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# The semiotics of descriptiveness

- An analysis of the registrability of neologisms  
as trade marks in the European Union

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# Summary

The trademark regime of the European Union prohibits the registration of marks that are descriptive of the goods or services, or their characteristics, for which the mark is applied. This has been interpreted as a sub-group of the general prohibition of marks that lack distinctiveness and that thusly cannot fulfil the essential function of trademarks, i.e. identifying origin.

However, while some issues have been at least partly resolved, such as the relationship of the distinctiveness and the descriptiveness provision, many uncertainties remain. This is particularly true of how neologisms are to be assessed; the Union Courts have failed to come up with rules of any precision for the examination of neologisms. Rather the yardsticks given are very vague: ‘any perceptible difference’, ‘more than the sum of its parts’, ‘an impression sufficiently far removed’. It is argued in this paper that this may be not because of any reluctance or inability of the Union Courts, but rather an impossibility of formulating precise rules that are generally applicable. Therefore, this paper argues for the importance of formulating a comprehensive and predictable framework for dealing with these issues.

To achieve this, a semiotic analysis of trademark distinctiveness and descriptiveness is made, which informs the reading of the case law. The importance of a semiotic model is argued on the basis of a human rights framework. As a result this paper suggests that the examination deals with the first two points of view described by the case law separately, and that these two be seen as the two axes in the suggested semiotic spatial model.

Secondly, it has been suggested that the third point of view, that is the relevance of the degree of essentiality of the characteristic described, remains relevant, and that it was not, and should not be, completely done away with by the case law. Thirdly, it has been concluded that the aural impression is relevant under the first point of view, but that the finding of a completely different meaning under the second point of view may make the sign registrable. In other words, the first point of view is given an auxiliary importance in relation to the second. Fourthly, it has been argued that the Union Courts need to perform a full descriptiveness analysis of any potentially descriptive elements, even when the sign falls to be examined under (b) because of the existence of non-descriptive elements. Lastly, the coherency of a public interest underpinning (c) has been defended.

# Sammanfattning

Varumärkesrätten inom den Europeiska Unionen förbjuder registreringen av varumärken som är beskrivande för varan eller tjänsten, eller en av dess egenskaper, för vilket varumärket ansöks. Kravet har ansetts vara en undergrupp till det generella kravet på att ett varumärke måste ha särskiljningsförmåga, som krävs för att uppfylla det grundläggande syftet med varumärken, nämligen att identifiera ursprung.

Emedan vissa frågor har lösts åtminstone delvis, som relationen mellan kravet på icke-beskrivande och kravet på särskiljningsförmåga, återstår många osäkerheter. Det är i synnerhet sant för frågan hur neologismer ska bedömas och Unionsdomstolarna har inte lyckats formulera konkreta och tydliga regler för hur bedömningen ska göras. De tumstockar som har skapats är synnerligt vaga. I uppsatsen föreslås att detta inte beror på varken en ovillighet eller en oförmåga hos domstolarna, utan snarare på en omöjlighet att formulera precisa regler som förblir generellt applicerbara. Med grund i detta, förespråkas vikten av att skapa ett heltäckande och förutsebart ramverk för att hantera bedömningen av dessa märken.

För att uppnå detta har en semiotisk analys av kravet på särskiljningsförmåga och på ”icke-beskrivande” företagits, och som sedan utgör en grund för en djupare genomgång av rättsfallen. Vikten av att använda sig av en semiotisk analys påvisas med hjälp av ett ramverk för de mänskliga rättigheterna. Som ett resultat förespråkas att båda de perspektiv som identifieras i rättsfallen ges en separat bedömning, och att dessa två perspektiv ska ses som de två dimensionerna i den semiotiska spatiala modell som föreslagits.

Vidare föreslås att det tredje perspektivet, dvs. relevansen av hur viktig den beskrivna egenskapen är i förhållande till produkten, alltså är av intresse, och att det perspektivet inte blev, och inte heller borde bli, avfärdat i praxis. För det tredje föreslås att ljudbilden är relevant under det första perspektivet, men att fall där det visuella intrycket trots likhet i ljudbilden ändå skapar en markant skild mening, alltså ska vara registrerbara. Med andra ord förelås att det första perspektivet ges en underordnad och stödjande betydelse i förhållande till det andra. För det fjärde föreslås att domstolarna måste utföra en full beskrivandeanalys även vid märken som inte ska bedömas under kravet på icke-beskrivande då de innehåller andra element än beskrivande. Slutligen argumenteras det att det i kontrast med viss kritik, inte finns en motsättning i att icke-beskrivandekravet är underordnat kravet på särskiljningsförmåga samtidigt som det motiveras av ett eget intresse.

# Preface

I would like to thank my supervisor Ulf Maunsbach and OHIM for the opportunity to write this thesis as part of the OHIM Universities Network. I would also like to thank Anna Maria Andersen Nawrot at the Raoul Wallenberg Institute of Human Rights and Humanitarian Law for giving me her time and helpful suggestions.

I am further grateful to Gao Hang at WIPO, and once more to both Ulf Maunsbach and Anna Maria Andersen Nawrot, for providing the opportunity to intern at WIPO during the writing of my thesis, which although partly diverting my attention from the thesis, also helped me gain some new insights and sources for the continuance of my work once back in Lund. I would also thank all the helpful delegates during the conference of the Standing Committee on Trade Marks, who used their coffee breaks and lunches to explain to me their points of view on my topic.

Lastly, I would like to thank Gregor Schneider at OHIM for providing a topic which I would not have found by myself, and which turned out to be much more interesting throughout than I dared hope.

It has been challenging, and at times stressful, but always interesting.

*- It was the best of times, it was the blurst of times.*

# Abbreviations

AG	Advocate General
CTM	Community Trade Mark
CTMR	Community Trade Mark Regulation
ECHR	European Convention on Human Rights
ECJ	European Court of Justice
ECtHR	European Court of Human Rights
GC	General Court
n.y.r.	Not yet reported
OHIM	Office for the Harmonization of the Internal Market
TMD	Trade Mark Directive
USPTO	US Patent and Trademark Office
WIPO	World Intellectual Property Organization



# 1 Introduction

## 1.1 Background

The case law of the Union Courts<sup>1</sup> regarding the provisions on distinctiveness<sup>2</sup> has at times been criticised for not articulating a sufficiently clear view and sometimes even for formulating incompatible ideas.<sup>3</sup> In one article, the author suggests that it seems legitimate to question the very stability of the examination system itself.<sup>4</sup>

There are controversies regarding both the relationships between and the purposes of the different provisions, as well as regarding the requirements of the provisions.<sup>5</sup> Furthermore there are differences between EU member states despite the efforts of harmonization.<sup>6</sup> Even the Board of Appeal of OHIM has articulated the difficulties involved.<sup>7</sup>

This uncertainty is deleterious to trademark owners and applicants where it can be difficult to foresee the registrability of possible trademarks, and even the longevity of a registered trademark.<sup>8</sup> As will be argued, it may also have a greater negative impact in how it affects the use of language. A difference in treatment between member states, between member states and OHIM, or even between examiners within a state or OHIM, may also have a forum shopping effect. The loss for national offices of trademark applications to OHIM has been noted as a possibly negative development,<sup>9</sup> and differences in treatment may lead to more negative effects of this nature.

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<sup>1</sup> The terminology introduced by the Treaty of Lisbon will be used. Thus, the former Court of First Instance ("CFI") is referred to as "the General Court" and the European Court of Justice ("ECJ") is referred to as "the Court" or ECJ, even in relation to case law predating the Treaty of Lisbon.

<sup>2</sup> With the provisions on distinctiveness is meant Art. 3(1)(b)-(d) and Art. 7(1)(b)-(d) of the Directive 2008/95/EEC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ L 299, 8.11.2008 p. 25–33) (the Directive or TMD), and the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ L 78, 24.3.2009, p. 1–42) (the Regulation or CTMR) respectively. They may also be referred to collectively as the provisions under review.

<sup>3</sup> M. Handler, 'The distinctive problem of European trade mark law', 27:9 *European Intellectual Property Review* (2005), p. 312.

<sup>4</sup> I. Simon, 'Trade marks in trouble', 27:2 *European Intellectual Property Review* (2005), p. 72.

<sup>5</sup> See I. Simon, *supra* note 4, and M. Handler, *supra* note 3.

<sup>6</sup> Study on the Overall Functioning of the European Trade Mark System (Allenbach Study), 15 February 2011, Max Planck Institute for Intellectual Property and Competition Law Munich, <[http://www.ip.mpg.de/shared/data/pdf/mpi\\_final\\_report.pdf](http://www.ip.mpg.de/shared/data/pdf/mpi_final_report.pdf)>, last visited on 17 May 2011, §§ 9-14, § 74. The consistency of OHIM is rated higher than the consistency of national offices.

<sup>7</sup> See I. Simon, *supra* note 4.

<sup>8</sup> I. Simon, *supra* note 4, p. 75.

<sup>9</sup> Allenbach study, *supra* note 6.

For these reasons, it is important to create both clarity and uniformity in the application of the descriptiveness provision.

## **1.2 Purpose**

The aim of this paper is to analyze the descriptiveness provision in Article 7(1)(c) CTMR<sup>10</sup> as applicable to the registration of neologisms as trademarks. The purpose of this is two-fold.

The first is to review and, where necessary, clarify the requirements as they have been expressed by the Union Courts.

The second is to analyze the coherency of the conclusions drawn from the case law. This will be done mainly from a semiotic perspective. As will be argued under chapter 3, incorporating a semiotic understanding in trademark law is of importance not only for trademark applicants but for all. As the Union Courts have not been able to bring clarity to how the provision is to be applied, this paper aims to suggest a clearer framework for dealing with the issue and, if necessary, suggest concrete changes to how the provision has been applied, in order to be reconciled with the semiotic analysis.

## **1.3 Methodology**

The focus is on European trademark law, whether it be national trademarks or community trademarks. Thus, the case law of the Union Courts will be the primary point of departure. This will be complemented by relevant sources of law and legal doctrine. Part of this paper thusly uses a traditional dogmatic method.

However, the results will be analyzed and criticised, not only from a legal perspective, but also from a perspective of semiotics. Thus in chapter 2, a semiotic analysis of trademark law is performed. This part, then, falls outside of the traditional dogmatic method. Furthermore, in chapter 3 a human rights framework will be used to show the importance of the semiotic perspective.

## **1.4 Sources**

As stated, the case law of the Union Courts will be the primary point of departure. This is complemented by doctrine, and by the examination guidelines of both OHIM and USPTO (US Patent and Trade mark Office) for purposes of a comparative view.

For the semiotic analysis, both general sources on semiotics as well as sources on semiotics in relation to trademark law is used.

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<sup>10</sup> Henceforth, the descriptiveness provision, or just (c).

As regards the use of the OHIM Examination Guidelines the following can be said. While the national offices consider the Examination Guidelines as a reference source, they do not regard these guidelines as legally binding, and put more emphasis on national and Union Courts decisions.<sup>11</sup> As the guidelines have an informative value it will be used in this respect throughout this paper, particularly to give examples and flesh out the case law, but any (potential) inconsistencies between the guidelines and the case law, will be duly noted and analyzed where found.

This is also part of the reason for why this paper does not deal directly with the case law of OHIM itself, upon which the guidelines partly are based. As this paper aims to analyze what the Union Courts have said regarding the descriptiveness provision, and what requirements this puts on the examination of marks, the case law of OHIM, as well as that of national trademark offices, falls outside the scope of this paper, and does not play more than a supportive role; as with the Examination Guidelines.

## **1.5 Terminology and delimitations**

### **1.5.1 Terminology**

With the term neologism is meant words not found in dictionaries, regardless of whether they are made up of words that are found in dictionaries or not.

Whereas, generally, only the term ‘goods’, or even ‘products’ will be used, it should be understood to include services as well.

Italics are used for emphasis, Latin expressions and for key linguistic terms. In chapter 2, word marks are written in capitals so as to distinguish this use from other uses. This is not repeated in later chapters in order to make clear the stylization or capitalization of the elements of the word marks found in the case law. As an example, with the word mark ‘BioID’ the capitalization of ‘ID’ would only barely be perceivable if written BIOID.

### **1.5.2 The trademark directive and the regulation**

This paper will mainly refer to the provisions in the CTMR, and if nothing else is stated when referring to articles, henceforth it is CTMR that is referenced, but since the provisions under review are the same in the TMD, the conclusions are equally applicable to the Directive.<sup>12</sup> One important difference is Art. 7(2) of the CTMR, which states that it is sufficient for non-registrability that the grounds in 7(1) are applicable only in part of the Community.

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<sup>11</sup> See Allenbach study, *supra* note 6, p. 23.

<sup>12</sup> See AG Jacobs in Case C-191/01 P *Doublemint* [2003] ECR I-12447, para. 16.

Article 7(1)(b) CTMR will also be referred to as the provision on distinctiveness, 7(1)(c) as the provision on descriptiveness, and 7(1)(d) as the provision on customariness. As stated above, they will be referred to collectively as the provisions on distinctiveness.

Article 4 of the CTMR corresponds to Article 2 of the TMD. Article 7 of the CTMR corresponds to Article 3 of the TMD. In quotations the original articles will be used, but since Articles 2 and 3 of the CTMR will not be discussed, it will be clear when the quotes refer to the TMD.

### **1.5.3 Delimitations**

The question of acquired distinctiveness is outside the scope of this paper, as are the absolute grounds for refusal found in Article 7(1)(e)-(k) CTMR, and the relative grounds for refusal. Even though Article 12 is related to Article 7(1)(c), it will not be discussed except where relevant for the analysis of the provisions under review.

## **1.6 Outline**

The paper begins with a semiotic analysis, enabling a semiotic reading of the trademark regime.

Chapter 3 describes a human rights based framework and is mainly intended to point to the importance of understanding trademark law from a semiotic perspective.

Chapter 4 describes the development of a European trademark regime, with a focus on its justifications and purposes. Then follows a short description of the requirements for registering a trademark in order to put the provisions in Art. 7 CTMR in their context. The relationships and objectives of Art. 7(1)(a)-(d) will be analyzed particularly, and this will inform the reading of the case law.

In chapter 5 follows a review of the case law in regards to neologisms. Other relevant case law will also be analysed where appropriate.

Chapter 6 will then conclude with an analysis and critique of the case law. This critique will be informed primarily by the semiotic analysis, but will also be based in legal doctrine and a close reading of the case law.

## 2 The semiotics of distinctiveness and descriptiveness

While analyzing the descriptiveness and distinctiveness provisions, the Union Courts have been forced to discuss questions of language, analyzing whether a neologism has a ‘syntactically unusual juxtaposition’,<sup>13</sup> or includes a ‘semantic modification’.<sup>14</sup>

In linguistics *syntax* is the part of grammar which deals with the arrangement of words in sentences, and an important part of syntax is the order of words.<sup>15</sup> *Semantics* is the study of the meaning of words.<sup>16</sup> *Semiotics* is an even wider term, being the study of signs, words being only one type of sign.<sup>17</sup> The semiotic tradition defines the sign functionally, that is by what it does, and not by what it is.<sup>18</sup> In its widest sense, it is a study in communication, or the transfer of information.<sup>19</sup>

### 2.1 Semiotics

Defining semiotics is not completely straightforward. A loose definition has been given above, but it may be helpful to dig just a little bit deeper. Semiotics *may* mean either the specificity of human semiosis, or the general science of signs.<sup>20</sup> *Semiosis* is the name given to the actions of signs. Semiotics might thusly be understood as the study of semiosis or even metasemiosis.<sup>21</sup> Semiotics has been described as a discipline or science, as a theory, and as a doctrine.<sup>22</sup> An example of semiotics is medical semiotics, which is the study of symptoms.<sup>23</sup> The study of verbal signs, whether they be oral or written, is unique in that the signs carry out nothing other than a sign function (in contrast to medical symptoms).<sup>24</sup> Although not only verbal signs are relevant in trademark law, it is with verbal signs that this paper is preoccupied.

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<sup>13</sup> Case C-383/99 *Baby-Dry* [2001] ECR I-06251, para. 43.

<sup>14</sup> Case C-104/00 P *Companyline* [2002] ECR I-07561, para. 23.

<sup>15</sup> P. Cobley (ed.), *The Routledge companion to semiotics* (Routledge, London, 2010), p. 340.

<sup>16</sup> L. Holmqvist, *Varumärkens särskiljningsförmåga* (Norstedts juridik, Stockholm, 1999), p. 15.

<sup>17</sup> L. Holmqvist, *supra* note 16, p. 15.

<sup>18</sup> B. Beebe, 'The semiotic analysis of trademark law', 51 *UCLA Law Review* (2004), p. 630.

<sup>19</sup> L. Holmqvist, *supra* note 16, p. 15.

<sup>20</sup> P. Cobley (ed.), *supra* note 15, p. 322.

<sup>21</sup> P. Cobley (ed.), *supra* note 15, p. 318.

<sup>22</sup> P. Cobley (ed.), *supra* note 15, p. 322.

<sup>23</sup> P. Cobley (ed.), *supra* note 15, p. 322.

<sup>24</sup> P. Cobley (ed.), *supra* note 15, p. 322.

True to semiotic tradition, semiotics may possibly also be defined by what it is not, as well as by what it does. *Semiology* has often incorrectly been equated with semiotics, although they are not identical; semiology is coined by Saussure as the discipline devoted to studying ‘the life of signs as part of social life’.<sup>25</sup> Semiology has somewhat misleadingly been treated as a mere subset of linguistics.<sup>26</sup> The difference between semiotics and semiology seems to lie in that semiology is not a science of signs of every kind, excluding all signs dependent on or controlled by the decisions of individuals, as well as so-called natural signs, such as storm clouds or dilated pupils.<sup>27</sup> This dichotomy notwithstanding, Saussure has been called a principal founder of semiotics,<sup>28</sup> and his sign model will be used below.

Helpfully semiotics has been defined by the following; “The purpose of semiotic study is to understand the system of signs which creates meaning within a culture. It is to understand the underlying structures that make meaning possible.”<sup>29</sup>

## 2.2 Legal semiotics

The status of legal semiotics has been described as a sub-discipline of general semiotics, as a meta-discipline that provides a language within which to study the traditional methods of legal science, and as an auxiliary discipline that provides tools to advance the main discipline, e.g. philosophy or sociology, but in any case it is hardly a discipline in its own right.<sup>30</sup>

It would intuitively seem that applying semiotics to legal phenomena would suffice for it to qualify as legal semiotics. Some has suggested that legal semiotics need a progressive character, while some have been disinclined to agree.<sup>31</sup> Further, in the articles concerning semiotics and trademark law cited in this paper, the term legal semiotics is not used. It will not be used to describe the following analysis either, as it is not concerned so much with legal rules as signs, but with the application of semiotic theory when using those rules, i.e. it is not a semiotic analysis of those rules.

## 2.3 Semiotics and trademark law

The proposition that semiotics has a role to play in trademark law appears to have been well received.<sup>32</sup> Semiotic analysis has in various articles been

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<sup>25</sup> P. Cobley (ed.), *supra* note 15, p. 317.

<sup>26</sup> P. Cobley (ed.), *The Routledge companion to semiotics and linguistics* (Routledge, London, 2001), p. 4. Cf. P. Cobley (ed.), *supra* note 15, p. 318.

<sup>27</sup> P. Cobley (ed.), *supra* note 26, pp. 317-318.

<sup>28</sup> B. Beebe, *supra* note 18, p. 627

<sup>29</sup> J. M. Balkin, 'The promise of legal semiotics', 69 *Texas Law Review* (1991), p. 1845.

<sup>30</sup> B. S. Jackson, 'Legal Semiotics and Semiotic Aspects of Jurisprudence', in A. Wagner and J. Broekman (eds.), *Prospect of Legal Semiotics* (Springer, New York, 2011), p. 29.

<sup>31</sup> J. Paul, 'The politics of legal semiotics', 69 *Texas Law Review* (1991), pp. 1784-1785.

<sup>32</sup> A. Lang, 'A Case for Applying the Theoretical Semiotics in the Practice of Trade Mark Law', 21:1 *International Journal for the Semiotics of Law* (2008), p. 6.

applied to different issues in trademark law. However, these articles have focussed on issues of infringement, such as the concepts of dilution and deceptive similarity, but have not discussed issues regarding registrability.<sup>33</sup> Semiotic theory has a potentially important role in assessing this issue, a role that appears even more acute in relation to the descriptiveness provision, which can be said to completely revolve around the issue what a sign communicates, or can communicate, to the relevant public.

The purposes for the application of semiotic theory can be descriptive or normative.<sup>34</sup> It has been suggested that the usefulness of semiotic theory in relation to trademarks cannot be in explaining how the law has formed, as this would credit the responsible actors with being sophisticated semioticians, but rather its value is as a tool for analysing the protection trademarks need in order to fulfil their purposes.<sup>35</sup>

For the purposes of this paper, it can be said to work in both ways. The construction of the semiotic model is based on and informed by the trademark regime, and will thusly be a description of it. However, that model will be used to assess the coherency of that regime, i.e. as Pulos suggested; it will be used as a normative tool for analysing whether the trademark regime fulfils its purposes.

In the following, the term distinctiveness will be used. This is because even though it is the descriptiveness provision with which the paper is concerned, the following analysis regards, in part, whether the sign of a word mark is distinctive in relation to a descriptive sign, in much the same way as the semiotic analysis on infringement is concerned with whether one trademark is distinctive in relation to another.

