



European Communities Trade Mark Association

## Summary of the Answers to the Questionnaire of subject Project (5)

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The answers for 25 countries [Austria, Benelux (Belgium, Netherlands, Luxembourg), Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Malta, Poland, Portugal, Romania, Slovenia, Spain, Sweden, UK] have been evaluated so far.

### Replies to Question 1:

1. How do trade mark examiners in your country establish the manner of pronunciation of a trade mark (both in absolute and relative grounds matters)? Is reference made to official sources, such as dictionaries? Are surveys (formal or informal) carried out?

Legal provisions dealing with the role of pronunciation for assessment of likelihood of confusion of trademarks do not exist in the Member countries.

In UK the Registry Work Manual for internal examination procedures, which is published, refers in paragraph 26 of its chapter 3 to pronunciation in terms of phonetics and to which extent pronunciation/misspellings could influence the registrability of a mark.

Generally, the average consumer's pronunciation of trademarks is considered which, bottomline, is the pronunciation of the official language of the country or, in the case of Benelux, the official languages of the territories ("multi-lingual approach"). For the assessment of pronunciation, e.g. in Poland, the Examiner may use a computer program connected with the TM database. Such program simultaneously examines the trademark as to the Polish pronunciation and to possible different spellings of such pronunciation.

Exceptions from the national-language-pronunciation-rule are made if the words are clearly identified by the average consumer as words of a foreign language/fanciful words belonging to a foreign language.

In first place, English words appear to be known as foreign words to the average consumer throughout the Community.

For a few countries, other foreign languages are mentioned (French, German, Russian, Latin).

For the assessment of how the average consumer pronounces a word and whether the average consumer recognizes a foreign word, the TM Examiners rely widely on their own knowledge, including knowledge of foreign languages, and own experience but also use dictionaries, encyclopedias, other sources, e.g. the Internet, the result of informal inquiries among their fellow-examiners.



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Surveys, however, are not used apart from Estonia where the TM Examiners have referred to public surveys conducted by market survey companies showing the extent of knowledge of foreign languages (e.g. English) among Estonian consumers for the purpose of finding out how the average Estonian consumer pronounces a foreign word.

The written and other sources of the Examiner's wisdom appear to be mentioned in decisions more often in some countries whereas not so often or hardly ever in other countries.

Generally, interested parties may submit expert opinions including those based on surveys or other evidence of the pronunciation, e.g. presentation in radio/TV advertising (Austria).

### **Replies to Question 2:**

[2. In your country, are regional accents ever considered relevant with respect to pronunciation of a trade mark? How is the information obtained in this case?](#)

The answers to this question are split. 15 countries clearly do not consider regional accents as relevant (Austria, Cyprus, Czech Republic, Denmark, Estonia, France, Greece, Hungary, Italy, Latvia, Poland, Portugal, Romania, Sweden). Various reasons are mentioned, factual ones such as "the question never came up" or "there are no regional accents in our country" or "no officially acknowledged accents in our country (Austria, Cyprus, Czech Republic, Hungary, Italy) or legal reasons such as "our trademark law is national but not regional" (France, Sweden) or "regional accents normally are not a representative characteristic of the average consumer's pronunciation" (Portugal).

In 10 countries, Benelux taken as three countries, regional accents are assessed for the pronunciation of trademarks, though very rarely so going by known cases, or could at least be taken into consideration in appropriate cases (Finland, Germany, Ireland, Spain, UK):

In Benelux and Malta the pronunciation of a mark in various regional accents appear to be a quite important criterion for the assessment of a likelihood of confusion. For Malta, it is pointed out that the criterion how the "common consumer" would pronounce a trademark, is obtained through a knowledge of the regional aspect. In Benelux, the pronunciation of a trademark by even a part of the public is one of the factors for the overall assessment of likelihood of confusion.

For Slovenia, the manner how a word is pronounced, appears to be even more important for the assessment of the likelihood of confusion, as in the Slovenian language many words exist which look absolutely identical. However, the meaning of those depends on the pronunciation of the mark. That is to say, that a different pronunciation conveys a different meaning and, for this reason, pronunciation may be crucial for a likelihood of confusion. Apparently, the pronunciation of a word may differ from region to region.

Information on pronunciation in regional accents is either common knowledge (the Examiner's knowledge) or obtained from similar sources as the information obtained in



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“normal” cases, that is to say dictionaries, also newspaper articles, appropriate academic publications on linguistics or other expert evidence, including survey evidence.

For several countries (Austria, Benelux, Germany, UK) it was pointed out that the meaning of a word pronounced according to a regional accent or belonging to regional language, may weaken the distinctiveness, or as the case may be, may lead to non-registrability (e.g., if by regional pronunciation a word without any meaning becomes an offensive word or if the regional word is descriptive).

Local dialects are disregarded throughout the Community.

### **Replies to Question 3:**

3. How would a trade mark attorney in your country dealing with the comparison of two CTMs go about assessing the manner of pronunciation in the various EU languages?

