8 CTMR.

19. This category includes trade marks registered with the Benelux Trade Mark Office for Belgium, the Netherlands and Luxembourg. Article 8.2.(a)(ii) CTMR.

20. Article 8.2 CTMR. The use of the phrase “well-known” in this regulation is defined as being identical to that of the Article 6bis of the Paris Convention, *supra* note 3, at 6bis. Article 8.2.(c) CTMR.

21. Article 8.1 CTMR.

22. Article 7 CTMR.

23. Article 38 CTMR.

The first of the absolute grounds for refusal of registration is that the sign sought to be registered as a Community trade mark is incapable of either being rendered graphically, or of distinguishing the goods or services of one source from those of another.²⁴ The Examination Guidelines discuss the issue of graphical rendering of the signs, but provide no insight into the criteria regarding a sign's capability to distinguish goods or services.²⁵

The Examination Guidelines seem deficient in their discussion of the next absolute grounds for refusal of registration, the lack of any distinctive character of the mark.²⁶ Under the Community Trade Mark Regulation, this ground for refusal is treated as a separate consideration from considerations of descriptiveness, customariness, and deceptiveness, which are discussed below.²⁷ One author has highlighted this as a difference between the law on Community trade marks and national trade mark laws,²⁸ but this interpretation focuses solely on the application of distinctiveness to word marks. A word mark that is customary or descriptive is considered devoid of distinctive character,²⁹ but not all marks that are devoid of distinctive character are either customary or descriptive word marks.³⁰

24. Articles 4, 7.1(a) CTMR. Article 4 actually defines signs that may constitute Community trade marks, while Article 7.1(a) provides that signs not meeting this criteria shall not be registered; hence, the odd construction of this rule. *Id.* Although listed as an absolute ground for refusal, this seems to include the relative grounds for refusal, which are only applied upon opposition. Article 8 CTMR. The identity or similarity between a proposed mark and an earlier trade mark would render the proposed mark incapable of distinguishing the goods or services of the two undertakings.

25. Examination Guidelines, *supra* note 9, at para. 8.2. The guidelines do suggest that a sound that could be considered capable of graphical representation by musical notation would be acceptable, but do not address signs targeting the other non-visual senses of smell and taste. *Id.*

26. Examination Guidelines, *supra* note 9, at para. 8.3; *See also*, Article 7.1(b) CTMR.

27. Article 7.1(b) CTMR.

28. ERIC GASTRUEL & MARK MILFORD, *THE LEGAL ASPECTS OF THE COMMUNITY TRADE MARK* 71 (2001). Gastruel and Milford use the term generic instead of customary. *Id.* The term customary will be used in this Comment to follow the terminology of Article 7(1)(d) CTMR and to distinguish this type of mark from a mark that "become[s] the common name in the trade for a product or service in respect of which it is registered." Article 50(1)(b) CTMR. This second type of mark could also be considered generic, and would be revoked under this Article. *Id.* The need for this distinction is the ability under the CTMR for acquired distinctiveness to overcome the customary nature of a mark. Article 7(3) CTMR.

29. This is evident from the example provided by the Examination Guidelines of the word "wine" as used with respect to the product wine. Examination Guidelines, *supra* note 9, at para. 8.3. The word in this context is devoid of distinctive character because it is customary or descriptive.

30. The Examination Guidelines provide the additional examples of simple designs (circles or squares), primary colors, and marks consisting of one or two letters or

The descriptive nature of a mark is the third absolute grounds for refusal. The regulation prohibits the registration of marks that may serve to designate the characteristics of the goods or services.³¹ Related to this prohibition is the prohibition of registration for the customary nature of a mark. Customary marks are marks that “have become customary in the current language or . . . the bona fide and established practices of the trade.”³² This category of prohibited marks extends beyond word marks alone to include images of grape bunches and leaves from grape vines on wine bottles.³³

These grounds for refusal of registration, and the effect of the multilingual character of the European Union will be the focus of this Comment for comparison with the parallel treatments of the trademark law of the United States.³⁴ The linguistic effect on Community trade marks is magnified by the regulations provision that the grounds for refusal apply despite their existence in only a portion of the Community.³⁵

numbers as marks that are devoid of distinctive character. *Id.* at para. 8.3. Although the numbers may be descriptive of the quantity of a good, this is not necessarily the case, but depends on the usage. In addition, the deceptive quality of a word mark does not actually make the mark devoid of distinctive character because of the mark’s deceptive quality. The deceptive nature would logically require the conveyance of some information by the mark about the product, which would necessitate that the mark be customary, descriptive, or possibly suggestive. Although suggestive marks are generally considered distinctive, a mark that suggests information of a deceptive nature would be refused registration on the grounds of its deceptive nature. Article 7.1(g) CTMR; Examination Guidelines, *supra* note 9, at para. 8.8.

31. Article 7.1(c) CTMR. This regulation specifically cites the “kind, quality, quantity, intended purpose, value, geographic origin or the time of production of the goods or of rendering of the service.” *Id.* The regulation includes a catchall category for other characteristics. *Id.* The prohibition on registration applies only to marks that consist exclusively of descriptive elements. *Id.* The descriptive nature of the mark is to be determined in relation to the trade in the goods or services to which the mark relates. Examination Guidelines, *supra* note 9, at para. 8.4.1.

32. Article 7.1(d) CTMR.

33. Examination Guidelines, *supra* note 9, at para. 8.5. As with descriptiveness as a ground for refusal, customariness is examined in the context of the trade. *Id.* This examination is expanded to include uses of words in the current language as well, an aspect not covered in the Examination Guidelines. *See Id.*; Article 7.1(d) CTMR.

34. The regulation prohibits registration for several other grounds for which the effect of a multicultural society is less noticeable, including certain shapes, public policy and morality, deceptiveness, certain emblems, certain hallmarks, and deceptive geographic origin designation for wines or spirits. Articles 7.1(e)–(j) CTMR.

35. Article 7.2 CTMR. The regulation contains an additional provision allowing for acquisition of distinctiveness through use to overcome the prohibition of lack of a distinctive character, descriptiveness or customariness of a mark. Article 7.3 CTMR. Article 7.2 of the regulation applies to acquired distinctiveness as well.

IV. LINGUISTIC ASPECTS OF COMMUNITY TRADE MARK EXAMINATION

The multiplicity of official languages of the European Union³⁶ necessitates an examination of the treatment of language within OHIM. There are five languages of OHIM, English, French, German, Italian, and Spanish.³⁷ Applications for Community trade marks may be filed in any of the official languages of the European Union, but must specify an alternate language, which must be a language of OHIM.³⁸ If applications are filed in a language other than those of OHIM, they are translated into the alternate language specified.³⁹ The language of proceedings in which the applicant is the sole party is the language of the application;⁴⁰ for proceedings involving additional parties, the language of proceedings is either the language of the application or the alternate language, but in either case will be a language of OHIM.⁴¹

V. COMMUNITY TRADE MARK LAW APPLIED

Representative cases involving the application of the Community Trade Mark Regulation are analyzed in depth in Appendix 1. In summary, the Court of First Instance treats the issues of distinctiveness and descriptiveness of a proposed mark as separate considerations. Marks that are refused registration on grounds of a lack of distinctiveness based on descriptiveness alone, will be allowed registration if the descriptiveness is disproved.⁴² Some overlap between descriptiveness and distinctiveness does exist, as demonstrated in the assessment of distinctiveness in relation to the goods or services for which registration is requested.⁴³

36. At present there are twelve official languages in the European Union, eleven of which are actually used. RALPH H. FOLSOM, *EUROPEAN UNION LAW* 99 (3d ed. 1999). Gaelic is the unused language. *Id.*

37. Article 115.2 CTMR.

38. Article 115 CTMR.

39. *Id.*

40. *Id.* Although the language of the proceedings is the language of the application, OHIM is permitted to send written communications to the applicant in the alternate language if the language of the application is not one of OHIM. *Id.*

41. *Id.*

42. *See, e.g.*, Case T-87/00, *Bank für Arbeit und Wirtschaft AG v. OHIM*, [2000] E.C.R. II-1259, [2001] CEC (CCH) 73.

