



**THE  
DISTINGUISHING  
CAPACITY  
OF WORD MARKS**

**CASE LETTER 5**  
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## THE DISTINGUISHING CAPACITY OF WORD MARKS

In many of the word marks rejected in the Benelux, the (lack of) distinguishing capacity plays a role. By 'distinguishing capacity' we mean: *"Is the brand suitable for distinguishing goods/services of one company from those of another company?"*

The issue is whether the public is able to recognise the products or services of a certain company. In other words: does the public recognise it as a trademark. Trademarks that lack any distinguishing capacity, or that consist only of marks or indicators of type, quality, quantity, destination, value, place of origin, time of manufacture of the goods or performance of the service or other qualities of goods or services, are not eligible for protection.

In the past year, the Court of Appeal in The Hague passed a large number of judgments on decisions that the Benelux Merkenbureau (*Trade Marks Office*) made to refuse to register certain trademarks, against which the applicants of the trademarks in question appealed. This Novagraaf Case Letter pays particular attention to the distinguishing capacity of word marks.

Is the mark suitable for distinguishing the products or services of a company?



## FITLINE

The *FitLine* mark was filed for food supplements, food additives and clothing. The trademark registration was refused because the mark consists of two elements: FIT (as in: fresh, healthy) and LINE (as in: product line/product range), and can be used to indicate type, nature etc. It was therefore lacking any distinguishing capacity.

The *FitLine* mark is compiled from the words 'fit' and 'line'. The noun 'fit' has the following meaning(s): fresh, powerful and healthy (2002 Van Dale Hedendaags Nederlands dictionary). In the Benelux, the English word 'line' is interpreted to mean, among other things: product line/product range.

The applicant argued that 'fit' and 'line' cannot be indications of (qualities of) the registered goods and that the mark as a whole has 'something extra'. The applicant also pointed out that the name is registered in a number of European countries, including the United Kingdom and Denmark and has – partially – been accepted as a European trademark.

However, the Court of Appeal concluded as follows: *The mark as a whole is not notably different from the sum of its parts. The word combination does not have 'something extra' that gives it a distinguishing capacity. The words 'fit' and 'line' are combined in line with normal grammatical rules and do not constitute a combination that is unusual for the goods and makes an impression that is based on the simple combination of the parts.*

The reference to acceptance of the trademark in other EU countries was not accepted either. The Court of Appeal decided: *The distinguishing capacity of the mark must, after all, be assessed on its own merits and in relation to – among other things – the relevant public in the Benelux countries.*

## SUPER CHAMPION

The Court of Appeal passed a comparable judgement with regard to the filing of the *Super Champion* mark as a trademark for computer games. The trademark application was refused because the mark consists exclusively of the quality SUPER and the appellative CHAMPION, and can be used to indicate type, quality etc. and has no distinguishing capacity.

The applicant was of the opinion that the trademark has a 'double meaning' (something extra). The Court of Appeal disagreed and stated: *Super means over, above, very (Van Dale woordenboek der Nederlandse taal, 13th edition). This is a frequently used qualification, comparable to fantastic, top, first-class etc. The mark was compiled in line with normal grammatical rules. 'Champion' is the English and French word for the Dutch word 'kampioen'. This gives the mark the literal meaning of first-class Champion and gives the impression of an accumulation of superlatives.*



The mark as a whole is not notably different from the sum of its parts. The word combination does not have 'something extra' that gives it a distinguishing capacity.



Words that are combined in line with normal grammatical rules lack distinguishing capacity.

The 'something extra' in a word brand must be really special if it is to counterbalance the lack of distinguishing capacity.

The fact that other trademarks using the word Champion have been registered did not make any difference. The distinguishing capacity of the mark must be assessed on its own merits. Other registrations do not add to or take away from that distinguishing capacity. In other words, every case is evaluated individually and referring to previous registrations does not make any difference.

### **RapidCHIP and Happy Vakanties**

In the cases of *RapidCHIP*, (RAPID as in: 'fast', CHIP is an appellative) and *Happy Vakanties* (HAPPY as in: joyous/glad, VAKANTIES is the Dutch word for holidays) it's the same story. With reasoning similar to the SUPER CHAMPION case, the Court of Appeal in The Hague ruled that the Benelux Merkenbureau was right in its assertion that the trademarks in question were not distinguishing and that the rejection was justified.

