

# A COMPARATIVE ANALYSIS OF U.S. AND EUROPEAN COMMUNITY CASE LAW REGARDING DESCRIPTIVE SIGNS

## I. THE RELEVANT LEGAL PROVISIONS AND INTERPRETING CASE LAW:

### **I.1. In the European Community:**

#### I.1.a. The applicable provisions of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark:

- *Ground for refusal of registration as a Community trademark of descriptive character:*

According to Article 7(1)(c) of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark, signs 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 good or service, cannot be registered as Community trademarks.

This ground for refusal of descriptive character regulated in Article 7(1)(c) does not apply to generic marks which are banned from registration as a Community trade mark by Article 7(1)(d) of the Regulation (“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”).

Article 7(2) provides that a sign cannot be registered as a Community trademark even if the grounds of non-registrability obtain in only part of the Community. It is therefore sufficient for a sign to be rejected pursuant to Article 7(1)(c) of the Regulation on the Community trademark that this sign is descriptive in only one country of the European Union.

- *Registrability of marks which have acquired distinctiveness through use:*

Under Article 7(3) of the Regulation a descriptive trademark and even a generic trademark may be registered as a Community trademark if the sign has become distinctive in relation to the goods and services for which registration is requested in consequence of the use which has been made of it by the applicant.

- *Fair use defense:*

Under Article 12 of the Regulation on the Community Trademark, the rights conferred by the trade mark do not entitle the proprietor to prohibit a third party from using, in the course of trade, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or the time of rendering the service, or other characteristics of the goods or service, provided he uses them in accordance with honest practices in industrial or commercial matters.

I.1.b. The general principles established by the European Court of Justice regarding the application of the ground for refusal of descriptive character:

In applying and interpreting the provisions relating to the ground for refusal of descriptive character, the European Court of Justice (ECJ)<sup>1</sup> has defined a series of principles and criteria to be taken into account when evaluating the possible descriptive character of a sign.

- *Concerning the public interest underlying this ground for refusal:*

In its “Baby-Dry” decision, the European Court of Justice stated that “it is clear from Articles 7(1)(c) and 12 of the Regulation on the Community Trademark taken together 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 fulfill the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function”.<sup>2</sup>

In later decisions, the ECJ made clear that this need to ensure that the sign can fulfill the basic function to guarantee the identity of the origin of the marked product or service to the consumer is in fact the public interest which underlies the ground for refusal of lack of distinctiveness, regulated in Article 7(1)(b) of the Council Regulation on the Community trademark, whilst the public interest underlying the ground for refusal of descriptive character is that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all.<sup>3</sup> Obviously, signs which are rejected for the ground of refusal of Article 7(1)(c) of the Regulation on the Community Trademark, because they are found to be descriptive of the goods or services concerned, also lack distinctive character, as they will be perceived by the public as a descriptive indication and are therefore deemed incapable of fulfilling the essential indication-of-origin function of the trade mark.<sup>4</sup>

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<sup>1</sup> Any final decision by the Office for Harmonization in the Internal Market (OHIM) in Alicante, which is the Office handling Community trade marks, can be appealed before the Boards of Appeal of OHIM; against the Boards of Appeals’ decisions appeal can be brought before the European General Court, a court attached to the Court of Justice of the European Union in Luxembourg. Against the General Court’s decisions, a final appeal can be brought before the Court of Justice, but this appeal is strictly limited to questions of law. The Court of Justice of the European Union is also the sole authority competent for the interpretation of European Union law. The National Courts may (last instance Courts must) submit any issue that implies interpretation of the Council Regulation (EC) No 207/2009 on the Community Trademark or the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks to the ECJ for a preliminary ruling. The National registration authorities and Courts are obliged to apply the findings of the ECJ regarding European Community trademark law.

<sup>2</sup> ECJ, 20.9.2001, C-383/99 – BABY-DRY

<sup>3</sup> ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 - Chiemsee  
ECJ, 12.2..2004, C-363/99 – Postkantoor  
ECJ, 12.2.2004, C-265/00 – Biomild  
ECJ, 23.10.2003, C-191/01 P - Doublemint

<sup>4</sup> EGC, 29.9.2012, T-200/08 – Foodlube; EGC, 9.3.2010, T-77/09 – Nature Watch, and case-law cited  
EGC, 16.3.2006, T-322/03 – Weisse Seiten;

The public interest underlying the ground for refusal of descriptive character requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless they have acquired distinctiveness through use.

- *Concerning the characteristics of descriptive signs; tests to be applied by the registration authority when determining the possible descriptive character of a sign:*

When assessing the possible descriptiveness of a sign, the registration authority has to determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future.<sup>5</sup>

It has to be asked whether the sign is associated by the relevant public with the goods and services concerned or whether it can reasonably be assumed that such an association will be made in the future.<sup>6</sup>

This association between the sign and the goods and services covered by the application has to be concrete and direct and made immediately and without further thought.<sup>7</sup> There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics.<sup>8</sup>

In its Baby-Dry decision<sup>9</sup> the ECJ stated that “the signs and indications referred to in Article 7(1)(c) of the Regulation on the Community Trademark are only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought”. This statement was quoted in numerous later decisions of the EGC and the Boards of Appeal of OHIM but, whilst in the Baby-Dry decision it led the Court to allow registration of the mark because the sign is not the usual way the characteristics of babies’ nappies are described, in later decisions signs which are not currently used to describe the

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<sup>5</sup> ECJ, 12.2.2004, C-363/99 – Postkantoor  
ECJ, 12.2.2004, C-265/00 – Biomild

<sup>6</sup> ECJ, 9.12.2009, C-494/08 – Pranahaus  
ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 - Chiemsee

<sup>7</sup> ECJ, 9.12. 2009, C-494/08 – Pranahaus

<sup>8</sup> EGC, 12.6.2012, T-165/11, Stichting Regionaal Opleidingencentrum van Amsterdam v. OHIM and Investimust SA.

EGC, 8.7.2008, T-160/07, Lancôme parfums et beauté & Cie SNC v. OHIM – Color Edition

EGC, 22.6.2005, T-19/04 – PAPERLAB

EGC, 9.6.2010, T-19/04 - SAFELOAD

<sup>9</sup> ECJ, 20.9. 2001, C-383/99 – BABY-DRY

characteristics of the goods are still refused trademark protection because they might be used as a descriptive indication in the future.<sup>10</sup>

It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists and whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small.<sup>11</sup>

A sign has to be rejected if at least one of its possible meanings designates a characteristic of the goods or services concerned.<sup>12</sup>

Though in some decisions the ECJ and EGC declare that the sign needs to be descriptive of the goods or services at issue or their “essential characteristics”<sup>13</sup>, in others it is declared 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>14</sup>.

- *A guess about future consumers’ perception and future descriptive use:*

For a sign to be rejected as descriptive, it is sufficient that the relevant public might perceive the sign as a descriptive indication and that it might be used in such a way in the future.

According to the European Court of Justice it follows from the wording of Article 7(1)(c) of the Council Regulation (EC) No 207/2009 (... signs 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 good or service ...) that it is not necessary that the sign is already used in trade in a descriptive manner. If a sign which is not currently used as a descriptive indication seems capable of being used to describe the goods or services, their characteristics or purpose in the future, it cannot be registered as a Community trademark.<sup>15</sup>

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<sup>10</sup> ECJ, 9.12.2009, C-494/08 – Pranahaus  
EGC, 9.3.2010, T-77/09 – Nature Watch, and case-law cited

<sup>11</sup> ECJ, 12.02.2004, C-363/99 – Postkantoor  
ECJ, 12.02. 2004, C-265/00 – Biomild  
ECJ, 23.10.2003, C-191/01 P - Doublemint

<sup>12</sup> ECJ, 9.12.2009, C-494/08 – Pranahaus  
ECJ, 23.10. 2003, C-191/01 P – Doublemint

<sup>13</sup> ECJ, 9.12.2009, C-494/08 – Pranahaus

<sup>14</sup> ECJ, 12.2.2004, C-363/99 – Postkantoor  
ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 - Chiemsee

<sup>15</sup> See ECJ, 23.10.2003, C-191/01 P - Doublemint  
ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 – Chiemsee  
ECJ, 13.2.2008, C-212/07 P - Hairtransfer  
ECJ, 9.12.2009, C-494/08 – Pranahaus  
ECJ, 12.02.2004, C-265/00 – Biomild  
EGC, 6.3.2012, T-565/10, ThyssenKrupp Steel Europe AG v. OHIM - Highprotect

In its “Doublemint” decision, the ECJ stated that it has to be ascertained whether the word at issue is capable of being used by other economic operators to designate a characteristic of their goods and services.<sup>16</sup> In applying this test, the Court of Justice and the General Court do not ask whether there is actually any need for competitors to be able to freely use the term in describing their products. A mark is declared descriptive when it is found that it is “associated” by the relevant public with the products or services or their characteristics. Once this “association” has been ascertained, it is assumed that the sign might be used by competitors in a descriptive manner, being irrelevant whether it is actually being used or there is any need for such a use.<sup>17</sup>

A good example for this line of reasoning are the “Pranahaus” (translated Pranahouse) decisions of the European Court of Justice and the European General Court.<sup>18</sup>

The term “Prana” is not currently used to describe goods or services nor is the term “Pranahaus” used to describe a place where goods and services related to esoteric topics and yoga are offered. The applicant alleged that the sign “Pranahaus” will therefore not be understood by consumers “immediately and without further thought” as a descriptive indication, but that some mental steps are necessary for the consumer to reach such an understanding.

The Examiner and the Board of Appeal of OHIM found that, though “Prana” is not an ordinary word of the German language, it is an important term in Yoga and hinduistic teachings and known by those interested in these fields. The combination of the word “Prana” with the ordinary German word “Haus” (house) is not unusual and does not create an impression sufficiently far removed from that created by the mere combination of the words.