43. Case T-19/99 *Deutsche Krankenversicherungs AG v. OHIM*, [2000] E.C.R. II-1, para. 24, [2000] 1 C.M.L.R. 508; Case T-360/99, *Community Concepts AG v. OHIM*, [2001] E.T.M.R. 17, para. 21. The basis for this assessment is questionable. Article 4 CTMR includes the requirement that a sign be "capable of distinguishing the goods or services of one undertaking from those of other undertakings." Article 4 CTMR. This is interpreted as implying

Proposed marks are examined for descriptiveness simultaneously in virtually all of the languages of the community.⁴⁴ This examination is accomplished without translation of the mark into any specific language, and may take into consideration the understanding of the original language of the mark by non-native speakers of that language.⁴⁵

Proposed marks are examined for distinctiveness with respect to the goods or services for which registration is sought.⁴⁶ A mark may lack distinctiveness when it consists of a combination of words in a language of the Community when these words are commonly used with reference to the goods or services.⁴⁷ This may result despite a lack of descriptiveness of the resulting combination.⁴⁸

VI. REGISTRATION OF TRADEMARKS IN THE UNITED STATES

The Trademark Act of 1946 governs registration of trademarks in the United States.⁴⁹ Sections 2 and 3 of the Act provide grounds for refusal of registration that parallel many of the grounds of the Community Trade Mark Regulation.⁵⁰ Section 2 starts with the provision that “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration . . . on account of its nature unless” the grounds for refusal laid out in subsections (a) through (e) are present.⁵¹ This provision, extended to service marks by Section 3,⁵² is the equivalent of the requirements of Article 4 CTMR for Community trade marks.⁵³

that distinctiveness must be assessed with respect to the signs ability to distinguish the goods or services for which it is to be used. *E.g.*, Case T-19/99 *Deutsche Krankenversicherungs AG v. OHIM*, [2000] E.C.R. II-1, para. 24, [2000] 1 C.M.L.R. 508. The problem with this interpretation is that if the sign were not capable of distinguishing these goods or services, it would not meet the requirements of Article 4 CTMR as the cases interpret the Article. *Id.* This would render the proposed mark non-registrable under Article 7(1)(a) CTMR. The absolute grounds of refusal of Article 7(1)(a) CTMR may not be overcome by acquisition of distinctiveness, which may be accomplished in the case of a sign which is devoid of distinctive character under Article 7(1)(b) CTMR. Article 7(3) CTMR. Of course, the use of a mark that is already in use by another undertaking would be incapable of distinguishing the goods or services of the two undertakings. Registration of such a mark is prohibited by Article 8(1)(a) CTMR. The above interpretation of Article 4 CTMR would render this mark prohibited by Article 7(1)(a) CTMR as well, thus rendering a relative grounds for refusal into an absolute grounds for refusal.

44. *E.g.*, Case T-135/99, *Taurus-Film GmbH & Co. v. OHIM*, [2001] E.C.R. II-379.

45. *See id.*; *Bank für Arbeit und Wirtschaft AG*, *supra* note 42.

46. *E.g.*, *Deutsche Krankenversicherungs AG*, *supra* note 43, at para. 26.

47. *E.g.*, *Community Concepts AG*, *supra* note 43, at para. 22.

48. *See id.*

49. Trademark Act, 15 U.S.C. §§ 1051–1129 (1994, Supp. IV 1998, & Supp. V 1999).

50. *See* 15 U.S.C. §§ 1052–53.

51. 15 U.S.C. § 1052.

52. 15 U.S.C. § 1053. Section 45 defines trademarks and service marks as words, names, symbols, or devices used for goods or services respectively. 15 U.S.C. § 45.

53. Article 7(1)(a) CTMR has no explicit parallel in the Trademark Act; the equivalent requirements are implied. *See* 15 U.S.C. §§ 1052.

Section 2(e)(1) prohibits the registration of marks that are “merely descriptive” of the goods,⁵⁴ while Section 2(e)(2) prohibits the registration of geographically descriptive marks.⁵⁵ These sections combined are the equivalent of the absolute grounds of refusal of Article 7(1)(c) CTMR.⁵⁶ As in the Community trade mark, descriptiveness may be overcome by a showing of acquired distinctiveness.⁵⁷

There is no separate restriction under the Trademark Act for marks that are devoid of distinctive character.⁵⁸ This restriction may have a parallel in the requirement that the mark be able to distinguish the goods.⁵⁹ The difference between this form of non-distinctiveness and the lack of a distinctive character under the CTMR is that acquired distinctiveness cannot be demonstrated under the Trademark Act for a mark that is incapable of distinguishing the goods it represents.⁶⁰

VII. FOREIGN LANGUAGE MARKS UNDER THE TRADEMARK ACT

Although English is the official language of the United States, there is recognition of the multilingual character of consumers.⁶¹ The result of this recognition is the doctrine of foreign equivalents, which requires translation of foreign words to English prior to a determination of their descriptiveness.⁶² This is accomplished only for foreign words either from major foreign languages or from languages spoken by groups of consumers of the goods or services to which the words are applied.⁶³ If this is not the case, foreign words are only considered descriptive if they are similar to their English equivalents, and these equivalents are descriptive.⁶⁴

54. 15 U.S.C. § 1052(e)(1).

55. 15 U.S.C. § 1052(e)(2).

56. Article 7(1)(d), the absolute grounds of refusal for marks that are customary does not have a separate parallel in the Trademark Act. Such marks would be considered as covered under the prohibition of registration of Section 2(e)(1), 15 U.S.C. § 1052(e)(1), but have their closest parallel in the category of generic marks, which may be cancelled under Section 14(3). 15 U.S.C. § 1064. This is the equivalent of the procedure for cancellation of a Community trade mark that becomes the common name for the good or service. Article 50(1)(b) CTMR.

57. 15 U.S.C. § 1052(f).

58. See 15 U.S.C. §§ 1052–53.

59. 15 U.S.C. § 1052. This is a parallel similar to that found between Article 4 CTMR and Article 7(1)(b) CTMR. See discussion *supra* note 43.

60. See 15 U.S.C. § 1052(f).

61. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 14 (1995).

62. *Id.*

63. *Id.*

64. *Id.*

VIII. SUMMARY OF CASE LAW UNDER THE TRADEMARK ACT

Cases under the law of the United States involving the treatment of marks in a multilingual context are analyzed in Appendix 2. Notably, distinctiveness in the United States is treated as a consideration dependent on the characterization of a mark for descriptiveness or “genericness,” not a separate consideration.⁶⁵

Courts in the United States examine the distinctiveness of a foreign language trademark by first translating the mark into English, then by categorizing the mark on the spectrum of distinctiveness.⁶⁶ In addition, the courts examine the usage of the mark in its country of origin.⁶⁷ Marks that result from the combination of words from different languages are not translated, but may be accepted as being suggestive, arbitrary, or fanciful.⁶⁸

IX. CONCLUSION

The trademark laws of the United States and the European Union each have their advantages and disadvantages. The CTMR is an inherently inward-looking regulation as regards its treatment of marks for their linguistics. This treatment is more in depth than the treatment afforded by the United States; the multilingual nature of the European Union requires simultaneous examination of a proposed mark in all of the languages of the Community rather than translation of the mark prior to examination. The examination of the mark in several languages has the advantage of precluding the registration of a mark that would be descriptive or generic in part of the community. This examination has the disadvantage of requiring the refusal of a mark because of descriptiveness in pidgin.

The U.S. trademark law is an outward-looking one. The Doctrine of Foreign Equivalents provides a means of examining proposed marks for their descriptiveness or genericness in foreign languages, without restricting the languages examined. The examination is not applied to composite marks, which may result in registration and protection of marks that are actually generic in a foreign language.⁶⁹ As a result,

65. *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

66. *E.g., Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000).

