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THE SUITABILITY OF ACRONYMS AS TRADEMARKS

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I hereby declare that I have compiled the paper independently and all works, important stand-points and data by other authors has been properly referenced and the same paper has not been previously presented for grading.

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ABSTRACT

This thesis is set out to study the laws governing intellectual property. More specifically, laws around trademarks. The thesis is focused on working respectively with European law, Trade Marks act, and Trade Marks Directive.

More in-depth, it will explain the different trademarks that are used today and what can be trademarked. The focal point of the study is to find out what challenges can arise from applying for the registration of an abbreviation/acronym/word mark as a trademark and the relevant case laws that define the law today. In this thesis the word abbreviation will be used respectively.

List of acronyms

CJEU - Court of Justice of European Union

ECJ - European Court of Justice

EU - European Union

IP - Intellectual Property

MS - Member States

TM - Trademark

TMA - Trade Marks Act

TMD - Trade Mark Directive

UK - United Kingdom

USA/US - United States of America

USPTO - United States Patent and Trademark Office

WIPO - World Intellectual Property Organization

INTRODUCTION

As a brand in the international market, it is essential to protect your image. It would not be nice to wake up one morning and realise a brand with twice as many investors is selling a similar product with the same logo and name as yours. How can they do that? With a registered trademark, they have every right to do so. Intellectual property rights are made for all businesses and people who want to protect their creation against copying, stealing, or anything that would negatively affect their image.

This thesis is set out to help me as a brand owner to discover my opportunities when it comes to registering my trademark in USA and the most efficient way to do that. As I plan to register my trademark in USA, it helps to go in-depth, research relevant case laws and understand whether I can do that with my brand. In addition, this thesis helps me find out reasons as to why people have been denied from registration.

With the help of working with various trademark laws, this thesis explains the procedures and conditions that must be met to register an acronym as a trademark in the EU and US. It studies the differences under both legal systems by using case laws where registering acronyms has been successful or unsuccessful. Following is the research question. How well do acronyms suit as trademarks, and what conditions must be met to have a successful registration of a trademark as an acronym?

In all the chapters, I have used law books, law journals, case laws, and trademark laws to structure a thesis that is easy to follow and answers all questions regarding abbreviations/ acronyms and trademarks.

The thesis is structured as follows:

Chapter one focuses on the exploration of intellectual property and trademarks. It acquaints the reader with the development of IP Law as a whole. The chapter explains what separates different intellectual properties from one another and why trademarks are a vital topic for anyone who

owns a brand or wants to distinguish one in their local or international market. Next, the chapter introduces us to the history of trademarks and relevant legal acts that we get more familiarised in the following chapters. The thesis uses references from the United Kingdom (UK) laws and cases, since till 2020 UK was considered a part of the European Union (EU). Since BREXIT the laws will likely be changing, but this will be a long process.

After the more fundamental knowledge of trademarks, the thesis gives examples of the most known trademarks of distinct shapes. I will be presenting my own trademark and brand called JIV.

Chapter two focuses strictly on the development of trademark law into what it is today. It explains the mandatory parts of a trademark to be acceptable and the different types of trademarks, furthermore finding out the challenges that may arise when trying to trademark an acronym. Furthermore, this chapter will be introducing all the governing laws with a detailed description, which makes it easier to follow relevant case laws in a later chapter. Lastly, this chapter has various examples of acronyms that are trademarks.

In this thesis, an example of my own brand will be used, and this thesis will find applicable laws that support my case. In chapter two, we look closely at what an acronym is and why an acronym can be registered as a trademark and why one would want to do so.

Chapter three is fully focused on case laws. After being acquainted with the world of trademarks, we have six different cases with different issues that all revolve around the same laws. The chapter then concludes all the cases.

Chapter four puts the emphasis on my own brands' case study. Throughout this thesis, I will learn and find out if my trademark will be accepted in USA as a trademark. The result was surprising, and therefore this chapter is also my favourite chapter as I am comparing my trademark with another one and come up with solid conclusions.

Chapter five is a conclusive chapter to gather all the chapters together. I will be adjoining all the chapters into the last final chapter. This chapter gives an overview of everything that had been explored during the writing of this thesis.

As a result of this thesis, I will have studied everything there is to know in regards to acronyms as trademarks. I will have answers to questions on what conditions must be met, when I plan to register my acronym.

I would like to thank my supervisor, Pawan K. Dutt for his help and attentiveness.

1. EXPLORING INTELLECTUAL PROPERTY AND TRADE-MARKS

1.1 Getting to know the world of Trademarks

Whenever we think of a famous brand, whether it is BMW or Nike, it does not take long to see their logo in our head. A brand is not complete without a logo that is personalised to its brand image. A logo is a type of trademark. But what about the word BMW or VW? Besides the logo, big companies have also registered their word marks. Word marks are in other words known as acronyms. Neither of these word marks mean anything, but in the case of BMW, it is an acronym, everyone is familiar with. Another good example would be VW (Volkswagen). Besides the logo, they have registered the two letters that are distinctive to their brand.

A trademark is one form of intellectual property (IP) and therefore falls under the scope of IP Law, more specifically trademark law. Trademark as a property right. Most important law governing trademark is the Trade Marks Act 1994. Which stipulates trademark as any sign which helps distinguish goods or services.

As already mentioned, a trademark could be many things. It can be composed of words, letters, a logo, colour, numerals, the shape or packaging of goods. There are examples of even sounds or smells that can be represented graphically. More interestingly, even musical notes or chemical formulas can become trademarks. As Tarawneh helped explain, a trademark gives a reference point for the consumer to acquire information about the goods or services offered by the company behind the trademark.¹

A well-known trademark of a sound is the sound of MGM Lion. We have all seen a movie with the lion roaring in the beginning. That sound is trademarked. Also Tarzans yell from Tarzan movie is a trademark sound. In this thesis we will find out that one of the most important parts of a trademark is its distinctiveness, and it should also not be ambiguous.² If all companies produc-

¹ Tarawneh J. (2014). Nature of trade marks.

² Woodley M. (2013). *Osborn's Concise Law Dictionary*. (12th Ed.) UK: Sweet&Maxwell.

ing balls had the name Ball and a logo indicating a ball, it would create a situation where no company could have an advantage if they would work harder. It would be merely futile to distinguish separate companies, and this would create chaos and does not give the consumer the chance to choose whom they want to do business with. Over the years, trademarks have gained much more importance due to their use as tools in business.

This chapter looks more into the history of intellectual property and the creation process of trademark law. For successful navigation within IPs, it is essential to know the background, in order to understand the importance of the legal systems built around it.

1.2 The history of Trademarks

When we think about archeological findings, we can think of different drawings on cave walls. It is known now that each drawing had a meaning, and in this way, different communities were able to correspond to each other.

Some of the oldest discoveries include symbols that were used on clay pots. These symbols indicated the origin of a pot. Symbols of cultures were means of communicating for people who did not speak the same language. In today's modern society, we use Google Translate to communicate with foreign people.

