



Trade Marks and Languages

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Abstract

My presentation will be focused on three main points for discussion:

- 1) The challenges for EUIPO to assess the descriptiveness of a trademark in a working environment with 24 languages. We will mention personal cases such as EU Trademark Application No. 11966769 “MAPP” filed in July 2013, where we are still fighting to overcome objections on descriptiveness. First it was refused because in Swedish and Estonian it means “portfolio”. We managed to overcome this objection in appeal by proving that in such languages this is not used to refer to portfolio in the computer sector. Then we received an objections where the Examiner argued that it would be perceived by an abbreviation of “mobile applications”, we restricted the list, won the appeal and now it is back again with the Examiner. Other examples are those of EU Trademark Application No. 4453668 “MARA” for footwear (class 25), which was rejected because it means “woman” in Maltese language, but a few years later was accepted for footwear (EU Trademark No. 14273461 MARA, in class 25
- 2) Linked to the above, we will then focus on the criteria to follow in cases of non-official languages of the EU. For instance, EUTM-4917274 “YAKISOBA” (now facing cancellation proceedings) was registered for “noodles” in 2007 despite being a Japanese word for this product and being widely used in the EU. We will then refer to minority EU languages such as Catalan, which is not an official EU language (only official in Spanish territories) but are spoken by a large community, larger than the population of many EU Member States. We will mention Case T-72/11, where the General Court upheld the findings of the examiner who refused to register the name ESPETEC for goods in Class 29, namely “dry and raw pork meat sausage” on the grounds that in the Catalan language, “espetec” refers to the Spanish equivalent of a pork sausage called “fuet” and cannot be registered because it is descriptive in the meaning of Article 7(1) (c) CTMR
- 3) Finally, we will focus on enforcement and the criteria that Courts must follow in cases of trademark infringement where the coincident element is descriptive in a language of the EU but not in others. We will refer to the request for preliminary ruling from the higher regional court (Oberlandesgericht) Duesseldorf under Article 267 TFEU in the matter combit Software GmbH / Commit Business Solutions Ltd (Case C-223/15) of 22 September 2016. The German Court of Appeals took the position that the use of the designation "Commit" caused a likelihood of confusion with the trademark "combit", on part of the average German consumer, it found, in turn, that there was no likelihood of confusion on part of the average English-speaking consumer as the latter could easily understand the conceptual difference between the English verb "to commit" and the word "combit" as "combit" is made up of the letters "com" (for computer) and "bit" (for binary digit). The Oberlandesgericht Duesseldorf decided to stay the proceedings and to refer – in essence – the following question to the CJEU for a preliminary ruling. In the opinion of the court, under Article 102(1) of Regulation No 207/2009, a court which has made the finding that likelihood of confusion does only exist in one part of the European Union must issue an order prohibiting the defendant from proceeding with acts which infringe or would infringe the EU trademark. While "special reasons" may lead to a different conclusion, the

Court of Justice had always held that an exception must be interpreted strictly and covering only certain exceptional situations which are not an issue in this case. Further, in order to guarantee the uniform protection of the EU trademark the prohibition must, as a rule, extent to the whole area of the European Union. However, in line with the court's judgment of April 12, 2011, DHL Express France (C-235/9, EU:C:2011:238), where an EU trademark court finds that the use of a similar sign for identical similar goods does not, in a given part of the European Union, create a likelihood of confusion, the court must limit the territorial scope of the prohibition, thereby identifying with precision in respect of which part of the European Union it finds that is does not adversely affect the functions of trademark. The court states that it must be absolutely clear from the order issued under Article 102 of Regulation No. 207/2009 which part of the Union is not covered by the prohibition on using the sign in question. In the given case, the court must therefore exclude from the prohibition on use certain linguistic areas of the European Union such as those designated by the term "English-speaking", thereby stating comprehensively which areas it intends at term to cover. We will also refer to a case from the Spanish EUTM Courts ("BUSINESS MAIL").