67. *E.g., Orto Conserviera Sameranesi di Giacchetti Marino & Co. v. Bioconserva*, S.R.L., 49 U.S.P.Q.2d 2013 (S.D.N.Y. 1999) *aff'd* 205 F.3d 1324 (2d Cir. 2000).

68. *French Transit, Ltd. v. Modern Coupon Systems, Inc.*, 818 F. Supp. 635, 636 (S.D.N.Y. 1993).

69. This may result when one of the words has meaning in both English and the language of the remaining words. “La Yogurt” was arguably a mark of this nature. *See In re Johanna Farms Inc.*, 8 U.S.P.Q.2d 1408 (T.T.A.B. 1988). Although not argued in this way,

registration and protection of marks that are descriptive or generic in pidgin is possible.

The disparate treatment of distinctiveness between the European Union and the United States is an additional area that requires harmonization. The provision of Article 7(1)(b) CTMR adds nothing to the grounds on which a mark may be refused; lack of a distinctive character for descriptiveness or genericness is covered by Articles 7(1)(c) and (d) CTMR, while a lack of distinctive character for other reasons would be covered by Article 7(1)(a) CTMR. The examination of the distinctiveness of a mark with respect to its goods or services clearly implicates an examination of descriptiveness or genericness. A further examination with respect to the goods or services related to a mark threatens the validity of suggestive marks, which are considered deserving of greater protection under the U.S. trademark law.

X. THE WAY AHEAD

To render the protection to be afforded a mark predictable under the Madrid Protocol the mechanisms for determination of the mark's distinctiveness should be consistent. The Protocol allows for denial of protection to foreign marks that meet criteria corresponding nearly verbatim to the absolute grounds of refusal of the CTMR,⁷⁰ and invalidates an international registration if the original registration of the mark is rejected, revoked, or invalidated.⁷¹ It is clear that the intent of the Council in adopting the CTMR was to adopt the international bars to protection of marks.⁷² The bars to the protection of marks under European law diverge from the internationally accepted bars to protection due to the interpretation of the phrase "devoid of distinctive character" by the Court of First Instance as being related to particular goods or services,⁷³ a proposition unsupported by the wording of the

"Pizzeria Uno" is another mark of this nature. See *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522 (4th Cir. 1984) (protection of the word *pizzeria* was disclaimed by the mark owner because it is generic, in English, for the type or restaurant for which the mark was registered).

70. THESE criteria are actually contained in the Paris Convention, which is incorporated by reference in the Madrid Protocol. MADRID PROTOCOL, *supra* note 5, art. 5(1); PARIS CONVENTION, *supra* note 3, art. 6 quinquies; Articles 7(1)(b)–(d) CTMR.

71. MADRID PROTOCOL, *supra* note 5, art. 6(3).

72. Compare PARIS CONVENTION, *supra* note 3, art. 6 quinquies with Articles 7(1)(b)–(d) CTMR.

73. E.g., *Deutsche Krankenversicherungs AG*, *supra* note 43, at para. 24. This interpretation resulted from an imputation of the requirements of Article 4 CTMR into to the requirements of Article 7(1)(b) CTMR, see discussion *supra* note 43.

Paris Convention.⁷⁴ The protection of marks too closely related to their particular goods or services is barred under European law by the descriptive or generic nature of the mark;⁷⁵ there is no need for a further examination of distinctiveness. European trademark law should be harmonized with the international protection of marks through elimination of Article 7(1)(b) CTMR, or the reinterpretation of this Article by the European courts to exclude a reference to goods or services in the determination of distinctiveness.

The current interpretation by the European courts presents several logical problems, the first of which is the duplication of the bar to registration of a mark for lack of distinctiveness by Articles 7(1)(a) and (b) CTMR. Article 7(1)(a) CTMR bars registration of a mark that is not capable of distinguishing goods and services of competitors by reference to Article 4 CTMR;⁷⁶ Article 7(1)(b) CTMR bars registration of “marks which are devoid of any distinctive character.”⁷⁷ The reference to the requirements of Article 4 CTMR by Article 7(1)(a) CTMR is the source of the interpretation that distinctiveness must be determined with respect to the goods and services related to the mark.⁷⁸ The parallel use of the words “capable of distinguishing” and “distinctive” has resulted in the inappropriate consideration of goods or services in a determination of distinctiveness for the purposes of Article 7(1)(b) CTMR. The error of this interpretation is highlighted by Article 7(3) CTMR, which allows for an acquisition of distinctiveness to overcome the bar to registration under Article 7(1)(b), but not Article 7(1)(a).⁷⁹ Clearly there must be some difference between “marks which are devoid of any distinctive character”⁸⁰ and marks that “are [in]capable of distinguishing the goods or services of one undertaking from those of other undertakings.”⁸¹

The acquisition of distinctiveness under Article 7(3) CTMR presents another logical problem with the CTMR. The Examination Guidelines provide an example of a mark devoid of distinctive character in relation to its goods, “wine” with respect to wine.⁸² This example is for a lack of distinctiveness under Article 7(1)(b) CTMR.⁸³ It is difficult to imagine this

74. PARIS CONVENTION, *supra* note 3, art. 6 quinquies.

75. Articles 7(1)(c)–(d) CTMR.

76. Articles 4, 7(1)(a) CTMR.

77. Article 7(1)(b) CTMR.

78. Case T-163/98, *Procter & Gamble Co. v. OHIM*, [1999] E.C.R. II-2393, paras. 20–21, [1999] 2 C.M.L.R. 1442; *Deutsche Krankenversicherungs AG*, *supra* note 43, at paras. 23–24.

79. Article 7(3) CTMR.

80. Article 7(1)(b) CTMR.

81. Article 4 CTMR.

82. Examination Guidelines, *supra* note 9, at para. 8.3.

83. *Id.*

word, which is generic with respect to wine, becoming distinctive with respect to wine through use by one producer. An example that makes more logical sense is a mark composed of one or two letters or numbers.⁸⁴ The mark "A-1"® is an example of one that could be considered to lack distinctive character apart from distinctiveness or genericness under the CTMR, but has acquired distinctiveness through its use with condiments.⁸⁵

XI. THE COMMUNITY TRADE MARK AND EXPANSION

The Community trade mark law, as it is currently administered, acts as a sort of halfway house to the international registration envisioned by the Madrid Protocol. A mark that qualifies as a Community trade mark would meet the criteria for protection as they would be applied between the member states of the Community. Taken as a snapshot, this is a desirable situation for a business interested in protecting its marks. In the context of enlargement of the Community, the picture becomes murkier.

The entry of new states into the European Union will result in additional languages in which marks must be examined. This will result in the need to examine new marks for descriptiveness, genericness, and lack of a distinctive character in the new languages.⁸⁶ In the case of marks whose registrations are pending, this examination will not be conducted in the new languages.⁸⁷ The generic nature of an existing mark in the language of a new Member State will not provide a basis for invalidation of the mark, but would allow fair use of the mark in the new member state.⁸⁸ Absent one of the grounds for refusal of a mark, Community trade mark rights automatically extend to new member states.⁸⁹ The result of this extension, with exceptions, is the creation of a

84. *Id.*

85. "A-1"®, a mark comprised of two letters or digits, is another example of a mark lacking distinctiveness under Article 7(1)(b) CTMR provided in the Examination Guidelines. Examination Guidelines, *supra* note 9, at para. 8.3. Of course, this mark might be considered to be descriptive in nature of the quality of the goods or services, as well as lacking a distinctive nature.

86. Articles 7(1)(b)–(d) CTMR.

87. *Perspectives on Enlargement*, OHIM DESIGNS AND ENLARGEMENT DIVISION, at <http://oami.eu.int/en/enlargement.swf> (last visited Nov. 24, 2001).