A more familiar example of trademarks is known from pre-literate societies. Trademarks were used as commercial communication methods due to a large number of different languages.³ Doing so assured a practical way of exchanging information about the goods that were being marketed.⁴

The First signs of legislation to protect the rights of marketers and their products date back to 19th century Europe. However, till 1850 the laws regulating the use of names and marks were inconsistent. The first act to protect traders was the Merchandise Marks Act, which administered

³ Tarawneh J. (2014). History of trade marks.

⁴ Diamond S.A. (1975). The Historical Developments of Trademarks. *Trademark Reporter*; 64, 265.

protection for trademarks and it was very well received. The Act was introduced in 1862 in UK. Even though the Act offered wide protection, it was not enforceable if one could not prove intent of defrauding. Secondly the description of a trademark did not specify the characteristics or functions of a trademark.⁵

1.3 Relevant legal acts

Intellectual property law was being updated by extra protection in Europe in the 1800s.

- In 1883, the Paris Convention gave inventors the right to protect their inventions.
- In 1886, writers were given protection on an international scale for all forms of written content, which included musical compositions, drawings, artwork. This was the result of the Berne Convention.
- The Madrid Agreement was established in 1891. It provided a wider protection for trademarks.
- In 1893, the Paris and Berne Conventions were combined together and that formed the United International Bureaux for the Protection of Intellectual Property
- In 1963 WIPO Convention established the governing agency for intellectual property law. It is an agency of the United Nations.⁶

Trade Marks Directive EU 2015/2436

This directive has added amendments to the former directive 2008/95/EC. It governs the laws between EU Member States relating with trademarks. The amended directive entered into force in 2016.

The new directive introduced several changes to the previous directive. Some of those changes include the use of the acronym EU in all terminology. The changes also made it easier to register

⁵ Azmi I.M., et al. (1997). Distinctive Signs and Early Markets: Europe, Africa and Islam. *The Prehistory and Development of Intellectual Property Systems: Perspective on Intellectual Property*. (Vol.I) London, UK: Sweet & Maxwell, 128-129.

⁶ Upcounsel. *Intellectual Property Rights History: Everything to Know*. Retrieved from <https://www.upcounsel.com/intellectual-property-rights-history>, 15 March 2021.

non-graphical trademarks like sounds and smells when conditions are met. It also changed some of the fees for trademark registration⁷

The foundation of trademarks and the indicator to anything related to trademarks is World Intellectual Property Organization (WIPO). WIPO has members from 193 states. Their procedures and governing bodies are set out in the WIPO Convention. The treaties WIPO conducts, combining national and local laws, compose the international legal framework for trademarks. All trademark treaties are administered by WIPO, and that are also used in this thesis are the Paris Convention, Madrid Agreement, Madrid Protocol, Nice, Agreement, Vienna agreement, Trademark Law Treaty.

The Trade Marks Act (TMA) 1994 consisted of updates to the existing UK trademark law. The most significant update was the possibility to extend registrability to almost all types of marks, including three-dimensional marks, sounds, and smells. While in the meantime securing the owner of a distinguished trademark against others use in trade. In addition, the TMA 1994 enabled the UK to sign the Madrid Protocol, which gave local businesses the freedom to obtain international registration for their trademarks.⁸

1.4 Use of Trademarks

What separates trademark from other forms of intellectual properties is the matter of use. A trademark can be extended for decades as long as the owner can prove use of a trademark. The owner is obligated to show that the trademark is in use in daily business. Otherwise, it would not make sense to own the trademark. "There is no significant aspect of trade mark law that does not require the concept of use. There is however no single cogent and authoritative definition of use".⁹

⁷ Marschollek D. (2016). *EU trade mark law reforms*. 10 things to know. Norton Rose Fulbright. Retrieved from <https://www.nortonrosefulbright.com/en/knowledge/publications/1ee50866/eu-trade-mark-law-reforms>. 14. February 2021.

⁸ Tarawneh J. (2014). History of trade marks

⁹ Blythe A. (2016). A useful test for trade mark use: an analysis of current CJEU guidance and the difference between defining use online and offline. *European Intellectual Property Review*, 38(9), 563-569.

A clear legal definition of what is trademark use is not precisely written in law books, but there are ways to describe and test it. Trademark use is a crucial condition for the extension of trademark registration. Differently from other categories of IP, trademarks must not have a function. For example, if you patent an invention, the invention must have a use, because a patent protects the technical details of an invention and it is to describe the use of invention. Whereas in trademark, the mark is only there for identification and distinction of the brand not the product itself for that matter. (Gilbert 2004, 28)¹⁰ The use of trademark is decided by reference to the Court of Justice of the European Union (CJEU) case laws and for this reasons it has remained undefined in the Trade Marks Directive (TMD).¹¹

A useful case to look into about trademark (TM) use is Arsenal Football Club Plc v Reed (C-206/01), where a stallholder was operating outside Arsenal FC's ground. The stallholder was selling goods off the record, that had fan signs referring to Arsenal football club. This was an infringement of the clubs' trademarks. It is important to note that he did have a sign, which said that these were not in fact official goods. In the ruling given, Reed was in infringement of the use of Arsenal Football club trademark and the club has the right to prohibit him from using their logo according to art.5(1) of the 1989 Directive.¹² This ruling came on the basis of protection of trademark. The trademark owner of Arsenal football club has the exclusive rights to their trademark and therefore someone else should not be allowed to profit from its trademark.¹³

The importance of registering your trademark is simply protection. If you register your trademark in the classification most relatable to your brand, you ensure that another person or company cannot enter the same market with an identical or even similar trademark. Classifications of trademark law help identify which service or product is under your trademark.

¹⁰ Guide G. (2004). *Entrepreneur's Guide To Patents, Copyrights, Trademarks, Trade Secrets*. New York, USA: Berkley Publishing Group.

¹¹ Blythe A. (2016). A useful test for trade mark use: an analysis of current CJEU guidance and the difference between defining use online and offline. *European Intellectual Property Review*, 38(9), 563-569.

¹² Court decision, 12 November 2002, Chancery UK, Arsenal Football Club Plc v Reed no. C-206/01.

¹³ Fhima I. (2017). The public interest in European trade mark law. *Intellectual Property Quarterly*, 4, 311-329.

Conditions to meet for registering your trademark are the following: relatable to your product. Having a frog picture as your trademark when in reality you sell dog collars, just does not make sense. Secondly it cannot be the same or similar to any previous trademark on the same market. Although it is important to mention, two identical marks/symbols can be registered if there are sufficient differences between the goods or services. This will likely be decided by the board.

