

LETTER FROM EUROPE

Dictionaries and trade marks

The following is a transcript of the 15 April, 2014 podcast

Hello. My name is Paul Harris, and this is my 'Letter from Europe', the first in what will be a fortnightly communicate of my thoughts on the commercial world, and IP in particular. After all, I have been doing this for more than 30 years, so I trust that my views and observations will have some value and resonance for your own business or practice.

I thought I'd begin in the field of trade marks, a topic I know something about, having lectured on the Oxford University IP Diploma course for many years.

In this inaugural letter, I have chosen a topic that is a well-known frustration to brand owners—the use of trade marks in dictionaries, reinforcing the impression that the mark is generic. In part, this is because my good friend, Anna-Lena Wolfe, Head of Trade Marks at AB Tetra Pak, asked me recently about the issue, but also because I'm conscious of the shifting burden being placed on brand owners by the courts in Europe to establish that a mark has not become generic.

Of course, not every brand owner is concerned about their mark becoming generic. Take Dyson for example. In his autobiography, Sir James Dyson paints a scenario in the future of a little boy not being allowed by his mother to go out and play with his friends until he'd finished 'dysoning' his room. It's certainly one way of continuing to be remembered after

death, and Sir James is a very capable marketing man (although his desire for immortality is probably going a bit too far for most people). As yet, 'dyson' hasn't made it into the online version of the Oxford English Dictionary, either as a noun or a verb, so I guess he'll just have to try harder.

It may be tempting to think that this is a problem that really only affects older marks, like Hoover, which in the UK is used as the alternative verb to 'vacuuming', or in the U.S., 'Kleenex' being the noun for tissues. Not so. Both the marks GOOGLE and BOTOX are suffering a similar fate, although Google Inc. has been fighting back by sending out cease-and-desist letters. (In Sweden, the company has prevented the Swedish Language Council from adding a new word meaning 'unGoogleable'.) But in the case of dictionaries like the Oxford English Dictionary, it really isn't as simple as that.

The dictionaries will claim that as publisher of such a scholarly work, they have a duty to describe, and therefore mirror, how language (particularly English, which is ever-changing) is actually used in everyday parlance. They may well acknowledge this cuts across what the trade mark holders want, or indeed, are trying to prevent. But nevertheless, they feel bound by their duties.

Each dictionary no doubt has its own method of assessing what should



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be placed within its pages and the criteria necessary to be fulfilled before that is achieved. In most cases, this is usually based on the extent of use of the relevant word in a number of independent publications or other sources (including online ones).

So does the law help brand owners avoid the creeping genericization of their marks? Not really. It is true that the Community Trade Mark Regulation 207/2009/EC (or 'CTMR' for short) contains Article 10, which enables a brand owner to require a dictionary to change the reference if it gives the impression that the mark is the generic name for goods or services. Ah but, say the dictionaries, we always put the word 'trademark' somewhere on the definition page, so we're not giving that impression. I suppose that depends on the reader, but it is a defence that the dictionaries will no doubt stick to.

The increasing burden I mentioned

at the beginning has been further increased by the European Court of Justice's interpretation of whose views should be taken into consideration in deciding whether a mark has become the common name in the trade (which is EU legal-speak for 'become generic'). The particular case concerned was a referral from a Swedish appeal court relating to Procordia's mark 'BOSTONGURKA', which was sought to be revoked by a rival, Björnekulla, because, so they claimed, this was the common name for chopped pickled gherkins in Sweden. It is hard to imagine that such passion can be aroused over pickled gherkins in Sweden, but there we are!

The relevant provision in the CTMR is Article 51(b), which provides that the rights of the proprietor will be revoked if in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered. Note particularly that the provision uses the phrase 'in the trade'.

In the United Kingdom under our old trade mark law, the test was restricted to what was happening in the trade; the logic being that a trade mark proprietor is able to stop a competitor mis-using his trade mark, whereas prohibiting the public from doing so is an altogether different task.

Unfortunately for brand owners, the ECJ (now renamed the 'Court of Justice of the European Union' and abbreviated to 'CJEU') decided that where goods reached ultimate

consumers, the relevant classes of persons whose views are to be taken into account comprised all consumers as well as those in the trade. That decision has already had an impact in domestic English law. Interestingly, dictionaries were referred to in that case (which was all about the marks SPAM owned by Hormel Foods for tinned luncheon meat, and SPAMBUSTER for computer programming), but the judge noted that the entry for SPAM started with 'n.....(Proprietary name for) a tinned meat product consisting chiefly of ham....'. The judge pointed out that the definition 'expressly acknowledges that "SPAM" is a trade mark'. But note how different the entry is set out back in the dictionaries in the early Noughties, to that faced by brand owners in dictionaries now.

And for those of you curious as to how 'SPAM' is now set out in the online Oxford English Dictionary, the tinned meat definition has been surpassed by that relating to unsolicited email messages. But the entry no longer uses the phrase '(Proprietary name for)' and uses simply the word 'trademark'.

A further problem for brand owners in their fight to prevent descriptive use of their mark from tipping over into becoming completely generic is that EU law presently does not allow them to prevent it. This may come as a surprise to many of you, particularly those in the U.S., but the ECJ in a decision earlier than the 'BOSTONGURKA' case, involving the marks SPIRIT SUN and CONTEXT CUT (registered for 'diamonds for

further processing as jewellery'), concluded that where a trader in commerce uses a sign solely to denote the particular characteristics of his goods, then it is not being used to indicate origin. In other words, it's not being used in a trade mark sense.

Now, if I ruled the World, or at least the trade mark bit, Mr Freiesleben, who created these unique cuts, would not have been allowed to obtain a trade mark registration in the first place, as the primary function of the sign is descriptive. So now we're left with the mess that, in effect, a proprietor cannot prevent descriptive use even amongst competitors. That hardly helps a proprietor in preventing his mark from becoming generic.

Many of you reading this who are not trade mark owners may think this is simply a case of proprietors wringing their hands and crying 'Woe is me', when in fact they do well enough out of trade mark law protection as it is. Possibly that may be true, but nevertheless there is a whiff of injustice hanging in the air about the way that the courts have gone about this that a good stiff breeze of common sense should be able to dispel.

And perhaps after all the controversy over Google's AdWords policy in Europe, it would be fitting for Google to be the one to take on the dictionaries, and earn the respect of brand owners in Europe for (hopefully) easing the burden in the fight against genericism.

Until the next time. Goodbye.