



## DESCRIPTIVE TRADEMARKS AND LIKELIHOOD OF CONFUSION

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### Summary

The article is devoted to the problem of examination of descriptive trademarks, specifically concerning the principles of expertise, features taken into account, acquisition of secondary meaning and the role of public opinion concerning the distinctiveness of the sign. On the basis of the Judgment given by the Court of European Union illustrated in the article, we revealed the way to examine and compare intrinsic features of the product and the sign, obtained for it.

**Key words:** trademark, likelihood of confusion, descriptive mark, distinctiveness, secondary meaning.

### Аннотация

Статья посвящена проблеме экспертного исследования изобразительных торговых знаков, а именно что касается руководствующих принципов осуществления экспертизы, характерных качеств знака, приобретения второстепенного значения, а также роли общественного мнения о наличии отличительных черт торгового знака. На основании решения Суда Европейского Союза мы раскрыли способ исследования и сравнения свойственных товару характеристик и знака, который применяется для обозначения данного товара.

**Ключевые слова:** товарный знак, введение потребителя в заблуждение, отличительное качество, изобразительный знак, второстепенное значение знака.

**Problem statement.** The issue of intellectual property protection sets huge debates between scientist and practices, especially when it comes to the determination of a trademark name/indication, its lawfulness and existence of all grounds for granting legal protection. However, we often collide with unfair and indecent traders/suppliers who use the reputation of the competitors for their own benefit. It is the key problem which gives a rise to the discovery of a distinctiveness of trademarks, in this rate – descriptive trademarks and likelihood of confusion among the consumers.

**Relevance.** Nowadays trade market can be characterised as an overflow of goods/services of various types, classes, satisfying all basic and fastidious needs of consumers. When the trademark appears on the horizon of the commerce, it should be granted a legal protection from unauthorised access, meaning the trademark name must be the sole indication on the market of the respective goods/services applied for.

**Motivation.** The prior aim of the article is to reveal the main principles of the trademark examination as to the fact of descriptiveness, distinctive character and its ability to provoke a likelihood of confusion. In what way the

examination must be carried out, what principles should be followed and finally what characteristics must be taken into account while discovering the level of distinctiveness of the trademark.

In the century when commercial relations dominate and trade goes far beyond national borders, merchandise market offers a huge variety of opportunities for consumers. Goods and services being introduced on the market encourage business extension, develop competition between sellers of goods/suppliers of services and provides for a diversity of presented goods and services. The main principle on the market is considered to satisfy public needs in offered goods/services. For that particular reason owners build their work with the aim to maintain positive reputation on the market and to promote own trademark, taking into consideration requirements and standards for the protection of goods and services under certain trademark name.

Goods and services are represented on the market under respective indications, chosen by its owner. A «trade mark» means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other

и комплекс предложений по снижению уровня коррумпированности в административных судах. Приведенные в данной научной работе направления совершенствования деятельности административного судопроизводства, и конкретные предложения на этот счет хотя и являются содержательными и обоснованными, однако они далеко не исчерпывающие. Поставленная в статье проблема раскрывается достаточно глубоко и по сути, вместе с тем вопросы данной научной работы являются очень объемными и требуют более широкого диссертационного исследования.

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undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging [1].

Trademark name serves as a mean of individualization of products, which involves reference to the origin of goods/services in the title or label of product, distinguishes product among similar ones, is used in advertising and protects against unauthorised use of third parties. Stated briefly, it is designed to avoid consumer confusion over the trademarks of the owner and other commercial names used in connection with goods and services of the same class.

In this context occur problems concerning the name of the trademark and cause of likelihood of confusion among consumers as to the source of production of goods/services and their owner. One of the conditions for acquiring distinctiveness is consumers' imagination concerning the place of the trademark on the market. It leads to the visualization of the trademark name being embodied in certain word or phrase.

In this context we can talk about the scale of force of the trademark. Names that comprise unusual combination of words and/or signs, fonts and figures, colors and space order are perceived to have strong distinctive character. To compare signs which consist of single words of common generic use possess weak distinctive character. It can be demonstrated on the example of the trademark 'Apple' for computers and other technical devices. 'Apple' is accompanied by the drawing of its implementation – an apple. Consequently, we can state that the foregoing trademark name possesses strong distinctive character because the sign and the meaning of the word, used as a trademark logo, do not tie on the type of goods it represents. So, the consumers will be able to identify the source of goods immediately, not applying any sensors, such as imagination and thinking, consequently – no likelihood of confusion as to the producer of devices.

It is a common practice in litigations to refer to expertise in intellectual property, particularly with a question of descriptiveness of a trademark and as an outcome, likelihood of confusion among consumers as to the fact of origin of goods/services.

If the business has chosen the mark because of its ability to emphasize a key characteristic of the product or service that the business offers, it may be in for even more bad news-the mark may be a «descriptive» one and therefore not sufficiently distinctive to warrant legal protection. [2, p. 1].