1.5 My Trademark

As mentioned above, every trademark creates a marketing tool for a brand. My brand is called JIV. Legally JIV Sport and the registered trademark is JIV. JIV was registered in 2017 under class 25 - clothing, footwear, headgear. Our brand produces clothing for figure skaters and all our operations are based in Estonia. Our production is sold by resellers and an online store worldwide, but the main markets as of today are the EU, Switzerland, South Korea, Japan. Our trademark is used on all social media platforms and marketing. It is interesting to note that what is registered is the acronym JIV, but not our logo as it has since changed. Basically, this means that someone can enter the market with a logo and the same brand name as us, as long as it is not identical and not in the same class. Articles 4; 5 in the DIRECTIVE (EU) 2015/2436 cover the grounds of refusal for a trademark.

In the WIPO trademark database and in the US Patent and Trademark database, I see an active trademark in USA. A company has registered the name JIV Athletics and its logo. Their operating area is sports underwear. Their underwear also has a patent pending on the design. The trademark is registered in class 25. Unfortunately for us, this is not a good start if we want to have our trademark registered in USA.

Our trademark is registered in the following locations: China, Germany, European Union, Finland, Japan, Latvia, Lithuania, Russia, Sweden. As these are big markets for us it was important for us to be established in these locations. Despite not being established in China yet, we wanted to protect our trademark before we got more prominent in China. There are many cases of Chinese companies copying foreign companies work. We will probably be copied anyway, but at

least we have protection over JIV, so it is likely that we will see brands like JIVE or JIVS doing similar items in the future.

JIV is an acronym of three different words: Johanna Iluuisu Varustus - *Johannas figure skating wear*, which basically speaks for itself. We do not market the meaning of the acronym, and this is purely because our clients are better acquainted with the word JIV. We have established ourselves in various markets with the word mark JIV and the meaning behind it is not known to the general public. That is something we can use purely for marketing purposes and content if we wanted to.

JIV is 18 years old and the brand has had good success entering new markets. As the pandemic has changed our course in various ways, we have put our plans to enter the US market on hold temporarily. This is because many potential resellers have either gone bankrupt or are not taking in new clients at this moment. We are still aiming to enter the US market as we see great potential in our brand over there, but likely in further future. For us to be able to successfully sell our brand in US, we must register our trademark as an acronym or a logo in US, and this thesis will help me along the way doing so. I will be looking closely at the US and EU trademark laws to find the best solution to register my trademark.

2. DETAILED DESCRIPTION ABOUT ACRONYMS USED AS TRADEMARKS

2.1 Role of Trademarks

The first knowledge of trademarks goes back to the early stages of civilisation. Even so-called tribe symbols could be seen as trademarks since each tribe had their own symbol. A trademark was something that did not need a translation. It was used to communicate with others in an understandable way at a marketplace. Having a trademark provided an image.

The primary role of trademarks is very straightforward: they are designed to lead consumers in a marketplace and promote fair competition among businesses.¹⁴ As mentioned above, trademarks are in all Member States governed by national legislation. In Estonia Kaubamärgiseadus (Trade Marks Act, KaMS) regulates the processes involving trademarks. The Trade Marks Act c.26 provides the protection of trademarks through a registration system. The Act deals within the UK as well as in between EU MS.¹⁵

2.2 What type of Trademarks are there?

The legal definition of a trademark according to the Trade Marks Act 1994 describes trademark as: “(1) In the Act "trade mark" means any sign which is capable -

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.”

Under the law, trademark may consist of words, designs, letters, numerals or the shape of goods or their packaging. Some of the famous well-known trademarks are, for example monograms of

¹⁴ Calboli, I. (2015) Trademark Protection and Territoriality Challenges in a Global Economy. *European Intellectual Property Review*, 37 (2), Lee, E.(ed). UK: Sweet & Maxwell and its Contributors, 123-125.

¹⁵ KaMS RT I 2002, 49, 308.

luxury fashion brands like LV and LP or car logos like VW or BMW. Registration of your trademark gives you a right to use the trademark.

2.3 Madrid Agreement

A registered trademark is a property right. In order to have your trademark registered, one must go through a registration process. The Madrid System is governed by the Madrid Agreement. Finalised in 1891, and the Protocol relating to that Agreement, finalised in 1989.

The Madrid System makes mark protection possible in many countries. Through the Madrid System you have to file an application and pay a sum, which usually depends on the number of territories one wishes to register their trademark. In Estonia this amount varies between 100-200€. If you register in Estonia, you will have your trademark protection only in Estonia and for ten years.¹⁶ The fee varies by location, and the more territories you wish to cover, the more expensive the registration is.

The Madrid System is open to use for anyone with a personal or business connection within one of the System's Members. Madrid System currently has 123 countries.

2.4 Nice Agreement

The Nice Agreement covers everything when it comes to the classification of goods and services, in order to register a trademark. Every trademark must classify the intended use. Therefore similar trademarks can co-exist if they are classified differently from one another. Currently, there are 34 classes for goods and 11 classes for services. A registrar can register its trademark in multiple classes if it meets the conditions for each class. Once your application is received and confirmed, your trademark is registered. A trademark, when registered, will be valid for ten years. If it is still in use, it can be renewed after ten years.

¹⁶ KaMS RT I 2002, 49, 308; §8. (2).

The possibility to register acronyms as trademarks was first introduced into the Italian legal system, when the Legislative Decree no. 480/1992 was enacted. That decree was the implementation of Directive 89/104/ EEC. Nonetheless, there were arguments that acronyms are not strong trademarks and there is a high chance of infringement. Yet, later the changes were allowed, as long as the trademark is distinctive.¹⁷

2.5 Influential decisions

In the decision concerning brand Ferragamo and their famous omega letter, the Supreme Court ruled, that even though the letters of the alphabet are used as language tools, they could also be used as identification signs, and that is the exact reason, that gives them distinctiveness.

MPH Mittelständische Pharma Holding AG was looking to register the word mark MPH. It was applied to be registered in classes 5, 35, 36, and 41. The application was rejected for the bigger part of the goods and services, because of the lack of distinctive character. And you might think that it is because most of us know MPH as miles per hour, but the application was rejected by the Patent and Trademark Office, because they believed that the compatible commune would take the letters as an acronym for the active substance methylphenidate (used for treating ADHD). MPH filed a complaint against the decision. The complainant held that the acronym showed “an indeterminate nature”.¹⁸

Such trademark had always been registered until the decision of the ECJ (1), ruled as:

“A word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an acronym of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be

¹⁷ Varese E. (2019) Monograms: Just letters or powerful trademarks? *Return to Law à la Mode*, DLA Piper, 29.

¹⁸ Knitter M. (2016) *Registrability of acronyms as trademarks*. Retrieved from <https://www.internationallawoffice.com/Newsletters/Healthcare-Life-Sciences/Germany/SKW-Schwarz-Rechtsanwlte/Registrability-of-acronyms-as-trademarks>, 15 February 2021.

understood as a combination of descriptive indications or acronyms which is therefore devoid of distinctive character.”¹⁹

2.6 Examples of different acronyms as Trademarks

Today, registering a trademark has become a somewhat simplified and easy procedure if your trademark as an acronym meets the conditions of registering. As we have established, an acronym is a sequence of letters or also known as word mark. An acronym is not a word, but a combination of different letters that represent different words in relation to the brand or company name. For example BMW - Bayerische Motoren Werke; VW - Volkswagen; DHL - Dalsey - Hillblom - Lynn (founders last name initials); KLM - Koninklijke Luchtvaart Maatschappij.