The question apparently was not clear as it produced three types of answers.

1. CTMs are assessed like national TMs if the relevant public is the national one (e.g., Danish, French, Portuguese). These answers focus on procedures before the national TM Offices.
2. The second group of answers focuses also on procedures before the national TM Offices. The answers of this group explain which languages are examined with regard to pronunciation of a mark in assessing a likelihood of confusion. First, the pronunciation in the national language or national languages (e.g., Benelux: Dutch, French, German) is considered.

If the words belong to a language known to the average customer, the pronunciation in that language is considered, that is, mostly English, in some countries French or German, in Finland also Swedish, in Slovenia Italian. The answer for Greece states that the proper pronunciation in the country of the proprietor's origin is considered. If the mark is not perceived as clearly belonging to a known language, the pronunciation in the national language is considered. Some answers stress the detailed visual phonetic comparison of the marks to be carried out in those cases.

3. The last group of answers refer to procedures before the OHIM and tackles the task of multi-lingual examination of CTMs. Several answers, notably from smaller EU Member Countries emphasize the personal knowledge of the TM Attorneys of at least one or more official EU languages enabling them to make a comparison of trademarks in those languages themselves, notably in the main languages of the Community.

As resources of information in addition are mentioned dictionaries, colleagues or other persons fluent in foreign languages, preferably native speakers, online resources containing audio clips, linguistic reference books, expert evidence of linguists who have experience in those languages. The UK Member, though, realizes that those types of resources are unlikely to help for invented words. In such case, it



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is hoped that specialist linguistic service suppliers may assist in drawing conclusions. Survey evidence is also mentioned as potentially helpful, although in practice surveys do not appear to be used.

1 answer (Austria) reflects the difficulties of convincing the OHIM of a certain factual pronunciation of the word by the average customer which pronunciation apparently was not reflected in dictionaries.

#### **Replies to Question 4:**

#### **4. How would a trade mark attorney in your country dealing with a trade mark in a foreign language go about assessing how the average consumer would pronounce it?**

Almost all answers appear to imply that with regard to trademarks which are words of foreign languages, the pronunciation in the original language is considered if the average consumer is deemed to clearly perceive the word as belonging to a foreign language which is known to him.

Likewise, the answers appear to imply that pronunciation according to the national language or languages is considered if the word is not clearly perceived by and known to the average customer as a word of a foreign language. For Greece, it is stressed that correct pronunciation according to the rules of the foreign language cannot always be expected in case the foreign mark is written in the Latin alphabet.

The assessment as to whether a word is clearly understood as belonging to a foreign language and, thus, is pronounced according to the pronunciation rules of that foreign language, is primarily based on the Practitioner's/Examiner's personal knowledge, expertise and experience regarding how widespread or familiar the language is to the national consumer, supported in some cases by dictionaries reflecting foreign words as adopted by the national languages or by documentation of advertisements in TV/radio broadcasting or the use of the marks in printed media reflecting the pronunciation promoted to the consumer – although the promoted pronunciation is not always fully adopted by the consumers, as, e.g., the answer for Romania vividly emphasizes – or the other "usual" resources, such as interviews amongst colleagues, the internet, linguistic reference books, expert evidence. The answer for Cyprus indicates that it is not unusual to ask consumers from Cyprus. Survey evidence does hardly appear to be used in practice with one exception: Slovenia. The assessment of the pronunciation of foreign or unknown words appears to be in some cases difficult even for the Practitioner so that submittal of survey evidence does not appear unusual in that country.

#### **Final remarks:**

With regard to the general result of this survey, it may be noted that in some countries the relevance of the criterion of pronunciation of a mark for the likelihood of confusion appears to be higher than in other countries. Virtually all answers show that the principal approach to assessment of pronunciation of word marks is common to all national laws why national



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preferences for certain methods of assessment of pronunciation by the average consumer exist.

The numbers of the national EU languages rising, the OHIM's problem of defining the pronunciation of a trademark in a given national language will not become smaller. In some cases, users felt uneasy with the OHIM's findings regarding the pronunciation of marks if the language is not English, French or Spanish. The Committee submits to the OHIM to consider to obtain expert opinions from the respective national TM Offices in appropriate cases.



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## ECTA HARMONIZATION COMMITTEE

### Survey on the assessment of pronunciation of marks in the different member countries

**Compilation of the answers (status: 13.10.2008)**

*1. How do trade mark examiners in your country establish the manner of pronunciation of a trade mark (both in absolute and relative grounds matters)? Is reference made to official sources, such as dictionaries? Are surveys (formal or informal) carried out?*

#### AUSTRIA

There are no rules in the law how an examiner has to establish the manner of pronunciation of a trade mark. It is, however, the general attitude of the examiners that in case a trade mark clearly belongs to a certain language, to also examine this trade mark according to the rules of the language, to which it belongs and not only according to the rules of the German language, i.e. as they will be understood and pronounced by the average consumer, i.e. according to the rules of the English language if applicable.