## 2.4 What is a sign?

Ferdinand de Saussure, a Swiss linguist, and one of the principal founders of semiotics, proposed a dyadic sign model, according to which a sign, and so a word, consists of two parts: a *signifier* and a *signified*.<sup>36</sup> The signifier is, in the case of a word, the aural, visual, or in the case of Braille, even tactile, impression perceptible to us.<sup>37</sup> As such, the word love, whether spoken or written, is a signifier for the signified, which is the idea or the concept of love. This bipolarity between word and mental image is an irreducible and inevitable part of language.<sup>38</sup> Except for the rare cases of onomatopoeia, the signifier is arbitrary in relation to the signified.<sup>39</sup>

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<sup>33</sup> See A. Lang, *supra* note 32, p 7. An important exception is L. Holmqvist, *supra* note 16.

<sup>34</sup> A. Lang, *supra* note 32, p. 7.

<sup>35</sup> M. Pulos, 'A semiotic solution to the proprietization problem of trademark', 53:3 *UCLA Law Review* (2006) p. 850.

<sup>36</sup> B. Beebe, *supra* note 18, p. 627ff.

<sup>37</sup> See L. Holmqvist, *supra* note 16, p. 15.

<sup>38</sup> L. Holmqvist, *supra* note 16, p. 15.

<sup>39</sup> According to Holmqvist there are three types of 'motivated', i.e. non-arbitrary, words; those phonetically motivated (onomatopoeic), those derived from other words, and those

To this can be added a third phenomenon, which is the actual thing referred to, e.g. a certain individual table, and not just the idea or concept of tables in general.<sup>40</sup>

This third phenomenon is recognized by the Charles Sanders Peirce (1857-1913) in his triadic structure. Although naming them differently, this structure also has a signifier (representamen) and a signified (interpretant). Where it differs is the inclusion of an object, or referent. This can be a physical or mental entity, but it is not something created in the mind of the interpreter, i.e. it is not the same as the signified.<sup>41</sup>

For trademark law, Beebe has proposed a triadic structure of signifier, signified, and referent.<sup>42</sup> In this structure, with the example of NIKE (signifier), “the signified is the goodwill of Nike Inc, and the referent is the shoes or other athletic gear to which the signifier ‘Nike’ is attached”, i.e. the goods.

Holmqvist, having a primarily semantic rather than semiotic view, acknowledges the Saussurean and Peircean analysis in regards to *appellatives*<sup>43</sup> but questions whether this is also true for proper names. He concludes that while there is still bipolarity, proper names do not mean anything, rather they point out an individual. As such, the acoustic image of a proper name does not give rise to an idea or concept or, to use Holmqvist’s words, a mental object. Whereas the word ‘table’ signifies the concept of a table no matter what shape or form it takes, a proper name such as Steven Andersson only point to the individual. This is not changed by the fact that more information may be required to identify a particular individual, should there be anyone else carrying the same name. In this light, the proper name is self-referential.<sup>44</sup>

The structure for a proper name would then seem to correspond to that of signifier-referent, i.e. a dyadic structure. The bipolarity of proper names is therefore different from that of appellatives. This different bipolarity is similar to the bipolarity of word marks.<sup>45</sup> However, where the appellative denotes a certain good, and the proper name points out a certain individual, word marks denote a certain category of a certain good (or a number of

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motivated by semantics, such as metaphors. *See* L. Holmqvist, *supra* note 16, p. 25.

However, it could be argued that the last two groups are still to be seen as arbitrary as they only derive their motivation from other words, which, if not themselves, will at some point reach an arbitrary signifier.

<sup>40</sup> L. Holmqvist, *supra* note 16, p. 16.

<sup>41</sup> B. Beebe, *supra* note 18, p. 632.

<sup>42</sup> B. Beebe, *supra* note 18, p. 645ff.

<sup>43</sup> Which he separates from proper names or proper nouns, *see* L. Holmqvist, *supra* note 16, p. 16.

<sup>44</sup> L. Holmqvist, *supra* note 16, p. 17.

<sup>45</sup> L. Holmqvist, *supra* note 16, p. 18.



goods), namely a certain good (denoted by an appellative) that has a certain commercial origin.<sup>46</sup> What this means will be further discussed below.

With, *inter alia*, the protection of shapes as trademarks and the rise of the trademark as a self-referential product in and of itself, Beebe has proposed that a merger of signifier and referent, as well as a merger of signified and referent, has taken place.<sup>47</sup> These developments, albeit important, should have no bearing on the topic of this paper, why it is left without further discussion.

A final note is that the terms sign, word sign, and trademark will be used in this paper to mean the whole, i.e. never just the signifier or signified alone.

## 2.5 Distinctiveness of signs

One important part in the Saussurean notion of language is that language is empty, a form and not a substance.<sup>48</sup> As stated above, language is principally arbitrary. In regards to distinctiveness, the semantic relations of *signification* and of *value* are helpful. Signification is the *intrasign* relationship between signifier and signified.<sup>49</sup> It is the positive meaning of the sign (when I hear the word ‘fear’ a certain mental image is created in my mind). Value is the *intersign* relationship between different signifiers and signifieds (‘fear’ is similar to ‘dread’, but they’re not the same, and thus this can’t be fear, because it is dread).<sup>50</sup> As such, value is negative in that it is determined in relation to other values, i.e. in relation to what it is not. In the Saussurean view, signification cannot occur without value. Each of a set of synonyms like ‘to dread’, ‘to fear’, ‘to be afraid of’ has its particular value only because they stand in contrast with one another. If one of them did not exist, its content would be shared by its “competitors”.<sup>51</sup> The same is true for phonemes, they are “characterized not, as one might think, by their own positive quality but simply by the fact that they are distinct. Phonemes are above all else opposing, relative, and negative entities.”<sup>52</sup>

### 2.5.1 Source distinctiveness and differential distinctiveness

Whereas the semiotic relation of signification corresponds to *source distinctiveness*, the semiotic relation of value corresponds to *differential*

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<sup>46</sup> L. Holmqvist, *supra* note 16, p. 19.

<sup>47</sup> B. Beebe, *supra* note 18, p. 656ff. See also M. A. Lemley, ‘The modern Lanham Act and the death of common sense’, 108 *Yale Law Journal* (1999), pp. 1687-1715. Note that both deal with US trademark law, why the discussions on the legal developments cannot be taken as directly relevant in the European context.

<sup>48</sup> B. Beebe, *supra* note 18, p. 641.

<sup>49</sup> B. Beebe, *supra* note 18, p. 639.

<sup>50</sup> B. Beebe, *supra* note 18, p. 639.

<sup>51</sup> B. Beebe, *supra* note 18, p. .

<sup>52</sup> Ferdinand de Saussure, *Course in General Linguistics* 16 (Charles Bally & Albert Sechehaye eds., Wade Baskin trans. 1959), p. 119.

*distinctiveness*.<sup>53</sup> It is, according to Beebe, source distinctiveness, i.e. the extent to which the signifier is distinctive of its signified, that is relevant for assessing the registrability of a sign.<sup>54</sup> Differential distinctiveness, i.e. the extent to which a signifier is distinctive in relation to other signifiers, is of importance when assessing whether infringement has occurred.<sup>55</sup>

Beebe's explanation of source distinctiveness is slightly confusing. He states that this corresponds to signification, i.e. the relation between signifier and signified. Applied to his triadic trademark structure, source distinctiveness would then be the relation between the signifier and the source/goodwill, i.e. between NIKE and Nike Inc (and its goodwill). However, it is not this relationship that is important when assessing distinctiveness. Instead, it is the relationship between the signifier and the goods that is relevant (between NIKE and shoes). However, when describing signification in the article, this is based on the Saussurean dyadic structure, and as such, signification is defined outside the context of Beebe's triadic trademark structure. Thus, the apparent inconsistency in the reading above is the effect of confusing two different structures.

## 2.5.2 Bipolarity, secondary meaning, and distinctiveness

As already mentioned, Holmqvist has his departure in the classification of words into proper names and other nouns. In fact, he sees this as the endgame of distinctiveness.<sup>56</sup>

Holmqvist proposes that the bipolarity of a word mark is between the signifier (the word mark) and signified (the good). This bipolarity then gives rise to a secondary meaning, and this secondary meaning is what gives a word mark distinctiveness. If there is no distinctiveness, i.e. no secondary meaning and no bipolarity, the word is generic.<sup>57</sup> When the mark GAZELLE is used in relation to tables a secondary meaning arises as a result of the primary meaning of the word 'gazelle' being obviously different from how it is used when affixed to a table.

Thus, instead of having Beebe's triadic structure, Holmqvist has a dyadic structure, to which he introduces the notion of primary and secondary meaning. The practical difference might be small as both structures, albeit in different terms, acknowledges the existence of a signifier, a source signified, and a good signified.

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<sup>53</sup> B. Beebe, *supra* note 18, p. 625.

<sup>54</sup> B. Beebe, *supra* note 18, p. 625.

<sup>55</sup> B. Beebe, *supra* note 18, p. 625. Differential distinctiveness can of course be relevant in assessing registrability in regards to the relative grounds for refusal.

<sup>56</sup> L. Holmqvist, *supra* note 16, p. 20. This is rather a question of semantics than semiotics, which could explain the different points of departure, and different approaches to distinctiveness.

<sup>57</sup> L. Holmqvist, *supra* note 16, p. 19.

It is still an assessment of the relation between the trademark sign and the goods sign that is needed to determine distinctiveness, but in this dyadic structure the goods is the signified.

### 2.5.3 Sign field

From his triadic structure, Beebe introduces a spatial model of trademark scope, according to which any given trademark forms a point in a two-dimensional model. The signifier dimension is the collapsed continuum of a sign field.<sup>58</sup> A sign field surrounds a specific signifier and comprises other signifiers, actual or hypothetical, that are close to each other because of similarities in how they are perceived (like *abode* and *adobe*).<sup>59</sup> The referent dimension contains a collapsed continuum of goods that are similar to each other. This model is used to determine the scope of protection and whether infringement has occurred. The closer two points are in the two-dimensional model, the more likely infringement is.

While the model cannot as such be used for registrability, other than regards the relative grounds, it may be helpful to think of the trademark signifier as well as the goods signifier having a sign field, consisting of signs that are perceived similarly or have similar meaning. From this could then be constructed a spatial model where closeness on one axis represents similarity of the visual and aural perception (i.e. similarity of form) and closeness on the other axis represents similarity of the meanings or ideas being evoked. This could also be expressed as similarity of signifier and similarity of signified. While *LITE* is perceived as almost identical to 'light' and would probably evoke the same meaning, hence being very close to each other in both dimensions, 'minute made' and *MINUTE MAID* while sounding identical and looking very similar, has two completely different meanings, and would therefore end up further away from each other. This has also been accepted by the Union Courts, albeit in relation to the relative grounds, under the notion of conceptual differences, where such a difference can negate the similarity of the visual and aural impression.<sup>60</sup> This notion should be extendable to the absolute grounds for refusal.

While *DOUBLEMINT* might evoke the meaning 'double the amount of mint', this meaning is so similar to 'two types of mint' that they are still within each others' meaning fields.

Lastly, while *FOOTCOVERS* could evoke the idea of socks, the aural and visual impressions are far removed. For the purposes of assessing the descriptiveness, the trademark signifier would have to be compared not only

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<sup>58</sup> B. Beebe, *supra* note 18, p. 653f. With a collapsed continuum is meant that a two- or even three-dimensional field is collapsed into a one-dimensional continuum.

<sup>59</sup> B. Beebe, *supra* note 18, p. 654.

<sup>60</sup> See B. Kunoy, 'What's in a name that which we call a rose by any other name would smell as sweet? Reflections on ECJ's Trade Mark Case Law', 8:6 *German Law Journal* (2007), p. 646f, Case T-278/04 *Yupi* [2006] ECR II-00090\* and Case T-292/01 *Phillips-Van Heusen* [2003] ECR II-04335.

to the most common word for the good, but also for synonyms (actual or hypothetical), for the goods' characteristics and so forth. It matters not whether the word is a neologism because as the case law will show, a word is not required to be in use at the time of application for it to be regarded as descriptive, although neologisms do raise the question how to accommodate them within the semiotic model proposed below.

## 2.5.4 Proposed semiotic model for analyzing distinctiveness

For the purposes of this paper, the model used will be a dyadic model of signifier and signified. This is because even though it is all about what Beebe would term source distinctiveness, the source itself is not actually important for the analysis. This can be seen in the doctrine of anonymous source, where it matters not if the relevant public knows the source as long as they can distinguish it as one single source.<sup>61</sup> Technically it must not even be the same source, as with franchising, as long as the relevant public can repeat favourable experiences (their own or others). In other words, as long as the difference between the signifier and/or signified of the word mark differs sufficiently from the signifier or signified of the good, or its characteristics, it can be assumed that the word mark signifier will signify a source and not a descriptive term.

As this model departs from Beebe's triadic model it is important to note that since the purpose of this analysis is to provide a useful model for this particular issue, it is based on the norms relevant to this analysis, why it is not necessary or even appropriate that the model chosen conform to other semiotic models used in analyzing trademark law.<sup>62</sup>

The word mark will in this structure contain a signifier - the actual word - and a signified. This signified is the mental image evoked in mind of the relevant public by the signifier.<sup>63</sup> For a completely arbitrarily made up word, it may not signify, in the sense of denoting, anything, although, depending on the word, it may still evoke connotations. As such while the signifier 'apple' would signify the fruit, the signifier 'prerax' may not signify/denote anything although it may, because of the composition of sounds, evoke or suggest, pharmaceuticals.

This word mark will then be compared, using the spatial model described, with the word sign(s) that can be seen as descriptive of the goods, which will be called the descriptive signifier and the descriptive signified. This may even be sentences.

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<sup>61</sup> See B. Beebe, *supra* note 18, p. 663. See also Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA* [2004] ECR I-05089, para. 43.

<sup>62</sup> See A. Lang, *supra* note 32, p. 12.

<sup>63</sup> That, as mentioned above, the signified will be assumed to denote origin, if the word mark is accepted as distinctive, is not relevant here, as this is prior to this assumption having effect.

So, as stated above, where the signifier DOUBLEMINT could evoke either the signified “double the amount of mint” or “two types of mint”, this would, when compared to the sign describing the goods, be either identical or very similar to both the descriptive signifiers (‘double the amount of mint’ or ‘two types of mint’) as well as the descriptive signified which would be the image of something either containing a double amount or two types of mint and in any case tasting doubly of mint.

This example, the fictional one of FOOTCOVERS, as well as most, if not all, neologisms provide a problem of how this comparison is to be performed. The main problem concerns the comparison of signifiers. Is DOUBLEMINT to be compared to, as was done above, the signifier ‘double the amount of mint’ or ‘two types of mint’, and is FOOTCOVERS to be compared with ‘socks’? In the former case, there is still great similarity between the aural and visual impressions of the different signifiers, but in the latter, there is a great difference.

There are two possible solutions. The first is to deal with neologisms in the way that a grammatically correct combination of descriptive elements, such as in DOUBLEMINT is itself seen as a descriptive signifier, to be compared with the word mark signifier, which would then of course be identical. This has the downside of putting the emphasis on the decision of which signs are eligible for comparison with the word mark, i.e. the assessment of registrability is more or less made in a discussion of which words could serve as descriptions of the goods or its characteristics. This is of course akin to assessing whether the word mark itself could serve as a description. While this is exactly what the assessment is supposed to do, it only takes us full circle, and as such is no aid in the assessment itself.

The second solution then, is to treat the comparison of signifiers as helpful in comparing signifieds, and that it is this latter comparison that is of greater importance. This would entail only using descriptive signifiers that can reasonably be said to be an actual way of describing something, e.g. the generic signs for the good or characteristic. That is, if FOOTCOVERS were to be seen as descriptive of socks, it would not be because it is itself seen as a descriptive (i.e.) generic signifier of socks, but that the signified is identical to socks, why no Holmqvistian bipolarity arises. An important note is that as the descriptiveness provision covers different characteristics apart from the good itself, such as the intended purpose, the word mark may have to be compared to these as well; if the purpose of socks can be said to be to ‘cover your feet’, then maybe this signifier can be seen as a descriptive signifier.

## **2.5.5 The categories of descriptiveness**

While, as shown above, there are some differences in the structures proposed for trademarks, there is unity as regards the different categories of descriptiveness. These categories describe the relation between the signifier

(e.g. word mark) and the generic word for the goods, or its characteristics.<sup>64</sup> Another way to describe it is that the assessment regards how motivated the signifier is by the goods.<sup>65</sup> In one end of the (registrable) spectrum the signifier can be descriptive, i.e. not registrable without acquiring distinctiveness. In the other end the word is completely free of associations in relation to the goods, either because the word is arbitrarily chosen (APPLE for computers), or because the word is fanciful (in relation to any goods) because it is arbitrarily made up (PRERAX).<sup>66</sup> In between comes the suggestive words. It is how to draw the line between descriptive and suggestive that it all comes down to; as regards registrability there is no point in discussing to which extent a word is distinctive of source; either it is or it is not.<sup>67</sup> There are, of course, no clear lines between the categories; rather it is a continuous line that seamlessly shifts between the categories. Thus, there are not just words that fit into either of these categories; there are words, that fit more or less into a certain category.

To illustrate this, the word mark DIAMOND can be used. The corresponding generic word is, of course, diamond. DIAMOND would be descriptive in relation to diamond jewellery. It could be suggestive in relation to dishwasher tablets, and it would be completely arbitrary in relation to foodstuffs.

## 2.6 Different ways of forming neologisms

The most straightforward way of creating a new term is to combine two or more already existing words from the same language (BREADBAKER for a bread making machine). This way, while being the most straightforward, would for the very same reason be the most liable to be regarded as descriptive.

On the other hand, combining words from two or more languages would tend not to be descriptive. This is of course only true if the words are not such as to be understood in either language (BÜCHSTORE would probably be descriptive for bookshops in most of Europe and, at the very least, in the United Kingdom and Germany).

Another way is to combine not words but morphemes (POSTSHAVE for aftershave). The descriptiveness would then often be a question of how readily understandable the morphemes are. Morphemes from different languages will increase the possibility of non-descriptiveness.

Another group of neologisms includes words that are combined while cutting out parts or morphemes from one or more of the words. LIGHCRETE

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<sup>64</sup> L. Holmqvist, *supra* note 16, p. 20.

<sup>65</sup> B. Beebe, *supra* note 18, p. 6710

<sup>66</sup> L. Holmqvist, *supra* note 16, p. 20. *See also* B. Beebe, *supra* note 18, p. 670f, citing American case law.

<sup>67</sup> B. Beebe, *supra* note 18, p. 671. The further categorization may have relevance in an infringement procedure however.

for light concrete would be one example. This contracting of one or several words can easily be found in the language use on internet or in texting. The descriptiveness assessment would then have to analyze how readily apparent the non-contracted meaning is. In some cases, the contraction may even be in common use, as accepted slang.

There are several ways of using misspelling to form new words, although calling them new, may be stretching it a bit at times. Holmqvist mentions seven variations.<sup>68</sup> These are misspellings based on careless pronunciation (LECTRIC SHAVE), on regional dialects, fanciful pronunciations, simplified spelling (KLEEN), a reduction in graphemes (BRITE-N-KLEAN), an increase in graphemes (FAYMOUS), or a variation in graphemes (Minute Made → MINUTE MAID).

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<sup>68</sup> L. Holmqvist, *supra* note 16, p. 63f.

# 3 Human rights and the importance of language

This chapter aims to show the importance of a sound basis in semiotic thought when assessing the registrability of a potentially descriptive sign. Under this chapter, two issues will be analyzed. First is the issue whether a human rights framework can be used to argue *for* the registration of trademarks in general and descriptive signs in particular. The second issue is of what use a human rights framework can be in arguing for the refusal of the registration of a descriptive sign. A subsidiary issue, which will be analyzed first, albeit only superficially, is the capability of companies to claim their “human rights”.

The analysis will mainly focus on the European Convention on Human Rights (ECHR) rather than the Charter of Fundamental Rights. The conclusions should be equally applicable to the Charter however, as it expressly provides that it be read in the light of the case law of the ECHR.<sup>69</sup>

## 3.1 Corporate human rights

The European Court of Human Rights has shown itself to be very open to corporate applicants. The desirability of this openness is another issue, and one that will not be dealt with here.<sup>70</sup>

The basis for corporate claims under ECHR can be found in Art. 34 of the ECHR, which states that the Court “may receive applications from any person, non-governmental organisation or group of individuals claiming to be the victim of a violation”. Drawing on the French text and the draft history, Emberland shows that companies were always meant to be included under ‘non-governmental organizations’.<sup>71</sup>

Article 1 of Protocol No 1 of the ECHR explicitly recognizes the right of legal persons. Corporate applicants have further been accepted under the right to fair trial.<sup>72</sup> A legal person’s business premises has been accepted (as a ‘home’) under Article 8, and so has business ‘correspondence’.<sup>73</sup>

Commercial speech was included under Article 10 by the European Court of

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<sup>69</sup> Charter of Fundamental Rights of EU, article 52(3).

<sup>70</sup> See A. Grear, ‘Challenging Corporate “Humanity”’: Legal Disembodiment, Embodiment and Human Rights’ Vol. 7 *Human Rights Law Review* (2007), pp. 511-543, for an argument against corporate human rights.

<sup>71</sup> M. Emberland, *The Human Rights of Companies: Exploring the structure of ECHR protection* (Oxford University Press, Oxford, 2006), p. 4.

<sup>72</sup> M. Emberland, *supra* note 71, p. 14.

<sup>73</sup> *Société Colas Est and Others v. France*, 16 April 2002, ECHR, Application no. 37971/97, and *Petri Sallinen and Others v. Finland*, 27 September 2005, ECHR, Application no. 50882/99.



Human Rights (ECtHR) in two early cases.<sup>74</sup> Article 11 also seems open for corporate claims.<sup>75</sup> The Court has further accepted claims under Article 13<sup>76</sup> and under Article 14.<sup>77</sup> Companies even have the right to compensation for non-pecuniary damage under Article 41.<sup>78</sup>

The ECtHR is thus very open to corporate claims, and in any case, the nature of the applicant should not be decisive as regards the *admissibility* of a claim under the articles relevant to this paper. The corporate nature of a applicant may however, as discussed below, be of relevance as regards the merits of the claim, where the protection of corporate interests are generally submitted to a less strict scrutiny.