The sign “Pranahaus” immediately informs the relevant public on an essential characteristic of the goods and services, which is their thematic content and their place of sale.

The relevant public, which include consumers especially interested in esoteric matters, are capable of understanding that the sign “Pranahaus” has the meaning of a house or place which serves for the sale of goods or the offering of services with a specific thematic content closely linked to esotericism, Hinduism and yoga.

The European General Court confirmed these findings and stated that the mark might be used to designate a place where goods and services related to esotericism and yoga are offered and that it only serves to describe the thematic content and characteristics of the goods and services. The ECJ did not review these findings, as it does not have jurisdiction to review points of fact, but confirmed that it is not necessary that the sign is currently used in a descriptive manner.

- *Word combinations and composite marks:*

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<sup>16</sup> ECJ, 23.10.2003, C-191/01 P - Doublemint

<sup>17</sup> EGC, 19.5.2010, T-163/08 – Golden Toast; ECJ, 9.12.2009, C-494/08; EGC, 17.09.2008, T-226/07 - Pranahaus

<sup>18</sup> EGC, 17.9.2008, T-226/07; ECJ, 9.12.2009, C-494/08 – Pranahaus

The assessment of the descriptive character of word combinations and composite marks cannot be limited to an evaluation of each of its words or components, considered in isolation, but must be based on the overall perception of that mark by the relevant public.

For a mark composed of descriptive elements not to be considered itself descriptive there must be a perceptible difference between the word and the mere sum of its parts. The impression created by the (unusual) combination of elements has to be sufficiently far removed from that produced by the mere combination of the meanings of the descriptive elements, with the result that the word is more than the sum of its parts. In case the sign has acquired its own meaning, with the result that it is now independent of its components, it has to be ascertained whether it is not itself descriptive.<sup>19</sup>

This requirement that the impression created by the word combination must be more than the sum of its parts was introduced by the ECJ after the criticism received for its Baby-Dry decision (in which it had 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”) and following the suggestion of Advocate General Ruiz-Jarabo Colomer.<sup>20</sup>

In his opinion, Advocate General Ruiz-Jarabo pointed out that “perceptible” is a relative term and must not be confused with “minimal”. For word marks, he proposed that “a difference will be regarded as perceptible if it affects important components of either the form of the sign or its meaning. 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.”

- *Geographical names:*

Geographical names cannot be registered as trade marks for being descriptive of the place of origin of the goods or services, where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question or are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods. It has to be determined whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods, not being necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.<sup>21</sup>

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<sup>19</sup> ECJ, 8.5.2008, C-304/06 P – EUROHYPO  
ECJ, 12.2. 2004, C-265/00 - Biomild  
ECJ, 2.6.2005, C-37/03 – BioID  
EGC, 13.11.2008, T-346/07 - Easycover

<sup>20</sup> Opinion of Advocate General Ruiz-Jarabo Colomer, 31.1.2002, C-363/99 – Postkantoor, and 14.5.2002, C-104/00 – Companyline; ECJ, 12.2.2004, C-363/99 – Postkantoor

<sup>21</sup> ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 - Chiemsee

- *Proof of acquisition of distinctiveness through use:*

Under Article 7(3) of the Regulation No 207/2009 a descriptive mark can still be registered as a Community trademark if evidence is provided that it has acquired, through the use which has been made of it, distinctive character in the part of the European Union in which it lacked such character. This part of the European Union may be comprised of a single Member State<sup>22</sup>.

The acquisition by a mark of distinctive character through use requires that at least a significant proportion of the relevant public identifies the products or services concerned as originating from a particular undertaking because of the mark.<sup>23</sup>

In past decisions, the ECJ and ECG have maintained that the acquisition of distinctive character through use has to be proven for all the Member States of the European Union in which the mark applied for did not originally have such character, not being sufficient to prove that the mark has acquired distinctive character through use in a substantial part of the European Union<sup>24</sup>. The Court based this opinion on the fact that under Article 7(1)(b) of Regulation No 207/2009, read in conjunction with Article 7(2) thereof, a mark must be refused registration if it is devoid of distinctive character in part of the European Union and that part may be comprised of a single Member State.<sup>25</sup>

However, in its recent Lindt Easter Bunny decision<sup>26</sup>, the ECJ declares that though according to its case law the distinctiveness acquired through use has to be proven for the part of the Union in which the mark lacks originary distinctiveness, it would go too far to demand that such a proof of acquired distinctiveness must be supplied for each member state separately.

This statement suggests that the ECJ may be willing to accept that the proof of distinctiveness acquired through use does not have to be supplied for each and every EU country in which it lacks originary distinctiveness, but that it suffices to furnish “quantitatively sufficient proof” that the mark has acquired distinctiveness in the whole territory of the European Union.

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<sup>22</sup> ECJ, 22.6.2006, C-25/05 P - Representation of a gold-coloured sweet wrapper

<sup>23</sup> ECJ, 7.7.2005, C-353/03 – Have a break  
EGC, 6.7. 2011, T-318/09 – TDI  
EGC, 15.12.2005, T-262/04 – Shape of a lighter  
EGC, 3.12. 2003, T-305/02 – Shape of a bottle

<sup>24</sup> EGC, 6.7. 2011, T-318/09 - TDI

<sup>25</sup> EGC, 6.7.2011, T-318/09 - TDI

<sup>26</sup> ECJ, 24.5.2012, C-98/11 P – Shape of a chocolate bunny wrapped in golden foil

## I.2. In the U.S.:

### I.2.a. The applicable provisions of the Lanham Act:

- *Ground for refusal of descriptive character:*

§ 2 (e)(1) of the Trademark Act of 1946 (15 U.S.C. § 1052) provides that a mark which is merely descriptive or deceptively misdescriptive of the goods on or in connection with which it is used is not registrable on the principal register.

- *Registrability upon proof of secondary meaning:*

§ 2 (f) of the Trademark Act allows registration of such a mark if it has become distinctive of the applicant's goods in commerce.

- *Fair use defense:*

§ 33(b)(4) of the Lanham Act (15 U.S.C. § 1115 (b)(4)) allows fair use of a descriptive term or device to describe the goods or services of the user, or their geographic origin.

### I.2.b. U.S. Case law on descriptive signs:

- *Concerning the reasons for not protecting merely descriptive marks:*

“The major reasons for not protecting such [merely descriptive] marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”<sup>27</sup>

Descriptive signs in most cases are also unable to serve as an indication of origin of the goods or services, as pointed out by The Supreme Court.<sup>28</sup>

“The law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade. This

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<sup>27</sup> *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978), citing *Armour & Co. v. Organon Inc.*, 44 CCPA 1010, 1014 and 1016, 114 USPQ 334, 337, 338 (1957)

<sup>28</sup> *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543 (1920), cited in *In re Abcor Dev. Corp.*, supra at 217. See also *Remington Products, Inc. v. North American Philips Corp.*, 13 USPQ. 2d 1444, 1448 (Fed. Cir. 1990): “The result was that “travel care” could not thereafter meet the essential characteristic of a trademark - that it *distinguish* the goods of one merchant from those of another. The reason it cannot do so is that usage in the trade as a category designation has rendered it descriptive and therefore incapable of designating origin. If both Norelco and Franzus put travel irons on the market associated with the words “Travel Care,” how can anyone, in the absence of some other mark, tell the origin of either of them?”

for the reason that the function of a trademark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public.”

- *Tests applied by U.S. Courts in determining the possible descriptiveness of a sign; trademark distinctiveness continuum:*

Case law has established four categories of marks according to their degree of distinctiveness: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful marks.<sup>29</sup>

- Generic marks:

No trademark protection is granted to generic terms. The name of a thing is the ultimate in descriptiveness.<sup>30</sup> A common descriptive name is not a trademark and is not capable of distinguishing an applicant's goods.<sup>31</sup> It cannot become a trademark under any circumstances<sup>32</sup>, even if it has in fact come to indicate origin.<sup>33</sup>

The main question to be asked when determining the possible genericness of a designation is: What do buyers understand by the word for whose use the parties are contending?<sup>34</sup>

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<sup>29</sup> *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir.1979) *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, 2757 (1992) - both citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir.1976).

<sup>30</sup> *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 48 CCPA 1004, 129 USPQ 411, 413 (1961) citing *In re Cooper*, 45 CCPA 923, 254 F.2d 611, 177 USPQ 396 (1958); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986)

<sup>31</sup> *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 962 (Fed.Cir.1985) citing *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 151 USPQ 606 (CCPA 1969); *Cummins Engine Co., Inc. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966); *Clairol, Inc. v. Roux Distributing Co., Inc.*, 280 F.2d 863, 126 USPQ 397 (CCPA 1960).

<sup>32</sup> *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir.1976)); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 48 CCPA 1004, 290 F.2d 845, 129 USPQ 411, 414 (1961) (“registration of the Hungarian name for noodles, “haluska” or its phonetic equivalent in English, whether or not hyphenated, would be contrary to law for no one can be granted the exclusive use of the name of an article, either in our native tongue or its equivalent in any foreign language”). See also *Gustave Holland, Jr. v. C. & A. Import Corp.*, 22 USPQ 249 (S.D.N.Y. 1934); *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*, 50 USPQ.2d 1626 (2nd Cir. 1999).

<sup>33</sup> *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 48 CCPA 1004, 290 F.2d 845, 129 USPQ 411, 414 (1961) citing *J. Kohnstam, Ltd. v. Louis Marx & Co., et al.*, 47 CCPA 1080, 280 F.2d 437, 126 USPQ 362; *In re The Deister Concentrator Corp.*, 48 CCPA 952, 289 F.2d 496, 129 USPQ 314; *In re Shakespeare*, 48 CCPA 969, 289 F.2d 506, 129 USPQ 323; *DeWalt, Inc. v. Magna Power Tool Corp.*, 48 CCPA 909, 289 F.2d 656, 129 USPQ 275.

