



## MILK, MOO JUICE and AMERICAN ENGLISH

This article by David Wilkinson and Tom Lingard first appeared in Legal Week on 15 November 2007.

It's no exaggeration to say that, these days, branding can be everything. The growth of the "global village" means that businesses (or their advertising agencies and brand consultants) are constantly searching for new and distinctive brands, and they are increasingly looking overseas for inspiration.

The difficulties of protecting descriptive marks in the UK (either as a registered trade mark or under the law of passing off) are well established. If a word is descriptive in one jurisdiction, however, does that mean it cannot be protected in another, where it may be unknown or have no natural meaning?

### Registered Trade Marks

Milk Link Limited v Almighty Marketing Limited<sup>1</sup> concerned a registration for the mark MOO JUICE (a slang term for "milk" in the United States) in class 29 for "*milk; milk beverages; flavoured milk; milk products; yoghurt; drinking yoghurt; flavoured yoghurt*".

Milk Link applied to have the mark declared invalid under Section 47 of the Trade Marks Act 1994 ("the Act"), on the grounds that it was:

- Descriptive of milk, and so "*devoid of distinctive character*" under Section 3(1)(b) of the Act;
- Used as slang for milk, and so consisted exclusively of an indication which "*designated the kind of goods in question*" under Section 3(1)(c) of the Act ; and
- Used as slang for milk, and so consisted exclusively of an indication which was "*customary in the current current language*" under Section 3(1)(d) of the Act.

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<sup>1</sup> In the matter of Application No. 81899, Sub nom Milk Link Limited v Almighty Marketing Limited, decision of the Appointed Person (Geoffrey Hobbs QC) of 29 November 2006, unreported

At first instance the Hearing Officer rejected the application, summarising his findings as follows:

*“On the basis of the evidence before me I do not consider that MOO JUICE is in common parlance in the United Kingdom as a synonym for milk... The evidence shows MOO JUICE is a phrase that has been used in North America; how pervasive that use is, I cannot tell...*

*Most of the evidence has dealt with American usage. American and British English do diverge; they may use the same words meaning different things. In such cases it may be necessary to view the languages as being different languages. Such is the case here. There is no indication that the British public has been exposed to the phrase MOO JUICE in such a manner that it will have seen it as a synonym for milk. The best that Link can muster to support its case is one incidence in one television programme.”<sup>2</sup>*

Milk Link appealed to the Appointed Person, however, arguing that the Hearing Officer had not demonstrated *“due regard for the effect of people in the United Kingdom being linguistically, culturally, socially and economically prone to adopt and use words and expressions from American English”*.

Interestingly, this argument echoed one considered sixty years ago in La Marquise Footware Inc’s Application<sup>3</sup>. That case concerned an application to register the word “OOMPHIES” for footwear. The word “Oomph” apparently owes its origin to the Hollywood actress Ann Sheridan. In the words of Evershed J:

*“... after being particularly applied to her, it has achieved a significance – how widespread I cannot say – meaning those qualities... of which I can use the phrase ‘sex appeal’... That being the origin of the word, the applicants have added to it the suffix ‘ies’ and have produced the word ‘oomphies’.”*

Evershed J decided that although in light of its origins OOMPHIES was a word with an accepted meaning, it was nevertheless registrable. His reasoning was that although OOMPH was used in American slang to refer to ‘sex appeal’, that did not make OOMPHIES descriptive of shoes sold in the UK. He went on to say that:

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<sup>2</sup> Paras 23 and 32 of Mr Landau’s judgment.

<sup>3</sup> [1947] 64 RPC 27.

*“I think that it would be an affectation to say that a word which has gained any currency as an American slang word ought to be treated in these islands, in the absence of any evidence one way or the other, as a foreign word.”<sup>4</sup>*

His approach, therefore, was not to treat ‘American’ English as a foreign language, but carefully to consider whether American usage would lead consumers in the UK to regard the mark as descriptive of the goods or services in question. If not, the ‘descriptive’ objection to registered trade mark protection could not apply.

In Almighty Marketing the Appointed Person confirmed that this approach is still correct, concluding that the assessment of descriptiveness should be a localised one and take into account the extent to which the ‘American’ English meaning will be perceived and remembered by UK consumers. He went on to find that MOO JUICE would not be used and understood purely descriptively in relation to dairy products in the UK, and so Milk Link’s appeal failed.

A similar conclusion had been reached in 2006 by the ECJ in Matrazen Concord AG v Hukla Germany SA (which was also referred to in Almighty Marketing). In Matrazen Concord the court refused to cancel a Spanish registration for MATRAZEN in respect of mattresses and similar goods, since although MATRAZEN was the German word for “mattress”, it did not carry the same descriptive connotations in Spain.

### **Unregistered Trade Marks**

As shown by the leading case of Office Cleaning Services Limited v Westminster Window and General Cleaners Limited<sup>5</sup> (which involved an attempt to protect “office cleaning services” for the service of cleaning offices), it can be very difficult to protect a descriptive mark under the law of passing off. In order to do so, it is normally necessary to show that the mark has acquired a “secondary meaning” through use, which means that the public associate the word or phrase in question with goods or services from a particular source, despite the descriptive connotations.

Most of the cases in this area suggest that to be descriptive for the purposes of passing off, the name must immediately describe the goods without additional explanation (e.g. “Gourmet” for a magazine

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<sup>4</sup> See note 3 above at p31.

<sup>5</sup> [1946] RPC 39, HL

about food<sup>6</sup>; “Gold AM” for a radio station playing ‘golden oldies’<sup>7</sup>; and “oven chips” for chips cooked in the oven<sup>8</sup>).

These principles were considered recently in A&E Television Networks v Channel 4 Television Corporation<sup>9</sup>. The case concerned the use of the word INTERVENTION as the title of a series of television programmes. “Intervention” therapy is used in the United States as a means of dealing with various types of addiction and compulsive behaviour disorders, and involves a surprise confrontation of the patient by a close group of friends and family. Such therapy is, however, little known or used in the UK. After the series of “fly on the wall” documentaries entitled “Intervention” enjoyed success in the United States, the broadcaster A&E pitched the format to television executives from the UK, which led to an option agreement being entered into with a UK production company. Channel 4, however, then announced plans for a programme on the same subject entitled “Intervention: we’re coming to get you”, which led A&E to bring a claim for passing off.

Despite evidence of confusion on the part of TV executives as to whether Channel 4 had taken a licence from A&E, the court found that the word ‘intervention’ had descriptive connotations in the UK, both among the psychiatric and medical professions and (as a result of references in programmes and films of US origin shown in the UK) to a fairly widespread section of the general public. Consequently, A&E’s claim failed, on the basis that *“the greater the descriptive power of the word or expression in question, the higher is the burden of proof required by a claimant to satisfy this limb of the law of passing off”*.

## Conclusions

In the digital age, it does not take long for a little-known colloquialism to become known throughout the world. When deciding whether a particular word or phrase has become descriptive in this jurisdiction, the UK courts have to decide what stage the process of linguistic colonisation has reached. While MOO JUICE may, for now, be a slang term confined to the United States, how long will it be before we are all pouring it on our cornflakes?

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<sup>6</sup> *Advance Magazine Publishing Inc v Redwood Publishing Limited* [1993] FSR 449.

<sup>7</sup> *County Sound Plc v Ocean Sound Limited* [1991] FSR 367.

<sup>8</sup> *McCain International Limited v Country Fair Foods Limited and Another* [1981] RPC69.

<sup>9</sup> Judgment of HH Michael Fysh QC, sitting as a Deputy Judge of the High Court, 7 April 2006, unreported.