

A CASE STUDY OF SEMIOTIC DISTINCTIVENESS IN BRAND NAMES

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Abstract : Brand names constitute a form of value for commercial products, because they suppose a savings of search costs for the consumer. The law, as a consequence, has the obligation to protect brand names. But the number of attractive brand names is not infinite and sometimes companies seek brand names which are reminiscent of others. In this article a conflict between two companies for the distinctiveness of two brand names is addressed: one Spanish company used the English common noun *doughnut* for a product similar to the American pastry, while the other company had already registered *donut* as a brand name, in addition to its variants. This second company sued the first on the grounds that the names were not distinctive. Here we offer the arguments presented to the judge in defense of the distinctiveness of *doughnut* and the judgment.

Keywords:

Brand names. Trade mark law. Linguistic signs, Distinctiveness of signs.

At present, trademark names have become a source of linguistic and legal obstacles. From a linguistic point of view, trademark names must adapt to the linguistic patterns of a particular language and must be sufficiently distinctive so as to be easily identifiable and distinguishable from other brand names for similar or identical products. As a result, the number of brand names that are distinctive is declining as a direct result of these linguistic and legal constraints. Other restrictions have become obstacles for manufacturers when they have to coin a brand name. One way to solve this shortage of names is to borrow generic or common nouns from other languages, particularly English.

Recently, the Spanish company Panrico, an industrial pastry manufacturer, sued another Spanish company, Europastry, because of what they considered to be the illegal use of the word *doughnut*. Panrico has used this trademarked name since 1962, and in successive years variant forms of common English nouns such as *donut*, *donuts*, *doghnut*, *donetes* have been coined. In their defense, Europastry argued that the word they used to describe a similar and imported product from the Anglo-Saxon world is a common English noun, different in both its phonetic adaptation to Spanish as well as the visual aspect of the name *doghnut*.

The issue raised requires not only a legal analysis, but also a linguistic assessment in

order to establish the distinctiveness of the name *doughnut*, which Europastry sought to use for a particular bakery product.

1. **Distinctiveness of the brand name.**

Spanish Trademark Law requires in Article 4 that the sign of a brand name be distinctive, but does not specify on which traits distinctiveness is based. The law prohibits trademarks "which consist exclusively of signs or indications which may serve in trade to distinguish the kind, quality, intended purpose, value, geographical origin, and the time of production of the product or the service."

Linguistic analysis must, therefore, determine if the *doughnut* sign that the Europastry wanted to use is sufficiently distinctive from the *dognnut* sign that the company Panrico took from English and trademark in 1988.

The word *donut* has entered the Spanish language in the last thirty years. Lorenzo [6] dates the term for the first time back to 1981, although it is somewhat earlier. The term does not appear in the Dictionary of the Royal Spanish Academy [7], which is a dictionary of the normative use of Spanish and often used in the courts to interpret the shape and meaning of words [3]. The Spanish Royal Academy only admits lexical items which have been consolidated in the language through several subsequent generations. So it is no wonder that the term *doughnut* does not appear in this dictionary. The term is only listed in the dictionary Clave [4] published by SM, which mistakenly asserts that the term is a trademark name.

2.1. Phonetic distinctiveness of the sign.

Today the term 'donut' is an anglicism commonly used in Peninsular and Hispanic-American Spanish. Many anglicisms [6] have been introduced into Spanish (and from there to other peninsular languages such as Catalan, Galician and Basque) mainly starting from the nineteenth century. These anglicisms have been adapted into Spanish by way of phonetic orthographic conventions. Thus, anglicisms like *túnel* (Engl. tunnel), which were introduced in the nineteenth century, are adapted into Spanish by maintaining their phonetic realization and stress position within the word but modifying their spelling to coincide with the norms of Spanish orthography

(*tunnel*, *wagon*, and *rail*, with the accent on the first syllable). The average Spanish speaker pronounces these and other written words in accordance with their spelling, the only difference being in the placement of prosodic stress, which Spanish-speakers tend to modify in accordance with the rules of Spanish stress assignment in which the accent falls on the penultimate syllable [1]. It must be stressed that anglicisms in Spanish are not restricted to these three examples. The following list shows the natural way in which anglicisms in Spanish are pronounced as they are read:

I	II
Palabra inglesa original	Anglicismo hispánico
1. jersey [ˈdʒərzi]	jersey [xerˈsej]
2. jockey [ˈdʒəki]	jockey [ˈxokej]
3. bádminton	bádminton, badmintón
4.pudding	puđin
5.bungalow	bungaló
6.cok	cok, coque
7.check	cheque
8.body	body
9. bulldog	buldóg
10.cable [keɪbəl]	cable
11. blockhaus	blocao
12. lifting	lifting
13.iceberg ¹	iceberg
14.flirt	flirt-ear
15. stagflation	estagflación
16.softwar	software [sóftguar]
17. pancake	panqueque
18.pick up	picú
19.puzzle	puzle
20. sándwich	sángüich

¹ Palabra holandesa que a través del inglés pasa al español.