<sup>34</sup> Opinion of Judge Learned Hand in *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y.1921). (“So here the question is whether the buyers merely understood that the word ‘Aspirin’ meant this kind of drug, or whether

“A mark answers the buyer's questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’”<sup>35</sup>

If buyers take the word to refer only to a particular producer's goods or services, it is not generic. But if the word is identified with all such goods or services, regardless of their suppliers, it is generic and not a valid mark.<sup>36</sup>

Determining whether a mark is generic involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?<sup>37</sup>

A combination of two generic words is also generic, unless the combination is a “deviation from natural usage” or an “unusual unitary combination”.<sup>38</sup>

- Descriptive marks:

The next category of marks, which only qualify for trademark protection if they have acquired secondary meaning, are descriptive marks.

A mark is merely descriptive if it “consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark”<sup>39</sup>, being enough if it describes one characteristic of the goods or services.<sup>40</sup>

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it meant that and more than that; i.e., that it came from the same single, though, if one please anonymous, source from which they had got it before.”)

<sup>35</sup> *Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.*, 198 F.3d 1143, 1147 (9th Cir.1999) quoting *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir.1993) (quoting 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 12.01 (3d ed.1992))

<sup>36</sup> *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) quoting *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 579 (2 Cir. 1963); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1069 (9th Cir. 2002) citing *Park N' Fly, Inc. v. Dollar Park and Fly, Inc.*, 718 F.2d 327, 330.

<sup>37</sup> *The H. Marvin Ginn Corporation v. The International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528 (Fed. Cir. 1986) quoting *Department of Justice, Federal Bureau of Investigation v. Calspan Corp.*, 578 F.2d 295, 299, 198 USPQ 147, 149 (CCPA 1978); *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 1118, 174 USPQ 395, 398 (CCPA 1972); *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 1394–95, 160 USPQ 233, 235–36 (CCPA 1969).

<sup>38</sup> *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.*, 198 F.3d 1143, 1147 (9th Cir.1999)

<sup>39</sup> *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) citing *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543 (1920).

<sup>40</sup> *In re Andes Candies Inc.*, 478 F.2d 1264, 1267, 178 USPQ 156, 157 (CCPA 1973) (CREME DE MENTHE held descriptive for laminated chocolate mint candy squares) quoting *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 49 C.C.P.A. 931 (1962); *In re Sun Oil Co.*, 426 F.2d 401, 57 C.C.P.A. 1147 (1970); *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 56 C.C. P.A. 1110 (1969).

Merely descriptive marks “define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood”.<sup>41</sup> They immediately convey knowledge of a quality or characteristic of the product.<sup>42</sup>

When determining the descriptive character of a mark, “it seems elementary that one must find out how people in the trade and the purchasers use the terms with respect to the involved goods in order to determine whether or not they are descriptive.”<sup>43</sup>

Merely descriptive marks, unlike suggestive and arbitrary or fanciful marks, are not inherently distinctive and can only enjoy trademark protection if they have acquired secondary meaning.<sup>44</sup>

To possess secondary meaning, and thus qualify for trademark protection, the descriptive term must have become distinctive of the applicant's goods in commerce<sup>45</sup> because customers associate the mark with a particular source.<sup>46</sup>

In order to establish a secondary meaning for a term, a plaintiff “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”<sup>47</sup>

- Suggestive marks – drawing the line between descriptive and suggestive signs:

The third category of marks, suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning.

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<sup>41</sup> *Nautilus Group, Inc. v. ICON Health and Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ.2d 1173 quoting *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d, 1042, 1047 (9th Cir. 1998).

<sup>42</sup> *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ.2d 1370, 1371 (Fed. Cir. 2004) citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ.2d 1807, 1812 (Fed. Cir. 2001). *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 594 (TTAB 1979)

<sup>43</sup> *In re Andes Candies Inc.*, 478 F.2d 1264, 1267, 178 USPQ 156, 157 (CCPA 1973) quoting *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 1396, 56 C.C.P.A. 817, 823 (1969)

<sup>44</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, 2758 (1992) quoting Restatement (Third) of Unfair Competition § 13, pp. 37–38, and Comment a (Tent. Draft No. 2, Mar. 23, 1990): “The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning.”

<sup>45</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 112 S.Ct. 2753 (quoting 15 U.S.C. § 1052(e), (f))

<sup>46</sup> *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 citing *Rodeo Collection Ltd. v. West Seventh*, 812 F.2d 1215, 1218, 2 USPQ.2d 1204 (9th Cir. 1987)

<sup>47</sup> *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790, 217 USPQ 988, 994, citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118, 39 USPQ 296, 299 (1938)

Suggestive marks are considered to be inherently distinctive, and thus automatically qualify for trademark protection because they naturally “serve [ ] to identify a particular source of a product...”<sup>48</sup>

Whether a mark has to be qualified as suggestive or merely descriptive will depend on “the imaginativeness involved in the suggestion, that is, how immediate and direct is the thought process from the mark to the particular product. If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.”<sup>49</sup>

“A suggestive mark is one for which ‘a consumer must use imagination or any type of multistage reasoning to understand the mark's significance ... the mark does not *describe* the product's features, but *suggests* them.”<sup>50</sup>

“A suggestive mark employs terms which do not describe but merely suggest the features of the product, requiring the purchaser to use imagination, thought and perception to reach a conclusion as to the nature of goods.”<sup>51</sup>

If a mark imparts or conveys an immediate idea of the ingredients, qualities or characteristics of the goods, the term is descriptive, while the term would be considered suggestive if, as applied to the goods, it requires imagination, thought and perception to reach a conclusion as to the nature thereof.<sup>52</sup>

An incongruity between the message or idea conveyed by the mark and the real characteristics of the goods or services also indicates suggestiveness. Incongruity is “one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark”.<sup>53</sup> The mark “Tennis in the round” will be associated by the public to the well-known phrase “theater-in-the-round” and therefore conveys the idea of a tennis court in the middle of an auditorium, which does not correspond to what applicant's tennis facilities

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<sup>48</sup> *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1067 (9th Cir.2003) citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S.Ct. 2753, 2757 (1992) („their intrinsic nature serves to identify a particular source of a product.”)

<sup>49</sup> *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) quoting *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir.1995)

<sup>50</sup> *Entrepreneur Media, Inc. v. Smith*, 279 F.3d, 1135, 1142, 61 USPY 2d 1705 (9th Cir. 2002) quoting *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 (9th Cir. 1998)

<sup>51</sup> *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 143 (2d Cir.1997) quoting *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 572 (2nd Cir. 1993)

<sup>52</sup> *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) quoting *In re Colonial Refining and Chemical Company*, 196 USPQ 46 (TTAB 1977). See also *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972).

<sup>53</sup> See *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978); *In re Shutts*, 217 USPQ 363, 364-5 (TTAB 1983) “the concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’”

really look like.<sup>54</sup> This incongruity renders the mark suggestive. A rake is not normally used to remove snow, which is why the mark “Sno-rake” has been considered suggestive of snow removal tools.<sup>55</sup>

Other tests applied in drawing the line between descriptive and suggestive terms look at the use competitors make of the same or similar terms, the need of others in the marketplace to use the term to describe their goods or services<sup>56</sup> and how useful competitors might find the term to designate the characteristics of their own products.<sup>57</sup> “If there are numerous synonyms for a common trademarked word, others will have less need to use the trademarked term.”<sup>58</sup> If the term or sign is extensively used by third parties, consumers are likely not to perceive it as a trademark.<sup>59</sup>

## **II. DECISIONS OF U.S. AND EUROPEAN COMMUNITY COURTS REGARDING DESCRIPTIVE SIGNS:**

### **II.1. Decisions of the European Court of Justice and the European General Court:**

#### **II.1.a. Marks which were found merely descriptive:**

The following trademarks have been found to be descriptive and therefore not eligible for registration as a Community trademark by the European Court of Justice and/or the European General Court.

In some of these cases, the applicants alleged that the sign is registered as a trademark in the U.S. and other countries. This argument was rejected by the Court declaring that according to settled case law, the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system. Accordingly, the registrability of a sign as a Community trade mark is to be assessed solely on the basis of the relevant Community legislation.<sup>60</sup>

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<sup>54</sup> *In re Tennis in the Round Inc., ut supra.*

<sup>55</sup> *In re Shutts, ut supra.*

<sup>56</sup> *In re Dune Medical Devices Ltd.*, 2011 WL 1495445 (TTAB 2011).

<sup>57</sup> *Q-TIPS, Inc. v. Johnson & Johnson*, 206 F.2d 144, 146, 147, 98 U.S.P.Q. 86 (3rd Cir. 1953)

“The numerous competitors in the field had got along well enough without using the word, and still do so. It can scarcely be said that ‘tips’ is a reasonably necessary word to describe the product to the public.”

*In re Shutts*, 217 USPQ 363, 364, 365 (TTAB 1983): Use of the term “SNORAKE” “would hardly remove a desired or apt descriptive characterization from the trade repertoire of other makers and sellers of snow removal tools. It is difficult to perceive any competitive need to use “SNORAKE” or “snow rake” or “snow raking” or even “raking” in describing goods of the type before us, and that too is a relevant indicator of the suggestive as opposed to the descriptive mark”.