Ukrainian legislation outlines that 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services' shall not be granted legal protection [3, p. 4]. It is sufficient if one of the meanings of the mark designates a characteristic of the goods/services. This must be taken as applying only where there is a reasonable likelihood that the sign in question will serve a descriptive purpose in the ordinary course of trade. What must be considered is whether third parties are likely to use signs corresponding to the trade mark applied for in order to describe characteristics of the goods/services covered by the application [4, p. 10-11].

Descriptive marks do not identify the source of a product as well as a mark that is fanciful, arbitrary, or suggestive because descriptive marks retain their original descriptive meaning. As descriptive marks quickly and cheaply provide consumers with information regarding the attributes of a product, protecting exclusive rights in such marks does not directly and materially further trademark law's goal of helping consumers identify and distinguish among the products of competing manufacturers [5, p. 1095, 271].

Furthermore, the main aim for not registering descriptive signs or indications is that such signs should be free for use by all and should not be monopolised by any single trader.

Principles of assessing a descriptiveness of a mark. Trademark should be examined as a whole. This is because of the principles laid down by the ECJ in the case of Procter & Gamble Company v OHIM (Case C-383/99P) in relation to BABY-DRY for babies' nappies: descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the

combination of words submitted for registration and the terms used in the common practice 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.

A mark consisting of a word or neologism composed of elements, each of which is descriptive of the characteristics of the products or services in respect of which registration is sought, is itself descriptive and non-registrable, unless there is a perceptible difference between the word or neologism and the mere sum of its parts.

In order for a mark to be capable of registration, it must produce an impression that is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed. In that case, the ECJ was guided by public interest grounds that descriptive trade marks should be kept free for all to use. [6, p. 6-7]

Descriptive trademark should not necessarily be embodied exclusively in characteristics of goods/services, in most cases they design merely the most prominent and remarkable features of this certain type of product. For instance, LIGHTS for cigarettes means from the view of a consumer an amount of nicotine, namely 'light cigarettes', or for example SLIM FIT for sportswear symbolizes 'sportive shapeliness'.

Besides, a trademark can be admitted to be descriptive if the vocabulary meaning of the word (trademark name) corresponds to the notion and purpose of the mark. As a sample, can serve a trademark «Auction Web» for online auctions. 'Auction' has a definition of 'bidding, tenders' and transmits the general meaning and assignment of the word [7, p. 18]. 'Web' – is a widely spread name of an Internet. In conclusion, with the combination of these two words we receive a descriptive name of auction in Internet that except of activity description and venue, does not carry any other meaning. Moreover, it does not associate with the founder, or any organization/legal entity in charge of it. All this makes the choice of trademark name inappropriate and unpractical.

Under such circumstances competitors could also use the aforementioned wording for characteristic of their own



goods/services or it is already used in the ad. In this rate we come across the issue of the likelihood of confusion as the trademarks of this type of services are not distinguishable.

When a descriptive term has been converted into a trademark for certain goods, a party other than the trademark owner may not use the descriptive term as a trademark under circumstances that are likely to cause confusion. However, a party other than the trademark owner may use the descriptive term «otherwise than as a mark . . . fairly and in good faith . . . to describe the goods . . . of such party». For example, even if one party establishes trademark rights in CLEAR for bottled water, another party may describe its brand of bottled water as appearing «clear as a lake on a bright summer day» [8, p. 859-869].

Another side of descriptive trademarks examination is acquisition of secondary meaning. Secondary meaning possesses a sign which copies a description of features of a certain type of goods/services, however consumers could unmistakably identify at once a source of origin of goods/services, at the same time it points on the functional characteristics of product. Meaning, for the first sight the trademark name is a common sense, generic term, however it gains secondary meaning while long-term usage for a certain class of goods/services. As already stated, secondary meaning may be acquired by long-term use in commerce or in a promotion of a trademark by means of advertising.

It is evident for the trademark to obtain secondary meaning apart from descriptive the perception of it by consumers as a brand name, well known with doubtless denomination of origin of goods/services. In this way a secondary meaning is acquired when a meaning of a trademark indication sounds for a consumer as a source of origin rather than as a product itself.

For instance, we can show the trademark names with acquired secondary meaning: 'SHARP' for TV; 'DIGITAL' for Computers; 'WORLD BOOK' for Encyclopedia; 'AMERICA'S BEST POPCORN!' for Popcorn; 'FORUM' for business seminars and workshops; 'PIZZAZZ' for pizza

There exists a number of facts that should be taken into account while

designation of a secondary meaning of a trademark: (1) the extent of sales and advertising leading to buyer association; (2) length of use; (3) exclusivity of use; (4) the fact of copying; (5) customer surveys; (6) customer testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and, (11) actual confusion [9]. Accordingly, we may observe a chain of continuous and interwoven actions and facts that constitutes a dynamics of trademark functioning.

A trademark will be recognised to meet all the conditions for registration and become protected by the law if its visibility and popularity, with a extensive clients' database will be proved. For instance, a trademark XEROX for copying machines, being well known and established its place on the market offering office equipment, will have lawful grounds for registration without any doubts concerning origin of its products.