88. *Id.* A similar result occurs for descriptive marks without an acquisition of distinctiveness in the new member states. *Id.*

89. *Id.* A similar treatment exists for the grounds of refusal based on public policy/morality. The grounds of refusal based on national emblems/hallmarks exists for all national emblems/hallmarks due to the requirements of the PARIS CONVENTION, *supra* note 3, art. 6 ter.

multi-tiered trademark protection regime throughout the Community after enlargement. A simpler, and more desirable result is possible if the Doctrine of Foreign Equivalents is applied to Community trade marks. For example, Hungary is a candidate state for enlargement. Application of the Doctrine of Foreign Equivalents, under U.S. trademark law resulted in the cancellation of registration of the mark "Ha-Lush-Ka," a phonetic spelling of the Hungarian word for noodles.⁹⁰ Under the current policy for Community trade marks, "Ha-Lush-Ka" could be registered in the European Union and retain trademark rights despite its generic nature after enlargement of the Union to include Hungary. Such an occurrence would seem to present problems for the free movement of goods in the future.

OHIM should adopt the multiple language exception to the Doctrine of Foreign Equivalents in examination of proposed Community trade marks. The underlying reasons for refusing registration of a mark for its descriptive or generic nature are to protect consumers' expectations and to allow competing undertakings the right to call their goods and services by the appropriate names.⁹¹ The Doctrine of Foreign Equivalents protects both interests, when it is limited to the manner in which consumers and competing undertakings communicate, in one language at a time. The refusal of registration of a neologism as lacking distinctiveness due to an interpretation of two English words combined under German rules of grammar seems to miss the point of trademark law, the protection of consumer expectations as to what is a trademark and what is not.⁹²

XII. LIMITATIONS OF THE DOCTRINE OF FOREIGN EQUIVALENTS

The application of the doctrine of foreign equivalents in U.S. trademark law could be improved. This is particularly the case where a mark includes words with meaning in both English and a foreign language, as in "La Yogurt" or "Pizzeria Uno."⁹³ While the multiple language exception to the doctrine fills a purpose, harmonizing trademark law with human communication, this purpose is served only when the application of the exception is rationally limited. An appropriate limitation would exclude marks that consist of words in one language with articles or numbers from another language.

90. *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 846-47 (C.C.P.A. 1961).

91. *See Abercrombie & Fitch Co.*, *supra* note 65, at 9.

92. *See, e.g., Deutsche Krankenversicherungs AG*, *supra* note 43.

93. *See discussions supra* note 69; *infra* note 206. "Pizzeria Uno," if examined as a Community trade mark would probably also be found lacking of distinctive character under the CTMR, the equivalent of "Brand X" in English.

XIII. TRIPS AND DISTINCTIVENESS

The upcoming negotiations of the World Trade Organization on the Agreement on Trade-Related Aspects of Intellectual Property Rights⁹⁴ (TRIPS) may provide a mechanism for harmonization of the treatment of distinctiveness in the Community trade mark and the Trademark Law of the United States. Article 15 of this agreement provides the sole requirement that a sign be capable of distinguishing the goods or services of undertakings to constitute a trademark.⁹⁵ The sole clarification of how a sign may be considered capable of distinguishing goods and services is the allowance for the acquisition of distinctiveness for signs that are not inherently distinctive.⁹⁶ The weakness of the TRIPS agreement is its lack of a definition of "signs [that] are not inherently capable of distinguishing the relevant goods or services."⁹⁷ To correct this weakness, and implement a rational treatment of marks in the global, multilingual environment, the following clarification should be added as Article 15(6) of TRIPS:

(6) Signs consisting of words are not inherently capable of distinguishing the relevant goods or services if they may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.

This addition corresponds to the appropriate portion of the Paris Convention,⁹⁸ and will form the basis for an appropriate analysis of word marks for distinctiveness based on their descriptive nature, leaving a determination of distinctiveness for other reasons to signs that are not words. The bona fide and established practices of the trade form the basis for analysis of word marks in other major languages used in trade with the country where trademark protection is sought and would, reasonably interpreted, include a multiple language exception. It is a bona fide and reasonable practice to use articles from one language with words from another, but in general the use of multiple languages in a single sentence should not be considered an established practice when the "imported" words are not established in the "current" language.

94. TRIPS, *supra* note 7.

95. *Id.* art. 15 at para. 1.

96. *Id.*

97. *Id.*

98. PARIS CONVENTION, *supra* note 5, art. 6 quinquies.

XIV. APPENDIX I—EUROPEAN UNION CASE LAW

An examination of the case law of the European Union regarding the registration of Community trade marks is helpful in illustrating the application of these regulations. Although the European Union is not typically considered a common law jurisdiction, many of the cases discussed below include citations to prior cases in a precedential manner. This renders an examination of the case law almost a necessity.

A. Procter & Gamble Co. v. OHIM⁹⁹

This was an appeal from a refusal to register the mark “Baby-Dry” for disposable diapers.¹⁰⁰ The grounds for refusal were the mark’s lack of a distinctive character and the mark’s descriptive nature.¹⁰¹ In the appeal process before the Board of Appeals, the applicant had attempted to prove that the mark had become distinctive through use, which would overcome these grounds for refusal,¹⁰² but was not permitted to do so.¹⁰³ The court analyzed the nature of the mark and found it to be descriptive.¹⁰⁴ The opinion does not specifically address the lack of a distinctive character, merely noting that the mark was not “capable of distinguishing the applicant’s goods from those of other undertakings.”¹⁰⁵ Ultimately, the court annulled the refusal of registration based on the failure of the Board of Appeals to consider the acquisition of distinctiveness through use.¹⁰⁶ The failure of the court to address the issue of distinctiveness itself presents some problems; a mark that is devoid of distinctive character under Article 7(1)(b) CTMR may acquire distinctiveness through use, while a mark that does not conform to the requirements of Article 4 CTMR (being “capable of distinguishing the goods or services of one undertaking from those of other undertakings”),¹⁰⁷ cannot acquire distinctiveness through use.¹⁰⁸

99. *Procter & Gamble Co.*, *supra* note 78.

100. *Id.* at paras. 2–3.

101. *Id.* at para. 8.

102. Article 7(3) CTMR.

103. *Procter & Gamble Co.*, *supra* note 78, at para. 8.

104. *Id.* at paras. 22–26.

105. *Id.* at para. 27. This follows the wording of Article 4 CTMR, which is the basis for the grounds of refusal of Article 7(1)(a) CTMR.

106. *Id.* at para. 54. Of note, the court does not have the power to remand the case to the Board of Appeals for further consideration, leaving the final resolution of this case to OHIM. *Id.* at para. 53.

107. Article 4 CTMR.

108. Article 7(3) CTMR allows acquisition of distinctiveness through use to overcome the grounds for refusal of Articles 7(1)(b), (c), and (d).

*B. Ford Motor Co. v. OHIM*¹⁰⁹

This case was an appeal from the OHIM Board of Appeals refusal to register the mark "OPTIONS" as a Community trade mark for insurance, warranty, financing, hire-purchase, and lease-purchase services.¹¹⁰ Registration was refused by the examiner based on a lack of distinctive character in both English and French.¹¹¹ Ford appealed to the Board of Appeals, asserting that the mark had been used in Belgium, Denmark, the Netherlands, Portugal, Sweden, and the United Kingdom.¹¹² The appeal to the OHIM Board of Appeals, and the appeal here, argued that the acquisition of distinctiveness through use in the Union would overcome the lack of distinctiveness in part of the Union.¹¹³ The court found for OHIM, clarifying that, to overcome a refusal of registration for descriptiveness or lack of distinctiveness, acquired distinctiveness must be demonstrated in those parts of the Community where these grounds for refusal exist.¹¹⁴

This case is notable for its demonstration of the interpretation of a proposed mark in two different languages, English and French. It was not argued that the mark was a word in English rather than French. This argument would doubtless have failed because the examination for descriptiveness or distinctiveness must be based on the perception of the mark by the consuming public, which would obviously use French in member states using that language. The case is also interesting in its failure to address English or French speaking consumers in other portions of the Community, seemingly implying that descriptiveness must be overcome by acquired distinctiveness in only those Member States where the descriptiveness results in a native language.¹¹⁵

109. Case T-91/99, *Ford Motor Co. v. OHIM*, 2000 E.C.R. II-1925, [2000] 2 C.M.L.R. 276.

110. *Id.* at para. 3.