<sup>58</sup> *Entrepreneur Media, Inc. v. Smith*, 279 F.3d, 1135, 1143, 61 USPQ.2d 1705 (9th Cir. 2002)

<sup>59</sup> *Playboy Enterprises, Inc. v. Netscape Communications Corp.*, 354 F.3d, 1020, 1028 (9th Cir. 2004)  
*Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 (9th Cir. 1998)

<sup>60</sup> EGC, 12.6.2007, T-339/05 – Truwhite; ECG, 6.3.2012, T-565/10, ThyssenKrupp Steel Europe AG v. OHIM – Highprotect; EGC, 22.11.2011, T-290/10 – Tennis Warehouse; EGC, 12.6.2007, T-339/05 – Lokthread

- Word mark „**TRUEWHITE**“ for LED’s in class 9 and „Lighting apparatus“ in class 11 of the Nice Classification<sup>61</sup>:

In this decision, the European General Court first quoted the principles established by the ECJ that for a sign to be merely descriptive there must be a “sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics” and that “a combination of descriptive terms is itself, in principle, descriptive of the goods or services for which registration is sought, except where, because of the unusual nature of the combination, the sign in question creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by its component elements, with the result that the word is more than the sum of its parts.”

It then declared that on the basis of a specific meaning of the sign it has to be examined whether the sign “TRUEWHITE” from the point of view of the relevant public has a sufficiently direct and specific relationship with the goods in respect of which registration is sought. It finally held that the combination of the elements “true” and “white” obeys the grammar rules of the English language, is not unusual and does not create an impression sufficiently far removed from that created by the mere combination of the words.

The sign “TRUEWHITE” can be perceived as indicating a „true white“ and is therefore descriptive of an essential characteristic of the goods concerned, namely their capacity to create a white light, which can be compared to natural light.<sup>62</sup>

- Word mark „**REVALUE**“ for services in classes 35, 36 and 42, mainly in the field of real estate<sup>63</sup>:

According to the General Court, the meaning of the word „revalue“ will be understood without any mental effort nor special knowledge by any consumer in the English speaking part of the EU.

As it is a word of everyday language, the use of which is not limited to any specific field, it allows the relevant public without any further thought the assumption that this indication, namely that the services offered under that mark are able to increase the value of their assets, refers to one of the essential characteristics of these services.

- Word mark „**υγεία**“ for „medical services“ in class 44<sup>64</sup>:

The word “υγεία” written in greek letters translates into “health” in latin letters and directly and immediately describes to the Greek consumer the purpose of the services, namely the recovery of health.

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<sup>61</sup> EGC, 7..7.2011, T-208/10

<sup>62</sup> EGC, 12.6.2007, T-339/05

<sup>63</sup> EGC, 28.6. 2011, T-487/09

<sup>64</sup> EGC, 17 May 2011, T-7/10

- Word mark „**RESTORE**“ für „surgical and medical instruments and apparatus; stents; catheters; guide wires“ in class 10<sup>65</sup>:

The mark has been found to be descriptive, as the word „restore“ for goods such as surgical and medical instruments and apparatus, stents and catheters will be understood immediately and unambiguously by the English speaking public or at least the expert public with a sufficient knowledge of the English language in the sense that there is a direct relationship with the restoration of the health of the persons for whom the products at issue are used.

The sign also lacks distinctiveness, as it will be understood as an indication of the functionality of the goods, and not as an indication of their origin.

- Word Mark “**HIGHPROTECT**” for “metals, steel etc.” in class 6<sup>66</sup>:

The Court argued that for a sign to be rejected it is not necessary that the sign is actually used as descriptive term, but that it suffices that it can be used as such.

The relevant public will understand the meaning of the English words “high” and “protect” and will perceive the composite mark as an indication that the goods concerned offer a high protection against corrosion and wear.

- Word mark “**AMPLIDECT**” for ‘Telecommunications apparatus and instruments; telephones and telephone answering machines; parts and fittings included in Class 9 for all the aforesaid goods’ in class 9 and ‘Printed matter; manuals, leaflets, booklets, magazines’ in class 16<sup>67</sup>:

The term “amplidect” immediately and unequivocally informs the relevant public of the essential characteristics of the goods marketed by the applicant and covered by the disputed registration, namely an amplificatory function incorporated in a telephone and using DECT technology.

- Word mark “**TENNIS WAREHOUSE**” for goods in classes 25 and 28<sup>68</sup>:

The sign will be understood by the relevant public in accordance with the rules of grammar of the English language as indicating a warehouse or a store where tennis articles are stored and in its case offered for sale at wholesale prices. The applicant has not disputed that the goods in question are all articles of clothing, for which it cannot be excluded that they might be used for or associated with tennis, or articles which are or might be related to sports in general or specifically tennis articles. The word sign TENNIS WAREHOUSE will be understood directly and without further thought be the relevant public as indicating the place where such goods are usually stored and possibly offered for sale.

- Word mark “**LOKTHREAD**” for ‘bolts, bolts of metal, nuts, nuts of metal’ in class 6<sup>69</sup>:

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<sup>65</sup> EGC, 15.11.2011, T-123/10

<sup>66</sup> EGC, 6.3.2012, T-565/10, ThyssenKrupp Steel Europe AG v. OHIM

<sup>67</sup> EGC, 23.11.2011, T-59/10

<sup>68</sup> EGC, 22.11.2011, T-290/10

The mere combination of the words ‘lok’ and ‘thread’, the first being descriptive of the intended use and the second of a technical characteristic of the goods concerned, is itself also descriptive of that intended use and of that characteristic of those goods.

- Word mark **“PRANAHAUS”** (translated: PRANA-HOUSE) for services in classes 9, 16 and 35<sup>70</sup>:

According to the EGC and ECJ, the mark has the meaning of a house or a place for the sale of goods or the offering of services with a specific thematic content with a close relation to esoteric, hinduism and yoga and is therefore descriptive of the goods and services concerned.

- Word mark **“GOLDEN TOAST”** for “electrical household appliances, baking machines” in class 11 and “flours and cereal preparations, bread, bakery goods, doughs” etc. in class 30<sup>71</sup>:

The sign “Golden Toast” consists exclusively of elements which are descriptive of the characteristics and the actual or desired purpose of the goods concerned (to produce or to convert into a golden toast).

The adjective “golden” indicates in a laudatory manner that the final product, a toasted bakery good, is toasted just right. The fact that the bakery good is sold in a raw state does not change this result, as the goods are destined for being toasted. The word “golden” refers to a characteristic of each of the goods at issue, as the baking machine in class 11 can bake the dough or bakery good just to the right point and the goods in class 30 will turn “golden” when toasted or baked.

The applicant argued that the sign was not used by competitors to describe their goods nor their characteristics, and that there was no need for the sign “Golden Toast” to be freely used by competitors, to which the Court replied that the applicability of the ground for refusal of descriptive character does not require that the sign is actually used in a descriptive manner, being sufficient that it might be used in such a way, nor the existence of a concrete, current and serious need to keep the sign available for competitors.

- Word mark **“ATRIUM”** for various building materials (mainly of wood) and floor coverings in classes 19 and 27<sup>72</sup>:

The term “Atrium” refers to the central room of a house in Roman architecture as well as to a interior courtyard without a roof or with a glass roof.

Building materials and floor coverings can be used for the construction or furnishing of the central room of a house as well as a central courtyard. The term “Atrium” can therefore be used to describe the purpose of the goods covered by the application (to build an Atrium).

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<sup>69</sup> EGC, 12.6.2007, T-339/05

<sup>70</sup> ECJ, 9.12.2009, C-494/08; EGC, 17.09.2008, T-226/07

<sup>71</sup> EGC, 19.5.2010, T-163/08

<sup>72</sup> EGC, 17.1.2012 – T-513/10

- Word mark “**HALLUX**” for “orthopaedical articles” in class 10 and “footwear” in class 25<sup>73</sup>:

The term “Hallux” refers to various forms of foot deformation. The relevant consumers will without a special mental effort make a concrete connection between the term hallux and the purpose of the goods.

- Word mark „**PIPELINE**“ for ‘Medical devices, namely, devices used in the treatment of aneurysms’ in class 10<sup>74</sup>:

A medical professional specialising in the treatment of aneurysms will immediately understand the word ‘pipeline’, as used in the context of his specialisation, as being a direct and specific indication of the characteristics of the goods in question.

- According to the General Court the word mark **MPAY24** (for ‘Data processing apparatus, software, hardware’ in class 9; Printed matter, particularly magazines’ in class 16; ‘Advertising and business management’ in class 35; ‘Financial affairs’ in class 36 and ‘Telecommunication’ in class 38)<sup>75</sup> could be understood as referring to a system making it possible to pay by mobile telephone around the clock (mobile payment) or even a multifunctional payment system available around the clock (multi payment) and is therefore descriptive in character.<sup>76</sup>

- Word mark „**COMPLETE**“ for goods in classes 5 and 10 (incontinence pads, diapers etc. but also orthopaedic articles and surgical suture material)<sup>77</sup>:

The EGC shared OHIM’s view that the mark will immediately convey the idea to the consumer, that all goods covered by the application serve the purpose of a „full service against incontinence”, but upheld the appeal for other reasons.

#### II.1.b. Marks which were declared not merely descriptive:

On the other hand, in the following cases the ECJ and/or EGC have **not qualified the mark as merely descriptive**:

- the application for declaration of invalidity of the word mark “**COLLEGE**” for “tourist and travel agencies; passenger transport; sightseeing etc.” services in class 39 and “hotel, temporary accommodation and boarding house reservations; providing of food and drink and hotel accommodation etc.” services in class 43 was rejected because the applicant had “failed to establish a sufficiently direct and specific link, in the mind of the relevant public, between the term ‘college’ and the services concerned.”<sup>78</sup>

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<sup>73</sup> EGC, 16.12.2010 – T-286/08

<sup>74</sup> EGC, 11.10.2011, T-87/2010

<sup>75</sup> EGC, 22.11.2011, T-275/10

<sup>76</sup> Notwithstanding this finding the Court upheld the appeal for other reasons and the mark is now registered.