22. sweater

suéter

23. golf

golf

Column II recognizes the anglicized pronunciation by retaining the original spelling in most cases. Even though the consonant clusters -lf (23) and -rt (14), as well as the word-final "ch" in (20) have no analogues in contemporary Spanish, they are now admissible Spanish tokens.

Consequently, it would not be uncommon for an average Spanish-speaker to produce the word *doughnut* as [dówɣnut] or [dóɣnut], pronouncing each and every one of the graphemes, with the exception of the letter "h" which is not pronounced in Spanish. These realizations differentiate the pronunciation of *doughnut* from that of *donut*. The realization of [dóɣnut] is consistent with the phonetic model of Spanish which permits the co-occurrence of the consonants /gn/, as in the lexical items *digno*, *maligno*, and *pugna* ('worthy', 'evil', 'struggle'). The presence of the consonant "t" in word final position does not contradict this model, since this consonant appears as well in lexical items in early forms of Spanish and in borrowed tokens such as *robot*, *boicot*, *soviet* ('robot', 'boycott', 'soviet') in modern Spanish.

2.2. Visual distinctiveness.

Linguistic signs are not only phonetically distinctive, but also visually distinctive. Bolinger [2] argued in favor of the existence of visual morphemes (i.e. signs) in English. The English words *rite*, *right*, and *wright* all have the same pronunciation, but their distinctiveness lies exclusively in their spelling. English speakers discriminate the signs *rite* from *right* by the -gh graphemes, and distinguish *right* from *wright* by the appearance of the grapheme *w*. Likewise, Spanish speakers distinguish *ojea* (to have a look at) and *hojear* (to leaf through), *asta* (n. flagpole) and *hasta* (prep. until), *hato* (n. bundle) and *ato* (verb, I fasten), *vaca* (n. cow) and *baca* (n. roof rack), *benéfico* (adj. beneficial) and *venéfico* (adj. poisonous), *boto* (n. type of shoe) and *voto* (n. vote), in addition to many more.

Using these criteria, one would have to conclude that the terms *doughnut* and *doghnut* are visually distinctive as well, although they might not be distinctive if the context or communicative situation were the same. But this is not the case since Europastry sells its product as a frozen pastry, while Panrico sells theirs as a fresh product.

2. The distinctiveness of the brand in relation to generic names

Spanish trademark law states in Article 4 that a brand is "*any sign capable of graphic representation which serves to distinguish the goods or services of one company or the other in the market*". Such signs may be, according to paragraph a) of art. 4, "*the words or combinations of words, including those used to identify individuals.*" Article 5, paragraph d) of this law forbids "*signs or indications which have become customary to designate the goods or services in common language*". The law provides that a trademark can be a word that is distinctive of commercial products. The law does not specify what is meant by *word*, but not restricting the interpretation of the term *word* implies that any linguistic form commonly used in a language is fair game. In particular, common generic nouns, appearing in the dictionary or not, are suitable candidates for brand names. But the use of generic words for commercial products complicates distinctiveness, especially if this means blocking another company from the use of the term, and makes the creation of new brand names an uphill battle.

One way to express the distinctiveness of a word is to use a neologism to describe a completely new product. One way to create new words is by way of acronyms in which the initial sounds of different words are combined into one term. A well-known case is that of *Aspirin* (from the German *Aspirin*), which combines the components *acetylierte Spirsäure* with the chemical suffix -in, producing a-spir-in, which in Spanish is adapted with the suffix -ina, as in other pharmaceutical names such as *penicil-ina*. It is, therefore, a new, artificial creation which associates the chemical composition of the product to a specific and new brand name. Because of the widespread use of the drug, aspirin has become a common noun, but the manufacturer is active in the ownership of the brand name. And although this brand name is already used as a common noun in Spanish and other European languages, it has an owner, the company Bayern. It can therefore not be used by another company to designate the therapeutic use of acetylsalicylic acid.

This is not the case, however, with the word *doughnut* and its variants. In 1962, the Spanish company Panrico took a generic or common noun from English in order to designate and identify a special type of pastry that has very particular organoleptic characteristics, which do not form

part of any confection produced in Spain.

Morphological analysis reveals that the word *doughnut* is a complex word consisting of two roots: the root *dough* is a name or generic noun which means "a mass made of flour used for bread and cakes" and another root *nut*, which is a generic noun which means "small biscuit or Cake, round in shape like a ring,"

The English language supports a variant of the word, *donut*, which is also a generic name and pronounced like *doughnut*. The reason for this double spelling is due to the fact that the graphic representation of words in English is extremely conservative. The form which contains the graphemes *gh*, which are not pronounced, suggests an older form than the word which is written as *donut*,

Regarding the word *doghnut*, which the company Panrico also has registered, refers most certainly to a barbarism formed from the original English word, which is not included in any English dictionary, but which English speakers use in specific contexts such as descriptions of jewelry or even physical objects to denote a ring shaped object.