111. *Id.* at para. 4.

112. *Id.* at para. 5. The mark had been registered in Ireland, the United Kingdom, and Benelux as a word mark (a mark consisting of the word itself, not a printed form of it). *Id.* at para. 13. In the United Kingdom, this registration had required a demonstration of acquired distinctiveness, the form of distinctiveness found lacking in the remainder of the Union by the court in this case. *Id.* In Denmark, the mark was registered in a specific script form, not as a word mark, lending credence to the classification of the mark as descriptive. *See id.* These registrations are unaffected by the Community trade mark application and its refusal. Registration as a Community trade mark would have allowed Ford to assert trade mark rights in the mark throughout the Union based on a single registration, rather than requiring individual registrations for the remaining member states.

113. *Id.* at para. 6, 9.

114. *Id.* at para. 27.

115. The opinion merely discusses descriptiveness of the mark in French, and a lack of acquired distinctiveness through use in France. *Id.* at para. 28. The mark in question

C. Bank für Arbeit und Wirtschaft AG v. OHIM¹¹⁶

This case was an appeal from the OHIM Board of Appeals refusal to register the mark “EASYBANK” for on-line banking services.¹¹⁷ Registration had been refused on the grounds that the mark was devoid of distinctive character and was descriptive in nature.¹¹⁸ The OHIM Board of Appeals had found the mark descriptive with respect to two separate groups of consumers, those in the English-speaking portion of the European Union and those in the market targeted by the mark, who “have knowledge of English, are abreast of the possibilities of modern media and are interested in . . . services offered by an on-line bank.”¹¹⁹ The court disagreed, finding that the mark was not descriptive because it did not describe the kind, quality, quantity, purpose, value, or any other characteristics of the services offered, as required for a refusal on the basis of descriptiveness.¹²⁰

The decision by the Board of Appeal that the mark was not distinctive because it was descriptive was annulled based on the court’s finding that the mark was not descriptive,¹²¹ the basis cited by the Board of Appeals for a finding of non-distinctiveness.¹²²

had been registered nationally in Ireland, a country where English is commonly spoken, but no evidence of use there was presented. *Id.* at paras. 5, 14. Many consumers in other portions of the Community also speak English, notably the large U.S. military presence in Germany and Italy, but also ex patriots from English speaking Member States living in other Member States as part of the consuming public.

116. *Bank für Arbeit und Wirtschaft AG*, *supra* note 42.

117. *Id.* at paras. 2, 6. The application for the trademark was initially for insurance, financial affairs, monetary affairs, banking, banking services, and real estate affairs, but was amended by the applicant. *Id.* at paras. 3, 6.

118. *Id.* at para. 7. Of note in this refusal, the lack of distinctive character was based on the descriptive nature of the mark. *Id.* at para. 37. This directly contradicts the principle that distinctiveness is independent of descriptiveness as espoused by Gastruel and Milford in their treatise. GASTRUEL & MILFORD, *supra* note 28, at 71.

119. *Bank für Arbeit und Wirtschaft AG*, *supra* note 42, at paras. 25–26.

120. *Id.* at para. 29. These requirements are laid out in Article 7.1(c) CTMR, but include the geographic origin or time of rendering of the service as well. Although the mark might arguably be considered descriptive of another characteristic of the service, the ease of use of the service is distinguishable from the example of such a characteristic provided by Examination Guidelines for the Community trade mark, lead-free for petrol. Examination Guidelines, *supra* note 9, at para. 8.4.1.

121. *Bank für Arbeit und Wirtschaft AG*, *supra* note 42, at 37–40.

122. *Id.* at para. 40. The result of this case was merely the annulment of the decision of the OHIM Board of Appeals. The court did not address the subsequent actions to be taken by OHIM, following the precedent of *Procter & Gamble*, in which it was established that the requirement of Article 63.6 CTMR for OHIM to take “necessary measures to comply with the judgment of the” court makes on order from the court unnecessary and beyond the power of the court. *Procter & Gamble Co.*, *supra* note 78, at para. 53.

D. Deutsche Krankenversicherungs AG v. OHIM¹²³

This case was an appeal to the Court of the First Instance of the OHIM Board of Appeals' refusal to register the mark "Companyline" for insurance and financial affairs.¹²⁴ The basis for refusal of registration was the lack of a distinctive nature for the mark.¹²⁵ The Board of Appeals, and the court, found that the coupling of two words that are customary in English-speaking countries without any graphic or semantic modification would be insufficient to make the resulting sign capable of distinguishing goods or services.¹²⁶

The decision is notable for what appears to be the application of foreign grammar rules to English language marks. The official language of this decision was German, as was *Bank für Arbeit und Wirtschaft AG*,¹²⁷ but the treatment of the coupling of common English words in the two cases seems significantly different. This is more clearly seen in the report of the Board of Appeals decision, which discusses the lack of distinctiveness as being due to the use of a generic word with a second word appended as a modifier to describe the services for which the *workkombinationen* is proposed as a mark.¹²⁸ Although there is some logic to refusing registration of this mark based on the interpretation of the mark by an English-speaking German consumer, the mark had already been registered as a national trademark under German law.¹²⁹ The mark was registered in Germany in 1996, and has probably acquired distinctiveness there. Unfortunately, the acquisition of distinctiveness to overcome a lack of distinctive character must hold true throughout the Community.¹³⁰ If a neologism consisting of the combination of two English words must be analyzed as it would be perceived by the English-speaking German population and found to lack distinctiveness based on

123. *Deutsche Krankenversicherungs AG*, *supra* note 43.

124. *Id.* at paras. 2–3.

125. *Id.* at para. 27–29.

126. *Id.* at para. 26.

127. *Bank für Arbeit und Wirtschaft AG*, *supra* note 42.

128. Case R-72/1998-1, *Deutsche Krankenversicherungs' Application*, available in both English and German at <http://oami.eu.int> (last visited Feb. 12, 2003). This is an example of the formation of compound words in German. Compound "words [are] formed by combining two or more separate words. Some of these compounds, particularly the long ones, are not listed in dictionaries." ERNST KOCH & FRANCIS J. NOCK, *ESSENTIALS OF GERMAN* 192 (1957). See also APRIL WILSON, *GERMAN QUICKLY: A GRAMMAR FOR READING GERMAN* 126 (1993).

129. *Deutsche Krankenversicherungs' Application*, *supra* note 128.

130. *Ford Motor Co.*, *supra* note 109, at para. 27.

German construction of a *wortkombinationen*, then surely a similar analysis would be necessary to account for the perception of the neologism by the German-speaking English population. This general rule would require the examination of neologisms proposed as marks applying the grammatical rules of all of the community's languages to words from those languages without regard to their origin.

E. Deutsche Krankenversicherungs AG v. OHIM II¹³¹

This case is another appeal by Deutsche Krankenversicherungs of a Board of Appeal refusal to register a Community trade mark, in this case "EuroHealth" for insurance and financial affairs.¹³² The examiner had refused registration of the mark on grounds of a lack of distinctive character;¹³³ this was amended by the Board of Appeals to include descriptiveness.¹³⁴ The court agreed that the term "EuroHealth" was descriptive in English of health insurance in Europe,¹³⁵ but held that it was not descriptive of financial affairs.¹³⁶ The refusal of registration of the mark was annulled in so far as it applied to financial affairs.¹³⁷ The court examined the determination of the Board of Appeals that the mark was not distinctive and found it to be based solely on the descriptive nature of the mark,¹³⁸ as was the determination of the Board of Appeals in *Bank für Arbeit und Wirtschaft*.¹³⁹

131. Case T-359/99, *Deutsche Krankenversicherungs AG v. OHIM*, [2001] E.T.M.R. 81 [hereinafter *Deutsche Krankenversicherungs AG II*].