<sup>77</sup> EGC, 30.11.2011, T-123/10

<sup>78</sup> EGC, 12.6.2012, T-165/11, Stichting Regionaal Opleidingencentrum van Amsterdam v. OHIM and Investimust SA.

- the application for declaration of invalidity of the word mark “**16PF**” (the abbreviation of the denomination of a specific behavioral test “16 personality factors”) for goods and services relating to personality assessment was rejected, as “the average professional in the human resources sector would not understand the meaning of the mark at issue without a complex process of interpretation involving time of reflection and a significant amount of imagination. Such a process of interpretation is incompatible with the recognition of the descriptive character of a sign, the meaning of which must be immediately perceived without further thought”.<sup>79</sup>

- The European General Court annulled the rejection of the mark “**CELLTECH**” for pharmaceutical etc. goods and services in classes 5, 10 and 42 because the Board of Appeal did not establish that the term, even taken as meaning cell technology, is such as to be immediately and unambiguously perceived as designating activities in the field of cell technology and products used in connection therewith.<sup>80</sup> The ECJ confirmed this decision, declaring that the EGC did not hold that a word or an expression designating a scientific method which enables the manufacture of pharmaceutical, veterinary or hygienic preparations, compounds or substances or the supply of services relating to the biological, medical and chemical sciences is not descriptive of the goods and services obtained by that method but annulled the contested decision on the ground that the Board of Appeal had not established, in particular, that cell technology is a method of production of the goods or of supply of the services referred to in the application for registration. Thus, the EGC did not annul the Board of Appeal’s decision because it found that the mark “Celltech” is not descriptive of the goods concerned but because the Board had failed to explain and to furnish evidence of the relationship between the mark “Celltech” and the goods concerned (as it had considered the term “cell technology” and the fact that it can be a method of production of the goods concerned self explanatory).

## **II.2. Recent rejecting decisions of the Boards of Appeal of OHIM:**

As the majority of rejections of Community trade mark applications are not appealed before the European General Court and the European Court of Justice, the final decision on descriptiveness is usually taken by the examiner or – in second instance – the Boards of Appeal of OHIM:

Here are some examples for signs which have recently been declared descriptive by the Boards of Appeal of OHIM:

- “**DEFINITIVE GROOM**” for goods in class 3.<sup>81</sup>

This decision is a good example of how the above described general principles established by the ECJ are currently interpreted and applied by OHIM:

After quoting the above described ECJ case law, the Board stated that registration of the mark is sought for “cosmetics; hair lotions; preparations for the cleaning, care and beautification of

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<sup>79</sup> EGC, 7.6.2011, T-507/08

<sup>80</sup> EGC, 14.4.2005, T-260/03

<sup>81</sup> R-1414/2011-2, 17.9.2012

the skin, scalp and hair; hair styling products; hair tinting, bleaching, dyeing and coloring preparations” in class 3, which are products for mass consumption that are mainly aimed at the general public.

It went on to analyze the meanings of the words “definitive” and “groom”, which are “not able to be changed or improved; final, complete, or best” and “to look after your appearance by keeping your hair, body, and clothes clean and tidy” and, on the basis of that meaning, assessed whether, from the point of view of the intended public, there is a sufficiently direct and specific relationship between the sign “DEFINITIVE GROOM” and the goods in respect of which registration is sought. It explained that the goods applied for in class 3 are goods that have as one of their main final aims to provide consumers with a groomed look. Thus, when the expression “DEFINITIVE GROOM” is used in connection with these goods the relevant consumers will directly understand, without the need for further reflection, that these products provide the best in grooming, their purpose being to groom with a final, complete or best result. This expression merely informs consumers that by using these products they will get a definitive groomed look. The Board concludes that taken as a whole this expression has the meaning that results from the mere addition of the meanings of each of its components, which directly informs about the kind, quality and intended purpose of the goods involved.

- **“MASTERWALL”** for paints, building materials etc.<sup>82</sup>

The Board held that there is a clear and specific relationship between the sign and the goods as the mark has a clear meaning of “exemplary wall”, the goods are all used in the construction of walls, and the mark will therefore be understood as referring to first quality materials which are used in the construction of a perfect wall.

- **“CLEAR FOCUS”** for “plastic film for use in displaying advertising graphics and signage” in class 17.<sup>83</sup>

The examiner rejected the mark because the expression “CLEAR FOCUS” complies with English grammar rules and means “the state of an optical image when it is distinct”. The expression immediately informs consumers that the goods are plastic films that enable a distinct display of advertising graphics and signage. Therefore, the application conveys direct information on the purpose of the goods.

The Board of Appeal found that the mark also lacked distinctiveness because the targeted public will see the mark as an advertising slogan and not as an indication of origin.

The following marks were also declared descriptive by the examiners and the Boards of Appeal of OHIM:

- **“PVLIN”** for goods and services related to (solar) energy.<sup>84</sup>
- **“WATERFLUX”** for measuring instruments.<sup>85</sup>

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<sup>82</sup> R-272/2012-4, 26.9.2012

<sup>83</sup> R-1844/2011-4, 11.9.2012

<sup>84</sup> R-789/2011-4, 16.10.2012

<sup>85</sup> R-115/1012-4, 8.10.2012 (quoting EGC, 22.6.2005, T-10/04 -Paperlab; 27.02.2002, T-106/00 – Streamserve; ECJ, 12.2.2004, C-363/99 – Postkantoor; 12.2.2004, C-265/00 – Biomild)

- **“DIGISPA”** for goods in classes 9 and 11.<sup>86</sup>
- **“BIOCLAMP”** for goods in classes 9 and 17.<sup>87</sup>
- **“CLASSIC”** for dental instruments etc.<sup>88</sup>
- **“SPARK INSPIRATION”** for computers etc.<sup>89</sup>

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<sup>86</sup> R-2545/2011-4, 4.10.2012

<sup>87</sup> R-879/2012-2, 1.10.2012

<sup>88</sup> R-1564/2011-4, 17.9.2012

<sup>89</sup> R-1376/2012-4, 17.9.2012

### **II.3. Decisions of U.S. Courts regarding descriptive/suggestive signs:**

#### **II.3.a. Decisions in which the mark was held merely descriptive:**

The following marks have been held **merely descriptive** of the goods or services concerned:

- The word mark “**APPLE PIE**” was held merely descriptive of potpourri, as it “conveys the key characteristic of the potpourri, its scent.”<sup>90</sup>

- The mark “**ENTREPRENEUR**” for a magazine for small businesses. “The word “entrepreneur” describes both the subject matter and the intended audience of the magazine and programs; an entirely unimaginative, literal-minded person would understand the significance of the reference.”<sup>91</sup>

- The word mark “**BED & BREAKFAST REGISTRY**” was refused registration for lodging reservations services, as it “would be understood to describe a register of bed and breakfast lodgings, and may convey the related thought of registering at a bed and breakfast lodging”.<sup>92</sup>

- The designation “**MALE-P.A.P. TEST**” was held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer and reporting results thereof, as it is likely to be perceived as an indication that applicant’s services involve tests for the detection of cancer of the male reproductive tract.<sup>93</sup>

- The designation “**COASTER-CARDS**” was declared merely descriptive of a coaster suitable for direct mailing, as it conveys “an immediate idea of a significant characteristic of such goods, namely, that they consist of a combination of a coaster and a greeting or postal card”.<sup>94</sup>

- In *Zatarains, Inc. v. Oak Grove Smokehouse, Inc. et al.* the trademark “**Fish-Fri**” was held descriptive of batter mixes used to fry foods.<sup>95</sup> The court stated that “mere observation compels the conclusion that a product branded “Fish-Fri” is a prepackaged coating or batter mix applied to fish prior to cooking” “it simply does not require an exercise of the imagination to deduce that “Fish-Fri” is used to fry fish” that competitors are likely to find “fish fry” a useful term for describing their batter mix for frying fish, and that other companies were already using the word combination “fish fry” to identify their batter mixes.

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<sup>90</sup> In re *Joseph Gyulay*, 820 F.2d 1216, 1218, 3 USPQ2d 1009 (Fed. Cir. 1987)

<sup>91</sup> *Entrepreneur Media, Inc. v. Smith*, 279 F.3d, 1135, 1142, 61 USPY 2d 1705 (9th Cir. 2002)

<sup>92</sup> In re *Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818 (Fed. Cir. 1986)

<sup>93</sup> In re *MetPath Inc.*, 223 USPQ 88, 89 (TTAB 1984)

<sup>94</sup> In re *Bright-Crest, Ltd.*, 204 USPQ 591, 594 (TTAB 1979)

<sup>95</sup> *Zatarains, Inc. v. Oak Grove Smokehouse, Inc. et al.*, 698 F.2d 786, 996, 217 USPQ, 988.

- The sign “**JAPAN TELECOM**” was held descriptive for a telecommunications business that caters to the Japanese community, as it “leaves very little to the imagination”.<sup>96</sup>

- In *Vision Center v. Opticks, Inc.*<sup>97</sup> the trade name “**VISION CENTER**” was deemed descriptive of a clinic providing optical goods and services.

- The sign “**FIRSTIER**” was held unregistrable for banking services, because it describes a class of banks.<sup>98</sup>

### II.3.b. Decisions in which the mark was found suggestive:

On the other hand, the following marks were qualified as **suggestive marks**:

- The term “**SNO-RAKE**” was held not merely descriptive of a snow-removal hand tool.<sup>99</sup>

The Court stated that “it would be rare (indeed, close to non-existent) in contemporary usage to request someone to “rake snow” from either a large or small surface or to refer to any long or short-handled snow removal tool (e.g., an auto windshield scraper) as a “rake” and evoke an understanding of this as a natural language usage” and that there was no need for competitors to be able to freely use the term.

