Kluwer Trademark Blog

A distinction without a difference: what about non-EU languages? In particular: Chinese and Russian

Sara Parrello, Fabio Angelini (Bugnion S.p.A) · Friday, July 10th, 2020

In our previous post, we discussed the issue of terms that are descriptive in English but still lead to likelihood of confusion on an EU level, given the General Court's belief that " *...if the word is not part of the mother tongue of a territory such understanding cannot be presumed unless a sufficient knowledge by the public in that territory is a well-known fact*". Do the same principle apply also to other languages which are spoken in the EU, without being an "official" language of any Member State?

The answer to this question is not always consistent, as two recent decisions show, one EUIPO Board of Appeal (BOA) decision regarding Chinese, the other a Court of Justice (CJEU) judgment concerning a Russian expression.

VS

Let's start with the BOA. The owner of the EU trademark n. 12214871 (shown above

on the left) filed an invalidity action against the EU trademark n. 12220513 (shown above on the right). Both trademarks designated alcoholic beverages in class 33. In the first instance, the EUIPO cancellation division rejected the opposition, finding the two marks dissimilar in the view of the average EU consumer, who does not read or understand Chinese and finding thus that the Latin character sign XI FENG would be sufficient to allow EU consumers to distinguish the two marks.

On appeal, the BOA reversed (decision R 2210/2019-5 of May 12, 2020), finding that the identical circular element in both marks would trigger a likelihood of confusion. However, the BOA confirmed that the Chinese script as a whole was illegible for EU consumers whowould not and could not pronounce it or link it to a definite meaning but would rather see Chinese as abstract signs.

Now to the CJEU judgment of June 18, 2020 (C-142/19). This concerns the transliteration in Latin characters of a term that, in Russian language, would be descriptive. To advance the outcome, likelihood of confusion was found in the end, although the Fourth Board of Appeal saw this differently:

Back in 2011, the EUIPO granted the EUTM n. 9171695 PLOMBIR for 'Compotes, eggs, milk, and milk products' in class 29 and 'Ices, coffee, cocoa' in class 30. PLOMBIR is the transliteration of "Пломбир", apparently a Russian word for "ice cream". In 2014, an invalidity action was brought, based on consumers in Germany and in other EU countries, such as the Baltic States, would understanding Russian and being able to perceive the descriptive character of PLOMBIR.

The invalidity action was accepted by the EUIPO Cancellation Division, but the Fourth BOA reversed considering that it had not been proven that German consumers – or a sufficiently significant part thereof – understood Russian. Nothing was said about the Baltic States.

The General Court reversed again. It held that the BOA should have taken into account the Baltic States given that a large part of the population living there speaks or understands Russian. Moreover, Art. 7(2) could not be understood as necessarily referring only to official languages of the EU Member State. Thus "Plombir", the faithful transliteration of "Пломбир", would be immediately and directly grasped by EU consumers who speak Russian (especially in the Baltic States and in Germany) – as "ice cream", and was thus descriptive.

This judgment has now been upheld by the CJEU. The CJEU said that it was "common knowledge" that a significant proportion of the inhabitants of the Baltic States speak Russian or have Russian as their mother tongue. In addition, according to a German judgment that had been submitted during the course of the proceedings before the EUIPO, about three million people in Germany speak Russian. Therefore, the GC was fully entitled to find that the BOA had committed an error of assessment in determining the relevant public.

Looking at both decisions one may wonder whether they make a distinction without a difference.

While the CJEU held that Russian was understood in the EU so that a transliteration of

a Russian generic word would likely not be considered distinctive enough, when it comes to Chinese characters trademarks, the assumption by the BOA is that EU consumers would not "understand" it, and thus confusion cold only be justified from a visual, not aural/conceptual similarity.

However, although the average EU consumer may not understand Chinese, it must not be forgotten that there is a significant Chinese community living in the EU. In the appeal filed with the BOA it was stated that according to a report of the Council of Europe, back in 2013 "*an estimated 2.8 million Chinese citizens currently reside legally in Council of Europe member States, with the largest populations in Russia, France, the United Kingdom, and Italy*". That was back in 2013, and the number was already higher than the population of several European countries, such as Cyprus (875 898), Luxembourg (613 894), Malta (493 559), Slovenia (2 080 908). Seven years later, the numbers may be much higher.

Thus, the suspicion of a distinction without a difference, resulting from insufficient or obsolete data, seems not unfounded. While we may not know exactly how many Chinese nationals reside in the EU (so updated data would be necessary), we know that an increasing number of young people study Chinese, and many more EU professionals have acquired at least rudimentary knowledge of Chinese. Possibly with adequate "homework" and sufficient data to back it up, very soon we could have a case where either the EUIPO or the CJEU will acknowledge that even Chinese characters marks are sufficiently understood in the EU so as to allow for a full aural and conceptual analysis.

We'll just have to wait for it.

To make sure you do not miss out on regular updates from the Kluwer Trademark Blog, please subscribe here.

This entry was posted on Friday, July 10th, 2020 at 4:36 pm and is filed under descriptive elements, The EU is an economic and political association of certain European countries as a unit with internal free trade and common external tariffs.“>European Union
You can follow any responses to this entry through the Comments (RSS) feed. You can leave a response, or trackback from your own site.