132. This appeal was from a refusal by the same Board of Appeals as that in the earlier case. *Id.* at para. 6; *Deutsche Krankenversicherungs AG*, *supra* note 43, at para. 8. The appeals were heard by different chambers of the Court of First Instance; in this case the Second Chamber, which included a Dutch judge and a German judge (nationalities of the judges were determined from the information available at <http://curia.eu.int/en/pres/cvtp.htm> (last visited Oct. 1, 2002); one of the judges listed in the opinion is no longer on the court, but the only new judge since this opinion was written is French. *Id.*). *Deutsche Krankenversicherungs AG II*, *supra* note 131. The earlier case had been heard by the Fourth Chamber, which consisted of a Portuguese judge, a Finnish judge, and an Italian judge.

133. *Deutsche Krankenversicherungs AG II*, *supra* note 131, at para. 4.

134. *Id.* at para. 7.

135. *Id.* at para. 27. Euro is descriptive of the geographic location in which the services would be rendered, and Health is descriptive of the kind of insurance. *Id.* at para. 26.

136. *Id.* at para. 37.

137. *Id.* at para. 50.

138. *Id.* at para. 46.

139. *Bank für Arbeit und Wirtschaft AG*, *supra* note 42, at paras. 37–40. Both of these cases were decided by the same chamber of the court. *Id.*; *Deutsche Krankenversicherungs AG II*, *supra* note 131.

F. Community Concepts AG v. OHIM¹⁴⁰

This case, another appeal of an OHIM Board of Appeals refusal to register a mark, also involved a mark formed by connecting two common English words. The mark was "INVESTORWORLD" for insurance, financial business, monetary (currency) affairs, and property services.¹⁴¹ The mark was refused registration on grounds of descriptiveness and being devoid of distinctive character.¹⁴² On appeal, OHIM acknowledged that the mark was not descriptive.¹⁴³ The court found the mark to be devoid of distinctive character, following the reasoning of *Deutsche Krankenversicherungs*.¹⁴⁴

The result of this case presents some problems in deriving the rule to be applied in determining whether or not a combination of words is distinctive. The mark was registered as a Community trade mark for products and services other than those involved in this appeal.¹⁴⁵ OHIM and the court acknowledged that the mark was not descriptive,¹⁴⁶ but found that it was not distinctive with relation to certain goods and services while it was distinctive with respect to other goods and services.¹⁴⁷ The result is a need to hold the distinctive character of a mark, based on the goods or services to which it refers, to a stricter standard than mere descriptiveness. It appears that this result would prevent the registration of marks that are suggestive in nature.¹⁴⁸

These last four cases may be reconciled by examining the bases for their outcomes. The marks "Companyline" and "INVESTORWORLD" were found to be devoid of distinctive character by both the OHIM Board of Appeals and the Court of First Instance for reasons other than a descriptive nature.¹⁴⁹ The reason underlying this lack of a distinctive character was the combination of two words that lack distinctiveness in

140. *Community Concepts AG*, *supra* note 43.

141. *Id.* at paras. 2–3.

142. *Id.* at paras. 4, 8. Registration of the mark had been allowed in connection with a variety of other products and services not discussed in the opinion. *Id.* at para. 7.

143. *Id.* at para. 14.

144. *See id.*

145. *Id.* at para. 7.

146. *Id.*

147. *Id.* at paras. 21–25.

148. Such marks are inherently distinctive, and registrable, under the trademark law of the United States. *Abercrombie & Fitch Co.*, *supra* note 65. The categories of marks used in the case law of the United States is discussed below.

149. *Deutsche Krankenversicherungs AG*, *supra* note 43; *Community Concepts AG*, *supra* note 43.

relation to the goods or services offered.¹⁵⁰ The marks “EuroHealth” and “EASYBANK,” on the other hand, had not been found to lack distinctive character by the OHIM Board of Appeals on any basis other than a descriptive nature. This leaves the decision to annul the Board of Appeals action in these two cases appearing to be based more on procedural problems in the refusal to register the marks than substantive problems of the marks actually being distinctive.¹⁵¹ The determination that a mark is not distinctive must be based on a lack of a distinctive quality separate from the descriptive nature of the mark.

G. Sunrider Corp. v. OHIM¹⁵²

The mark refused registration in this case was “VITALITE” for use with a wide variety of goods.¹⁵³ The Board of Appeals had refused registration because the mark could be read as the French word “vitalité,”¹⁵⁴ and would therefore be descriptive and lack distinctiveness for many of the goods.¹⁵⁵ The court affirmed this action for the majority of the goods on the basis of descriptiveness, but annulled the action with respect to the goods baby food and mineral and aerated water.¹⁵⁶

The reason the mark was found to be descriptive for the goods was their common nature; all of the goods were to be used for medical, nutritional, or dietetic reasons.¹⁵⁷ It is not wrong to conclude that the intended purpose of these goods is to provide renewed vitality;¹⁵⁸ this meets the criteria for exclusion under Article 7(1)(c) CTMR. OHIM argued that the mark would describe baby food, which is “preservative-free or contain[s] added vitamins and minerals.”¹⁵⁹ The court rejected this argument, finding that the mark was merely evocative of these characteristics.¹⁶⁰

150. *Deutsche Krankenversicherungs AG*, *supra* note 43, at para. 26; *Community Concepts AG*, *supra* note 43, at paras. 21–25.

151. See *Deutsche Krankenversicherungs AG II*, *supra* note 131; *Bank für Arbeit und Wirtschaft AG*, *supra* note 42.

152. Case T-24/00, *Sunrider Corp. v. OHIM*, 2001 E.C.R. II-449, [2001] E.T.M.R. 56.

153. *Id.* at paras. 2–3.

154. *Id.* at para. 8. This reading is possible because capital letters in French are not normally depicted with the accents they would have in lower case. *Id.* The meaning of the word “vitalité” is vitality in English. *Id.*

155. The Board of Appeals permitted registration for milk products and drinks made of milk. *Id.* at paras. 8, 23.

156. *Id.* at paras. 26, 30, 35.

157. *Id.* at para. 25. The goods included pharmaceutical preparations, herbal foods and beverages, and nutritional supplements. *Id.* at para. 8.

158. *Id.* at para. 25.

159. *Id.* at para. 22.

160. *Id.* at para. 22. OHIM additionally argued “such food can give life force or vitality to babies.” *Id.* at para. 22. This would appear to be the equivalent of the purpose of the food, the designation of which by the mark is prohibited by Article 7.1(c) CTMR. The distinction between baby food and the goods for which the mark was refused might

With respect to mineral and aerated water, OHIM pointed out the common use of health, sport, and a general sense of well-being in advertising, which would render the mark descriptive.¹⁶¹ The court rejected this argument as demonstrating that the mark would be suggestive of an image attributed to the goods rather than their purpose.¹⁶²

The court annulled the finding of the Board of Appeals that the mark was devoid of distinctive character with respect to baby food and mineral and aerated water because it was based solely on the mark's descriptive character.¹⁶³ However, it did not clearly address the distinctiveness of the mark with relation to the goods for which it was refused registration.

The applicant argued that the mark was registered as a trademark in fifteen countries in Europe, twelve of which were Member States, and therefore registration should be permitted.¹⁶⁴ The court rejected this argument due to the difference between the Community trade mark registration and the nature of the mark as registered, and the goods for which it was registered, in the national registrations.¹⁶⁵ The applicant could have argued that prior use of the mark, rather than prior registration, with respect to the goods resulted in acquisition of distinctiveness and overcame the mark's descriptiveness.¹⁶⁶ This argument was not offered.¹⁶⁷

H. Taurus-Film GmbH & Co. v. OHIM¹⁶⁸

The mark refused registration in this case was "CINE ACTION" for a wide variety of goods and services involving entertainment.¹⁶⁹ The basis for refusal to register the mark was a lack of distinctiveness and the descriptiveness of the mark. The court affirmed the action of the Board of

be the lack of specifically identified supplementation of the baby food to give it a beneficial nature.