## **CONCLUSION**

A trademark consisting of a combination of two descriptive words that does not constitute more than the sum of its parts and does not contain anything 'extra' to distinguish the trademark will almost certainly be rejected for the lack of this distinguishing capacity. The 'something extra' must be really special if it is to counterbalance the lack of distinguishing capacity. These judgements support and reinforce the policy of the Benelux Merkenbureau and the chances of successfully winning the procedure against the Benelux Merkenbureau are small.

The European Trade Mark Office (B.H.I.M.) also rejects trademarks based on the principle that the consumer must be able to distinguish the trademark from the trademarks of others. The descriptive character is assessed with regard to the goods or services for which registration is requested, and is based on the perception of the relevant public that makes up the consumers of these goods or services. In the assessment, the objective of general interest is adhered to, namely knowing that it must be possible for anyone to freely use such marks or indications.

If a trademark consists of a combination of several words, the possible descriptive character must not only be determined in respect of each of the individual words, but also in respect of the entity they make ('having something extra'). In the Community trademark system the various languages of the European Union must also be taken into account. A purely descriptive character of the trademark in one of the languages of the EU makes it unsuitable for registration as a Community trademark.

Parties can appeal against a rejection by the B.H.I.M. to the Board of Appeal. After this the Court of First Instance can, if desired, look at the matter in the capacity of an independent professional authority.

## JUDGEMENTS BY THE COURT OF FIRST INSTANCE

In the past year the Court of First Instance passed the following judgements:

### **Bioknowledge**

The trademark was filed for a number of goods and services, including databases and directories, but also for the provision of information with regard to living organisms. The B.H.I.M. classed this brand as a composite brand (BIO as the usual abbreviation combined with KNOWLEDGE) without 'something extra'. Among other arguments the applicant asserted that 'knowledge' has various meanings, for instance knowledge gained by experience, the scope of the information possessed by a person and the theoretical and practical understanding of a subject or language. This would, therefore, have a different meaning from the provision of information in the service description.

However, the Court concluded: *Bioknowledge has at least one meaning in which a quality of the goods in question is indicated, namely specific information about living organisms*, which means the rejection is justified.

### **TOP**

The TOP mark was requested as a trademark for herbal nutritional capsules, powders and supplements.

The Court agreed with the B.H.I.M. that the term TOP is a commonly used superlative in the European Union. Unlike 'Ultraplus', a brand that was previously accepted, 'top' is used in its common grammatical structure and, as such, does not deviate from the correct grammatical construction.

### **LIVE RICHLY**

In this case the Court concluded that the relevant public would not consider the mark LIVE RICHLY, which was requested for – mostly – financial services, as an indication of origin, but will regard the mark in a purely promotional context only. This is not sufficient.



The word is used in its common grammatical structure and, as such, does not deviate from the correct grammatical construction.

## EURO PREMIUM

The examples in the previous pages lead us to suspect that all brand applications that have a descriptive character or that must be considered pure promotion will be rejected. The fact that it is difficult to draw a line as to what will be and what will not be accepted is seen in the following examples of judgements by the Court of First Instance.

### **Europremium**

The trademark was requested for, among other things, packaging, transport and storage services.

The B.H.I.M. rejected the trademark for the following reason: *The trademark is descriptive for goods and services of excellent quality and of European origin.*

However, the Court of First Instance felt that the word Europremium is not made up of components that describe the goods or services *in question*. For these goods and services it can therefore act as a trademark.

### **Cloppenburg**

The trademark, filed by Peek & Cloppenburg, was requested for retail services. The B.H.I.M. rejected the trademark based on the fact that Cloppenburg is a geographical indication, namely a town in Germany. A refusal on these grounds is not uncommon; after all, consumers could think that the goods in question originated from this town and could even draw wrong conclusions regarding the quality or authenticity (consider Delft blue pottery).

However, the Court of First Instance felt that: *even if the relevant public has heard of the town of Cloppenburg (150,000 inhabitants), this does not automatically mean that this is a name that is commonly used in commerce to indicate the place of origin of retail services.* Cloppenburg can therefore be a trademark for these services.



**Peek&Cloppenburg**

The Benelux  
Merkenbureau uses  
a more careful and  
reticent rejection  
policy than the  
B.H.I.M.





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