The examiner is free to have recourse to any official or unofficial sources and he will naturally also consult directories.

As regards relative grounds of refusal, e.g. cancellation as no opposition procedure exists in Austria, it is well possible for a party to submit opinion surveys and expert opinions on how a word will be pronounced: In case a trade mark is advertised on radio or TV, we have in the past submitted tapes to demonstrate how a certain sign is pronounced in advertising and therefore should be used in this form by the consumers.

The issue whether trade marks are similar or not is considered to be a question of law and not a question of fact; therefore, the pronunciation of a sign also has to be decided as a question of law. Nevertheless, evidence of the actual understanding of a sign by the public is generally considered as permissible. In practice this means that the issue of pronunciation and similarity can be decided independently up to the Supreme Court of Austria as a question of law, because otherwise questions of fact cannot be re-examined by the Supreme Court.

#### BENELUX

In the Benelux territory there are several official languages (see ECJ case C-108/05, EUROPOLIS) and the knowledge of foreign languages (especially English) is relatively high. In this respect, the examiners of the Benelux Office for Intellectual Property (BOIP) represent a cross section of the Benelux population. Both in absolute and relative ground matters, cases are dealt with by a multilingual (and multicultural) team. Besides that, the BOIP uses all available sources it finds helpful (dictionaries, encyclopedias and other books, the internet, etc..). In exceptional cases, an (informal) survey is carried out.



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### BULGARIA

The reference is made only to official sources, such as dictionaries.

### CYPRUS

Reference is made to dictionaries. Surveys are not carried out.

### CZECH REPUBLIC

Firstly, Czech pronunciation rules would be applied. If it is an international word it would be analysed in accordance with the pronunciation rules of the relevant language (English, German or Latin if it is a technical or classical expression). It is possible to take into account the pronunciation of a foreign term only in case the word is known by the average consumer of the relevant public.

### DENMARK

At first, the word would be pronounced in Danish. If it is an English word and it is assumed that it would be understood by the Danish public, its translation is taken into account. NEW BALANCE and BALANCE were found to be dissimilar because NEW BALANCE would be pronounced as an English word whereas BALANCE would be pronounced as if it were a Danish word.

In case of doubts, a dictionary would be used, although this usually does not happen. Surveys would not be relevant.

### ESTONIA.

The Estonian language is very exact, i.e. the letters are pronounced in the way as they are written. Despite of that fact the pronunciation issues raise usually if a trademark includes a foreign letter that is not commonly used in Estonia or is not part of the Estonian alphabet, also the pronunciation issues might raise if a trademark is in a foreign language.

While dealing with the pronunciation issues, the examiners usually make references to the dictionaries, also to the papers of the official bodies dealing with the language issues. Depending on the language used (e.g. trademark is in English), the examiners have made also references to the public polling results of the polling companies showing the knowledge of foreign language spoken among the Estonian consumers, based on those results showing how would an average consumer pronounce a trademark.

The examiners have also conducted Internet-based surveys.

### FINLAND

Pronunciation is not really officially examined by the Trademarks Office, and thus examiners will not refer to any official sources or alike. In principle the words are considered to be pronounced as they are written. However, English pronunciation is deemed to be generally known for most commonly used vocabulary. The other language paid really attention to is naturally Swedish, the other official language in Finland. To a certain extent pronunciation of German and French will be taken into consideration, too.



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### FRANCE

The examiners and the judges in France consider that pronunciation of a trade mark would follow the rules of the French language. No reference is made to official sources. However, dictionaries mention the pronunciation of the word and are often provided by the parties in support of their argumentations.

As regards trademarks in foreign languages, the original pronunciation will only be taken into consideration if the foreign word is known and understood by the average French public.

### GERMANY

As far as German words are concerned, the pronunciation of the average consumer is relevant, i.e. the correct pronunciation according to linguistic rules. The pronunciation of imaginary words is often not clear-cut. However, not all abstractly possible pronunciations are taken into consideration, but only the possibilities which are most probable according to general linguistic rules. The trade mark examiners further consider the kind of goods and/or services. It is possible that certain ways of pronunciation (in particular foreign ones) may suggest themselves for such products.

The German Patent and Trademark Office does not have any fixed rules as to how to establish the pronunciation of a trademark. The Internet has become the most important source of information for the examiners (especially Google and specific search facilities). Reference is also made to official sources such as dictionaries, also specialized and technical dictionaries. Official surveys will not be carried out by trade mark examiners, and informal surveys are unusual because the examiners will form their own opinion on the pronunciation of a trademark, especially if they are experienced. However, surveys and opinions conducted by the parties may be considered by the Office in opposition or cancellation proceedings, especially if they originate from renowned institutions such as Duden or linguistic institutes of universities etc.

### GREECE:

Official sources are referred to, such as dictionaries and the phonetics used therein. The Examiner would not undertake the initiative to conduct a survey which is to be presented primarily to the applicant.