161. *Id.*

162. *Id.*

163. *Id.* at para. 29.

164. *Id.* at para. 31. This argument was offered based on the preamble of an earlier Council Directive, which stated that the protection of registered trade marks of one member state should be provided in other member states to promote the free movement of goods. *Id.* at para. 32. See also, First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, 1989 O.J. (L40).

165. *Id.* at para. 34.

166. Article 7.3 CTMR

167. See *Sunrider Corp.*, *supra* note 152.

168. See *Taurus-Film GmbH & Co.*, *supra* note 44.

169. *Id.* at paras. 2, 10.

Appeals with respect to many of the goods and services for which registration of the mark was requested,¹⁷⁰ finding that “CINE” would mean film or cinema to speakers of English, French, Italian, and German.¹⁷¹ The combination of “CINE” and “ACTION” would therefore have the meaning “action film” and be descriptive of the goods and services with the exception of those not involving action films.¹⁷² Although the word “action” is native to the English tongue, and the word “cine” was found to signify film in English by the court and the Board of Appeals,¹⁷³ it does not appear to be entirely clear that “CINE ACTION” would mean action films in English. This finding seems the result of the application of a multilingual interpretation of the phrase.

The court’s discussion of the problem of a distinctive nature for the mark is based entirely on the descriptive nature of the mark.¹⁷⁴ OHIM’s refusal to register the mark was annulled with respect to those goods not involving action films because the descriptiveness of the mark for action films would not render the mark void of distinctiveness for these goods.¹⁷⁵ The court’s analysis of the distinctiveness of the mark resembled that conducted for the marks “EuroHealth” and “EASYBANK,” with the annulment of a finding of non-distinctiveness resulting from the reliance on descriptiveness of the mark.¹⁷⁶

I. *Harcourt Brace & Co.’s Application*¹⁷⁷

This case is an appeal before the First Board of Appeal for OHIM of the examiner’s refusal to register the mark “IDEAL” for access to an electronic database of journal articles.¹⁷⁸ The examiner refused registration of the mark due to a lack of distinctiveness because it

170. *Id.* at para. 26.

171. *Id.* at paras. 19, 26.

172. *Id.* at paras. 26, 28. These goods and services included rights of access to communication networks, quiz shows, technical consulting, etc. *Id.* at para. 28. The Board of Appeals had found that the word “ACTION” was used colloquially in modern German to mean “action film,” which would render the mark in German “a clear and unmistakable indication of . . . action films.” *Id.* at para. 8. This reasoning would support a refusal of registration under Article 7(1)(d) CTMR for which colloquial usage seems more apt. Article 7(1)(d) CTMR.

173. *Id.* at para. 26.

174. *See id.* at paras. 22–25, 30, 31.

175. *Id.* at para. 31.

176. Of note, all of these marks were examined by the Second Chamber of the Court of First Instance, and the marks “Companyline” and “INVESTORWORLD” had been examined by the Fourth Chamber of the court. *Id.*; *Bank für Arbeit und Wirtschaft AG*, *supra* note 42; *Deutsche Krankenversicherungs AG*, *supra* note 43; *Deutsche Krankenversicherungs AG II*, *supra* note 131; *Community Concepts AG*, *supra* note 43. Although it is possible that the disparate results are due to the examination by different chambers, the citation of precedent in all of these opinions demonstrates a leaning towards common law principles that argues for unification of the rule to be derived from the cases.

177. Case R 130/1999–I, *Harcourt Brace & Co.’s Application*, [2000] E.T.M.R. 382.

178. *Id.* at 385.

described the services for which the mark was applied.¹⁷⁹ The appeal was based on acquired distinctiveness of the mark, and the nature of the mark as an acronym rather than a word.¹⁸⁰

The Board of Appeals upheld the action of the examiner in refusing registration of the mark for its descriptiveness and lack of distinctiveness, but remitted the case to the examiner for a determination of acquired distinctiveness.¹⁸¹ The Board found descriptiveness in the mark by referring to the dictionary definitions of "ideal" in English, German, Spanish, and Portuguese; these definitions pointed to the use of the word in all of the languages as descriptive of the high quality of the item being described.¹⁸² The mark was found to lack distinctiveness because "it cannot distinguish one undertaking's services from those of other undertakings which might also wish to emphasize the superior quality of their services."¹⁸³ The Board rejected the characterization of the mark as an acronym because this ruling would have allowed registration of any non-distinctive or descriptive mark merely by arguing that the mark is an acronym.¹⁸⁴

XV. APPENDIX 2—CASE LAW UNDER THE TRADEMARK ACT OF THE UNITED STATES

Because of the common law tradition of the United States, it is necessary to examine the case law to fully understand the law of the United States. *Abercrombie & Fitch Co. v. Hunting World, Inc.*,¹⁸⁵ provides the conceptual framework followed in the assessment of distinctiveness of a mark. Distinctiveness is evaluated along a spectrum ranging from generic as the least distinctive, to descriptive, suggestive,

179. *Id.* This refusal was under Article 7(1)(b) CTMR, distinctiveness, rather than Article 7(1)(c) CTMR, descriptiveness, for reasons that are not clear in the report.

180. *Id.* at 388. "IDEAL" is an acronym for "International Digital Electronic Access Library." *Id.* at 388. The appeal also stated that "IDEAL" could be applied to any good or service and would not be descriptive of the service applied for. *Id.* This does not address the descriptiveness of the quality of the service, which would be grounds for refusal of registration under Article 7(1)(c) CTMR.

181. *Id.* at 391–99.

182. *Id.* at 391.

183. *Id.* This phrasing of the lack of distinctive character of the mark is lifted almost verbatim from Article 4 CTMR, which describes signs that may be used as Community trade marks. Article 4 CTMR.

184. *Id.* at 391–92.

185. *Abercrombie & Fitch, Co.*, *supra* note 65.

and finally arbitrary or fanciful as the most distinctive.¹⁸⁶ The assessment of a mark's place on the spectrum provides the basis for determining the protection available to marks in foreign languages as well as English language marks.

A. *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*¹⁸⁷

The plaintiff in this case was the owner of four trademarks for the word "otokoyama", and won a preliminary injunction against use of the mark by the defendant.¹⁸⁸ The defendant counterclaimed, seeking cancellation of the trademarks.¹⁸⁹ The District Court excluded evidence that "otokoyama" is a generic term in Japanese for a type of sake.¹⁹⁰ The Court of Appeals held the exclusion of this evidence an error, applied the Doctrine of Foreign Equivalents, and vacated the granting of the preliminary injunction.¹⁹¹

B. *Orto Conserviera Sameranesi di Giacchetti Marino & Co. v. Bioconserve, S.R.L.*¹⁹²

This case involved the use of the phrase "Bella di Cerignola" as a trademark for a type of olive grown in the vicinity of the town Cerignola in the province of Puglia, Italy.¹⁹³ The court examined evidence that established the phrase was used in Italy for this type of olive, rendering this phrase generic for the olives.¹⁹⁴ The court alternatively found the phrase descriptive;

186. *Id.* at 9. Of note, this opinion provides a discussion of the genesis of the suggestive category, which is missing in the CTMR. In the trademark law of the United States prior to the current Trademark Act, acquisition of distinctiveness was not possible for marks that were merely descriptive. *Id.* at 10. The courts created the category of suggestive marks to overcome this obstacle for marks that seemed neither descriptive nor fanciful, but required "imagination, thought and perception to reach a conclusion as to the nature of [the] goods." *Id.* at 10–11 (quoting *Stix Products, Inc. v. United Merchants & Manufacturers Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

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

188. *Id.* at 268–69. The four separate trademarks were in the word "otokoyama" depicted in the three Japanese writing systems, Kanji (Chinese characters), Katakana (Japanese phonetic characters), and Hiragana (Japanese phonetic characters for foreign words), as well as in the English transliteration (Romaji). *Id.* at 269.