My brand name JIV is registered as an acronym - Johanna Iluuisu Varustus (Johannas Skating Gear). The brand name was generated from the music genre name JIVE, which was our first option for the brand name, but since that is a very well-known word and would not have been possible to register, we settled on JIV. The acronym in itself does not hold meaning. It is considered like other brand names NIKE; KLM; ALO. None of these word marks have meaning, but they are known within their market. This brings us to the first issue that arises when wanting to register a trademark as an acronym.

The trademark applicant has to show that the letters they are trying to register as a trademark have a distinct meaning separate from the words it represents. At first, this is very confusing to understand, because there are plenty of acronyms, and acronyms that do not hold any meaning to our knowledge, yet they are world-famous and distinguished and therefore we do not think about the meaning.

To qualify for trademark protection, the acronym or initials must not be descriptive, and the public must not be able to recognise them as synonymous with the product.

¹⁹ Court decision, 29 July 2015, USA, Federal Patent Court, 29 W (pat) 78/12 – MPH.

As of now, there are several legal systems that do provide protection of acronyms under their legal system. An acronym should be able to designate the goods or services covered by the trademark. Secondly, the distinctive character of the acronym must remain independent from the words which compose it. Even if the words can be or have already been registered as a trademark, it is important to note that this protection is not automatically given to the acronym.²⁰

Lastly, it is just as well important to note, abbreviations must not be deceptive or against moral. We might think that who would even want their trademark to be something offensive, yet history teaches us differently. In many cases those offensive trademarks might just be the ones, that will be more popular amongst young people, because they are easy to remember. A good example of this is the case of trademark FCUK, which indeed resembles visually a swear word, yet the appellant did explain that this is just word play, but the judge thought otherwise, because there is really nothing else that comes to mind when seeing this trademark and therefore on the grounds of refusal under TMA 1994. art.3(3)(a).²¹

2.7 Examples of refusals to registration

In the event of refusal to register, one can either appeal the decision if they have grounds for appeal or accept the result. All the grounds of refusal are easily accessible when searching the internet. Therefore I will explain with some case laws to show different refusals to registration. The examples consist of cases with abbreviations and cases with longer trademarks.

Athlon sportswear was denied registration on the grounds of similarities to an earlier trademark Decathlon. The GC held that even tho they are two different names, the aural and conceptual similarity would create confusion and therefore interfere with the marketing.²²

²⁰ Court decision, 15 March 2012, joined cases C-90/11, C-91/11.

²¹ Mellor, J., QC., Llewelyn, D., Moody-Stuart, T. QC., Keeling, K., Berkeley, I., Chantrielle, A., Keay, M., (2020). Public Policy, Accepted Principles of Morality. *Kerly's Law of Trade Marks and Trade Names*. UK: Sweet&Maxwell.

²² Ikpe E. (2020). Trade mark decisions: Decathlon v EUIPO (T-349/19) (GC). *Chartered Institute of Patent Agents Journal*, 49(12), 31.

In 2013, a film titled Fack Ju Göhte, a deliberate misspelling of "Fuck you, Goethe", aired in Germany. Following the success of the movie, the producer filed for registration of trademark for the words Fack Ju Göhte. The application was unsuccessful on the grounds of refusal article 7(1) (f), which meant that the words are against moral and principle, meaning they are offensive. Interestingly the applicant unsuccessfully appealed to the Board of Appeal (BA) and the General Court (GC), yet finally had a successful appeal with the CJEU.²³

A very interesting case was in Germany, where a company applied for registration for the letter K. It was supposed to stand for a variety of goods made of metal like keys, grilles, windows, door etc. The Trademark Division at the German Patent Office dismissed the application on the grounds of a lack of distinctiveness and a legitimate interest in free use.²⁴ The distinctiveness was denied. Explanation was that the letter K is simply not enough of a trademark to be seen as something related to a business. Just as well, it seemed as if the business was more interested in the letter K.

An important case in the EU trademarks world is the ruling of *Strigl v Deutsches Patent- und Markenamt* (C-90/11). Two abbreviations: multi-markets fund - MMF and Der natur-aktien index -NAI were denied of registration. It was ruled, that both trademarks consisting of a descriptive word in combination with an abbreviation are not distinctive enough. According to article 3(1)(c) the abbreviations MMF and NAI were not descriptive. However as noted, the abbreviations represent the followed descriptive word combinations and that makes the trademark descriptive.²⁵ If the two abbreviations had been registered without the word combinations, they would not have been considered descriptive, yet because of the following words it is so clearly descriptive.

And following to this case we have another case from Germany where a similar idea of trademark was also denied registration, yet this time on the likelihood of confusion. In their ruling, the example of joined cases C-90/11 and C-91/11 was used. An abbreviation for BGW Bun-

²³ Davis J. (2020). Fack Ju Gohte: or when is a trade mark offensive? *Cambridge Law Journal*, 79(2), 234-237.

²⁴ W. D. (2002). Trade mark and unfair competition law: Germany: Letter "K". *International Review of Intellectual Property and Competition Law*, 33(1), 83-85.

²⁵ Marks to be assessed as whole., *EU Focus* 2012, 295, 27

desverband der deutschen Gesundheitswirtschaft was denied.²⁶ It was denied on the grounds of article 4(1)(b), since a trademark BGW had been registered in the same classes 2 years prior and had been used since. Due to the likelihood of confusion two trademarks consisting of the same abbreviation, can not operate on the same market.²⁷

In 2018 a word mark EZMIX was denied registration due to the descriptiveness of the mark. Reading it out loud, it is clear that the mark is 'easy mix'. The mark was supposed to stand for easily mixing music, which was also the pinpoint that was used when marketing the product/service. Just as in the previous case, as well as in this example, the court ruled that the mark is descriptive, and therefore can not be registered as a trademark.²⁸

Another case of descriptiveness comes from the abbreviation LIMO being registered in relation to medical laser equipment. During closer look, it was discovered that the abbreviation LIMOS stands for Laser Intensity Modulation System and this is exactly the good that the trademark LIMO would have represented. Even though the sign in question was LIMO, it does not change the fact that to the general public it was known that LIMOS indicates to the good that LIMO and therefore under art. 7(1)(c) the registration was unsuccessful. Due to the insufficient proof to show that LIMO is not descriptive this case was not appealed and the case was closed.²⁹

Lastly, another very clear example of the descriptiveness of abbreviation is the trademark BioID, which was a visual abbreviation of the words biometric identification. It was ruled that under art.7(1)(c) and art.7(1)(b) the trademark needs more distinctiveness and less descriptiveness.³⁰ In case the company would have changed the abbreviation to something like B-ID and made a vis-

²⁶ Court decision. 22 October 2015, Germany. BGW Beratungs-Gesellschaft Wirtschaft mbH v Scholz (C-20/14), WL 6181031.