### HUNGARY

Trademark examiners establish the manner of pronunciation of a trademark mainly upon their personal knowledge of any foreign languages, since most speak English and/or German or French and eventually some other European languages. No reference is made to official sources such as certain dictionaries. We presume that informal surveys within the Hungarian Patent Office (HPO) are carried out in general, but not reported or referenced in the office's decisions.

### IRELAND

Trademark Examiners generally arrive at a decision regarding the manner of pronunciation of a Trademark in absolute or relative grounds matters from their own experience. While it is possible for Examiners to refer to official sources such as dictionaries, in our experience, it is



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rare for such sources to be cited in decisions. We are not aware of any instances where an Examiner has carried out a formal or informal survey regarding the pronunciation of a Trademark and referred to it in the decision. While there is nothing in principle to prevent such a survey being carried out and relied upon, this will have to be in accordance with the principles of natural justice. For example, the interested party or parties would have to have an opportunity to submit its opinion on relevance and admissibility of the survey.

#### ITALY

The examiner would base the evaluation mainly on his or her personal knowledge. Regarding Italian word, widespread dictionaries may be used in order to verify the accentuation of certain words. This, however, is unusual and would be done in an unofficial way.

With respect to foreign terms, examiners apply their personal knowledge or use dictionaries.

The only form of survey used would be amongst fellow examiners.

#### LATVIA

Basically trademark examiners define the pronunciation of trademarks (phonetic representation of a mark) guided by the place (country) of origin of a mark, what is defined following corresponding language dictionaries or specialized explanatory dictionaries in all fields of activities (generally it refers to the absolute grounds of trademarks). Language identification (knowledge) and degree of usage is taken into consideration from the point of view of an average consumer in the respective field: Latvian, Russian, English, German, French, etc. In problematic cases the trademark examiners can conduct opinion poll among trademark examiners, in specific cases organizing telephone enquiry in the respective field.

#### MALTA

The way in which the ordinary consumer would pronounce the mark is the criterion which in our view is used. Dictionaries and informal surveys are tools which are also probably used at times.

#### POLAND

Basically, trademark examiners establish the manner of pronunciation of a trademark upon their personal knowledge of any foreign languages (most of the examiners do speak English and/or French or German or Russian). First of all, a trademark is examined according to local pronunciation, which is based on spelling of the trademark read according to the Polish rules (words are read as they are written). Besides, a computer program used by the Polish Patent Office connected with the trademark database can simultaneously examine the trademark according to its different types of spelling but the same pronunciation (identical pronunciation in Polish but different spelling).

#### PORTUGAL

Trade mark examiners generally analyse the pronunciation of words according to the Portuguese language. In case of foreign words whose pronunciation is well known to the average consumer, then the foreign language pronunciation will be taken into account.



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### ROMANIA

They generally pronounce it in Romanian or English. Rarely in French. No other pronunciations are used.

### SLOVENIA

Slovenian trademark examiners establish the manner of pronunciation by using the dictionaries, however, also the anticipated pronunciation by an average Slovenian consumer is taken into consideration, particularly if a foreign word is pronounced in a special way by a significant percentage of the public. The latter is not based on an official survey but is accepted as a known fact.

### SPAIN

Examiners usually establish the manner of pronunciation of a trade mark based on the common use of the word as well as on dictionaries, basically the official "Real Academia Española". No surveys are carried out.

### SWEDEN

The examiners in Sweden refer to normal Swedish pronunciation if it is a word in Swedish or a fanciful word, or to English pronunciation rules if it is in English or a typical English fanciful word, such as PINKY (which refers to the word pink). Dictionaries are not used.

### UK

The NPTO publishes its internal examination procedures and these contain reference to pronunciation in terms of phonetics and paragraph 26 of chapter 3 of the Registry Work Manual addresses this and we set this out at the end of the questionnaire.

In the context of oppositions, a consideration of a number of cases where pronunciation has been considered tends to show that hearing officers of the NPTO tend to adopt a practical and common-sense approach to considering pronunciation. In addition, in the context of a contested hearing, each party may seek to adduce its own evidence on pronunciation.

In the context of Court cases, a search for trade mark cases containing reference to "pronunciation" or "pronounce" reveals only handful of UK cases. For example in the appeal from an opposition decision in the INADINE Trade Mark ([1992] RPC 421) case, where the mark upon which the opposition was based was ANADINE. However, the case was not really about pronunciation in the context of this questionnaire.

Perhaps one of the best known cases was that of *Aristoc Ltd v Rysta Ltd and Another* ([1945] 1 All ER 34), where the Court said:

*"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938 must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance therefore is to be obtained from meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court*



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*must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants"*

*2. In your country, are regional accents ever considered relevant with respect to pronunciation of a trade mark? How is the information obtained in this case?*

#### AUSTRIA

The problem of regional accents has never come up as far as we could ascertain. Although Germany and Austria have the same language, it is usual in Germany to pronounce trade marks pertaining to the English language as for instance COLGATE or TUPPERWARE pursuant to the rules of the German language, while in Austria anybody will pronounce these two and many other trade marks of similar nature in their English form. As the view of the average consumer is paramount, this circumstance must be considered by the Austrian Patent Office and by the courts.