## 3.2 Refusal to register a sign as a human rights violation

Three human rights have been put forward as possibly protecting trademarks to some extent; the right to privacy,<sup>79</sup> the right to property and freedom of expression. The first two can be dealt with rather swiftly, as they do not have a direct bearing on the issue of this paper.

### 3.2.1 Right to privacy

Trademarks, it can be argued, have similar qualities to personality rights, in that it is a mark of identity. The ECtHR has recognized violations under the article in the unauthorized commercial exploitation of personal images. As Reiss puts it; “[when] conceptualized as components of identity, it is not a huge leap from images to marks, especially when celebrities like Catherine Zeta-Jones use their famous identities in economically beneficial endorsements.”<sup>80</sup> However, this argument presupposes that the mark functions as a mark of identity. As such, this argument, whether it holds true or not, is not applicable to the refusal of a sign for reasons of its descriptiveness; if the applicant can prove that it does function as a mark of identity, it will be registered under Article 7(3).

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<sup>74</sup> *Markt intern Verlag GmbH and Klaus Beermann v. Germany*, 20 November 1989, ECHR, Application no. 10572/83, and *Groppera Radio AG and Others v. Switzerland*, 28 March 1990, Application no. 10890/84.

<sup>75</sup> See *AB Kurt Kellerman v. Sweden*, 1 July 2003, ECHR, Application no. 41579/98.

<sup>76</sup> See *Stockholms Modégarn AB v. Sweden*, 16 January 2001, ECHR, Application no. 38993/97.

<sup>77</sup> See, *inter alia*, *G. G.m.b.H. v. Austria*, ECHR, 7 January 1991, Application No. 11334/85, and *Granos Organicos Nacionales S.A. v. Germany*, 12 October 2010, ECHR, Application no. 19508/07.

<sup>78</sup> *Comingersoll S.A. v. Portugal*, 6 April 2000, Application no. 35382/97.

<sup>79</sup> See J. W. Reiss, 'Commercializing Human Rights: Trademarks in Europe After *Anheuser-Busch v Portugal*', 14:2 *The Journal of World Intellectual Property* (2011), p. 186, where the author puts forward, but takes issue with, the possibility of protecting trademarks under article 8.

<sup>80</sup> J. W. Reiss, *supra* note 79, p. 186.

### 3.2.2 Protection of property

The second argument is the protection of trademarks as property under Article 1 of Protocol 1 ECHR. In the *Anheuser-Busch* case the Grand Chamber of the ECtHR acknowledged three things of importance; intellectual property rights are protected under the article; this includes trademark rights; and a trademark application may be protected under the article.<sup>81</sup> In Article 17 of the EU Charter, intellectual property rights are explicitly recognized,<sup>82</sup> which should cover trademarks and trademark applications to the same extent as under the ECHR, for the reason given above.

Concerning trademark applications the Grand Chamber accepted that an application is capable of possessing substantial financial value thus making the article applicable. Even though the rights derived from an application pending registration are conditional, there is an entitlement to have it examined properly.<sup>83</sup>

Importantly, in holding that the applicant was entitled to expect that its application would be examined under the applicable legislation, the Grand Chamber expanded the ECtHR's jurisdiction to review the denial of registration on any ground recognized in trademark law.<sup>84</sup> This means that a refusal to register a trademark may be a violation of the right to property if that refusal is inconsistent with trademark law. In other words, it is important that trademark examiners can be reasonably certain how to assess the registrability of a trademark.

Again, this right is not directly of relevance to the registrability of neologisms. It is only concerned with procedural issues, and not with substantive issues. In other words, it cannot be used as an argument for or against registrability of a potentially descriptive neologism, only as an argument if the examiner has acted inconsistently with trademark law.

The article, as interpreted in *Anheuser-Busch*, does serve one important function however, apart from requiring consistency. Helfer notes as a possible consequence of the case that the identification of the prospect of violation by retroactive effect, may have led to the ECtHR having calcified current trademark law.<sup>85</sup> In other words, the article may have a role to play, in that it reinforces the importance of the Union Courts and trademark examiners "getting it right" from the start, as it may be difficult to roll back the effects of a too lenient standard of review, this standard having led to the

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<sup>81</sup> See *Anheuser-Busch v Portugal*, App. No. 73049/01 (11 January 2007), Grand Chamber Judgment.

<sup>82</sup> Charter of Fundamental Rights of the EU, article 17, 7 December 2000, OJ [14 December 2000] C 364/1

<sup>83</sup> *Anheuser-Busch v Portugal*, App. No. 73049/01 (11 January 2007), Grand Chamber Judgment, paras. 77-78.

<sup>84</sup> Helfer, L. R. 'The New Innovation Frontier? Intellectual Property and the European Court of Human Rights' 49(1) *Harvard International Law Journal* (2008), p. 26.

<sup>85</sup> Helfer, L. R., *supra* note 84, p. 50.

legitimate expectations of a mark being examined under the same standard. As will be argued below, getting it right involves basing the assessment in semiotics

### 3.2.3 Freedom of expression

As noted above, the freedom of expression is protected under Article 10 ECHR, even when the expression is commercial in nature. The case law suggests however, that commercial expression generally merit a lesser protection. At least, interferences with commercial expression merit a less strict scrutiny, giving a greater margin of appreciation to national courts.<sup>86</sup> To decide whether the refusal to register a sign can be assessed under the article it has to be shown that the registration, or at least use, of a trademark is an ‘expression’, and that the refusal to register constitutes an interference with that expression. If this can be shown, the question then is whether this refusal can be justified under Article 10(2). This latter question is analyzed below as part of the argumentation against the registration of descriptive signs.

This very question has been analyzed by Griffiths, albeit in relation to the provision prohibiting the registration of immoral trademarks, i.e. in relation to Article 7(1)(f) CTMR.<sup>87</sup> Both the courts in the United Kingdom as well as the Grand Board of OHIM have recognized that Article 10 ECHR has a role to play in the interpretation of Article 7(1)(f).<sup>88</sup> Thus, before discussing the correctness of this assessment Griffiths concludes that it now seems to be generally accepted that a refusal to register a trademark under this provision is to be considered within the framework established by Article 10 ECHR.<sup>89</sup>

As regards the issue of what form of “expression” would be at issue in the application to register a trademark, Griffiths argues that it cannot be the registration itself, as this is simply a “bureaucratic act carried out by the Registrar (rather than by the applicant)”, thus it has to be the trademark *use* that constitutes the expression.<sup>90</sup> That the use of a trademark would qualify as expression seems, on the other hand, quite likely.<sup>91</sup>

Regarding the second issue, whether the refusal to register a sign constitutes an interference, Griffiths is more sceptical. A refusal to register a mark is akin to refusing to provide positive assistance to the applicant, and the ECtHR have been very reluctant to impose positive obligations under the

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<sup>86</sup> See M. H. Randall, 'Commercial Speech under the European Convention on Human Rights: Subordinate or Equal?', 6:1 Human Rights Law Review (2006), pp. 53-86.

<sup>87</sup> J. Griffiths, 'Is there a right to an immoral trade mark?', in P. Torremans (ed.), *Intellectual Property and Human Rights* (Kluwer Law International, Alphen aan den Rijn, 2008), pp. 309-334.

<sup>88</sup> J. Griffiths, *supra* note 87, p. 324-327.

<sup>89</sup> J. Griffiths, *supra* note 87, 328.

<sup>90</sup> J. Griffiths, *supra* note 87, p. 328.

<sup>91</sup> J. Griffiths, *supra* note 87, p. 329.

article, and has done so only in extreme cases.<sup>92</sup> For this reason, and since commercial expressions merit less protection, it seems unlikely that the Court would regard this failure of assistance as a relevant interference. Thus, as Griffiths concludes, the case for invoking Article 10 in relation to a refused application is rather weak, albeit not completely without merit.<sup>93</sup>

However, this reasoning is based on the assumption that a refusal to register is not the same as hindering the applicant to use the mark. While this is technically true, it seems unlikely that an undertaking would risk using and investing in a mark that would have no protection. Thus, a refusal to register a sign may be construed as effectively hindering the applicant from using the sign as a trademark. While accepting this reasoning would make it likelier that the ECtHR would accept a refusal as an interference, it is far from clear that they would do so.<sup>94</sup>

There is thus an uncertainty whether the human rights framework confer a right to register a trademark. If it does, the next part will be important in concluding when it is legitimate to let this right give way to other rights or interests, and if it doesn't the next part is still of relevance as an argument for that it is not only in compliance with human rights to refuse to register a descriptive sign, it may also be required to do so.

### **3.3 Human rights framework against registration**

As concluded above, a human rights framework provides tenuous arguments at best for the registration of a sign; the protection of property does not seem to demand anything substantive, the right to privacy should at most be applicable only to signs that have acquired distinctiveness, and finally while the freedom of expression does provide a possible argument, it is very uncertain if the ECtHR would recognize a refusal to register a mark as an interference, and even if it did, states would have a wide margin of appreciation in these matters.

#### **3.3.1 The impact on other traders**

The impact of registration of a descriptive sign, or any sign for that matter, on other traders is rather straightforward. Whereas trademark rights can generally not be used to prohibit the use of the sign in non-commercial situations, the prohibition of the use of the mark by other traders constitutes of course the very core of trademark law. Giving a monopoly on the

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<sup>92</sup> J. Griffiths, *supra* note 87, p. 330.

<sup>93</sup> Under the possibility that it could be seen as an interference Griffiths continues to examine the necessity of the intervention. As it regards the reasons underpinning Article 7(1)(f) it is of no relevance to this paper.

<sup>94</sup> As of writing, May 5 2011, no cases of the ECtHR concerns the refusal to register a trademark as a possible violation of Article 10.

commercial use of a sign may be an interference with the commercial expression of other traders and must thus be justified.

In searching for a legitimate aim, it is helpful to make a difference between signs that have acquired distinctiveness, whether or not they were also inherently distinctive, in the sense that the relevant public has come to see the sign as indicating origin, and between signs that have not. As regards the former, the protection of the trademarks can be justified by reference to the property rights under Article 1 Protocol 1 ECHR, as well as by protecting the meaning democratically “chosen” by the relevant public. Further, as was indicated above, with this category of marks, Article 8 might be of relevance. Lastly, the trademark regime may be said to protect the expression of the trademark proprietor. Letting other traders use the same mark will distort this expression into something else. It can thus be said to protect the integrity of the expression. This last aspect is also relevant for signs that have not acquired distinctiveness, as the registration constitutes a future assurance of the integrity of the mark, whereas the others are not.

In connection to this it is of relevance that the ECtHR has made it rather easy for a respondent State to bring its actions within one of the legitimate aims listed in Articles 8 through 11, indeed Kempees has reported that there is no case in which the ECtHR has found a violation of any of the articles, purely on the basis of the failure to satisfy the requirement for a legitimate aim.<sup>95</sup> Thus, at least one of the arguments outlined above, should constitute a legitimate aim.

### **3.3.2 Freedom of expression and semiotic democracy**

This part argues that, whether or not trademark applicants can use Article 10 to protect their interests, Article 10 requires the examination of potentially descriptive marks to be based in semiotic theory. While this part focuses on Article 10, some of the arguments would be equally at home under the right to culture in Article 15 of the International Covenant on Economic, Social, and Cultural Rights.

This part aims to use the concepts of *semiotic democracy* and a *descriptive domain* to show why the notion of freedom of expression must cover more than the prohibition of state censorship. This extended notion of freedom of expression will point, in turn, to what may be at stake when examining a trademark application, the conclusion of which will imply the importance of

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<sup>95</sup> L. Bently and B. Sherman, *Intellectual Property Law* (Oxford University Press, New York, 2009), p. 317, and P. Kempees “Legitimate aims” in the case-law of the European Court of Human Rights’ in P. Mahoney and others, *Protecting Human Rights: The European Perspective. Studies in Memory of Rolv Ryssdal* (Carl Heymanns, Köln, 2000), p. 659.

a well-balanced and consistent examination procedure with a sound basis in semiotic theory.<sup>96</sup>

### 3.3.2.1 The public and the descriptive domain

The notion of a public domain is helpful to the discussion in describing what signs belong, or should belong, to what will be called a descriptive domain. What constitutes the public domain has been discussed at length.<sup>97</sup> One controversy is how to classify that which in theory is in the public domain, but e.g. because it is privately owned, is for practical purposes not available. On the other hand, there are several categories that are so widely available as to seem to be in the public domain, such as open source software.<sup>98</sup> Another issue is whether allowed uses, such as the permission to use a sign descriptively under Article 12 CTMR, are part of the public domain or not.<sup>99</sup>

However, the categorization of these different types of content has no direct bearing on the topic at hand. Suffice it to say that the public domain consist of a vast and diverse assortment of contents available to all.<sup>100</sup> This includes content that is virtually useless, as well as content that “need to remain open and unownable as sources for future creations.”<sup>101</sup>

In regards to trademark law and potentially descriptive signs, the public domain will henceforth be called the descriptive domain. For the purposes of this paper, it includes all signs that are perceived as descriptive. This definition entails that a sign is only included in the descriptive domain in relation to certain goods or characteristics. That is, the descriptive domain is always a function of a certain sign seen in relation to other signs. Therefore, the word love, as well as the drawing of a heart, may both be in the descriptive domain of the concept of love, but most likely not in relation to computer technology.<sup>102</sup> What is striking with such a descriptive domain, in contrast to the legally defined public domain, is its inherently democratic nature;<sup>103</sup> it is defined in trademark law by the perception of the relevant

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<sup>96</sup> As pointed out in chapter 1, consistency is of course also important from an economical user perspective.

<sup>97</sup> See, *inter alia*, R. Deazley, *Rethinking copyright – History, Theory, Language* (Edward Elgar Publishing, Cheltenham, 2006); and E. Samuels, ‘The Public Domain in Copyright Law’ Vol. 41 *Journal of the Copyright Society of the U.S.A.* (1993).

<sup>98</sup> P. Samuelson, ‘Mapping the digital public domain: threats and opportunities’, 66 *Law and Contemporary Problems* (2003), p. 149.

<sup>99</sup> See P. Samuelson, *supra* note 98, where it is not. Cf R. Deazley, *Rethinking copyright – History, Theory, Language* (Edward Elgar Publishing, Cheltenham, 2006).

<sup>100</sup> Assuming the capability of people of accessing it, a question which raises a whole set of other issues. See, P. Samuelson, *supra* note 98, p. 148.

<sup>101</sup> P. Samuelson, *supra* note 98, p. 147.

<sup>102</sup> See K. Assaf, ‘The dilution of culture and the law of trademarks’, 49:1 *IDEA—The Intellectual Property Law Review* (2008), pp. 6-7.

<sup>103</sup> The difference in nature between the two domains is one of degree rather than kind. The public domain, although legally defined, is of course construed through processes that are more or less democratic. The difference, then, is the fluent nature of the descriptive domain, it is constantly subject to direct and democratic change, whereas the public domain is more constant, requiring legal change to substantially alter it.

public.<sup>104</sup> Thus, although it is an examiner or, in the end, a court that decides if a sign is in the descriptive domain, this decision is to be based on the perception of the relevant public. Another striking feature is that the assessment is, as will be described below, forward looking. That is, the descriptive domain includes not only the signs that are actually in use, but also all signs that could be used, thereby protecting the future potential of the descriptive domain.

The function of the descriptiveness provision in trademark law is not to permanently position signs in the descriptive domain, and as such does not prohibit a trader from using the sign in a non-descriptive way, as a badge of origin. Its function is rather to ensure that the decision of whether a sign belongs in the descriptive domain or not, i.e. the creation of meaning, is a democratic process. It ensures that no single trader can unilaterally decide where the sign belongs.<sup>105</sup>

### 3.3.2.2 Semiotic democracy

This democratic nature can be explained by the notion of semiotic democracy. Although media studies professor John Fiske coined the term in reference to the audience's power in viewing and interpreting television narratives, the core concept is nonetheless useful here.<sup>106</sup> It has been described as a world where the public freely and widely engage in the use of cultural symbols, enabling it to resist or recode certain meanings.<sup>107</sup> If political democracy enables the participation in the exercise of political power, semiotic democracy enables the public to participate in the creation of cultural meaning.<sup>108</sup>

In relation to this notion, Assaf raises the issue of the dilution of culture by the use of trademarks. She uses a semiotic model derived from M. Ross Quillian, where a person's mind is a mass of nodes interconnected by associative links with each other. It is the sum of these links that determine the meaning of each node.<sup>109</sup> This notion is similar to that of value described in chapter 2. Using this model, she describes a reciprocal nature where a change to a node, or to the links of a node, also changes the connected node(s).<sup>110</sup> In this way, by creating associative links between a trademark and other cultural signs, the meaning of both are changed, the trademark

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<sup>104</sup> The sufficiency of acquiring distinctiveness in only a part of the Community may put this supposedly democratic nature in question. The issue of in how large a part acquired distinctiveness must be proved is however outside the scope of this paper.

<sup>105</sup> Once more, this democratic nature is not necessarily absolute. It is open to question whether the new meaning is chosen by or forced upon the relevant public (through advertising, product placement etc). Taking the latter view the process may of course be described as equally (un)democratic as a political vote where one candidate is constantly propagated for. However this issue, regarding the commercialisation of public space etc. is arguably too large to be encompassed under and managed by trademark law.

<sup>106</sup> See S. K. Katyal, 'Semiotic Disobedience', 84 *Washington University Law Review* (2006), pp. 489-490.

<sup>107</sup> S. K. Katyal, *supra* note 106, pp. 489-490.

<sup>108</sup> S. K. Katyal, *supra* note 106, p. 491.

<sup>109</sup> K. Assaf, *supra* note 102, p. 7.

<sup>110</sup> K. Assaf, *supra* note 102, p. 8.

being imbued with the cultural values, and the cultural signs in turn taking on a 'commercial flavour'.<sup>111</sup> When the law allows trademark owners to 'freeze' the meaning of the sign they own, it deprives other members of society the power to partake in shaping their culture; yet this opportunity is fundamental to meaningful social dialogue, i.e. to semiotic democracy.<sup>112</sup> She also describes how corporate censorship aggravates this undemocratic element, where trademark owners influence the content of cultural expressions such as films.<sup>113</sup> What Assaf describes can possibly be summarized as a sort of hijacking by trademark owners of cultural signs, at the expense of the cultural meanings, deriving from an asymmetry in the legal protection.<sup>114</sup> While this cultural hijacking is not the same as the issue of taking signs out of the descriptive domain, it highlights the importance of semiotic democracy, an issue that extends far beyond trademarks, and can be seen as sufficiently similar to be helpful in analyzing what is at stake when protecting potentially descriptive signs as trademarks, something which will be elaborated in the following.

### 3.3.2.3 'Positive' freedom of expression<sup>115</sup>

To accommodate the issue of semiotic democracy under the concept of freedom of expression, it is necessary to extend the notion of what this freedom is, and what it can do, beyond a formal right, i.e. beyond a negative freedom that only demands freedom from state censorship.<sup>116</sup>

In this extended notion, the true problem of freedom of expression rests on our power to act.<sup>117</sup> Power to act means the power to actualize and produce beings and existence.<sup>118</sup> In this context this means the power to produce ideas and hence to produce meaning. As we cannot have a right to something that we do not have the power to actualize, the notion of freedom of expression has to have a positive substance as well.<sup>119</sup> Thus, freedom of expression cannot be confined to require a non-censoring state, to a negative liberty, as this does nothing to address the question of power.

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<sup>111</sup> K. Assaf, *supra* note 102, p. 2. It is worth noting that these associations are made in two very different, non-exclusive, ways. The first is when the sign chosen as a trademark has a prior meaning, an example given by Assaf being 'Nike' the original meaning of which is the Greek goddess of victory. The second is when a sign, whether it has an original meaning or not, is associated with other signs or cultural values, through e.g. advertising, an example being associating 'Coca-Cola' with happiness or youthfulness.

<sup>112</sup> K. Assaf, *supra* note 102, pp. 4-5.

<sup>113</sup> K. Assaf, *supra* note 102, p. 26.

<sup>114</sup> The inverse also occurs however, when the public starts to use a word generically, "degenerating" the trademark. An important difference of these two processes is the great disparity in resources available to trademark owners and to the public to influence the outcome of such a process

<sup>115</sup> This part builds upon the semiotic analysis of freedom of expression as expressed in A. Carnera, 'Freedom of Speech as an Expressive Mode of Existence', *International Journal for the Semiotics of Law* (2010). Found at <http://dx.doi.org/10.1007/s11196-010-9212-7>. Last viewed on 15 May 2011. Where the author refers to freedom of speech, freedom of expression is used here as this is in line with the terminology in ECHR.

<sup>116</sup> See A. Carnera, *supra* note 115, p. 11.

<sup>117</sup> See A. Carnera, *supra* note 115, p. 8.

<sup>118</sup> See A. Carnera, *supra* note 115, p. 9.

<sup>119</sup> See A. Carnera, *supra* note 115, p. 9.



The negative notion has its roots in the nature of freedom of expression as a form of resistance, a power struggle against suppression and religious authority.<sup>120</sup> Thus, it has always been placed by reference to a posited imaginary opposition instead of having its own positive substance.<sup>121</sup> It is not here suggested that this nature of resistance be done away with, rather it has to enable resistance in other forms, such as resistance against the cultural hijacking described by Assaf, or more generally, in defence of a semiotic democracy.

Carnera proposes that our “acts and utterances should be interpreted as different kinds of symptoms expressing each person’s mode of existence.”<sup>122</sup> If the meaning of our utterances is allowed to change undemocratically, this will or at least may, also affect our mode of existence. Assaf argued that cultural hijacking successfully links consumption to important social values, which leads to cultural ideals incorporating the materialistic values embedded in trademarks.<sup>123</sup> In a similar but more general fashion, all changes in meaning may both reflect a change in being, as well as affect such a change.