- The mark “**BOWFLEX**” was declared a suggestive mark for resistance training systems that use bendable rods. The Court found that the “mental leap” between “Bowflex” and the curving rods it describes is not “almost instantaneous” and that it requires “imagination or any type of multistage reasoning to understand the mark's significance.”<sup>100</sup>

- The mark “**SPEEDI BAKE**” was declared to “only vaguely suggest a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread.”<sup>101</sup>

- The designation “**NOBURST**” for liquid antifreeze and rust inhibitor for hot-water-heating systems was found to “suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute”<sup>102</sup>

- The mark “**DRI-FOOT**” was held suggestive of anti-perspirant deodorant for feet. The Board declared that “DRI-FOOT” is “obviously not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described” and that “the registration of “DRI-FOOT” could not preclude the use by competitors of the ordinary descriptive phrase “keeps feet dry” in connection with their products”.<sup>103</sup>

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<sup>96</sup> *Japan Telecom, Inc. v. Japan Telecom America Inc.*, 287 F.3d 866, 873 (9th Cir. 2002)

<sup>97</sup> 596 F.2d 111, 116 202 U.S.P.Q. 333 (5th Cir. 1979)

<sup>98</sup> *In re Omaha National Corp.*, 819 F.2d 1117 (Fed. Cir. 1987)

<sup>99</sup> *In re Shutts*, 217 USPQ 363 (TTAB 1983)

<sup>100</sup> *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1343 (Fed. Cir. 2004)

<sup>101</sup> *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985)

<sup>102</sup> *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985)

<sup>103</sup> *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972)

- The mark “**SWIVEL-TOP**” was held suggestive of mooring buoys.<sup>104</sup>

- In *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*<sup>105</sup> the Court found that a **grape leaf as mark for wine** would normally be inherently distinctive because it suggests, rather than describes, the product. “One has to go through two or three steps to associate the leaf with the product-i.e., a grape leaf comes from a grapevine, which has grapes from which wine is produced”. However, because of the long use also by other wine bottlers of grape leaves to decorate their labels, the grape leaf emblem was found to be generic.

- The mark “**THE MONEY SERVICE**” was declared not merely descriptive for “financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution” because “to effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation.”<sup>106</sup>

- The mark “**TENNIS IN THE ROUND**” was held not merely descriptive of the service of providing tennis facilities in the form of courts and tennis ball machines and offering instructions in tennis.

The Trademark Trial and Appeal Board found that the “association of applicant's marks with the phrase “theater-in-the-round” creates an incongruity because applicant's tennis facilities are not in fact at all analogous to those used in a “theater-in-the-round” and that others offering the same service did not appear to have any need to use the phrase “in the round” in describing their service.”<sup>107</sup>

- In *Synergistic International, LLC v. Korman*<sup>108</sup> the mark “**GLASS DOCTOR**” was deemed suggestive of windshield repair services, as the public is more likely to view the word “doctor” to mean “healing”, rather than to connote “repair”, and some imagination is necessary in order to deduce that “healing” applies to the repair or installation of glass and windshields.

- In *WWW Pharmaceutical Company, Inc. v. The Gillette Company*<sup>109</sup>, the mark “**SPORTSTICK**” was held suggestive of lip balm packaged in a tube.

- In *Orange Crush Co. v. California Crushed Fruit Co*<sup>110</sup> the designation “**ORANGE CRUSH**” was found suggestive of a beverage.

- The term “**MOVIEBUFF**” for computer software providing entertainment industry related data and information and providing access to an on-line database offering such information was found to be suggestive and not descriptive, “because it does not describe either the software product or its purpose” and “requires a mental leap from the mark to the product”.<sup>111</sup>

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<sup>104</sup> In re *Ray J. McDermott and Co., Inc.*, 170 USPQ 524 (TTAB 1971)

<sup>105</sup> 150 F.3d 1042, 1048 (9th Cir. 1998)

<sup>106</sup> In re *TMS Corporation of the Americas*, 200 USPQ 57, 58 (TTAB 1978).

<sup>107</sup> In re *Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978)

<sup>108</sup> 470 F.3d 162, 172 (4th Cir. 2006)

<sup>109</sup> 984 F.2d 567, 572 (2nd Cir. 1993)

<sup>110</sup> 54 U.S.App.D.C. 313, 297 F. 892 (1924)

<sup>111</sup> *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036 at 1058 (9th Cir. 1999)

- In *GoTo.com v. The Walt Disney Company*<sup>112</sup> the mark “**GoTo.com**” (consisting of the words “GO” and “TO” in a white font stacked vertically within a green circle and the characters “.com” in black) for an Internet search engine was declared to fall into the suggestive category.

- In *BlendCo Inc. v. Conagra Foods, Inc.*<sup>113</sup> the product name “**Better-N-Butter**” for butter-flavored oil was considered suggestive rather than descriptive. The producer of “a butter-flavored oil would not likely need or even find useful the exact term “Better-N-Butter” or a similar term in its name”. No other competitors were using the term as a name of the product.

- In *Douglas Laboratories Corp. v. Copper Tan Inc.*<sup>114</sup> the term “**COPPERTONE**” was found not merely descriptive of a sun tan lotion.

- In *The Coca-Cola Company v. The Seven-Up Company*<sup>115</sup> the mark “**THE UNCOLA**” was held not to be merely descriptive of soft drinks.

- The term “**TREKKING**” was declared not merely descriptive of “educational services, namely providing seminars and clinics relating to the use of exercise equipment”.<sup>116</sup>

- In *Maremont Corp. v. Air Lift Corp.*<sup>117</sup> the Court stated that the term “**LOAD-CARRIER**” was highly suggestive of the function of the goods (vehicle load supports), but equally suggestive of many other things – e.g. wheel barrows, dump trucks, freight cars, steamships and elevators. The mark was therefore deemed not so obviously descriptive that it was incapable of use as a trademark.

- The mark “**CHEW N’ CLEAN**” was held suggestive of dentifrice. The Trademark Trial and Appeal Board had found the mark to be merely descriptive of the intended use of applicant’s dentifrice, as it “immediately and directly relates the information that applicant’s dentifrice is a product that will clean the teeth when it is chewed”. The United States Court of Customs and Patent Appeals reversed the Board’s decision, holding that “granted that ‘CHEW ‘N CLEAN’ might well, and doubtless does, suggest a possible manner of use of the dentifrice, it is not merely descriptive of the dentifrice per se.”<sup>118</sup>

- In *Tigrett Industries, Inc. v. Top Value Enterprises, Inc.* the trade mark “**PITCH BACK**” was held not to be descriptive of a recreational apparatus the purpose of which is to return a ball thrown against the apparatus. The Court declared that “Such terms, indeed, shed some light upon the characteristics of the goods, but so applied they involve an element of incongruity, and in order to be understood as descriptive, they must be taken in a suggestive or figurative sense through an effort of the imagination on the part of the observer”.<sup>119</sup>

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<sup>112</sup> *GoTo.com v. The Walt Disney Company*, 202 F.3d 1199 at 1207 (9<sup>th</sup> Cir. 2000)

<sup>113</sup> 132 Fed. Appx. 520, 521 (5<sup>th</sup> Cir. 2005)

<sup>114</sup> 210 F.2d 453 (2<sup>nd</sup> Cir. 1954)

<sup>115</sup> 497 F.2d 1351 (C.C.P.A. 1974)

<sup>116</sup> *In re Trek Bicycle Corp.*, 2001 WL 300519 (TTAB 2001)

<sup>117</sup> 463 F.2d 1114, 1117, 59 C.C.P.A. 1152, 1156 (1972)

<sup>118</sup> *In re COLGATE-PALMOLIVE CO.* 406 F.2d 1385, 56 CCPA 973 (1969)

<sup>119</sup> 217 F.Supp. 313, 316 (W.D. Tennessee 1963 Quoting *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4<sup>th</sup> Cir. 1940)

- In *Charles of the Ritz, Inc. v. Elizabeth Arden Sales Corporation*<sup>120</sup> the term “**FEATHER-LIGHT**” was held highly suggestive, but not merely descriptive of face cream.
- In *Feathercombs, Inc. v. Solo Products Corporation*,<sup>121</sup> the designation “**FEATHERCOMBS**” was deemed a valid mark for hair-retaining combs.
- In *Q-TIPS, Inc. v. Johnson & Johnson* the term “**Q-TIPS**” was declared a valid mark for cotton tipped medical swabs<sup>122</sup>.
- The term “**SPRAY MIST**” was held suggestive of one feature, or function, of a combination steam, spray and dry iron.<sup>123</sup>
- The mark “**SUGAR&SPICE**” was declared not merely descriptive bakery products. The Court declared that “the immediate impression evoked by the mark may well be to stimulate an association of “sugar and spice” with “everything nice” and that the term “along with the favorable suggestion which it may evoke, seems to us clearly to function in the trademark sense and not as a term *merely* descriptive of goods.”<sup>124</sup>
- The term “**UNBURN**” was qualified as being suggestive of a desired result rather than merely descriptive or deceptively misdescriptive of a medical preparation for minor skin irritations.<sup>125</sup>
- The designation “**BRAKLEEN**” for a chemical composition for cleaning and degreasing automotive brake parts was declared not merely descriptive. The TTAB found that “‘brake clean’ is suggestive of a desired result of a brake cleaner and therefore the asserted phonetic equivalent ‘Brakleen’ must be considered to be suggestive rather than merely descriptive when applied to applicant's goods.”<sup>126</sup>
- The words “**CLOTHES FRESH**” were found to be merely suggestive of a possible desirable end result of a clothes and shoe spray deodorant.<sup>127</sup>

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<sup>120</sup> 161 F.2d 234, 237, 34 CCPA 1029, 1032 (1947).