189. *Id.* at 268.

190. *Id.* at 269. This type of sake is specifically a "dry, manly sake." *Id.* at 271.

191. *Id.* at 270. The defendants had also argued that the registration of the trademarks had been obtained fraudulently due to the refusal of the plaintiff to supply translations of the marks. *Id.* at 269, 273. The district court ultimately decided the case in favor of the defendants on the grounds that the mark was generic; this decision was affirmed on appeal. *Otokoyama Co. LTD., v. Wine of Japan Import, Inc.*, 7 Fed. Appx. 112 (2d Cir. 2001).

192. *Orto Conserviera Sameranesi di Giacchetti Marino & Co.*, *supra* note 67.

193. *Id.* at 2013. It is not clear from the opinion what the plaintiffs and defendants sought, merely that the defendants had applied for the trademark and counterclaimed against the plaintiffs' suit for unfair competition, false marketing, and trademark misuse.

194. *Id.*

"one need not be an Italian scholar to recognize that 'Bella di Cerignola' means beauty of or from Cerignola."¹⁹⁵ In either case, the mark fell too low on the spectrum of distinctiveness to warrant protection. This seems an application of the Doctrine of Foreign Equivalents, with the court treating Italian as a major foreign language.

C. Enrique Bernat F., S.A. v. Guadalajara, Inc.¹⁹⁶

The defendant in this case appealed a preliminary injunction forbidding the sale of "Chupa Gurts", a frozen-yogurt flavored type of lollipop, due to the similarity with the plaintiff's registered trademark "Chupa Chups" for lollipops.¹⁹⁷ The court of appeals examined the use of the word "chupa" in a variety of Spanish speaking countries, and found that it was commonly used to refer to lollipops.¹⁹⁸ Because "chupa" is a generic term, the Doctrine of Foreign Equivalents prevents the granting of trademark protection to this portion of the mark.¹⁹⁹ The court of appeals vacated the granting of a preliminary injunction by the district court as an abuse of discretion because it had been based on an erroneous likelihood of confusion analysis comparing "Chupa Chups" and "Chupa Gurts" rather than comparing the non-generic portions of the two marks, "Chups" and "Gurts."²⁰⁰

D. Pizzeria Uno Corp. v. Temple²⁰¹

The plaintiff in this case brought suit for infringement of the registered trademark "Pizzeria Uno" against the proprietor of "Taco Uno", a mark for which registration was sought.²⁰² The district court had found the registered mark to be merely descriptive and therefore not entitled to protection absent a showing of secondary meaning.²⁰³ The district court

195. *Id.* Of course, it is helpful to be an Italian scholar, or at least familiar with the Italian language.

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

197. *Id.* at 441.

198. *Id.* at 443-44. The district court had found that "chupa" primarily meant "to lick" or "to suck", but failed to address the common or slang usage of the term. *Id.* at 443.

199. *Id.* at 445.

200. *Id.*

201. *Pizzeria Uno Corp.*, *supra* note 69.

202. *Id.* at 1524-25.

203. *Id.* at 1526. This finding was based on the decision of the trademark examiner to publish the second mark, which would allow an opportunity for comment by anyone who believed they would be damaged by the use of the mark. *Id.* at 1525.

found an absence of secondary meaning, and held for the defendant.²⁰⁴ The Court of Appeals reversed this holding, finding that the mark “Pizzeria Uno” was suggestive rather than descriptive.²⁰⁵ This reversal was based, in part, on application of the Doctrine of Foreign Equivalents; “uno” is not descriptive of “the best” pizzeria or taco stand.²⁰⁶

This opinion is more valuable for its discussion of the limitations on the Doctrine of Foreign Equivalents than it is for its result. These limitations arise when a foreign word or phrase is commonly used in English with a meaning different than its literal meaning.²⁰⁷ Thus, the French word “Repechage” and the French phrase “Le Cordon Bleu” are not the equivalent of “Second Chance” and “Blue Ribbon,” their respective literal translations.²⁰⁸ The Doctrine seems to have other limitations not discussed in this opinion; the Doctrine requires a showing of secondary meaning, or acquired distinctiveness, for foreign words that are descriptive, but does not clearly specify where this must be shown.

E. *In re Johanna Farms, Inc.*²⁰⁹

This case involved an appeal of the refusal to register the mark “LA YOGURT”.²¹⁰ The registration had been refused based on the generic nature of the mark in French.²¹¹ The Trademark Trial and Appeal Board found that the mark was not generic in French because it was a combination of an American-English word combined with the French article “la.”²¹² Combining words from different languages creates a different commercial impression and renders Doctrine of Foreign Equivalents inapplicable to the resulting mark.²¹³

The inapplicability of the Doctrine of Foreign Equivalents to marks resulting from a combination of languages had been established in prior

204. *Id.* at 1526.

205. *Id.* at 1533.

206. *Id.* The district court had found that “uno” is commonly used in the English language, apparently with the colloquial meaning “the best” due to the presence of the word in a dictionary. The appellate court looked in the dictionary cited and found that the meaning in the main portion was “United Nations Organization,” while the Italian word “uno” is translated in the Italian-English section as the article a or an, and the number one. *Id.* at 1533.

207. *See id.* at 1532.

208. *Id.* (discussing *In re Sarkli, Ltd.*, 721 F.2d 353 (Fed. Cir. 1983) and *Continental Nut Co. v. Le Cordon Bleu*, 494 F.2d 1395 (C.C.P.A. 1974)).

209. *In re Johanna Farms Inc.*, *supra* note 69.

210. *Id.* at 1409.

211. *Id.* The proper generic word for “the yogurt” in French would be “le yogurt”. *Id.* at 1414 (Simms, Member, dissenting).

212. *Id.* at 1413.

213. *See id.* at 1413.

cases,²¹⁴ but seems a weak argument in this case due to the fact that yogurt is also a French word.²¹⁵ It was merely the fact that an improperly gendered article was used in the phrase that enabled the mark to be registered.²¹⁶ Allowing registration of a mark based on improper application of grammatical rules of the language of the mark to its construction seems improper.²¹⁷ This is particularly troublesome when the grammatical error is the use of an incorrect article, a not wholly uncommon occurrence in everyday speech.

*F. French Transit, Ltd. v. Modern Coupon Sys., Inc.*²¹⁸

The defendant in this trademark infringement suit moved for summary judgment that the registered mark "LE CRYSTAL NATUREL" was descriptive and therefore invalid.²¹⁹ This argument was based on application of the Doctrine of Foreign Equivalents.²²⁰ The court declined to apply this Doctrine under the reasoning of *In re Johanna Farms, Inc.* because the mark consisted of one English word and two French words,²²¹ and denied the motion for summary judgment.²²²

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214. See, e.g., *In re Universal Package Corp.*, 222 U.S.P.Q. 344 (T.T.A.B. 1984).

215. See *In re Johanna Farms, Inc.*, *supra* note 69, at 1411. Although the Board recognized that the "yogurt" is a word in French as well as English, the Board treated the word as English.

216. *Id.* at 1414 (Simms, Member, dissenting).

217. *Id.* (Simms, Member, dissenting). The result of this case is rendered further suspect by examination of the mark in Italian. The word yogurt is a foreign word imported to the Italian language for which the feminine article is used. The phrase "la yogurt" would therefore be generic in Italian.

218. *French Transit, Ltd.*, *supra* note 68.

219. *Id.* at 636-37.

220. *Id.* at 636.

221. *Id.* The French word for "crystal" is "cristal".

222. *Id.* at 640.