It is thus suggested, that the freedom of expression requires the protection of a semiotic democracy, so as to enable the capability to meaningfully express ourselves. As this capability is closely connected to our freedom of thought and the problem of individuation,<sup>124</sup> our power to act must include a power to create meanings, and not only the permission to regurgitate meanings as defined by someone else, because this is the only way in which we can express our own, personal existence and thus, in a way, the only way we can exist as individuals. One part of this, albeit only a small one, is to protect the descriptive domain, and to ensure that the decision of what it contains is a democratic decision.

### 3.4 Conclusion

If we accept that the registration of a descriptive sign interferes with the freedom of expression by being “semiotically undemocratic”, we then have to ask whether the interference is legitimate under the article. Thus, the arguments under 3.2 may be used to argue for the legitimacy of the interference, in the same way this part is used to argue the legitimacy of a potential interference under Article 10 by the refusal to register. In this way, the arguments under both parts need to be balanced against each other. The arguments for registration were, as seen, tenuous at best, whereas the arguments for the refusal to register carries more weight, although they may require a reconceptualization of the freedom of expression.

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<sup>120</sup> See A. Carnera, *supra* note 115, p. 10.

<sup>121</sup> See A. Carnera, *supra* note 115, p. 3.

<sup>122</sup> See A. Carnera, *supra* note 115, p. 10.

<sup>123</sup> K. Assaf, *supra* note 102, p. 15.

<sup>124</sup> See A. Carnera, *supra* note 115, p. 1.

However, as the purpose of this chapter has been to show the importance of assessing descriptiveness with a basis in semiotics, it is not decisive how the balancing falls out. As long as there is a need to balance these interests, and at least one interest must be assessed with regards to semiotics, the aim of this chapter has been fulfilled.

# 4 The European trademark regime

## 4.1 History and development

### 4.1.1 Origin of trademarks

The historical development of trademark law can be said to contain two strands. One is the proprietary mark, which had little to do with the source of a certain good. Rather it was used to identify goods in the event of theft, piracy or ship wreck.<sup>125</sup> The other, more interesting, strand is the production mark. This stems from the guilds structure, where it was used both as a means to control competition, by e.g. enabling the tracing and confiscation of goods smuggled into an area where another guild had monopoly, and to hold the producer responsible for defective goods.<sup>126</sup> As such the trademark was more a liability than an asset.<sup>127</sup>

However, notwithstanding the demise of the guild structure, the use of these marks continued and they were increasingly used as an indicator of quality.<sup>128</sup> It has been argued that their use changed once more in the beginning of the twentieth century, becoming valuable assets in their own rights, and as such becoming symbols rather than signals.<sup>129</sup> In this view the mark is valued not because it denotes a certain origin or quality, but because it carries an attractive meaning all on its own.

### 4.1.2 Legal history

The historical common law view on trademarks was as part of goodwill and it was an extension of the torts of deceit.<sup>130</sup> The Paris Convention for the Protection of Industrial Property of 1883 prescribed national treatment and harmonized some provisions on trademark law. Some provisions, notably for the purposes of this paper Article 6quinquies B(2), have similar wording to those found in the TMD and CTMR, more on which below.

In Hag II the European Court of Justice (ECJ) recognized trademark rights as an essential element of undistorted competition.<sup>131</sup> With the First Council Directive 89/104/EEC (TMD), now Directive 2008/95/EEC, many substantial provisions of trademark law were harmonised. In the recital to

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<sup>125</sup> H. Rosler, 'The rationale for European trade mark protection', 29:3 *European Intellectual Property Review* (2007), p. 100. See also L. Bently and B. Sherman, *supra* note 95, p. 712f.

<sup>126</sup> B. Beebe, *supra* note 18, p. 677.

<sup>127</sup> *Ibid.*

<sup>128</sup> L. Bently and B. Sherman, *supra* note 95, p. 712.

<sup>129</sup> L. Bently and B. Sherman, *supra* note 95, p. 712.

<sup>130</sup> H. Rosler, *supra* note 125, p. 101.

<sup>131</sup> Case C-10/89, *Hag II*, [1990] ECR I-3711.

the Directive, the disparities of trademark law between countries are said to be an impediment to the free movement of goods and services.<sup>132</sup> The Council Regulation 40/94 on the Community Trade Mark, now Council Regulation (EC) No 207/2009, (hereafter CTM for the mark) established the Office for Harmonisation of the Internal Market (OHIM or ‘the Office’) to examine applications for CTMs.

The TMD and CTMR were developed jointly. Where the CTMR created a unitary right, the TMD harmonized only those provisions having the greatest bearing on the functioning of the internal market. Important for this paper is that the relevant absolute grounds for refusal were brought into full harmony.<sup>133</sup>

### 4.1.3 The purpose(s) of trademarks

While it is the specific purposes underlying the descriptiveness provision that will have the greatest value to the further analysis, a discussion on the general purpose of protecting trademarks will also be valuable for the later discussion.

Trademarks differ from other intellectual property rights in that we cannot use the same justifications for protection. We do not protect trademarks to incite the creation of more trademarks. Trademarks are not valuable in themselves, and therefore we need to go further to justify the protection given.

As noted above, the function of the production mark was to indicate origin, but the indication of origin was not important *per se*. Rather the purpose was to control the market and hold responsible the producers of defective goods. Therefore, whereas this origin or source identifying function is recognized both by the Union Courts as the essential function of trademarks,<sup>134</sup> as well as by the doctrine, this function is not useful if it cannot be linked to something else.

This link can be the quality guarantee function or an information function more generally. As Rosler indicates, the separation of the origin function and the quality guarantee function is irrelevant from the consumer perspective.<sup>135</sup> A trademark can be an effective way of communicating information to the consumer.<sup>136</sup> This information need not necessarily concern the quality of the good, but could also concern e.g. the ethical reputation of the source. As such, it contributes to a certain market transparency and lowers search costs.<sup>137</sup> A trademark enables a consumer to repeat a favourable experience he, or someone he knows or trusts, has made

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<sup>132</sup> Directive 89/104/EEC, Recital 3.

<sup>133</sup> See Allenbach study, *supra* note 6, p. 49.

<sup>134</sup> B. Kunoy, *supra* note 60, p. 637.

<sup>135</sup> H. Rosler, *supra* note 125, p. 105.

<sup>136</sup> H. Rosler, *supra* note 125, p. 104.

<sup>137</sup> H. Rosler, *supra* note 125, p. 104.

in the past, by guaranteeing the identity of the source of the good. This will also create an incentive for the producers to (consistently) create better quality goods, even when these qualities are not perceivable before purchase.<sup>138</sup> As was mentioned above, it is not important that the consumer knows the source as long as she knows that a good bearing a certain mark comes from the same source as another good bearing the same mark. That the source itself is not important can be seen in the doctrine of anonymous source or with practises such as franchising, where it is enough that the consumer can trust in the quality of the good even though he or she may know that the source is a franchisee, thus fulfilling the important informational function.<sup>139</sup>

While this link is generally made in the doctrine, the Union Courts seem, at times, content with only citing the source identifying function, either taking this link to something inherently valuable for granted, or having lost sight of the need for one. This emphasis on the origin function by the Union Courts has been criticised.<sup>140</sup>

Jehoram, van Nispen, and Huydecoper take a wider view of the purposes of trademarks in stating that the trademark serves a two-fold objective; it protects the proprietor against disruptions of the connection created by his use of a trademark and it protects the consumer against the consequences of such disruptions.<sup>141</sup>

While, arguably, the origin function, the quality guarantee function, and the information function mentioned by different authors are different sides of the same coin, there are two functions that should be mentioned separately.

The first should rather be called a justification than a function. It is the ethical justification of unfair competition or unjust enrichment.<sup>142</sup> While the other functions mentioned above can be derived from the good it does the consumer, this justification is about fairness. While the other purposes mentioned above would not e.g. seem to preclude the possibility of third parties to produce “perfect copies” of a good, this justification would.

A third, separate function, is the advertising function. For the purposes of this paper, this only includes what Brown would have called the persuasive advertising,<sup>143</sup> as the informational advertising is more at home under the informational function. This function utilizes the trademark as a symbol that can be loaded with values and associations, making the symbol valuable in

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<sup>138</sup> H. Rosler, *supra* note 125, p. 104. *See also* L. Bently and B. Sherman, *supra* note 95, p. 718.

<sup>139</sup> *See* Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA*, *supra* note 61, para. 43.

<sup>140</sup> T. Cohen Jehoram et. al., *European trademark law: community trademark law and harmonized national trademark law* (Wolters Kluwer, Alphen aan den Rijn, 2010), p. 9.

<sup>141</sup> T. Cohen Jehoram et. al., *supra* note 140, p. 6.

<sup>142</sup> L. Bently and B. Sherman, *supra* note 95, p. 719.

<sup>143</sup> *See* L. Bently and B. Sherman, *supra* note 95, p. 718f.

itself.<sup>144</sup> The legitimacy of this function has been questioned, as it has been seen as a way of artificially isolating a good from similar goods, enabling the manipulation of demand, price and output.<sup>145</sup> It could be argued that this adds a non-physical experience value that may be as valuable to the consumer as any physical qualities, why the sustainability of this function should be protected. Whether it is desirable to protect this function is an important question, the answer to which can have influence on e.g. dilution doctrine, but for the purposes of this paper, it need not be answered.

To summarize then, there are three separate functions or justifications for protecting trademarks. The first, and for this paper most important, is the informational function; reducing search costs and inciting higher quality goods. The second (justification) is the ethical, and the third is the (persuasive) advertising function, which in line with the above can also be called the experience value function.

Lastly, it is worth repeating that while these are the functions invoked for the protection of trademarks it may be significant that the purpose of the TMD and the CTMR is not to fulfil these functions *per se* but to remove any impediment to the functioning of the internal market.<sup>146</sup> Thus, trademark law in the EU perspective is, as stated, an essential element of undistorted competition.

## 4.2 The requirements for registering a trademark

Simply put, there are the (absolute) requirements for a trademark in Article 4 CTMR, the absolute grounds for refusal in Article 7, and the relative (i.e. in relation to earlier marks) grounds for refusal in Article 8. Each of these will be shortly described to provide context for the later discussion.

Article 4 CTMR establishes three requirements for trademarks. The first is that it has to be a sign.<sup>147</sup> In regards to this requirement the ECJ stated in a case concerning the application for trademark protection of a transparent dust collector bin for vacuum cleaners that

“Article 2 is to be interpreted as meaning that the subject-matter of an application ...which relates to all the conceivable shapes of a transparent bin...forming part of the external surface of a vacuum cleaner, is not a

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<sup>144</sup> It is this development that has caused what was mentioned above as the conflation of a triadic structure to a dyadic, or even monadic structure.

<sup>145</sup> See L. Holmqvist, *supra* note 16, p. 719 and H. Rosler, *supra* note 125, p. 106.

<sup>146</sup> Also expressed as contributing to the establishment of a genuine system of competition in the internal market, see AG Colomer in Case C-363/99 *Postkantoor* [2004] ECR I-01619, para. 32.

<sup>147</sup> As has been noted, this includes anything capable of communicating information.

sign within the meaning of that provision and therefore is not capable of constituting a trade mark”<sup>148</sup>

Secondly, this sign has to be capable of being represented graphically. This does not exclude signs that are not visually perceivable, but they must be represented in a manner that is “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.<sup>149</sup> This requirement is mostly relevant in respect to non-traditional signs such as sounds and smells.<sup>150</sup> Thirdly, it has to be capable of distinguishing the goods or services of one undertaking from those of another. This last requirement is of the greatest interest to this paper and its relationship with Article 7 will be analyzed below.

Article 7 gives the absolute grounds for refusal and it is worthwhile to cite the distinctiveness provisions in full:

1. The following shall not be registered:
  - (a) signs which do not conform to the requirements of Article 4;
  - (b) trade marks which are devoid of any distinctive character;
  - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
  - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;[...]
2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.
3. Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

In Article 8 the relative grounds for refusal are listed. These deal with earlier marks similar to the applicant’s, but will not be dealt with in this paper.

Article 12 provides the flip side to Article 7(1)(c) providing that “A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade [...] (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service; [...] provided he uses them in accordance with honest practices in industrial or commercial matters.” Thus,

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<sup>148</sup> Case C-321/03 *Dyson* [2007] ECR I-00687. The case concerned the TMD, in which Article 2 is the equivalent of Article 4 in the CTMR.

<sup>149</sup> Case C-273/00 *Sieckmann* [2002] ECR I-11737, para. 55.

<sup>150</sup> See L. Bently and B. Sherman, *supra* note 95, p. 785ff.

the proprietor of ‘Baby-Dry’ cannot prohibit a third party from describing that their diapers “keep your baby dry”. This has often been used by the applicant to argue for a less strict approach to Article 7(1)(c).<sup>151</sup>

### 4.3 The relationships between and purposes of articles 7(1)(a) through (d)

Three relationships will be analyzed below. The first is the relationship between Article 4 and 7. The second is the relationship between Article 7(a) and 7(b)-(d). The third, and the most important for this paper, is the relationship between the provisions (b) through (d). The provisions under Article 7(1) will also simply be referred to as (a)-(d).

#### 4.3.1 The relationship between Article 4, Article 7(1)(a) and 7(1)(b)-(d)

Article 7(1)(a) has been expressed simply to be the negative mirror image of Article 4, restating that if not the requirements under Article 4 are fulfilled, the sign does not merit trademark protection.<sup>152</sup>

The relationship between (a) and (b)-(d) is not as certain. There are two obvious alternatives. The first is that (a) reiterates the *other* requirements under Article 4, i.e. that it constitutes a sign and that it can be represented graphically, while (b)-(d) specifies when a sign is distinctive.

The other alternative is that while distinctiveness under (b)-(d) has to be assessed in relation to a specific product or service, a sign may fall foul under (a) if it cannot be distinctive of *any* product or service.<sup>153</sup> Article 7(1)(a) could then include, *inter alia*, signs that are descriptive by law, such as the International Non-proprietary Names for Pharmaceutical Substances.<sup>154</sup> However, in Phillips, the Court stated clearly that there is no “category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”<sup>155</sup> Naturally, this does not apply vice-versa, that is, just because a sign in general is capable of constituting a

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<sup>151</sup> See *inter alia* AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 48.

<sup>152</sup> See S. Maniatis and D. Botis, *Trade marks in Europe: a practical jurisprudence* (Sweet & Maxwell, Thomson Reuters, London, 2010), p. 103.

<sup>153</sup> See T. Cohen Jehoram et. al., *supra* note 140, p. 130.

<sup>154</sup> See ‘Grounds for refusal of all types of mark’, WIPO/STrad/INF/5, 30 August 2010, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, World Intellectual Property Organization, <[http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo\\_strad\\_inf\\_5.pdf](http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_5.pdf)>, last viewed on 17 May 2011, p. 11.

<sup>155</sup> Case C-299/99 *Philips* [2002] ECR I-5475, para. 40.



trademark within the meaning of Article 4, does not mean that it is distinctive for the purposes of (b) in relation to a specific product.<sup>156</sup>

Thus even though Advocate General Ruiz-Jarabo Colomer distinguished “capable of distinguishing” from “distinctive character” by noting that the former expressed a potentiality while the latter expressed an actuality,<sup>157</sup> (a) has no role of its own in the assessment of distinctiveness, although a bigger role has been suggested for it.<sup>158</sup>

### 4.3.2 Relationship between and purposes of (b) through (d)

Because the relationships between the provisions are inseparable from the analysis of the purposes of the very same provisions, the two questions will be dealt with in parallel. The overlap, or even confusion, regarding the relationship between (b) and (c) can be seen in *UltraPlus* where the General Court discusses descriptiveness and ‘syntactically unusual juxtaposition’ under the header of distinctiveness, after having already decided that *UltraPlus* was not descriptive.<sup>159</sup>

In *Chiemsee* the Court recognized that 7(1)(c) “pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all.”<sup>160</sup>

However in *Baby-Dry* the Court treated (c) as a subset of (b), and as such fulfilling the origin identifying function, in stating that “the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is [...] to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”<sup>161</sup> The existence of a public interest underlying (c) was therefore uncertain.<sup>162</sup>

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<sup>156</sup> Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA*, *supra* note 61, para. 32.

<sup>157</sup> AG Colomer in Case C-299/99 *Philips*, *supra* note 155, para. 44. Advocate General Jacobs stated in *SAT.2* that (a) refers to the abstract capacity to distinguish, whereas (b) refers to the distinctiveness in relation to the class of products in question, giving the example of the ‘.’ in *SAT.2* saying that this sign would be precluded from registration both by (a) and by (b) whereas ‘SAT’ would only be precluded by (b). AG Jacobs in Case C-329/02 P *SAT.2* [2004] ECR I-08317, paras. 16-17. As this was not confirmed by the Court, it remains the opinion of the Advocate General and, in any case, it can be safely concluded that even if this opinion would be accepted this is not relevant in relation to neologisms.

<sup>158</sup> See C Case C-150/02 P *Streamserve* [2004] ECR I-01461.

<sup>159</sup> Case T-360/00 *UltraPlus* [2002] ECR II-03867, particularly paras. 47-49. See also AG Colomer in Case C-104/00 P *Companyline*, *supra* note 14, paras. 23-26, and paras. 37-43.

<sup>160</sup> Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, para. 25.

<sup>161</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 37.

<sup>162</sup> See AG Colomer in Case C-104/00 P *Companyline*, *supra* note 14, para. 36.

The Court came to this conclusion by interpreting the provision in light of Article 12, satisfying itself that this article sufficiently protected the interests of other traders.<sup>163</sup> This conclusion also showed the importance of this question as it led to a rather low threshold for registrability, more on which below under chapter 5.<sup>164</sup> The Advocate General, who had taken the same position, did so conscious of the fact that it did not rhyme with Chiemsee, where the existence of a need to keep certain signs free, and the irrelevance of Article 12 for the interpretation of Article 7(1)(c) had been expressed. He defended his position by stating that although the language in Chiemsee was general, it should only be seen as concerning geographical indications.<sup>165</sup> He also found support in that Chiemsee had explicitly stated that there was no *Freihaltebedürfnis*<sup>166</sup> in the Community trademark regime. A closer reading of Chiemsee, however, reveals that in rejecting the doctrine of *Freihaltebedürfnis*, the Court actually took an even stricter approach by stating that the application of (c) does not require a *real, current or serious* need to keep free, rather it is sufficient that it is reasonable to assume that such a need might exist in the future.<sup>167</sup>

In later cases, however, *Baby-dry* was partly overturned. In *Doublemint* the Court, while agreeing that descriptive signs are by their very nature non-distinct, reiterated Chiemsee in stating that (c) pursues the public interest in keeping these signs free to use by all.<sup>168</sup> That descriptive signs are also by their very nature non-distinct, and as such a subset of (b), and that the provision pursues the aim of keeping these signs free to use by all has since been confirmed by later cases.<sup>169</sup>

However, the provisions (b) through (d) are still held to be independent of each other, meriting separate examination, although the Court admits that there is a clear overlap. They also have to be interpreted in light of the public interest underlying each of them.<sup>170</sup> This may or even must reflect different considerations according to the ground for refusal in question.<sup>171</sup> In *SAT.2* the Court explicitly stated that the aim pursued under (c) is not relevant under (b).<sup>172</sup> It is important to note however, that apart from (c) the

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<sup>163</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 36.

<sup>164</sup> See AG Jacobs in Case C-329/02 P *SAT.2*, *supra* note 157, para. 28, expressing the opinion that ascribing such an interest will inevitably make the test for registrability more severe.

<sup>165</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, paras. 79-81.

<sup>166</sup> The German doctrine requiring a real, current or serious need to keep a sign free.

<sup>167</sup> Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee*, *supra* note 160, paras. 31 and 37. See also AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 17.

<sup>168</sup> Case C-191/01 P *Doublemint*, *supra* note 12, paras. 30-31.

<sup>169</sup> See *inter alia* Case C-326/01 P *Universaltelefonbuch* [2004] ECR I-01371, Case C-150/02 P *Streamserve*, *supra* note 158, Case C-363/99 *Postkantoor*, *supra* note 146.

<sup>170</sup> See M. Handler, 'The distinctive problem of European trade mark law', 27:9 *European Intellectual Property Review* (2005), p. P 307, and Case C-265/00 *Biomild* [2004] ECR I-01699, para. 34.

<sup>171</sup> Case C-329/02 P *SAT.2*, *supra* note 157, para. 25.

<sup>172</sup> Case C-329/02 P *SAT.2*, *supra* note 157, para. 36. See also Case C-37/03 P *BioID* [2005] ECR I-07975, para. 62, where this was confirmed. Cf. Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA*, *supra* note 61, paras. 47-48, where it is not entirely clear if the

Union Courts has accepted that there is a need to keep free also in relation to colours and shapes.<sup>173</sup>

Thus, the Court has accepted that (c) and (d) are subsumable under (b), in that all signs that fall foul of either (c) or (d) also fall foul of (b). The language in Article 7(3), which states that a sign falling foul of any of the grounds (b) through (d) may still be registered if they have acquired *distinctiveness*, supports this.<sup>174</sup> This is also mirrored in the proposal for the TMD where descriptiveness and customariness are treated as examples of non-distinctiveness.<sup>175</sup> Further this understanding is reflected in the new Swedish trademark law.<sup>176</sup>

OHIM takes the same position as is shown by its guidelines. These Examination Guidelines state that each ground should be reasoned separately and that if the sign has a descriptive meaning, that is immediately apparent to the relevant public, the sign is also non-distinct.<sup>177</sup> Thus, when a sign is a word mark with a semantic meaning, it shall first be examined under (c) and then under (b), and all grounds shall be given separate motivations, preferably under separate headings.<sup>178</sup>

Thus, the position of the Court on the relationships between and the purposes of the provisions (b) through (d) are now reasonably clear. Should any doubt have lingered regarding the Court's position, in a very recent case, the Court confirmed its position in the most explicit language to date.<sup>179</sup> This position has been criticised however, why the desirability of the position will be discussed under chapter 6.