<sup>121</sup> 306 F.2d 251 (2nd Cir. 1962)

<sup>122</sup> 206 F.2d 144, 146, 147, 98 U.S.P.Q. 86 (3rd Cir. 1953)

<sup>123</sup> *In re Sunbeam Corp.*, 152 USPQ 116 (CCPA 1967)

<sup>124</sup> *In re Colonial Stores Inc.* 157 USPQ 382 (CCPA 1968)

<sup>125</sup> *The Norwich Pharmacal Company v. Chas. Pfizer & Co., Inc.*, 165 USPQ 644, 646 (TTAB 1970)

<sup>126</sup> *In re C. J. Webb, Inc.*, 182 USPQ 63 (TTAB 1974)

<sup>127</sup> *In re Frank J. Curran Co.*, 189 USPQ 560 (TTAB 1975)

### III. COMMENTS:

#### **II.1. Comparison of the applicable statutory provisions and the general principles established by U.S. Courts and the European Court of Justice regarding descriptive signs:**

The statutory provisions applicable to descriptive signs are practically identical in the U.S. and the European Community. In both jurisdictions signs which consist exclusively of descriptive indications cannot be registered, unless they have acquired distinctiveness through use and a mark owner cannot prevent others from fairly using a descriptive term.<sup>128</sup>

A comparison of the case law on descriptive signs shows that the general principles established by the European Court of Justice regarding the reasons for not protecting descriptive signs and the characteristics of descriptive marks are very similar to those applied by U.S. Courts.

- *Concerning the reasons for not protecting descriptive marks:*

As to the reasons why descriptive signs are refused trademark protection, the U.S. Supreme Court has stated that descriptive signs do not point distinctively to the origin of the goods or services and that these signs must be left free to be used by competitors.<sup>129</sup>

The ECJ declared that descriptive signs cannot fulfill the basic function of a trademark to identify the origin of the goods and services<sup>130</sup> and that the public interest which underlies the ground for refusal of descriptive character is the need that descriptive indications may be freely used by all<sup>131</sup>.

- *Concerning the characteristics of descriptive signs:*

As to the nature and characteristics of descriptive signs, U.S. case law qualifies as “merely descriptive” only those signs which “define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood” and immediately convey knowledge of a quality or characteristic of the product.<sup>132</sup> If, on the contrary, “a consumer must use imagination or any type of multistage reasoning to understand the mark's significance”,<sup>133</sup> the mark is considered suggestive and not descriptive and is granted trademark protection without proof of secondary meaning.

The European Court of Justice and European General Court have declared that the ground for refusal of descriptive character only operates in cases in which there is a “sufficiently direct and specific relationship between the sign and the goods and services in question to enable the

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<sup>128</sup> See points I.1.a. and 1.2.a.

<sup>129</sup> *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543 (1920)

<sup>130</sup> ECJ, 20.9. 2001, C-383/99 – BABY-DRY

<sup>131</sup> ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 – Chiemsee

<sup>132</sup> See <sup>41</sup> and <sup>42</sup>

<sup>133</sup> See <sup>50</sup>

public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics”.<sup>134</sup>

These principles sound more or less the same. However, the application of the formulas “requires no exercise of the imagination to be understood”, “immediately convey knowledge of the quality or characteristic of the product” and existence of a “sufficiently direct and specific relationship ... to enable the public immediately to perceive, without further thought, a description...” obviously involves a good measure of subjective judgment and the fine line between descriptive and merely suggestive signs is often drawn on an intuitive basis.<sup>135</sup> This subjective judgment can obviously lead to differing results, which will depend on whether the Courts or registration authorities generally tend to grant trademark protection to suggestive signs or not.

## **II.2. Comparison of the results of the application of these principles to specific signs in the U.S. and the European Community:**

A comparison of the above cited decisions of U.S. Courts and the European Court of Justice, the European General Court and the Boards of Appeal of OHIM shows that marks which suggest a characteristic, purpose or function of the goods or services are more likely to receive trademark protection in the U.S. than in the European Community.

In the U.S., the fine line between descriptive and suggestive signs is drawn in favor of the protectability of a mark when the sign does not directly describe the product or its characteristics but only suggests them and there is some imaginativeness involved in the suggestion. In application proceedings, doubts about the “merely descriptive” character of the mark are resolved in favor of applicants.<sup>136</sup>

The European Court of Justice and the European General Court - though they have also declared that descriptive signs are only those which “enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics”<sup>137</sup> – do not apply the approach of distinguishing between “descriptive” and “suggestive” signs but concentrate the analysis on the question whether the sign is descriptive or not and apply the ground for refusal of descriptive character as soon as a sign suggests the nature, a characteristic, function or purpose of a good or service.

- *“Baby-Dry” and the criticism received; “Baby-Dry” compared to “Dri-Foot”*

This strict standard might be the result of the criticism received for the European Court of Justice’s “Baby-Dry” decision.<sup>138</sup>

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<sup>134</sup> See <sup>8</sup>

<sup>135</sup> See *In re Shutts*, 217 USPQ 363 (TTAB 1983); *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985).

<sup>136</sup> *In re Shutts*, 217 USPQ 363, 364-5 (TTAB 1983) citing *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972); *In re J. Ray McDermott and Co., Inc.*, 170 USPQ 524 (TTAB 1971); *In re Dune Medical Devices Ltd.*, 2011 WL 1495445 (TTAB 2011)

<sup>137</sup> See <sup>8</sup>

<sup>138</sup> ECJ, 20.9. 2001, C-383/99 – BABY-DRY

In this decision the ECJ stated that descriptive signs are “only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought” and 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”.

In application of these principles, the Court then asked whether the term “Baby-Dry” may be viewed as a normal way of referring to babies’ nappies or of representing their essential characteristics in common parlance, and concluded that, “whilst each of the words in the combination may form part of expressions used in everyday speech to designate the function of babies’ nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for babies’ nappies or for describing their essential characteristics” and that word combinations like “Baby-Dry” cannot be regarded as exhibiting, as a whole, descriptive character.

This result is comparable to that reached by the TTAB in the above cited “DRI-FOOT” decision<sup>139</sup>, in which the Board declared that “DRI-FOOT” is “obviously not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described” and held the sign highly suggestive, but not merely descriptive of a deodorant for feet.

The Baby-Dry decision was widely criticized as it was feared that the possibility to register signs composed of descriptive elements which are simply juxtaposed in an unusual way and differ “perceptibly” from the words used in the common parlance to describe the goods and services or their characteristics would cause an avalanche of applications for registration of combinations of descriptive words and their registration would lead to a monopolization of descriptive terms and a multitude of infringement claims against competitors who use these terms in a descriptive manner.

It was feared that in the real world a fair use defense against an infringement claim under Article 12(b) of the Regulation on the Community Trademark might be worth rather less than its ostensible value in law.

Trade mark owners with monopolistic ambitions might bring or threaten unmeritorious infringement claims against competitors who merely seek to use descriptive terms descriptively and honestly and the alleged infringer might capitulate rather than incur the costs of litigation as well as risk an adverse outcome.<sup>140</sup>

The Court was also criticized for applying a different test than that applied in the previous “Windsurfing-Chiemsee” decision<sup>141</sup>, in which it had stated that the public interested underlying the ground for refusal of descriptive character is that descriptive signs and indications may be freely used by all and that therefore it has to be asked whether the sign may serve in trade as a descriptive indication (in that case of geographical origin). In the “Baby-Dry” case, the Court did not apply this test but declared that a sign cannot serve as an

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<sup>139</sup> In re *Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972)

<sup>140</sup> See Opinion of Advocate General Jacobs, 10.4.2003, C-191/01 – doublemint

<sup>141</sup> ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 – Chiemsee

indication of origin of the goods or services if it is no different from the usual way of describing these goods or their characteristics.<sup>142</sup>

Also, the formula applied in this decision that “any perceptible difference” between the mark and the usual way of describing the product or its characteristics and that the “unusual juxtaposition” of the two descriptive elements “Baby” and “Dry” suffice to make the combination distinctive was considered to leave the door wide open for registration of combinations of descriptive indications. This caused the Government of the United Kingdom and the Government of Germany to intervene in defense of OHIM’s position in the “Doublemint” case, which was seen as an opportunity for the Court to eliminate the doubts and concerns raised by the “Baby-Dry” decision.

- *Getting stricter: “Doublemint” and “Postkantoor”*:

In its “Doublemint” decision, the ECJ, following the suggestion of the Court’s Advocate General Jacobs and the Government of the United Kingdom, clarified that to exclude descriptiveness it is not enough that the sign differs from the expressions currently used to describe but for the ground for refusal of descriptive character to apply it suffices that it is capable of being used in a descriptive manner.<sup>143</sup>

The meaning of the expression “any perceptible difference between the combination of words .. and the terms used in the common parlance of the relevant class of consumers ...” used in “Baby-Dry” was finally clarified in the ECJ’s “Postkantoor” decision<sup>144</sup>, in which the Court introduced the formula suggested by Advocate General Ruiz-Jarabo Colomer that a combination of descriptive words is not itself descriptive if, because of the unusual nature of the combination, the sign in question creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by its component elements, with the result that the word is more than the sum of its parts.