²⁷ Stephens K., Fuller Z., Atherton H., (2015). Trade marks: likelihood of confusion in letter sequences perceived as acronyms. *Chartered Institute of Patent Agents Journal*, 44(12), 47-48.

²⁸Büller C. (2019). EZMIX considered descriptive for music production services. *Entertainment Law Review*, 30(5), 152-154.

²⁹ (2004) Descriptive word mark "LIMO" rejected as CTMU. *EU Focus*, 149, 24.

³⁰ Court decision. December 2002, BioID AG v Office for Harmonisation in the Internal Market (OHIM) (T-91/01), WL 31868.

ual presentation more distinguishable, there might have not been complications, but this is just my opinion based on what I have learned so far.

3. TRADEMARK CASES INVOLVING ACRONYMS

To have a better understanding of the grounds of refusal for registering an acronym, I have looked into several case laws.

3.1 Case 1 - Ford Motor Co's Community Trade Mark Application

Two decades ago one of the worlds' biggest car companies Ford filed for application to register abbreviation TDdi as trademark. The class that they chose was 12, since the goods were land vehicles, engines and car parts. For those who are familiar with cars, already know, that TDdi stands for turbo diesel direct injection.

This meant that the abbreviation is directly describing the goods, and is therefore invalid. Interestingly, the company appealed that the abbreviation is merely single letter formed together and mixing upper and lower case letter and that the initial buyer would not see it as an abbreviation for turbo diesel direct injection. The appeal was dismissed on the merits that the target customers would recognise the meaning behind the abbreviation, which therefore makes it descriptive.³¹

3.2 Case 2 - Frank industries pty limited v Nike retail bv

A clothing manufacturer (Frank) had a claim against Nike for trademark infringement. Nike appealed for a declaration that Franks trademarks were invalid.

Frank was the owner of UK and EU trademarks consisting of the letters LNDR (seen as Londoner). The marks were registered to use on clothing, including sportswear, and they were registered from February 2015 and March 2016. The marks were in association with a range of ladies' sportswear. In January 2018, Nike released an advertising campaign "nothing beats a Londoner". The campaign was directed at young people living in London. Also known as Londoners. The sign LDNR was used with Nike's famous logo.

³¹ Court decision. 10 February, 2000, Ford Motor Co's Community Trade Mark Application, E.T.M.R. 679 Case R 433/1999-1.

This case is purely about the likelihood of confusion, which is very common in the world of trademarks. Frank claimed that Nike infringed its marks under Directive 2015/2436 art.10(2)(b) and Regulation 2017/1001 art.9(2)(b).

Nike on the other hand argued that Franks marks are invalid under art.4(1)(c) of the Directive and art.7(1)(c) of the Regulation. Saying that they were descriptive, because LNDR, as mentioned, could and was recognised by the average consumer to be an acronym of "Londoner".³²

It was disputed that because Nike is so distinguished, the general public would see the use of LDNR with the Nike logo as an advertisement for Nike goods. Just as well it argued that the consumers would see LDNR as an acronym of "Londoner" and would not relate it to the origin of the goods.

Frank disputed that the acronym does not describe the characteristic of product, even if LNDR was seen as an acronym for "Londoner", it does not describe the characteristic of the product. In this case, clothing. On the infringement point, Frank argued that Nikes' use of their logo does not avoid the possibility of the public thinking that its use of LDNR pointed to some sort of collaboration with Frank Industries.³³

The judgment was in favor of Frank industries, meaning that the two acronyms were too similar and therefore Nike was in infringement or art.14(1)(b) It was confirmed that the two signs were confusingly similar.

3.3 Case 3 - Gerolsteiner Brunnen GMBH & CO v Putsch GMBH

A comparable case to the one above is a German case about two seemingly similar trade marks GERRI and KERRY SPRING. The latter being produced in Germany and Kerry Spring in Ireland. The case went by Trade Marks Directive Art.6(1)(b), which covered defences to trade mark infringement. It was stated that the two marks, both soft drink makers had an aural confusion between the two. Aural confusion means that the sound of the two marks is too similar.

³² Horton A. (2019). Trade marks: validity and infringement in the context of acronyms. *PLC Magazine*. Thomson Reuters Ltd, 29(8), 74-75.

³³ Rivers F. (2018) Trade marks: LNDR distinctive for clothing. *Chartered Institute of Patent Agents Journal*, 47(10), 42.

Gerolsteiner Brunnen (GB) of Germany sued Putsch for trademark infringement for the use of the trademark "Kerry Spring" for mineral water. The ECJ said that the word duo "Kerry Spring" was included in the list of mineral waters recognised by Ireland and published by the European Commission and that the term "Kerry Spring" was used in Germany as a geographical indication of origin.³⁴

It is stated in the EU Trade Marks Directive that the owner of a registered trademark cannot prohibit a third party from using geographical indications of the goods in the course of trade, considering the trading is "in accordance with honest practices in industrial or commercial matters."

The German court argued that the average consumer shortens Kerry Spring to Kerry, and that creates the aural confusion. Putsch stood its ground to once again focus on the geographical indications and emphasise that everything is in accordance with honest practices. The German court then decided to send this case back to the national level because, even though there is a likelihood of confusion, Putsch made a strong case for geographical indication, and therefore prohibiting them from using their trademark in EU would be a sign of unfairness.³⁵

Generally, geographically descriptive terms are not allowed to be registered as trademarks unless they later achieve distinctiveness. Although geographically descriptive terms are the main subject matter of geographical indicators. The ECJ decided that the conflict is not between a geographical term used as a trademark and a geographical term used as a PGI, but it was between a geographically descriptive term (KERRY) and a trademark that coincidentally happened to sound like the above term (GERRI).³⁶

³⁴ Clarke O.(2004) *Registered trade marks v geographical indications*. Retrieved from <https://marketinglaw.osborneclarke.com/media-and-ip/registered-trade-marks-v-geographical-indications/>, 15. February 2021.

³⁵ Case comment. (2004) European Union: First Council Directive (EC) No.89/104/EEC to approximate the laws of the Member States relating to trade marks, Art.6(1)(b) - "GERRI/KERRY Spring". *International Review of Intellectual Property and Competition Law*, 35(6), 654-656.

³⁶ Phillips J.(2004) In praise of confusion: honest use of descriptive term is protected. *Trademark World*, 166, 66.

3.4 Case 4 - Modern optics, inc v Univis lens co

One of the most famous cases on the descriptiveness of an acronym was in 1956. The applicant applied a trademark for the use of letters CV within a logo. As in Curriculum Vitae like most people know. First, it was tried, to register a mark which was described as “mark that comprises a pictorial representation of an eye from which outwardly projecting lines radiate through a lens to and through the wording ‘Continuvis Lenses’”.