Words in a local dialect may be considered as less distinctive because of their meaning in the local dialect.

#### BENELUX

Yes. Phonetic aspects are relevant both in absolute and relative ground cases. So the pronunciation of a trade mark by the public or a part of the public is one of the factors that is taken into account. The information is obtained in the same way as described in the reply to question 1.

#### BULGARIA

No.

#### CYPRUS

As a general rule, regional accents are not taken into consideration.

#### CZECH REPUBLIC

There are no regional accents. Special dialects would not be relevant because they might not be known by the rest of Czech citizens.

#### DENMARK

Regional accents are not taken into account, only the Queen's Danish.

#### ESTONIA

The one and only Estonian language is spoken in every part of Estonia. Some archaic regional accents exist, which nowadays do not play a significant role, therefore, the regional accents are not relevant at all.



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### FINLAND

Examiners will consider regional accents only exceptionally, e.g. if an examiner happens to know about one, or if the argument is brought up by an opponent. Rare local pronunciation would not be paid attention to.

### FRANCE

Regional accents would not be considered as relevant because trade mark rights extend their effects throughout the whole of the French territory and not only regionally.

### GERMANY

Regional accents are only considered in exceptional circumstances, namely if the trade circles concerned are particularly important, if there is a concrete relationship between the accent and the product or trade mark or if the general use of language is characterized by the accent.

The information in this case is obtained by all available means such as dictionaries, dialect dictionaries, Internet sources or the own knowledge of the examiners. In the case of regional accents, the examiners try to trace the word back to the official German language in order to decide on the registrability.

### GREECE

In Greece regional accents are not considered relevant with respect to pronunciation of a trade mark.

### HUNGARY

Since there are no officially acknowledged regional dialects in Hungary, they would not be considered as relevant with respect to the pronunciation of trademarks. Accents of foreign languages would also not be taken into account.

### IRELAND

Regional accents have not been considered in any written decisions on Trade Mark cases to date in Ireland. In any event, differences in regional accents in Ireland are relatively minor but it is possible that they might be considered in an appropriate case. While this issue has not to our knowledge been considered to date, we would foresee that appropriate means of proof might include reference to appropriate academic publications on linguistics or expert evidence. It is also possible that survey evidence might be of assistance.

### ITALY

Regional accents are not taken into account because there are no acknowledged regional dialects. Moreover, dialects would not influence pronunciation but would radically affect spelling.

### LATVIA

Local regional provisions stipulating pronunciation of a trademark do not exist in our country; hence, the pronunciation is based on pronunciation peculiarities of the languages given in the item 1.



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#### MALTA

Yes. The manner in which the "common consumer" would pronounce a candidate mark, is probably the criterion used – this information is obtained through a knowledge of the regional aspect.

#### POLAND

The regional accents are not considered as relevant with respect to the pronunciation of trademarks. The pronunciation is based like it is in item 1.

#### PORTUGAL

Regional accents may be considered but normally not as a representative characteristic of the average consumer.

#### ROMANIA

No. Even the general Romanian diacritics are eliminated.

#### SLOVENIA

The answer to this question depends on the circumstances of the case and it is considered case by case; namely, in Slovenian the way a word is stressed sometimes determines the meaning of the word, so the accent may play a crucial role as to the meaning conveyed. Namely, in the Slovenian language there are lots of words which are totally identical to look at but have a totally different meaning when pronounced with different accents. However, the pronunciation characteristic for a certain region of Slovenia usually has no essential importance with respect to the rest of the country.

No official survey has been carried out by the Office concerning this issue.

#### SPAIN

Regional accents could be considered relevant whether the interested party justifies it with newspaper articles, reference to common use, dictionaries, although the level of general knowledge would definitely determine the relevance of such arguments.

#### SWEDEN

Regional accents are not taken into account because Swedish law is national and not regional.

#### UK

We are aware of only one UK trade mark opposition case that directly refers to regional accents, that being O-389-031 relating to the UK application 2220509 for the mark PHILOS and an opposition by Philips, the decision being of 13 December 2003. In that case there was some argument by the parties as to pronunciation of PHILOS and a mention of regional accents. However, the hearing officer found little similarity between the marks and the opposition failed.

In the case of UK trade mark application number 2309350 for the mark FOOK, this was refused on appeal on the grounds that in certain regional dialects it would be phonetically identical to the word FUCK and was, therefore, offensive and registration not allowed. In that



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case, there appears to have been a common knowledge and understanding of this type of pronunciation without any specific evidence being adduced. The NPTO raised this in its objections and the application accepted these and argued, unsuccessfully, on other grounds

*3. How would a trade mark attorney in your country dealing with the comparison of two CTMs go about assessing the manner of pronunciation in the various EU languages?*

#### AUSTRIA

The issue of different pronunciations in different EU countries has rarely come up. In a case which we handled before the OHIM and which involved the trade marks KOTÁNYI and CATTANI, it was claimed by the applicant for the trademark CATTANI that the trade mark KOTÁNYI would be pronounced on the second syllable because of the accent on the vowel A. We submitted tapes with advertising demonstrating that the emphasis in Austria is always on the first syllable, but here again we were not successful. However, this kind of evidence was accepted, although we believe it was not properly taken into consideration by OHIM.