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Court only acknowledges the interest not to unduly restrict the availability of colours under (b), or intimidates a certain need to keep free under (b) also. In any case, they recognize the origin identifying function of (b) also.

<sup>173</sup> T. Cohen Jehoram et. al., *supra* note 140, p. 139. Cf AG Jacobs in Case C-329/02 P SAT.2, *supra* note 157, para. 26, distinguishing the need of 'not unduly restricting' the availability of colours as something slightly different from the aim pursued under (c), why Case C-104/01 Libertel [2003] ECR I-3793, is not acknowledging the public interest under (c) as also applicable under (b).

<sup>174</sup> See M. Handler, *supra* note 170, p. 309.

<sup>175</sup> Proposal for a first Council Directive to approximate the laws of the Member States relating to trade marks, November 25, 1980 [1980] O.J. C351/1, Art.2(1).

<sup>176</sup> See Prop. 2009/10:225 Ny varumärkeslag och ändringar i firmalagen, p. 164.

<sup>177</sup> OHIM, 'The manual concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part B: Examination', in the version of 17.05.2011, p. 26.

<sup>178</sup> OHIM Examination Guidelines, *supra* note 177, p. 22.

<sup>179</sup> Case C-51/10 P *I000* [2011] n.y.r., paras. 33 and 37.

# 5 The descriptiveness provision as regards neologisms

## 5.1 Descriptiveness under (c)

To be refused under this provision are trademarks which *consist exclusively* of *signs or indications* which *may serve*, in trade, to *designate* the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.

Below follows an explanation of the different kinds of designations that are excluded. Some of the examples from WIPO<sup>180</sup> are taken from national offices outside of EU, but from states that are members of the Paris Convention, why they are still helpful as examples. Even though this summation below somewhat anticipates the case law review below and could therefore be more at home after the review under chapter 5.3, it is helpful when reading the cases to have in mind these different categories of designations covered under the provision. As the following includes examples from the doctrine, some of which are based in the case law but others are not, they should be seen as exemplary, rather than legally binding.

*The kind* is the type or nature of the goods or services. This includes the generic term of the good.<sup>181</sup> Examples are ‘Bank’ for financial services or ‘Universaltelefonbuch’ for a universal telephone directory.<sup>182</sup> Another example is ‘Tourmaline soap’ for soap containing tourmaline.<sup>183</sup>

*The quality* of the goods or services includes both generally laudatory terms, more on which below, referring to a superior quality, and qualities inherent to the goods or services.<sup>184</sup> The latter category may include ‘stainless’ while the former may include ‘extra’,<sup>185</sup> ‘light’, ‘superior’, ‘elite’, ‘fresh’ etc.<sup>186</sup> Examples from national offices include ‘No1 in Air Conditioning’, ‘Jumbo’ for meat products and sea food, ‘Best food’, ‘Diet cookie’ and ‘Garantia de calidad total’.<sup>187</sup>

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<sup>180</sup> WIPO, *supra* note 154.

<sup>181</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>182</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>183</sup> WIPO, *supra* note 154, p. 10.

<sup>184</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>185</sup> See below for the registrability of ‘Extra’.

<sup>186</sup> L. Holmqvist, *supra* note 16, p. 91, and OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>187</sup> WIPO, *supra* note 154, p. 11.

*The quantity* covers indications of how the goods are usually sold, such as ‘six pack’ for beer, ‘100’ (gram) for chocolate bars, ‘2000’ referring to the size of the motor for cars.<sup>188</sup> Important to note is that only those quantity measures that are relevant in trade, and not those that are hypothetically possible, are relevant for the assessment.<sup>189</sup> Put differently, and in regards to unaccompanied numerals, the provision is applicable only when it is reasonable to believe that, in the mind of the relevant public, the quantity indicated by a numeral characterizes the goods or services applied for.<sup>190</sup> When the goods or services is of such a nature that it is easily and typically designated by a numeral indicating the number of units they contain, it is reasonable to believe that the numeral will be recognized as a description of that quantity.<sup>191</sup> Quantity may cover weight, dimensions, volume etc. Numerals are not automatically non-distinctive, even when not graphically stylized.<sup>192</sup> As in the examples given above, it is clear however, that numbers may very well fall foul of the provision.

*The intended purpose* covers the way or the means of application, as well as the function in which a good or service is to be used.<sup>193</sup> As will be shown, it even covers accessories.<sup>194</sup> This ground is not to be confused with the kind of the goods. Intended purpose would cover ‘Inhale’ for pharmaceuticals one can inhale, and ‘Therapy’ for massage tools.<sup>195</sup> Other examples are ‘antiKALK’ (anti-lime) for, *inter alia*, water softening products and descaling detergents, and ‘beauty24.de’ for cosmetics.<sup>196</sup> It would also cover ‘Lightning’ for lightning rods, ‘Blonde’ for hair colouring and ‘Baby’ for strollers.<sup>197</sup>

*Value* covers the price to be paid, whether high or low, as well as the value in quality.<sup>198</sup> Examples are ‘Extra’, ‘Top’, ‘Cheap’ and ‘More for your money’.<sup>199</sup> Examples from national offices are ‘250 yen lunchbox’ and ‘100 pesos’ for alcoholic beverages, although the latter was refused as being misleading or deceiving.<sup>200</sup>

*The time of production* of the goods, or of rendering of the service covers the time on which services are rendered, such as ‘evening news’, ‘24 hours’ or ‘24/7’.<sup>201</sup> It also covers the time the goods were produced, but only if this is relevant for the type of good; ‘1998’ would be acceptable for chocolate

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<sup>188</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>189</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>190</sup> Case C-51/10 P 1000, para. 52.

<sup>191</sup> Case C-51/10 P 1000, *supra* note 179, para. 56.

<sup>192</sup> Case C-51/10 P 1000, *supra* note 179, paras. 29-31. *See also* L. Holmqvist, *supra* note 16, p. 91.

<sup>193</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>194</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>195</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>196</sup> WIPO, *supra* note 154, p. 12.

<sup>197</sup> L. Holmqvist, *supra* note 16, p. 91.

<sup>198</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>199</sup> OHIM Examination Guidelines, *supra* note 177, p. 29.

<sup>200</sup> WIPO, *supra* note 154, p. 13.

<sup>201</sup> OHIM Examination Guidelines, *supra* note 177, p. 30.

but not for wine.<sup>202</sup> ‘Cosecha 54’ was refused for alcoholic beverages as describing the vintage.<sup>203</sup> Designations such as ‘Antique’ might also be covered.<sup>204</sup>

By ending the provision with ‘*other characteristics of the goods or service*’ it is clear that the list is open-ended.<sup>205</sup> Any other relevant characteristics must lead to a refusal.<sup>206</sup> This includes the subject matter,<sup>207</sup> e.g. ‘Elektronika’ for a trade fair, a definition of the targeted consumers, e.g. ‘Children’ or ‘Ellos’ for clothing, and technical characteristics, e.g. ‘Trustedlink’ for goods and services in the IT sector aiming at securing a safe (trusted) link.<sup>208</sup>

## 5.2 The cases

Below follows the cases important for the analysis. The order is chronological to show the development of the case law. This means that in some cases, where the opinion of the Advocate General is deemed important for the analysis, the judgment of the Court and the opinion may be separated by other judgments or opinions. In each chapter heading, the instance under review is given, although of course the ECJ or the Advocate General may refer to statements made by the General Court, which will then be included under the header of ECJ or AG. In chapter 5.3 a thematically structured summary of what can be concluded from the case law will be given.

In the following, the terms used by the Union Courts will also be used here. This means that the use of *signs*, *marks*, etc will not necessarily reflect the understanding gained in the semiotic analysis in the preceding chapter.

### 5.2.1 Chiemsee (ECJ)

The case regarded the geographical name Chiemsee, a lake in Bavaria. The Court stated that under (c) “the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, *or whether it is reasonable to assume that such an association may be established in the future.*”<sup>209</sup>

Importantly the Court rejected the German doctrine of *Freihaltebedürfnis* as the application of (c) does not depend on there being a real, current or

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<sup>202</sup> OHIM Examination Guidelines, *supra* note 177, p. 30.

<sup>203</sup> WIPO, *supra* note 154, p. 14.

<sup>204</sup> L. Holmqvist, *supra* note 16, p. 92.

<sup>205</sup> Case C-51/10 P 1000, *supra* note 179, para. 49.

<sup>206</sup> OHIM Examination Guidelines, *supra* note 177, p. 30.

<sup>207</sup> The issue of subject matter will be discussed further below.

<sup>208</sup> OHIM Examination Guidelines, *supra* note 177, p. 30.

<sup>209</sup> Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee*, *supra* note 160, para. 31. Emphasis added.

serious need to leave a sign or indication free.<sup>210</sup> In this context, it is important to note that this is not a refutation of the stated purpose of the provision as it has sometimes been argued. Rather, the Court established an even stricter test under (c), where even where it is reasonable to assume that the term may be used to designate a characteristic in the future, the provision is applicable.

## 5.2.2 Baby-Dry (AG)

In this case the applicant had sought to register Baby-Dry for diapers. This case has arguably lost some of its relevance as parts of it has been overruled, or at least nuanced or qualified to such an extent, that the reading of this case alone will give a misleading impression of the requirements under (c). This can also be seen in the fact that many applicants cite this case in support for a low threshold of registrability despite there being more recent case law available.

The case is still important for two reasons; the first being that it is the starting point for the case law on neologisms. The second reason is that the Court has been unwilling to explicitly overrule the case, possibly because the Court sat in plenary while deciding it, why it is constantly referred to, and the requirements laid down in the case are to some extent still used, although in a manner that would hardly look intuitive while reading Baby-Dry.<sup>211</sup>

As explained above, Baby-Dry seemingly did away with the public interest underlying (c) as described in *Chiemsee*. The Advocate General noted in his opinion that even OHIM shared the opinion that the provision only served to prohibit signs that did not fulfil the essential function of trademarks from being registered.<sup>212</sup>

The Advocate General stated that the term Baby-Dry was not to his “knowledge used in ordinary language to refer to such items or their intended purpose, nor has it been suggested that it is.”<sup>213</sup> He also went on to state that if, when hearing or reading the sign disconnected from any specific product, it could be taken to suggest products as diverse as “talcum powder, rain hoods for prams, compact tumble-dryers or drinks presented in small bottles” that would speak against the signs being able to designate diapers with any precision.<sup>214</sup>

He also stated that the sign’s character as a neologism would make it considerably less likely to be used as a descriptive term in trade.<sup>215</sup> Further, important factors when assessing the sign under (c) in the case of Baby-Dry

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<sup>210</sup> Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee*, *supra* note 160, para. 35.

<sup>211</sup> See AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 70.

<sup>212</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 53.

<sup>213</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 85.

<sup>214</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 86.

<sup>215</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 91.

was said to be the sign's "extreme ellipsis, unusual and opaque grammatical structure, incompleteness as a description and inventiveness"<sup>216</sup> all of which supported the registrability of the sign. It can be noted that these factors are very much overlapping as the 'extreme ellipsis' presumably refers to that Baby-Dry only makes sense in a sentence like "keep your baby dry", while the 'unusual and opaque grammatical structure' would refer to the inverted word order. However, the word order is inverted only if we assume that there is no ellipsis, otherwise, as shown, the word order is grammatically correct and unsurprising. The 'incompleteness of the description' is the same as the ellipsis, while the 'inventiveness' would, presumably, constitute the ellipsis or the inverted word order.

### 5.2.3 Baby-Dry (ECJ)

Overall, the Court agreed with the opinion but used slightly different language. The provision covered those signs, which *may serve in normal usage* from a consumer's point of view to designate a characteristic. The provision is applicable only when the sign comprises no non-descriptive elements, and where it is not presented or configured in such a manner as to distinguish the resultant whole from the *usual way* of designating the goods or services or *their essential characteristic*.<sup>217</sup>

Although a sign may be composed of several elements, each of which may be descriptive, the assessment must also be made in relation to the whole that they form.<sup>218</sup> Importantly the Court stated that any "perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."<sup>219</sup> The determination, then, is to be made by assessing whether the sign in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.<sup>220</sup> It is this, seemingly very low threshold, which has been qualified in later cases.

As regards the sign Baby-Dry the Court noted that it had a syntactically unusual juxtaposition, i.e. inverted word order, and that it was not a familiar expression for designating diapers or for describing their essential characteristics.<sup>221</sup> This was sufficient for the Court to deem that the sign could not be refused under (c).<sup>222</sup>

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<sup>216</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para 96.

<sup>217</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 39.

<sup>218</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 40.

<sup>219</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 40.

<sup>220</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 42.

<sup>221</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 43.

<sup>222</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 44.



## 5.2.4 New born baby (GC and AG)

The word mark ‘New Born Baby’ had been applied for dolls and for accessories to these dolls. In this case, two topics of interest were discussed. Both regarded what the term could be descriptive of and still fall within (c).

The first regarded whether it was sufficient that the word mark described what the doll represented, to conclude that it was descriptive of the dolls themselves. Surprisingly the General Court found that this was not so, why the term had not been shown to be designate a quality or other characteristics of dolls.<sup>223</sup>

The second issue regarded whether the term could be seen as descriptive of accessories to the dolls. The General Court found that the “fact that goods are intended to be accessories for other goods, in relation to which the sign in question is descriptive, is not in itself sufficient to render the sign descriptive in relation to the accessories.”<sup>224</sup>

The Advocate General rejected both these conclusions in his opinion. Whereas a term which is descriptive of what a toy represents is not directly descriptive of the toy itself, it is an essential characteristic of many toys that they represent something. The term would thus be caught by the provision under ‘other characteristic’. If this wasn’t so, anyone could register the term ‘Motorcycle’ for toy motorcycles, something which would surely not be compatible with the provision.<sup>225</sup>

As regards accessories he also found the General Court’s reasoning to be flawed. By its very definition the intended use of an accessory is intimately linked to the product. ‘Shoe’ would be descriptive not only for shoes, but also for shoe trees or shoe polish.<sup>226</sup>

Following the opinion the applicant withdrew the application to register the trademark, why the Court never ruled on the issue. However, the General Court confirmed the opinion in *Rockbass*, stating that it was descriptive not only of guitars but also of their accessories, as they were inseparably linked.<sup>227</sup>

## 5.2.5 Postkantoor (AG)

The sign which means ‘post office’ was applied as a word sign for paper, card and products manufactured therefrom, and a wide variety of services.<sup>228</sup> The Advocate General delivered his opinion shortly after *Baby-Dry*. He noted that a combination of components, each of which is devoid of

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<sup>223</sup> Case T-140/00 *New Born Baby* [2001] ECR II-02927, paras. 25-27.

<sup>224</sup> Case T-140/00 *New Born Baby*, *supra* note 223, para. 31.

<sup>225</sup> AG Jacobs in Case C-498/01 P *New Born Baby* [2004] ECR I-11349, paras. 27-28.

<sup>226</sup> AG Jacobs in Case C-498/01 P *New Born Baby*, *supra* note 225, para. 38.

<sup>227</sup> Case T-315/03 *Rockbass* [2005] ECR II-01981, paras. 67-69.

<sup>228</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 2.

distinctive character may nonetheless be distinctive, provided that it amounts to more than just a mere sum of its parts.<sup>229</sup> Going on to analyze when this is so, he cites, and takes issue with, Baby-Dry and its statement that *any perceptible difference* between the sign and the terms used in the common is apt to confer distinctive character on the word combination, enabling it to be registered as a trade mark:

“If that, purely minimum, test is not tempered by the ‘requirement of availability’ approach, to which the judgment in question did not refer, I do not believe that it is capable of ensuring that trade marks are not essentially descriptive in nature.”<sup>230</sup>

The Advocate General proposes that a difference should be seen as perceptible if it affects important components of either the form of the sign or its meaning:<sup>231</sup>

“As regards form, a perceptible difference arises where, as a result of the unusual or imaginative nature of the word combination, the neologism itself is more important than the sum of the terms of which it is composed. As regards meaning, a difference will be perceptible provided that whatever is evoked by the composite sign is not identical to the sum of that which is suggested by the descriptive components.”<sup>232</sup>

He goes on to explain that while Article 6(1) of the TMD (the equivalent of Article 12), does preclude the proprietor of a trade mark from preventing the use of such indications by third parties, it does not preclude him from preventing third parties from the use of such indications as trademarks, thus maintaining the advantage initially acquired over a resource that is very likely to be exhausted, such as descriptive terms with positive associations.<sup>233</sup>

With this in mind, he concludes that “the existence of synonyms or the essential, or incidental, nature of the descriptive element of a sign are immaterial to the assessment of distinctive character.”<sup>234</sup>

## 5.2.6 Streamserve (GC)<sup>235</sup>

In this case the applicant had sought to register Streamserve for, basically, products and services for streaming data. The applicant held that ‘serve’ is not an abbreviation of server, and that account should be taken of the more

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<sup>229</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 65.

<sup>230</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 69.

<sup>231</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 70. Differently put, a perceptible difference is required either in appearance or in the semantic content, *see* AG Colomer in Case C-104/00 P *Companyline*, *supra* note 14, para. 51.

<sup>232</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 69.

<sup>233</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 74.

<sup>234</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 75.

<sup>235</sup> The Court simply confirmed the reasoning of the General Court in its own judgment 5th of February 2004, Case C-150/02 P *Streamserve*, *supra* note 158.

general meanings, such as to be “a ‘servant to somebody’, ‘work for somebody’, ‘supply with goods and services’ or ‘be satisfactory for a need or purpose’.”<sup>236</sup> This line of argument is similar to that in Doublemint below. The General Court held that it is sufficient if at least one of the potential meanings of a word sign designates a characteristic of the goods or services concerned.<sup>237</sup>

As regards the meaning, the General Court held that the technique of streaming does not “merely constitute a field in which those goods are applied but rather is one of their specific functions”<sup>238</sup> and that accordingly, there was a “sufficiently direct and specific relationship between the term STREAMSERVE and those goods.”<sup>239</sup>

In contrast, with regards to ‘manuals’ and ‘publications’ the General Court held that the term Streamserve was not proven to designate the characteristics of those goods, stating that the transfer of texts by streaming is at most a field of application but not a technical function.<sup>240</sup> Thus, the mark was registrable for those goods. This conclusion is interesting in relation to the question of subject matter, which will be discussed below.

### 5.2.7 UltraPlus (GC)

This case from the General Court concerned the sign UltraPlus for plastic ovenware. Only a year after BabyDry, the General Court still reiterated the public interest as underlying the provision, citing a case from the General Court that postdates BabyDry by only a couple of months.<sup>241</sup>

The General Court analyzed the elements Ultra and Plus, and concluded that if Ultra had been combined with an adjective, it would have reinforced this adjective, and the sign as a whole would still have been descriptive,<sup>242</sup> but as neither Ultra nor Plus designates a characteristic of plastic ovenware, it is not apparent “that the relevant public would immediately and without further reflection make a definite and direct association between plastic ovenware and ‘UltraPlus’”<sup>243</sup>

Thus, a sign is registrable where it only extols, indirectly and abstractly, the excellence of a product, without, directly and immediately, informing the consumer of one or more specific qualities, as this is an evocation rather

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<sup>236</sup> Case T-106/00 *Streamserve* [2002] ECR II-00723, para. 24.

<sup>237</sup> Case T-106/00 *Streamserve*, *supra* note 236, para. 42. Note that the *Streamserve* judgment postdates the judgment of the General Court in *Doublemint*, not here reviewed, which was handed down 31 January 2001, where the General Court seemed to take a contradictory stance in relation to the question of multiple meanings, as is described below. *See also* Case T-358/00 *Truckcard* [2002] ECR II-01993.

<sup>238</sup> Case T-106/00 *Streamserve*, *supra* note 236, para. 44.

<sup>239</sup> Case T-106/00 *Streamserve*, *supra* note 236, para. 44.

<sup>240</sup> Case T-106/00 *Streamserve*, *supra* note 236, para. 50.

<sup>241</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 21.

<sup>242</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 24.

<sup>243</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 26.

than a designation for the purposes of (c).<sup>244</sup> Importantly however, such a sign may still fall foul of (b).<sup>245</sup> The General Court, in analyzing the sign in relation to (b), confusedly goes on to note the syntactically unusual juxtaposition, and the fact that it is not used descriptively for plastic goods, concluding that the sign is in fact distinctive.<sup>246</sup> However right the conclusion might be, the arguments put forward are more at home under (c) and (d), why the case is not very informative for the assessment to be made under (b).

## 5.2.8 Doublemint (AG)

In Doublemint the Court was confronted with the statement by the General Court that since the word Doublemint had several possible meanings, it was not *exclusively* descriptive, rather it was ambiguous and suggestive;<sup>247</sup> it could mean that double the amount of mint had been used, or that there were two types of mint used. This interpretation was summarily rejected by the Advocate General, as the word ‘exclusively’ in the provision does not preclude the application of the provision where a sign has several possible meanings. Rather it qualifies the word ‘consist’ and thus precludes the application for signs which has non-descriptive elements in a composite word.<sup>248</sup>

He went on to state that it:

“is immediately possible to think of many other instances of general characteristics which may require further definition before the consumer can be sure of what is referred to but which none the less quite clearly remain characteristics of the product in question. To take but one example, to qualify a product as ‘natural’ is undoubtedly to designate one of its characteristics, whilst leaving any consumer in considerable doubt as to the precise nature of that characteristic, unless further details are provided. Indeed, it is relatively difficult to find ‘indications which may serve to designate characteristics’ which do not call at some level for further precision.”<sup>249</sup>

This take on why Doublemint should not be registrable will be relevant to the later analysis as it will be argued that the Court restated this in too general terms, which may result in too broad a scope of (c).