The products are ophthalmic lens blanks, eyeglasses, and trifocal lenses. At first, the mark was not granted a registration on the basis that the mark was too descriptive of the goods. An appeal followed to register just the letters CV.

The question in this case is clear. Are the letters CV descriptive of the products mentioned above or not? The court noted that the mark in question is too descriptive and therefore can not be registered. The appellant then argued that even though they are recognised as continuous vision, they are not related to trifocal lenses immediately and therefore make the mark merely descriptive.³⁷ This case has been followed by courts since then. Mainly so, because it is important to look at how the public perceives the mark, rather than what it stands for.

3.5 Case 5 - Russell Campbell v Rangers Football Club ltd

In this case, the opponent appealed against rejection of his opposition to the registration of a trade mark RFC - Rangers Football Club. The club wanted to register the acronym RFC and R.F.C. in several classes under the Trade Marks Act 1994 s.41(1)(c).

RFC is also widely known as an acronym for rugby football club, and therefore there was grounds of refusal to the application. Yet the club still decided to appeal, and it was allowed. The opponent then said that not enough emphasis is put on the importance of the acronym RFC and the club should not be allowed to register their trademark under any circumstances.

³⁷ Court decision. 1956, California, USA, California Consumer Privacy Act, Modern Optics, Incorporated, Appellant, v. the Univis Lens Company, Appellee, 234 F.2d 504.

The application made by Rangers Football club was later reformed so that all of the goods classes included the limitation "all of the aforesaid goods relating to or for the promotion of football(soccer)". The opponent disputed that under s.3(1)(b), (c) and (d), the registration should be refused, but the hearing officer rejected the opposition.

3.6 Case 6 - Psytech International Ltd v Office for Harmonisation in the Internal Market

Bad faith and descriptiveness of a trademark. P's trademark 16PF was called into question, on the basis that it is too descriptive and is registered in the means of bad faith, to avoid others from using it. To clarify, the abbreviation stands for 16 personality factors and is linked to a system that creates personality analysis on the basis of personality factors. P successfully appealed its case, by proving that the abbreviation is enough distinctive, yet not descriptive and not customary. Also it appealed that bad faith was not proven.

The marks descriptiveness was then assessed on the basis of market research. The research showed that the sign in fact was not descriptive, because even the professionals of personality analysis field, would not immediately understand the meaning behind the name. It was also proven that all services and goods the company had marked to their field were in good faith and that they were operating in the field. This case made me wonder if the party filing the claim was a rival and wanted to get rid of their competition? Possibly, and therefore if I had been on the side of P I would not have been shy to fight this, if it had come to that.³⁸

3.7 Case 7 - Case of online clothing store ASOS

I chose this case for a the following reasons: ASOS is an online clothing store where I shop rather often and secondly today they are one of the most popular online shops for men and women and I consider them to have a very good name for trademark. ASOS stands for 'as seen

³⁸ Stephens K., Fuller Z., Atherton H., (2011). Trade marks: 16PF. *Chartered Institute of Patent Agents Journal*, 40(7), 455.

on screen'. It is a great name, because it is easy to pronounce, easy to remember, yet it is not descriptive of the goods.

In this case there was a likelihood of confusion with the claimant, that was a brand ASSOS, which was operating cycling gear and therefore a likelihood of confusion could have occurred, due to the similarities of the two names. In the proceedings both markets were searched to prove if there had been confusion prior, therefore seeing if there is a likelihood.³⁹

As a result no likelihood of confusion was found and ASOS was allowed to proceed with their trademark and they also took steps to ensure, their fashion would not be related to the same goods as ASSOS.

3.8 Summary of relevant case laws

What I learned from these cases, that in order to register an acronym as a trademark or claim someones trademark is in infringement with mine, I must have very solid ground in claiming that. It also shows that courts approach their cases differently.

There are many things to take into account, but most importantly a lot of the time problems will occur, when applying for a trademark that is either a descriptive/known word, or an acronym that is also known to be used by the general public, f.e. CV.

The reason being that these acronyms are known, and whether they are related to your product, there is a high risk of likelihood, but also even more importantly it could substantially create an unfair advantage. Unfair advantage should be avoided at all cost keeping in mind the honest trading and good cross border relationships for trading.

In all these cases is the trademarks under question are highly likely to be confused with other trademarks already in use. In these type of cases it is important to look at how the general public perceives these trademarks, especially the widely known trademarks.

³⁹ Mellor, J., QC., Llewelyn, D., Moody-Stuart, T. QC., Keeling, K., Berkeley, I., Chantrielle, A., Keay, M., (2020). "Name" of the Defendant. *Kerly's Law of Trade Marks and Trade Names*. (16th Ed.). UK: Sweet&Maxwell.

It can also be tricky to prove that the trademark does not describe the product. With widely known trademarks, the names can already be so distinguished that even though they do not describe the product, consumers still relate the trademarks to products.

4. MORE ACRONYMS AND CASE STUDY OF JIV TRADE-MARK

4.1 Famous acronyms as Trademarks

Before I continue to analyse my own brand registration to the US trademark office, I will describe more acronyms. As established in the beginning of this research, I have come across various conflicting facts, that will possibly make the registration of my trademark in US impossible or very complicated.

There are acronyms that sound like words, but they do not hold a meaning. HEMA (Hollandsche Eenheidsprijzen Maatschappij Amsterdam) a shop for all sorts of home and beauty products or the grocery shop DE SPAR (Door Eendrachtig Samenwerken Profiteren Allen Regelmatig). In the case of DE SPAR, the acronym has now been updated to SPAR. Even though the underlying words describe the companies activities precisely, the acronyms make good trademarks, because there is no reference to the product or service.⁴⁰

Some other examples include situations where letters are articulated separately – airline KLM (Koninklijke Luchtvaart Maatschappij) or ING (Internationale Nederlanden Groep). It is remarkable, that none of these acronyms describe the companys products or service, and therefore make good trademarks.

Before deciding if an acronym works as a trademark, it is important to decide what the acronym stands for, and especially if the meaning is relevant to the market where the acronym will be used.

⁴⁰ Graver-de Looper M. (2016). *Registering an acronym as a trademark*. Retrieved from <https://www.lexology.com/library/detail.aspx?g=9f7b9956-3fb9-4d1d-bb62-cb76a2e6e3b0> 15. February 2021.

4.2 Scope of protection

In the case of similar trademarks, the rights holder can launch proceedings against the use of signs which are identical or very similar. In these cases, similarities in the appearance, sound or meaning are examined and tested throughout. If two identical acronyms have the same intention for use, it is usually possible to take legal action. Although, if the acronyms do have even the slightest difference, then the overall impression will show if any legal action is possible to take. See case FRANK INDUSTRIES PTY LTD v NIKE RETAIL BV in previous chapter.