#### BENELUX

Dutch, French and German are official and/or regional languages in the Benelux so the pronunciation in all these languages is potentially relevant. As mentioned under 1 the knowledge of foreign languages, especially English is relatively widely known and should be taken into account.

#### BULGARIA

On the basis of dictionaries.

#### CYPRUS

Official sources, such as dictionaries, would be used.

#### CZECH REPUBLIC

The comparison must be comprehensible to Czech consumers. Firstly it would be done in the Czech language and then in other languages, provided they are known to the average consumer.

#### DENMARK

If the relevant public is the Danish public, it would be assessed just like a national mark.

#### ESTONIA

Not having a need to compare yet the two CTMs for a case, presuming that the matter depends on a trademark and on the fact which part of the parties to represent in a case, i.e., is it relevant to show the phonetic similarity between the marks or rather to disregard it.

As a first step, would use the main EU languages.

#### FINLAND

Swedish, English and French may be taken into consideration but other languages would only be referred to if a word is well-known in Finland or a word designates a common noun that refers particularly to a certain country being renowned for the relevant products.



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#### FRANCE

The CTMs would be assessed as if they were national marks.

#### GERMANY

The assessment of the manner of pronunciation in the various EU languages would be mainly by reference to dictionaries which reflect the way of pronunciation or the Internet. As surveys are very expensive, they will seldom be carried out.

#### GREECE

A trade mark attorney in Greece would, among others, consult the proper pronunciation of the CTM in the language and in the country of the proprietor's origin.

#### HUNGARY

The trademark attorney would base its decision on the personal knowledge of its native language and of any other European languages known to him/her. However, a detailed comparison cannot be required/expected since supposedly he/she cannot speak all official languages of the EU. In case of trademarks in the five official languages of the OHIM the comparison could be made without any difficulties since these languages and their main pronunciation rules could be considered as part of the public general knowledge.

#### IRELAND

An Irish Trade Mark attorney would deal with a comparison of two Community Trade Marks in terms of pronunciation in the various EU languages in the same manner as any other Trade Mark attorney: he or she would have to consider how the respective Marks might be pronounced by native speakers of those languages. Reference sources which might assist would include dictionaries in those languages, linguistic reference books, or expert evidence of linguists who have experience in those languages. Equally, survey evidence might assist

#### ITALY

It is hard to infer a common procedure as it would depend on the attorney. See answer to No. 4.

#### LATVIA

Comparing two CTMs, a trademark Attorney will primarily be guided by a trademark pronunciation perception in the country of origin, irrespective of a certain European Union member state language, and only afterwards the Attorney will conduct a detailed visual-phonetic comparison of these trademarks.

#### MALTA

this is probably a very rare task for a local trademark attorney. If we were entrusted with one such manner, we would probably be in a position to use our knowledge of English, French and Spanish to cover various jurisdictions, and we would compliment this with our basic knowledge of the other official languages obtaining where necessary, tips from nationals of the countries in question residing in Malta.



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### POLAND

Comparing two CTMs, a trademark attorney will primarily be guided by a trademark pronunciation perception in the country of origin if the trademark contains the letters in English, French or German. If the trademark is in another language, the examiner will conduct a detailed visual-phonetic comparison of these trademarks.

### PORTUGAL

The same criteria of national marks would be applied.

### ROMANIA

First we try to find out which language was used. Then we try to imagine how an average consumer might pronounce it.

### SLOVENIA

Taking into consideration the fact that an average Slovenian citizen speaks at least one world language, mostly English or Italian and German (less French and Spanish), the Slovenian trademark attorneys are usually fluent in more foreign languages. Thus, in such case there is no problem with the comparison of the words in different languages and with the manner of their pronunciation.

### SPAIN

The pronunciation would be determined on the basis of the misspellings to be found in dictionaries.

### SWEDEN

The attorney would take into account how the sign is pronounced in the relevant language.

### UK

An attorney may seek the views of colleagues who speaks the languages in question and may be likely to speak to colleagues from the countries in question. Consulting a dictionary may help, as can some on-line resources that contain audio clips of spoken words – although these types of resources are less likely to be of help for invented words.

The use of specialist linguistic service suppliers may assist in drawing conclusions.