To make it more understandable in practice, we will illustrate descriptiveness of a trademark stated in the Judgement of The European Court of Justice in case T-512/10 Nike International Ltd v. OHIM (Office for harmonization in the internal market) [10].

The core provisions of the judgment are the following:

- 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;

- signs or indications relating to the characteristics of goods or services are those which may serve in normal usage from the point of view of relevant public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought;

- sign's descriptiveness can therefore be assessed only by reference to the goods or services concerned and to the way it is understood by the relevant public;

- as regards signs consisting of neologism or of a word composed of elements each of which is descriptive, it should be borne in mind that the combination of descriptive terms is itself descriptive, unless because of the unusual nature of the combination of meanings of its component elements, with the result that the word is more than the sum of its parts;

- as regards to the relevant public, it should be taken into account the public who are able to understand the meaning of the sign composed of English words, being native speakers, or those who has sufficient knowledge in English.

**Conclusions.** Trademarks are used in conjunction with goods/services which are offered on the market. Preliminary to receiving trademark protection, the owner must establish likelihood of confusion and that his mark has acquired «secondary meaning» or is «inherently distinctive». Secondary meaning is a term used in order to describe the mark's source identifying characteristics. An indication or a sign can not serve as a trademark unless it identifies the source of the goods/services that it is applied to.

Some marks are stronger in their distinctiveness than others. A distinctive mark does not possess a secondary meaning for protection. A mark is inherently distinctive for the existence of inconspicuous connection between the mark's attributes and the product or service.

Legal framework of intellectual property rights are not aimed to provide for exclusive usage of certain words or phrases, descriptive by their nature for respective goods/services, to a single trader. In order to restrain from putting limitations on legal rights of the owners to apply those words or phrases in advertisements of their own goods/services, descriptive trademarks are recognized to cause a likelihood of confusion, possess weak distinctive character and cannot be granted a registration.

In order to designate the distinctiveness of a trademark, it should be borne in mind the meaning of the words as a whole, public opinion concerning the fact whether they associate a name of a trademark with a product or with a source of origin.

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## СУЩНОСТЬ, ПРЕДМЕТ И СПЕЦИФИКА НАУКИ ИНФОРМАЦИОННОГО ПРАВА

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### Summary

The article investigates the phenomenon of science information law in Ukraine. Based on the ontological characteristics of science information law, its mission, offers a definition of the latter, is considered its subject and is determined that it is wider than the subject of information law as a branch of law. The author characterizes especially science information law, its positive and negative aspects, analyzes the organizational and legal forms of information science of law in Ukraine. Investigated the directions of science information law. Served an expanded list of the forms that are used by scientists for fixation their scientific results.

**Key words:** science information law, the subject of science information law, features science information law, organizational and legal forms of science information law, the directions of science information law.

### Аннотация

Статья посвящена исследованию явления науки информационного права в Украине. Основываясь на онтологических характеристиках науки информационного права, ее предназначении, предлагается определение последней, рассматривается ее предмет и обуславливается, что он шире, чем предмет информационного права как отрасли права. Автором подаются особенности науки информационного права, ее позитивные сдвиги и негативные стороны, анализируются организационно-правовые формы науки информационного права Украины. Выясняются направления науки информационного права, а также дается расширенный перечень тех форм, которые используются учеными для закрепления своих научных результатов.

**Ключевые слова:** наука информационного права, предмет науки информационного права, особенности науки информационного права, организационно-правовые формы науки информационного права, направления науки информационного права.

**Постановка проблемы.** Наука Информационного права находится в начале своего пути. Исследования информационно-правовой тематики, особенно теоретико-методологического содержания, проводились не часто, но стоит отметить тенденцию постепенного увеличения таких работ. Вместе с тем остается открытым вопрос онтологии информационного права как науки, ее общая характеристика.

**Актуальность темы.** Изучение основных принципов любой отрасли науки позволяет глубже понять значение тех постулатов, которые ею рассматриваются, обеспечивает возможность лучшего познания определенных общественных явлений, обогащает теоретический фундамент этой науки. Информационное право как одна из наук юридического цикла достаточно «молодая», что актуализирует вопросы исследования ее сущности и первичных начал.

**Степень исследования темы.** При исследовании информационного права как науки следует принять во внимание

труды ученых, изучавших юридическую науку в целом. Среди таких ученых – С. Д. Гусарев, Е. П. Евграфова, Т. А. Коломеец, А. Д. Тихомиров и другие. Кроме того, некоторые вопросы науки информационного права рассматривали И. В. Аристова, В. М. Брыжко, А. И. Марущак, В. С. Цымбалюк, В. К. Шкарупа и другие. Но онтологические аспекты информационного права как науки требуют своего дальнейшего выяснения.

**Целью статьи** является раскрытие сущности и предмета информационного права как науки, а также характеристика ее специфических особенностей.

**Изложение основного материала.** Наука информационного права является частью юридической науки, которая, в свою очередь, является частью науки в целом. Как отмечает М. С. Кельман, «наиболее распространенным и разработанным есть понимание науки как вида познавательной деятельности, процесса выработки нового знания» [1, с. 5]. «Внешне наука представляет собой