The Advocate General proposed that a sign should be assessed from three points of view. The first would be the way in which a term relates to a product or one of its characteristics. The more factual and objective the relationship, the likelier it is that the term may be used as a designation of

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<sup>244</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 27.

<sup>245</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 30.

<sup>246</sup> Case T-360/00 *UltraPlus*, *supra* note 159, paras. 47-54.

<sup>247</sup> See AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 12-14.

<sup>248</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 39.

<sup>249</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 43.

the product or characteristic. Conversely, the more imaginative and subjective the relationship the more likely that the term does not fall foul of (c).<sup>250</sup>

The second point of view concerns how the sign is perceived. It is the immediacy of the message that is relevant. The more ordinary, definite and down-to-earth a term is, the more likely it is that it may be used as a designation.<sup>251</sup> Where the “skills of a cryptic-crossword enthusiast are needed in order to detect any connection with the designated characteristic” the provision should not apply.<sup>252</sup>

The third, and last, point of view relates to the significance of the characteristic. If it is essential to the product, or is of particular importance in a consumer’s choice, the more reason for refusing the sign exists. Where the designated characteristic is purely incidental or arbitrary, the case for refusing is considerably weaker.<sup>253</sup>

However, in the opinion, he stressed that, as alluded to above, the question of precision, accuracy or factual correctness is not normally relevant to the examination from any of those points of view.<sup>254</sup>

Applying this test to Doublemint he found that:

“First, the compound term is a factual, objective reference to mint flavour in some way doubled; second, it is readily perceivable as such; and third, such a flavour is a salient feature of the product. The fact that neither the particular variety or varieties of mint involved nor the precise mode of doubling can be discerned in no way detracts from the fact that the term designates a characteristic of doubled mintiness.”<sup>255</sup>

## 5.2.9 Doublemint (ECJ)

Largely agreeing with the opinion, the Court stated that it is indeed sufficient that a word *could* be used in a descriptive way.<sup>256</sup> Therefore, the Court concluded, a sign must be refused if *at least one of its possible meanings* designates a characteristic of the goods or services concerned.<sup>257</sup>

## 5.2.10 Universaltelefonbuch (ECJ)

This case regarded community trade mark applications for Universal-telefonbuch (Universal Telephone Book) and Universalkommunikations-

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<sup>250</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 62.

<sup>251</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 63.

<sup>252</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 63.

<sup>253</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 64.

<sup>254</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 65.

<sup>255</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 67.

<sup>256</sup> Case C-191/01 P *Doublemint*, *supra* note 12, para. 32.

<sup>257</sup> Case C-191/01 P *Doublemint*, *supra* note 12, para. 32.

verzeichnis (Universal Communications Directory). In this case the Court confirmed Doublemint, stating that it is not necessary that the term be in descriptive use at the time of the application; it is sufficient that the term could be used for such a purpose.<sup>258</sup> The Court went on to state that “thus [...] registration of a word mark must be refused if at least one of its possible meanings designates a characteristic of the goods or services concerned”.<sup>259</sup>

The Court agreed with the General Court that the word was formed in accordance with the grammatical rules of the German language and composed of common German words.<sup>260</sup> Moreover, it agreed with the General Court that “it is sufficient that the sign is, in the eyes of the target public, associated with the goods concerned or *that it may be reasonably envisaged* that such an association will be made in the future.”<sup>261</sup> As such “the fact that there is currently no market for universal telephone or communication directories does not alter the descriptive character of the words in question.”<sup>262</sup>

The Court also stated that since the target public could *immediately and without further reflection* establish a *specific and direct association* between those words and the goods and services, the application was rightly refused under (c).<sup>263</sup> Refuting the argument that only a minimal level of distinctiveness is required the Court stated that (c) does not only apply to signs and indications which are totally devoid of distinctive character.<sup>264</sup>

### 5.2.11 Postkantoor (ECJ)<sup>265</sup>

The Court, delivering its judgment a full two years after the opinion, seems to have accepted, the gist of the opinion. By reiterating the public interest underlying (c) the Court, *mutatis mutandis*, restated Chiemsee in that it is not decisive whether the sign currently represents a description of the characteristics of the goods. Rather it is sufficient that it is *reasonable to assume* that this might be the case in the future.<sup>266</sup> Thus, it is not necessary that the sign is in use at the time of the application as long as it could be used.<sup>267</sup> A word must therefore be refused registration under (c) if at least one of its possible meanings designates a characteristic of the goods.<sup>268</sup>

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<sup>258</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 28.

<sup>259</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 28.

<sup>260</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 30.

<sup>261</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 31.

<sup>262</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 31.

<sup>263</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 33.

<sup>264</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 34.

<sup>265</sup> The Court delivered judgment in Case C-265/00 *Biomild*, *supra* note 170, at the same date using, *mutatis mutandis*, the same language.

<sup>266</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 56.

<sup>267</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 97.

<sup>268</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 97.

The Court confirmed that the existence of other, more usual, signs or indications for designating the same characteristics is irrelevant.<sup>269</sup> It added that the number of competitors who may have an interest in using the sign is also irrelevant.<sup>270</sup> The Court also stated that it is irrelevant if the characteristic designated is *commercially essential* or *merely ancillary*,<sup>271</sup> thus possibly overruling Baby-Dry in this respect.

Whether a mark has distinctive character must firstly be assessed by reference to the relevant goods or services and, secondly, by reference to the way in which it is perceived by the relevant public.<sup>272</sup> The Court reiterated that the word must be assessed as a whole.<sup>273</sup>

When a neologism is made up of a mere combination of several elements, each of which is descriptive, it is itself descriptive, if it does not introduce any unusual variations.<sup>274</sup> Thus, there is a presumption that the bringing together of descriptive elements results in a descriptive whole. However as the examiner has to assess the word as a whole, he cannot stop at assessing the elements just because the applicant has failed to put forward evidence of the unusualness of the combination.

There must be, as stated earlier, a *perceptible difference* between the word and the mere sum of its parts.<sup>275</sup> This might come about if the unusual combination of elements makes the impression *sufficiently far removed* from that produced by the *mere combination* of those elements.<sup>276</sup> In the case of a word mark that condition must be met in regards both to the aural and the visual impression.<sup>277</sup> It might also come about if the word “has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”<sup>278</sup> What this means will be analyzed below.

Lastly, the Court stated that the use of disclaimers is precluded by the TMD.<sup>279</sup>

## 5.2.12 Eurohypo (GC and ECJ)

The applicant had sought to register the sign ‘Eurohypo’ for services in Class 36 of the Nice Agreement of 15 June 1957 concerning the

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<sup>269</sup> Case C-363/99 *Postkantoor*, *supra* note 146, paras. 57 and 101.

<sup>270</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 58.

<sup>271</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 102.

<sup>272</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para 75.

<sup>273</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 96.

<sup>274</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 98.

<sup>275</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 100.

<sup>276</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 99.

<sup>277</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 99.

<sup>278</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 100.

<sup>279</sup> Case C-363/99 *Postkantoor*, *supra* note 146, paras. 111-117.

International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended ('the Nice Agreement'), corresponding to the following description: 'financial affairs; monetary affairs; real estate affairs; provision of financial services; financing ...'.

The General Court, after having noted that the components Euro and Hypo were both descriptive of the services, found that;

“In the present cases the word sign EUROHYPO is a straightforward combination of two descriptive elements, which does not create an impression sufficiently far removed from that produced by the mere combination of the elements of which it is composed to amount to more than the sum of its parts. The applicant has not shown that that compound word had become part of everyday language and had acquired a meaning of its own. It argues, to the contrary, that the word sign EUROHYPO has not become part of everyday German for describing financial services.”<sup>280</sup>

Once again, the Union Courts show confusion when there is interplay of the distinctiveness provisions. The Court criticised the General Court for having had regard to whether the word had become a part of everyday language and had acquired a meaning of its own. It did so because in its view “while this criterion is relevant in the context of Article 7(1)(c) of Regulation No 40/94, it cannot form a basis for the interpretation of Article 7(1)(b).”<sup>281</sup>

### 5.2.13 Color edition (ECJ)

The applicant had applied with the word mark Color Edition for cosmetics and make-up preparations. The General Court had found that there was a sufficiently direct and specific relationship between the mark and the products,<sup>282</sup> and that it was “exclusively composed of indications designating certain characteristics of the goods in question and that it did not create, for the target public, an impression sufficiently far removed from that produced by the simple juxtaposition of the verbal elements of which it was composed.”<sup>283</sup>

Citing Baby-Dry the applicant submitted that a mark is only descriptive if it is found that the terms chosen and their association are known and used habitually in the everyday language of the target public.<sup>284</sup>

The Court found it to be settled case-law that, as a general rule, the mere combination of descriptive elements, is itself descriptive under (c). It restated and thereby confirmed the wording of Postkantoor.<sup>285</sup>

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<sup>280</sup> Case T-439/04 *Eurohypo* [2006] ECR II-01269, para. 55.

<sup>281</sup> Case C-304/06 P *Eurohypo* [2008] ECR I-03297, para. 61.

<sup>282</sup> See, Case C-408/08 P *Color Edition* [2010] n.y.r., para. 20.

<sup>283</sup> See, Case C-408/08 P *Color Edition*, *supra* note 282, para. 21.

<sup>284</sup> Case C-408/08 P *Color Edition*, *supra* note 282, para. 56.

<sup>285</sup> Case C-408/08 P *Color Edition*, *supra* note 282, paras. 61-62.



## 5.2.14 1000 (ECJ)

In this very recent case from March 2011, the applicant had applied with the sign ‘1000’ as a CTM for brochures, periodicals, including periodicals containing crossword puzzles and rebus puzzles, and newspapers.<sup>286</sup>

The Court started by pointing out that a sign composed exclusively of a numeral may not automatically be refused, finding support in the explicit mention of numerals in Article 4 of the CTMR.<sup>287</sup> This is true even when there is no stylization present.<sup>288</sup> The Court also rehashed that it is sufficient that a sign could be used as a designation.<sup>289</sup> As there is no *Freihaltebedürfnis*, the number of interested competitors or the existence of more usual signs designating the same characteristic is irrelevant.<sup>290</sup>

The Court took the opportunity to explicitly state that Baby-Dry could not be relied upon in arguing that the sign applied with is not the usual way of designating the relevant goods, and that it should therefore be registered, as this is simply not a requirement for the application of (c).<sup>291</sup>

The Court added that a sign may only be refused if it is *reasonable to believe* that it will actually be recognized by the relevant class of persons as a description of one of those characteristics.<sup>292</sup> In respect of signs composed exclusively of numerals, this means that in order for it to be refused “it must be reasonable to believe that, in the mind of the relevant class of persons, the quantity indicated by those numerals characterises the goods or services in respect of which registration is sought.”<sup>293</sup> Regarding when it is reasonable to believe this the Court stated that where:

“an application for registration refers, in particular, to a category of goods the content of which is easily and typically designated by the numeral indicating the number of units they contain, it is reasonable to believe that a sign composed of numerals – such as that at issue – will actually be recognised by the relevant class of persons as a description of that quantity and therefore as a characteristic of those goods.”<sup>294</sup>

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<sup>286</sup> Case C-51/10 P 1000, *supra* note 179, para. 8.

<sup>287</sup> Case C-51/10 P 1000, *supra* note 179, paras. 29-30.

<sup>288</sup> Case C-51/10 P 1000, *supra* note 179, para. 31.

<sup>289</sup> Case C-51/10 P 1000, *supra* note 179, para. 38.

<sup>290</sup> Case C-51/10 P 1000, *supra* note 179, para. 39.

<sup>291</sup> Case C-51/10 P 1000, *supra* note 179, para. 40.

<sup>292</sup> Case C-51/10 P 1000, *supra* note 179, para. 50.

<sup>293</sup> Case C-51/10 P 1000, *supra* note 179, para. 52.

<sup>294</sup> Case C-51/10 P 1000, *supra* note 179, para. 56.

## 5.3 Conclusions

Under chapter 6 an analysis is made that is informed by the semiotic analysis. This will deal with some issues meriting closer scrutiny, many of which can be clarified by the semiotic understanding gained under chapter 2. For this reason, and to avoid repetition, the following will not deal with the overarching issue of registrability under the descriptiveness provision, but will rather deal with various specific issues with which the Union Courts have dealt.

### 5.3.1 Starting point

It is the ordinary understanding of the word that constitutes the reference base for the assessment, and as such, what is primarily of interest is the ordinary and plain meaning of the word.<sup>295</sup> Specialist terminology is covered, and in these cases it is not required that the meaning is readily apparent to the end consumer.<sup>296</sup> The provision covers the scientifically correct terms, but is not limited to them.<sup>297</sup> This applies also to abbreviations, which must be commonly understood, if only by the relevant specialists.

### 5.3.2 Who is the relevant public and how much does it know?

The question of who is the relevant public is a topic worthy of an exploration of its own. Suffice it here to note that it most readily includes the end consumer, which may include specialists, but that it may possibly also include other traders:

“From a slightly different point of view, I would suggest that the difference — the addition of at least one element, or the subtraction of some significant element — must be such that it is apparent **to both traders (35) and consumers** that the mark as a whole is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.”<sup>298</sup>

An important question that is usually not directly analyzed is how much the relevant public knows in the assessment whether it would recognize a sign as a description or as identifying origin. The assessment would be very different depending on whether the relevant public perceives the sign completely free of any context, if it knows the class of goods, or the good itself. In one article, it is argued that a consumer will recognize a trademark as identifying origin rather than describing the product, no matter how

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<sup>295</sup> OHIM Examination Guidelines, *supra* note 177, p. 27.

<sup>296</sup> Joined cases T-367/02 to T-369/02 *SnTEM* [2005] ECR II-00047, para. 35. *See also* OHIM Examination Guidelines, *supra* note 177, p. 27f.

<sup>297</sup> OHIM Examination Guidelines, *supra* note 177, p. 34.

<sup>298</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 77. Emphasis added.

descriptive the mark, just from the way it is used when applied to a product.<sup>299</sup> While quite possibly true, it is arguably premised on, from a trademark perspective, flawed grounds. A word mark monopolizes, albeit in a limited way, the use in trade of the mark, no matter if it is stylized, big or small, used in flowing text etc. For that reason, the assessment cannot be based on how the trademark is actually used on a certain product. On the other extreme, if it would be assessed completely out of context, this would result in a fairly low threshold for registrability. In the words of the Advocate General in *Baby-Dry* (supporting the relevance of such an assessment);

“If the term ‘Baby-Dry’ is capable of suggesting products as diverse as, say, talcum powder, rain hoods for prams, compact tumble-dryers or drinks presented in small bottles, then that might seem to dilute its power to designate with any precision the intended purpose of diapers.”<sup>300</sup>

So where on the spectra of information resides the relevant public? In a number of cases and opinions, the answer has been implied.

In *Baby-Dry* the Advocate General did analyze the sign both with regards to the consumer hearing it disconnected from the good and the consumer hearing it in connection with the good, stating that the latter is of greater concern, adding however, that the first aspect too may not be entirely without relevance.<sup>301</sup>

In *UltraPlus*, the General Court may have considered only the first aspect, in stating that “it is not apparent from the contested decision that the relevant public would immediately and without further reflection make a definite and direct association between plastic ovenware and ‘UltraPlus’”.<sup>302</sup>

Notwithstanding how the General Court may have viewed it, the Court has later on confirmed that it is the relevant public’s understanding of the sign “in the light of the goods and services claimed in the trade mark application” that is decisive.<sup>303</sup>

### 5.3.3 Question of language

Article 7(2) CTMR makes it clear that it suffices that the word is descriptive in any part of the Community. As such, the language in which the word mark is written is not of any direct relevance, assuming it is a language spoken within the Community. The Advocate General in *Doublemint* suggested that firstly, regards should be had to the perception of native

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<sup>299</sup> T. R. Lee, E. D. DeRosia and G. L. Christensen, 'An empirical and consumer psychology analysis of trademark distinctiveness', 41 *Arizona State Law Journal* (2009), pp. 1033-1109.

<sup>300</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 86.

<sup>301</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, paras. 84-86.

<sup>302</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 26.

<sup>303</sup> C-37/03 P *BioID*, *supra* note 172, para. 70.

speakers, but if the word mark was not found to be descriptive in relation to this group, regards could be had, if relevant, to other consumers. However, with the example of Baby-Dry, he opined that you cannot take a French speaker and conclude that he understands the English words, but lacking knowledge of English grammar imposes French grammar instead, thereby perceiving the word mark as grammatically correct and thus descriptive.<sup>304</sup> That is, it cannot be required that “any innovative or unusual feature in the grammatical or semantic structure of a mark must thus pass the test of innovativeness and unusualness”<sup>305</sup> also for non-native speakers with an imperfect knowledge of the language.

### 5.3.4 Synonyms

As a result of the sufficiency that a word could be used descriptively, and the rejection of a *Freihaltebedürfnis*, the existence of other, even more usual ways, of designating the product or characteristic is irrelevant.<sup>306</sup>

### 5.3.5 Accesories and subject matter

Even though a sign’s descriptiveness must be assessed individually by reference to each of the categories of goods applied for, as has been shown by the case law, the goods may be inseparably linked. Thus ‘New born baby’ is descriptive not only of dolls but of their accessories<sup>307</sup> and ‘Rockbass’ not only of guitars but of guitar accessories.<sup>308</sup>

The issue of subject matter is relevant when the goods or services applied for can have content, such as printed matter.<sup>309</sup> According to OHIM, an objection on subject matter is only justified where the word identifies a real category of products on the market, or a category likely to exist on the market.<sup>310</sup> As such, ‘Penguin’ or ‘Apple’ would probably not be objectionable for books, whereas ‘Fantasy’ would be.<sup>311</sup>

In *Map&Guide* the General Court held that “the Board of Appeal properly decided that that sign merely described the actual subject-matter of certain goods (‘computer software’) and of certain services (‘computer programming’). In the English-speaking zone of the Community, that sign may serve to designate computer software and computer programming services the function of which is to provide (city) maps and (travel) guides”<sup>312</sup>

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<sup>304</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, paras. 83 and 87.

<sup>305</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 90.

<sup>306</sup> Case C-51/10 P *1000*, *supra* note 179, para. 39.

<sup>307</sup> AG Jacobs in Case C-498/01 P *New Born Baby*, *supra* note 225.

<sup>308</sup> Case T-315/03 *Rockbass*, *supra* note 227.

<sup>309</sup> OHIM Examination Guidelines, *supra* note 177, p. 31.

<sup>310</sup> OHIM Examination Guidelines, *supra* note 177, p. 33.

<sup>311</sup> OHIM Examination Guidelines, *supra* note 177, p. 33.

<sup>312</sup> Case T-302/03 *map&guide* [2006] ECR II-04039, para. 47.

### 5.3.6 Laudatory terms

As noted above, laudatory terms may be descriptive of the quality of the product and may therefore fall foul of (c). However, ‘UltraPlus’ was not considered descriptive because neither the word ‘Ultra’ nor ‘Plus’ was considered to be descriptive in themselves. Rather both were reinforcing terms, but since they had nothing to reinforce, they did not together constitute a laudatory (descriptive) term.

This distinction may not always be easy to make. Words such as ‘Premium’ or ‘Luxury’ would probably be descriptive as denoting quality even on their own. Adding ‘Ultra’ or ‘Plus’ to these terms would generally not change the assessment. ‘Extra’ would most likely be seen as a reinforcing term, without a meaning on its own. However, many of these terms would very possibly be regarded as lacking distinctiveness under (b). It is also important to note that this assessment may have different outcomes depending on the product, as some laudatory terms, may not be seen as such in relation to all goods.<sup>313</sup>

### 5.3.7 Time of assessment

Registration will be refused if the conditions under any of the grounds in Article 7 (1) (b)-(d) are met. OHIM has interpreted this as meaning that the conditions must be fulfilled also on the date when the decision is taken. This interpretation finds support in Article 52(2) CTMR, which states that a mark that has obtained distinctiveness through use after registration cannot be declared invalid. Thus, OHIM considered it sufficient for refusal to show non-distinctiveness or descriptiveness at the time of the decision.<sup>314</sup> In *Frosch Touristik* the Court held that the only relevant date is the filing date.<sup>315</sup> This would mean that a mark that has lost its distinctiveness or become descriptive or customary after the filing date could not be refused. This seems contra-intuitive, but would rarely if ever, prove to be of any practical concern.

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<sup>313</sup> ‘Jumbo’ should not be descriptive of quality in relation to goods where size is unimportant, such a recorded media.

<sup>314</sup> Allenbach study, *supra* note 6, p. 77.

<sup>315</sup> Case C-332/09 P *Frosch Touristik GmbH* [2010] n.y.r..

## 6 What does it all mean?

As stated, the Advocate General in *Doublemint* proposed three points of view for the assessment under (c). The first point of view concerns the way in which a term relates to a product or one of its characteristics. The second point of view concerns the way in which a term is perceived. The third point of view concerns the significance of the characteristic described in relation to the product.<sup>316</sup>

The first two of these points of view correspond to the two steps described by the Court in *Postkantoor*.<sup>317</sup> As interpreted for the purposes of this paper, the first two also correspond to the semiotic spatial model as described above.<sup>318</sup> The first point of view corresponds to the similarity of the signifier, i.e. the similarity in the aural and visual impression. The second point of view corresponds to the similarity of signifieds, i.e. similarity in perceived meaning.

The third point of view was not restated in *Postkantoor* and its importance is controversial. Nonetheless, most of what has been explored in the case law can be assigned to one of these three categories. For this reason, the following analysis will follow this structure.