*4. How would a trade mark attorney in your country dealing with a trade mark in a foreign language go about assessing how the average consumer would pronounce it?*

### AUSTRIA

Whether a trade mark will be pronounced according to the rules of the foreign language, to which it pertains or according to the rules of the German language, will depend whether this language is well known in Austria or not. As stated above, trade marks pertaining to the English language will in most cases be pronounced correctly, but almost nobody will be aware of the correct pronunciation of a trade mark in for instance Mandarin Chinese. The best way to demonstrate the correct pronunciation will be advertising on radio or TV. An opinion survey on the actual pronunciation by the public could be made but would be unusual. An expert opinion by a linguistic institute may not be very helpful, because it is not



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how a word should be pronounced, but how it is actually pronounced by the average consumer in order to assess the pronunciation to be considered.

#### BENELUX

In view of the situation mentioned under 3 the trade mark, if clearly in a specific language will be considered as pronounced in its own language. In other cases both Dutch and French are in principle equally important.

#### BULGARIA

On the basis of dictionaries

#### CYPRUS

Consumers from that country would be consulted on how they understand it and/or how they consider it.

#### CZECH REPUBLIC

Dictionaries of foreign words adopted into the Czech language would be used. It would be presumed that the pronunciation in the original language would be known. The knowledge of consumers differs. The young generation tends to know English. The older generation knows German, while French or Latin are not known by the masses anymore.

#### DENMARK

If the relevant public is the Danish public, it would be assessed just like a national mark.

#### ESTONIA

The matter depends also in which foreign language a trademark is, whether a foreign word / expression represented by a mark is generally understood by an average consumer or not. It is still a common practice to analyse and assess how an average consumer would pronounce a mark (especially regarding the medicines), the relevant references to the dictionaries are usually made.

#### FINLAND

Examiners try to assess the pronunciation from the point of view of a consumer. Examiners may gather together to deal with more difficult cases.

#### FRANCE

The trademark attorney would assess whether or not the average consumer knows the foreign word, also based on the fact that it can be found in a French dictionary as a foreign word.

#### GERMANY

The assessment would be done through dictionaries or the Internet.

#### GREECE

A trade mark attorney in Greece would, among others, determine whether the foreign word mark is understandable to the average Greek consumer according to his/her linguistic sense and experiences. In case the foreign mark is written in the latin alphabet, correct pronunciation according to the rules of the foreign language is not always guaranteed



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### HUNGARY

The manner of pronunciation of the average consumers would be assessed, depending on the nature of the foreign language concerned and how its words are usually pronounced in Hungarian. German used to be the most taught language in Hungary, while nowadays English is the one commonly used. These two languages therefore require different and more thorough handling than for example Swedish.

### IRELAND

An Irish Trade Mark Attorney dealing with a Trade Mark in a foreign language would have to consider how the average Irish consumer would pronounce the Mark. We would suspect that the following matters might be considered:

- What is the level of knowledge of the language in question amongst Irish consumers? If the level of knowledge is high, the Irish consumer might pronounce it in the same manner as a native speaker of that language. However, the knowledge of foreign languages amongst Irish people is relatively low.
- Does the Mark bear any resemblance to a word or words in English? If so, the consumer might pronounce the foreign word in a similar manner.
- Linguistic reference books or expert evidence might assist.
- Survey evidence might assist.

### ITALY

If the word is common and originating from a European language, the assumption is that its pronunciation by Italian consumers would be correct. If it comes from a less common language, Italian-like pronunciation would be applied, with the aid of Internet and dictionaries.

### LATVIA

The majority of Trademark Attorneys know several languages and they also know well the majority of goods and services in various fields; so, it is possible to define methodologically a trademark pronunciation by the average consumer in the specific field.

### MALTA

Same as answer to point 3.

### POLAND

The consumer will pronounce a trademark as it is written, unless the pronunciation of the trademark is well known.

### PORTUGAL

If the average consumer is able to pronounce the foreign word correctly this pronunciation will be relevant. If not, then the Portuguese pronunciation would be more relevant.



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### ROMANIA

There are 2 major ways to determine how the average consumer would pronounce the word: how the verbal advertising introduces the word to the general public or how this trademark may be pronounced by a Romanian.

Even in these cases we may be wrong: VICEROY and MORE are spelled in Romanian, I-POD, I-MODE, AVON and COLGATE are spelled in English, CARREFOUR is spelled by the media in French and by the average consumer in English, QUELLE is spelled in French and the best example: AUCHAN – since the word is impossible to be pronounced in Romanian, I heard instead the English version (pronounced as OCEAN), the French version (the correct one) and the German version!

### SLOVENIA

Sometimes it is generally known how the words are pronounced by the Slovenian consumers, sometimes a survey has to be carried out, which then also serves as evidence in the official proceedings before the SIPO or the Court.

### SPAIN

The attorney would try to find documents, such as daily newspaper, radio or tv references detailing how the average consumer would pronounce the mark.

### SWEDEN

The attorney would take into account how the sign is pronounced in the relevant language.

### UK

This would probably be firstly a matter of common-sense and considering how someone in the UK pronounces a word from one's own knowledge. This may be affected by how wide spread or familiar the language is within the UK. Informal discussions with colleagues may assist.