The above cited later decisions of the Office for Harmonization in the Internal Market, the European Court of Justice and the European General Court show that the “Baby-Dry” decision was followed by numerous decisions which, based on these criteria introduced by the ECJ after the “Baby-Dry” decision, applied a more strict standard and that a sign is now refused registration as a Community Trademark if it has any descriptive connotation

In evaluating the descriptiveness of signs such as “PRANAHAUS”<sup>145</sup>, “TRUEWHITE”<sup>146</sup>, “Golden Toast”<sup>147</sup>, “Highprotect”<sup>148</sup> or „ReValue”<sup>149</sup> the Court analyzed the meaning of the words of which the signs are composed, assessed whether there is a “direct and specific relationship” between the sign and the goods or services and finally, after concluding that the words are descriptive of the goods and services concerned, found that the combination of

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<sup>142</sup> See Opinion of Advocate General Ruiz-Jarabo Colomer, 31.1.2002, C-363/99 – Postkantoor, and 14.5.2002, C-104/00 - Companyline

<sup>143</sup> Opinion of Advocate General Jacobs, 10.4.2003, C-191/01 – doublemint

<sup>144</sup> ECJ, 12.2.2004, C-363/99 – Postkantoor

<sup>145</sup> See <sup>70</sup>

<sup>146</sup> See <sup>61</sup>

<sup>147</sup> See <sup>71</sup>

<sup>148</sup> See <sup>66</sup>

<sup>149</sup> See <sup>63</sup>

these descriptive terms was not unusual and did not create an impression sufficiently far removed from that created by the mere combination of the words.

- *The need of competitors to use the term – A test not applied in the European Community:*

The ECJ, EGC and OHIM do not apply tests which look at the need of others in the marketplace to use the sign to market their goods or services, as do U.S. courts.<sup>150</sup>

In its “Windsurfing Chiemsee” decision the ECJ expressly answered to the question submitted by the German Supreme Court (Bundesgerichtshof) whether for the ground for refusal of descriptive character to apply there needs to be a real, current or serious need to leave a sign or indication free for competitors, that application of the ground for refusal of descriptive character does not depend on the existence of such a need, but rather on whether the sign or indication “may serve in trade to designate geographical origin”.<sup>151</sup>

It is therefore irrelevant whether there is any need for competitors to be able to freely use the term nor whether there are other ways to inform the consumer that for instance lamps produce a white or natural light (mark Truewhite) or that the services offered will lead to an increase of the value of consumers’ property (mark Revalue). Following the ECJ’s instructions in “Doublemint” and “Windsurfing Chiemsee” it is only asked whether the sign is capable of being used by other economic operators to designate a characteristic of their goods and services.

Whilst U.S. Courts look at whether competitors need to be able to freely use the mark or how useful they might find it, for the European General Court it is sufficient that the sign could be used by competitors in a descriptive manner and this seems to be assumed for any sign which is found to be descriptive, irrespective of whether there is (or might be) any actual need for competitors to use the sign to describe their goods or services or their characteristics.<sup>152</sup>

Whereas U.S. Courts have declared competitors to be perfectly capable of getting by without having to rely on terms such as “Snorake”<sup>153</sup>, “Q-Tips”<sup>154</sup>, Tennis in the Round”<sup>155</sup> or “Dri-Foot”<sup>156</sup>, because they can use alternatives which they cannot be prevented from using to market their products or services, the EGC considers that “Golden Toast”<sup>157</sup> or “Pranahaus”<sup>158</sup> are descriptive terms which might be used in trade somewhere in the future, which is sufficient for them to be excluded from trademark protection.

- *A direct comparison: “Golden Toast”, “Pranahaus” and “Definitive Groom” v. “Speedi Bake”, “Pich back” and “Dri-Foot”:*

A lot of the signs which are qualified as merely descriptive by OHIM and the Court of Justice of the European Union would probably be found to be suggestive and therefore eligible for

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<sup>150</sup> See 56-58

<sup>151</sup> ECJ, 4.5.1999, Joined cases C-108/97 and C-109/97 - Chiemsee

<sup>152</sup> See 70, 71

<sup>153</sup> See 99

<sup>154</sup> See 122

<sup>155</sup> See 107

<sup>156</sup> See 103

<sup>157</sup> See 71

<sup>158</sup> See 70

protection without proof of secondary meaning in the U.S., especially in cases in which the sign suggests a desired outcome or purpose of the product.

Signs as “Highprotect”, “Lokthread”, “Tennis Warehouse”, “Truwhite” and “Pipeline”, which are registered as trademarks in the U.S. have been declared descriptive by OHIM and the EGC and refused protection as a Community trademark.

In view of the above cited decisions of the ECJ and EGC, the signs “NOBURST” for liquid antifreeze, “DRI-FOOT” for a anti-perspirant deodorant for feet, or “SPEEDI-BAKE” for frozen dough would probably have little chances of being registered as a Community Trademark.

If the reasoning that led the EGC to confirm the rejection of the mark “**GOLDEN TOAST**” for “electrical household appliances, baking machines” and “flours and cereal preparations, bread, bakery goods, doughs” etc. in class 30 was applied to the mark “**SPEEDI BAKE**” for frozen dough, the latter would most certainly have been denied protection as a Community trademark, whereas it was declared suggestive by the T.T.A.B.<sup>159</sup>

In its “Speedi Bake” decision the T.T.A.B. quoted the rule that “.. if a mark imparts or conveys an immediate idea of the ingredients, qualities or characteristics of the goods, the term is descriptive, while the term would be considered suggestive if, as applied to the goods, it requires imagination, thought and perception to reach a conclusion as to the nature thereof” and then declared the mark to fall within the category of suggestive rather than descriptive marks.

The ECJ, EGC and OHIM would first have analyzed the meaning of the words “speedi” and “bake” and, based on that meaning, would have assessed whether there is a direct and specific relationship between the sign and the goods concerned to enable consumers immediately to perceive a description of those goods or their characteristics. Unlike the T.T.A.B., they would probably have found – as did OHIM and the EGC in the “Golden Toast” decisions - that the combination of the words “speedi” and “bake” tell consumers in a straightforward way and in a laudatory manner that the goods concerned “bake quickly”. They would therefore have held that the sign “Speedi Bake” consists exclusively of elements which are descriptive of the characteristics and the actual or desired purpose of the goods concerned (to bake quickly).

The applicability of the ground for refusal of descriptive character does not require that the sign is actually used in a descriptive manner, being sufficient that it might be used in such a way, nor the existence of a concrete, current and serious need to keep the sign available for competitors.

In the case of the mark “**PITCH BACK**”<sup>160</sup>, the examiner of OHIM would have looked at the meaning of the two elements and then asked whether the overall impression created by the word combination was sufficiently different from that created by the addition of the meanings of the two words. (S)he would most certainly have reached the conclusion that the word combination is not unusual and that the mark merely describes what the exercise equipment does – to throw back a ball which is thrown at it.

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<sup>159</sup> In re *George Weston Ltd.*, 228 USPQ 57 (TTAB 1985)

<sup>160</sup> *Tigrett Industries, Inc. v. Top Value Enterprises, Inc.* 17 F.Supp. 313, 316 (W.D. Tennessee 1963 Quoting *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir. 1940)

The same is valid for signs such as “UNBURN”<sup>161</sup>, “DRI-FOOT”<sup>162</sup> or “BRAKLEEN”<sup>163</sup>. In view of the reasoning followed and the results reached in the “Pranahaus”, “Truewhite”, “Highprotect” or “Definitive Groom” decisions of the European General Court and the Boards of Appeal of OHIM, those signs would probably all be found to describe a characteristic, the purpose or a desired outcome of the goods. They would probably all be considered to be composed of word elements which are descriptive of the goods or their characteristics, and the combination of the words would be held not to be unusual and not to create an impression sufficiently far removed from the sum of the meanings of the words. The marks “Unburn” or “Brakleen” would probably be found to describe a desired result of the product, as the marks “Restore”, “Revalue” or “Definitive Groom” were held descriptive of the purpose or desired result of the products or services. The mark “Better’n butter” would probably be considered descriptive of a characteristic or quality of the product – that it is better than butter. The combination is not unusual and in the E.C. it is irrelevant whether others use or need to use the term or not.

On the other hand, in the U.S. signs as PRANAHAUS<sup>164</sup>, TRUEWHITE<sup>165</sup> or DEFINITIVE GROOM<sup>166</sup> would probably be considered to require a certain amount of imagination or mental leap to be understood. As in the decisions “Brakleen”, “Dri-Foot” or “Clothes Fresh”, the mark “Definitive Groom” would probably have been found not to describe any characteristic of the product, but to only suggest the result of the use of the products. A place where esotericism and yoga goods are sold is not usually called prana or pranahaus and there seems to be no need for competitors to be able to freely use that term, arguments which led the U.S. Courts to hold the marks “Dri-Foot”, “Sno-rake” and “Better’N Butter” not merely descriptive of the goods and services concerned.

These comparisons show that in the European Community a sign is more likely to be considered to immediately tell something about the product and not to require any imagination or further thought on the part of the relevant public to be understood than in the U.S.

As pointed out by the Third Circuit in *Q-Tips, Inc. v. Johnson & Johnson*, “there must be some description in almost any suggestion or the suggesting process will not take place”<sup>167</sup>

Decisions as “Pranahaus”, “Truewhite”, “Atrium”, “Definitive Groom”, “Masterwall” etc. show that for the European Community Courts and OHIM “some description” suffices to reject a sign as descriptive.

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<sup>161</sup> *The Norwich Pharmacal Company v. Chas. Pfizer & Co., Inc.*, 165 USPQ 644, 646 (TTAB 1970)

<sup>162</sup> *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972)

<sup>163</sup> *In re C. J. Webb, Inc.*, 182 USPQ 63 (TTAB 1974)

<sup>164</sup> ECJ, 9.12.2009, C-494/08; EGC, 17.09.2008, T-226/07

<sup>165</sup> EGC, 7..7.2011, T-208/10

<sup>166</sup> 2<sup>nd</sup> Board of Appeal of OHIM, case R-1414/2011-2, 17.9.2012

<sup>167</sup> *Q-TIPS, Inc. v. Johnson & Johnson*, 206 F.2d 144, 146, 147, 98 USPQ 86 (3rd Cir. 1953)