Acronyms such as NKS and NKT. When pronouncing them, they sound entirely different, yet the look is similar. No infringement. In the contrary, NKS and MKS are very similar to each other, because the one letter difference does not create a difference in sound. It is worth mentioning though, that in 2008 the owner of the MKS trademark did have a successful legal action against NKS. This just goes to show that one letter can have a lot of amplitude. ⁴¹

Another great example is CVS Pharmacy. It is a store in the US, that sells prescription drugs, but also any product you may need, including seasonal products and clothes. CVS has registered many marks for their brand protection, some including "CVS Health" to "CVS Speciality". Yet the acronym for the underlying words is Customers Value Service.

Another example DHL. It was founded in the United States in 1969 to deliver documents between San Francisco and Honolulu. The company then expanded its service throughout the world by the late 1970s. Today we know DHL as one of the worlds leading delivery service company.

The world-famous shipping company DHL was formed by 3 people - Larry **H**illblom, Adrian **D**alsey, Robert **L**ynn. So the name the company simply came from the initials of their last names.

⁴¹ *Ibid.*

4.4 Personal case study - Applying for trademark protection in USA

Before applying for a trademark registration in USA, I did some research. Essentially, as I have already stated, there is another brand called JIV Athletics already registered in USA. They have a pending patent on their design, and they are classified as sporting goods.

When going through their website <https://www.jivathletics.com> I determined that this brand specialises in undergarments for women living an active lifestyle. Therefore I believe their market is female in all sizes and who like to live actively. Therefore it is similar to our scope.

Table comparisons of the two brands in order to establish a distinguishability between them.

Tabel 1

Comparison between two brands

	class	products	market	distinguished?
JIV Sport	25	figure skating clothing, workout clothes	Both female and male figure skaters, dancers, gymnasts. People who work out.	Very distinguished in specific figure skating market. When googling 'figure skating clothes' JIV comes up on first page.
JIV Athletics	25	performance undergarments	women who wear underwear and want more comfortable underwear.	There are many other brands for sports underwear, but they are the only one with a special design, due to the special characteristics of the product. When googling 'sports underwear for women' they don't come up on first page.

Tabel 2

Similarities between two brands

	similar name?	Same market?	competing companies?	similar logo?
JIV Sport	YES	NO	NO	NO
JIV Athletics	YES	NO	NO	NO

Following the research I did in regards to JIV ATHLETICS, I see that there could be complications in registering my trademark in the same market. Thereof I believe that for us it would be important to make our logo very different from theirs, and this is something we have just finalised within the company, and I believe that if we tried to register the symbol, we might succeed.

When registering the acronym JIV, I do not think that it is distinctive enough and they might be confused on the market. Although we might be able to gather enough proof, to prove that the brand name JIV is distinguished in a specific figure skating market, and with that said it does not infringe with JIV ATHLETICS that operates on a market separate from us. Another important factor to mention is, that we will only register the part JIV, which does not indicate the products and is not descriptive, whereas JIV ATHLETICS is descriptive, describing athletic wear.

When it comes to the descriptiveness of our trademark, then we have no infringement. Our trademark does not describe the products, even though the underlying words describe what we do. We do not market that, and therefore the name JIV is merely a name of a brand.

SUMMARY

THE SUITABILITY OF ACRONYMS AS TRADEMARKS

Johanna Allik

The goal of this thesis is to describe in the most accurate way possible what are trademarks, specifically acronyms, and how suitable are they for registration as trademarks. The world of trademarks and acronyms is big, and it will keep expanding. And more disputes will be happening, but thankfully there are plenty of case laws around to refer to.

Starting to register a trademark is a long process that should not be done overnight. Whether you register the full name of the company or just the abbreviation, has to do with many things. As this thesis has proven, in many cases it is easier to register the company name as long as it is not in infringement with anyone else's. Yet most times the acronym that the company portrays outside, and uses for marketing purposes could be much more distinguished and known. If some other company were to start using it, they would have a clear advantage in starting their business.

Therefore it is important for any competing company to invest in protecting their company image, logo, name. It is very difficult to fight against anyone who has been on the market longer than you.

The main issues that arise when applying for registration of an acronym as trademark, are the likelihood of confusion, and descriptiveness of the mark. Using initials is also not recommended, as often enough they end up being abbreviations of widely known words.

After studying this matter and writing this thesis, I recommend creating acronyms that are made of at least three letters, that put together do not hold a distinct meaning, but the underlying words the letters separately represent could or should relate to the goods or services the company markets. It is also a good marketing standpoint, to have a meaning behind the acronym, yet the letters should not form a word, that could lead to the likelihood of confusion with some other brand or product.

When it comes to international companies, it is further suggested to register your trademark in as many locations as possible. The sooner you do that, the lower the chance of having a competing brand with similar name.

With that said, one should not forget in which specified class they apply for registration. Since registering in classes, where the company does not plan to operate creates bad faith and could therefore result in the dismissal of your application.

Even though courts do not enjoy dealing with cases that involve acronyms, I think it is great that there are laws that protect company owners that have acronyms as their trademarks. It should be encouraged to create acronyms and register them and with all that said, acronyms are definitely suitable as trademarks. I believe they can have a big value when creating company image.

LIST OF REFERENCES

Scientific books

- Guide G. (2004). *Entrepreneur's Guide To Patents, Copyrights, Trademarks, Trade Secrets*. New York, USA: Berkley Publishing Group.
- Mellor, J., QC., Llewelyn, D., Moody-Stuart, T. QC., Keeling, K., Berkeley, I., Chantrielle, A., Key, M., (2020). "Name" of the Defendant. *Kerly's Law of Trade Marks and Trade Names*. (16th Ed.). UK: Sweet&Maxwell.
- Mellor, J., QC., Llewelyn, D., Moody-Stuart, T. QC., Keeling, K., Berkeley, I., Chantrielle, A., Key, M., (2020b). Public Policy, Accepted Principles of Morality. *Kerly's Law of Trade Marks and Trade Names*. (16th Ed.). UK: Sweet&Maxwell.
- Woodley M. (2013). *Osborn's Concise Law Dictionary*. (12th Ed.) UK: Sweet&Maxwell.

Scientific articles

- Azmi I.M., et al. (1997). Distinctive Signs and Early Markets: Europe, Africa and Islam. *The Prehistory and Development of Intellectual Property Systems: Perspective on Intellectual Property*. (Vol.I) London, UK: Sweet & Maxwell, 128-129.
- Bird & Bird. (2018). Trade marks: validity and infringement in the context of acronyms. *PLC Magazine*, 29(8), 74-75.
- Blythe A. (2016). A useful test for trade mark use: an analysis of current CJEU guidance and the difference between defining use online and offline. *European Intellectual Property Review*, 38(9), 563-569.
- Büller C. (2019). EZMIX considered descriptive for music production services. *Entertainment Law Review*, 30(5), 152-154.
- Calboli, I. (2015) Trademark Protection and Territoriality Challenges in a Global Economy. *European Intellectual Property Review*, 37 (2), Lee, E.(ed), Sweet & Maxwell and its Contributors, 123-125
- Davis J. (2020). Fack Ju Gohte: or when is a trade mark offensive? *Cambridge Law Journal*, 79(2), 234-237.
- Diamond S.A. (1975). The Historical Developments of Trademarks. *Trademark Reporter*, 64, 265.