These points of view however, cannot be assessed in complete isolation from each other, as they influence each other. To use the terms of the Advocate General in *Doublemint*; if under the first point of view the relationship between the word mark and the sign for the product or characteristic is “imaginative” or “subjective”, this will increase the likeliness that one would find, under the second point of view, that the term is not very readily perceived by the relevant public as a designation of the product or a characteristic. In semiotic terms, finding a dissimilarity of the signifier will increase the likeliness of finding a dissimilarity of the signified.

### 6.1 The first point of view: How the term relates to the product or characteristic

The Advocate General in *Doublemint* described the first point of view in the following terms:

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<sup>316</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, paras. 62-64.

<sup>317</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 75.

<sup>318</sup> As the third step can be said to concern itself *only* with what terms a similarity with which will constitute a ground for refusal, it does not constitute an independent third step from a semiotic perspective. Rather it is just a question of which signs that will have to be assessed in relation to the word mark, something which is also dealt with under the first two perspectives.

“The first point of view concerns the way in which a term relates to a product or one of its characteristics. The more factual and objective that relationship, the more likely it is that the term may be used as a designation in trade, so that registration will be precluded by Article 7(1)(c); conversely, the more imaginative and subjective the relationship the more acceptable the term will be for registration.”<sup>319</sup>

In semiotic terms, as stated, this is the step where the signifiers are compared. It could also be expressed as assessing how motivated or arbitrary the word mark’s signifier is in relation to the goods or characteristics. The relationship between ‘Lite’ and the characteristic ‘light’ is not very imaginative or subjective. The relationship between ‘Apple’ and the product ‘computers’ is not factual or objective, rather it is very arbitrary.

### 6.1.1 The general requirements

The word mark has to be assessed as whole.<sup>320</sup> This is not incompatible with first assessing each element of a composite word mark.<sup>321</sup> Indeed, this is very appropriate as the mark cannot be refused under (c) at all should the examiner find that one or more of the elements are not descriptive. Generally the mere combination of descriptive elements is itself descriptive,<sup>322</sup> unless it creates an impression which is sufficiently far removed from that produced by the simple combinations of elements.<sup>323</sup> ‘Universaltelefonbuch’ is too close to ‘universal telefonbuch’, whereas ‘Unitelbuch’ might have a better chance.<sup>324</sup> Such a perceptible difference can be said to arise if it affects important components of the form, making the neologism itself more important than the sum of the terms of which it is composed.<sup>325</sup>

### 6.1.2 The aural and visual impression

In *Postkantoor* the Court clearly stated that the requirement that the impression created must be sufficiently far removed, had to be satisfied in regards to both the aural and the visual impression produced by the mark.<sup>326</sup> However, in the two cases cited, this remark was not necessitated by either the questions put to the Court or by the trademarks concerned, *Postkantoor* and *Biomild*, the nature of which obviated separate examinations as they were equally descriptive both aurally and visually.

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<sup>319</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 62.

<sup>320</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 96.

<sup>321</sup> C-37/03 P *BioID*, *supra* note 172, para. 31.

<sup>322</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 98.

<sup>323</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 99.

<sup>324</sup> Cf C-37/03 P *BioID*, *supra* note 172 regarding abbreviations which are still seen as descriptive when too easily translated.

<sup>325</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 70. *See also* Case T-439/04 *Eurohypo*, *supra* note 280, para. 55.

<sup>326</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 99. *See also* Case C-265/00 *Biomild*, *supra* note 170, para. 40.

The statement is of importance however, e.g. to signs incorporating misspellings. In a Swedish case, the word mark 'Xider' was rejected by the Swedish Patent and Registration Office with the motivation that the mark was too close both visually and aurally to 'cider', which the application covered.<sup>327</sup> However, the decision was overturned on appeal as it was deemed that the misspelling made the mark visually distinctive, and that 'x' is pronounced 'ks' at the beginning of a word, and not 's' like the rejecting office had concluded, which made the mark aurally distinctive as well.<sup>328</sup>

Notably, however, the Examination Guidelines of OHIM, states that the Office does not read Postkantoor as requiring that a mark be refused if the way it is to be pronounced leads to a descriptive term, and that it is relevant only in relation to the relative grounds for refusal. Thus, the Office would accept both 'Indx' and 'Minute Maid'.<sup>329</sup>

As noted above, the Examination Guidelines of OHIM are not legally binding, whereas the judgments of the Union Courts are. However, as the statement in Postkantoor and Biomild can possibly be regarded as *dicta* there may yet be some uncertainty awaiting a judgment on this specific issue.

In semiotics, the aural signifier and the visual signifier are two separate entities, belonging to two different signs. However, as they have the same signified, there is no semiotic justification under this perspective for requiring only that the visual impression be non-descriptive. Monopolizing the aural signifier may have the same effects as monopolizing the visual signifier.<sup>330</sup>

Thus, under the first point of view, it is argued that in accordance with Postkantoor, a sign like 'Xider' should be refused, notwithstanding a possible visual distinctiveness, *if* 'x' is deemed to be pronounced 's' in the beginning of a word. That 'Minute Maid' should still be registrable will be argued under the second point of view.

### **6.1.3 When is the impression sufficiently far removed?**

The Union Courts and the Advocate Generals have used an array of terms to describe what makes the impression produced by the sign sufficiently far removed from that produced by the mere combination of elements. In Baby-Dry, it was the extreme ellipsis, the unusual and opaque grammatical

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<sup>327</sup> Swedish Patent and Registration Office, trademark application 2000/09274, found at <[http://reg.pbr.se/fmi/iwp/data.file?-containerfield&-recid=12131106&-field=0\(1\).1035](http://reg.pbr.se/fmi/iwp/data.file?-containerfield&-recid=12131106&-field=0(1).1035)> on 24 April 2011.

<sup>328</sup> Swedish Court of Patent Appeals, judgment 05-162.

<sup>329</sup> OHIM Examination Guidelines, *supra* note 177, p. 37.

<sup>330</sup> However, when dealing with the similarity of meaning under the second point of view, the argument is stronger, see below under 6.2.



structure, the incompleteness of the description (i.e. ‘keeps your baby dry’), and the inventiveness.<sup>331</sup> In *Universaltelefonbuch* one of the reasons for refusing the mark was that it was formed in accordance with grammatical rules.<sup>332</sup> A recurring expression is that a syntactically unusual juxtaposition may move the sign outside the scope of (c).<sup>333</sup> Whereas it is not required for a finding of distinctive character that the sign is original or fanciful,<sup>334</sup> an imaginative nature helps.<sup>335</sup> It may be noted however, that of all the cases on neologisms reviewed above, only *Baby-Dry* was held to be registrable, and considering that this case has been shown to have set the threshold too low, it is not even certain that the sign would be deemed registrable today. Thus, neologisms have been shown to be very liable to be refused under (c).

Abbreviating is not sufficient in itself as was shown in *BioID*, where the abbreviations were too easily interpreted by the relevant public. Of course, a more “opaque” abbreviation may be registrable, but even where only specialists recognize it, it may still fall inside the scope of (c).<sup>336</sup>

From a semiotic perspective, there are two questions to be answered under this point of view. The first is which signs are to be compared with the word mark applied for. This is answered by the case law in its comments on the syntactically unusual juxtaposition etc. This means that only signs that are formed in grammatically correct manner are included. As such, *Baby-Dry* was compared to the more grammatically correct juxtaposition of ‘dry baby’, and to the full description of ‘Keeps your baby dry’. In relation to the former, *Baby-Dry* created an impression sufficiently far removed because of the unexpected inversion. In relation to the latter, the sign was sufficiently elliptical and incomplete. The assessment made under this first perspective would be probably not have changed with the partial overruling of the *Baby-Dry* case, as this perspective is not concerned with the movement from requiring that the term be a familiar expression to requiring that the term could be used descriptively.

## 6.2 The second point of view: The way in which a term is perceived

The Advocate General in *Doublemint* described the second point of view in the following terms:

“The second point of view concerns the way in which a term is perceived: how immediately is the message conveyed? The more ordinary, definite and down-to-earth a term is, the more readily a consumer will apprehend any designation of a characteristic and the

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<sup>331</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 96.

<sup>332</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 30.

<sup>333</sup> Case C-383/99 *Baby-Dry*, *supra* note 13, para. 43 and Case T-360/00 *UltraPlus*, *supra* note 159, para. 47.

<sup>334</sup> Case T-360/00 *UltraPlus*, *supra* note 159, para. 45.

<sup>335</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 69.

<sup>336</sup> Case T-237/01 *BSS* [2003] ECR II-00411.

more likely the term thus is not to qualify for registration as a trade mark. Where at the other extreme the skills of a cryptic-crossword enthusiast are needed in order to detect any connection with the designated characteristic, the grounds for refusing registration are very weak indeed.”<sup>337</sup>

The semiotic equivalent in the spatial model is, as stated, the comparison of signifieds. If the meaning of the word mark is identical to that of the product or a characteristic, i.e. if both signifieds are the same, the mark is less likely to be registrable. This would be the case with the aforementioned example of ‘Lite’ which would, when seen together with a ‘light product’, i.e. low on fats and/or sugar, be ascribed the meaning ‘light’. This is true, notwithstanding that ‘Lite’ when not seen together with a specific product could be interpreted as ‘light’ in the sense of not being heavy, in the sense of being opposite to ‘dark’, or in the sense of being ‘a light’, i.e. a lamp. In this sense, it is obvious that the fact that a word may have multiple meanings does not diminish its descriptive possibilities in relation to a certain product. Differently put, a word may also be descriptive in relation to other goods, and still be descriptive of the goods applied for.<sup>338</sup>

## **6.2.1 The relation between the word mark’s signifier and the signified of the product or characteristic**

In *Baby-Dry* the Court had held that since the sign was not the usual way of designating, in this case, the intended purpose to keep your baby dry, there was a perceptible difference between the sign and the term as used in common parlance. While this conclusion may seem to belong under the first perspective above, it is in fact concerned with whether the relevant public readily would ascribe the same meaning, i.e. the same signified, to the sign as to the description of the intended purpose.

This becomes even clearer when looking at other case law. Already before *Baby-Dry*, the Court held in *Chiemsee* that it was sufficient that a geographical name designates a place with which it is reasonable to assume that, in mind of the relevant class of persons, an association with the category of goods concerned may be established in the future.<sup>339</sup> It was reiterated more generally in *Streamserve* by the General Court in stating that it is sufficient if at least one of the potential meanings of a word sign designates a characteristic of the goods or services concerned.<sup>340</sup> This was confirmed by the Court in *Doublemint*.<sup>341</sup>

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<sup>337</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 63.

<sup>338</sup> Case T-77/09 *Nature Watch* [2010] n.y.r., para. 26.

<sup>339</sup> Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee*, *supra* note 160, para. 31.

<sup>340</sup> Case T-106/00 *Streamserve*, *supra* note 236, para. 42.

<sup>341</sup> Case C-191/01 P *Doublemint*, *supra* note 12, para. 32.

In semiotic terms, this means that it is not required that the word mark's signifier actually be in use in relation to the signified of the product or characteristic at the time of application; it is sufficient that it could be used for that purpose. This means that the relevant public must, when confronted with the word mark in relation with the goods, perceive it to have a meaning identical to the product or characteristic.<sup>342</sup> In the words of Holmqvist, the word mark is descriptive under the second perspective if no bipolarity arises, because the word mark's signifier is not perceived as having a different signified than the signified of the product or characteristic. When confronted with the word mark 'Apple' in relation to computers there is bipolarity between the primary meaning (signified) of the word and the signified of the product 'computers'. When confronted with the word Baby-Dry, there *may* arise bipolarity because, as a result of the syntactically unusual juxtaposition, the relevant public may not immediately and without further reflection ascribe the sign the same meaning as the signifier 'Keeps your baby dry'. Rather, the relevant public may perceive the signifier as signifying a brand, and so an origin.

As implied above, the way in which the Court in Doublemint came to its conclusion and how its wordings differed from the Advocate General's opinion is of importance. It has led to a subset of conclusions concerning a number of aspects of importance. This will now be discussed, the conclusion of which suggest a clarification or even a rereading of Doublemint.

## 6.2.2 The existence of several possible meanings

The Court in Doublemint stated that, notwithstanding Baby-Dry, it is not necessary that the signs and indications composing the mark actually be in use at the time of the application in a way that is descriptive of the relevant goods or services, or of characteristics of those goods or services. Rather, the Court concluded, it was sufficient, as the wordings 'may serve' in the provision indicates, that the sign *could be used* for such purposes.<sup>343</sup>

The Court went on to conclude that a "sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."<sup>344</sup>

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<sup>342</sup> Although with what precision or factual correctness this identity must be perceived will be discussed below under chapter 6.6.

<sup>343</sup> Case C-191/01 P *Doublemint*, *supra* note 12, para. 32. This has been repeated in, *inter alia*, Postkantoor.

<sup>344</sup> Case C-191/01 P *Doublemint*, *supra* note 12, para. 32. As described above regarding the word 'light', that the existence of several different meanings for a word cannot automatically put the word outside the scope of the provision, is an inevitable consequence of signifiers being able to signify several signifieds, either because the meaning of a word is broad enough to accommodate several possible related meanings, or because the signifier just happens to signify two more or less unrelated concepts (as with 'light'). This is not,

However, depending on the word ‘could’, this second conclusion is not logically necessitated by the first. The wordings ‘may serve’ and ‘could be used’ can be interpreted, although they need not be, as requiring some degree of likeliness. As cited above, the Court in *Chiemsee* had after all qualified its statement by requiring it to be ‘reasonable to assume’ that the relevant association could be established in the future. This requirement of likeliness or reasonableness has been echoed in later cases; *Postkantoor* cited *Chiemsee* directly,<sup>345</sup> in *Universaltelefonbuch* the Court spoke of ‘reasonable to envisage’,<sup>346</sup> and in ‘1000’ the Court analyzed whether it was ‘reasonable to believe’ that a sign would “actually be recognized by the relevant class of persons as a description of those characteristics.”<sup>347</sup>

Thus, the Court’s conclusion in *Doublemint* cannot be taken to mean that any term that could *conceivably* be used as a description, no matter how unlikely such a use is, would be barred from registration under the provision. The acknowledgment of a requirement of likeliness qualifying the word ‘could’ would also have to qualify the word ‘possible’ in the Court’s conclusion regarding the sufficiency that at least one of the possible meanings of a word mark is descriptive of the product or characteristic. This can thus only be true where it is reasonable to assume that the relevant public, when confronted with the word mark in relation to the product, will perceive this meaning above all other conflicting meanings. This would reduce the Court’s statement in *Doublemint* to clarifying that the Advocate General’s statement in *Baby-Dry*, i.e. that the fact that a term could signify many different products diminished its descriptiveness of diapers, is in most cases of marginal concern.<sup>348</sup> This assumes that, as has been stated above, how the relevant public perceives the word mark must always be assessed in light of the product.

To exemplify; the word ‘watch’ could be easily perceived as descriptive, when paired with the product ‘watches’ or with a service that could be described by the verb ‘to watch’, such as a surveillance service, even though the word could signify both the noun and the verb. Thus, it would be reasonable to assume that ‘Sports watch’ when seen together with a watch would function descriptively of watches suitable in some way for sporting activities. On the other hand, the word mark ‘Apple’ or even ‘Big Apple’

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however, the same as saying that the existence of one possible meaning that is descriptive is sufficient for refusing the application.

<sup>345</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 56.

<sup>346</sup> Case C-326/01 P *Universaltelefonbuch*, *supra* note 169, para. 31.

<sup>347</sup> Case C-51/10 P *1000*, *supra* note 179, para. 50.

<sup>348</sup> AG Jacobs in Case C-383/99 *Baby-Dry*, *supra* note 13, para. 86. This statement assumes that it is also relevant for the assessment what meaning the relevant public would ascribe a word mark when perceiving the mark unrelated to a certain product. This would be akin to saying that the fact that the word ‘Light’ might mean several different things would diminish its descriptiveness for lamps. However, whereas this sounds nonsensical in relation to lamps, it may be of some relevance to the discussion below on the situation where the descriptive meaning can be said to be very weak in relation to other existing meanings.

should be registrable for computers, even if they were designed in New York, *if* it could not be shown that the relevant (European) public would be likely to, when confronted with the mark in relation to the product, ascribe the signified ‘New York’ to the signifier ‘Big Apple’. This becomes even clearer if you take a more obscure reference.

‘Sugar & Spice’ was judged registrable for bakery goods in the US, because the applicant successfully argued that the mark would immediately and automatically call to mind “sugar and spice and everything nice” from a well known nursery rhyme.<sup>349</sup> It is not argued in this paper, that this mark should likewise be registrable under the CTMR because, in contrast to the European provision, the US counterpart only applies to terms which are “merely descriptive” i.e. to terms with no other (relevant) possible meaning.<sup>350</sup> However, it is here argued, that word marks having several possible meanings, one of which could be used descriptively, should be registrable where the non-descriptive meaning is so dominant as to be the meaning evoked, immediately and without further reflection, in the mind of the relevant public, rather than the descriptive one, even when confronted with the product.

Apart from the existence of the likeliness requirement outlined above, this conclusion is supported by two other grounds. The first ground is the possibility acknowledged by the Court of a word mark acquiring a secondary non-descriptive meaning, and the second is the Advocate General’s opinion in Doublemint.

### **6.2.2.1 Acquiring a (non-descriptive) meaning of its own**

In *Postkantoor*, the Court stated that apart from creating an impression sufficiently far removed, a second possibility for a word composed of descriptive elements to be registrable is if “the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components.”<sup>351</sup> This cannot be taken to constitute a reference to the possibility of acquiring distinctiveness under Article 7(3), as the Court also stated that it is necessary to ascertain that this secondary meaning is not itself descriptive of the product or characteristic, which would not be relevant under Article 7(3).<sup>352</sup>

Thus, the Court has opened for the possibility that a word mark, although one of its possible meanings is descriptive, may have acquired a meaning of its own, and that this new meaning is the one that will be perceived by the public, even when perceived in the light of the product. Tempering the Doublemint notion of ‘possible meaning’ with a likeliness requirement

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<sup>349</sup> M. Moreno, ‘Strategies for responding to an office action refusing registration for a “merely descriptive” mark’, 19 *Journal of Contemporary Legal Issues* (2010), p. 119.

<sup>350</sup> M. Moreno, *supra* note 349, p. 119.

<sup>351</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 100.

<sup>352</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 100.

would achieve a coherence with the possibility of a word acquiring a (dominant) meaning of its own.

What this secondary non-descriptive meaning could be is not developed by the Union Courts. However, it is imaginable that using ‘Television’ for binoculars, or ‘Loudspeakers’ for marketing services would constitute examples of words that could, conceivable at least, be seen as a descriptive neologism if they did not already have acquired a non-descriptive meaning.

### 6.2.2.2 Rereading Doublemint

The Advocate General in his opinion also discussed the plurality of possible interpretations of the word mark Doublemint. He noted that the reasoning of the General Court had been as follows:

“[Double] is not a usual term of praise and that, combined with ‘mint’, it has two distinct meanings, while ‘mint’ itself covers different varieties of a particular herb. The multiple meanings of the two terms in combination are immediately apparent to an average English-speaking consumer, so that the combination cannot fulfil a descriptive function. Thus ‘Doublemint’ is ambiguous and suggestive and does not enable the public concerned immediately and without further reflection to detect a description of characteristics of the relevant goods.”<sup>353</sup>

However, he noted that the fact that ‘double’ and ‘mint’ in combination give rise to a multiplicity of possible meanings, making them ambiguous, does not necessarily deprive them of their descriptiveness. Instead of just concluding that it is sufficient that at least one of the possible meanings describe a characteristic, he went on to state that there are many descriptions that may “require further definition before the consumer can be sure of what is referred to but which none the less quite clearly remain characteristics of the product in question”<sup>354</sup> giving the term ‘natural’ as an example. In regards to the term double he had the following to say:

“If, for example, a consumer remains unsure whether a ‘double’ liqueur chocolate contains two different types of liqueur (and/or chocolate) or twice as much liqueur (and/or chocolate) as some other unspecified standard, he is none the less practically certain to apprehend that a characteristic of the product (its liqueur or chocolate ingredient) is being designated as in some way doubled or duplicated, even if not literally or precisely so. The term in question may thus serve in trade to designate such a characteristic.”<sup>355</sup>

Thus, even though he cited Truckcard where the General Court had concluded that it was sufficient if at least one of the possible meanings was descriptive,<sup>356</sup> the analysis was not really concerned with the existence of

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<sup>353</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 41.

<sup>354</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 43.

<sup>355</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 44.

<sup>356</sup> Case T-358/00 *Truckcard*, *supra* note 237, para. 31.

multiple meanings, but rather with the precision, accuracy or factual correctness required of the meaning as perceived by the relevant public. It is also in connection with the allegation that the word mark Truckcard did not have a *clear* and *specific* meaning, that the General Court stated that it was sufficient if one of the possible meanings identified a feature of the goods concerned.<sup>357</sup>

On this issue, the Advocate General stressed that the question of precision, accuracy or factual correctness is normally not relevant to the examination from any of the three points of view.<sup>358</sup> Any designation may be rendered more precise, and untruthful descriptions are generally prohibited under Article 7(1)(g). However, there are some requirements on specificity. According to the General Court it was relevant for finding the provision applicable that “for the public addressed, there is a sufficiently direct and specific relationship between the term [...] and those goods”.<sup>359</sup> Thus, at some point, a word mark is too vague in its descriptiveness. To describe a service with a colour should generally be too vague to create a sufficiently direct and *specific* relationship between the term and the characteristic, with the notable exception of green for describing an environment friendly service, or a similar notion.