## **25 Representations of well known fictional characters**

Similar considerations apply to representations of well known fictional characters. However, it should be borne in mind that (unlike with a name) there are many ways of depicting the same character and a representation of even a widely used fictional character may be acceptable if it has distinctive stylisation.

## **26 Phonetic equivalents of objectionable words (misspellings)**

When considering applications which are in respect of words which are the phonetic equivalent of a descriptive or non-distinctive word(s), the appearance of the mark should be given weight. If the mark applied for is distinctive to the eye **as a matter of first impression**, then it cannot be said to be devoid of any distinctive character, at least where the goods or services are customarily selected by eye.

The Registrar is aware that in case *C-363/99 Postkantoor*, the ECJ stated at paragraph 99 of its decision that word only marks should be distinctive to the ear as well as the eye.

However, the Court was not asked to rule on this point and this observation is therefore not binding upon us. Until the matter has been properly argued before the ECJ, the Registrar does not propose to change his practice in order to conform with this observation, remaining consistent with the judgment delivered by the English Court of Appeal in the *Reed v. Reed*



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case [2004] EWCA (Civ) 159. The Court said that distinctive character must be assessed by reference to the visual and aural impact of the mark, basing its judgment upon the ECJ judgment in the *LTJ Diffusion SA v.*

*Sadas Vertbaudet SA* case, C-291/00. So, a mark which is a gross mis-spelling of a descriptive mark, and therefore has visual distinctiveness, should not necessarily be denied the benefit of trade mark protection, even though, aurally, it may appear to be identical to the descriptive word.

### **26.1 Common misspellings**

Whilst obvious misspellings of words may be acceptable because the average consumer would perceive the difference between the trade mark and the descriptive word, this may not be true when considering applications to register words which are commonly misspelt, or where the public are not used to seeing the word written down.

For example,

KOMMUNIKATION is clearly misspelt and the average consumer would immediately recognise the difference between this mark and the descriptive word COMMUNICATION.

When confronted with words which are often misspelt, the difference may not be perceptible as a matter of first impression. For example,

MILLENNIUM is often misspelt with either one "l" or one "n". The average consumer is therefore less likely to see any perceptible difference between the word and the mark MILENNIUM.

This may often be true where "double" letters appear in the middle of the word.

Informal words may be more often heard than written down, eg, CUPPA for tea. The average consumer may therefore be unsure of the correct spelling of the word because they will be unused to seeing it written down. Arguments that the word is misspelt will not assist in these circumstances.

Similarly, use of the "American" spelling of a word is less likely to be perceived as different to a normal presentation of the word. Even if the difference is noticeable, the average consumer is unlikely to suppose that the difference is on account of the fact that the American spelt version of the word is a trade mark. The average consumer is more likely to assume that the goods are originally from America or the person marketing them has used the American spelling of a description.

For example,

COLOR

Where there is a perceptible difference between the trade mark and those descriptive or non-distinctive terms, the trade mark will be generally acceptable.

For example, the following examples of obviously misspelt or unusually presented descriptions are all acceptable:

DIETETIX for dietician services

NOWAX for ear drops (In this rather unusual case the conjoining of the two words NO and WAX, the individual words are submerged within the apparent invented word NOWAX

KA for cars

SERIAL for breakfast cereals

### **26.2 Misspellings used in trade**

Care should be taken however where misspellings are commonly used, for example "XTRA" instead of EXTRA and 'N' instead of AND. Such variations will not confer distinctiveness.

Where mis-spellings or abbreviations are commonly used in the trade, the marks would still be open to objection.

For example :



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CUT 'N BLOW DRY for hairdressing.  
 DRIVE THRU for restaurant services.  
 STARTER PAK for beginner packages.  
 FRESHLY PREPARED 2 GO for takeaway pizzas.  
 BEST 4 YOU

### **26.3 Text messaging abbreviations**

With the advent of sending text messages via mobile phones, a virtually completely new language has evolved, centred around using abbreviations rather than the full word. Indeed there are dictionaries available which detail the meanings of such abbreviations. Further, goods and services are now commonly promoted through advertisements in the form of text messages delivered to mobile phones.

The average consumer will, or it is reasonably foreseeable that they will in the future, see direct descriptions in the form of text messages as being a usual way of designating goods or services provided to the general public. Consequently

applications consisting of this abbreviated language are open to objection where the equivalent full word(s) would be objectionable. For example:

LRN 2 TXT for telecommunications or education services would be objectionable as it directs the consumer to the subject matter, namely, Learn to Text.

### **26.4 Goods and Services customarily ordered by word of mouth**

Most goods and services are these days usually selected by eye. However, in some cases goods and services are still ordered by word of mouth eg food and drink, takeaway services, and taxi services. Misspelt descriptions may not work as trade marks for goods and services of this type. Consequently, applications to register trade marks consisting of misspelt words for these types of goods/services will be examined critically if there is no perceptible difference to the ear between a description and the mark.