- Fhima I. (2017). The public interest in European trade mark law. *Intellectual Property Quarterly*, 4, 311-329.
- Fields D. (2019). EU General Court says "no" to MARRY ME trade mark. *Entertainment Law Review*, 30(5), 156-158.
- Horton A. (2019). Trade marks: validity and infringement in the context of acronyms. *PLC Magazine*. Thomson Reuters Ltd, 29(8), 74-75.
- Ikpe E. (2020). Trade mark decisions: Decathlon v EUIPO (T-349/19) (GC). *Chartered Institute of Patent Agents Journal*, 49(12), 31.
- Phillips J.(2004) In praise of confusion: honest use of descriptive term is protected. *Trademark World*, 166, 66.
- Rivers F. (2018) Trade marks: LNDR distinctive for clothing. *Chartered Institute of Patent Agents Journal*, 47(10), 42.
- Stephens, K., Fuller, Z., Atherton H. (2011). Trade marks: 16PF. *Chartered Institute of Patent Agents Journal*, 40(7), 455.
- Stephens, K., Fuller, Z., Atherton H. (2015). Trade marks: likelihood of confusion in letter sequences perceived as acronyms. *Chartered Institute of Patent Agents Journal*, 44(12), 47-48.
- Tarawneh J. (2014a). History of trade marks.
- Tarawneh J. (2014)b. Nature of trade marks.
- Varese E. (2019) Monograms: Just letters or powerful trademarks? *Return to Law à la Mode*, DLA Piper, 29
- W. D. (2002). Trade mark and unfair competition law: Germany: Letter "K". *International Review of Intellectual Property and Competition Law*, 33(1), 83-85.
- Descriptive word mark "LIMO" rejected as CTMU. (2004) *EU Focus*, 149, 24.

Estonian legislation

KaMS RT I 2002, 49, 308.

KaMS RT I 2002, 49, 308; §8. (2).

Court decisions

Court decision. 1956, California, USA, California Consumer Privacy Act, Modern Optics, Incorporated, Appellant, v. the Univis Lens Company, Appellee, 234 F.2d 504.

Court decision. 10 February, 2000, Ford Motor Co's Community Trade Mark Application, E.T.M.R. 679 Case R 433/1999-1.

Court decision, 12 November 2002, Chancery UK, Arsenal Football Club Plc v Reed no. C-206/01.

Court decision. December 2002, BioID AG v Office for Harmonisation in the Internal Market (OHIM) (T-91/01), WL 31868.

Court decision, 15 March 2012, joined cases C-90/11, C-91/11.

Court decision. 22 October 2015, Germany, BGW Beratungs-Gesellschaft Wirtschaft mbH v Scholz (C-20/14), WL 6181031.

Court decision, 29 July 2015, USA, Federal Patent Court, 29 W (pat) 78/12 – MPH.

Other sources/Web materials

Clarke O. (2004) *Registered trade marks v geographical indications*. Retrieved from <https://marketinglaw.osborneclarke.com/media-and-ip/registered-trade-marks-v-geographical-indications/>, 15. February 2021.

Case comment. (2004) European Union: First Council Directive (EC) No.89/104/EEC to approximate the laws of the Member States relating to trade marks, Art.6(1)(b) - "GERRI/KERRY Spring". *International Review of Intellectual Property and Competition Law*, 35(6), 654-656.

Graver-de Looper M. (2016). *Registering an acronym as a trademark*. Retrieved from <https://www.lexology.com/library/detail.aspx?g=9f7b9956-3fb9-4d1d-bb62-cb76a2e6e3b0> 15. February 2021.

Knitter M. (2016) *Registrability of acronyms as trademarks*. Retrieved from <https://www.internationallawoffice.com/Newsletters/Healthcare-Life-Sciences/Germany/SKW-Schwarz-Rechtsanwlte/Registrability-of-acronyms-as-trademarks>, 15. February 2021

Marschollek D. (2016). *EU trade mark law reforms*. 10 things to know. Norton Rose Fulbright. Retrieved from <https://www.nortonrosefulbright.com/en/knowledge/publications/1ee50866/eu-trade-mark-law-reforms>, 14. February 2021.


Upcounsel. *Intellectual Property Rights History: Everything to Know*. Retrieved from <https://www.upcounsel.com/intellectual-property-rights-history>, 15 March 2021.


Varese E. (2019) Monograms: Just letters or powerful trademarks? *Return to Law à la Mode*, DLA Piper, 29.

7. APPENDICES

Appendix 1

Following screenshots taken from WIPO database:

U.S. Trademark	
87363356 - JIV ATHLETICS	
87363356 - JIV ATHLETICS	
Status: Live/Registered, Registered	
(111) Registration Number	5424938
(151) Date of the registration	13.03.2018
(210) Serial Number of the application	87363356
(220) Date of filing of the application	08.03.2017
(270) Language(s) of the application	English
(540) Mark	
(526) Disclaimer	'ATHLETICS'
(550) Indication relating to the nature or kind of mark	Trademark
(571) Description of mark	The mark consists of the stylized wording "JIV" appearing above the stylized wording "ATHLETICS".
(591) Information concerning colors claimed	Color is not claimed as a feature of the mark.
(750) Address for correspondence	JEFFREY M. FURR , FURR LAW FIRM , 2622 DEBOLT ROAD , UTICA, OH 43080
(731) Name and address of the applicant	(Applicant) JIV LLC Limited Liability Company CALIFORNIA, 2625 Camino Del Mar
(732) Name and address of the holder of the registration	(Registrant) JIV LLC Limited Liability Company CALIFORNIA, 2625 Camino Del Mar
(740) Name and address of the representative	(Attorney of Record) Jeffrey M. Furr
(511) The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto	25 Apparel, namely, shorts, tops, t-shirts, pants, skirts; active apparel yoga pants, sweat pants, sweat shirts; active undergarments; bags, namely, ski boot bags, hunting boot bags
(512) National classification and/or list of goods and/or services classified according thereto	022, 039

International Trademark	
1397056 - JIV	
1397056 - JIV	
(151) Date of the registration	03.11.2017
(180) Expected expiration date of the registration/renewal	03.11.2027
(270) Language(s) of the application	English
(732) Name and address of the holder of the registration	JIV Sport OÜ Paneeli 2a EE-11415 Tallinn (EE)
(812) Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment	EE
(842) Legal nature of the holder (legal entity) and State, and, where applicable, territory within that State where the legal entity is organized	Limited company, Estonia
(750) Address for correspondence	JIV Sport OÜ Meremägi 6 EE-76905 Muraste (EE)
(540) Mark	
(531) International Classification of the Figurative Elements of Marks (Vienna Classification)- VCL (7)	27.05.03.
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