To reconcile the statement of the Advocate General and the Court in Doublemint a dichotomy is needed in what ‘possible meanings’ may mean. On the one hand, as with the examples of ‘Light’ and ‘Watch’ and the statement of the Advocate General in Baby-Dry above, it may mean that a word may describe completely different products, or characteristics irreconcilable with the product in question. On the other hand, it may mean that the word has, as in Doublemint, an array of possible meanings which all can be descriptive of the product in question but where only one, if any, is completely accurate. It is the latter situation that the Advocate General was concerned with, as was the General Court in Truckcard. Then it becomes a question of specificity and accuracy, and since this normally is not relevant to the assessment it is true in this sense that the existence of a variety of possible meanings is irrelevant. This would mean that it is sufficient for the application of the provision that one of the possible meanings is accurate, which would make the Court’s conclusion the same as the Advocate General’s, if seen in this latter sense.

In the former sense, the conclusion is not completely true. There are situations, admittedly rare and possibly even only hypothetical, where the descriptive meaning of a word is so overshadowed by a more dominant non-descriptive meaning, that a word should be registrable even though one of its possible meanings are descriptive, simply because it is not reasonable to assume that the relevant public will perceive this meaning.

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<sup>357</sup> Case T-358/00 *Truckcard*, *supra* note 237, para. 31.

<sup>358</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 65.

<sup>359</sup> Case T-439/04 *Eurohypo*, *supra* note 280, para. 44.

### 6.2.3 The aural and visual impression

As discussed under the first perspective, the Court stated in *Postkantoor* that the requirement that a word mark, consisting of descriptive elements, create an impression sufficiently far removed from that produced by the simple combination of those elements, must be satisfied as regards both the aural and the visual impression produced by the mark.<sup>360</sup>

Meanwhile the Examination Guidelines of OHIM provides a conflicting view, stating that both ‘Indx’ and ‘Minute Maid’ would be registrable because of their visual distinctiveness alone. It will here be argued that while ‘Minute Maid’ should be registrable ‘Indx’ should not.

The conflicting views of the Court and OHIM may, if only partly, be explained by distinguishing the first and the second points of view from each other in the reading of *Postkantoor*. For the sake of clarity it is necessary to quote paragraphs 99 and 100 in *Postkantoor* (emphasis added).

“99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is **sufficiently far removed from that produced by the simple combination of those elements**. In the case of a word mark, which is intended to be heard as much as to be read, **that condition must be satisfied as regards both the aural and the visual impression** produced by the mark.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which **is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed**, with the result that the word is more than the sum of its parts...”<sup>361</sup>

The two paragraphs seem to be repeating each other to a certain extent, although with a slight, but important, change in wording. In paragraph 99 it is concluded that a combination of descriptive elements is itself descriptive unless it creates an impression sufficiently far removed from that produced by *the simple combination of those elements*. This requirement has to be satisfied as regards both the aural and the visual impression.

In paragraph 100, the same requirement is repeated but with the difference that it first says that there must be a perceptible difference, and that this assumes that the word creates an impression which is sufficiently far

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<sup>360</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 99.

<sup>361</sup> Case C-363/99 *Postkantoor*, *supra* note 146, paras. 99-100.



removed from that produced by the mere combination of *meanings lent by the elements* of which it is composed. Here the requirement regarding the aural and visual impression is not restated.

While this regurgitating of the same requirements using slightly different expressions may be the effect of repeating statements from earlier case law, it could be interpreted as explaining the requirements from the two different points of view. In paragraph 99, the Court is speaking about the relationship between the word mark and the simple combination of the descriptive elements, i.e. between the *aural and visual* impression of the word mark signifier as compared to the signifiers of the descriptive term(s).

In paragraph 100 on the other hand, the Court is assessing the question from the second point of view. Here it is the meaning as perceived by the public that is relevant, i.e. a comparison of signifieds. This can be seen in the Court's statement that the impression needs to be sufficiently far removed from the combination of *meanings* lent by the descriptive elements, i.e. the signified has to be sufficiently far removed from that of the combination of the descriptive elements.

While 'Minute Maid' may or may not be visually distinctive from 'Minute Made' which would arguably be descriptive of freshly made juices, it is definitely not aurally distinctive. However, because of the distinctively different and non-descriptive meaning given by the change from 'made' to 'maid', the meaning as (visually) perceived by the relevant public is not descriptive. 'Indx' on the other hand is probably neither visually nor aurally distinctive, and would evoke the same meaning as 'Index' and therefore be descriptive from both perspectives (for goods where the word 'Index' is descriptive).

According to the distinction made here, the requirement of an aural impression sufficiently far removed from that of the descriptive term is, according to Postkantoor, only relevant under the first perspective, i.e. when assessing the meaning perceived by the relevant public, the Court is looking only at the visual signifier. If the example of 'Minute Maid' is accepted, the conclusion follows that the descriptiveness of the aural impression may be healed by a finding of non-descriptiveness in the visual impression and the perceived meaning. This would also mean that a word, clearly recognizable as written in English, and not descriptive of the good in this language, would not be considered as descriptive merely because the word, as pronounced, might in a different language make a similar aural impression to a descriptive term.<sup>362</sup>

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<sup>362</sup> To be clear, this would require that the word is visually distinctive as well as being perceived (visually) as having completely different, or unknown, meaning.

## 6.3 The third point of view: The significance of the characteristic in relation to the product

The Advocate General in *Doublemint* described this perspective in the following way:

“The third point of view concerns the significance of the characteristic in relation to the product, in particular in the consumer’s mind. Where the characteristic designated is essential or central to the product, or is of particular importance in a consumer’s choice, then the case for refusing registration is compelling; where the designation is of a characteristic that is purely incidental or arbitrary, the case is considerably weaker.”<sup>363</sup>

That the characteristic described had to be essential had already been stated in *Baby-Dry*. However, the Court in *Doublemint* did not comment on this point of view. On top of that, the Advocate General in *Postkantoor* had already before the opinion in *Doublemint*, stated that “the essential, or incidental, nature of the descriptive element of a sign are immaterial”.<sup>364</sup> This was later taken up by the Court in *Postkantoor*. The Court stated that it is irrelevant “whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary”<sup>365</sup> adding that “in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”<sup>366</sup>

At first sight this would seem to deny the existence of the third point of view. However, this may not be entirely true. While it may not be an independent third point of view, it is here argued that it is relevant under the second point of view, i.e. how readily the relevant public perceives it as a descriptive meaning, and that this is in line with *Postkantoor*. The Court was asked whether it was relevant that the word indicated a *commercially* essential characteristic, as opposed to an incidental one.<sup>367</sup> The Court answered in the same terms, repeating the word ‘commercially’ twice as shown above. The word ‘commercially’ is here taken to be an important qualification, and that the Court thus did not do away with a requirement of essentiality altogether.

This is important as it is the only interpretation allowing the statement to be consistent with the requirements under the second perspective. As discussed above, there has to be a sufficiently direct and specific relationship between

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<sup>363</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 64.

<sup>364</sup> AG Colomer in Case C-363/99 *Postkantoor*, *supra* note 146, para. 75.

<sup>365</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 102.

<sup>366</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 102.

<sup>367</sup> Case C-363/99 *Postkantoor*, *supra* note 146, para. 18.

the word mark and the product or characteristic, that is perceivable by the relevant public immediately and without further reflection. This relationship would not exist for, e.g. the word mark 'Blue' for computers; just because some parts of some computers happen to be blue. That is, because of the complete insignificance of the characteristic, the relevant public would not perceive the word mark as a description.

## 6.4 Neologisms assessed under (b)

For the reasons given above it is important to analyze the two points of view separately. As also noted, the third point of view, even if viewed as subsumable under the second point of view, should also be taken into account. This is true even though they are interdependent. This relationship can be seen as somewhat analogous to that of the relationship between provisions (b) and (c). As the Union Courts have repeatedly stated, they are to be examined separately, even though there is a significant overlap, and the Union Courts have stated that all word marks that fall foul of (c) also fall foul of (b), but not vice versa. However, in two cases the Court has shown a possible confusion regarding how to assess the word element(s) of a mark that, because of also having non-descriptive elements, is assessed under (b) and not (c).

In SAT.2 the judgement of the General Court was overturned because the Court considered that the General Court had wrongly applied the aim pursued under (c) to the assessment under (b) and further that it had applied the criterion 'commonly used in trade' and 'capable of being used in that manner' under (b), whereas this is relevant only under (c).

In BioID the word mark was typeset in Arial with 'Bio' in bold, and two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®), thus moving the assessment from (c) to (b). The General Court had considered whether the word element was likely to be commonly used in trade and concluding that this was so, went on to assess the figurative elements in the same way, coming to the conclusion that the mark lacked distinctiveness because it was composed of elements each of which is likely to be used in trade.<sup>368</sup> The Court overruled this with reference to SAT.2 stating that the General Court had applied this criterion although it is not the yardstick by which (b) must be interpreted.<sup>369</sup>

This is interesting for highlighting the interplay between the provisions in situations where you have a word with figurative elements. The Court, having chastised the General Court for using a criterion only relevant under (c), goes on itself by assessing the word element using language that is at home under (c) but not (b).<sup>370</sup> This should not come as a surprise, because even though a word mark including non-descriptive elements cannot be

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<sup>368</sup> Case T-91/01 *BioID* [2002] ECR II-05159, para. 41.

<sup>369</sup> C-37/03 P *BioID*, *supra* note 172, para. 62.

<sup>370</sup> C-37/03 P *BioID*, *supra* note 172, para. 70.

refused under (c) but must rather be assessed under (b), the semantic elements should still be assessed with the criteria relevant to (c), in order to determine their descriptiveness.

What is surprising however is that the analysis on the descriptiveness of the word seems very truncated when compared to the case law concerning “pure” word signs. The Court satisfied itself with noting that “the relevant public will understand BioID, in the light of the goods and services claimed in the trade mark application, as being made up of the abbreviation of an adjective ‘biometrical’ and of a noun (‘identification’), and thus, as a whole, as meaning ‘biometrical ‘identification’.”<sup>371</sup> There was no extended analysis whether BioID created an impression sufficiently far removed, or whether the term BioID could be used in trade etc, and no discussion regarding the aim pursued under (c). This may be because of the nature of the word; the Court may have found the word so obviously descriptive that it obviated any need for further analysis.

This should be the case, because if it were not, it would mean that the analysis of whether a word is descriptive or not, would differ depending on whether the sign as a whole also incorporated graphic elements or not. However, the Court stated that the General Court had erred in law by taking into account whether the mark was likely to be used in trade, “in order to establish that it fell within Article 7(1)(b) of the regulation.”<sup>372</sup> It could be argued that it only took this position because the General Court had assessed not only the word component, but also the figurative elements using this criterion, but in finding that the General Court had erred in law, the Court cited all paragraphs where this yardstick had been used, including those assessing the semantic component ‘BioID’.

This suggests that, according to BioID, while the sign ‘Juice’ for beverages would be assessed with the public interest pursued under (c) in mind, the sign ‘Juice.’ would only be assessed as to whether the sign could serve to identify origin, thus being assessed under a less severe test. There can be no reason for this; when a sign is composed of a word with semantic meaning and figurative elements, although it cannot be refused under (c), the word components should still, where relevant, be assessed of their descriptiveness, *as if they were* assessed under (c), i.e. using the same yardsticks as under this provision. If it is then concluded that the word is descriptive and thus lacks distinctiveness, the examination should continue with assessing whether the graphic elements confer distinctiveness, making the mark registrable as a whole notwithstanding the descriptiveness of the word(s).

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<sup>371</sup> C-37/03 P *BioID*, *supra* note 172, para. 70.

<sup>372</sup> C-37/03 P *BioID*, *supra* note 172, paras. 61-62.

## 6.5 The aim pursued under (c)

The case law has made clear the public interest pursued under (c) and the fact that this is not relevant under (b), which is instead indissociable from the essential function of trademarks, i.e. identifying origin.

In an article these conclusions, as they are expressed in SAT.2, are criticised.<sup>373</sup> The author concludes, as is supported by the case law, that all descriptive signs are also non-distinctive, and thus descriptiveness is a subgroup of non-distinctiveness. This makes it clear, the author argues, that the provisions cannot be underpinned by separate interests.<sup>374</sup>

This argument is flawed. While a subgroup (c) of something possibly has to be underpinned by the same interest as the overarching group (b), this does not mean that the subgroup cannot have other interests particular only to itself; for biological diversity it may be important to protect all organic materia, but the protection of (the subgroup) plants that perform photosynthesis may be underpinned by the additional interest of producing oxygen.

The author does not however, stop at this argument, but also explains why this outcome cannot be supported either by the literal text of the TMD and CTMR, or on policy grounds. It is the latter that this section will deal with.

The main argument is that there is nothing special about descriptive signs as opposed to non-distinctive signs, such as numerals and exclamation points, to explain why the public interest should underpin (c) only. He does this by assuming first, that other traders would be placed at an equally serious competitive disadvantage by the monopolization of basic, commonplace signs such as single letters and numerals. Secondly he states that depletion theory cannot be the only doctrine that justifies keeping certain marks free for general use, because this would not be reconcilable with the fact that (c) recognizes a public interest even where the registration would leave many alternative descriptive terms free for other traders to use.<sup>375</sup>

These two points can also be questioned. Regarding the first point, it is sufficient to note that this contention is far from clear. Rather descriptive trademarks have always been very popular with trademark owners because they can communicate a positive message.<sup>376</sup> Thus, there is good reason to believe that monopolizing a descriptive term places other traders at a more serious competitive disadvantage, than the monopolization of single letters or numerals. Regarding the second point, the argument seems fundamentally flawed. Stating that recognizing the public interest even when alternative

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<sup>373</sup> M. Handler, *supra* note 170.

<sup>374</sup> M. Handler, *supra* note 170, p. 309.

<sup>375</sup> M. Handler, *supra* note 170, p. 311.

<sup>376</sup> See T. Pfeiffer, 'Descriptive trade marks: the impact of the Baby Dry case considered', 24:7 *European Intellectual Property Review* (2002), p. 373.

descriptions are available would put it outside the scope of depletion theory is simply not true. Analogous to colours, the interest is not upheld by the fact that a single registration would deplete the availability of descriptions (or colours), but rather that a handful would (or could).

Nonetheless, the public interest recognized as underpinning (c) may be questioned in the light of Article 7(3). If it were important to keep these signs free for the use of others, why would this interest vanish, simply because an applicant can show acquired distinctiveness? One argument might be that the very fact that an undertaking has succeeded in acquiring distinctiveness proves that there is no foreseeable use for the term as a description. This argument is very weak however. Another might be found in the General Court's reasoning in SAT.2, that "[unlike] intellectual and industrial property rights, the legal protection afforded to trade marks is not intended, in principle, to cover the result of a creative or economic effort of the proprietor of the right but only the sign 'occupied' by him",<sup>377</sup> and that it is "only in the event that such a sign, in consequence of the use to which it has been put, is actually perceived by the relevant public as an indication of the trade origin of the goods or service that the economic effort made by the trade mark applicant justifies putting aside the public-interest considerations set out above."<sup>378</sup> A third argument is that although underpinned by this public interest, the provision is also underpinned by the essential function of a trademark, i.e. denoting origin. Thus, when a sign actually fulfils this function, it would go against the very purpose of trademark law as a whole, to deny this sign protection because of this public interest, which therefore has to give way. Lastly, this is, as was shown in chapter 3, consistent with a requirement of semiotic democracy.

The conclusion then, must be that despite the criticism above and notwithstanding Article 7(3), there is nothing precluding the consideration of this public interest under (c), and (c) only.

## 6.6 Suggested framework for assessing descriptiveness

With regards to the above, the following suggestion is made. The principal aim is to assess whether the relevant public may reasonably perceive the word mark as a description when seen in light of the product, or in other words, whether, in the mind of the relevant public, there is a sufficiently direct and specific link between the word mark and the goods or its characteristics. This entails that it is the second point of view that is dominant, and in most cases decisive.

The assessment is made in three steps. The first is to identify the relevant descriptive signs that come to mind when seeing the word mark in relation to the goods, i.e. the signs that would be close in the semiotic spatial model.

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<sup>377</sup> Case T-323/00 SAT.2 [2002] ECR II-02839, para. 36.

<sup>378</sup> Case T-323/00 SAT.2, *supra* note 377, para. 36.

It is under this step that the essentiality of the characteristic comes into play. Although, following Postkantoor, it is clear that the characteristic need not be *commercially* essential, as described above, if the characteristic is not perceptible, or completely incidental, it is very unlikely that the relevant public will perceive it as a description.

The second step is to compare these descriptive signifiers and the visual and aural impression they make, to the word mark signifier. The third step is to assess what meaning the relevant public would ascribe the word mark in the light of the goods applied for. Regarding the two points of view and their relationship, the following can be said. A perceptible difference under the first point of view is necessary but not sufficient for finding a word mark registrable. That is, if there is a perceptible difference, and this threshold is very low, the examiner should continue with the second point of view. Otherwise the word mark can be refused without proceeding further, since if there is no perceptible difference at all, no other meaning than the descriptive can be perceived. As an example, the registration of ‘Sugar & Spice’ for goods containing sugar and spice would run counter to this proposition, assuming that these ingredients are deemed to be of a sufficiently essential nature under the first step.

The first two steps thus constitute an aid in assessing the third step. Finding the aural and visual impression very similar to a descriptive term would suggest that the meaning perceived by the relevant public might be descriptive. This however, cannot always be a correct assessment. One such exception is when a slight change in the signifier drastically changes the signified as perceived. ‘Minute made’ constitutes an example of this, ‘Swatch’ for watches could possibly constitute a second. This is also supported by the notion of conceptual differences. In a case concerning the similarities between the word marks ‘Bass’ and ‘Pash’ the General Court stated that:

“it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately”<sup>379</sup>

Another exception is when the word mark evokes a meaning that is so dominant that it excludes the descriptive meaning from being ascribed by the relevant public.<sup>380</sup> This can be said to happen when a trademark acquires distinctiveness, but as the Court stated in Postkantoor, it can also happen when a word acquires a secondary non-descriptive meaning. The existence of non-descriptive meanings for the word mark is thus generally not relevant for the assessment, but this cannot be taken for granted.

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<sup>379</sup> Case T-292/01 *Phillips-Van Heusen*, *supra* note 60, para. 54.

<sup>380</sup> See Case T-292/01 *Phillips-Van Heusen*, *supra* note 60, para. 47, where the General Court reiterates that one has to bear in mind the dominant elements when assessing the possibility of confusion.

Under this third step, i.e. under the second point of view, the precision of the descriptiveness of the word mark is also relevant. Although the Advocate General in *Doublemint* stated that this is generally not relevant, this statement was made with examples of signs that were quite obviously descriptive, but somewhat lacking in precision, leaving some ambiguities as to the exact meaning of the description. On the other hand, some word marks are so vague in relation to the goods as to, in the words of the Advocate General himself, require “the skills of a cryptic-crossword enthusiast”<sup>381</sup> to identify a descriptive meaning, that these cannot be seen as descriptive under the provision, the example given above, being most colours in relation to a product not incorporating that colour, but possibly suggesting that the colour and the product has similar attributes.

## 6.7 Final words

The Union Courts have failed to come up with rules of any precision for the examination of neologisms. Rather the yardsticks given are very vague: ‘any perceptible difference’, ‘more than the sum of its parts’, ‘an impression sufficiently far removed’. However, this may not be because of any reluctance or inability of the Union Courts, but rather an impossibility of formulating precise rules that are generally applicable.<sup>382</sup> If this is so, it becomes even more important to formulate a comprehensive framework for dealing with these issues. It may inevitably, in the end, come down to the subjective assessment of a single individual; the assessment may be art rather than science, but this very fact necessitates that the way in which the examiner is to proceed is itself very clear and predictable.

It is in this, that the case law has not yet reached its goal. Some important factors have been clarified, such as the aim pursued under (c), and that it is not sufficient for registrability that the sign is not a familiar expression at the time of application. However, there still exist many unknowables from the perspective of a user of the system.

One of the most important of these uncertainties is what has been described above regarding the different points of view. Whereas it seems that the Union Courts agree regarding the applicability of the first two, the analyses in the cases do not clearly distinguish between the two (in much the same way that the earlier cases did not distinguish between the distinctiveness provisions). Secondly, the relevance of the third point of view is not clearly determined. A third uncertainty regards the requirement that both the aural and visual impressions need to be sufficiently far removed from the impression of the descriptive terms. A fourth, arguably very important, uncertainty is what happens to the analysis under (c), when the word sign is

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<sup>381</sup> AG Jacobs in Case C-191/01 P *Doublemint*, *supra* note 12, para. 63.

<sup>382</sup> See USPTO, ‘Trademark Manual of Examining Procedure (TMEP) - 7th Edition’, para. 1209.01(b) where the impossibility of formulating specific rules is concluded.



assessed under (b) instead because the sign incorporates non-descriptive elements.

To address the first issue, it has here been suggested that the examination deals with the first two points of view separately, and that these two be seen as the two axes in the suggested semiotic spatial model. Secondly, it has been suggested that the third point of view still remains relevant, and that it was not, and should not be, completely done away with in *Postkantoor*. Thirdly, it has been concluded that the aural impression is relevant under the first point of view, but that the finding of a completely different meaning under the second point of view may make the sign registrable. In other words, the first point of view is given an auxiliary importance in relation to the second. Fourthly, it has been argued that the Union Courts need to perform a full descriptiveness analysis of any potentially descriptive elements, even when the sign falls to be examined under (b) because of the existence of non-descriptive elements. Lastly, the coherency of a public interest underpinning (c) has been defended.

All these suggestions aim to strike a fair balance between the interest of the applicant, the function of trademarks, and the interests underpinning the descriptiveness provision. It has been argued under chapter 3 that such a balance is important, not only for the coherency of the trademark regime, but from a human rights perspective as well. The human rights framework has also shown the importance of striking this balance from the very beginning, as it can otherwise be difficult to roll back the effects.

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