As already mentioned above, the word *doughnut* entered into the Spanish language in the last 30 years as the generic name designating a confectionery product with unique organoleptic properties.

Although the phonetic and visual distinctiveness of the sign *doughnut* is justifiable with respect to its variants, this is not so from the point of view of semantics.

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The anglicism is employed to fill a gap in the Spanish lexicon. This is no different than the case of the English word *sandwich*, which the dictionary of the Royal Spanish Academy recognized

in 2014, indicating that it is pronounced as it is written. *Sándwich* in Spanish does not mean the same as "*bocadillo*", as any Spanish speaker will attest. If it designated the same concept, the unnecessary anglicism would not have been introduced and accepted into Spanish. It is noteworthy that the Spanish term "*emparedado*" was proposed to replace the anglicized "*sándwich*", but was unsuccessful, although it appears in the dictionary of the Royal Spanish Academy. Therefore, the word *sandwich* could not be registered as a trademark, exactly for the same reason that the term *bocadillo* could not be.

In conclusion, Morphological analysis reveals that the word *doughnut* is a complex word consisting of two roots: the root *dough* is a name or generic noun which means "a mass made of flour used for bread and cakes" and another root *nut*, which is a generic noun which means "small biscuit or

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It is not surprising that two specialists in the economic analysis of law, William Landes and Richard Posner [5], have warned of the need to guard against generic names being used as brand names for the effects this would have on the monopolization of everyday language:

“ Generic words cannot be trademarked at all; what is more, if a trademark becomes a generic name, trademark protection immediately ceases. A generic name or term is by definition the name not of a brand but of an entire product; ‘airplane’ and ‘computer’ are examples of generic names. If the producer of one brand could appropriate the name of the product, he would earn rents because of the added cost to his rivals of periphrasis –of describing their products as ‘ heavier-than-air flying machines’ or ‘ artificially-intelligence machines’.” [5], 291.

4. The judgment of the Court of Barcelona.

The Barcelona hearing (Case 280/2008) found that the terms *donut*, *donuts* and *doughnuts* are not identical signs. But the Court determined that "one cannot deny the similarity". The judge had to meet other non-semiotic criteria in order to rule in favor of one of the parties involved in the litigation. The judgment states that "there are discrepancies with respect to the knowledge we have in Spain the regarding the word '*doughnuts*' ". The judge fails to recognize that in Spain the English language has been taught officially since 1970, and since then the number of Spaniards who know the language is enormous. The judge says the word "doughnut" is not a generic name, but a "fantastical name" (" denominación de fantasía" in the judge's words), much as if it had been invented by John Tolkien in *The Lord of the Rings*. Additionally, the judge disregarded wholesale the existence of distinctive visual morphemes as studied by Bolinger [2]. Hence, the judge says, this word has no descriptive function or product identifier. Consequently, the Court ruled that the word "doughnut" is devoid of any distinctive value, and therefore, must prohibit its use by one of the companies involved in litigation.

4. Conclusions.

Brand names should possess distinctiveness in several regards. The concurrence of various signs for a product, the facts of which we have presented in these pages with respect to the generic name *doughnut* and its variants, allows us to examine with some precision what the distinctive properties of a brand name entail. In the case of *doughnut* versus *doghnut*, it is possible to semiotically justify the phonetic and graphic distinctiveness of the terms as well as their power as an identifier, without confusion with respect to the context in which they appear. Semantically, the anglicism *doughnut* is necessary because there is no such term in the specialized vocabulary of the baked-goods industry of Spanish by which to describe the organoleptic characteristics of the product. The appropriation of this generic English noun as a commercial brand by a company set a worrying precedent for free enterprise, laying the path toward the monopolistic use of language, which in an open and liberal society is unacceptable. For language, as an economic good, is not appropriable.

The registration of the word *doughnut* and its variants which Panrico made between 1962 and 1988 was based on the idea that English in 1962 was an "exotic" language which the general public did not know in Spain. Today the registration of this English word would be unjustifiable because of the general knowledge of English in Spain. Still in 1976 a ruling by the 3rd Chamber of the Spanish Supreme Court, ruled that foreign words are arbitrary names, provided they "have not been integrated into the national language."

The reality of languages in twenty-first century European society has left behind the law, as often happens. Languages in an open and liberal society are porous and absorb words and phrases from other languages. It is sometimes difficult to determine the direction of loanwords and idioms. In a world dominated by English, like it or not, European national languages are so chockfull of anglicisms that it is arbitrary to establish which English word or not is integrated into the national languages.

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